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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85747739
Applicant	Internet Promise Group LLC
Applied for Mark	MOBILE SEARCH
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Date	06/09/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: INTERNET PROMISE GROUP®, LLC Applicant		Mark: MOBILE SEARCH Application Ser. No.: 85/747,739 Filed: 10/07/2012
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REPLY BRIEF

Honorable Commissioner of Trademarks
P O Box 1451
Alexandria, VA 22313-1451

Examiner Attorney having filed Examiner Appeal Brief, Applicant files the attached Reply Brief. The Reply Brief is timely filed within 20 days of the Examiner Brief dated 05/23/2014 that is on or before 06/13/2014.

Respectfully submitted,

Date: June 9, 2014

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: INTERNET PROMISE GROUP®, LLC

Applicant

Mark: MOBILE SEARCH
Application Ser. No.: 85/747,739
Filed: 10/07/2012

REPLY BRIEF

INTRODUCTION

The Arguments advanced by the Examiner Attorney in the Examiner Attorney Appeal Brief are responded to as follows:

The mark is MOBILE SEARCH and the identification of the goods/services is:

Computer software in smart phones; namely, the software permits a hybrid search interface using a combination of both or either touch or voice commands as decided by a user, in International Class 9.

With a proposed modification to:

Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.

The Examiner has argued against this proposed amendment because of deletion of word “search” in phrase “hybrid search interface”; arguing the proposed amendment makes the goods outside the scope of the original identification of the goods.

The examiner has also argued that this mark is “Merely Descriptive” under Section 2(e) (1) as the Examiner states in the Final Rejection as well in the Examiner Appeal Brief.

Applicant Arguments in the Reply Brief:

Examiner has raised the following issues:

ISSUES ON APPEAL

(1) Whether the asserted mark MOBILE SEARCH defined as “web search engine ability in a mobile form” primarily merely describes features and functions as well as the use and purpose of the Applicant’s “search interface” software for use on “smart phones”, within the meaning of Section 2(e)(i) of the Trademark Act.

(2) Whether the Applicant's proposed Amendment to the identification of goods submitted in its Request for Reconsideration is beyond the scope of the identification as already amended by the Applicant and accepted by the Examiner Attorney, and therefore constitutes an amendment not permitted at the "Request for Reconsideration" stage of the application prosecution.

Both of these issues had been addressed in the Applicant's Appeal Brief. However, given the contents of the Examiner Appeal Brief, Applicant provides the following additional arguments and remarks.

Examiner misunderstands and misconstrues the identification of the goods in the following respects:

The identification of the Applicant's goods is directed to human-factors driven user interface in handheld devices. Applicant here first provides brief historical information that would help the Appeal Judges understand the Applicant's identification of the goods.

There has been since the advent of smart phones around year 2007, a new type of user interface using a touch screen of the device, where a user touched a

specific part of the display/touch screen to interact with the device and to select or control the functions of the smart phone device, in contrast to mechanical switches that were used before 2007.

Within the last year or so there has been still further a new type of interface in the smart phone type devices, using voice-based interface when the SIRI was launched in the market place by Apple.

Now users with these two new types of user interfaces, when using these modern devices are faced with and have a choice between two different types of interfaces, one touch-based and the other voice-based.

A user is left to his/her own ways to determine when to use one or the other type of user interface for interacting with the device. One type of interface may be better in some situations and the other type of interface may be better in other situations and in some situations each has its own advantages to be able to switch from one type to another type. The differences or advantages and disadvantages of one type of user interface versus the other type of user interface are not clearly or properly understood by an average user.

The goods of the applicant are directed to computer software application that is directed to a user interface technology to assist a user of a smart phone or a mobile device when and how to use or select between these two types of entirely different user interfaces and which type of interface to use and when.

Applicant's goods have nothing to do with a search engine or a web search engine that uses a browser application based on using an HTML language for the browser for searching the web.

Examiner was taking a single word "search" outside the context of the identification of the goods based on a user interface and was thus causing confusion. Therefore, Applicant decided to delete that word "search" from the proposed identification of the goods.

In summary,

1. a user interacts and interfaces with a smart phone type device for any number of reasons, and not necessarily for use of a web search engine.

2. the goods relate to a type of user interface; there are primarily two types of user interfaces, one is touch-based that has existed since the advent of smart phones in 2007 and the second is voice-based interface that has existed since the advent of SIRI by Apple. Given these two different types of interfaces now

applicable to these select class of smart phones, a user is unsure which one to use and for what application, because for some applications one is preferred and for other applications the other is preferred and for some applications a combination or a hybrid would be preferred at different stages of user interaction with the smart phone. These two types of interfaces can be used in a variety of ways for different applications and thus are confusing to a user.

The proprietary technology of the goods is directed to make it easier for a user to understand and use these two different types of user interfaces for interacting with the smart phone type device. Hence the emphasis in the identification of the goods is “interface” and a “hybrid interface” and not “search” using a web search engine.

