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

Proceeding	86906610
Applicant	Central Dynamics, LLC
Applied for Mark	ECONCIERGE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Serial No.	86/906,610
Mark:	ECONCIERGE
Applicant:	Central Dynamics, LLC
Examining Attorney:	Ryan Cianci Law Office 116

APPLICANT'S *EX PARTE* REPLY BRIEF

ARGUMENT

Applicant Central Dynamics, LLC appeals the Examining Attorney's refusal to register Applicant's word mark ECONCIERGE in Application Serial No. 86/906,610 ("the Application"). The Examining Attorney's refusal on the grounds that Applicant's ECONCIERGE mark is generic is not supported by the requisite clear and convincing evidence and is inconsistent with the evidence that is in the record. Moreover, the Examining Attorney has improperly discounted Applicant's evidence of acquired distinctiveness.

I. The ECONCIERGE Mark is NOT Generic

The Examining Attorney's genericness rejection rests largely on the flawed proposition that the relevant public for Applicant's services comprises ordinary consumers. This conclusion is inconsistent with Applicant's recitation of services as well as the evidence that is in the record. As set forth in Applicant's Appeal Brief, Applicant uses its ECONCIERGE mark in connection with:

> Platform as a service (PAAS) featuring computer software platforms **for** hotels, resorts, casinos, hospitality and transportation **providers to communicate with and support** guests before, during and after stays regarding preferences, profiles, planning and management of stays, dining, transportation and activities; providing temporary use of online non-downloadable software for hotels, resorts, casinos, hospitality and transportation providers to communicate with and support guests before, during and after stays regarding preferences, profiles, planning and management of stays, dining, transportation and activities.

Contrary to the Examining Attorney's assertion, Applicant's Appeal Brief did not omit any portion of its recitation in order to mislead the Board. After presenting the entire recitation, Applicant draws the Board's attention to the language in the recitation that specifically enumerates the relevant public for Applicant's services, namely, "hotels, resorts, casinos, hospitality and transportation providers," which are professionals in the hospitality industry. It is

noteworthy that this portion of the recitation does not include "guests," because they are simply not part of Applicant's customer base and therefore not part of the relevant public for Applicant's ECONCIERGE branded services. The latter portion of the recitation sets forth what the services permit the relevant professionals in the hospitality industry to do, which is "to communicate with and support guests before, during and after stays regarding preferences, profiles, planning and management of stays, dining, transportation and activities."

The Examining Attorney's assertion that "the relevant public comprises ordinary consumers, because the purpose of applicant's software is used by anyone receiving hospitality services" is incorrect. The Federal Circuit has explained that "the test for genericness the primary significance of the mark to **the relevant public limited to actual or potential purchasers of the goods or services**." *Magic Wand, Inc., v. RDB, Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991) (emphasis added); *see also In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342 (Fed. Cir. 2014). The fact that professionals in the hospitality industry use Applicant's services to provide downstream services to their guests does not mean that guests are part of the relevant public for Applicant's services. Further, a guest's use or interaction with aspects of Applicant's services provided through a hospitality provider does not change the analysis. Does a guest's use of fresh towels or linens in their hotel room make them part of the relevant public for a company providing cleaning services to the hotel? The obvious answer is no.

The evidence from Applicant's website that is highlighted by the Examining Attorney further supports the foregoing. The excerpts quoted by the Examining Attorney are clearly directed toward hospitality industry professionals, to wit: "eConcierge allows guests to customize their experience at **your property**…" and "[e]mpower **your guests** to customize their pre-stay itinerary…" Furthermore, the evidence submitted by Applicant makes clear that the

relevant public consists of professionals in the hospitality industry. For example, the Declaration of Michael Bennett (May 4, 2017, Response to Office Action, TSDR pp. 2-56; hereinafter "Bennett") states that Applicant's specialized software services branded under the ECONCIERGE mark are used by over 30,000 hotel clients around the world such as Marriott, Hyatt, and Hilton, and that "relevant consumers for Cendyn's software services presented with Cendyn's brands… include executives, managers, and other business decision makers for hospitality service providers such as hotels, resorts, casinos, transportation providers, and restaurants." Bennett at ¶¶ 15-16. In addition, the articles submitted as evidence by Applicant as Exhibits B, C, D, and E to the Bennett Declaration all include quotes from hospitality industry professionals referencing Applicant's ECONCIERGE branded services.

With regard to the genus of the services at issue, Applicant maintains that the recitation of services speaks for itself and is much broader in scope than the concierge activities according to the Examining Attorney's evidence. The Examining Attorney's assertion that "if the applicant's services are broader than the dictionary definitions, then its services inherently include the services mentioned in the dictionary definitions" is incompatible with the correct analysis. A broader scope of services dilutes the relevance of the dictionary evidence, and therefore the reliance on this evidence results in an inappropriate identification of the genus for the genericness analysis.

