

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: The Ronald Reagan Presidential Foundation  
Serial No.: 85/233,487  
Filed: May 4, 2011  
Mark: GUIDECAM  
Examiner: Jennifer Vasquez  
Law Office: 113

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE TO OFFICE ACTION DATED MAY 4, 2011**

In response to the Office Action dated May 4, 2011, kindly consider the following comments in connection with the above-identified application.

**Identification of Goods and Requirement for Further Specificity**

In the Office Action, the Examining Attorney asserts that the designation of goods in Class 9 is indefinite and must be clarified because it is “indefinite as to the specific type of wireless devices.” May 4, 2011 Office Action at p. 4. The Examining Attorney has suggested that Applicant amend the Class 9 designation of goods by adding the words “handheld electronic” before the words “wireless devices” in the Class 9 designation of goods. Applicant respectfully requests that the Examining Attorney withdraw this requirement.

In support of Applicant’s position that no further specificity should be required with respect to wireless devices in its Class 9 designation of goods, Applicant submits herewith as

Exhibit A a printout of a page from the USPTO's current *Acceptable Identification of Goods and Services Manual*. The manual shows that the term "wireless devices" is sufficiently specific if the designation specifies the function of the wireless device. Further, the manual shows that the term "wireless devices" itself is acceptable for use in a designation of goods when used as part of a designation for computer software. For example, the designation "electronic game software for wireless devices" is acceptable. Further, the designation "wireless communication devices for voice, data or image transmission" is also an acceptable identification of goods. Further, by analogy, a computer software designation is sufficiently specific if the designation specifies the function of the program and, if software is content- or field-specific, the content or field of use. See Exhibit B for excerpt from the Trademark Office's current *Acceptable Identification of Goods and Services Manual* with respect to acceptable identification for computer software.

In this case, Applicant has described the function of its wireless devices as featuring software to facilitate tours of museums. Applicant has also indicated that its wireless devices are interactive and used to capture and upload digital images for future use. Accordingly, Applicant believes that the designation of the Class 9 goods as is presently set forth in the application is consistent with current USPTO practice and should be accepted.

#### **Refusal to Register Based On Descriptiveness**

With the Amendment to Allege Use filed for this application, Applicant seeks to register the mark GUIDECAM for the following goods and services: "wireless devices featuring software for facilitation of tours of museums; interactive wireless devices for capturing and uploading digital images for future use" in Class 9; and "providing self-guided tour services via wireless devices featuring prerecorded information about museum exhibits" in Class 39. The

Examining Attorney has refused registration under Trademark Act § 2(e)(1), 15 U.S.C. § 1052 (e)(1) asserting that the mark GUIDECAM “merely describes a feature of applicant’s goods and/or services.” May 4, 2011 Office Action at p.1.

In support of her refusal, the Examining Attorney reasons as follows:

The mark is descriptive of the applicant’s goods and services because according to [ ] applicant’s website the applicant provides devices that feature a camera for providing tour guide services and subsequent digital image printing. The term “guide” is descriptive because the wireless devices are used to “guide” the user through the museum where the users can take digital pictures to be printed at a later time. The term “cam” is short for camera. [ ]. The applicant’s website states the following:

*Through the use of cutting edge technology, the newly renovated Ronald Reagan Presidential Library and Museum encourages interactivity through dozens of hands-on exhibits and through the use of our new, one-of-a-kind GuideCam™.*

*This special, patent-pending device provides a state-of-the-art audio tour of the Museum, featuring over 50 audio stops in the voices of President and Mrs. Reagan. But the GuideCam™ is more than just an audio wand. **The GuideCam™ is also a still camera and video camera. Take photos and video throughout your museum experience capturing your special moments that will last a life time. By the time you get home from your museum visit, all of your photos and video will be waiting for you in your email inbox! Share your photos and videos with your friends and family through email, FaceBook, YouTube and Twitter!***

*If you’re visiting the Reagan Library, make sure to enhance your visit with the GuideCam™. You’ll be glad you did!*

When combined, the applicant’s entire mark “GUIDECAM” immediately indicates the nature of the goods and services, namely, a wireless device that features a camera used to guide users and used to store pictures that will be printed by the applicant for the user.

May 4, 2011 Office Action at p. 2 (emphasis in original)

The Examining Attorney's reasoning does not, however, consider the essential conclusion that must be reached before a mark can be deemed "merely descriptive" so as to support a refusal under Section 2(e)(1). To be characterized as merely descriptive, the mark as a whole must directly and immediately give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product or service. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. 55 (2d Cir. 1961); *accord*, *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968); *In re Pennzoil Products Co.*, 20 U.S.P.Q.2d 1753 (T.T.A.B. 1991).

