From: Milton, Priscilla

Sent: 4/27/2015 2:15:20 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85757665 - BOTVAC - 13861/65 - EXAMINER BRIEF

****

Attachment Information:

Count: 1

Files: 85757665.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

Applicant: Neato Robotics, Inc.

MARKS: NEATO BOTVAC, NEATO

BOTVAC, BOTVAC and BOTVAC

U.S. APPLICATION SERIAL NOS.

85751529

85751546

85757665

85757674

CORRESPONDENT ADDRESS:

MICHELLE MANCINO MARSH

KENYON & KENYON LLP

1 BROADWAY

NEW YORK, NY 10004-1007

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

CORRESPONDENT'S REFERENCE/DOCKET NO:

13861/65, 13861/65 and 13861/68

CORRESPONDENT E-MAIL ADDRESS:

tmdocketny@kenyon.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Neato Robotics, Inc., a corporation (hereinafter referred to as "applicant") has appealed the trademark examining attorney's final requirement that the merely descriptive wording BOTVAC be disclaimed apart from the mark as shown, pursuant to Trademark Act Section 2(e) (1), 15 U.S.C. §1052(e) (1) and Trademark Act Section 6, 15 U.S.C. §1056(a). The examining attorney required a disclaimer of the wording BOTVAC in application Serial No. 85751529 for the mark NEATO BOTVAC and in Serial No. 85751546 for the mark NEATO BOTVAC.

Applicant has also appealed the examining attorney's final refusal to register the mark BOTVAC in Serial No. 85757665 and BOTVAC in Serial No. 85757674 based upon Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a).

FACTS

On October 11, 2012, applicant filed Application Serial No. 85751529 for the standard character mark NEATO BOTVAC for "vacuum cleaners, robotic vacuum cleaners and parts thereof." Applicant alleged a bona fide intent to use the mark for the identified goods in interstate commerce. In the first Office action mailed February 13, 2013, the examining attorney required a disclaimer of the wording BOTVAC and requested a claim of ownership of two prior U.S. Registrations. On August 13, 2013, applicant responded to the first Office action. The applicant submitted arguments and evidence in support of registration without a disclaimer. However, the applicant did not submit a claim of ownership of the prior U.S. Registrations. On September 13, 2013, the examining attorney issued a final Office action for the requirement of a disclaimer of BOTVAC and a claim of ownership of the prior U.S. Registrations. On September13, 2013, the examining attorney also issued a subsequent final Office action, continuing the final disclaimer requirement but advising applicant of the correct spelling of the intentionally misspelled wording BOTVAC for the disclaimer. The correct spelling for the disclaimer is BOT VAC. On March 4, 2014, the applicant filed a Notice of Appeal. The applicant also requested reconsideration and submitted the claim of ownership of the prior U.S. Registrations. On March 26, 2014, the examining attorney refused the request for reconsideration and adhered to the final Office action as it relates to the disclaimer requirement. The claim of ownership of the prior U.S. Registrations have been made of

record and will be printed on any registration that may issue from this application. On February 27, 2015, applicant filed its appeal brief.

On October 11, 2012, applicant filed Application Serial No. 85751546 for the standard character mark NEATO BOTVAC for "robotic appliances for household purposes and maintenance and parts thereof, namely, robotic vacuum cleaners and parts thereof." Applicant alleged a bona fide intent to use the mark for the identified goods in interstate commerce. In the first Office action mailed February 13, 2013, the examining attorney required an amendment to the identification of goods because it was indefinite and too broad and could include goods in more than one class. The examining attorney provided suggested amendments to the identification and classification and provided applicant with the requirements for a multiple-class application. Additionally, the examining attorney required a disclaimer of the wording BOTVAC and requested a claim of ownership of two prior U.S. Registrations. On August 13, 2013, applicant responded to the first Office action. The applicant submitted arguments and evidence in support of registration without a disclaimer and a proposed amendment to the identification of goods. The examining attorney accepted the amendment to the identification of goods. However, the applicant did not submit a claim of ownership of two prior U.S. Registrations. On September 13, 2013, the examining attorney issued a final Office action for the requirement of a disclaimer of BOTVAC and a claim of ownership of the prior U.S. Registrations. On September 13, 2013, the examining attorney also issued a subsequent final Office action, continuing the final disclaimer requirement but advising applicant of the correct spelling of the intentionally misspelled wording BOTVAC for the disclaimer. The correct spelling for the disclaimer is BOT VAC. On March 4, 2014, the applicant filed a Notice of Appeal. The applicant also requested reconsideration and submitted the claim of ownership of the prior U.S. Registrations. On March 26, 2014, the examining attorney refused the request for reconsideration and adhered to the final Office action as it relates to the disclaimer requirement. The claim of ownership of the prior U.S. Registrations have been made of record and will be printed on any registration that may issue from this application. On February 27, 2015, applicant filed its appeal brief.

