

From: Pendleton, Carolyn

Sent: 1/19/2015 5:48:57 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85791698 - VIEWABILL - NSSL-2 / 122 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 85791698.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85791698 MARK: VIEWABILL	
CORRESPONDENT ADDRESS: THEODORE R REMAKLUS WOOD HERRON & EVANS LLP 441 VINE ST 2700 CAREW TOWER CINCINNATI, OH 45202-2814	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: No Surprises Software, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: NSSL-2 / 122 CORRESPONDENT E-MAIL ADDRESS: tremaklus@whe-law.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's refusal to register the trademark VIEWABILL. Registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is merely descriptive of the services.

FACTS

On November 30, 2012, the applicant No Surprises Software, LLC., filed an intent-to-use trademark application seeking registration on the Principal Register of the mark VIEWABILL in International Class 035 for “providing an on-line system for clients of hourly service providers and the hourly service providers to share activity information on a real time basis”.

In an Office Action mailed on March 26, 2013, the examining attorney required amendment of the identification of services and re-classification of the services to Class 42. On September 16, 2013, applicant submitted an allegation of use, which was accepted, and amended the identification of services as suggested by the examining attorney in the March 26, 2013 Office action. However, the classification was not amended, so the examining attorney subsequently issued an examiner’s amendment on December 29, 2014 to amend the classification to Class 42.

On October 9, 2013 the examining attorney refused registration of the mark on the Principal Register under Trademark Act Section 2(e)(1) as being merely descriptive based on the specimen of record submitted by applicant with the September 16 allegation of use. On February 18, 2014, the applicant responded by arguing against the refusal to register the mark on the Principal Register under Section 2(e)(1). On March 21, 2014, the examining attorney issued a final Office action on the refusal under Section 2(e)(1).

The applicant noted the instant appeal on September 17, 2014, and filed its brief on November 14, 2014. The file was forwarded to the examining attorney for statement on November 20, 2014.

ISSUE

The issue on appeal is whether the mark VIEWABILL, when used in connection with the applicant’s services, is merely descriptive of those services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

ARGUMENT

THE APPLICANT'S MARK IS MERELY DESCRIPTIVE OF THE SERVICES UNDER SECTION 2(e)(1) OF THE TRADEMARK ACT.

A mark is merely descriptive if "it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant's] goods or services." *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); see *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200Applicant argued in its brief that the law is well settled that a mark will be deemed to be merely descriptive only if it "immediately conveys information" about an ingredient, characteristic, function or feature of a product or service." See, e.g., *In re MBNA America Bank N.A.*, 67 U.S.P.Q.2d 1778, 1780 (Fed. Cir. 2003); *In re Time Solutions Inc.*, 33 U.S.P.Q.2d 1156, 1157 (T.T.A.B. 1994); see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 189 U.S.P.Q. 759, 765 (2d Cir. 1976) ("A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods."). It is not sufficient, however, that the term may convey an indefinite scrap of information about the goods or services, it must provide the consumer with an unambiguous idea as to the nature of those goods or services. See *Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55, 60 (2d Cir. 1961) ("Unless a word gives some reasonably accurate — some tolerably distinct knowledge — as to [the goods], it is not descriptive within the meaning of trademark terminology."). By contrast, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978); *In re Mayer-Beaton Corp.*, 223 U.S.P.Q. 1347, 1349 (T.T.A.B. 1984). (Applicant's brief p. 3).

The specimen submitted by the applicant in the allegation of use dated September 16, 2014, shows that applicant's services consist of the provision of online technology that enables users to access counsel's time entries to determine that the counsel is "using best billing practices". The specimens consist of screenshots from applicant's website showing a live demo of a legal bill. The specimen states, "with real-time access to outside counsel's billable activity, "Legal Spend Management' just became meaningful". The specimen describes the features of the online technology which enables users to "experience peace of mind that outside counsel is using best billing practices" and enables users to "actively review entries and collaborate with outside counsel in real time".

In the Office action dated March 21, 2014, the examining attorney included screenshots from applicant's website which contain images of the end result of applicant's online technology. For example, one screen shot shows what the applicant's services look like on a computer device. The wording VIEWABILL appears on top of the screen, and underneath is the wording "MY DASHBOARD". The graphics are divided into various segments, such as "Total Spend", "Total Hours", "Average Rate", "Daily Activity Graph" and "Average Cramming Delay". This screenshot is entitled "take control of billable hours". Another screenshot states, "[t]here's a reason general counsel's value 'transparency' above cost-cutting measures, such as lower rates. When you know exactly how much time I being spent, the opportunities are endless". Another screenshot states, "[a]ccess anytime, anywhere. Always know when you're being billed, by whom and for how much" ...Build stronger, trusting relationships with outside counsel. That's what happens when you don't have to worry about overbilling". Another screenshot states "[i]nnovative law firms are excited to build stronger, transparent relationships with their clients". Thus the specimens show the online technology allows the user to view an online bill.

Applicant argued in its brief that the law is well settled that a mark will be deemed to be merely descriptive only if it "immediately conveys information" about an ingredient, characteristic, function or

feature of a product or service." See, e.g., *In re MBNA America Bank N.A.*, 67 U.S.P.Q.2d 1778, 1780 (Fed. Cir. 2003); *In re Time Solutions Inc.*, 33 U.S.P.Q.2d 1156, 1157 (T.T.A.B. 1994); see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 189 U.S.P.Q. 759, 765 (2d Cir. 1976) ("A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods."). It is not sufficient, however, that the term may convey an indefinite scrap of information about the goods or services, it must provide the consumer with an unambiguous idea as to the nature of those goods or services. See *Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55, 60 (2d Cir. 1961) ("Unless a word gives some reasonably accurate — some tolerably distinct knowledge — as to [the goods], it is not descriptive within the meaning of trademark terminology."). By contrast, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978); *In re Mayer-Beaton Corp.*, 223 U.S.P.Q. 1347, 1349 (T.T.A.B. 1984). (Applicant's brief p. 3).

