

From: Aikens, Ron

Sent: 5/23/2014 8:15:22 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85747739 - MOBILE SEARCH - N/A - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 85747739.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85747739

**MARK:** MOBILE SEARCH



**CORRESPONDENT ADDRESS:**

TARA CHAND PRESIDENT

INTERNET PROMISE GROUP LLC

2390 CRENSHAW BLVD SUITE 239

TORRANCE, CA 90501-3300

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Internet Promise Group LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

chand@InternetPromise.com

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant has appealed the trademark Examining Attorney's final refusal to register the mark MOBILE SEARCH for "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. Registration was refused on the Principal Register because the asserted mark, when used in connection with the goods at issue, primarily merely describes a significant function, feature, purpose or use of the specified goods. In addition, the Examining Attorney denied an amendment to the identification of goods that was submitted by the Applicant at the Request for Reconsideration stage of prosecution for being beyond the scope of the identification currently of record. The identification was refused for being an impermissible request at the “Reconsideration” stage of prosecution. For the reasons and authorities cited below, it is requested that the denial of the “Reconsideration” stage proposed amendment and the refusal to register be affirmed.

### **FACTS AND PROCEEDINGS**

On October 7, 2012, Applicant Internet Promise Group LLC filed an Intent to Use-based application seeking registration on the Principal Register for the mark MOBILE SEARCH in typed form for use in connection with “a search interface function using a hybrid touch and voice interface for mobile wireless devices for searching content in the device, prior query databases and the global computer network,” in International Class 35.

On December 8, 2012, the Examining Attorney issued an Office action: (1) refusing registration because the activities recited were not recognized as a service; (2) advising the Applicant as to the attendant requirements in seeking reclassification for goods falling within the scope of International Class 9; (3) refusing registration on the Principal Register of the Applicant’s mark pursuant to Section 2(e)(1) of the Trademark Act; and, (4) requiring a redrafting of the entire identification.

On June 1, 2013, the Applicant filed a Response to Office action amending the identification of goods to, “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,” and presenting arguments in favor of registration on the Principal Register.

On June 29, 2013, the Examining Attorney issued an Office action, noting the Office’s acceptance of the proposed amendment to the identification and making Final the refusal to register the asserted mark on the Principal Register for being primarily merely descriptive, pursuant to Section 2(e)(1) of the Trademark Act.

On December 26, 2013, the Applicant filed a Notice of Appeal in conjunction with a Request for Reconsideration which addressed the 2(e)(1), primarily merely descriptive refusal. In addition, the Applicant proposed a voluntary amendment to the identification of goods, requesting that the identification read, “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.”

On January 27, 2014, the Examining Attorney denied the Request for Reconsideration, simultaneously rejecting the proposed amendment to the identification as not being permissible at the Reconsideration phase of prosecution. The file was remanded to the TTAB for a continuation of the appeal proceedings.

## ISSUES ON APPEAL

Whether the asserted mark “MOBILE SEARCH,” defined as a “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)(1) of the Trademark Act.

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 Examining Attorney, and therefore constitutes an amendment not permitted at the “Request for Reconsideration” stage of application prosecution.

## ARGUMENT

### **I. The Plain Meaning Of The Term “MOBILE SEARCH” Describes The Features, Functions, Use And Purpose Of The “Search Interface Software” For Which Protection Is Sought.**

The Applicant seeks registration of the mark MOBILE SEARCH for use in connection with “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. The examining attorney contends that the asserted mark “MOBILE SEARCH” immediately conveys the purpose of the search interface software to be used on “smart phones,” which are also known as “mobile devices”: that the associated “search interface” software will be used to conduct a search for information in a mobile manner. It matters not whether the word “search” refers to a function regarding “the Internet” or the actual device upon

which the software resides. Likewise, it matters not whether the word “mobile” refers to the nature of the device upon which the software resides or the portability of the function. Both interpretations are contemplated by the plain meanings of the words comprising the asserted mark, and both interpretations are features contemplated by the search interface software at issue. In other words, the asserted mark primarily merely describes a significant characteristic and feature, as well as the function and purpose of the relevant goods, and the asserted mark, therefore, is not registrable on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act.