On October 12, 2012, applicant filed Application Serial No. 85757665 for the standard character mark BOTVAC for "vacuum cleaners, robotic vacuum cleaners and parts thereof." Applicant alleged a bona fide intent to use the mark for the identified goods in interstate commerce. In the first Office action mailed February 13, 2013, the examining attorney refused registration under Trademark Act Section 2 (e) (1). On August 13, applicant responded to the first Office action. Applicant made arguments in support of registration, submitted dictionary evidence and third party registration to support applicant's conclusion that the mark is suggestive. On September 13, 2013, the examining attorney finally refused the mark under Trademark Act Section 2(e) (1). On March 4, 2014, the applicant filed a Notice of Appeal. On February 27, 2015, applicant filed its appeal brief.

On October 18, 2012, applicant filed Application Serial No. 85757674 for the standard character mark BOTVAC for "robotic appliances for household purposes and maintenance and parts thereof, namely, robotic vacuum cleaners and parts thereof." Applicant alleged a bona fide intent to use the mark for the identified goods in interstate commerce. In the first Office action mailed February 13, 2013, the examining attorney refused registration under Trademark Act Section 2 (e)(1) and required an amendment to the identification of goods because it was indefinite and too broad and could include goods in more than one class. The examining attorney provided suggested amendments to the identification and classification and provided applicant with the requirements for a multiple-class application. On August 13, 2013, applicant responded to the first Office action. Applicant made arguments in support of registration, submitted dictionary evidence and third party registration to support applicant's conclusion that the mark is suggestive. Additionally, applicant submitted an amendment to the identification of goods. On September 13, 2013, the examining attorney accepted the proposed amendment to the identification of goods and finally refused the mark under Trademark Act Section 2(e) (1). On March 4, 2014, the applicant filed a Notice of Appeal. On February 27, 2015, applicant filed its appeal brief.

On March 25, 2015 the examining attorney filed a motion to consolidate the appeals in Application Serial Nos. 85751529, 85751546, 85757665 and 85757674. In light of the similarity of records and issues in these cases, the motion was granted.

Thus, the only issue on appeal, in Application Serial Nos. 85751529, 85751546, 85757665 and 85757674, is whether the designation BOTVAC when applied to applicant's goods is merely descriptive.

ARGUMENT

THE DESIGNATION BOTVAC IS MERELY DESCRIPTIVE OF THE GOODS.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g.*, *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 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 and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 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 examining attorney maintains that the proposed mark BOTVAC used in connection with applicant's "…robotic vacuum cleaners and parts thereof," and "vacuum cleaners" merely describes a feature

and/or characteristic, of applicant's goods. Trademark Act Section 2(e) (1), 15 U.S.C. §1052(e) (1); *see* TMEP §§1209.01(b), 1209.03 *et seq.* The terms "bot," "robot" "robotic" and "vac" are defined in relevant part as follows.

Bot

Abbreviation for robot [1]

Robot

A machine or device that operates automatically or by remote control.

OTHER FORMS:
ro·botic*(Adjective)*[2]

Vac

Informal for vacuum cleaner [3]

In the present case, applicant has combined two highly descriptive and/or generic designations for applicant's goods. Bot, an abbreviation for robot merely indicates that the product features robotic technology. The term vac is informal for vacuum cleaner and applicant's goods are vacuum cleaners. The wording BOTVAC merely describes a feature and /or characteristic of applicant's goods, specifically, robotic vacuum cleaners, robot vacuum cleaners and/or vacuum cleaners featuring robotic technology.

