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Sent: 6/16/2016 1:45:38 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86496091 - ICE SWAP RATE - IBL-14-2443 - SU - Request for Reconsideration Denied - Return to TTAB

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Files: 86496091.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86496091

MARK: ICE SWAP RATE



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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Intercontinental Exchange Holdings, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

IBL-14-2443

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 6/16/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated 12/1/2015 are maintained and continue to be final: Failure to Function as a Trademark/Service Mark (Classes 16, 35, 36, 38, 41, 42); Refusal under Sections 1 and 45 for Classes 9 and 16, for failure to show use in commerce with the identified goods, and for not being goods in trade. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

REFUSAL UNDER SECTIONS 1, 2 and 45: FAILURE TO FUNCTION AS A SERVICE MARK (Classes 35, 36, 38, 41, 42)

Registration is refused because the applied-for mark, as used on the specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; see *In re Moody's Investors Serv., Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re The Signal Cos.*, 228 USPQ 956 (TTAB 1986); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984); TMEP §§904.07(b), 1301.02 *et seq.*

The applied-for mark, as shown on the specimen, does not function as a service mark because it is clearly not functioning in commerce as a **source of these services**, but rather, instead identifies a particular methodology – specifically, a type of market swap rate.

Merely because applicant's services list "calculation" as a service does not automatically render any wording associated with a calculation into a service mark in commerce. To be considered a service mark, the proposed mark must be viewed – ultimately – as a **source** of such calculation services, not merely as the name given to the *calculation itself*. Not every word, design, symbol or slogan used in the advertising

or performance of services functions as a mark, **even though it may have been adopted with the intent to do so**. See TMEP §1301.02. A designation cannot be registered unless purchasers would be likely to regard it as a source-indicator for the services. *Id.*; see *In re Moody's Investors Serv. Inc.*, 13 USPQ2d 2043, 2047-49 (TTAB 1989).

The Applicant themselves, in their request for reconsideration, refers to the mark as a “calculated rate price.” This is a *thing* provided to customers, a calculation which has been given a name, but it does not identify the *source of such calculation services* in any way. A consumer would not be likely to view the mark as used on the specimens of record as a source of services, but merely as the title given to a single *type* of calculation.

This is not, as applicant claims, evidence that the mark is being used in the *rendering or performing* of the services. Applicant, further, mis-cites to the section of the TMEP from which this assertion arises. Section 1301.04(b) merely states, in full, that “a service-mark specimen must show the mark used or displayed in connection with a registrable service offered for the benefit of others.” Rather, it is TMEP Section 1301.04(e) which most clearly speaks to the circumstances here, in which it is outlined that registration must be refused if, for example, the specimen shows the mark serves *solely* as a trade name, only as the name of a computer software program or application, *exclusively* as the name of a method, process, or system, or merely as informational or ornamental matter. See *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973) (“The requirement that a mark must be ‘used in the sale or advertising of services’ to be registered as a service mark is clear and specific. **We think it is not met by evidence which only shows use of the mark as the name of a process and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used.** The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.”); *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1669 (TTAB 2010) (finding that, although the submitted specimens referenced the identified consulting services, the applied-for mark, as used on the specimens, would be perceived by the relevant public as identifying only applicant’s drug technology and thus the specimens failed to establish the required association between the mark and the identified services); *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1625-26 (TTAB 2008) (finding the submitted specimen unacceptable evidence of use of the mark in connection with custom manufacturing services because it did not show an association between the mark and the services, but instead the mark was used only to refer to computer software) (**bold emphasis added by the examiner**).

This line of caselaw is *incredibly* relevant and applicable here. Specifically, the TTAB in the aforementioned cases notes extensively and explicitly that a mark is being utilized only as the *name* of something, rather than as a *source of services in commerce*, refusal is proper.

Here, the proposed mark ICE SWAP RATE is not a *source* of services in commerce, but rather, is the specific title given to a specific type of calculation – while never appearing as a *source for calculation services* in commerce, as would be required to demonstrate trademark usage.

The Applicant has previously claimed the examining attorney failed to address the term ICE, indicating applicant has failed to grasp the nature of this refusal. The examining attorney is not stating that the proposed mark is descriptive, or that the proposed mark contains no distinctive matter – this refusal specifically addresses **how** a proposed mark is utilized in a specimen to determine whether the proposed mark is being utilized in the manner of a service mark. Specifically, a service mark must show use in such a manner that a consumer, viewing it, would understand the proposed mark to identify a *source for services in commerce*.

