

To: TokenAI LLC (TMadmin@goodwinlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 88015660 - TOKEN AI - TOK-600
Sent: 11/1/2018 1:44:53 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION
SERIAL NO. 88015660

MARK: TOKEN AI ***88015660***

CORRESPONDENT

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APPLICANT: TokenAI
LLC

**CORRESPONDENT'S
REFERENCE/DOCKET
NO:**

TOK-600

**CORRESPONDENT E-
MAIL ADDRESS:**

TMadmin@goodwinlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT EASTERN TIME OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: **11/1/2018**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

SUMMARY OF ISSUES:

- Section 2(e)(1) Refusal - Merely Descriptive
- Supplemental Register
- Identification of Services

SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes the function of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Applicant has applied for the mark **TOKEN AI** in standard characters for "Software as a service (SAAS) services featuring cryptocurrency market and portfolio analysis; Platform as a service (PAAS) featuring cryptocurrency market and portfolio analysis; Platform as a service (PAAS) featuring computer software for data mining and data analytics; computer software for creating and controlling artificial intelligence; Providing artificial intelligence based data analysis, pattern discovery, process automation, contextual prediction, predictive analytics, predictive modelling, recognition, segmentation, regression, decision support and visualization services" in International Class 42.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/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)).

In this case, the term "TOKEN AI" describes a feature of applicant's services. As shown in the attached evidence, linked below, in the context of applicant's services "TOKEN" refers to "a unit of cryptocurrency." The attached evidence, linked below, also shows that the term "AI" is short for "artificial intelligence" and means "intelligent machines that work and react like humans". Taken together, the mark "TOKEN AI" means "artificial intelligence related to units of cryptocurrency," or, in other words, "intelligent machines that work and react like humans to issues related to units of cryptocurrency."

Merriam-Webster: <https://www.merriam-webster.com/dictionary/token> (token)

CryptoCurrency Facts: <https://cryptocurrencyfacts.com/what-is-a-cryptocurrency-token/>

Citowise: <https://blog.citowise.com/the-basics-coin-vs-token-what-is-the-difference-5cd270591538>

Investopedia: <https://www.investopedia.com/terms/c/crypto-token.asp>

Blockchain Council: <https://www.blockchain-council.org/blockchain/what-are-crypto-tokens-how-crypto-tokens-work/>

Merriam-Webster: <https://www.merriam-webster.com/dictionary/AI> (AI)

Oxford Dictionaries: <https://en.oxforddictionaries.com/definition/us/AI> (AI)

Techopedia: <https://www.techopedia.com/definition/190/artificial-intelligence-ai>

Investopedia: <https://www.investopedia.com/terms/a/artificial-intelligence-ai.asp>

Webopedia: https://www.webopedia.com/TERM/A/artificial_intelligence.html

In this case, applicant's identification of services shows that applicant provides services related to cryptocurrencies and services using artificial intelligence. Thus, applicant's identification of services shows that applicant's services likely include using artificial intelligence in connection with cryptocurrencies. In other words, applicant is using "artificial intelligence related to units of cryptocurrency," or "TOKEN AI". Moreover, applicant's website, attached and linked below, confirms that applicant is providing consumers with artificial intelligence software to manage cryptocurrency tokens. Therefore, the mark "TOKEN AI" merely describes a characteristic of applicant's services and is refused.

Token AI: <https://tokenai.io/>

SUPPLEMENTAL REGISTER

Although an amendment to the Supplemental Register would normally be an appropriate response to the Section 2(e)(1) refusal above, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the application effective filing date will be the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for an amendment to allege use. TMEP §§816.02, 1102.03; *see* 37 C.F.R. §2.75(b). In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages to the registrant:

- (1) Use of the registration symbol ® with the registered mark in connection with the designated goods and/or services, which provides public notice of the registration and potentially deters third parties from using confusingly similar marks.
- (2) Inclusion of the registered mark in the USPTO's database of registered and pending marks, which will (a) make it easier for third parties to find it in trademark search reports, (b) provide public notice of the registration, and thus (c) potentially deter third parties from using confusingly similar marks.

- (3) Use of the registration by a USPTO trademark examining attorney as a bar to registering confusingly similar marks in applications filed by third parties.
- (4) Use of the registration as a basis to bring suit for trademark infringement in federal court, which, although more costly than state court, means judges with more trademark experience, often faster adjudications, and the opportunity to seek an injunction, actual damages, and attorneys' fees and costs.
- (5) Use of the registration as a filing basis for a trademark application for registration in certain foreign countries, in accordance with international treaties.

See 15 U.S.C. §§1052(d), 1091, 1094; J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§19:33, 19:37 (rev. 4th ed. Supp. 2017).

ADVISORY – WORDING APPEARS TO BE GENERIC

Applicant is advised that, if an acceptable allegation of use and an amendment to the Supplemental Register are filed, applicant will be required to disclaim “AI” because such wording appears to be generic in the context of applicant’s goods and/or services. See 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986); TMEP §1213.03(b).

The following is the standardized format for a disclaimer:

No claim is made to the exclusive right to use “AI” apart from the mark as shown.

TMEP §1213.08(a)(i).

Although applicant’s mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

IDENTIFICATION OF SERVICES

The wording noted below in the identification of services is indefinite and must be clarified because it does not specify the nature of applicant’s services or the common name for applicant’s services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The trademark examining attorney has previously discussed the suggestions below with applicant’s attorney. Based on those conversations, applicant may substitute the following wording, if accurate (additions in **bold**):

International Class 42: Software as a service (SAAS) services featuring **software for** cryptocurrency market and portfolio analysis; Platform as a service (PAAS) featuring **computer software platforms for** cryptocurrency market and portfolio analysis; Platform as a service (PAAS) featuring computer software for data mining and data analytics; computer software for creating and controlling artificial intelligence; **Software as a service (SAAS) services featuring software for** artificial intelligence based data analysis, pattern discovery, process automation, contextual prediction, predictive analytics, predictive modelling, recognition of data and market patterns resulting from asset metrics and features, segmentation of asset data, market data, external data sources, social media and other data sources, regression in the nature of analysis regression and asset performance and metrics regression, decision support in the nature of consumer and professional asset trading and visualization services in the nature of visualizing analysis results and recommendations.

Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. See TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). See TMEP §1402.04.

RESPONSE GUIDELINES

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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