---

[1] See http://www.abbreviations.com/serp.php?st=bot. See attachment to the Office action mailed 2/13/13.

[2] See http://education.yahoo.com/reference/dictionary/entry/robot; http://websters.yourdictionary.com/robotic. See attachments to the Office action mailed 2/13/13.

[3] See http://education.yahoo.com/reference/dictionary/entry/vacSee attachment to the Office action mailed 2/13/13.

The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to "robot" and to "bot," used in connection with vacuum cleaners and other robotic appliances appeared in several stories. This evidence demonstrates that consumers are familiar with the terms "bot" and "robots" used in connection with robot vacuum cleaners and other goods featuring robotic technology. [4] See attachments and excerpts below, especially those referencing applicant, Neato Robotics or "Neato."

SUCK IT UP! NEATO IS READY TO KICK ROBOT VACUUM BUTT

Neato has a bot that sees better, works smarter, and sucks harder…and that's a good thing. After talking with VP Patrick De Neale, I can tell you that Neato isn't just building the next great **robotic vacuum**, it's building the next great robotic empire with more than $15 million in funding and retailers lined up to get the vacuum to market. Don't fret robo-junkies, we've got some great videos and pics to sate your hunger for machine machinations after the break. See.[5]

iRobot Roomba Vacuum Cleaning

You can get a wide range of types of **bot** there is extensive sought. Coupled with it has the extensive to line of robotics, **a bot vacuum cleaners** can come in close proximity to care as long as mobility out of mind-numbing deliver the results can be involved.[6]

Neato Robotics showed off its XV-11 **vacuum bot** after launching it last year. The company says its $399 droid has a more powerful vacuum than Roomba. It has a rotating laser scanner that maps rooms while working, minimizing cleaning time.[7]

---

[4] See attachments to the Office action mailed 9/14/13.

[5] http://singularityhub.com/2010/02/09/suck-it-up-neato-is-ready-to-kick-robot-vacuum-butt/. See attachments to the Office action mailed 9/14/13.

[6] See http://www.google.com/#q=%22bot+vacuum+cleaners%22. See attachments to the Office action mailed 9/14/13.

Neato XV-25 Features

Love or hate the look of the Neato XV-25, however, what has come to define **Neato's** robot vacuums (and redefine them in the sector) is how they go about their business. Neato was only formed back in 2009 and didn't release its first product until 2010, but what got investors hot under the collar was the SLAM (Simultaneous Localization and Mapping) technology at their heart. Unlike so-called **'bump bots'** which seem to take an almost random approach to cleaning, SLAM robot vacuums calculate their every move. [8]

THE NEW ROBOT VACUUMS FROM NEATO ARE SHIPPING JULY 15

Neato's XV-11 **is the new and upcoming robot vacuum**. It does what others can't – clean a room without randomly bumping around. **The bot** uses advanced mapping software and a killer laser range to find its way through a room with a single pass. Back when we visited Neato Robotics in Febuary, the XV-11 was slated for release by the end of the first quarter of 2010... I talked to VP Patrick De Neale to get the inside scoop on what caused the hold up, and to find out when we'll see the XV-11 in our homes. Worry not **bot-junkies**, the next generation of **vacuum bots** is making its way stateside as we speak, and if you've pre-ordered your robot online, yours will be in the mail starting July 15. New sales (still $399) will launch in August. [9]

Household Robots

---

[7] See http://www.google.com/search?as_q=%22bot+vac%22&num=10&as_epq=&as_oq=dictionary+glossary+words+terms+lexicon&as_eq=&lr=lang_en&as_occt=any&as_dt=i&as_sitesearch=&safe=off. See attachments to the Office action mailed 9/14/13.

[8] See http://www.trustedreviews.com/neato-xv-25_Vacuum-Cleaner_review. See attachment.

[9] See http://singularityhub.com/2010/06/29/the-new-robot-vacuums-from-neato-are-shipping-july-15/. See attachments to the Office action mailed 9/14/13.

Science fiction writers have long envisioned a future where scurrying, insect-like surveillance robots hide in the shadows and stream pictures and videos to far-away computer networks. Little could they have imagined that when those spybots became a reality, we would invite them into our homes.

