

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86301489
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 107
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="http://tmng-al.uspto.gov/resting2/api/img/86301489/large">http://tmng-al.uspto.gov/resting2/api/img/86301489/large</a>
<b>LITERAL ELEMENT</b>	INFOR FACTORY TRACK
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<b><u>REQUEST FOR RECONSIDERATION</u></b>	
<p>In an Office Action issued April 28, 2015, the Examining Attorney maintained and made final her requirement that Applicant disclaim allegedly descriptive matter from its mark INFOR FACTORY TRACK pursuant to Section 6 of the Lanham Act, 15 U.S.C. § 1056. In response, Applicant hereby submits the following in further support of registration without disclaimer.</p>	
<p><b>I. <u>NO DISCLAIMER OF "FACTORY TRACK"</u></b></p>	
<p>In the Office Action, the Examining Attorney required Applicant to enter a disclaimer of exclusive rights to the phrase "FACTORY TRACK" apart from Applicant's mark as a whole on the basis</p>	

that it allegedly "describes a feature or characteristic of the applicant's goods and services, namely, the way in which applicant's software is used to track efficiencies in factories in the form of goods and inventory tracking, personnel and equipment." Based on Applicant's previous arguments and evidence, the following supplemental analysis set forth herein, and additional evidence submitted herewith, Applicant respectfully, albeit vigorously, maintains its position that the "FACTORY TRACK" portion of Applicant's coined and unique mark INFOR FACTORY TRACK is unitary and, as used in connection with Applicant's goods and services, is at worst suggestive and simply cannot be found to be merely descriptive of such goods and services. Applicant's mark is therefore undoubtedly registrable on the Principal Register without a disclaimer of "FACTORY TRACK." Accordingly, Applicant respectfully requests that the disclaimer requirement be withdrawn and that the subject mark be approved for publication in its entirety without disclaimer.

**A. "FACTORY TRACK" Is Unitary and Suggestive, Not Merely Descriptive.**

Contrary to the Examining Attorney's position, Applicant emphatically reiterates that, under the appropriate standard set forth in Applicant's Response to Office Action submitted March 23, 2015, and as further explained herein, the "FACTORY TRACK" portion of Applicant's mark INFOR FACTORY TRACK is not merely descriptive of Applicant's goods and services as it by no means *immediately* describes or conveys knowledge of a significant feature or characteristic of Applicant's software and related services to relevant consumers. Rather, the wording FACTORY TRACK, as used in connection with the applied-for goods and services, is a suggestive, unitary phrase that can be understood only as a unique source

identifier for Applicant and therefore requires no disclaimer.

Initially, Applicant respectfully maintains its position that the fusion of "FACTORY" and "TRACK" in Applicant's mark creates a novel, suggestive (and thus non-descriptive), unitary phrase that engenders a distinct commercial impression independent of the individual words "factory" and "track." Indeed, the mental effort that must be employed by consumers to associate the invented phrase FACTORY TRACK with Applicant's goods and services exceeds the minimal degree of imagination, thought, and perception that would be required to recognize the descriptive nature of the discrete words "factory" and "track" as used in respect of such goods and services. This is particularly true here, where Applicant has transformed the verb "TRACK" in the mark into a noun, thus creating a novel and distinctive commercial impression. See generally Henry Hitchings, Those Irritating Verbs-as-Nouns, N.Y. Times, March 30, 2013, available at [http://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/?\\_r=0](http://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/?_r=0), submitted herewith as Exhibit B (describing the transmutation undergone when verbs are used as nouns and the transformative impact such conversion has on readers). Consequently, the creative use of the verb-turned-noun "track," together with the novel union of the words "factory" and "track" in their unique syntax, necessarily requires some degree of thought and imagination to surmise the nature of Applicant's goods and services. Indeed, the fact that the Examining Attorney had to dissect the FACTORY TRACK portion of Applicant's mark into its constituent elements prior to arriving at her conclusion that the composite is merely descriptive underscores the *suggestive* nature of FACTORY TRACK. While merely descriptive marks (or portions thereof) *immediately* describe the goods or services offered thereunder, suggestive terms require consumers to employ some degree of

imagination, thought, or perception before arriving at a conclusion as to the nature of the goods or services. This is the hallmark of suggestive marks.

