

Request for Reconsideration after Final Action

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Input Field	Entered
SERIAL NUMBER	77199918
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	

TRADEMARK
Case No. 13439-364

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Chicago Mercantile Exchange Inc.

Serial No.: 77/199,918

Filing Date: June 7, 2007

Mark: CHI

Examining Attorney:

Linda A. Powell

Law Office 106

**REQUEST FOR RECONSIDERATION AFTER FINAL ACTION
DATED OCTOBER 5, 2012**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1450

I. INTRODUCTION

After carefully reviewing the contents of the Final Action, Applicant submits this Request for Reconsideration and several substitute specimens showing use of the CHI mark as a source identifier in connection with the services set forth in the Application. For example, Applicant uses the CHI mark as the name of a particular futures contract related to hurricanes. This is clear evidence of Applicant's use of the mark as a source identifier in connection with the relevant services. In

addition, Applicant respectfully argues that the CHI mark does not simply identify a process or system for estimating hurricane damage but actually identifies an investment service, namely futures and options contracts related to hurricanes. More importantly, customers seek to utilize Applicant's investment services on the basis of the CHI mark and recognize the CHI mark as a source identifier. Accordingly, the mark is registrable as a service mark. The Examining Attorney's arguments to the contrary are simply not supported by the case law and evidence of record. As a result, the refusal to register should be withdrawn and the Application should proceed to registration. Applicant's arguments are more fully set forth below.

II. ARGUMENT

A. Review of Prosecution History:

On June 7, 2007, Applicant filed an application to register the mark CHI (the "Mark" or "CHI Mark") in connection with "investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange" (hereinafter "Services") based on intent to use the Mark in commerce under Section 1(b). The application was allowed on August 16, 2011, and Applicant filed a Statement of Use on February 7, 2012. On March 8, 2012, the Examining Attorney issued an office action refusing the specimen because the Examining Attorney believed the Mark "as used on the specimen of record, merely identifies a process or system; it does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services." In response, Applicant submitted an alternative specimen showing the use of the CHI Mark in connection with the Services. However, in the Final Action dated October 5, 2012, the Examining Attorney maintained her original refusal on the basis that the second specimen also shows use of the Mark to identify a process or system, namely, the Mark "is used with an index used in valuation of investments, but not as a source identifier for investment services." Applicant now submits this Request for Reconsideration to address Examining Attorney's arguments and submit substitute specimens.[1]

B. Background Information Regarding Applicant's Services:

To assist the Examining Attorney in understanding Applicant's business and the nature of the

services offered, Applicant provides certain background information. Applicant is a worldwide leader in the financial industry and part of CME Group, which is the world's largest and most diverse financial derivatives marketplace. Customers rely upon Applicant's services for their financial exchange trading, investment, risk management, and financial information services. Applicant's services are defined into two core investment services: financial trading services and financial information services. Financial trading services relate to the trading of financial products through an exchange or over-the-counter platform, including the matching, processing and clearing of those trades. Financial information services involve the provision of financial market data services and analysis, including real-time and historical information and financial indexes. These are separate and distinct services offered by Applicant and may be used by different customers for different reasons.

The key financial products traded on Applicant's exchange are futures and options contracts. These contracts are offered in a wide range of asset classes, such as metals, commodities, foreign exchange, energy, equity indexes and weather products. For example, Applicant's weather futures and options contracts allow customers to transfer risk associated with adverse weather events to the capital markets and increase their overall capacity to recover from the damage. Relevant to this application, the services provided under the CHI Mark are actually part of the hurricane futures and options contracts traded at Applicant's exchange. These contracts are based, in part, on numerical measures of the destructive potential of a hurricane. Simply put, Applicant provides investment services, namely, the futures and options contracts related to hurricanes, and Applicant uses the CHI Mark as a source identifier for these services. Applicant's target customers include hedge funds, insurers and reinsurers, energy companies, utility companies, hotel corporations and other commercial enterprises that might be affected by hurricanes. This service can be a critical component of a customer's risk management in the investment process.

Finally, to demonstrate to the public that CHI Mark is a source identifier and one of Applicant's trademarks, Applicant regularly uses the TM symbol next to the CHI Mark, which is a signal to third parties that Applicant claims trademark rights in the mark. An example of such usage is shown in Exhibit D.