Earlier this month, Hong Kong-based robotics company WowWee began selling Rovio, a $300 black, three-wheeled surveillance robot equipped with a webcam, speakers and a microphone. **Connect the bot** to your home wi-fi network and you can control it through a Web browser from anywhere in the world. [10]

5 Household Robots That Make Your Life Easier

Windoro WCR-1001

Attached to your windows by four large magnets. Windoro cleans windows small to large with adjustable magnets, you can fit the window cleaner **bot** to single or double pane windows.[11]

Plant **bot:** The world's first robot that can turn your household plants into light-seeking 'triffid' drones

The world's first robot that can carry plants around a room making sure they stay in sunlight all day has been developed by a team of researchers from Rutgers University.[12]

Dawn of the **bot**? New era nears, experts say

---

[10] See http://www.forbes.com/fdc/welcome_mjx.shtml. See attachments to the Office action mailed 9/14/13.

[11] http://mashable.com/2012/09/27/household-robots/ See attachment to the Office action mailed 9/14/13.

[12] See https://www.google.com/#q=household+robots+%26+bot. See attachment.

> Science fiction is quickly taking a back seat to science fact. Just look at a new report by the country's leading roboticists. By 2030, it says, robots will be everywhere.[13]

> **Bots** behind the wheel: Ford turns to high-tech robots for track testing duties
>
> The technology, being used at Ford's Michigan Proving Grounds in Romeo, Mich., features a robotic control module installed in a test vehicle that controls vehicle steering, acceleration and braking , according to a Ford …[14]

Applicant criticizes the evidence of record, stating as follows: "… the examining attorney has failed to provide any evidence regarding consumer understanding and recognition of applicant's applied-for mark." However, contrary to applicant's belief, the dictionary evidence and Internet evidence, made of record, by the examining attorney, clearly demonstrates that the designation "bot" is understood to mean "robot" when used in connection with robotic appliances, including, robot vacuum cleaners. More importantly, references to the wording "bots" in online advertising material and news articles, related to applicant's robot vacuum cleaners, support the conclusion that the mark in its entirety is merely descriptive. Material obtained from the Internet is generally accepted as competent evidence. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness). TBMP §1208.03; TMEP §710.01(b).

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not

[13] See https://www.google.com/#q=bot+%26+robotic+technology. See attachment

[14] See https://www.google.com/#q=bot+%26+robotic+technology. See attachment

registrable. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) (holding AGENTBEANS merely descriptive of "computer software for use in the development and deployment of application programs on a global computer network"). Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods, specifically, robotic vacuum cleaners, robot vacuum cleaners and/or vacuum cleaners that feature robotic technology.

Applicant argues that BOTVAC for "robotic appliances for household purposes and maintenance and parts thereof, namely, robotic vacuum cleaners and parts thereof" and "vacuum cleaners" is either fanciful, arbitrary or suggestive. The examining attorney respectfully disagrees. Applicant's contention that the designation BOTVAC is fanciful because it comprises a term that has been invented for the sole purpose of functioning as a trademark is unpersuasive. To support the contention that the mark is fanciful, applicant points to the fact that the dictionary evidence made of record does not proffer a single definition for "botvac." While this is true, the fact that a term is not found in a dictionary is not controlling on the question of registrability if the evidence of record shows that the term has a well understood and recognized meaning. See *In re Gould Paper Corp*., 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987) (SCREENWIPE held) generic as applied to pre-moistened antistatic cloths for

cleaning computer and television screens). Fanciful marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, EXXON) or are completely out of common usage (e.g., FLIVVER). See TMEP § 1209.01(a). In the present case, applicant's mark has not been invented for the sole purpose of functioning as a trademark. Applicant's mark is comprised of terms that are known in the language and in common usage. The evidence made of record demonstrates that BOTVAC used in connection with the applied-for goods is not fanciful.

