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Subject: U.S. TRADEMARK APPLICATION NO. 87507760 - CARGOSIGNAL - N/A - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 20

Files: 20181130-rec0002.JPG, 20181130-rec0003.JPG, 20181130-rec0004.JPG, 20181130-rec0005.JPG, 20181130-rec0006.JPG, 20181130-rec0007.JPG, 20181130-rec0008.JPG, 20181130-rec0009.JPG, 20181130-rec0010.JPG, 20181130-rec0011.JPG, 20181130-rec0012.JPG, 20181130-rec0013.JPG, 20181130-rec0014.JPG, 20181130-rec0015.JPG, 20181130-rec0016.JPG, 20181130-rec0017.JPG, 20181130-rec0018.JPG, 20181130-rec0019.JPG, 20181130-rec0020.JPG, 87507760.doc

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

U.S. APPLICATION SERIAL NO. 87507760

MARK: CARGOSIGNAL

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GENERAL TRADEMARK INFORMATION:

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APPLICANT: Expeditors International of Washington, ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/15/2019

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 refusal and requirement made final in the Office action dated August 15, 2018 are maintained and continue to be final: the disclaimer requirement; the Sections 1 and 45 refusal for failure to show the applied-for mark in use in commerce in International Class 39. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

The requirement for clarification of the identification of goods made final in the Office action has been satisfied, and the Section 2(d) refusal made final in the Office action is withdrawn. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

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

Specifically, applicant argues that mental processing is required to understand the meaning of the mark because the dictionary contains multiple definitions for the word "signal." However, descriptiveness is considered in relation to the relevant goods and services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). "It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). In the present case, the identification of goods and services includes "trackers that transmit and receive digital **signals**," "transmission of information regarding physical condition of goods, packages, and freight during delivery via devices that transmit and receive digital **signals**," "advice related to the transmission and reception of digital **signals**," "providing consulting services and advice related to electronic devices that transmit and receive digital **signals**" and "troubleshooting in the nature of diagnosing challenges related to the use of computer software and hardware related to the use of electronic devices that transmit and receive digital **signals**." Thus, based on the context of applicant's goods and services, a consumer would immediately understand "signal" as referring to an electrical impulse or radio wave transmitted or received.

Additionally, "a mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Applicant also argues that the combination "CARGO SIGNAL" creates an incongruous meaning because cargo cannot commit the act of signaling. However, the attached evidence from https://www.praxas.com, http://www.e2e.us, https://www.jv-technoton.com, http://www.transervicios.com, and https://logistimatics.com shows that devices are commonly used to

emit and track “signals” from “cargo” containers. Additionally, the attached evidence from https://www.ups.com, http://www.landlinemag.com, https://www.fleetowner.com, https://www.link-labs.com, https://developer.ibm.com, and https://qsales.com shows that issues with “signals” emitted from tracking devices attached to cargo containers are a common area of concern in the transportation industry; thus, it is likely that many consumers are in the market for products or services designed to meet a particular need related to such signals. Accordingly, rather than interpreting the mark as referring to cargo that itself emits signals, consumers are likely to understand the mark as referring to products and services designed to meet consumer needs relating to signals used to track cargo. Thus, although “cargo signal” does not appear to be a generic term for a specific type of tracking device, a consumer would immediately understand that applicant’s goods and services relate to electrical impulses or radio waves transmitted or received from containers of goods carried on a ship, aircraft, or motor vehicle.

Further, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that CARGOSIGNAL is merely descriptive. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

Additionally, applicant argues that third parties have registered marks containing the term “CARGO” that appear to be descriptive. However, the fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Additionally, applicant argues that any doubt regarding the mark’s descriptiveness should be resolved on applicant’s behalf. *E.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

With regard to the specimen, the refusal is maintained because the substitute specimen does not appear to show the mark in use in commerce with any of the services identified in the application in International Class 39. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017); *In re Graystone Consulting Assocs., Inc.*, 115 USPQ2d 2035, 2037-38 (TTAB 2015); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). Specifically, the specimen indicates that applicant's "Cargo Signal" services are for *monitoring* shipments, whereas applicant assesses risk and plans routes and "the selected airline" provides the actual transportation services. Accordingly, the applied-for mark does not appear to be in use in connection with any pickup, transportation, storage or delivery activities.

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 overcome any outstanding final requirement and refusal, 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).

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