In Examiner’s Appeal Brief, Examiner has cited five different definitions, all of them for related to either MOBILE, or SEARCH or MOBILE SEARCH, implying search of the internet using mobile devices. Of these definitions MOBILE SEACRH refers to web-search engine using mobile devices.

Applicant submits that the prior use of the phrase “mobile search” is directed to and indicates conducting web searches using mobile devices and do not relate to the user interface with the mobile device.

Therefore, with due respect, in her merely descriptive rejections, Examining Attorney has misunderstood and mischaracterized the applicant’s identification of the goods and this misunderstanding and mischaracterization of the goods has been the basis and used by the Examiner when searching for and or citing prior similar uses of the mark and/or prior meanings of the mark and to support Examiner arguments for “merely descriptive”.

To further provide an understanding of the identification of the goods, for the benefit of the Appeal Judges, the proposed identification of the goods is parsed into its four different elements as follows:

(i) Computer software application for use in (ii) computing and communication devices (iii) that provides a hybrid interface by a user (iii) using a combination of both or either touch or voice commands for (iv) interacting with the functions of the device.

These four features of the identification of the goods as delineated above have been misunderstood by the Examining Attorney to argue merely descriptive in her refusals and appeal brief and to confuse them somehow to the mark itself or how others in the industry have used similar marks.

These features of the identification of the goods of the applicant's mark, as described above are unique and proprietary and are not commercially available.

Therefore, the applicant's identification of the goods is unlike other commercially available goods being used by others in the industry and therefore the identification is not merely descriptive of commercially available goods referred to as with words that may include MOBILE and or SEARCH.

Therefore Applicant respectfully submits that based on the foregoing analysis, the mark is not "merely descriptive" as the mark does not satisfy the legal standard of "merely descriptive".

Examiner has also objected to the proposed amendment of the identification of the goods at the late stage of request for consideration.

In reality, Examiner is not objecting to when the amendment was made but that the proposed amendment broadens the identification of the goods. Applicant submits the proposed amendment is made for clarifying the nature of the goods and not be confusing as it has been to the Examiner, by proposing deleting the word “search” as the goods are directed to human factors aspect of using a smart phone features and functions and not to conducting web-searches.

Applicant supplements the above arguments with the arguments in the Applicant’s Appeal Brief as reproduced below.

From the Applicant’s Appeal Brief:

There are two issues (1) whether the amended identification is within the scope of the original identification that was set forth in the application at the time of the filing and (2) whether this mark is “Merely Descriptive” under Section 2(e) (1) as the Examiner states in the Final Rejection.

Addressing the first issue of amended identification of the mark being outside of the scope of the original identification, Examining Attorney raises the objections (i) that prior identification used the phrase “smart phone” and the amended identification has used the phrase “computing and communication

devices” and (ii) that prior identification used the phrase “hybrid search interface using a combination of both or either touch or voice commands as decided by the user” and the amended identification has used the phrase “a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device”

Addressing the first of these identification of goods objections, Applicant submits that the amended identification is within the scope of the original identification because, the amended identification addresses the same aspect, computer software application for use in computing and communication devices whereas the original identification also addressed that same aspects of the goods, namely for computer software in smart phones.

First, it is common knowledge that smart phone is a slang use implying a computing and communication device. The amended identification merely provided a more English appropriate use of words that does not change the scope of the goods.

Second, a commonly understood meaning of word “smart phone” is a computer and communication device, and the amended identification provides for

accurate identification. For an objective person, “smart phone” is equivalent to a “computing and communication device”.

For the above stated reasons, the amended identification is no more broader than the original identification and is a more accurate identification to comply with the TMEP regulations.

Addressing the second of these identification of the goods objections, Applicant submits that the amended identification is within the scope of the original identification because, the amended identification addresses the same aspect, computer software application for use in computing and communication devices for a “hybrid user interface using both touch and voice”; whereas the original identification also addressed the same aspect of the goods, “namely computer software for a hybrid search interface using a combination of both or either touch or voice commands as decided by the user”.

Examiner states the original identification used the phrase “hybrid search interface” and the amended identification has used the phrase “hybrid interface” and therefore is broader than the original identification.

In modern computing and communication devices, a user interface with the device is principally in two different ways, by either touch interface by using a touch screen of the device or by voice interface by speaking to the device or by using one or the other of these interfaces, as decided by the user, for controlling the functions of the device.

The focus of the identification of the goods in the amended identification is “computer software for a hybrid interface using both touch and voice interfaces”. That focus of the goods in the amended identification is no more broader than the original identification, because the amended identification has merely provided a more appropriate purpose of the goods, that of user interface that does not change the scope of the goods that of user interface. For an objective person, the identification is used as a single identification entity for the identification and purpose of the goods that of user interface has not changed or is more broader than the original identification of the goods.

For the above stated reasons, the amended identification is no more broader than the original identification and is a more accurate identification to comply with the TMEP regulations.

