IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Miscellaneous Ex parte

Applicant	:	New York Stock Exchange, Inc.
Mark	:	TRACK THE MARKET
Serial No.	:	76/574,196
Filing Date	:	February 5, 2004
Examining Attorney	:	Gwen P. Stokols
Law Office:	:	102

RESPONSE AFTER FINAL OFFICE ACTION AND REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

To The Commissioner For Trademarks:

Applicant respectfully responds to the Office Action dated April 11, 2005, as follows:

I. APPLICANT'S MARK PROPERLY FUNCTIONS AS A TRADEMARK

The Examining Attorney has maintained its refusal of the subject mark on the grounds that it allegedly is (i) merely an informational slogan and does not function as a source identifier, and (2) merely descriptive of the identified services. Applicant respectfully disagrees with the Examining Attorney.

Applicant's mark is not merely an informational slogan or merely descriptive. Rather, as shown in the specimens submitted to date, it is properly used as a trademark to identify the source of the services provided therewith. Indeed, the mark appears on the

specimens in a prominent manner, in bold font and with the "sm" symbol indicating that Applicant claims trademark rights therein.

Moreover, even if the mark is correctly characterized as a "slogan", which Applicant submits it should not, it is well established that a slogan can nevertheless function as a trademark. See e.g., Roux Laboratories, Inc. v. Clairol, Inc., 427 F.2d 823, 166 U.S.P.Q. 34 (C.C.P.A. 1970) (holding that the slogan HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE used on hair tinting preparations registrable on the Principal Register, rejecting opposer's contention that the slogan was generic and incapable of achieving any trademark significance); In re Hallicrafters Co., 153 U.S.P.Q. 376 (T.T.A.B. 1967) (holding that the slogan QUALITY THROUGH CRAFTSMANSHIP for radio receivers is not "so highly laudatory or trite" as to be incapable of functioning as a mark); In re McDonald's Corp., 199 U.S.P.Q. 490 (T.T.A.B. 1978) (finding the slogan TWO ALL BEEF PATTIES SPECIAL SAUCE LETTUCE CHEESE PICKLES ONIONS ON A SESAME SEED BUN to have secondary meaning and registrable on the Principal Register); In re Sottile, 156 U.S.P.Q. 655 (T.T.A.B. 1968) (holding the slogan YOUR FINANCIAL SECURITY IS OUT BUSINESS for insurance planning services to be suggestive, non-descriptive mark eligible for registration).

As asserted in Applicant's Response to Office Action dated March 1, 2005, Applicant's mark is not merely descriptive, but is suggestive of a feature or characteristic of Applicant's services. *Merriam Webster's Collegiate Dictionary*, Tenth Edition (1997) indicates that numerous definitions can be attributed to the term "market". In the context of Applicant's listed services and the securities industry in which Applicant operates, several of the listed definitions are relevant, including: (1) a meeting together of people for the purpose of trade by private purchase and sale; (2) a geographical area of demand for commodities (i.e., the European

Market); or (3) demand of commodities itself. See Declaration of Robert M. Wasnofski, Jr. ¶ 2, Ex. 1 submitted with March 1, 2005 Response.

As the world's leading securities market, consumers are not able to reach a conclusion as to just what type of services and information Applicant is providing in connection with the subject mark. For example, the mark itself does not make clear whether Applicant is providing information about particular *geographic markets* (i.e., the European Market), the *demand* for certain individual securities, or the demand for industry specific indexes (i.e., the Energy Market).

Since Applicant's mark can be understood to have multiple commercial impressions, the reasonably prudent consumer will be required to take more than one logical step to arrive at a precise conclusion as to the particular services provided by Applicant. See, e.g., In re Kopy Kat, Inc., 182 U.S.P.Q. 372, 373 (CCPA 1974) (holding "[t]he slogan [WE PRINT-IT IN A MIN-IT] is, obviously, highly suggestive of speed with respect to some kind of printing service, but one cannot tell what kind. It could be printing photographs, or printing with type, or making photostatic, xerographic, lithographic, photo offset, or other copies.")(citations omitted).

Here, similarly, it is not clear from Applicant's mark just what type of services Applicant provides in connection with said mark. Accordingly, it is respectfully submitted that the mark TRACK THE MARKET is not an informational slogan and does not directly or immediately describe Applicant's services, but rather requires imagination, thought and perception to reach a clear conclusion as to its particular services.

II. AMENDMENT OF THE APPLICATION TO THE SUPPLEMENTAL REGISTER

In the event that the Examining Attorney maintains the refusal, in the alternative, Applicant respectfully requests that the application be amended to seek registration on the

Supplemental Register and that all references in the instant application to "Principal Register" be amended to "Supplemental Register". T.M.E.P. §816 et. seq.

III. NOTICE OF APPEAL

Applicant notes that on this date it has filed a Notice of Appeal to the Trademark Trial and Appeal Board with a request that the appeal be suspended pending consideration of this Request for Reconsideration. A copy of the Notice of Appeal as filed is attached hereto.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register. Prompt and favorable action is respectfully requested.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: October 11, 2005

By: Robert M. Wasnofski, Jr.

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Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Trademarks, P.O. Box 1451 Alexandria, VA 22313-1451, on

Date of Deposit : October 11, 2005

Signature : Robert M. Wasnofski, Jr.

Name : Robert M. Wasnofski, Jr.

Noda, Masa

From: estta-server@uspto.gov
Sent: Tuesday, October 11, 2005 12:23 PM
To: Wasnofski, Robert M.; Trademark Dept, New York City
Subject: ESTTA. Notice of Appeal. confirmation receipt ID: ESTTA48006

Notice of Appeal.

Tracking No: ESTTA48006

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

We have received your Notice of Appeal. submitted through the Trademark Trial and Appeal Board's ESTTA electronic filing system. This is the only receipt which will be sent for this paper. If the Board later determines that your submission is inappropriate and should not have been accepted through ESTTA, you will receive notification and appropriate action will be taken.

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ESTTA Tracking number: ESTTA48006
Filing date: 10/11/2005

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

Application Serial No.:76574196
Applicant: New York Stock Exchange, Inc.

Notice of Appeal

Notice is hereby given that appeal to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 76574196.

Applicant has filed a request for reconsideration of the refusal to register, and requestssuspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:
IC 036

Respectfully submitted,
ROBERT M. WASNOFSKI, JR.
/rmw/
10/11/2005
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