Section 2(e)(1) of the Trademark Act provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on account of its nature unless it-

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an Applicant’s goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, \_\_\_ F.3d \_\_\_, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (*citing Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an Applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, \_\_\_ F.3d \_\_\_, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

The Court's decision in *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 216 (CCPA 1978), in affirming the board's finding that the mark was merely descriptive, the Court quoted the following language from the board's opinion:

Whether or not a term is merely descriptive in a trademark sense must necessarily be considered in relation to the specific goods for which registration is sought, the context of which is used on labels, packages, or advertising materials directed to these goods, *the possible significance of the term in relation to the goods, and the likely reaction thereto of the average purchaser as he encounters the goods in the marketplace.* (Emphasis added).

In other words, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Furthermore, the fact that a term may have different meanings in other contexts is

not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

The two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

In consideration thereof, the Examining Attorney made of record the following definitions of terms relevant to the prosecution of the trademark application:

Definition No. 1: Smart Phone – A smartphone, or smart phone, is a mobile phone built on a mobile operating system, with more advanced computing capability and connectivity

than a feature phone. ([http://en.wikipedia.org/wiki/Smart\\_Phone](http://en.wikipedia.org/wiki/Smart_Phone), last visited May 1, 2014; *see* Final Offc. Act'n. 6/29/2013)

Definition No. 2: Mobile Operating System – A mobile operating system, also referred to as mobile OS, is the operating system that operates a smartphone, tablet, PDA, or other digital mobile devices. Modern mobile operating systems combine the features of a personal computer operating system with a touchscreen, cellular, Bluetooth, WiFi, GPS mobile navigation, camera, video camera, speech recognition, voice recorder, music player, Near field communication, Infrared Blaster, and other features.

([http://en.wikipedia.org/wiki/Mobile\\_operating\\_system](http://en.wikipedia.org/wiki/Mobile_operating_system), last visited May 1, 2014; *see* Final Offc. Act'n. 6/29/2013)

Definition No. 3: MOBILE – Remote, portable, on-the-go. A "mobile" is a cellphone; however, a "mobile device" can refer to any portable device including a phone, PDA, digital music player, tablet computer, netbook or laptop.

(<http://encyclopedia2.thefreedictionary.com/mobile>, last visited May 1, 2014; *see* Offc. Act'n. 12/8/2012)

Definition No. 4: SEARCH – To look for specific data in a file or an occurrence of text in a file. A search implies either scanning content sequentially or using algorithms to compare multiple indexes to find a match. A search on the Web yields a list of Web pages that contain all the words in the search criteria (see SERP).

(<http://encyclopedia2.thefreedictionary.com/search>, last visited May 1, 2014; *see* Offc. Act'n. 12/8/2012)

Definition No. 5: MOBILE SEARCH – Mobile search is an evolving branch of information retrieval services that is centered on the convergence of mobile platforms and mobile phones, or that it can be used to tell information about something and other mobile devices. Web search engine ability in a mobile form allows users to find mobile content on websites which are available to mobile devices on mobile networks.

([http://en.wikipedia.org/wiki/Mobile\\_search](http://en.wikipedia.org/wiki/Mobile_search), last visited May 1, 2014; see Final Offc. Act'n. 6/29/2013)

Further, in the 6/29/2013 Final Office Action, the Examining Attorney made of record an article from "eMarketer" that contained the following statements, in relevant part:

Competition for the US mobile search market promises to be fierce, thanks to the large US online ad market and strong pushes by portals. eMarketer projects that by 2011, mobile search will account for around \$715 million, or almost 15% of a total mobile advertising market worth nearly \$4.7 billion. SHARE SHARE THIS 0000 Granted, a \$715 million mobile search market is not a foregone conclusion, but many of the behavioral factors are in place in the US market to push mobile search forward. For one, there is already a strong correlation between mobile Internet use and accessing mobile search services. In April 2007, iCrossing reported that three-quarters of mobile Internet subscribers access mobile search services. This is in contrast to the little more than 20% of general mobile phone users in the US who access mobile search. The US mobile search market can be expected to suffer some growing pains over the next two to three years as the tug of war between the major operators, the major portal players, major media and a gaggle of mobile search start-ups compete for the title of mobile search leader.

(<http://www.emarketer.com/Article/Mobile-Search-US/1005170>, last visited May 1, 2014)

The Trademark Trial and Appeal Board has held that printouts obtained through global computerized networks are admissible under Rule 2.122(e). *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998).

