

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

In Re Application of Lucio Volpi
Application Serial No. 90799675
Tracking No. ESTTA1286554
Application Filed June 28, 2021
Appeal Filed: May 22, 2023
Examiner: Shaila Lewis

DRONABOT

APPLICANT’S EX PARTE APPEAL BRIEF

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STATEMENT OF THE CASE

The present brief is in response to the final office action dated April 7, 2023, regarding registration application No. 90799675 for the mark “DRONABOT”. The examining attorney has refused registration of the mark under section 2(e)(1) of the Lanham Act on grounds of the mark being allegedly merely descriptive of the goods. See 15 U.S.C. §1052(e)(1). For the reasons discussed below the applicant respectfully disagrees with the examining attorney’s refusal and requests a reversal of the examiner’s final office action. See 15 U.S.C. § 1070.

THE TRADEMARK APPLICATION

The applicant has applied to register the word mark “DRONABOT” in international class 12 with respect to applicant’s intended use in connection with the sale of drones.

ARGUMENT

The Applicable Law

The determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960 (Fed. Cir. 2007). Substantial evidence is more than a scintilla of evidence but less than a preponderance; it is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. See *In re Pacer Technology* 338 F.3d 1348, 1350 (Fed. Cir. 2003). See also *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed.Cir.2010). It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services. *In re Gyulay* 820 F.2d 1216 (Fed. Cir. 1987). Suggestive marks are those that, when applied to the goods or services at issue, require some imagination, thought, or perception to reach a

conclusion as to the nature of those goods or services. See TMEP § 1209.01(a). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). A mark does not have to be devoid of all meaning in relation to the goods or services to be registrable. *Id.* On appeal, the Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant. See e.g., *In re Fat Boys Water Sports LLC* 118 USPQ2d 1511 (TTAB 2016).

Summary Of Argument

In this case the applicant's mark "DRONABOT" has been rejected by the examining attorney on the grounds that it is allegedly merely descriptive.

It is not disputed by the examining attorney that the mark "DRONABOT" is unique, and that there is no evidence of anyone else having ever used "DRONABOT" to describe drones or anything else. It is also not disputed that "DRONABOT" is not a just a combination of descriptive words.

Rather the examining attorney's only basis for refusing registration is an allegation that applicant's unique mark "DRONABOT" is merely descriptive of drones because, according to the examining attorney, it is the phonetic equivalent of an intentional misspelling of the term "drone bot". The examining attorney alleges that the term "drone bot" is a well-known descriptive term to the average customers of drones.

The issue on appeal is whether there is substantial evidence of record to support the examiner's refusal. As explained herein, and in the record below, there is

no substantial evidence supporting the examining attorney's refusal, which in view of the other evidence of record appears to be an entirely arbitrary refusal. Applicant's unique mark "DRONABOT" is at the very least suggestive on the spectrum of distinctiveness, and as such is entitled to registration. The examining attorney's refusal should be reversed.

The Prosecution Background

It should be noted at the outset that what sparse evidence the examiner has made of record concerning the very rare usage in obscure corners of the internet of the term "drone bot" is the cumulative result of THREE separate searches performed by the examining attorney. It begs the question that, if the term "drone bot" is such a well-known descriptive term for average consumers of drones, as alleged by the examining attorney, why did it take the examining attorney three separate searches to come up with what can still reasonably be characterized as just a scintilla of evidence of *any* usage of the term "drone bot"?

The Examining Attorney's First Search

In the first rejection by the examining attorney the only evidence of the use of the term "drone bot" presented by the examiner consisted of just passing mentions in an obscure 2019 engineering journal article, and in a 2021 defense blog post. When the applicant rebutted this inadequate evidentiary showing, the examining attorney responded by performing another search. See Applicant's August 19, 2022, Response to First Office Action.

