

ESTTA Tracking number: **ESTTA1079905**

Filing date: **09/04/2020**

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

Proceeding	88354318
Applicant	Ivani, LLC
Applied for Mark	NETWORK PRESENCE SENSING
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Submission	Appeal Brief
Attachments	Network_Presence_Sensing_Appeal_Brief.pdf(430520 bytes)
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Date	09/04/2020

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

In re Application of:
Ivani, LLC

Serial No: 88/354,318

Mark: NETWORK PRESENCE SENSING

Filed: March 25, 2019

**TRADE MARK APPLICATION
PRINCIPAL REGISTER**

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APPLICANT'S EX PARTE APPEAL BRIEF

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2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:51 (Fourth Ed. 2009) 3, 5

COMES NOW Applicant Ivani, LLC (the “Applicant”), by and through undersigned counsel, and hereby respectfully submits this brief in support of its appeal of the Examining Attorney’s refusal to register the mark NETWORK PRESENCE SENSING (the “Mark”) for “Computer hardware and downloadable computer firmware to analyze data to detect human presence within an area,” Serial Number 88/354,318, filed with the United States Patent and Trademark Office on March 25, 2019.

I. DESCRIPTION OF THE RECORD

A. PROSECUTION HISTORY

On June 6, 2019, the Examining Attorney issued a non-final office action initially refusing registration of the Mark on account that it is merely descriptive on account of the word elements “network” and “sensing”. Examiner also sought a minor amendment to the identification of goods.

Applicant responded to the initial Office Action on December 6, 2019, submitting argument and evidence against Examiner’s position that the Mark is merely descriptive. Applicant further offered explanation of Applicant’s good and the underlying technology with which the Mark is associated. After considering Applicant’s argument, and even agreeing with certain arguments advanced by Applicant, Examiner issued a final Refusal of Registration for Applicant’s Mark on January 6, 2020.

On July 6, 2020, Applicant filed a Request for Reconsideration of the final refusal, submitting additional evidence and argument against Examiner’s merely descriptive refusal. Applicant additionally filed a notice of appeal that same day with the Trademark Trial and Appeal Board (“TTAB”).

On July 24, 2020, Examiner denied Applicant’s Request for Reconsideration.

B. EXAMINER’S EVIDENCE

The Examiner’s evidence consisted of definition printouts (for network), and screenshots from Applicant’s website.

C. APPLICANT’S EVIDENCE

December 6, 2019 Office Action Response

Applicant submitted two videos describing Applicant’s good, and definition printouts.

II. STATEMENT OF THE ISSUES

At issue is whether the Mark, NETWORK PRESENCE SENSING, is merely descriptive of services associated with the Mark, namely “Computer hardware and downloadable computer firmware to analyze data to detect human presence within an area.”

III. ARGUMENT

This appeal concerns how many layers of applied analysis, and how many mental leaps are required, before a mark can defeat a *merely descriptive* refusal. Applicant’s Mark is not merely descriptive of the good offered in association, rather, it is suggestive. The word element “NETWORK” is somewhat ambiguous in that it can be a very broad or a very narrow word, depending on the interpreter. Even in Examiner’s evidence, the ambiguity posed by this term is acknowledged. Examiner himself acknowledged that the definition of network provided by Examiner does not fit Applicant’s Offering (see Final Office Action, January 6, 2020). Examiner’s has instead posited essentially that a network consists of any two or more items or devices that have the capacity to access the same wifi, as in such an occurrence, those items or devices in turn become a network. Such a broad application of the word “network” is unfounded in this context, not just in application to the several newly introduced definitions of “network” submitted by

Examiner, but even in deriving this definition, Examiner’s reasoning demonstrates that the Mark is not *merely* descriptive as several mental leaps are required to arrive at Examiner’s application and conclusion. The same is true as to the word element “sensing” as there is no actual *sensor* device involved in Applicant’s good.

Further, while not the sole test, it is important to note that ordinary citizens that view “network presence sensing” will not know exactly what Applicant’s good does. Applicant’s good cannot sense whether or not there is wifi or “a network”. This is further support that the Mark is suggestive.