C. The Mark Is Used In Connection With Services And Not A Process.

In the instant case, the services provided under the CHI Mark constitute a service and are not a process or system. As explained above, CHI service is embedded in and part of the hurricane futures and options contracts and Applicant actually offers a CHI futures contract. The mere fact that Applicant uses the word “index” on the specimens does not mean that the CHI service is simply a process or system for estimating hurricane damage as opposed to an investment service. As fully explained in the preceding section, CHI services allow customers to offset risk associated with potential damage arising from a hurricane by trading futures or options contracts related to hurricanes on Applicant’s exchange. Applicant could have used the term “CHI service” instead of the term “CHI index” in the specimens, which would not have changed the essence of the Services provided under the CHI Mark. Furthermore, the CHI service is such an intrinsic part of Applicant’s Services that consumers view CHI, as used on the specimens, not as the name of an index used to estimate hurricane damage, but as a mark for the service. See *In re Stafford Printers, Inc.*, 153 USPQ 428 (T.T.A.B. 1967)[2] (“[t]hat the term “process” is used on the specimen does not ipso facto mean that an arbitrary mark used in connection therewith designates a process and not more”). This reinforces the fact that Applicant identifies futures contract by the mark CHI.

The Board’s decision in *In Re Caldwell Tanks, Inc.*, Ser. No. 75/672,03, 2002 WL 376688 (T.T.A.B. 2002) is instructive. Specifically, the Board found that “[a]lthough the specimens use the mark, in part, in conjunction with the phrase “jump form system,” the word “system,” like “process,” does not automatically prevent a term from functioning as a mark. As a result, “the construction system is such an intrinsic part of the construction service that consumers will view STAC-4 and design, as used on the specimens, not merely as the name of the system, but as a mark for the service.” Similarly, *In Re Solutions Now*, 1999 WL 670730 (T.T.A.B. 1999), the Board found that “applicant could have just as easily used the word ‘service’ in lieu of the word ‘process,’” therefore applicant’s use of the word “process” in the specimens did not mean that the mark identified a process as opposed to a service. *Id.*

Therefore, the CHI Mark refers to a service and not simply a process or system, and is used as a source identifier. As a result, the refusal to register should be withdrawn.

D. In the Alternative, Even Marks That Identify Both The System Or Process And Applicant’s Investment Services Rendered By Means Of The System Or Process Are Registrable.

“A process, inter alia, is a particular method or system of doing something..By its very meaning, the term “process” can encompass a service.” *In re Stafford Printers, Inc.*, 153 USPQ 428 (T.T.A.B. 1967). The name of a process or system is registrable if: (1) the applicant is performing a service; and (2) the designation identifies and indicates the source of the service. TMEP §1301.02(e). Applicant meets both of these criteria. In the Final Action, the Examining Attorney argued that “the specimen shows the applied-for mark used solely to identify a process or system because it is used in reference to ta [sic] numerical measure of potential damage from a hurricane, and index of that measure, and not to identify the source of the provision of investment services.” Applicant respectfully disagrees.

Both the case law and TMEP clearly state that if the term is used to identify both the system or process and the services rendered by means of the system or process, the designation may be registrable as a service mark. See *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (T.T.A.B. 1979) (the Board found the mark LIQWACON registrable as a service mark where the mark identified both a waste treatment and disposal service and a chemical solidification process). See TMEP §1301.02(e).

Assuming, arguendo, that the CHI Mark identifies the system or process for estimating hurricane damage, the CHI Mark is still registrable as a service mark because the CHI Mark, as clearly shown on the previously submitted and new specimens, identifies both the system or process and Applicant’s investment services rendered by means of such system or process. The CHI Mark is used in the context of providing investment service, including as the name of a particular futures contract. Accordingly, the CHI Mark is used in connection with and as part of providing the investment services and is registrable as a service mark. In support, Applicant submits three different documents as additional specimens of use.

The first new specimen submitted by Applicant is a brochure regarding Applicant’s hurricane contracts. See Exhibit B. Most importantly, the specimen identifies list of “Seasonal Max Binary futures contracts” and the name of the first contract includes the CHI Mark.

The second new specimen submitted by Applicant entitled “Hurricane Product Center” is a print-out from Applicant’s website that consists of an advertisement for the Mark in connection with providing Applicant’s investment services. See Exhibit C. The second specimen states in part:
The CME Hurricane Index (CHI) was developed to provide a quick and easy-to-calculate estimate of hurricane damage and is used by all of our Hurricane futures and

options on futures contracts. (emphasis added)

The third new specimen submitted by Applicant entitled “A Detailed Overview of the CME Hurricane Index™(CHI™)” is a brochure describing the CHI Index. See Exhibit D. The third specimen states in part:

This high level of detail and responsiveness, plus the ability to update frequently using publicly available data, *make the CHI an ideal choice as the basis for the suite of hurricane futures, options, and binary contracts traded at CME.* (emphasis added)

The fact that there is a CHI hurricane contract and the fact that the last two specimens include the words “used by all of our Hurricane futures and options on futures contracts” and “make the CHI an ideal choice as the basis for the suite of hurricane futures, options, and binary contracts traded at CME” clearly indicate that the CHI Mark is used in connection with and as a part of Applicant’s investment services. Similarly, the specimens previously submitted by Applicant demonstrated use of the CHI Mark in connection with “futures and options” or “futures and options contracts.” There can be no clearer specimen or evidence of record showing use of the CHI Mark as a source identifier for the provision of Applicant’s investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange. Accordingly, at a minimum, the Mark identifies both the system or process for estimating hurricane damage and the investment services rendered by means of such system or process, and thus registrable as a service mark.