In light of the plain meanings of the words comprising the asserted mark "MOBILE SEARCH," and the definition of the term "mobile search" as a whole, the Examining Attorney

refused registration of the asserted mark in the initial Office action for being primarily merely descriptive, arguing that the Applicant had essentially sought registration of “MOBILE SEARCH for mobile device search interfaces.” (See Initial Office action.) After Applicant amended the identification, the Examining Attorney made Final the refusal to register the asserted mark for being primarily merely descriptive, asserting that the Applicant sought registration of “MOBILE SEARCH for mobile searching software that is likely a part of a mobile operating system for use on smart phones.”

In response to the refusals, Applicant argued that:

The word “mobile” by itself does not characterize applicant’s goods as the word “mobile” customary usage is generally applicable to items that are mobile or can be moved, and not necessarily to mobile phones. For example word mobile is applicable to auto mobiles among many other items or things.

The Applicant continued the argument, contending that:

The word “search” by itself also does not characterize the applicant’s goods as the word search by itself is generic and does not imply a search in and or using a mobile device.

Furthermore, as part of the Request for Reconsideration and in response to the Final Refusal, the Applicant stated that:

With due respect, with the amended 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.

The Applicant has not made clear why the Office should not consider the term “mobile” descriptive of the mobile devices on which the goods are to be used, or not consider the term “search” descriptive of its software that is for use in permitting “a hybrid search interface.” It is unclear why the Applicant argues that “the word search by itself is generic and does not imply a search in or using a mobile device.” This statement alone evidences the descriptive nature of the asserted mark. The Applicant’s argument is especially unclear in that “mobile search” has been shown to refer to a “[w]eb search engine ability in a mobile form allows users to find mobile content on websites which are available to mobile devices on mobile networks.” The definition of “mobile search” as a unitary phrase makes clear that the term refers to the functions of the software for which protection is sought herein, namely, search interface software. The Examining Attorney contends that the Applicant’s various arguments ignore the Applicant’s own use of the term “search” to describe search interface software at issue.

At each stage of the application’s prosecution, the Applicant has failed to submit evidence or case law references to support its contention that the words comprising the mark are not descriptive in the context of the goods for which it seeks protection. Further, the Applicant has failed to challenge the validity of the definitions made of record or present a reasonable explanation for why such definitions do not establish that the asserted mark is primarily merely descriptive. Instead, the Applicant has only offered anecdotal explanations of the term, such as referring to the term “smart phone” as “slang.”

The Examining Attorney does note that on Appeal the Applicant presents a new argument in support of registration, contending that “MOBILE SEARCH” comprises

“incongruous” wording and therefore cannot be held primarily merely descriptive. The Applicant states that:

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.

(App. Br. at p. 21)

The Board had made clear that a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); TMEP Section 1209.03(d). However, the Board also has held that when there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce, and render more efficient wide area network usage).

Here, the record reflects that the composite mark is in common use, forming a unitary term that describes software similar to that sought for protection by the Applicant. More

importantly, the Applicant has not made clear how the components are incongruous as applied to the goods. Despite the evidence of record establishing that the terms, both individually and as a single phrase, have specific definitions that are descriptive in the context of the goods, the Applicant argues that:

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 ... With due respect, this mark MOBILE SEARCH has no relationship to the identification of goods.

(App. Br. at pgs. 18, 19)

It seems that the Applicant’s premise is that it no longer wishes to seek protection for software that was originally described as having a “search interface function” for use on “mobile wireless devices for searching content,” or seek protection for the amended “computer software in smart phones” featuring a “hybrid search interface.” Instead, Applicant now seeks protection for a “computer software application for use in computing and communication devices” that simply features a “hybrid interface” so the user may interact with other features of the device. And because its third iteration of the function of the software no longer refers to “searching” features and functions, and because the identification references use with any type of “wireless device,” whether or not a “smart phone,” the Applicant seems to argue that the asserted mark “MOBILE SEARCH” can no longer describe either the type of goods being sought for protection or their intended use.

