From: Rutland, Barbara

Sent: 8/31/2016 3:51:28 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 86285538 - RAPID LINE INTEGRATION - ROC-38678 - EXAMINER BRIEF

****

Attachment Information:

Count: 1

Files: 86285538.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86285538

MARK: RAPID LINE INTEGRATION

CORRESPONDENT ADDRESS:
E LISABETH TOWNSEND BRIDGE

WHYTE HIRSCHBOECK DUDEK SC

555 E WELLS STREET SUITE 1900

MILWAUKEE, WI 53202

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Rockwell Automation, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

ROC-38678

CORRESPONDENT E-MAIL ADDRESS:

ptomailbox@whdlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark attorney's final refusal to register the applied-for mark RAPID LINE INTEGRATION. 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 applied-for mark RAPID LINE INTEGRATION is merely descriptive of "Computer software for use in industrial automation manufacturing equipment,

namely, application software and operator interface software used to integrate manufacturing line, equipment and controls."

FACTS

On May 19, 2014, applicant Rockwell Automation, Inc. filed an intent-to-use trademark application seeking registration of the mark RAPID LINE INTEGRATION for goods identified as "Computer software for use in industrial automation namely, application software and operator interface software for in manufacturing lines and equipment control."

In an Office Action issued on September 12, 2014, the trademark examining attorney refused registration of the applied-for mark based on Trademark Act Section 2(d) for a likelihood of confusion with a registered mark. In addition, applicant was required to clarify the identification of goods and disclaim the wording "LINE INTEGRATION". In a Response to Office Action dated February 24, 2015, applicant responded with arguments in favor of registration and provided a definite amended identification and required disclaimer statement.

In a second Office Action issued on April 14, 2015, the examining attorney, withdrew the Trademark Act Section 2(d) refusal and accepted and made of record the amended identification and disclaimer statement. The examining attorney, however, raised a new matter in refusing registration of the mark under Trademark Act Section 2(e)(1) on the ground that the applied-for mark is merely descriptive of the applicant's goods. In a Response to Office Action dated October 14, 2015, the applicant responded with arguments in favor of registration.

The examining attorney issued a Final Office Action on November 30, 2015; therein, the examining attorney made final the refusal under Section 2(e)(1).

The applicant filed its appeal brief on July 7, 2016, and the file was forwarded to the examining attorney on July 7, 2016.

ISSUE

The sole issue on appeal is whether the applicant's mark RAPID LINE INTEGRATION, when used on or in connection with the goods for which registration is sought, is merely descriptive of such goods under Trademark Action Section 2(e)(1).

ARGUMENT

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.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). 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.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); TMEP §1209.01(b). Thus, "[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).

While a combination of merely descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, the mere combination of descriptive words does not necessarily create a unique, incongruous, or otherwise nondescriptive word or phrase. *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). If each individual component of the mark retains its descriptive significance in relation to the goods, the combination results in a composite that is itself descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004).

I.) THE APPLIED-FOR MARK IS MERELY DESCRIPTIVE NOT SUGGESTIVE OF THE IDENTIFIED GOODS

Both the individual components of the applied-for mark 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 identified as "Computer software for use in industrial automation manufacturing equipment, namely, application software and operator interface software used to integrate manufacturing line, equipment and controls."

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, 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 Cannon Safe, Inc., 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because "each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive"); *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 goods 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, RAPID LINE INTEGRATION is merely descriptive of computer software used to integrate manufacturing line, equipment and controls because the evidence shows that the wording is nothing more than a combination of descriptive terms with each component term retaining its merely descriptive significance in relation to the goods resulting in a mark that is also merely descriptive.

The examining attorney has provided evidence showing the term RAPID has descriptive significance in the automated manufacturing field as it refers to a type of manufacturing.

See, e.g.:

> *ParamountInd.com,* "Paramount is innovatively establishing new levels of achievement in **rapid manufacturing**, producing finished parts for highly-specialized applications direct from 3D CAD digital input, thus dispensing with the costly and time-consuming process of tool making[1] . . . . Applications for **Rapid Manufacturing** [include] packaging." [2]

> *p2pfoundation.net,* "**Rapid Manufacturing** is a broad term including the use of Rapid Prototyping, Rapid Tooling, and the direct use of Layer Manufacturing technologies to produce final products quickly. . . . **Rapid Manufacturing** is a new area of manufacturing developed from a family of technologies known as Rapid Prototyping. These processes have already had the effect of both improving products and reducing their development time; this in turn resulted in the development of the technology of Rapid Tooling, which implemented Rapid Prototyping techniques to improve its own processes. **Rapid Manufacturing** has developed as the next stage, in which the need for tooling is eliminated. It has been shown that it is economically feasible to use existing commercial Rapid Prototyping systems to manufacture series parts in quantities of up to 20,000 and customised parts in quantities of hundreds of thousands. This form of manufacturing can be incredibly cost-effective and the process is far more flexible than conventional manufacturing."[3]