E. The Examining Attorney’s Case Law Fails to Support Her Position.

In support of her refusal, the Examining Attorney relies upon decisions in *In re Universal Oil Prods. Co.*, 476 F.2d 653 (C.C.P.A. 1973), *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984) and *Liqwacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305 (TTAB 1979). The decisions in *In re Universal Oil Prods. Co.* and *In re Hughes Aircraft Co.* are clearly distinguishable from the present record and therefore do not support the Examining Attorney’s position. Furthermore, the decision in *Liqwacon Corp. v. Browning-Ferris Indus., Inc.* supports Applicant’s position, not the Examining Attorney’s position .

In *In re Universal Oil Prods. Co.*, the brochures submitted as specimens completely failed to show any use of the PACOL and PENEX marks in reference to PACOL or PENEX services. 476 F.2d at 654. Specifically, the Court of Customs and Patent Appeals found no association between the marks and the offer of services. Instead, the marks were simply used in a brochure offering to

license or install the processes. *Id.* In *In re Hughes Aircraft Co.*, the specimens and other materials introduced by the applicant used the term “PHOTOX” only in connection with applicant’s photochemical vapor deposition process or method, and not any specific services. 222 USPQ at 265. The Board found that there was no association between the applicant’s offering of services of treating the products of others by means of photochemical vapor and the term “PHOTOX.” *Id.* Neither of these situations is present here.

Unlike *In re Universal Oil Prods. Co.*, all specimens submitted in support of the use of the CHI Mark reference and detail Applicant’s investment services, namely, futures and options contracts related to hurricanes for trading on an exchange. Applicant has submitted ample evidence of record on this issue and further detailed these arguments in the above sections. Moreover, the specimens submitted by Applicant show the use of the mark CHI in association with and as part of providing Applicant’s investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange, because the specimens reference these services.

Finally, the Board’s decision in *Liqwacon Corp.* supports Applicant’s position because, similar to the present case, the mark in *Liqwacon Corp.* identified both a waste treatment and disposal service and a chemical solidification process, and thus was registrable as a service. 203 USPQ at 318. At the very least, Applicant has provided ample evidence and arguments to show that the mark CHI Mark identifies both an index and investment services. Therefore, the Examining Attorney’s case law fails to support her position that Applicant’s specimens are unacceptable.

III. CONCLUSION

Based upon the foregoing, Applicant respectfully requests that the Examining Attorney withdraw her refusal with regard to the previously submitted specimens, accept the new specimens submitted by Applicant with this Request and allow the CHI Mark to proceed to the registration. The Examining Attorney is urged to contact Applicant’s counsel directly with any questions regarding this Request for Reconsideration or the specimens submitted.

Respectfully Submitted,

CHICAGO MERCANTILE EXCHANGE INC

Dated: April 5, 2013

By: /Tatyana V. Gilles/
Joseph T. Kucala, Jr.

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Attorneys for Applicant

[1] Applicant also simultaneously filed a Notice of Appeal with the Trademark Trial and Appeal Board.

[2] All cases cited in this Request are attached as Exhibit A.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

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DESCRIPTION OF EVIDENCE FILE	case law, Applicant's brochures and print-outs from Applicant's website
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INTERNATIONAL CLASS	036
DESCRIPTION	
Investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange	
FIRST USE ANYWHERE DATE	At least as early as 03/31/2007
FIRST USE IN COMMERCE DATE	At least as early as 03/31/2007
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	036
DESCRIPTION	
Investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange	
FIRST USE ANYWHERE DATE	At least as early as 03/31/2007
FIRST USE IN COMMERCE DATE	At least as early as 03/31/2007
	"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or

STATEMENT TYPE	new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use].
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SPECIMEN DESCRIPTION	Applicant's brochures and a print-out from Applicant's website showing Applicant's Mark as used in connection with providing Applicant's investment services
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Tatyana V. Gilles/
SIGNATORY'S NAME	Tatyana V. Gilles
SIGNATORY'S POSITION	Attorney
DATE SIGNED	04/05/2013
RESPONSE SIGNATURE	/Tatyana V. Gilles/
SIGNATORY'S NAME	Tatyana V. Gilles
SIGNATORY'S POSITION	Attorney
DATE SIGNED	04/05/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Apr 05 22:27:51 EDT 2013
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**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77199918** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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Case No. 13439-364

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chicago Mercantile Exchange Inc. Serial No.: 77/199,918 Filing Date: June 7, 2007 Mark: CHI	Examining Attorney: Linda A. Powell Law Office 106
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DATED OCTOBER 5, 2012**