Thus, the Examining Attorney's genericness analysis is flawed because it misconstrues the relevant public and fails to properly determine the genus of Applicant's services. As set forth in Applicant's Appeal Brief, the evidence of record does not demonstrate that the term econcierge is being used as the name of Applicant's specific recited services or that the relevant hospitality industry professionals understand the term econcierge to refer to Applicant's services.

Consequently, the Examining Attorney has failed to meet the heavy burden of showing that Applicant's mark is generic by clear and convincing evidence, and Applicant respectfully requests that the Board withdraw this refusal.

II. The ECONCIERGE Mark has Acquired Distinctiveness

The Examining Attorney rejects Applicant's claim of acquired distinctiveness and contends that the evidence submitted by Applicant is insufficient because it is biased and lacks context. As a preliminary matter, Applicant notes that the instant appeal for ECONCIERGE was filed concurrently with an ex-parte appeal for Applicant's ECONNECTIVITY mark (U.S. Serial No. 86/851,903) wherein the Examining Attorney also rejected Applicant's claim of acquired distinctiveness. Applicant's evidence of acquired distinctiveness in both instances was substantially similar and provided via the Declaration of Michael Bennett, and the Examining Attorney has since withdrawn the rejection and approved the ECONNECTIVITY mark for publication.

In the instant appeal for ECONCIERGE, the Examining Attorney contends that the Bennett Declaration "is entitled to little weight because his declaration is self-serving." However, the Examining Attorney ignores the fact that Mr. Bennett had significant experience as a professional in the hospitality industry prior to joining Applicant and that Mr. Bennett testified that "prior to joining Cendyn, I had knowledge of Cendyn's software products and recognized ECONCIERGE, ESURVEY, ECONNECTIVITY, EPROPOSAL, EMENUS, and EBROCHURE as identifying each of their respective software products/services." Bennett at 7. In the absence of any evidence of bias, the Board should consider and give weight to the uncontroverted facts set forth in a declaration. *See Kellog Co. v. General Mills, Inc.*, 82 USPQ2d 1766 (TTAB 2007) (precedential decision finding that facts set forth in trademark counsel's

declaration were relevant to claim of acquired distinctiveness in the absence of evidence of bias).[1]

With regard to Applicant's sales figures, the Examining Attorney states that lack of industry context precludes a determination of their significance. Notwithstanding the alleged lack of context, the Examining Attorney somehow concludes that "sales of less than a million dollars and marketing budget of $5,000 dollars is minimal and does not establish consumers will identify the proposed mark as a source-identifier." First, Applicant notes that the total sales over the five-year period that are attributable to ECONCIERGE branded software services is nearly $5,000,000, which is significantly more than a million dollars as alleged by the Examining Attorney. Second, Applicant notes that the total sales revenue for ECONCIERGE is substantially the same as that of ECONNECTIVITY (approximately $5M), which the Examining Attorney found persuasive in establishing secondary meaning.

Lastly, the Examining Attorney discards Applicant's evidence in the form of articles and press releases because they allegedly lack context and are insufficient in number. The Examining Attorney contends that "[i]t is common knowledge that the internet permits anyone to post and make public anything… just because anyone can post anything doesn't mean anyone has viewed the posting or has heard about it." This reasoning is flawed for several reasons. First, the articles each include direct quotations from professionals in the hospitality industry and are therefore relevant to the analysis and entitled to evidentiary weight for at least that reason. Furthermore, the articles submitted are each from reputable sources of information pertaining to

[1] The Examining Attorney contends that this case is not applicable because "the examining attorney does not have the capability to and cannot engage in the same litigation maneuvers as counsel in an *inter partes* proceeding." However, the Board in *Kellog Co.* noted that "the record consists only of the pleadings and the file of the involved application. The parties submitted no testimony or other evidence…" The Board also noted that the declaration was afforded evidentiary weight because "[t]he relevant portions of the declaration pertain to facts regarding length of use and sales and advertising figures," not because the declarant was subjected to a deposition or some other "litigation maneuvers."

the hospitality industry and are not taken from some obscure blog or message-board posted by anonymous sources. Indeed, the evidence includes articles from Hyatt, Hospitality Upgrade, Hotel Executive, and CIO Review, among others. The Examining Attorney's contention that "the Office cannot discern how the applicant's press releases were disseminated, nor can it determine [to] whom the press releases were directed," is simply without merit.

Thus, the Examining Attorney has failed to properly weigh the significant evidence of secondary meaning by analyzing and improperly rejecting each piece of evidence individually and in isolation. Consideration of the composite effect of the full body of evidence, which includes advertising and sales volume, the examples of marketing materials, and the over 12 years of continuous and exclusive use of the ECONCIERGE mark, clearly demonstrates that the ECONCIERGE mark is recognized as the source of Applicant's specialized software services among the relevant, sophisticated professional consumers in the hospitality industry. The Board should therefore find that the ECONCIERGE mark has acquired distinctiveness for the recited services and approve the mark for registration on the Principal Register.

Dated October 23, 2018.

Respectfully submitted,

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