Moreover, while the Examining Attorney has proffered as evidence definitions of the words "factory" and "track" and evidence of third-party use of those words independently (most of which are non-trademark usages), the record is significantly devoid of any evidence of use of the phrase "FACTORY TRACK" (except that of Applicant), let alone evidence that the novel and unique phrase carries a well-understood and recognized meaning. While consumers of Applicant's goods and services may recognize and understand the individual words "factory" and "track" and ultimately perceive a suggestive connection between FACTORY TRACK and the nature of Applicant's goods and services, they must first engage in at least a minimal amount of reasoning to dissect the phrase "FACTORY TRACK" into its constituent elements, consider the nature and meanings of the individual words and possible meanings of the composite phrase, and subsequently develop an understanding of the phrase "FACTORY TRACK" as applied in the novel context of Applicant's software and related services, rendering it impossible *immediately* to associate FACTORY TRACK with such goods and services. Indeed, absent prior exposure to FACTORY TRACK, it is impossible for consumers *immediately* to recognize the phrase as a descriptor of such goods and services. At worst, the phrase "FACTORY TRACK" may be *suggestive* of Applicant's goods and services, but it by no means *immediately* conveys knowledge about Applicant's software and related services; rather, any association between the phrase "FACTORY TRACK" and Applicant's goods and services necessitates more than a minimal degree of imagination, thought, or perception before achieving the requisite "mental leap."

As previously explained, Applicant is not attempting to register the words "factory" or "track" separately; rather, Applicant seeks registration of its coined, unitary mark INFOR FACTORY TRACK and the protections that flow from such registration, including the exclusive right to use *that phrase* - FACTORY TRACK - in commerce in connection with Applicant's goods and services. Thus, the question in the subject matter is not whether "factory" and "track" are independently merely descriptive, but rather whether the phrase "FACTORY TRACK," when properly viewed in its entirety, is merely descriptive of Applicant's goods and services. Without evidence to support the Examining Attorney's disclaimer requirement, the Examining Attorney's burden has not been satisfied. Consequently, the disclaimer requirement cannot be maintained.

It cannot be overemphasized that there is no such thing as a "factory track," as underscored by the dearth of evidence of meaning of such phrase in the record. Consequently, Applicant's unusual and novel combination of the words "FACTORY" and "TRACK" creates an inherently distinctive commercial impression that surpasses the respective meanings of the mark's individual components. The trademark significance of INFOR FACTORY TRACK is thus not derived from the individual meanings of "factory" and "track," but rather from the overall suggestive commercial impression engendered by Applicant's mark as a whole. Indeed, in the subject case, the whole is undoubtedly greater than the sum of its parts. Thus, the unitary mark INFOR FACTORY TRACK is unquestionably a distinguishing mark, no component of which requires a disclaimer.

As the foregoing demonstrates, the FACTORY TRACK portion of Applicant's novel and unique mark INFOR FACTORY TRACK precludes any possibility of *immediate* conveyance to consumers of the nature of Applicant's goods and services. Consequently, the unitary phrase

FACTORY TRACK fails to meet the threshold legal standard for mere descriptiveness, rendering the subject disclaimer requirement untenable. Indeed, a disclaimer requirement based on a phrase that did not exist until its recent coinage by Applicant simply cannot stand. Applicant's mark INFOR FACTORY TRACK thus can only be understood as a unique source identifier for Applicant's goods and services and is therefore unequivocally registrable on the Principal Register in its entirety, without disclaimer. Accordingly, because FACTORY TRACK is unitary and suggestive, Applicant respectfully reiterates its request that the subject disclaimer requirement be withdrawn and that Applicant's mark be approved for publication in its entirety without disclaimer of FACTORY TRACK.

**B. Past P.T.O. Determinations Favor Registration Without Disclaimer.**

Furthermore, Applicant reiterates that directly analogous third-party marks registered on the Principal Register further underscore Applicant's position against descriptiveness of "FACTORY TRACK," including without limitation the numerous registrations attached as Exhibit A to Applicant's Response to Office Action submitted March 23, 2015, as well as the additional third-party registrations submitted herewith as Exhibit C. Like Applicant's mark, these registrations feature marks containing the words "FACTORY" or "TRACK" for identical or highly similar goods and/or services for which no disclaimer of such word was required. Given that the P.T.O. has permitted registration of the foregoing analogous marks on the Principal Register without disclaimer of "FACTORY" or "TRACK" (or a claim of acquired distinctiveness), Applicant's mark INFOR FACTORY TRACK is as deserving, if not more so, of registration without disclaimer. Indeed, while Applicant recognizes that each case

must be decided based on the evidence before the Trademark Office, the P.T.O. has always maintained that consistency in examination is an important, if not crucial, role of the Trademark Office. See In re Litehouse Inc., 82 U.S.P.Q.2d 1471 (T.T.A.B. 2007) (Court encourages the P.T.O. to achieve a uniform standard for assessing registrability of marks); In re Rodale Inc., 80 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 2006) (Board recognized that consistency in examination is a goal of the Trademark Office); In re Finisair Corp., 78 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 2006) (Board recognized that uniform treatment during examination is a goal of the P.T.O.). Thus, to ensure consistent treatment between the subject mark and the above-mentioned analogous registrations in which "FACTORY" and "TRACK" were deemed *not* descriptive, Applicant respectfully reiterates its request that the Examining Attorney withdraw the subject disclaimer requirement and approve Applicant's mark for publication without disclaimer.

