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

Proceeding	86285538
Applicant	Rockwell Automation, Inc.
Applied for Mark	RAPID LINE INTEGRATION
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Attachments	RAPID LINE INTEGRATION Reply Brief.pdf(446405 bytes )
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Date	09/19/2016

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

In re Application of:

Serial No.:	86/285538
Mark:	RAPID LINE INTEGRATION
International Class:	Class 9
Applicant:	Rockwell Automation, Inc.
Filing Date:	May 19, 2014
Examining Attorney:	Barbara Rutland Law Office 101
Applicant's Attorney of Record:	Elisabeth Townsend Bridge

**REPLY BRIEF OF THE APPLICANT**

On May 10, 2016, Rockwell Automation, Inc., (“Applicant”), filed its Notice of Appeal with the Trademark Trial and Appeal Board (the “TTAB”) of the Examining Attorney’s final refusal to register the mark RAPID LINE INTEGRATION (“Applicant’s Mark”), with “LINE INTEGRATION” disclaimed. Registration was finally refused by the Examining Attorney under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052 on the basis that the Applicant’s Mark is merely descriptive of the features and subject matter of the goods provided under the Applicant’s Mark. Pursuant to the Notice of Appeal, the Applicant appeals the Examining Attorney’s final refusal to register the above-identified mark, and respectfully requests that the TTAB reverse the Examining Attorney’s refusal and approve Applicant’s Mark for publication and registration.

**FACTS**

On May 19, 2014, Applicant filed an application for registration of the mark “RAPID LINE INTEGRATION” for use on or in connection with “computer software for use in industrial

automation namely, application software and operator interface software for use in manufacturing lines and equipment control,” in International Class 9 (the “Applicant’s Goods”).

The Examining Attorney initially refused registration under Section 2(d) of the Trademark Act on the basis that, in her opinion, the Applicant’s Mark was likely to cause confusion with the mark in U.S. Registration No. 4,072,266 for RAPID for use on "computer hardware, computer software, computer programs, all of the above goods relating to the collection, storage and analysis of production data in the field of production and manufacturing management for the manufacturing industry," in International Class 9 (the “Registered Mark”).<sup>1</sup> The Examining Attorney also issued a requirement that the Applicant disclaim the wording “LINE INTEGRATION” because, in her opinion, the wording merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of the Applicant’s Goods.<sup>2</sup>

Applicant responded to the initial Office Action on February 24, 2015, by arguing that the Applicant’s Mark was unlikely to cause public confusion with the Registered Mark in light of (1) the significant distinctions in sound, meaning and appearance between the marks in their entireties; (2) the significant distinctions between the overall commercial impression of each mark; (3) the significant distinctions between the goods sold under the respective marks; (4) the frequent use of the word “rapid” in marks owned by third parties showing a crowded field of “rapid” marks; and (5) the level of sophistication and discrimination exhibited by purchasers of goods sold under the respective marks.<sup>3</sup> Supportive evidence was submitted with the Response. Applicant also disclaimed the wording “LINE INTEGRATION” in accordance with the

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<sup>1</sup> September 12, 2014 Office Action, TSDR p. 1.

<sup>2</sup> September 12, 2014 Office Action, TSDR p. 1.

<sup>3</sup> February 24, 2015 Response to Office Action, TSDR pp. 2–15.

Examining Attorney's request. Thus, Applicant's Mark includes the words "RAPID LINE INTEGRATION" with the language "LINE INTEGRATION" disclaimed.

After receipt of Applicant's initial response, on April 14, 2015, the Examining Attorney issued a second Office Action withdrawing the refusal under Section 2(d) of the Trademark Act and raising a new basis for refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052, namely, that the Applicant's Mark was merely descriptive of the features and subject matter of the goods provided under the mark.<sup>4</sup>

Applicant responded to the second Office Action on October 14, 2015 by arguing that the Applicant's Mark: (1) is not descriptive of the Applicant's Goods, but is instead at least suggestive and distinctive and therefore registrable on the Principal Register; (2) is a double entendre that conveys a dual meaning and is thus not merely descriptive; and (3) the use of the word "rapid" in marks owned by third parties in the computer software and other similar contexts is frequently deemed at least suggestive by the U.S. Patent and Trademark Office (the "USPTO") and therefore Applicant's Mark should be treated similarly to those marks.<sup>5</sup> Supportive evidence was submitted with the Response.