Applicant's specimens do not show such usage. The specimens submitted make this distinction abundantly clear with how it references the applied-for mark. For example, on the first page of the previously submitted press release, the release states "IBA transitioned ICE Swap Rate from a submission based **rate** using inputs from panel banks to a benchmark calculated from tradable quotes." Further along, it states "ICE Swap Rate represents the average mid-market swap rate for three major currencies." On the second page, the release makes it abundantly clear that ICE Swap Rate is not a source of services because it refers to it as "[t]he new methodology." A method or approach to conducting business does not show trademark usage if it is not also the source for such services. The mark ICE Swap Rate, in this case, is a *rate*, or at the very least a *thing*, and not the source from which these services are being provided. Rather, it appears that ICE Swap Rate is the rate *used* in calculating and factoring such services. This is not trademark usage, however. Instead, a consumer would perceive this merely as the name given to a methodology rather than the *source* of Applicant's Class 35, 36, 38, 41, 42 services. It is **irrelevant** that a consumer would know this proposed mark to be utilized only by the Applicant – it is, instead, relevant that the mark always identifies a *thing* rather than a *source of services* offered **independently** of the software/hardware calculating such a rate.

Applicant's second round specimen, for example, states that "ICE Swap Rate is calculated by working out the mid-price you would get if you were to fill a trade of Standard Market Size using the best prices available..."

The grammatical composition of this sentence renders "ICE SWAP RATE" a *thing* – it is **calculated** – rather than a **source for services or goods in the marketplace**. By its very designation as an article, it is not serving as a source for services.

The specimen also states that “ICE Swap Rate... is recognized as the principal global benchmark for swap rates.” Thus, once again, applicant is incorrect – this is not a mark identifying the *source* of services. Rather, ICE SWAP RATE identifies a benchmark *type of swap rate*. It is not a source, it is a thing. At most, it could still be a type of good, but it is not identifying a source for services in the marketplace. Indeed, Applicant’s new specimen on Page 1 goes on to specifically state “ICE SWAP RATE is a regulated benchmark under the rules of the Financial Conduct Authority and has been designed to be fully compliant with the IOSCO Principles for Financial Benchmarks.”

Applicant’s new specimens are no better, with Page 1 referring to “Calculation of ICE Swap Rate,” “The ICE Swap Rate benchmark, etc.,” Page 2 stating “Quality-weight the remaining snapshots... to give the ICE Swap Rate,” Page 7 noting “Summing the weighted VWAMP’s gives the final ICE Swap Rate,” and so forth. Page 12 of the specimens (Page 1 of “ICE Benchmark Administration”) even states that one can apply “the use of ICE Swap Rate as a data input or reference rate.” A *rate* – not a source of services in commerce.

The specimen of record, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a service mark. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998).

Here, a purchaser is unlikely to view “ICE Swap Rate” as an indicator of the **source** of services. Therefore, it fails to function as a service mark in commerce for applicant’s identified service classes.

Applicant may respond to this refusal by submitting the following:

- (1) A substitute specimen showing the mark in use in commerce for the services specified in the application for others; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** 37 C.F.R. §2.59(a); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. See TMEP §§1301.04 *et seq.*

Applicant may respond to this refusal by submitting a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the services identified in the statement of use.

Applicant, however, may not withdraw the statement of use. See 37 C.F.R. §2.88(g); TMEP §1109.17.

For more information about this refusal and instructions on how to submit a verified “substitute” specimen online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

SPECIMEN REFUSAL – CLASS 9

Applicant’s class 9 goods are “equipment and apparatus, namely, computer hardware and computer software” which are listed as performing a wide variety of tasks.

Applicant's new specimen does not show the wording ICE SWAP RATE anywhere on the screenshot, only the wording ICE SWAP TRADE. Thus, the specimen still fails to show an association between the mark and the goods. Further, Applicant is advised that the refusal applied to the service classes above would be *as likely* to be applied to Class 9 goods should there be no clear use of the mark as a trademark, but only as a calculation identifier.

Finally, as Applicant argues once again in favor of their previous specimen, the examiner notes that the prior Class 9 specimen failed to make any association between the mark and these goods. Specifically, it is a *clear requirement* of the trademark act that a mark in commerce, for computer hardware as a good, must be shown in association with the goods themselves. Nowhere in Applicant's offered Class 9 specimens is there hardware offered for sale, nor does the mark appear emblazoned on said hardware anywhere in the specimens of use. Although webpages *may* be acceptable specimens of use, it is established law and precedent that such a webpage must **both** include a picture or textual description of the goods associated with the mark **and the means to order the goods**. TMEP §904.03(i). Nowhere in the specimens of use is *computer hardware* offered for sale, nor is there any indication it may be purchased.

