

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	88010246
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/88010246/large
LITERAL ELEMENT	SEGWAY DRIFT
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)

I. The Refusal Based on Reg. No. 4329613 Should be Withdrawn or a Decision should be Deferred

With respect to Reg. No. 4329613, Applicant does not believe there is any likelihood of confusion because, among other reasons, Reg. No. 4329613 covers some type of "overlying platform" apparatus for in-line skates and Applicant is not seeking registration of its Mark in connection with goods or services that are closely related enough to an "overlying platform" apparatus to cause confusion. Moreover, each trademark owner appears to operate in distinct fields and consumers are unlikely to be confused into believing there is a relationship between Applicant and the owner of Reg. No. 4329613.

In the alternative, Applicant notes that the Cited Mark is due for its requisite Section 8 Declaration of Use on April 30, 2019 and as of the date of filing this response, Registrant has failed to file such. Accordingly, to the extent the Examiner maintains the refusal after reviewing Applicant's preliminary response, Applicant requests suspension of its Application pending a determination of whether the registrant timely files, and the USPTO accepts, the §8 or affidavit and/or whether the registration is renewed during the grace period. See TMEP §716.02(e). Applicant reserves its right to present additional arguments to the refusal should Registrant maintain Reg. No. 4329613.

II. The Disclaimer Requirement for "DRIFT" Should be Withdrawn

The Examining Attorney has requested Applicant disclaim "DRIFT" from its Mark, because "DRIFT" purportedly describes an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant's goods. Applicant respectfully requests the Examining Attorney to re-evaluate the disclaimer request, and notes Applicant's Mark is, as a whole, at least suggestive, rather than merely descriptive. More particularly, and as further detailed below, Applicant's product is not a "drift skate" as that term may be commonly understood. Accordingly, the disclaimer of "DRIFT" is inappropriate and the Mark should be registrable as is without entry of a disclaimer.

a. "DRIFT" Does Not Describe Applicant's Goods with the Immediacy and Particularity Required to Render Such Disclaimable.

"DRIFT" is not merely descriptive of Applicant's goods. A term is merely descriptive only if it "immediately describes" the Applicant's goods and services. *In re Econoheat, Inc.*, 218 U.S.P.Q. 381, 383 (TTAB 1983) (SOLAR QUARTZ held suggestive, not descriptive, of infrared

heaters) (emphasis in original). A mark is not merely descriptive simply because a person encountering a mark might recognize a suggestion regarding an aspect of the applicant's goods and services. *In re Nalco Chem. Co.*, 228 U.S.P.Q. 972, 973 (TTAB 1986) (VERI-CLEAN held suggestive, not merely descriptive, of Applicant's cleaning additives); *In re George Weston, Ltd.*, 228 U.S.P.Q. 57, 58 (TTAB 1985) (SPEEDI BAKE does not convey an "immediate idea" of the ingredients, qualities or characteristics of dough that quickly bakes into bread); *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (TTAB 1978). To be deemed merely descriptive and thus disclaimable, a mark must directly communicate the characteristics of the product or service in connection with which it is used. If the information about the product or service is indirect or vague, then the mark is considered suggestive, not descriptive. See J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.19, at 11-26 (4th ed. 1998). Applying the legal principles to Applicant's goods, Applicant's Mark is not descriptive.

The Mark's incorporation of "DRIFT" fails to describe the goods for which registration is sought with the immediacy and particularity required to find a term descriptive and thus disclaimable. A term is not merely descriptive simply because it imparts information about a quality of the underlying goods. See *In re DC Comics, Inc.*, 689 F.2d 1042 (C.C.P.A. 1982). Instead, the test for whether components of a mark are descriptive is whether such "conveys information about a significant feature or characteristic of the applicant's goods with the immediacy and particularity required by the Trademark Act." *In re Paul Leonhardt*, 109 U.S.P.Q.2d 2091, 2092 (T.T.A.B. 2008). In the instant case, the Examiner has identified several references to third-party offerings for a roller skate part purportedly called a "drift skate plate." Applicant is unclear as to the exact nature of this part as such is not incorporated into or used in its own products. However, based on a review of the Examiner's evidence, this part appears to allow a user to convert a traditional roller skate with wheels facing in the direction of the wearer to a traditional roller skate with wheels facing perpendicular to the wearer. This appears to allow the wearer to orient their body to be perpendicular to the direction of movement.

Applicant's goods would be unable to accommodate this part. In fact, Applicant's goods can only be safely operated with the wearer's body facing in the direction of movement. Attached as Exhibit 1 is a print-out of Applicant's website describing its goods. Applicant's goods relate to an innovative self-balancing electronic transporters. A "drift skate plate" could not reasonably be incorporated into any of the goods Applicant plans to provide under SEGWAY DRIFT.