If information about the product or service given by the term used as a mark is indirect or vague, requiring imagination, thought or perception to reach a conclusion about the nature of the goods or services, then the term is being used in a suggestive, not descriptive, manner. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968). A mark that is suggestive is considered inherently distinctive and is entitled to trademark protection without proof of secondary meaning. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d 1081, 1083 (1992). The distinction between a descriptive mark and a suggestive mark is subtle. *SiLite Inc. v. Creative Bath Products, Inc.*, 33 U.S.P.Q.2d 1308 (N.D. Ill. 1994). However, "[i]t is well-established that, when there is doubt as to whether a mark is merely descriptive, such doubt should be resolved in favor of the [A]pplicant." *In re Eden Foods Inc.*, 24 U.S.P.Q.2d 1757, 1762 (T.T.A.B. 1992) (Seeherman, member, dissenting) (citing *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983)).

In this case, the Examining Attorney has focused on the meaning of the term "cam" as shorthand for "camera" and the feature of Applicant's goods that allows for the capture of

images. Further, by dissecting the mark and making an additional inference of the words “museum” and “tour” as part of the mark, she has concluded that the term “guide” standing alone is descriptive of Applicant’s goods and services. However, the Examining Attorney has not considered the commercial impression of the mark as a whole and the incongruity created by the juxtaposition of the term “cam” with the word “guide.” Neither “camera” or “guide,” as those terms are commonly understood, have any meaning in relation to each other, whether in terms of functionality or otherwise. Further, without the additional inference of the words “museum” and “tour,” the word “guide” has no meaning in relation to Applicant’s specific goods or services. The commercial impression created by the combination of two terms results in an incongruity that causes the consumer to ponder the meaning of the mark GUIDECAM in the context of Applicant’s goods and services. Accordingly, Applicant asserts the mark GUIDECAM, as applied to its designated goods and services, is a coined arbitrary mark or is at most, by additional inference, suggestive of multipurpose functionality.

*GUIDECAM Mark is Arbitrary or Coined*

In determining whether a mark is merely descriptive or whether it is suggestive or arbitrary, the Examining Attorney must consider the evidence of record. T.M.E.P. § 1209.02. In this case, the Examining Attorney has provided evidence that “cam” is a shorthand phrase for camera. However, in order to understand the trademark significance of the mark GUIDECAM as a whole, it is necessary to also consider the individual meanings of “guide” and “camera” as applied to Applicant’s goods and services and the incongruity of their meaning *in combination* in the context of each other and Applicant’s goods and services.

In the context of Applicant's goods and services, the term "camera" means "a device for recording visual images in the form of photographs, movie film, or video signals." NEW OXFORD AMERICAN DICTIONARY 247 (2d ed. 2005). See Exhibit C attached hereto. The word "guide" has various meanings as a noun or a verb. The New Oxford American Dictionary provides four definitions of the term as a noun: (1) a person who advises or shows the way to others; (2) a thing that helps someone to form an opinion or make a decision or calculation; (3) a structure or marking that directs the motion or positioning of something; and (4) a soldier, vehicle, or ship whose position determines the movement of others. *Id.* at 751. As a verb, the term "guide" has two meanings: (1) show or indicate the way to (someone); and (2) direct or have an influence on the course of action of (someone or something). *Id.* A copy of the New Oxford American Dictionary definition of "guide" is submitted herewith as Exhibit D.

The commercial impression of the mark GUIDECAM is created by the *combination* of the individual terms "guide" and "cam." Based on the definition of "camera" and common knowledge, a camera does not act as a guide in any way; rather, it takes pictures. Further, there is nothing in the definition of "guide" that suggests it has any relation to the term "camera," indicates any particular type of camera, or indicates that a camera could itself acts as a guide. Further, without the additional inference of the words "museum" and "tour", the word "guide" does not even have meaning with respect to Applicant's goods or services much less any meaning in relation to the term "camera."

Thus, considering the individual meanings of the terms "guide" and "camera" and the commercial impression created by the combination of the terms "guide" and "cam," it can be readily seen that Applicant's GUIDECAM mark does not directly describe Applicant's goods

and services. The goods are not, as the Examining Attorney asserts “a wireless device that features a camera used to guide users . . . .” May 4, 2011 Office Action at p. 2. Rather, Applicant’s goods have multi-purpose functionality. The device enables an audio tour of the museum. Separately, it also acts as a still and video camera that enables the user to take photographs during the tour. However, these are two separate functions, and, without additional inference or thought, the consumer is not readily informed of this dual functionality. In order to gain a reasonably distinct understanding of the nature of the goods, one would need to mentally insert (i) the words “museum” and “tour” before the word “guide;” and (ii) the words “device that also serves as a” before the term “cam.”

Moreover, even (assuming for the sake of argument) that the terms “cam” or “camera” and “guide” by themselves are descriptive, it is well established that the combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is not “merely descriptive.” *See, e.g., Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557 (T.T.A.B.) *aff’d*, 189 U.S.P.Q. 348 (C.C.P.A. 1976) (holding BIAS-TEEL for steelbelted bias tires as only suggestive, not descriptive, as a composite term). That is, the commercial impression of a composite mark may be arbitrary or suggestive even though the separate parts are descriptive.