Finally, contrary to the Examining Attorney's position, the fact that there exist third-party registrations for allegedly similar software in which the terms FACTORY or TRACK are disclaimed or that are registered on the Supplemental Register does not compel the conclusion that "FACTORY TRACK" is merely descriptive of Applicant's goods and services. Indeed, there are many reasons why marks are registered with disclaimers, on the Supplemental Register, or pursuant to Section 2(f). As the Board explained in In re Serv-A-Portion Inc.:

[Third-party registrations] have no probative value for the purpose urged by the Examining Attorney . . . , i.e. to support his contention that these registrations reflect an office policy as to the nonregistrability of such marks on the Principal Register. The owners of the Supplemental Register registrations may have requested registration on that register merely to secure issuance of the United States registration more quickly, in order to use them in support of applications to register the marks in foreign

countries which require as a condition that an applicant prove prior registration in its country of origin. As for the disclaimer in the Principal Register registration of "Bake N Serv," we do not know whether that registrant contested the disclaimer requirement or acquiesced in it.

1 U.S.P.Q.2d 1915, 1915-16 (T.T.A.B. 1986) (internal citation omitted).

Moreover, the Examining Attorney failed to give due consideration to the numerous third-party registrations on the Principal Register proffered by Applicant for marks containing the terms FACTORY or TRACK without disclaimer thereof for goods and/or services that are identical or highly similar to those of Applicant. To the extent that the third-party registrations made of record by the Examining Attorney have any probative value on the issue of descriptiveness of "FACTORY TRACK," Applicant has clearly rebutted such registrations.

**C. All Doubts Concerning Registration Should Be Resolved in Applicant's Favor.**

Finally, as underscored in Applicant's Response to Office Action submitted March 23, 2015, Applicant reiterates that, where there is doubt as to whether a mark or portion thereof is merely descriptive, the clear weight of authority is to resolve such doubt in favor of the applicant and to publish the mark for opposition. See, e.g., In re Merrill Lynch, Pierce, Fenner, & Smith Inc., 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) ("It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent."); In re Aid Labs., Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983) ("Where there is doubt on the matter, the

doubt should be resolved in applicant's behalf and the mark should be published in accordance with Section 12(c) of the [Lanham] Statute for purposes of opposition."); In re Entenmann's Inc., 15 U.S.P.Q.2d 1750, 1751 n.2 (T.T.A.B. 1990) ("[I]n ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication."). After all, "any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence. . . ." In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972); see also In re The Gracious Lady Serv., Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) ("It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes. . . .").

As the foregoing makes exceedingly clear, the Examining Attorney's position in the instant case is supported neither by the evidence in the record nor by application of the law to the facts. When viewed in context, with the law properly applied to the facts, the purported descriptiveness of "FACTORY TRACK" vanishes in favor of the entire mark's overarching role as a recognizable, unique source identifier for Applicant. See In re Abcor Dev. Corp., 588 F.2d 811, 813 & n.7, 200 U.S.P.Q. 215, 218 & n.7 (C.C.P.A. 1978) ("Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.' . . . This court has indicated that 'merely' means 'only.'"). Ultimately, any ambiguity should be resolved in Applicant's favor, and, contrary to the Examining Attorney's position, Applicant respectfully submits that the record casts significant doubt on the Examining Attorney's

conclusion that FACTORY TRACK is merely descriptive. Consequently, Applicant's mark should be approved for publication without disclaimer.

**II. CONCLUSION**

Whereas Applicant has satisfied the concerns of the Examining Attorney, Applicant respectfully requests that the subject disclaimer requirement be withdrawn and that Applicant's mark be approved for publication in its entirety without disclaimer.

**EVIDENCE SECTION**

EVIDENCE FILE NAME(S)	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_389822016-20151028210601496020_ . Exhibit B - INFOR_FACTORY_TRACK.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (5 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0006.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_389822016-20151028210601496020_ . Exhibit C - INFOR_FACTORY_TRACK.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (7 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0007.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0008.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0009.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0010.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0011.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0012.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\014\86301489\xml9\RFR0013.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	newspaper article; registration certificates for analogous third-party registrations

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Zachary A. Aria/
SIGNATORY'S NAME	Zachary A. Aria
SIGNATORY'S POSITION	Attorney of Record, PA Bar Member
SIGNATORY'S PHONE NUMBER	215-569-5347
DATE SIGNED	10/28/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Oct 28 21:10:42 EDT 2015
TEAS STAMP	USPTO/RFR-38.98.220.16-20 151028211042554187-863014 89-54052915e47f98ccd614d2 e8b7c92405332dc8348536d54 96fc41c687a8b511317e-N/A- N/A-20151028210601496020

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **86301489** INFOR FACTORY TRACK(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86301489/large>) has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

**REQUEST FOR RECONSIDERATION**

In an Office Action issued April 28, 2015, the Examining Attorney maintained and made final her requirement that Applicant disclaim allegedly descriptive matter from its mark INFOR FACTORY TRACK pursuant

to Section 6 of the Lanham Act, 15 U.S.C. § 1056. In response, Applicant hereby submits the following in further support of registration without disclaimer.

