

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87659196
LAW OFFICE ASSIGNED	LAW OFFICE 122
MARK SECTION	
MARK	<a href="https://tmng-al.uspto.gov/resting2/api/img/87659196/large">https://tmng-al.uspto.gov/resting2/api/img/87659196/large</a>
LITERAL ELEMENT	CLASSIFY & PROCESS
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<a href="#">evi_839136204-20190307205323302270_.Evidence.pdf</a>
CONVERTED PDF FILE(S) (4 pages)	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\876\591\87659196\xml8\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\876\591\87659196\xml8\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\876\591\87659196\xml8\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\876\591\87659196\xml8\RFR0005.JPG</a>
DESCRIPTION OF EVIDENCE FILE	the actual argument text
SIGNATURE SECTION	
RESPONSE SIGNATURE	/alongobucco/
SIGNATORY'S NAME	Anne Marie Longobucco
SIGNATORY'S POSITION	Attorney of record, New York bar member
SIGNATORY'S PHONE NUMBER	212-921-2001
DATE SIGNED	03/07/2019
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Mar 07 22:22:55 EST 2019
	USPTO/RFR-X.XX.XXX.XXX-20 19030722255710841-876591 96-620cc59875b51897f34edd

**TEAS STAMP**

4bd9a734ca2b7a646c8a3c858  
f127de4eb65a1383d-N/A-N/A  
-20190307205323302270

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 09/20/2020)

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

Application serial no. **87659196** CLASSIFY & PROCESS(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87659196/large>) has been amended as follows:

**ARGUMENT(S)**

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

Please see the actual argument text attached within the Evidence section.

**EVIDENCE**

Evidence in the nature of the actual argument text has been attached.

**Original PDF file:**

[evi\\_839136204-20190307205323302270 -. Evidence.pdf](#)

**Converted PDF file(s)** ( 4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

**SIGNATURE(S)****Request for Reconsideration Signature**

Signature: /alongobucco/ Date: 03/07/2019

Signatory's Name: Anne Marie Longobucco

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 212-921-2001

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 87659196

Internet Transmission Date: Thu Mar 07 22:22:55 EST 2019

TEAS Stamp: USPTO/RFR-X.XX.XXX.XXX-20190307222255710

841-87659196-620cc59875b51897f34edd4bd9a

734ca2b7a646c8a3c858f127de4eb65a1383d-N/

A-N/A-20190307205323302270

### **Argument**

In the final office action, the Examining Attorney maintained his refusal to register the mark based on descriptiveness. Applicant respectfully submits, however, that the mark is suggestive, not descriptive, of Applicant's services.

#### **I. The Mark Does Not Describe the Function or Purpose of Applicant's Services**

As discussed in Applicant's response to the first office action, the mark CLASSIFY & PROCESS does not directly or immediately tell a prospective purchaser anything about Applicant's services, which are "Providing temporary use of non-downloadable cloud-based artificial intelligence (AI) software for organizing and integrating business data and intelligence for improving enterprise performance." In the absence of any such direct connection between the mark and the services, the mark is suggestive, not descriptive. *See Nautilus Group, Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) ("If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.").

In cases involving software with multiple, complex features, the Trademark Trial and Appeal Board has recognized that marks consisting of one or two ordinary words are suggestive rather than descriptive of the goods or services, even if they hint at or imply some information about the software's purpose or function. *See In re John M. Floyd & Assocs., Inc.*, Serial No. 78/259782, 2006 WL 2558004 (TTAB August 9, 2006) (finding PRIVILEGE MANAGER not descriptive of software used to "provide management reports in connection with overdraft