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P.O. Box 1451
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To assist the Examining Attorney in understanding Applicant’s business and the nature of the services offered, Applicant provides certain background information. Applicant is a worldwide leader in the financial industry and part of CME Group, which is the world’s largest and most diverse financial derivatives marketplace. Customers rely upon Applicant’s services for their financial exchange trading, investment, risk management, and financial information services. Applicant’s services are defined into two core investment services: financial trading services and financial information services. Financial trading services relate to the trading of financial products through an exchange or over-the-counter platform, including the matching, processing and clearing of those trades. Financial information services involve the provision of financial market data services and analysis, including real-

time and historical information and financial indexes. These are separate and distinct services offered by Applicant and may be used by different customers for different reasons.

The key financial products traded on Applicant's exchange are futures and options contracts. These contracts are offered in a wide range of asset classes, such as metals, commodities, foreign exchange, energy, equity indexes and weather products. For example, Applicant's weather futures and options contracts allow customers to transfer risk associated with adverse weather events to the capital markets and increase their overall capacity to recover from the damage. Relevant to this application, the services provided under the CHI Mark are actually part of the hurricane futures and options contracts traded at Applicant's exchange. These contracts are based, in part, on numerical measures of the destructive potential of a hurricane. Simply put, Applicant provides investment services, namely, the futures and options contracts related to hurricanes, and Applicant uses the CHI Mark as a source identifier for these services. Applicant's target customers include hedge funds, insurers and reinsurers, energy companies, utility companies, hotel corporations and other commercial enterprises that might be affected by hurricanes. This service can be a critical component of a customer's risk management in the investment process.

Finally, to demonstrate to the public that CHI Mark is a source identifier and one of Applicant's trademarks, Applicant regularly uses the TM symbol next to the CHI Mark, which is a signal to third parties that Applicant claims trademark rights in the mark. An example of such usage is shown in Exhibit D.

C. The Mark Is Used In Connection With Services And Not A Process.

In the instant case, the services provided under the CHI Mark constitute a service and are not a process or system. As explained above, CHI service is embedded in and part of the hurricane futures and options contracts and Applicant actually offers a CHI futures contract. The mere fact that Applicant uses the word "index" on the specimens does not mean that the CHI service is simply a process or system for estimating hurricane damage as opposed to an investment service. As fully explained in the preceding section, CHI services allow customers to offset risk associated with potential damage arising from a hurricane by trading futures or options contracts related to hurricanes on Applicant's exchange. Applicant could have used the term "CHI service" instead of the term "CHI index" in the specimens, which would not have changed the essence of the Services provided under the CHI Mark.

Furthermore, the CHI service is such an intrinsic part of Applicant's Services that consumers view CHI, as used on the specimens, not as the name of an index used to estimate hurricane damage, but as a mark for the service. See *In re Stafford Printers, Inc.*, 153 USPQ 428 (T.T.A.B. 1967)[2] (“[t]hat the term “process” is used on the specimen does not ipso facto mean that an arbitrary mark used in connection therewith designates a process and not more”). This reinforces the fact that Applicant identifies futures contract by the mark CHI.

The Board's decision in *In Re Caldwell Tanks, Inc.*, Ser. No. 75/672,03, 2002 WL 376688 (T.T.A.B. 2002) is instructive. Specifically, the Board found that “[a]lthough the specimens use the mark, in part, in conjunction with the phrase “jump form system,” the word “system,” like “process,” does not automatically prevent a term from functioning as a mark. As a result, “the construction system is such an intrinsic part of the construction service that consumers will view STAC-4 and design, as used on the specimens, not merely as the name of the system, but as a mark for the service.” Similarly, *In Re Solutions Now*, 1999 WL 670730 (T.T.A.B. 1999), the Board found that “applicant could have just as easily used the word ‘service’ in lieu of the word ‘process,’” therefore applicant's use of the word “process” in the specimens did not mean that the mark identified a process as opposed to a service. *Id.*

Therefore, the CHI Mark refers to a service and not simply a process or system, and is used as a source identifier. As a result, the refusal to register should be withdrawn.

D. In the Alternative, Even Marks That Identify Both The System Or Process And Applicant's Investment Services Rendered By Means Of The System Or Process Are Registrable.

“A process, inter alia, is a particular method or system of doing something...By its very meaning, the term “process” can encompass a service.” *In re Stafford Printers, Inc.*, 153 USPQ 428 (T.T.A.B. 1967). The name of a process or system is registrable if: (1) the applicant is performing a service; and (2) the designation identifies and indicates the source of the service. TMEP §1301.02(e). Applicant meets both of these criteria. In the Final Action, the Examining Attorney argued that “the specimen shows the applied-for mark used solely to identify a process or system because it is used in reference to ta [sic] numerical measure of potential damage from a hurricane, and index of that measure, and not to identify the source of the provision of investment services.” Applicant respectfully disagrees.