If this is an accurate assessment of the Applicant's position, then the problems with the Applicant's argument on Appeal are threefold: first, the Applicant's third proposed amendment submitted at the Request for Reconsideration phase of prosecution is not permitted (see below); second, the definitions of "mobile search" that have been made of record contemplate the "user interface" feature as being a general feature of "mobile search" type software, and so the mark remains primarily merely descriptive of a function or feature of the goods for which protection is sought; and third, because there is verifiable and relevant evidence establishing the primarily merely descriptive nature of the mark components as well as the mark as a whole in the context of computer software, claiming that the "mark MOBILE SEARCH has no relationship to the identification of goods" effectively makes the mark primarily merely deceptively misdescriptive, and the mark would therefore be unregistrable. *See* TMEP §1203.02(b) *et seq.* However, the record makes clear that the asserted mark "MOBILE SEARCH" does indeed have a relationship to the goods for which protection is sought, and the "deceptively misdescriptive" issue is not being raised herein.

The plain meanings of the individual words comprising the asserted mark, the plain meaning of the asserted mark as a whole, as well as the Applicant's identification of goods, and the Applicant's anecdotal explanations of the meaning of the asserted mark make clear that in the context of the computer software goods for which protection is sought, software that was twice referred to as having a "search" function, the asserted trademark is primarily merely descriptive of a significant characteristic and feature, as well as the function and purpose, of the goods for which protection is sought, namely, that the search interface software associated with the

asserted mark “MOBILE SEARCH” will be used to conduct a search for information in a mobile manner.

Moreover, in light of what has been described as “the evolving mobile search industry,” the average purchaser of Applicant’s computer software will understand the plain meaning, descriptive significance of the asserted mark “MOBILE SEARCH” in relation to the goods at issue. Further, the descriptive significance of each word comprising the asserted mark “MOBILE SEARCH” will be retained even if the Applicant seeks protection of goods utilizing only a single feature of what is considered a “mobile search” type software function. Allowing the Applicant to register the asserted mark would prevent others from entering into and already within the “mobile search industry” from seeking protection for mobile search software or even describing their goods as being “mobile search” software.

For the reasons and authorities cited above, it is requested that the refusal to register pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), be affirmed.

**II. Amendments To Definite Identifications Already Of Record Are Not Permitted At The Request For Reconsideration Phase And Therefore The Refusal Of Such Does Not Raise A New Issue Upon Which Relief May Be Based.**

The Applicant made the following identification of goods of record in the initial application for registration: “a search interface function using a hybrid touch and voice interface for mobile wireless devices for searching content in the device, prior query databases and the global computer network.” The identification was refused because the activities recited in the identification of services are not registrable services as contemplated by the Trademark Act.

Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; see TMEP §§1301.01 et seq. The Applicant was advised that if it sought to reclassify the identification to fall within the scope of Class 9, registration could be refused because the goods to which the proposed mark is applied are not “goods in trade.” Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; TMEP §1202.06(b). It was specifically noted that the refusal applied to “search interface function,” as a “function” is not itself a good in trade but instead, a “function” is a feature or characteristic of a good in trade and therefore “function” merely refers to how the larger goods work. Finally, the Applicant was directed to rewrite the identification of services in its entirety because of the nature and extent of the amendment. 37 C.F.R. §2.74(a). Via highlighted text, the Examining Attorney noted that an Applicant may amend an identification of services only to clarify or limit the services (goods); adding to or broadening the scope of the services (goods) is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 et seq., 1402.07 et seq.

In response, the Applicant proposed an amended identification of goods, which reads as follows:

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

The proposed amendment was accepted, and no further requirements or requests pertaining to the identification of goods were included as an issue in the Final Office action.

Instead of filing a response to the Final Office action, the Applicant filed a notice of Appeal and a Request for Reconsideration. However, in addition to addressing the outstanding

issue of descriptiveness, the Applicant filed the following voluntary amendment to the identification of goods:

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 proposed amendment was found unacceptable as being beyond the scope of the identification of record, and therefore, not an amendment that is permitted at the Request for Reconsideration stage of application prosecution.

**A. Amendments to the identification that would add to or expand the scope of an already acceptable identification are not permitted at the Request for Reconsideration phase of application prosecution.**

The TMEP makes clear that once an Applicant amends the identification of goods and/or services in a manner that is acceptable to the Examining Attorney, the amendment replaces all previous identifications and restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (*Comm'r Pats.* 1991); TMEP § 1402.07(e). This includes amendments to the identification submitted in an amendment to allege use, a statement of use, or a request for an extension of time to file a statement of use. 37 C.F.R. §§2.88(i)(2) and 2.89(f). The Examining Attorney contends that the list of impermissible submissions of amendments referenced in Section 1402.07(e) tacitly includes amendments to identifications that are submitted in Requests for Reconsideration. *See also*, TMEP § 1402.06(a).