A. THE MARK IS NOT MERELY DESCRIPTIVE

a) The Law

Section 1052(e)(1) says, in relevant part, “[n]o trademark . . . shall be refused unless it . . . consists of a mark which . . . when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). Because “merely” modifies “descriptive,” even descriptive marks are registrable as long as the mark does more than tell a customer the function or characteristics. McCarthy § 11:51. It is well established that a supposedly merely descriptive mark will “immediately” and “directly” describe the goods or services. *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y 1968). The correct test is whether the mark conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose of the good. TMEP § 1209.01(b). Further, a incongruity or double entendre of a word element can defeat a merely descriptive refusal. TMEP § 1209.03(e).

If a mark is more than merely descriptive, meaning more thought or imagination is necessary to determine the provided services than simply seeing the mark, then it becomes suggestive. Suggestive marks require some level of “imagination” to draw the association between the mark and its related goods and services. *Zobmondo Entertainment, LLC v. Falls Media, LLC*, 602 F.3d 1108,

1116 n.9 (9th Cir. 2010); *see also Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699 (2d Cir. 1961) (finding POLY PITCHER suggestive for polyurethane pitchers). Under the imagination test, a mark is suggestive if it takes some extra mental step for a consumer to arrive on the appropriately defined service. More mental steps suggest a stronger, more suggestive, mark. *Id.*

In *In re Hutchinson Technology, Inc.*, 852 F.2d 552 (Fed. Cir. 1988), the Federal Circuit reversed the Board's Section 2(e) refusal stating that the word element "TECHNOLOGY" was **not** merely descriptive of the applicant's goods (etched metal electronic components). The Federal Circuit concluded that "technology is a very broad term which includes many categories of goods...[and] does not convey an immediate idea of the 'ingredients, qualities, or characteristics of the goods.'" *In re Hutchinson Technology, Inc.*, 852 F.2d at 555 (citation omitted); *c.f. In re Colonial Stores, Inc.*, 394 F.2d 549, 551 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of the bakery products as sugar and spice are components of many products and therefore cannot be descriptive of any such goods, rather, the mark is suggestive of the goods).

Likewise, in *In re Dune Medical Devices Ltd.*, 2011 WL 1495445 (TTAB 2011), the Board reversed a Section 2(e) refusal and concluded that the applied-for-mark "MARGINPROBE" was not merely descriptive of the goods (medical device, namely, a tissue characterization device for use in surgical procedures). The Board concluded that while the term MARGINPROBE "suggests some sort of device with a probe ... probes are an integral part of many medical devices and also function as a part of composite marks therefore." *Id.*, at *5. As such, because the term is unduly broad, it is not merely descriptive and was not sufficiently narrowed to the particular uses associated with the applied-for-mark. Rather, terms such as "positive margin detector" or "cancer detector" or "tumor probe" or "margin assessment probe" would be considered descriptive. *Id.*, at *6.

This case is analogous. Examiner takes pause with the use of the word element “NETWORK” and has provided multiple definitions for which when combined, Examiner submits renders this word element descriptive. But given the totality of the definitions offered by Examiner, Applicant submits that just as in the *MARGINPROBE* analysis, while the word element “network” *suggests some sort of good that involves some kind of composition of multiple devices*, devices that have wireless abilities are an integral part of most technology, certainly all devices that will be invented today. As such, because the term is unduly broad, it is not merely descriptive as the primary significance is not in relation to the purpose of Applicant’s good. Further, the term “network” was not sufficiently narrowed to the particular uses associated with the Mark. Rather, terms or hypothetical marks such as “network human presence sensing” or “human presence sensing” or “disruption presence sensing” would be considered merely descriptive as applied to Applicant’s good. *Id.*, at *6. Likewise, if Applicant’s good were to detect the presence of a network, the Mark NETWORK PRESENCE SENSING would be descriptive, but this is not the case. Some imagination is required to arrive at the purpose and function of Applicant’s good, therefore rendering the Mark suggestive.

To this end, as explained, there is no actual sensor that is a component of Applicant’s good. Applicant’s good has the ability to use emitted energy from devices in a defined setting to *detect* disruptions in the flow of energy waves. “Sensing” does not derive from the noun “sensor” but is a verb. This incongruity further supports the conclusion that the Mark is not merely descriptive. Given the additional thought and imagination necessary to determine Applicant’s goods, NETWORK PRESENCE SENSING is not *merely* descriptive. *Zobmondo Entertainment, LLC*, 602 F.3d at 1116 n.9; McCarthy § 11:51 (a mark that does more than describe the services is entitled to registration under the Section 2(e) analysis). In the context in which the Mark is intended to be used, the average purchaser when presented with the Mark will require a layered thinking and a mental leap to reach

the purpose and function of the good based on the word elements of the Mark, and thus the impression on an average purchaser will be suggestive.

b) **Application of the Law**

i) **The Mark is Suggestive**

Applicant's Marks are at least suggestive of the services provided because the consumer's imagination is required to take the extra mental step to identify Applicant's services. The Section 2(e) refusal is based on an unduly broad application of the word elements *network* and *sensing*, each term of which would need to be further narrowed to render the Mark merely descriptive. When viewed with a more practical lens, one more akin to that of the average purchaser, the Mark is suggestive of the good associated, and therefore, is not merely descriptive.