In this case, the composite mark GUIDECAM is more than the mere sum of its parts. Descriptive, even generic, words may, when used in combination, become a valid trademark. *See, Association of Co-Operative Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134, 216 U.S.P.Q. 361 (5<sup>th</sup> Circuit 1982), *cert. denied*, 460 U.S. 1038 (1983). Moreover, under the anti-dissection rule, a composite mark is tested for its validity and distinctiveness by looking at it

as a whole, rather than dissecting it into its component parts. *See, California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, 810 (9<sup>th</sup> Cir. 1985). In fact, in reversing the Board's decision that the mark HUTCHINSON TECHNOLOGY was "merely descriptive," the Federal Circuit observed in *In re: Hutchinson Technology* that the "fatal flaw" in the Board's reasoning was its focus on the meanings of the individual terms comprising the mark HUTCHINSON TECHNOLOGY. 7 U.S.P.Q.2d 1490, 1492 (Fed. Cir. 1988). The Board's failure to recognize that the mark sought to be registered was not HUTCHINSON or TECHNOLOGY, but, rather, was HUTCHINSON TECHNOLOGY resulted in the Board's not considering what the purchasing public might think when confronted with the mark as a whole. *Id.*

Thus, even if the individual words "guide" or "cam" could be said to have some meaning with respect to some aspect of Applicant's goods and services does not mean that, in combination, the mark GUIDECAM is "merely descriptive" or are incapable of having trademark significance. Given the individual meanings of the terms "guide" and "cam" and the incongruity between them when combined, Applicant contends that the mark GUIDECAM, taken as a whole, is a coined, arbitrary term.

*GUIDECAM Mark is at Most Suggestive*

As noted previously, Applicant's goods for which it uses the GUIDECAM mark have multipurpose functionality. However, the mark GUIDECAM, taken as a whole, does not immediately, without additional thought of inference, inform the consumer of this multipurpose functionality or the specific nature of that functionality or the purpose of the goods and services. Upon encountering the mark GUIDECAM in the marketplace, the consumer must first ponder

the incongruity resulting from the juxtaposition of the term “guide” with the term “cam”. Assuming the consumer would infer that the goods had some kind of camera feature, the consumer would recognize the incongruity of the term “cam” in combination with “guide” in that a camera takes pictures and in no way “guides.” The consumer must go on to conclude that the goods have some functionality other than as a camera and speculate on the meaning of the term “guide” in the context of the goods. To gain a tolerably distinct understanding of the nature of the goods, the consumer would need to make the additional inferences about the goods such as by making mental insertions of additional words in the nature of those suggested above. The need for these inferential steps, however, shows the suggestiveness, not the descriptiveness of the mark GUIDECAM as applied to the goods and services at issue.

Applicant’s assertion that the term GUIDECAM as applied to Applicant’s goods is at most suggestive is supported by the TTAB’s decision in *Plough, Inc. v. Florida Tan Products Co., Inc.*, in which the Board concluded that the mark FLORIDA TAN was suggestive rather than descriptive of suntan lotion. 174 U.S.P.Q. 46, 47–48 (T.T.A.B. 1972). In that case, in support of its position that the mark FLORIDA TAN was descriptive, the opposer asserted that the mark immediately conveyed to the consumer that the applicant’s suntan lotion will produce a tan like one he would get in Florida; *i.e.*, a Florida tan. *Id.* The Board disagreed, saying that opposer’s statement indicated the suggestiveness of the term. The Board observed that a Florida tan can be obtained only by basking in the sun in Florida; it cannot be poured out of a container.

Applicant’s assertion that the GUIDECAM mark is at most suggestive is also supported by *BellSouth Corp. v. Planum Tech. Corp.*, 14 U.S.P.Q.2d 1555 (T.T.A.B. 1988). In that case, the Board held that the mark PHONE FORWARD was suggestive of automatic telephone call

diverters. U.S.P.Q.2d at 1556. The Board reasoned that the applicant's PHONE FORWARD mark was a "somewhat incongruous combination of words and requires a modicum of imagination or thought to determine the nature of applicant's product." *Id.* "We believe," said the Board, "that a multi-stage reasoning process (*i.e.*, substituting the word "call" for the word "phone" used as a verb) is necessary in order to ascertain the nature or function of applicant's goods. At worst, applicant's mark is highly suggestive of a feature or function of the product." *Id.*

As with FLORIDA TAN and PHONE FORWARD, upon encountering the GUIDECAM mark, a multi-stage reasoning process is required to learn the nature of Applicant's goods and services. Applicant's goods, while having camera functionality, are not in the nature of a "wireless device that features a camera used to guide users" as the Examining Attorney has asserted. The mark may suggest goods and services that have a camera feature and some other function, but it does not directly convey a meaning as to their actual nature without additional inferences, thought or imagination.

In light of the arguments and evidence presented, Applicant respectfully submits that the mark GUIDECAM as applied to its designated goods and services is a coined, arbitrary term, or is at most, suggestive. At the very least, Applicant has raised doubt as to whether the mark is merely descriptive which should be resolved in its favor. Accordingly, Applicant respectfully requests that the Section 2(e)(1) refusal on the basis of the mark being "merely descriptive" be withdrawn.

In light of the foregoing and having responded to all issues raised in the Office Action dated May 4, 2011, Applicant respectfully requests that this application be approved for publication.

Respectfully submitted,

Dated: Nov. 3, 2011



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