**I. NO DISCLAIMER OF "FACTORY TRACK"**

In the Office Action, the Examining Attorney required Applicant to enter a disclaimer of exclusive rights to the phrase "FACTORY TRACK" apart from Applicant's mark as a whole on the basis that it allegedly "describes a feature or characteristic of the applicant's goods and services, namely, the way in which applicant's software is used to track efficiencies in factories in the form of goods and inventory tracking, personnel and equipment." Based on Applicant's previous arguments and evidence, the following supplemental analysis set forth herein, and additional evidence submitted herewith, Applicant respectfully, albeit vigorously, maintains its position that the "FACTORY TRACK" portion of Applicant's coined and unique mark INFOR FACTORY TRACK is unitary and, as used in connection with Applicant's goods and services, is at worst suggestive and simply cannot be found to be merely descriptive of such goods and services. Applicant's mark is therefore undoubtedly registrable on the Principal Register without a disclaimer of "FACTORY TRACK." Accordingly, Applicant respectfully requests that the disclaimer requirement be withdrawn and that the subject mark be approved for publication in its entirety without disclaimer.

**A. "FACTORY TRACK" Is Unitary and Suggestive, Not Merely Descriptive.**

Contrary to the Examining Attorney's position, Applicant emphatically reiterates that, under the appropriate standard set forth in Applicant's Response to Office Action submitted March 23, 2015, and as further explained herein, the "FACTORY TRACK" portion of Applicant's

mark INFOR FACTORY TRACK is not merely descriptive of Applicant's goods and services as it by no means *immediately* describes or conveys knowledge of a significant feature or characteristic of Applicant's software and related services to relevant consumers. Rather, the wording FACTORY TRACK, as used in connection with the applied-for goods and services, is a suggestive, unitary phrase that can be understood only as a unique source identifier for Applicant and therefore requires no disclaimer.

Initially, Applicant respectfully maintains its position that the fusion of "FACTORY" and "TRACK" in Applicant's mark creates a novel, suggestive (and thus non-descriptive), unitary phrase that engenders a distinct commercial impression independent of the individual words "factory" and "track." Indeed, the mental effort that must be employed by consumers to associate the invented phrase FACTORY TRACK with Applicant's goods and services exceeds the minimal degree of imagination, thought, and perception that would be required to recognize the descriptive nature of the discrete words "factory" and "track" as used in respect of such goods and services. This is particularly true here, where Applicant has transformed the verb "TRACK" in the mark into a noun, thus creating a novel and distinctive commercial impression. See generally Henry Hitchens, Those Irritating Verbs-as-Nouns, N.Y. Times, March 30, 2013, available at <[http://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/?\\_r=0](http://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/?_r=0)>, submitted herewith as Exhibit B (describing the transmutation undergone when verbs are used as nouns and the transformative impact such conversion has on readers). Consequently, the creative use of the verb-turned-noun "track," together with the novel union of the words "factory" and "track" in their unique syntax, necessarily requires some degree of thought and imagination to surmise

the nature of Applicant's goods and services. Indeed, the fact that the Examining Attorney had to dissect the FACTORY TRACK portion of Applicant's mark into its constituent elements prior to arriving at her conclusion that the composite is merely descriptive underscores the *suggestive* nature of FACTORY TRACK. While merely descriptive marks (or portions thereof) *immediately* describe the goods or services offered thereunder, suggestive terms require consumers to employ some degree of imagination, thought, or perception before arriving at a conclusion as to the nature of the goods or services. This is the hallmark of suggestive marks.

Moreover, while the Examining Attorney has proffered as evidence definitions of the words "factory" and "track" and evidence of third-party use of those words independently (most of which are non-trademark usages), the record is significantly devoid of any evidence of use of the phrase "FACTORY TRACK" (except that of Applicant), let alone evidence that the novel and unique phrase carries a well-understood and recognized meaning. While consumers of Applicant's goods and services may recognize and understand the individual words "factory" and "track" and ultimately perceive a suggestive connection between FACTORY TRACK and the nature of Applicant's goods and services, they must first engage in at least a minimal amount of reasoning to dissect the phrase "FACTORY TRACK" into its constituent elements, consider the nature and meanings of the individual words and possible meanings of the composite phrase, and subsequently develop an understanding of the phrase "FACTORY TRACK" as applied in the novel context of Applicant's software and related services, rendering it impossible *immediately* to associate FACTORY TRACK with such goods and services. Indeed, absent prior exposure to FACTORY TRACK, it is impossible for consumers *immediately* to recognize the phrase as a descriptor of such goods and services. At worst, the phrase "FACTORY TRACK" may be *suggestive* of Applicant's

goods and services, but it by no means *immediately* conveys knowledge about Applicant's software and related services; rather, any association between the phrase "FACTORY TRACK" and Applicant's goods and services necessitates more than a minimal degree of imagination, thought, or perception before achieving the requisite "mental leap."