After receipt of Applicant's second response, on November 30, 2015, the Examining Attorney issued a third Office Action making final the Section 2(e)(1) refusal to register the Applicant's Mark on the basis that the Applicant's Mark is merely descriptive of the features and subject matter of the Applicant's Goods provided under the mark.<sup>6</sup> A Notice of Appeal was subsequently filed by Applicant and an Appeal Brief was filed by Applicant pursuant to 37

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<sup>4</sup> April 14, 2015 Office Action, TSDR p. 1.

<sup>5</sup> October 14, 2015 Response to Office Action, TSDR pp. 1-8.

<sup>6</sup> November 30, 2015 Office Action, TSDR p. 1.

C.F.R. § 2.142(b)(1). On August 31, 2016, the Examining Attorney filed the Examining Attorney's Appeal Brief and this Reply Brief of the Applicant is being filed in response.

## ARGUMENT

### **I. The Applicant's Mark is Not Merely Descriptive of the Applicant's Goods.**

#### **A. The Examining Attorney Bears the Burden of Proof in Establishing That Applicant's Mark is Descriptive, and the Examining Attorney Has Not Met this Burden.**

The Examining Attorney bears the burden of establishing that the Applicant's Mark is merely descriptive. The Applicant is required only to make the issue of whether the Mark is, at least suggestive of its goods or services an open question in order for the Mark to be registered. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991). Because it is a fine line between a merely descriptive mark and a suggestive mark, the TTAB takes the position that any doubt is resolved in favor of the applicant—as any potential competitors will have ample opportunity to oppose the registration of applicant's mark during the publication period. *See In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB. 1972). The Examining Attorney has clearly not met this burden.

Here, the Applicant's Goods are "computer software for use in industrial automation namely, application software and operator interface software for use in manufacturing lines and equipment control. "A mark must be *merely* descriptive of the applicant's goods or services to be refused registration on the Principal Register. TMEP § 1209(b). A mark is merely descriptive if it *immediately* describes an ingredient, characteristic, quality or feature of the goods. *See Chicago Reader, Inc. v. Metro College Publishing Co.*, 222 USPQ 782 (7<sup>th</sup> Cir. 1983). On the other hand, a mark is suggestive if *imagination, thought and perception* on the part of the

purchaser are required in order to obtain some direct description of the applicant's goods or services or the purpose for which they are sold. *McCarthy on Trademarks and Unfair Competition*, § 11:67; *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 160 USPQ2d 177 (SDNY 1968).

A trademark is merely descriptive only if it *immediately* informs ordinary purchasers of the purposes or functions of the goods or services *with a degree of particularity*. See, e.g., *Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Entennman's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd* 90-1495 (Fed. Cir. 1991). If a mark causes consumers to pause, even for a moment, in order to determine the exact nature of the goods or services, then the mark is suggestive. See, *Equine Tech., Inc. v. EquineTechnology, Inc.*, 36 USPQ2d 1659 (Fed. Cir. 1995). The categories of "suggestive" and "merely descriptive" are part of a spectrum, and are often very difficult to apply. *In re Gyulay*, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). "RAPID LINE INTEGRATION" does not immediately describe "computer software for use in industrial automation namely, application software and operator interface software for use in manufacturing lines and equipment control." The Applicant's Mark is therefore not merely descriptive.

**B. The 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.**

The Examining Attorney assumes in her argument that all of the individual components of the Applicant's Mark are merely descriptive as applied to the Applicant's Goods. She focuses on her position that if the individual components are descriptive, the mark in its entirety is descriptive. However, there is no evidence establishing that the word "RAPID" as applied to the Applicant's Goods is merely descriptive. The Examining Attorney tried to support the view that

“Rapid Manufacturing” is a known term in the industry. However, the Applicant is not using the term “RAPID MANUFACTURING” – it is using “RAPID LINE INTEGRATION.” Evidence of news articles using “Rapid Manufacturing” are not evidence that the word “RAPID” without “Manufacturing” has the same meaning. In fact, as set forth in the Applicant’s previous brief in this proceeding, there are numerous registrations for marks containing the word “RAPID” for use on software products where the language has not been viewed as merely descriptive and no disclaimer has been required. Applicant’s Mark requires imagination, thought and perception on the part of the purchaser to understand the nature of Applicant’s Goods. Purchasers need to make a mental leap between “RAPID” to computer software designed to “enable users to configure, control and analyze line performance from a standard operator station.”<sup>7</sup> The purpose or function of the Applicant's Goods is to create a common equipment interface, which enables manufacturers 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.

