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

Proceeding	88142672
Applicant	Patent Bots LLC
Applied for Mark	PATENT BOTS
Correspondence Address	ABRAHAM LICHY THE LICHY LAW FIRM PC 222 EAST 68TH STREET NEW YORK, NY 10065 UNITED STATES alichy@lichylaw.com, dhalberstein@lichylaw.com 917-933-3895
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Filer's Name	Abraham Lichy
Filer's email	alichy@lichylaw.com
Signature	/Abraham Lichy/
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## Applicant's Appeal Brief

MARK: PATENT BOTS  
SERIAL NO.: 88142672  
APPLICANT: Patent Bots LLC  
FILING DATE: October 4, 2018  
INTERNATIONAL 042  
CLASS:  
TO: Trademark Trial and Appeal Board

Applicant, Patent Bots LLC (“Applicant”) respectfully submits this Appeal to the trademark examiner’s Final Refusal to the Office Action issued on January 29, 2020 against Application Serial No. 88142672 for the PATENT BOTS mark (for, Class 042, as amended – *Providing a web site featuring technology that enables users to process patents and patent applications and find errors and mistakes in patents and patent applications; Providing a web site featuring technology that enables users to obtain information, analytics, and statistics about patent examiners; Providing a website that gives computer users the ability to process patents and patent applications and find errors and mistakes in patents and patent applications; Providing a website that gives computer users the ability to obtain information, analytics, and statistics about patent examiners; Providing an interactive website featuring technology that allows users to process patents and patent applications and find errors and mistakes in patents and patent applications; Providing an interactive website featuring technology that allows users to obtain information, analytics, and statistics about patent examiners* (the “Mark”).

The Examining Attorney has refused registration on the ground that the Mark is merely descriptive of Applicant’s goods, under 15 U.S.C. § 1052(e)(1). Consequently, Applicant respectfully requests that the Board overturn the examiner’s refusal because the Mark is not merely descriptive, rather, the Mark is suggestive.

### **The Mark is Not Merely Descriptive Because it is Suggestive**

A trademark is not merely descriptive if it does not immediately tell an average potential purchaser what the goods or services are. *In re Energy Resources Corporation*, 173 USPQ 510 (TTAB 1972) (holding ENERGY RESOURCES not merely descriptive of the services of exploration for and production of oil and gas for others). If a trademark does not without interpretation and imagination describe the goods or services, then the trademark is not merely descriptive. *In re The Gracious Lady Service, Inc.*, 174 USPQ 340 (TTAB 1972). If the mental leap between the mark and the applicant’s goods and services is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. *See McCarthy On Trademarks* (4<sup>th</sup> ed.), § 11.67 at 118. Further, a trademark is not merely descriptive if it is not needed by others to describe the goods or services. *See McCarthy On Trademarks* (4<sup>th</sup> ed.), § 11.68.

Applicant’s Mark is PATENT BOTS. The Office reasons that this is merely descriptive because “patent” is “an official document conferring a right or privilege” and “bot” is “a computer program that performs automatic repetitive tasks”. The Examining Attorney appears to contend that the term “BOTS” is descriptive of all services implemented in software, but, respectfully, this position directly contradicts many trademarks registered by the USPTO.

In the Office Action, the Examining Attorney asserts that Applicant’s Mark “describes a characteristic of the service, namely, that they are online technology using automation in patent drafting,” and that “PATENT” and “BOTS” immediately describe a “characteristic of the services, namely, that they are automated patent drafting proofreading services.” Notably, however, it is not clear from the Office

Action how a consumer could perceive the terms “PATENT” and “BOTS” and arrive at the conclusion that the mark represents “patent drafting,” “patent drafting proofreading services,” or, among other services, technology enabling users to find information regarding patent *examiners*.

While the Examining Attorney indicates that the only software application relating to patents must be drafting and proofreading services, this is not the case. Software has a variety of uses related to patents, including:

- finding prior art for a patent;
- performing freedom to operate searches;
- determining patent value;
- determining patent validity;
- determining patent infringement;
- translating patents to another language;
- determining the quality of coverage of a patent;
- determining the classification of a patent according to invention technology;
- processing patents to determine quality of individual patent attorneys or law firms;
- and comparing coverage of two different companies’ patent portfolios.

The above software application examples are remarkably different from each other, but using the Examining Attorney’s definition, “PATENT BOTS” would be descriptive of each and every example because they are all implemented in software.

Moreover, based on the Examining Attorney’s definition of “BOT”, which again it defines as “a computer program that performs automatic repetitive tasks,” that definition does not describe the services for which Applicant has applied. Applicant has applied for services pertaining to *Providing a website* – not for “computer software”. Thus, while there may be a technological component contained on its website, this creates a multi-step process to arrive at the conclusion that “Bots” is descriptive of a service which is for *providing a website*, and therefore cannot be found to be descriptive. Moreover, among other of its applied-for services, “Providing an interactive website featuring technology that allows users to obtain information, analytics, and statistics about patent examiners”. This service has two distinct qualities which make the mark non-descriptive.