As previously explained, Applicant is not attempting to register the words "factory" or "track" separately; rather, Applicant seeks registration of its coined, unitary mark INFOR FACTORY TRACK and the protections that flow from such registration, including the exclusive right to use *that phrase* - FACTORY TRACK - in commerce in connection with Applicant's goods and services. Thus, the question in the subject matter is not whether "factory" and "track" are independently merely descriptive, but rather whether the phrase "FACTORY TRACK," when properly viewed in its entirety, is merely descriptive of Applicant's goods and services. Without evidence to support the Examining Attorney's disclaimer requirement, the Examining Attorney's burden has not been satisfied. Consequently, the disclaimer requirement cannot be maintained.

It cannot be overemphasized that there is no such thing as a "factory track," as underscored by the dearth of evidence of meaning of such phrase in the record. Consequently, Applicant's unusual and novel combination of the words "FACTORY" and "TRACK" creates an inherently distinctive commercial impression that surpasses the respective meanings of the mark's individual components. The trademark significance of INFOR FACTORY TRACK is thus not derived from the individual meanings of "factory" and "track," but rather from the overall suggestive commercial impression engendered by Applicant's mark as a whole. Indeed, in the subject case, the whole is undoubtedly greater than the sum of its parts. Thus, the unitary mark INFOR

FACTORY TRACK is unquestionably a distinguishing mark, no component of which requires a disclaimer.

As the foregoing demonstrates, the FACTORY TRACK portion of Applicant's novel and unique mark INFOR FACTORY TRACK precludes any possibility of *immediate* conveyance to consumers of the nature of Applicant's goods and services. Consequently, the unitary phrase FACTORY TRACK fails to meet the threshold legal standard for mere descriptiveness, rendering the subject disclaimer requirement untenable. Indeed, a disclaimer requirement based on a phrase that did not exist until its recent coinage by Applicant simply cannot stand. Applicant's mark INFOR FACTORY TRACK thus can only be understood as a unique source identifier for Applicant's goods and services and is therefore unequivocally registrable on the Principal Register in its entirety, without disclaimer. Accordingly, because FACTORY TRACK is unitary and suggestive, Applicant respectfully reiterates its request that the subject disclaimer requirement be withdrawn and that Applicant's mark be approved for publication in its entirety without disclaimer of FACTORY TRACK.

**B. Past P.T.O. Determinations Favor Registration Without Disclaimer.**

Furthermore, Applicant reiterates that directly analogous third-party marks registered on the Principal Register further underscore Applicant's position against descriptiveness of "FACTORY TRACK," including without limitation the numerous registrations attached as Exhibit A to Applicant's Response to Office Action submitted March 23, 2015, as well as the additional third-party registrations submitted herewith as Exhibit C. Like Applicant's mark, these registrations feature marks containing the words "FACTORY" or "TRACK" for identical or highly similar goods and/or services for which no disclaimer of such

word was required. Given that the P.T.O. has permitted registration of the foregoing analogous marks on the Principal Register without disclaimer of "FACTORY" or "TRACK" (or a claim of acquired distinctiveness), Applicant's mark INFOR FACTORY TRACK is as deserving, if not more so, of registration without disclaimer. Indeed, while Applicant recognizes that each case must be decided based on the evidence before the Trademark Office, the P.T.O. has always maintained that consistency in examination is an important, if not crucial, role of the Trademark Office. See In re Litehouse Inc., 82 U.S.P.Q.2d 1471 (T.T.A.B. 2007) (Court encourages the P.T.O. to achieve a uniform standard for assessing registrability of marks); In re Rodale Inc., 80 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 2006) (Board recognized that consistency in examination is a goal of the Trademark Office); In re Finisair Corp., 78 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 2006) (Board recognized that uniform treatment during examination is a goal of the P.T.O.). Thus, to ensure consistent treatment between the subject mark and the above-mentioned analogous registrations in which "FACTORY" and "TRACK" were deemed *not* descriptive, Applicant respectfully reiterates its request that the Examining Attorney withdraw the subject disclaimer requirement and approve Applicant's mark for publication without disclaimer.