Both the case law and TMEP clearly state that if the term is used to identify both the system or

process and the services rendered by means of the system or process, the designation may be registrable as a service mark. See *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (T.T.A.B. 1979) (the Board found the mark LIQWACON registrable as a service mark where the mark identified both a waste treatment and disposal service and a chemical solidification process). See TMEP §1301.02(e).

Assuming, arguendo, that the CHI Mark identifies the system or process for estimating hurricane damage, the CHI Mark is still registrable as a service mark because the CHI Mark, as clearly shown on the previously submitted and new specimens, identifies both the system or process and Applicant's investment services rendered by means of such system or process. The CHI Mark is used in the context of providing investment service, including as the name of a particular futures contract. Accordingly, the CHI Mark is used in connection with and as part of providing the investment services and is registrable as a service mark. In support, Applicant submits three different documents as additional specimens of use.

The first new specimen submitted by Applicant is a brochure regarding Applicant's hurricane contracts. See Exhibit B. Most importantly, the specimen identifies list of "Seasonal Max Binary futures contracts" and the name of the first contract includes the CHI Mark.

The second new specimen submitted by Applicant entitled "Hurricane Product Center" is a print-out from Applicant's website that consists of an advertisement for the Mark in connection with providing Applicant's investment services. See Exhibit C. The second specimen states in part:

The CME Hurricane Index (CHI) was developed to provide a quick and easy-to-calculate estimate of hurricane damage and is *used by all of our Hurricane futures and options on futures contracts.* (emphasis added)

The third new specimen submitted by Applicant entitled "A Detailed Overview of the CME Hurricane Index™(CHI™)" is a brochure describing the CHI Index. See Exhibit D. The third specimen states in part:

This high level of detail and responsiveness, plus the ability to update frequently using publicly available data, *make the CHI an ideal choice as the basis for the suite of hurricane futures, options, and binary contracts traded at CME.* (emphasis added)

The fact that there is a CHI hurricane contract and the fact that the last two specimens include the words "used by all of our Hurricane futures and options on futures contracts" and "make the CHI an ideal choice as the basis for the suite of hurricane futures, options, and binary contracts traded at CME" clearly indicate that the CHI Mark is used in connection with and as a part of Applicant's

investment services. Similarly, the specimens previously submitted by Applicant demonstrated use of the CHI Mark in connection with “futures and options” or “futures and options contracts.” There can be no clearer specimen or evidence of record showing use of the CHI Mark as a source identifier for the provision of Applicant’s investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange. Accordingly, at a minimum, the Mark identifies both the system or process for estimating hurricane damage and the investment services rendered by means of such system or process, and thus registrable as a service mark.

E. The Examining Attorney’s Case Law Fails to Support Her Position.

In support of her refusal, the Examining Attorney relies upon decisions in *In re Universal Oil Prods. Co.*, 476 F.2d 653 (C.C.P.A. 1973), *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984) and *Liqwacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305 (TTAB 1979). The decisions in *In re Universal Oil Prods. Co.* and *In re Hughes Aircraft Co.* are clearly distinguishable from the present record and therefore do not support the Examining Attorney’s position. Furthermore, the decision in *Liqwacon Corp. v. Browning-Ferris Indus., Inc.* supports Applicant’s position, not the Examining Attorney’s position .

In *In re Universal Oil Prods. Co.*, the brochures submitted as specimens completely failed to show any use of the PACOL and PENEX marks in reference to PACOL or PENEX services. 476 F.2d at 654. Specifically, the Court of Customs and Patent Appeals found no association between the marks and the offer of services. Instead, the marks were simply used in a brochure offering to license or install the processes. *Id.* In *In re Hughes Aircraft Co.*, the specimens and other materials introduced by the applicant used the term “PHOTOX” only in connection with applicant’s photochemical vapor deposition process or method, and not any specific services. 222 USPQ at 265. The Board found that there was no association between the applicant’s offering of services of treating the products of others by means of photochemical vapor and the term “PHOTOX.” *Id.* Neither of these situations is present here.

Unlike *In re Universal Oil Prods. Co.*, all specimens submitted in support of the use of the CHI Mark reference and detail Applicant’s investment services, namely, futures and options contracts related to hurricanes for trading on an exchange. Applicant has submitted ample evidence of record on this issue and further detailed these arguments in the above sections. Moreover, the specimens submitted

by Applicant show the use of the mark CHI in association with and as part of providing Applicant's investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange, because the specimens reference these services.

