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Sent: 5/18/2016 3:47:51 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 86672373 - PRO. - 24066 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86672373

MARK: PRO.



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Pico Pro Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

24066

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the service mark PRO. in stylized form. Registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the grounds that the mark is merely descriptive of the identified services.

FACTS

On June 24, 2015, the applicant, Pico Pro Inc., filed a use-based service mark application seeking registration of the mark PRO. in stylized form for “Consulting services in the field of architectural design.”

The examining attorney issued a non-final Office Action on October 7, 2015. The examining attorney refused registration on the Principal Register under Trademark Act Section 2(e)(1) on the grounds that the mark is merely descriptive of the identified services.

The applicant responded to the Office Action on January 20, 2016. In that response, the applicant argued against the refusal under Section 2(e)(1).

On January 21, 2016, the examining attorney issued a final Office Action. The examining attorney made final the refusal under Section 2(e)(1).

The applicant noted the instant appeal on February 2, 2016 and filed its appeal brief on April 4, 2016. The file was forwarded to the examining attorney for his statement on April 4, 2016.

ISSUE

Whether the applied-for mark PRO., when used in connection with the applicant’s services, is merely descriptive of those services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

ARGUMENT

THE APPLICANT’S MARK IS MERELY DESCRIPTIVE OF THE IDENTIFIED SERVICES UNDER SECTION 2(e)(1) OF THE TRADEMARK ACT.

The applicant seeks registration of PRO. in stylized form for “Consulting services in the field of architectural design.”

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *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, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In the non-final Office Action dated October 7, 2015, the examining attorney provided evidence from The American Heritage Dictionary which shows that the wording PRO is short for "professional" or is defined as "an expert in the field of endeavor." (Office Action, 10/07/2015, TSDR pp. 2-4). In addition, evidence provided from thefreedictionary.com bolsters this definition of PRO by showing entries that define the term as "Engaging in a given activity as a source of livelihood or as a career," "Having or showing great skill; expert" or "A person following a profession, especially a learned profession." (Final Office Action, 01/21/2016, TSDR pp. 2-7).

Furthermore, in the final Office Action dated January 21, 2016, the examining attorney provided Internet evidence consisting of various websites that show that the wording professional is commonly used in connection with architectural design services to describe to consumers that the services are professional level services that are provided by experts in the field. This evidence includes the following examples:

- Moseley Architects provides comprehensive professional architectural, engineering, and interior design solutions to clients. (Final Office Action, 01/21/2016, TSDR pp. 15-16)
- Aspect Architecture offers customized and professional architectural and design services to meet the needs of their clients. (Final Office Action, 01/21/2016, TSDR p. 17)
- Reno Design Group provides professional architecture and planning services to consumers. (Final Office Action, 01/21/2016, TSDR pp. 20-21)
- Eaton Architecture provides architecture services that are provided by three professional licensed architects in the state of Utah. (Final Office Action, 01/21/2016, TSDR pp. 22-28)
- UIC provides professional services in the nature of architectural design services for consumers. (Final Office Action, 01/21/2016, TSDR pp. 31-33)

Material obtained from the Internet is generally accepted as competent evidence. *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); TBMP §1208.03; TMEP §710.01(b).

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in

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