Finally, contrary to the Examining Attorney's position, the fact that there exist third-party registrations for allegedly similar software in which the terms FACTORY or TRACK are disclaimed or that are registered on the Supplemental Register does not compel the conclusion that "FACTORY TRACK" is merely descriptive of Applicant's goods and services. Indeed, there are many reasons why marks are registered with disclaimers, on the Supplemental Register, or pursuant to Section 2(f). As the Board explained in In re Serv-A-Portion Inc.:

[Third-party registrations] have no probative value for the

purpose urged by the Examining Attorney . . . , i.e. to support his contention that these registrations reflect an office policy as to the nonregistrability of such marks on the Principal Register. The owners of the Supplemental Register registrations may have requested registration on that register merely to secure issuance of the United States registration more quickly, in order to use them in support of applications to register the marks in foreign countries which require as a condition that an applicant prove prior registration in its country of origin. As for the disclaimer in the Principal Register registration of "Bake N Serv," we do not know whether that registrant contested the disclaimer requirement or acquiesced in it.

1 U.S.P.Q.2d 1915, 1915-16 (T.T.A.B. 1986) (internal citation omitted).

Moreover, the Examining Attorney failed to give due consideration to the numerous third-party registrations on the Principal Register proffered by Applicant for marks containing the terms FACTORY or TRACK without disclaimer thereof for goods and/or services that are identical or highly similar to those of Applicant. To the extent that the third-party registrations made of record by the Examining Attorney have any probative value on the issue of descriptiveness of "FACTORY TRACK," Applicant has clearly rebutted such registrations.

**C. All Doubts Concerning Registration Should Be Resolved in Applicant's Favor.**

Finally, as underscored in Applicant's Response to Office Action submitted March 23, 2015, Applicant reiterates that, where there is doubt as to whether a mark or portion thereof is merely descriptive, the clear weight of authority is to resolve such doubt in favor of the applicant and to publish the mark for opposition. See, e.g., In re Merrill Lynch, Pierce, Fenner, & Smith Inc., 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) ("It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice

and precedent."); In re Aid Labs., Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983) ("Where there is doubt on the matter, the doubt should be resolved in applicant's behalf and the mark should be published in accordance with Section 12(c) of the [Lanham] Statute for purposes of opposition."); In re Entenmann's Inc., 15 U.S.P.Q.2d 1750, 1751 n.2 (T.T.A.B. 1990) ("[I]n ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication."). After all, "any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence. . . ." In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972); see also In re The Gracious Lady Serv., Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) ("It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes. . . .").

As the foregoing makes exceedingly clear, the Examining Attorney's position in the instant case is supported neither by the evidence in the record nor by application of the law to the facts. When viewed in context, with the law properly applied to the facts, the purported descriptiveness of "FACTORY TRACK" vanishes in favor of the entire mark's overarching role as a recognizable, unique source identifier for Applicant. See In re Abcor Dev. Corp., 588 F.2d 811, 813 & n.7, 200 U.S.P.Q. 215, 218 & n.7 (C.C.P.A. 1978) ("Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.' . . . This court has indicated that 'merely' means 'only.'"). Ultimately, any ambiguity should be resolved in Applicant's favor, and, contrary to the Examining Attorney's

position, Applicant respectfully submits that the record casts significant doubt on the Examining Attorney's conclusion that FACTORY TRACK is merely descriptive. Consequently, Applicant's mark should be approved for publication without disclaimer.

## **II. CONCLUSION**

Whereas Applicant has satisfied the concerns of the Examining Attorney, Applicant respectfully requests that the subject disclaimer requirement be withdrawn and that Applicant's mark be approved for publication in its entirety without disclaimer.

### **EVIDENCE**

Evidence in the nature of newspaper article; registration certificates for analogous third-party registrations has been attached.

#### **Original PDF file:**

[evi\\_389822016-20151028210601496020 . Exhibit B - INFOR FACTORY TRACK.pdf](#)

#### **Converted PDF file(s) ( 5 pages)**

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

#### **Original PDF file:**

[evi\\_389822016-20151028210601496020 . Exhibit C - INFOR FACTORY TRACK.pdf](#)

#### **Converted PDF file(s) ( 7 pages)**

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /Zachary A. Aria/ Date: 10/28/2015

Signatory's Name: Zachary A. Aria

Signatory's Position: Attorney of Record, PA Bar Member

Signatory's Phone Number: 215-569-5347

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the

highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86301489

Internet Transmission Date: Wed Oct 28 21:10:42 EDT 2015

TEAS Stamp: USPTO/RFR-38.98.220.16-20151028211042554

187-86301489-54052915e47f98ccd614d2e8b7c

92405332dc8348536d5496fc41c687a8b511317e

-N/A-N/A-20151028210601496020

# EXHIBIT B

**The New York Times**

## The Opinion Pages

DRAFT

# Those Irritating Verbs-as-Nouns

By **Henry Hitchings** March 30, 2013 3:09 pm

Draft is a series about the art and craft of writing.

“Do you have a solve for this problem?” “Let’s all focus on the build.” “That’s the take-away from today’s seminar.” Or, to quote a song that was recently a No. 1 hit in Britain, “Would you let me see beneath your beautiful?”