Finally, the Board's decision in *Liqwacon Corp.* supports Applicant's position because, similar to the present case, the mark in *Liqwacon Corp.* identified both a waste treatment and disposal service and a chemical solidification process, and thus was registrable as a service. 203 USPQ at 318. At the very least, Applicant has provided ample evidence and arguments to show that the mark CHI Mark identifies both an index and investment services. Therefore, the Examining Attorney's case law fails to support her position that Applicant's specimens are unacceptable.

III. CONCLUSION

Based upon the foregoing, Applicant respectfully requests that the Examining Attorney withdraw her refusal with regard to the previously submitted specimens, accept the new specimens submitted by Applicant with this Request and allow the CHI Mark to proceed to the registration. The Examining Attorney is urged to contact Applicant's counsel directly with any questions regarding this Request for Reconsideration or the specimens submitted.

Respectfully Submitted,

CHICAGO MERCANTILE EXCHANGE INC

Dated: April 5, 2013

By: /Tatyana V. Gilles/
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Attorneys for Applicant

[1] Applicant also simultaneously filed a Notice of Appeal with the Trademark Trial and Appeal Board.

[2] All cases cited in this Request are attached as Exhibit A.

EVIDENCE

Evidence in the nature of case law, Applicant's brochures and print-outs from Applicant's website has been

attached.

Original PDF file:

[evi_108160194249-213537584_.. Exhibit A CHI.pdf](#)

Converted PDF file(s) (27 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

[Evidence-15](#)

[Evidence-16](#)

[Evidence-17](#)

[Evidence-18](#)

[Evidence-19](#)

[Evidence-20](#)

[Evidence-21](#)

[Evidence-22](#)

[Evidence-23](#)

[Evidence-24](#)

[Evidence-25](#)

[Evidence-26](#)

[Evidence-27](#)

Original PDF file:

[evi_108160194249-213537584_.. Exhibit B CHI.pdf](#)

Converted PDF file(s) (13 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

Original PDF file:

[evi_108160194249-213537584 . Exhibit C CHI.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

Original PDF file:

[evi_108160194249-213537584 . Exhibit D CHI.pdf](#)

Converted PDF file(s) (7 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 036 for Investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

In International Class 036, the mark was first used at least as early as 03/31/2007 and first used in commerce at least as early as 03/31/2007.

Proposed: Class 036 for Investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

In International Class 036, the mark was first used at least as early as 03/31/2007. and first used in commerce at least as early as 03/31/2007.

Applicant hereby submits one(or more) specimen(s) for Class 036. The specimen(s) submitted consists of Applicant's brochures and a print-out from Applicant's website showing Applicant's Mark as used in connection with providing Applicant's investment services.

"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application"*[for an application based on Section 1(a), Use in Commerce]* OR **"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use"***[for an application based on Section 1(b) Intent-to-Use].*

Original PDF file:

[SPU0-108160194249-213537584 . CHI1.pdf](#)

Converted PDF file(s) (12 pages)

[Specimen File1](#)

[Specimen File2](#)

[Specimen File3](#)

[Specimen File4](#)

[Specimen File5](#)

[Specimen File6](#)

[Specimen File7](#)

[Specimen File8](#)

[Specimen File9](#)

[Specimen File10](#)

[Specimen File11](#)

[Specimen File12](#)

Original PDF file:

[SPU0-108160194249-213537584 . CHI2.pdf](#)

Converted PDF file(s) (3 pages)

[Specimen File1](#)

[Specimen File2](#)

[Specimen File3](#)

Original PDF file:

[SPU0-108160194249-213537584 . CHI3.pdf](#)

Converted PDF file(s) (6 pages)

[Specimen File1](#)

[Specimen File2](#)

[Specimen File3](#)

[Specimen File4](#)

[Specimen File5](#)

[Specimen File6](#)

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form

thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Tatyana V. Gilles/ Date: 04/05/2013