privilege programs” (emphasis in original); *In re Orincon Indus., Inc.*, Serial No. 76/259604, 2004 WL 2341815 (TTAB September 14, 2004) (finding TRAC SYSTEM not descriptive of goods that included “traffic management software . . . tracking the position of vehicles”); *In Re Satori Software, Inc.*, Serial No. 75/630,834, 2002 WL 1485321 (TTAB July 10, 2002) (finding MAILROOM TOOLKIT not descriptive of software for adding US Postal Service capabilities to database programs); *In re Synplicity, Inc.*, [Serial No. 75/566,083](#), 2001 WL 630663 (TTAB June 6, 2001) (dictionary definition of the term CERTIFY failed to establish that term was descriptive of software whose function included “verification”); *In re Evolving Sys., Inc.*, [Serial No. 75/217,681](#), 2000 WL 759721 (TTAB June 2, 2000) (finding NUMBERMANAGER not descriptive of software for verifying phone numbers to facilitate number portability and noting that applicant’s lengthy explanation of the software on its website suggested it was more than a “number manager”). In each of these cases, the mark did not “immediately and unequivocally” describe a feature or function of the software; some thought or speculation by the potential purchaser was still required, making the mark suggestive rather than descriptive. *See In re Synplicity, Inc.*, 2001 WL 630663, \*3.

Similarly, the mark CLASSIFY & PROCESS does not immediately or unequivocally describe any of the functions or features of Applicant’s software. A potential purchaser would at least need to exercise some thought, imagination or speculation to determine that Applicant provides cloud-based artificial intelligence software for organizing and integrating business data and intelligence for improving enterprise performance. Because such a mental leap is required, the mark is suggestive rather than descriptive. *See Nautilus Group, Inc., Inc.*, 372 F.3d at 1340.

## **II. The Examining Attorney's Evidence Fails to Establish That the Mark Is Descriptive**

In addition, the evidence submitted by the Examining Attorney fails to show that the mark is merely descriptive of Applicant's services. Notwithstanding the Examining Attorney's argument that material obtained from the Internet is generally considered competent evidence in trademark examination, the probative value of such evidence depends on its reliability and relevance to the particular application at issue. *See* TMEP §§710.01 ("the examining attorney must always support his or her action with relevant evidence") and 710.01(b) ("the weight given to [Internet] evidence must be carefully evaluated, because the source may be unknown"). Where, as here, the Examining Attorney's evidence is not demonstrated to be reliable and/or is irrelevant to this application, the evidence is entitled to little or no weight.

In the first Office Action, the Examining Attorney's evidence consisted solely of a page from the website [thesaurus.com](http://thesaurus.com) (listing "classify" as a synonym for "organize") dictionary definitions of "classify" and "process" from [freedictionary.com](http://freedictionary.com) and [foldoc.org](http://foldoc.org), a "free on-line dictionary of computing," without any indication that these sources are reliable or widely used in the software industry or by the general public. Moreover, in its response, Applicant submitted contrasting dictionary definitions from Merriam-Webster, demonstrating that these terms at a minimum have multiple meanings, some of which are not descriptive of Applicant's services. The Examining Attorney failed to consider Applicant's evidence or to explain why the definitions she submitted should be considered more authoritative than Applicant's.

In the final Office Action, the Examining Attorney submits web pages from other software companies, purporting to show that "the wording 'classify' and 'process' are commonly used together in connection with the same or similar services as applicant's to describe the function

of grouping data together and processing the data through the software.” The Examining Attorney fails to establish, however, that the services described in these web pages are in fact the same as or similar to Applicant’s, or that the terms “classify” and “process” have descriptive meanings as applied to *Applicant’s* software. Some of these pages, for example, appear to describe software for simulating and assisting customer service agents ([sundown.ai](https://sundown.ai)), for use in manufacturing technology ([sightmachine.com](https://sightmachine.com)), and for medical diagnosis ([hyperverge.co](https://hyperverge.co)) – none of which is identical or similar to Applicant’s software. Moreover, neither these web pages nor Applicant’s identification of services says anything about “grouping data together and processing the data through the software.” This evidence is therefore irrelevant to the meaning of CLASSIFY & PROCESS as applied to Applicant’s software and fails to show that the mark is merely descriptive.

#### **Conclusion**

For the reasons set forth above and in Applicant’s response to the first Office Action, Applicant respectfully requests that the refusal be reconsidered and withdrawn, and that the mark be approved for publication.