> *PCmag.com*, "Building parts out of plastic or metal one layer at a time using a method of additive fabrication such as 3D printing. Multiple pieces, either similar or dissimilar, can be built simultaneously. **Rapid manufacturing** evolved from some of the technologies used to build prototypes (see rapid prototyping) See 3D printing)."[4]

> *Wikipedia.org*, "**Rapid Manufacturing** (in German also Rapid Manufacturing) refers to methods and production methods for fast and flexible production of components and series by toolless production directly from CAD data."[5]

---

[1] Web page excerpt attached to Final Office Action (dated November 30, 2015) at p. 11.
[2] *Id.* at p. 13. It is noted that applicant's goods are used in the manufacturing of packaging. *See* Exhibit B, Applicant's Response to First Office Action (dated February 24, 2015) at p. 12.
[3] Web page excerpt attached to Final Office Action (dated November 30, 2015) at p.5.
[4] *Id.* at p. 3.
[5] *Id.* at p. 2.

In the alternative, the descriptive nature of the wording "RAPID" may be found in the ordinary meaning of the term, which may refer to "acting or moving quickly; fast."[6] Therefore, "RAPID", in the applied-for mark, merely describes goods involving fast manufacturing.

Evidence of the descriptive wording "LINE INTEGRATION" is found in applicant's use of the wording "LINE" in its identification of goods and in the ordinary meaning of the wording "INTEGRATION" showing that it may refer to "the process of combining with other things in a single larger unit or system."[7] Therefore, the wording merely describes computer software for use in industrial automation namely, software for use in manufacturing line integration or the process of combining manufacturing lines in a single larger unit or system.[8] In Applicant's Response to Office Action (dated February 24, 2015), applicant provided the required disclaimer of the wording "LINE INTEGRATION" without argument; thereby conceding the descriptive nature of the wording.

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

---

[6] *See* Dictionary definition from *The Collins English Dictionary* attached to Second Office Action (dated April 14, 2015) at p. 2.
[7] *See* Dictionary definition from *Macmillan Publishers Limited English Dictionary* attached to First Office Action (dated September 12, 2014) at p. 3.
[8] First Office Action (dated September 12, 2014) at p. 1.

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).

While consumers might not be able to guess from consideration of the mark alone the exact nature of applicant’s goods, “[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). The evidence demonstrates that in the field of computer automated manufacturing purchasers would understand the wording “RAPID LINE INTEGRATION” to immediately “convey information about [the goods].” *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).

The applicant contends that applicant’s mark is suggestive because it requires imagination, thought and perception on the part of the purchaser to understand the nature of applicant’s goods. Specifically, applicant states:

> The purpose or function of the Applicant’s Goods is to create a common equipment interface, which enables manufactures to more easily and economically commission new manufacturing lines or upgrade a line more efficiently. The goal of the Applicant’s goods is to limit the amount of downtime. The goal is **not** to run “fast” software

> programs or to even increase the speed of the manufacturing line or the integration time.[9]

The examining attorney has never argued that the function of applicant's goods is to run "fast" software programs but instead has argued that "rapid" refers to a type of manufacturing or, in the alternative, "rapid" means "fast" and applicant's goods involve fast manufacturing. It is important to note that applicant has never addressed the contention that "rapid" refers to a particular type of manufacturing. While applicant's software may not be literally used for "rapid manufacturing" as defined by the evidence, the identification of goods is broadly worded such that it can be read to include computer software used to integrate manufacturing line, equipment and controls in a rapid manufacturing production environment.

Nonetheless, contrary to applicant's assertion, one of the goals of applicant's software appears to be to "increase the speed of the manufacturing line or the integration time." *See, e.g.*:

> Applicant's RAPID LINE INTEGRATION software is designed to integrate all the various manufacturing equipment within one manufacturing line. Working as a common interface with each piece of equipment, many of which are manufactured by different OEM manufacturers, there is no need to modify or customize any equipment to link with the other equipment on the line. Each piece of equipment does not need to create its own "handshake" with the next piece down the line. Instead, all the equipment is installed with the RAPID LINE SOFTWARE so that each piece can be **quickly** and easily implemented into the manufacturing line. The entire line can be integrated together with ease, any portion of the line repaired or replace with **speed** and efficiency, and the overall downtime of the manufacturing line reduced significantly.[10]

---

[9] Applicant's Appeal Brief at 6.

[10] Applicant's Response to First Office Action (dated February 24, 2015) at p. 8.

In the Second and Final Office Actions, the examining attorney noted that the information attached to Applicant's Response to First Office Action (dated February 24, 2015) as Exhibit B described the goods as featuring "Faster installation"[11] and faster manufacturing line integration:

> RAPID Line Integration can be implemented **faster** than most traditional methods allowing most users to begin optimizing the line sooner with timely and accessible information including:
>
> •Real-time and historical information available immediately on the plant floor human machine interface (HMI).[12]

Thus, applicant's own promotional materials serve to ingrain in the potential consumer the descriptive character of the applied-for mark.