The Examining Attorney notes that as of the issuance of the Final Office action, the identification of goods was acceptable and amendments thereto could only be made to narrow the scope of the goods for which protection is sought, or to clarify indefinite references. Scope is generally determined by the ordinary meaning of the wording in the identification. TMEP §1402.07(a). Here, the proposed amendment sought to broaden the protection from “computer software in smart phones” to “computer software application for use in computing and communication devices,” effectively broadening protection from “smart phones” to personal computers, personal digital assistants, e-book readers, tablet PCs, laptops, pagers, various GPS devices and more. Further, the amendment sought to broaden the function by amending from “a hybrid search interface” to “a hybrid interface,” essentially stating that the software functions in more than a “search” capacity. Thus, the identification, incorporating the wording portion of the proposed amendment comprising “computer software application for use in computing and communication devices,” and “a hybrid interface,” therefore is not acceptable. *See* 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01.

In other words, the proposed amendment to the identification was found unacceptable because it exceeded the scope of the identification in the U.S. application, as amended on June 1, 2013. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07. The original identification in the U.S. application, and any previously accepted amendments, remain operative for purposes of future amendment. *See* 37 C.F.R. §2.71(a); TMEP §1402.07(d). As such, entering into the Request for Reconsideration phase of prosecution, the June 1, 2013 identification was operative. The Applicant’s proposed amendment submitted at the Request for Reconsideration phase of

prosecution, which would effectively add to or expand the scope of the recited goods or services in operation, should not be permitted.

For the reasons cited above pursuant to TMEP § 1402.07(e), the Examining Attorney contends that the decision not to accept the proposed amendment to the identification as submitted within the Request for Reconsideration be affirmed.

**B. Even if the Board finds the amendment to be within the scope of the identification made of record, analysis of the descriptiveness of the asserted mark in relation to the identification does not change.**

Assuming *arguendo* that the Board finds the Applicant's proposed amendment permissible at the Request for Reconsideration phase of prosecution because it references goods falling within the scope of the identification proposed by the Applicant on June 1, 2013 and subsequently made of record, the Examining Attorney contends that there will be no change in the analysis of the descriptiveness of the asserted mark.

The identification submitted in the July 1, 2013 response to the initial Office action is necessarily considered "definite," for the purposes of arguments herein. The Examining Attorney made clear that the Applicant could amend an identification of goods only to clarify or limit the goods of record. Indeed, the Applicant is arguing that its amendment proposed in the Request for Reconsideration did not exceed the scope of its proposed amendment of June 1, 2013. In other words, the Applicant is arguing that the proposed amendment at issue merely constitutes a narrower or clearer version of the identification of record. The Examining Attorney contends that the identification of record is not indefinite or otherwise unclear. Therefore, the proposed

amendment at issue could only be a narrower version of the identification of record. The proposed amendment at issue, to be acceptable, would necessarily reference a lesser included or subset function of the goods as contemplated by the identification of currently record.

A lesser included or subset function of the software at issue is still a function of the software at issue. That is, if the asserted mark is primarily merely descriptive of the goods as indicated in the identification of record, then the asserted mark also is necessarily primarily merely descriptive of any lesser included or subset functions of those goods.

So, while the Examining Attorney contends that the proposed amendment to the identification of goods is not permissible at the Request for Reconsideration phase of prosecution for exceeding the scope of the already acceptable identification of record, finding that the proposed amendment is “permissible” necessarily means that the proposed amendment refers to a function contemplated by the identification of record, and that acceptance of the Applicant’s proposed amendment to the identification should not affect the Board’s analysis of the 2(e)(1), primarily merely descriptive refusal in that the asserted mark will nevertheless continue to describe the goods at issue.

## **CONCLUSION**

For the foregoing reasons and authorities, the Examining Attorney submits that the refusal to register Applicant's mark on the basis that the mark is merely descriptive of the recited goods, and that the Applicant's proposed amendment to the operative identification during the Request for Reconsideration phase is not permitted should be affirmed.

Respectfully submitted,

/Ronald E. Aikens/

Examining Attorney

US Patent & Trademark Office

Law Office 112

571-272-9268

Ron.Aikens@USPTO.gov

Angela Wilson, Esq.  
Managing Attorney  
Law Office 112  
(571) 272-9443