With respect to the Class 9 software, the requirements for a specimen are even more stringent. Specifically, applicant's previous specimens in this case appear to be mere advertising material; thus, the specimen fails to show the applied-for mark in use in commerce for each international class. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

A specimen for software **must** create an association between the mark and the software, as well as provide the means to enable the user to **download or purchase the software from the website**. See *In re Sones*, 590 F.3d 1282, 1286-89, 93 USPQ2d 1118, 1122-24 (Fed. Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957 (TTAB 2012); TMEP §§904.03(e), (i) *et seq.* Without this feature, the specimen is mere advertising material, which is not acceptable as a specimen to show use in commerce for goods. See *In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006); *In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997); TMEP §904.04(b), (c).

Examples of specimens for software include instruction manuals and screen printouts from (1) web pages showing the mark **in connection with ordering or purchasing information** or information sufficient to download the software, (2) the actual program that shows the mark in the title bar, or (3) launch screens that show the mark in an introductory message box that appears after opening the program. See TMEP §904.03(e), (i), (j). Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. See *In re Sones*, 590 F.3d at 1286-89, 93 USPQ2d at 1122-24; *In re Azteca Sys., Inc.*, 102 USPQ2d at 1957; TMEP §§904.03(i) *et seq.*

Thus, on the whole, Applicant's specimens are not acceptable to show use with these Class 9 hardware and software goods.

Applicant may respond to this refusal by submitting, for each applicable international class, a different specimen (a verified "[substitute specimen](#)") that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the software identified in the statement of use.

Applicant, however, may not withdraw the statement of use. See 37 C.F.R. §2.88(f); TMEP §1109.17.

For more information about this refusal and instructions on how to submit a verified "substitute" specimen online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

SPECIMEN REFUSALS – CLASS 16

No Use in Commerce

Finally, nowhere in Applicant's specimens are Class 16 goods offered **for sale in commerce** – there is nowhere that these physical goods appear in association with the mark and with the means to purchase them. Further, it appears from Applicant's own application and specimens that these manuals may be intended to *explain the use of Applicant's Class 9 software and hardware*. As such, these Class 16 goods would **not be considered goods in trade**.

To determine whether goods are goods in trade, the three relevant factors are whether the proffered specimen is an item that (1) is simply the conduit or necessary tool useful only to obtain applicant's primary goods or services; (2) is so inextricably tied to and associated with applicant's primary goods or service as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from applicant's primary goods or services. *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381-82, 103 U.S.P.Q.2d 1672, 1676 (Fed. Cir. 2012).

Thus, in this case, it appears that Applicant's Class 16 goods may very well only be useful in association with Applicant's Class 9 goods, and have no usefulness beyond such goods.

Applicant is advised of a recent decision out of the Trademark Trial and Appeal Board, *In re Apple, Inc.*, Serial No. 78521891 (November 13, 2015), in which Apple was seeking to register "IPOD" for "Printed materials and publications, namely, brochures, pamphlets, and leaflets, all relating to computer software, computer hardware, and multimedia apparatus and instruments and sold or distributed in connection with handheld mobile digital media devices." The Board held that in order to be goods in trade, goods must have "independent, intrinsic value," and it is not clear from Applicant's specimens that these goods have such a function. Rather, these conceivably are merely manuals for the use of Applicant's software/hardware, and thus not offered in commerce beyond such goods, and so inextricably tied to said goods as to serve no alternative purpose or usefulness.

No Trademark Usage

Finally, the new specimens for Class 16 do not show trademark usage on the goods. Specifically, as better outlined previously in the specimen refusals for Applicant's service classes, the specimen in Class 16 submitted in the request for reconsideration only shows use of the proposed mark – ICE Swap Rate – as a *specific calculation* and not as a *source of goods*. It specifically states "Calculation of ICE Swap Rate from Tradeable Quotes" as the title of the document associated with Class 16, and no where does it appear used as a *source* for such Class 16 documents, *even if* such documents were presumed to be acceptable as goods in trade (which, as discussed above, they do not appear to be.)

Applicant may respond to this refusal by submitting, for each applicable international class, a different specimen (a verified ["substitute" specimen](#)) that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the software identified in the statement of use.

Applicant, however, may not withdraw the statement of use. *See* 37 C.F.R. §2.88(f); TMEP §1109.17.

For more information about this refusal and instructions on how to submit a verified “substitute” specimen online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

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