In the alternative to the mark being fanciful, applicant argues that the mark is arbitrary. To this end applicant contends that the wording BOTVAC do not suggest or describe a significant ingredient, quality, or characteristic of the applied for goods. To support this claim, applicant has made of record dictionary definitions which show that the wording "bot" has a variety of meanings, such as "the lava of a bot fly," "botanist," "botany" and so on. Applicant contends that when such words are combined with "vac" the combination does not suggest or describe applicant's robot vacuum cleaning appliances. However, the fact that the individual words have various meanings is not controlling. *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). When the mark BOTVAC is used in the context of applicant's goods, specifically, robotic vacuum cleaners," it seems clear that the applied for mark is not arbitrary. There is nothing incongruous in the combination BOTVAC when the evidence of record establishes that among other things the wording "bot" is commonly used in reference to "robot" and "robotic" and "vac" is informal for vacuum cleaner.

Applicant further contends that if the mark is not fanciful or arbitrary, it is suggestive. However, applicant's contention that the mark is suggestive is also unpersuasive. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a). In addition to arguments that "bot" has numerous definitions and common understandings beyond simply" "robot," the applicant contends that it's possible to not see the mark as "bot-vac" but instead see "boat vac" or "bo-t-vac." In light of this reasoning, applicant argues that upon encountering the mark BOTVAC in the marketplace, consumers must momentarily pause, work through the potential definitions and meanings of BOTVAC, and then take a mental leap in order to correctly determine the nature and characteristics of applicant's goods. However, the examining attorney finds these arguments unpersuasive in light of the plain meaning of the wording in the mark in relation to the goods as demonstrated by the evidence made of record by the examining attorney. "Whether 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). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but "whether someone who knows what the goods and [/or] services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed.

Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

Applicant points to three TTAB cases involving Trademark Act Section 2(e) (1) to support applicant's claim that the examining attorney has failed to meet her evidentiary burden. In each case, it was determined that the mark was not merely descriptive as applied to the goods. See *In re WhiteWave Services, Inc*., Serial No. 86008622 (January 27, 2015) [not precedential]. [Mere descriptiveness refusal of **CLASSICMAC** for "macaroni and cheese" where there was no evidence that "mac" alone means "macaroni and cheese," and where the evidence reflects no specific well-known or typical recipe for macaroni and cheese];" *Oreck Holdings, LLC v. Bissell Homecare, Inc.* Opposition No. 91173831 (February 16, 2010) [not precedential] [**HEALTHY HOME VACUUM** {vacuum –disclaimed} for vacuum cleaners, where it was determined that the mark "does not, in any clear or precise way, serve to immediately describe a particular characteristic or feature of the goods with any degree of particularity"]; *In re Future Ads LLC*, 103 USPQ2d 1571 (TTAB 2012) [precedential] [**ARCADEWEB & Design** for Internet marketing services, not descriptive where there was no evidence of record showing use of the term "arcadeweb" or "arcade web" used in connection with services like those of applicant].

In each of the cases described above, the marks were determined to be suggestive, requiring a multistage reasoning process to determine the attributes indicated by the mark. However, in the present case, the examining attorney has analyzed each portion of the compound word mark, BOTVAC to determine whether each portion of the mark "BOT" and "VAC" is merely descriptive

of the goods and then looked at the compound word mark in its entirety to determine if it is merely descriptive in its entirety. As indicated above, BOTVAC is the equivalent of robot vacuum cleaner, robotic vacuum cleaner and/or vacuum cleaners featuring robotic technology.

It is noted however, that applicant maintains that the examining attorney's evidence is deficient because the examining attorney has not made any evidence showing use of the mark in its entirety by anyone other than applicant. However, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that BOTVAC is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

CONCLUSION

The compound word BOTVAC when viewed in relation to the identified goods is merely a combination of terms BOT and VAC which indicates a feature and/or characteristic of applicant's goods as robotic vacuum cleaners, robot vacuum cleaners and/or vacuum cleaners featuring robotic technology. Given the plain meaning of the wording in the mark, in relation to the goods, the wording BOTVAC is not fanciful, arbitrary, and has no unique or incongruous meaning as applied to the goods. The evidence of record supports the conclusion that the wording BOTVAC is merely descriptive under Section 2(e) (1) of the Trademark Act.

For the foregoing reasons, the refusal to register the applicant's mark on the Principal Register under Trademark Act Section 2(e)(1) should be affirmed.

Respectfully submitted,

/Priscilla Milton/

Law Office 110

priscilla.milton@uspto.gov

571-272-9199

Chris A. F. Pedersen

Managing Attorney

Law Office 110