A customer with knowledge of the security function of Applicant's good can only at best state that Applicant's Mark is suggestive of the function and purpose of Applicant's good. This case is analogous to *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 555 (Fed. Cir. 1988), where the Federal Circuit reversed the Board's Section 2(e) refusal on the basis that the word "TECHNOLOGY" is a very broad term which includes many categories of goods...[and] does not convey an immediate idea of the 'ingredients, qualities, or characteristics of the goods.' *Id.*

Like *In re Dune Medical Devices Ltd.*, 2011 WL 1495445 (Trademark Tr. & App. Bd., March 31, 2011) (where the Board concluded that MARGINPROBE was suggestive of a device with a probe), Applicant's Marks *suggest* some sort of good or service involving multiple devices, but "NETWORK PRESENCE SENSING" does not merely describe the security attributes of Applicant's good and therefore the Section 2(e) refusal should be reversed.

ii) **The Mark Must be Considered As a Whole**

Additionally, because the words *network* and *presence* and *sensing* can have numerous meanings, it is impossible to state with any assurance what significance will be attached to

Applicant's Mark when it is seen by the relevant customer of Applicant's services. In any event, no matter the combination, the Mark is not merely descriptive of the actual good offered by Applicant.

While each word element of Applicant's Marks has meaning, the composite whole which forms NETWORK PRESENCE SENSING becomes suggestive. *Association of Co-op. Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134, 1140 (5th Cir. 1982). If we combine the definitions, we see that in this case, like many others, the composite whole is greater than its parts. *Synergistic Intern., LLC v. Korman*, 470 F.3d 162, 172 (4th Cir. 2006) (finding GLASS DOCTOR suggestive of windshield repair). Taking the mark as a whole requires the aforementioned imagination test and multi-stage reasoning to arrive at Applicant's good. *In re Tms Corporation of the Americas*, 200 U.S.P.Q. 57 (1978) (holding THE MONEY SERVICE suggestive for financial services).¹ It requires a mental leap to bring a consumer's mind to data center infrastructure in various systems like voice, security, and temperature monitoring. Considering Applicant's Marks without studying the parts individually—as should be done—Applicant's Mark does not immediately take consumers' minds to Applicant's good.

Applicant request that this Board reverse the Section 2(e) refusal and conclude that NETWORK PRESENCE SENSING is suggestive, and requests that the refusal be reversed on account that sufficient imagination is required to determine the purpose and function of Applicant's good, thus rendering Applicant's Mark suggestive and entitled to registration.

¹ Under the lesser used "competitor test," the outcome is the same. This test limits use of words that are descriptive because competitors in the same space need to use those words to describe their goods or services. *See Aluminum Fabricating Company of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 317 (1st Cir. 1980). Competitors do not need this Mark to describe goods in the same class(es). NETWORK PRESENCE SENSING is irrelevant to the lexicon of provided attributes of the good.

Applicant notes that the sister application, NPS (Ser. No. 88/354,321) has proceeded to publication, and respectfully requests the same path to registration be afforded to the Mark. Finally, in any close case in a Section 2(e) Office Action, it is the Board's practice to construe any doubt as to whether an applied-for-mark is merely descriptive or suggestive in favor of the applicant. *See e.g. In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983) (citing *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972)); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (1972) (where refusal to register "THE LONG ONE" used in association with a "longer" loaf of bread was reversed). Applicant requests resolution in its favor.

IV. DISCLAIMER

Applicant is willing to disclaim "network" upon reversal of Examiner's refusal.

V. CONCLUSION

For the reasons provided herein, the Applicant respectfully requests that the Board reverse the Examiner's refusals, and permit Applicant's Mark, NETWORK PRESENCE SENSING to be published for opposition.

Dated: September 4, 2020

Respectfully submitted,

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