Applicant stated in its brief that the relevant inquiry is "what is a bill", and stated that a bill in the context of the present application is the equivalent of an invoice. Applicant submitted a definition of "bill" defined as "an itemized list of fees or charges"; an amount of money owed for goods supplied or services rendered, set out in a printed or written statement of charges", and "invoice" as "an itemized list of goods shipped or services rendered, with an account of all costs: BILL; a list of goods sent or services provided, with a statement of the sum due for these; a bill". (Applicant's brief p. 4).

Applicant further argued that a "bill" is a document that sets out an amount of money that is owed for goods purchased or services provided, but argued that the applicant's services relate to "providing clients of hourly service providers the ability to share activity information on a real time basis

before a bill is generate". Applicant argued that VIEWABILL "only describes a situation in which a user would be able to see a final bill of charges for services provided", but a final bill is not what is being provided by applicant. Applicant argued that the services are "an interface between a customer and an hourly service provider that enables real-time evaluation of time entries before a bill is issued". Applicant stated that consumers will continue to receive the "bills" from the services provider and that the consumer would have to use "imagination to make a leap from the literal meaning of the mark – see a final bill of charges – to what is actually provided. (Applicant's brief pgs. 5-6).

The examining attorney respectfully disagrees with the applicant's argument that VIEWABILL is not descriptive because consumers use the services to see a bill before it is issued, rather than a final bill, and that the mark is only descriptive of final not interim bills. It is unlikely that consumers will need to make any leap from the literal meaning of the mark to what is actually provided because consumers are immediately able to view a bill. Therefore, consumers viewing the VIEWABILL mark with the services clearly conveys to the consumer the purpose and function of the mark. Applicant has based its arguments entirely on a timeline of events. Specifically, that applicant's services enable viewing of a bill before it is issued rather than enable viewing of a final bill, so the mark cannot be descriptive of anything but the final bill. It is irrelevant whether consumers can use applicant's services to view a bill before or after it is issued. The fact of the matter is that the applicant's services enable consumers to view, review and question a bill before it is issued. The timing of the viewing of the bill does not obviate a finding descriptiveness because the mark describes exactly what applicant's services provide, namely, the ability to "view a bill". In this situation, applicant is providing users the ability to view a bill before the final bill is issued in order to question charges that may seem too high or activity that may not have been performed.

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). "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).

Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term "BREATHABLE" retained its ordinary dictionary meaning when combined with the term "MATTRESS" and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely

descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the 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).

Consumers viewing the applicant’s mark, VIEWABILL will immediately understand the purpose of applicant’ services because of the combination of descriptive wording VIEW A BILL. Consumers who utilize the applicant’s services specifically choose these services because they desire the ability to view a bill before it is issued. The fact that the consumer wishes to view a bill before it is issued, rather than after, is not relevant to the finding of descriptiveness because the timing of the function does not change the purpose of the function of applicant’s services. 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 VIEWABILL 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).

Applicant argued that this case is analogous to the mark AIR-CARE, which was found by the Board to be suggestive, rather than merely descriptive, when used in connection with maintenance services for inhalation therapy equipment. *See Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977). Noting that the court’s rationale in the AIR-CARE case applies to the current

case as follows: The mark "AIR-CARE" is . . . not merely descriptive as applied to applicant's services. The literal meaning of the mark, namely, "care of the air", may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant's services, but it does not, in any clear or precise way, serve merely to describe applicant's preventive maintenance program for hospital and medical anesthesia and inhalation therapy equipment and the like. *Id.* at 835. Applicant argued that "[a]s with the AIR-CARE mark, Applicant's VIEWABILL mark does not in any clear or precise way serve merely to describe Applicant's technology is designed to enable a user to review time and cost entries on a real-time basis before a bill is generated, and Applicant's VIEWABILL mark is not merely descriptive of Applicant's services".

The examining attorney disagrees with applicant's contention that the AIR-CARE case is analogous to the current VIEWABILL mark. In the AIR-CARE application, it was clear that the mark is suggestive, and is vague as to what exactly is meant by the "care" of the air. Is it to clean the air, purify it, test it for impurities? Any number of functions could be described by wording "care", and therefore, the mark is indeed descriptive of the applied for goods. In the AIR-CARE case, the court stated the mark, *"does not, in any clear or precise way, serve merely to describe applicant's preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment and the like."* 196 USPQ 832, 835. The present case can be differentiated from AIR-CARE because, unlike in that case where the wording in the mark was somewhat ambiguous as to exactly what functions the goods performed because of the broad way in which the wording CARE can be interpreted, the mark in this case immediately conveys the function of the services, namely, to view a bill.

The evidence of record in the form of screenshots from applicant's website clearly illustrate that the function of the applicant's services is enable users to view a bill at any point in the process of the

provision of hourly services. The screenshots of record from applicant's website clearly show a dashboard that contains billing information. It is irrelevant to the finding of descriptiveness that the ability to view a bill occurs before the final bill is issued. It is sufficient that a user of applicant's services can view a legal bill at any point in the performance of the legal counsel's services. Therefore, the mark VIEWABILL is descriptive, not suggestive, of applicant's services because no multi-stage reasoning is required to ascertain the purpose of the services.

Applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) on the ground that the mark is merely descriptive of the identified services should be affirmed.

Respectfully submitted,

/Carolyn A. Pendleton/

Trademark Examining Attorney

Law Office 103

Phone: 571-272-9207

carolyn.pendleton@uspto.gov

Michael Hamilton

Managing Attorney

Law Office 103