If you find these sentences annoying, you are not alone. Each contains an example of nominalization: a word we are used to encountering as a verb or adjective that has been transmuted into a noun. Many of us dislike reading or hearing clusters of such nouns, and associate them with legalese, bureaucracy, corporate jive, advertising or the more hollow kinds of academic prose. Writing packed with nominalizations is commonly regarded as slovenly, obfuscatory, pretentious or merely ugly.

There are two types of nominalization. Type A involves a morphological change, namely suffixation: the verb “to investigate” produces the noun “investigation,” and “to nominalize” yields “nominalization.”

Type B is known as “zero derivation” — or, more straightforwardly, “conversion.” This is what has taken place in my opening illustrations: a word has been switched from verb into noun (or, in the last two cases, from adjective into noun), without the addition of a suffix.

Plenty of teachers discourage heavy use of the first type of nominalization. Students are urged to turn nouns of this kind back into verbs, as if undoing a conjurer's temporary hoax. On this principle, "The violence was Ted's retaliation for years of abuse" is better rendered as "Ted retaliated violently after years of abuse."

The argument for doing this is that the first version is weaker: dynamic writing makes use of "stronger" verbs. Yet in practice there are times when we may want to phrase a matter in a way that is not so dynamic. Perhaps we feel the need to be tactful or cautious, to avoid emotiveness or the most naked kind of assertion. Type A nominalization can afford us flexibility as we try to structure what we say. It can also help us accentuate the main point we want to get across. Sure, it can be clunky, but sometimes it can be trenchant.

On the whole, it is Type B nominalization that really grates. "How can anybody use 'sequester' as a noun?" asks a friend. "The word is 'sequestration,' and if you say anything else you should be defenestrated."

"I'll look forward to the defenestrate," I say, and he calls me something I'd sooner not repeat.

Even in the face of such opprobrium, people continue to redeploy verbs as nouns. I am less interested in demonizing this than in thinking about the psychology behind what they are doing.

Why say "solve" rather than "solution"? One answer is that it gives an impression of freshness, by avoiding an everyday word. To some, "I have a solve" will sound jauntier and more pragmatic than "I have a solution." It's also more concise and less obviously Latinate (though the root of "solve" is the Latin *solvere*).

These aren't necessarily virtues, but they can be. If I speak of "the magician's reveal" rather than of "the magician's moment of revelation," I am evoking the thrill of this sudden unveiling or disclosure. The more traditional version is less immediate.

Using a Type B nominalization may also seem humorous and vivid. Thus, compare "that was an epic fail" (Type B nominalization), "that was an epic failure" (Type A nominalization) and "they failed to an epic degree" (neither).

There are other reasons for favoring nominalizations. They can have a distancing effect. “What is the ask?” is less personal than “What are they asking?” This form of words may improve our chances of eliciting a more objective response. It can also turn something amorphous into a discrete conceptual unit, of a kind that is easier to grasp or sounds more specific. Whatever I think of “what is the ask?” it focuses me on what’s at stake.

Some regard unwieldy nominalizations as alarming evidence of the depraved zeitgeist. But the phenomenon itself is hardly new. For instance, “solve” as a noun is found in the 18th century, and the noun “fail” is older than “failure” (which effectively supplanted it).

“Reveal” has been used as a noun since the 16th century. Even in its narrow broadcasting context, as a term for the final revelation at the end of a show, it has been around since the 1950s.

“Ask” has been used as a noun for a thousand years — though the way we most often encounter it today, with a modifier (“a big ask”), is a 1980s development.

It is easy to decry nominalization. I don’t feel that a writer is doing me any favors when he expresses himself thus: “The successful implementation of the scheme was a validation of the exertions involved in its conception.” There are crisper ways to say this. And yes, while we’re about it, I don’t actually care for “Do you have a solve?”

Still, it is simplistic to have a blanket policy of avoiding and condemning nominalizations. Even when critics couch their antipathy in a language of clinical reasonableness, they are expressing an aesthetic judgment.

Aesthetics will always play a part in the decisions we make about how to express ourselves — and in our assessment of other people’s expression — but sometimes we need to do things that are aesthetically unpleasant in order to achieve other effects, be they polemical or diplomatic.

---

*Henry Hitchings is the author of three books exploring language and history, including, most recently, “The Language Wars.”*

A version of this article appears in print on 03/31/2013, on page SR9 of the New York edition with the headline: Those Irritating Verbs-as-Nouns.