Signatory's Name: Tatyana V. Gilles

Signatory's Position: Attorney

Request for Reconsideration Signature

Signature: /Tatyana V. Gilles/ Date: 04/05/2013

Signatory's Name: Tatyana V. Gilles

Signatory's Position: Attorney

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77199918

Internet Transmission Date: Fri Apr 05 22:27:51 EDT 2013

TEAS Stamp: USPTO/RFR-108.160.194.249-20130405222751

369523-77199918-5009e86b34126f546f38af99

c4aab161fd69a458b21c6e138512b6dcd4456fe2

e0-N/A-N/A-20130405213537584539

Exhibit A

agreement cannot bestow "valid" ownership for purposes of registration. This is a very narrow reading of the Scandinavian case, which has been interpreted as holding that ownership of a trademark in the United States may be based on a present assignment coupled with an exclusive distributorship of a product manufactured abroad even though the distributorship is terminable. Certainly, there is nothing in the decision to indicate that the conclusion reached would have been any different if the exclusive distributorship had been terminable at any time within the twenty year period. In fact, if the examiner's position was the law, the result in the Scandinavian case would have been different since, at the end of the first twenty years, the distributor-assignee could not have renewed for another twenty year period in view of the fact that the distributorship was set to expire within seven years. To follow the examiner to his ultimate illogical conclusion would be to permit registration only to those persons who can guarantee that the mark would be in use for the entire statutory period of registration. When one realizes that only a percentage of the marks registered in the Patent Office remain in use during the entire registration period, the fallacy of the examiner's reasoning becomes readily apparent. The statute, moreover, provides conditions precedent to registration and conditions subsequent such as abandonment, non-use, and the like only as grounds for cancellation of a registration after issuance.² The conditions precedent are use and ownership at the time of the filing of the application, and it is apparent that applicant has met both requirements. It is well settled, moreover, with respect to a transfer of property and contract rights that an obligation to reassign on the happening of a condition subsequent does not vitiate the effectiveness or completeness of the present transfer. Section 150 of the Restatement of Contracts sets forth the applicable law as follows:

"An assignment is not ineffective because it is conditional, revocable or voidable by the assignor for lack of consideration or for other reason, or because it is within the provisions of a Statute of Frauds."

It is therefore concluded that appli-

² In this regard, it is noteworthy that a registration can be cancelled under Section 8 of the Statute at the end of the sixth year of registration in the absence of a showing of continued use.

cant, by virtue of its exclusive dealership agreement, is the owner for purposes of registration of the mark "JIFFY-POTS" for peat moss pots in the United States.

Decision

The refusal of registration is reversed.

Patent Office Trademark Trial and Appeal Board

In re STAFFORD PRINTERS, INC.

Decided Apr. 18, 1967

TRADEMARKS

1. Marks and names subject to ownership — Service marks (§ 67.525)

Words and phrases (§ 70.)

Term "process" can encompass a service; fact that "process" is used in phrase "Printed By STAFFORDBLEND Process" on specimens does not ipso facto mean that arbitrary mark ("Staffordblend") used in conjunction therewith designates a process and not more; "Staffordblend" is registrable as service mark since applicant renders a service of printing, the particular process of printing being performed only by applicant; mark is placed on tags, which are attached to textiles printed by applicant; specimens show use of "Staffordblend" to identify applicant's service.

Appeal from Examiner of Trademarks.

Application for registration of service mark of Stafford Printers, Inc., Serial No. 170,353. From decision refusing registration, applicant appeals. Reversed.

PETER L. COSTAS, Hartford, Conn., for applicant.

Before WALDSTREICHER, LEFKOWITZ, and SHRYOCK, Members.

WALDSTREICHER, Member.

An application has been filed to register "STAFFORDBLEND" as a mark for the service of "printing of textiles". Use since January 26, 1963 has been alleged.

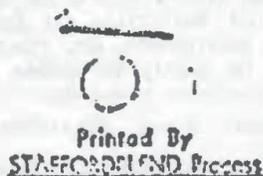
Registration has been refused for the reason that the specimens do not evidence use of the subject matter of the

application as a mark to identify a service.

Applicant has appealed.

It is the examiner's position, notwithstanding that applicant does in fact render the service claimed, that the term "STAFFORDBLEND" as used on the specimens submitted with the application merely designates a process; and in one of the examiner's letters it is indicated that since provision is made in the Act of 1946 to register service marks and no provision is made to register "process marks", the refusal to register is proper.

For the purpose of convenience the actual tag submitted with the application is hereby reproduced:



PATTERN

QUALITY

COMB NO.

YARDS

LOT NO.

The examiner in the examiner's statement indicates that the principal case on the subject appears to be *Ex parte Phillips Petroleum Company*, 100 USPQ 25 (Comr., 1953). Applicant indicates that *In re United Merchants and Manufacturers, Inc.*, 124 USPQ 11 (TT&A Bd., 1959), is directly analogous to the facts in the present case.

The first named case does not hold for the proposition that a "process designation" is inherently unregistrable. In said case the mark sought to be registered identified only a process in connection with which engineering services were furnished, but under the mark "PERCO". The Commissioner stated that "In order to be registrable, a mark must be used in the sale or advertising

of services rendered in commerce to identify and distinguish the services of one person from those of another. Nothing in this record shows any such use of 'Cycloversion'."

The Commissioner's conclusion would indicate that the decision was not based on the mere fact that the term "Process" was used in conjunction with "Cycloversion" and implies that if the term had been used to identify a service it would have been registrable notwithstanding the use of the word "Process".

[1] And what is a process? A process, *inter alia*, is a particular method or system of doing something, producing something or a system used in a manufacturing operation or other technical operation (See: Webster's New International Dictionary, 3rd Edition, 1965). By its very meaning, the term "process" can encompass a service. That the term "process" is used on the specimen does not *ipso facto* mean that an arbitrary mark used in conjunction therewith designates a process and not more.