A leading test for determining whether a mark is suggestive— as opposed to merely descriptive— is whether "[a] term... requires imagination, thought and perception to reach a conclusion as to the nature of goods." *Stix Prods., Inc. v. United Merchants & Mfrs. Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968). Put another way, "if the mental leap between the word and the product's attributes is not *almost instantaneous*, this strongly indicates suggestiveness, not direct descriptiveness." 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:67 (5th ed. 2017) emphasis added. The Board has further clarified that even if a mark suggests or hints at the nature of an applicant's goods or services, if one must engage in mental gymnastics and extrapolation, the mark does not merely describe the applicant's services. See *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 U.S.P.Q. 832 (TTAB 1977).

The word "DRIFT" considered in the context of the Mark as a whole is simply too vague to connote any specific, significant quality or characteristic of Applicant's goods and services to consumers. In fact, the word drift is commonly understood to have multiple meanings including, for example:

- the act of driving something along;
- the flow or velocity of the current of a river or ocean stream;
- a general underlying design or tendency;
- the underlying meaning, import, or purport of what is spoken or written [as in 'gist'];
- the motion or action of drifting, especially spatially and usually under external influence; and
- a gradual shift in position;
- an aimless course.

The above common definitions clarify that the word itself has multiple connotations. These multiple meanings require the consumer to engage in a thought process to determine how “drift” might apply to or what meaning is intended by the word DRIFT as applied to the goods.

Moreover, DRIFT does not directly describe Applicant’s goods such that a consumer encountering the Mark would gain any type of accurate or distinct knowledge of the characteristics of Applicant’s self-balancing electronic transporters. To one who is not familiar with Applicant’s self-balancing electronic transporters, Applicant’s Mark would— at best— convey only a suggestion as to the general nature of these goods—namely that they might help a user to “drift” in a direction, or that “drift” refers to a velocity or flow that occurs when a user wears the product, or that the user is able to conduct or drive something along by virtue of using the product. Again, determining the meaning of the word requires the consumer to engage in multiple various mental leaps, imagination and mental pauses to reach a conclusion about nature of Applicant’s goods. Because extrapolation and mental gymnastics are necessary to arrive at an understanding of Applicant’s product, the incorporation of DRIFT in Applicant’s Mark is at most suggestive rather than merely descriptive. Accordingly, a consumer encountering the word “DRIFT” must think about the relationship between the meaning of “DRIFT” and Applicant’s goods to determine the nature of the relationship between the two. This multi-step thought process is the very essence of suggestiveness and not descriptiveness.

b. Any Doubts to Be Resolved in Favor of Applicant.