First, the fact that the website is *interactive* distinctly implies that there is a human component to the process involved in using Applicant’s website. By its very nature, the word “interactive,” which means “involving the actions or input of a user,” a human user is required to input information. Thus, the Examining Attorney’s argument that because Applicant’s website advertises that its users can “increase your efficiency and quality with our automated proofreading” it somehow means that it is therefore a “computer program that performs automatic repetitive tasks” is inapposite. There is a human component involved in utilizing Applicant’s website that cannot be divorced from the process. Because of this human component, the website is not merely a “bot” but rather an interactive website which humans can interact with in a meaningful and substantive manner.

Second, the website allows users to obtain information, analytics, and statistics about patent *examiners*. It would follow then that “Patent” in this context could not be descriptive of this type of service because a “patent examiner” is not “an official document conferring a right or privilege.” Therefore it cannot be maintained that PATENT BOTS is merely descriptive of this service.

Applicant submits that the terms “PATENT” and “BOTS” cannot possibly describe all of the above software applications (including all the ones listed above that Applicant does not provide) relating to

patents. It would be a leap of the imagination for a consumer to perceive the two terms that make up the mark and arrive at a conclusion that they represent any of those specific applications. Accordingly, Applicant maintains that “PATENT BOTS” is not descriptive but is suggestive of a website featuring technology that relates to patents.

The USPTO has permitted numerous standard character marks on the principal register (and not on the basis of 2(f)) that include the terms “BOT” for goods and services related to software. Applicant refers the Board to the following standard character marks on the principal register that include “BOT” for goods and services related to software that do not disclaim “BOT”.

<b>Mark</b>	<b>Registration No.</b>	<b>Class</b>	<b>Goods/Services</b>
SCANBOT	5882279	9	Mobile application computer software for scanning images and documents, data processing, taking photographic images, creating and converting PDF files, optical character recognition, reading optical code and barcodes, data management, document management, converting document images into electronic formats, document automation, editing, transmission of photographs to mobile telephones and for organizing and viewing digital images and photographs
COINBOT	5763306	42	Platform as a service (PAAS) featuring computer software platforms for buying and selling, and sharing information concerning blockchain and crypto currency; Providing on-line non-downloadable computer software for use as a cryptocurrency wallet
TUNEBOT	5676075	9	Software for entertainment bars, restaurants, senior venues, resorts, private events, and entertainment venues for controlling musical selections and running music based bingo games
BOTKEEPER	5674319	42	Software as a service (SAAS) services featuring software for use in accounting, bookkeeping, account record keeping, virtual accounting, automated bookkeeping, machine learning, process automation and automated data entry
STYLEBOT	5648703	9	Downloadable mobile applications for analyzing a user's physical appearance and recommending garment colors and products to the user; Downloadable computer software for analyzing a user's physical appearance and recommending garment colors and products to the user
MEASUREBOT	5648698	9	Downloadable mobile applications for measuring the sizes of garments and uploading those sizes to other applications; Downloadable computer software for measuring the sizes of garments and uploading those sizes to other applications

PAGEBOT	5587257	9	Downloadable software for use in the open source development of typographic design and the design of publication pages for print, electronic publishing and use on the Internet developed in a computer programming language
DOCUBOT	5302627	9	Computer application software for mobile phones, namely, software for the automation of document creation; database management software for the automation of document creation; downloadable cloud-based software for the automation of document creation; software for the automation of document creation
TRAFFIBOT	5225907	9	Measurement devices for traffic safety technology, in particular distance, speed and traffic control devices as well as traffic monitoring devices, in particular for red-light monitoring, for recording vehicle registration marks, for recording and verifying the payment of road tolls, for recording traffic density, traffic flow, and vehicle types, namely, radar apparatus and cameras, radar detectors, radar guns for police work, radar object detectors for use on vehicles; electric, electronic, and optoelectronic sensors, especially for the aforementioned devices, in particular electric radar sensors, electric laser sensors, piezo electric sensors, induction loops in the nature of electrical inductors, and video cameras; electronic and optoelectronic proximity sensors; position control and docking electric sensors; tactile and non-contact electric sensors and measuring heads, namely, distance, speed, traffic density and traffic flow measuring apparatus; electric measuring devices, namely, instruments for measuring length, distance, speed, traffic density and traffic flow; radar guns for police work; antennas; storage devices for data processing systems, namely, blank electronic storage media, blank flash drives, high-speed storage subsystems for storage and backup of electronic data either locally or via a telecommunications network, external computer hard drives computer storage devices; image receiving devices, namely, digital media receivers; image reproduction devices, namely, apparatus for reproduction of images; time-recording apparatus; analytical devices, not used for medical purposes, namely, analysis instruments for photogrammetric purposes, luxmeters being devices for measuring the brightness or illumination of a surface, liquid analyzers, photometers; flashlight devices, namely, flashlights for use in photography, flashlights with light emitting diodes for use in photography; data processing apparatus for data evaluation; optical signaling systems, namely, traffic lights, variable vehicle traffic signals; Traffic-light apparatus signaling devices; electric traffic information systems, namely, electronic LED signs, LED vehicle traffic signals, traffic control equipment, namely, actuated and pretimed traffic signal controllers, Traffic lights, Traffic

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