In the instant case, applicant renders a service of printing. The particular process of printing is one actually performed by applicant and no one other than applicant. The mark is placed on tags, and the tags are attached to textiles which have been printed by applicant. We hold, therefore, that the specimens do show use of "STAFFORDBLEND" to identify the service rendered by applicant and that said mark does constitute a service mark within the meaning of the Act of 1946. See: *In re United Merchants and Manufacturers, Inc.*, *supra*.

Decision

The refusal to register is reversed.

2002 WL 376688 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE CALDWELL TANKS, INC.

Serial No. 75/672,039

March 8, 2002

*1 Jack A. Wheat and Jamie K. Neal of Stites & Harbison for Caldwell Tanks, Inc.

Megan Sweeney, Trademark Examining Attorney

Law Office 115

(Tomas Vlcek, Managing Attorney)¹

Before Seeherman, Bottorff and Rogers

Administrative Trademark Judges

Opinion by Seeherman

Administrative Trademark Judge

Caldwell Tanks, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register STAC-4 and design, as shown below, as a service mark for “construction of elevated tanks.”²



Registration has been refused pursuant to Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052, 1053 and 1127, on the ground that the proposed mark identifies a system, rather than being used as a service mark to identify the source of the identified services.

The appeal has been fully briefed; an oral hearing was not requested.

In order to determine whether STAC-4 and design functions as a mark for applicant's identified services of “construction of elevated tanks,” we must look at the specimens and other advertising material submitted by applicant. **In re Produits Chimiques Ugine Kuhlmann Societe Anonyme**, 190 USPQ 305 (TTAB 1976). Further, because applicant's services are offered to a specialized audience, we must consider the specimens and other literature in light of this audience.

Applicant has explained that its identified services, “construction of elevated tanks,” refer to the construction of water towers. These water towers are a composite elevated tank in which a metal water tank is placed atop a cement silo type tower. Applicant has explained that construction of the water tower is its service, and the references in the specimens to the manner of construction identify not only a process, but the service as well.

The specimens prominently feature the trademark STAC-4 and design, under which is the explanation “Specified Tolerance for Architectural Construction.” A caption under the words “STAC-4 by Caldwell Tanks” states “A Superior Jump Form System for the Construction of Composite Elevated Water Tanks” and the text below that heading includes the following □

Designed to meet construction tolerances for plumb, roundness, and leveling in composite elevated tank shafts, STAC-4 allows Caldwell's construction personnel control of the concrete pour by limiting the form height to four feet. □

STAC-4's diameter specific forms utilize reusable wall spacers, eliminating potential bulging of forms as well as the plug holes cause by alternative systems' ties. □ Finally, STAC-4's unique rustication pattern hides all horizontal and vertical construction joints, further enhancing the appearance of the tank shaft.

*2 On the obverse side of the brochure specimen, under a prominent display of STAC-4 and design, is the following text □

Caldwell's STAC-4 jump form system provides greater control of concrete construction tolerances in the erection of composite elevated tank shafts. Utilizing three, four-foot high, steel forms, STAC-4 meets or exceeds all ACI 371R-97 guidelines for the analysis, design and construction of concrete pedestal water towers while delivering a smooth geometric appearance.

This page of the brochure also has a column captioned “Advantages of the STAC-4 system” which lists various benefits, including, “unique rustication pattern hides vertical and horizontal form joints”; “designed specifically for composite elevated tanks”; and “constructed solely by Caldwell personnel.”

Although both applicant and the Examining Attorney have cited various cases dealing with whether the name of a process can function as a mark, these cases are so fact specific, in terms of whether the particular specimens show trademark or service mark use, that they are of little help in our analysis herein. They do, however, stand for the following legal propositions □ if a term is used only as the name of a process it does not function as a mark, **In re Universal Oil Products Company**, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); a term can be the name of a process and still function as a mark for services, **In re Produits Chimiques Uguine Kuhlmann**, *supra*; and the fact that the word “process” is used in connection with the term does not ipso facto mean that it designates a process and not more. **In re Stafford Printers, Inc.**, 153 USPQ 42 □ (TTAB 1967).

After reviewing the applicant's specimens we find that STAC-4 and design is used as a service mark for the construction of elevated tanks. Although the specimens use the mark, in part, in conjunction with the phrase “jump form system,” the word “system,” like “process,” does not automatically prevent a term from functioning as a mark. Here, the construction system is such an intrinsic part of the construction service that consumers will view STAC-4 and design, as used on the specimens, not merely as the name of the system, but as a mark for the service.

Decision □ The refusal of registration is reversed.

Footnotes

- 1 The Examining Attorney who wrote the brief was not the attorney who examined the application.
- 2 Application Serial No. 75/672,039, filed March 29, 1999, and asserting first use and first use in commerce December 3, 1999 □

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