The Examining Attorney has reviewed Applicant’s website and other evidence and found minor and isolated references to “faster” in concluding that the Applicant's Mark is merely descriptive. However, these minor references are not taken in their proper context, with the Examining Attorney erroneously concluding that the Applicant's Goods are described as “functioning in a fast or rapid manner.”

While Applicant’s Goods “can be implemented faster than most traditional methods” of line integration, this does not properly describe the goods, their function, or their purpose as

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<sup>7</sup> See Exhibit A, to October 14, 2015 Response to Office Action.

required for a descriptive mark. Instead, Applicant's Goods are used to optimize a manufacturing line with a simplified, repeatable interface across all equipment which provides the ability to produce reliable and real-time reporting for performance and to identify manufacturing issues.

**C. The Applicant's Mark Has a Dual Meaning and Therefore is Not Merely Descriptive Under Section 2(e) of the Trademark Act.**

Applicant's Mark conveys a unique and special meaning as applied to the Applicant's Goods. Applicant's Goods are uniquely focused on the ability to improve *performance* and provide real-time and historical *data* for line *integration*. In this way, the term RAPID has a novel and suggestive meaning as applied to Applicant's Goods and is not merely descriptive.

The term "RAPID" conveys a dual meaning. Applicant has developed an innovative approach and significant enhancement to line integration, which is a major development and improvement to manufacturing processes across many industries. Some might describe this new development as "cool" or "excellent." And, in fact, the slang definition for RAPID is actually "cool; excellent."<sup>8</sup> This dual meaning of "fast" and "cool" as applied to the term "RAPID" in connection with Applicant's Goods cleverly relates to Applicant's Goods. As such, Applicant's Mark is not merely descriptive, but at least suggestive of Applicant's Goods.

Applicant's Mark should be treated similarly to the third party marks discussed above and cited in the Applicant's Brief in this proceeding. These other registrations demonstrate that RAPID is not automatically viewed as meaning "fast" in a trademark context when used in a mark on software. Arguably, RAPID has less descriptive meaning as applied to Applicant's Goods than many of the registrations identified previously. Therefore, Applicant's Mark should be deemed suggestive and entitled to registration on the Principal Register.

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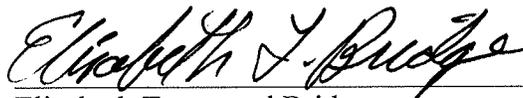
<sup>8</sup> See Exhibit B, October 14, 2015 Response to Office Action.

## CONCLUSION

The Examining Attorney has argued that Applicant's Mark is merely descriptive of the Applicant's Goods provided under the Mark. However, the Examining Attorney's arguments fail to meet the burden of proving that the word "RAPID," as applied to Applicant's Goods, is merely descriptive. In considering this issue, the Examining Attorney has failed to consider that the Applicant's Mark requires imagination, thought and perception on the part of the purchaser to understand the nature of Applicant's Goods. The Examiner has also failed to recognize that Applicant's Mark has a dual meaning and is therefore not merely descriptive under Section 2(e) of the Act. Moreover, the Examining Attorney has failed to consider that the usage of the term "rapid" is frequently deemed at least suggestive by the USPTO in the computer software field, and that Applicant's Mark should be treated similarly to those third party marks. In short, the Examining Attorney's evidence and arguments do not establish that the Applicant's Mark is merely descriptive of the features and subject matter of the Applicant's Goods provided under the Mark.

Consequently, Applicant respectfully requests the Applicant's Mark be approved for publication

Respectfully submitted,



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Elisabeth Townsend Bridge  
Attorney for Applicant

### **Alphabetical Index of Cited Cases**

*Chicago Reader, Inc. v. Metro College Publishing Co.*, 222 USPQ 782 (7<sup>th</sup> Cir. 1983)

*Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012)

*Equine Tech., Inc. v. EquineTechnology, Inc.*, 36 USPQ2d 1659 (Fed. Cir. 1995)

*In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)

*In re Entenman's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd* 90–1495 (Fed. Cir. 1991)

*In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB. 1972)

*In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994)

*In re Gyulay*, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)

*In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991)

*Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 160 USPQ2d 177 (SDNY 1968)