---

© 2015 The New York Times Company

# EXHIBIT C

**United States of America**  
United States Patent and Trademark Office

# DIGI.TRACK

**Reg. No. 4,612,623**

**Registered Sep. 30, 2014**

**Int. Cls.: 9 and 35**

**TRADEMARK**

**SERVICE MARK**

**PRINCIPAL REGISTER**

DIGITAL FLEET, LLC (ILLINOIS LIMITED LIABILITY COMPANY), DBA DIGITAL FLEET  
SUITE H  
440 QUADRANGLE DRIVE  
BOLINGBROOK, IL 60440

FOR: COMPUTER SOFTWARE AND HARDWARE FOR GEOSYNCHRONOUS POSITIONING, LOCATING, DISPATCHING AND FOLLOWING THE PROGRESS OF VEHICLES, VEHICLE LOGISTICS AND ADMINISTRATIVE ISSUES RELATING TO LOCAL AND OVER-THE-ROAD TRUCKS, NAMELY, ADMINISTRATIVE ISSUES RELATING TO COMMUNICATING INFORMATION ABOUT THE VEHICLE'S CONDITION AND ACTIONS OCCURRING ON OR ABOUT THE VEHICLE, AND TO ELECTRONIC COMMUNICATION BETWEEN THE VEHICLE OPERATOR AND A DISPATCHING LOCATION; NOT FOR USE IN HOSPITALS OR HEALTHCARE FACILITIES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 12-10-2012; IN COMMERCE 12-10-2012.

FOR: PROVIDING AN ON-LINE COMPUTER DATABASE FOR THE REPORTING AND TRACKING OF VEHICLE AND BOAT MOVES AND LOCATION FOR BUSINESS PURPOSES; PROVIDING TRACKING SERVICES AND INFORMATION CONCERNING TRACKING OF ASSETS IN TRANSIT, NAMELY, VEHICLES, TRAILERS, DRIVERS, CARGO AND DELIVERY CONTAINERS FOR BUSINESS INVENTORY PURPOSES; NOT FOR USE IN HOSPITALS OR HEALTHCARE FACILITIES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-10-2012; IN COMMERCE 12-10-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 86-111,522, FILED 11-6-2013.

SAMUEL E. SHARPER JR., EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**United States of America**  
United States Patent and Trademark Office

# ACA-TRACK

**Reg. No. 4,831,401**

**Registered Oct. 13, 2015**

**Int. Cls.: 9 and 42**

**TRADEMARK**

**SERVICE MARK**

**PRINCIPAL REGISTER**

PROFESSIONAL SYSTEMS, SOFTWARE AND TECHNOLOGY, LLC (KENTUCKY LIMITED LIABILITY COMPANY), DBA PSST, LLC  
303 MIDDLETOWN PARK PLACE, SUITE B  
LOUISVILLE, KY 40243

FOR: COMPUTER SOFTWARE FOR USE IN HUMAN RESOURCES MANAGEMENT AND FOR STATUTORY AND REGULATORY COMPLIANCE AND REPORT GENERATION IN THE FIELD OF HEALTH INSURANCE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 11-0-2013; IN COMMERCE 11-0-2013.

FOR: PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE SOFTWARE FOR FOR USE IN HUMAN RESOURCES MANAGEMENT, AND FOR STATUTORY AND REGULATORY COMPLIANCE AND REPORT GENERATION IN THE FIELD OF HEALTH INSURANCE, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 11-3-2014; IN COMMERCE 11-3-2014.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 86-554,631, FILED 3-5-2015.

CHRISTOPHER LAW, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

**NOTE:** A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

**United States of America**  
United States Patent and Trademark Office



ACA-Track

**Reg. No. 4,831,405**

**Registered Oct. 13, 2015**

**Int. Cls.: 9 and 42**

**TRADEMARK**

**SERVICE MARK**

**PRINCIPAL REGISTER**

PROFESSIONAL SYSTEMS, SOFTWARE AND TECHNOLOGY, LLC (KENTUCKY LIMITED LIABILITY COMPANY), DBA PSST, LLC  
303 MIDDLETOWN PARK PLACE, SUITE B  
LOUISVILLE, KY 40243

FOR: COMPUTER SOFTWARE FOR USE IN HUMAN RESOURCES MANAGEMENT AND FOR STATUTORY AND REGULATORY COMPLIANCE AND REPORT GENERATION IN THE FIELD OF HEALTH INSURANCE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 2-27-2015; IN COMMERCE 2-27-2015.

FOR: PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE SOFTWARE FOR FOR USE IN HUMAN RESOURCES MANAGEMENT, AND FOR STATUTORY AND REGULATORY COMPLIANCE AND REPORT GENERATION IN THE FIELD OF HEALTH INSURANCE, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 2-27-2015; IN COMMERCE 2-27-2015.

THE MARK CONSISTS OF THE WORDING "ACA-TRACK" ABOVE WHICH APPEARS THE DESIGN OF TWO OVERLAPPING DOUBLE ARCHES IN CONTRASTING TONES.

SER. NO. 86-554,657, FILED 3-5-2015.

CHRISTOPHER LAW, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\* See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**