Addressing the second issue is whether this mark is Merely Descriptive

under Section 2(e) (1) as the Examiner states in the Final Rejection.

The mark is MOBILE SEARCH and the identification of the goods/services is:

Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.

The issue is whether this mark is “Merely Descriptive” under Section 2(e) (1) as the Examiner states in the Final Rejection.

TMEP Section 1209 Refusal on Basis of Descriptiveness based on cited case law, the descriptiveness of the marks are defined on a continuum starting from (i) arbitrary, (ii) fanciful, (iii) suggestive, (iv) incongruent (v) merely descriptive, and (iv) generic, where arbitrary and generic are on the two ends of the spectrum. Each of these identifications on the continuum has been defined with the help of case law.

Further, **TMEP** based on case law states that the degree of distinctiveness on this continuum can be determined only by considering the mark in relation to the

specific goods or services. Applicant submits this determination would be judged on an objective standard and not a subjective standard.

TMEP also states that first four on this continuum (i) arbitrary, (ii) fanciful, (iii) suggestive, and (iv) incongruent may be registered while generic marks are banned from registration. The marks that are merely descriptive may be registered if they have acquired distinctiveness.

Applicant submits that the mark MOBILE SEARCH based on the identification of the good/services fits in the continuum in “suggestive” identification and not “merely descriptive”.

Applicant in addition and or in the alternative submits that the mark MOBILE SEARCH based on the identification of the good/services fits in the continuum in “incongruent” identification and not “merely descriptive”.

Applicant submits that the mark MOBILE SEARCH based on the identification of the good/services fits in the continuum in “suggestive” identification and not “merely descriptive”.

Based on a fair and equitable reading of the TMEP Section 1209 and its many cites, the mark is not “merely descriptive” because:

An objective person being exposed to the mark “MOBILE SEARCH” alone cannot come up with any sensible identification of the goods, as the goods have nothing to do with a search or a browse function as used in the Internet industry for data and web searches; and vice versa, an objective person reading the identification of the goods alone cannot come up with the mark. Thus the mark cannot be “merely descriptive” and

the mark is suggestive because: suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); the mark MOBILE SEARCH requires imagination, thought or perception to reach a conclusion as to the nature of the goods or services.

With this mark an objective person requires imagination, thought or perception as to the nature of the goods, which are a computer software for a specific application, identified as: *Computer software application for use in computing and communication devices that provides a hybrid interface by a user*

using a combination of both or either touch or voice commands for interacting with the functions of the device.

With due respect, this mark MOBILE SEARCH has no relationship to the identification of the goods. The identification of the goods is again reproduced here below:

Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.

The definitions for SEARCH as has been cited by the examiner have everything to do with computer applications generally called Internet Browser, as these definitions are directed to the act of browsing or searching, whereas in contrast, the identification of goods has nothing to do with either searching or browsing the Internet or Web but for a user interface that uses a hybrid user interface using both touch and voice to interface with the device. The mark therefore is suggestive and not merely descriptive.

Further, based on a fair and equitable reading of the TMEP Section 1209 and its many cites therein, the mark is not “merely descriptive” because:

An objective person being exposed to the mark “MOBILE SEARCH” alone cannot come up with any sensible identification of the goods, as the goods have nothing to do with a search or a browse function as used in the Internet industry for data and web searches; and vice versa, an objective person reading the identification of the goods alone cannot come up with the mark. Thus the mark cannot be “merely descriptive” and

the mark is incongruent because: the Board has described incongruity in a mark as “one of the accepted guideposts in the evolved set of legal principals for discriminating the suggestive from the descriptive mark.”

And has noted that the concept mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and “mental pause”.

The mark “MOBILE SEARCH” are word combinations whose import cannot be grasped without some measure of imagination and mental pause. Each of the words in the mark MOBILE and SEARCH individually is a common English language word and thus an incongruent combination of them cannot be merely descriptive.

The combination of the words is incongruent because MOBILE is a quality of being mobile or in motion or being capable of motion and SEARCH is a quality of searching and also browsing for information, the combination of these specific words is incongruent. Further the identification of the goods is:

Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.

The identification of the goods refers to something entirely different that has nothing to do with either mobility and or searching; and thus a combination of these words MOBILE and SEARCH is incongruent.

Applicant respectfully submits that the mark is not merely descriptive but suggestive for the following reasons. First, the words MOBILE and SEARCH are incongruous terms as these two terms are not commonly used in combination. Second the mark does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services.

Based on the applicable law and regulations above, Applicant argues the applicant's mark for the identified good/services is suggestive and the mark is also incongruent and thus also suggestive.

The identification of goods defines the goods in question as: Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.

With due respect, with these identification of the goods, the mark cannot be construed as “merely descriptive as the mark does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services and therefore is not merely descriptive.

Therefore Applicant respectfully submits that based on the foregoing analysis, the mark is not “merely descriptive” as the mark does not satisfy the legal standard of “merely descriptive”.

Signed/Date: 06/09/2014

//Tara Chand//

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