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).

---

[11] *Id.* at p. 12 (Exhibit B).
[12] *Id.* at p. 11 (Exhibit B).

In relation to applicant's goods, the context in which the mark is or will be used, and the possible significance the mark would have to the average purchaser in view of the foregoing, the significance of the applied-for mark is merely descriptive.

II.) Applicant's Mark Is Not A Double Entendre

A "double entendre" is an expression that has a double connotation or significance as applied to the goods and/or services. TMEP §1213.05(c); *see In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme "sugar and spice and everything nice").

Applicant contends that the term RAPID has a double connotation or significance as applied to the goods. Specifically, applicant argues "[t]he term RAPID refers to **R**ockwell **A**utomation for **P**erformance, **I**ntegration and **D**ata."[13] In addition, applicant contends that the term RAPID "conveys a dual meaning, excluding it from consideration as a descriptive mark."[14] Applicant relies on a slang definition for RAPID as "cool; excellent."[15]

---

[13] Applicant's Appeal Brief at p.7.
[14] *Id.* at p. 8.
[15] *Id.* at 9, *citing* definition from *InternetSlang.com*, attached as Exhibit B to Applicant's Response to Office Action (dated October 14, 2015).

A mark that comprises a "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods and/or services. TMEP §1213.05(c). However, the multiple meanings that make an expression a "double entendre" must be well-recognized by the public and readily apparent from the mark itself. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE not a double entendre in relation to wines and affirming requirement to disclaim ROUGE); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470-71 (TTAB 2005) (finding THE GREATEST BAR not a double entendre in relation to restaurant and bar services and affirming refusal to register based on descriptiveness of the mark); *In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158-59 (TTAB 2003) (finding ETHNIC ACCENTS not a double entendre in relation to television programs in the field of home décor and affirming refusal to register based on descriptiveness of the mark).

In this case, as noted by the examining attorney in the Final Office Action, applicant has failed to proffer, nor could the examining attorney find any evidence that the term RAPID is used or understood to represent **R**ockwell **A**utomation for **P**erformance, **I**ntegration and **D**ata.[16]

Moreover, applicant's sole focus is on the wording RAPID, but a true "double entendre" is unitary by definition. An expression that is a "double entendre" should not be broken up for purposes of requiring a disclaimer. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of "LIGHT" apart from the mark "LIGHT N' LIVELY" for reduced calorie mayonnaise, stating as follows:

---

[16] *See* attachments to Final Office Action (dated November 30, 2015) at pp. 16-25, from www.Google.com, www.acronymfinder.com, www.abreviations.com at pp. 16-25.

> The mark "LIGHT N' LIVELY" as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term "LIGHT" per se. That is, the merely descriptive significance of the term "LIGHT" is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole.

See TMEP §1213.05(c).

In addition, applicant has failed to provide evidence that the applied-for mark has a double connotation or significance as applied to the goods that is well-recognized by the public and readily apparent from the mark.

Applicant's contention that the term RAPID conveys a dual meaning, excluding it from consideration as a descriptive mark, fails similarly. Applicant has not proffered any evidence that the slang meaning is well-recognized by the public and readily apparent from the mark for these goods. 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). "That a term may have other meanings in different contexts 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).

III.) Third Party Marks Are Not Conclusive On The Issue Of Descriptiveness

Lastly, applicant argues against the descriptiveness refusal based on third-party registrations for marks allegedly similar to applicant's mark because wherein the wording RAPID has "been deemed suggestive and have been registered on the Principal Register without a disclaimer or a claim of distinctiveness."[17]

The fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Moreover, vocabulary used in the computer and electronics fields is particularly noted for changing rapidly, and descriptiveness is determined based on the facts and evidence in the record at

[17] Applicant's Appeal Brief at 9.

the time registration is sought. *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1088 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000) (noting "a year or two is an eternity in 'Internet time,' given the rapid advancement of the Internet into every facet of daily life"). A term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and come to be regarded by the purchasing public as nothing more than a descriptive designation. *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int'l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976).

Thus, third-party registrations of applicant's mark or portions of applicant's mark are not probative on the question of descriptiveness. Each case must be taken on its own facts. *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991); TMEP §1209.03(a).

CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the Board affirm the refusal of RAPID LINE INTEGRATION as merely descriptive of the applicant's services within the meaning of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) should be affirmed.

Respectfully submitted,

/Barbara Rutland/

Examining Attorney

Law Office 101

USPTO

Phone: 571-272-9311

Fax: 571-273-9101

barbara.rutland@USPTO.gov

Ronald R. Sussman

Managing Attorney

Law Office 101