When considering whether a mark is suggestive or merely descriptive, to the extent that there is some doubt, the doubt must be resolved in the Applicant’s favor by finding the proposed mark to be suggestive. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84 (T.T.A.B. 1983); *In re the Rank Organisation Ltd.*, 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984); *In re The Nobele Company*, 225 U.S.P.Q. 749, 750 (T.T.A.B. 1980). Resolving such doubts in favor of finding a mark suggestive is soundly based on the recognition that anyone who believes that they would be damaged by the registration will have an opportunity to oppose it. Given the, at best, nebulous connection between a “skate drift plate” and SEGWAY DRIFT, there are sufficient doubts as to whether the Mark is descriptive of a significant feature of Applicant’s goods with the immediacy and particularity required by the Trademark Act. Accordingly, these doubts should be resolved in Applicant’s favor and the request for disclaimer of DRIFT should be withdrawn.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_64124201218-20190416155914428695 . Exhibit 1 SEGWAY DRIFT.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT17\IMAGEOUT17\880\102\88010246\xml4\ROA0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\880\102\88010246\xml4\ROA0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\880\102\88010246\xml4\ROA0004.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\880\102\88010246\xml4\ROA0005.JPG
ORIGINAL PDF FILE	evi_64124201218-20190416155914428695 . Exhibit 2 DRIFT Definitions.pdf
CONVERTED PDF FILE(S) (10 pages)	\\TICRS\EXPORT17\IMAGEOUT17\880\102\88010246\xml4\ROA0006.JPG
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DESCRIPTION OF EVIDENCE FILE	Exhibit 1- Printout of Applicant's website; Exhibit 2- "drift" definitions
GOODS AND/OR SERVICES SECTION (012)(current)	
INTERNATIONAL CLASS	012
DESCRIPTION	
Vehicles; electric vehicle; locomotives; bodyworks; bicycles; scooters (vehicles); tires for vehicles; boats; vehicles with wheels; joysticks for vehicles; motorized, self-propelled, wheeled personal mobility and transportation devices, namely, mobility scooters, utility carts, and chariots; electric three-wheeled mobility and transportation devices, namely, motorized scooters, motorized personal mobility scooters, and motorized patrollers; three-wheeled motor vehicles; two-wheeled motor vehicles; robotic transport vehicles; electric bicycles; motorized bicycles; carts; go-carts; beach vehicles, namely, beach carts; motorized vehicles, namely, recreational carts, namely, motor racing cars, and go-carts; motorized carts for transporting and storing recreational and sports equipment; handling carts; all-terrain vehicles; trolleys; two-wheeled trolleys; shopping trollies; hand cars in the nature of hand-propelled wheeled vehicles; dollies; hand trucks; shopping trolleys; wheeled trolleys; motorized luggage carts; motorized carts for carrying goods and luggage; food carts, motorized; motorized golf carts; motorized, self-balancing dollies; motorized, self-balancing hand carts; motorized, self-balancing trollies vehicle wheel balancer; parts and accessories thereof	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (012)(proposed)	
INTERNATIONAL CLASS	012
TRACKED TEXT DESCRIPTION	
Vehicles; electrically powered motor vehicles; electric vehicle; locomotives; bodyworks for motor vehicles; bodyworks; bicycles; motor scooters; scooters (vehicles); tires for vehicles; boats; joysticks for land vehicles; vehicles with wheels; motorized, self-propelled, wheeled personal mobility and transportation devices, namely, mobility scooters, utility carts, and chariots; joysticks for vehicles; electric three-wheeled mobility and transportation devices, namely, motorized scooters, motorized personal mobility scooters, and motorized patrollers; three-wheeled motor vehicles; two-wheeled motor vehicles; robotic transport vehicles; electric bicycles; motorized bicycles; carts; go-carts; beach vehicles, namely, beach carts; motorized vehicles, namely, recreational carts, namely, motor racing cars, and go-carts; motorized carts for transporting and storing recreational and sports equipment; handling carts; all-terrain vehicles; trolleys; two-wheeled trolleys; shopping trollies; hand cars in the nature of hand-propelled wheeled vehicles; dollies; hand trucks; shopping trolleys; wheeled trolleys; motorized luggage carts; motorized carts for carrying goods and luggage; food carts, motorized; motorized golf carts; motorized, self-balancing dollies; motorized, self-balancing hand carts; motorized, self-balancing trollies vehicle wheel balancer; parts and fittings therefor; parts and accessories thereof	
FINAL DESCRIPTION	
electrically powered motor vehicles; locomotives; bodyworks for motor vehicles; bicycles; motor scooters; tires for vehicles; boats; joysticks for land vehicles; motorized, self-propelled, wheeled personal mobility and transportation devices, namely, mobility scooters, utility carts, and chariots; electric three-wheeled mobility and transportation devices, namely, motorized scooters, motorized personal mobility scooters, and motorized patrollers; three-wheeled motor vehicles; two-wheeled motor vehicles; robotic transport vehicles; electric bicycles; motorized bicycles; carts; go-carts; beach vehicles, namely, beach carts; motorized vehicles, namely, recreational carts, namely, motor racing cars, and go-carts; motorized carts for transporting and storing recreational and sports equipment; handling carts; all-terrain vehicles; trolleys; two-wheeled trolleys; shopping trollies; hand cars in the nature of hand-propelled wheeled vehicles; dollies; hand trucks; shopping trolleys; wheeled trolleys; motorized luggage carts; motorized carts for carrying goods and luggage; food carts, motorized; motorized golf carts; motorized, self-balancing dollies; motorized, self-balancing hand carts; motorized, self-balancing trollies vehicle wheel balancer; parts and fittings therefor.	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (028)(current)	
INTERNATIONAL CLASS	028
DESCRIPTION	
Toys; toy robots; toy vehicles; hang gliders; gymnastics equipment; skateboards; ski veneer; elbow pads (sports); knee pads (sports); roller skates; snow shoes; toy cars; parts and accessories thereof	

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (028)(proposed)	
INTERNATIONAL CLASS	028
TRACKED TEXT DESCRIPTION	
Toys; toy robots; toy vehicles; hang gliders; skateboards; gymnastics equipment; wood veneer skis; elbow pads for athletic use; ski veneer; knee pads for athletic use; elbow pads (sports); roller skates; knee pads (sports); snow shoes; toy cars; parts and fittings therefor; parts and accessories thereof	
FINAL DESCRIPTION	
toy robots; toy vehicles; hang gliders; skateboards; wood veneer skis; elbow pads for athletic use; knee pads for athletic use; roller skates; snow shoes; toy cars; parts and fittings therefor	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Deborah J Peckham/
SIGNATORY'S NAME	Deborah J. Peckham
SIGNATORY'S POSITION	Attorney of record, Massachusetts bar member
SIGNATORY'S PHONE NUMBER	617-345-3000
DATE SIGNED	04/17/2019
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Apr 17 11:34:30 EDT 2019
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XXX- 20190417113430231020-8801 0246-620ee4e9981e8f9bd3fe 72b31be89921efd6e2e52312c 3667bc702697db08e7ce9-N/A -N/A-20190416155914428695

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Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **88010246** SEGWAY DRIFT(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/88010246/large>) has been amended as follows:

ARGUMENT(S)

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

I. The Refusal Based on Reg. No. 4329613 Should be Withdrawn or a Decision should be Deferred

With respect to Reg. No. 4329613, Applicant does not believe there is any likelihood of confusion because, among other reasons, Reg. No. 4329613 covers some type of "overlying platform" apparatus for in-line skates and Applicant is not seeking registration of its Mark in connection with

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