The Examining Attorney's Second Search

The result of that examining attorney's second search was just:

- (1) A single CNET website post discussing an experimental robot from a research laboratory at Caltech that used the term drone-bot once in passing.
- (2) A Singularity Hub post discussing another research laboratory “drone robot” from the University of Tokyo which used the term drone-bot in passing only twice.
- (3) A Facebook page presented for a “DroneBot Workshop” which was a collection of “tutorials” on social media for electronic hobbyists to build “custom quadcopters, robots and devices for the Internet of Things (IoT)”.

There was not a single piece of evidence presented by the examining attorney of the term “drone bot” ever being used in connection with, or known to the average consumer of, commercially available drones. It was again pointed out to the examining attorney that this scintilla of evidence of the very infrequent use in obscure settings on the internet of the term “drone bot” did not rise to the level of substantial evidence that “drone bot” was for the average consumer a well-established descriptive term for drones, or that DRONABOT was an intentional misspelling of such term. See Applicant’s February 16, 2023, Response to Second Office Action.

The Examining Attorney’s Third Search

In response to the applicant’s rebuttal of the second search evidence, the examining attorney performed yet another search. The results of this third search still does not provide substantial evidence in support of the examining attorney’s position. Specifically, the examining attorney argues in the final office action, for example, that

the evidence presented from Target shows that the wording “dronebot” is used to refer to drones. This assertion is inaccurate to say the least.

The evidence produced by the examining attorney from Target is a website page produced in response to a search query from the examining attorney on Target’s website for the words “drone bot”. The website page simply shows that these were the words of the examining attorney’s search query. Not even one of the results returned from the examining attorney’s search query on Target.com shows use of the term “drone bot” in relation to any product. It is quite apparent that the Target search engine simply returned search results responsive to the word “drone” found in the examining attorney’s search query.

The other evidence proffered by the examining attorney from the third search was again just a few examples of obscure sites on the internet that happened to refer to the term “drone bot”. In sum, after three separate searches the examiner failed to produce substantial evidence that “drone bot” is a well-known descriptive term for drones to the average consumer of drones.

There Is No Substantial Evidence That “Drone Bot” Is A Well-Known Descriptive Term Used by Average Consumers of Drones

As explained above, the examining attorney has searched the internet multiple times and returned with just a few isolated examples of others using the term “drone bot” in obscure settings. It is respectfully submitted that this sparse evidence that the examiner has located on the internet does not constitute *substantial* evidence supporting a conclusion that the term “drone bot” is a descriptive term for drones known to the average customer of commercially available drones. At the very least

there is room for considerable doubt as to whether the average customer of commercially available drones has any familiarity at all with the term “drone bot”, and all doubts must be resolved in favor of applicant. See e.g., *In re Fat Boys Water Sports LLC* 118 USPQ2d 1511 (TTAB 2016).

The Applicant’s DRONABOT Mark Is Not a Visual or Phonetic Equivalent of a Merely Descriptive Term for Drones.

The examining attorney’s refusal relies entirely upon the argument that the law does not permit the registration of a mark if it is just a novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term for the goods. See November 15, 2022 Office Action at page 2.

The legal authority that has been cited by the examining attorney for support are very clearly distinguishable on their facts from the present case: For the cited case of *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 526 & n.9, 205 USPQ 505, 507 & n.9 (C.C.P.A. 1980), “QUIK-PRINT” was phonetically the same as the descriptive term “Quick-Print”. For the cited case of *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017), “SHARPIN” was phonetically the same as the descriptive term “Sharpen”. For the cited case of *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009), “URBANHOUSING” was phonetically the same as the descriptive term “Urban Housing”.

By contrast, the applicant’s mark DRONABOT is not phonetically equivalent to either “drone” or to the term “drone bot”. DRONABOT sounds very different than “drone” and sounds different from “drone bot” by at least one syllable. Accordingly, DRONABOT is not a novel spelling or intentional misspelling that is the phonetic

equivalent for what is a merely descriptive term used by average customers for commercially available “drones”: It is respectfully submitted that the average customer of drones would be able to easily distinguish DRONABOT both visually and phonetically from the descriptive term “drone”. As explained above, there is no substantial evidence that the average customer of drones ever uses or is familiar with the term “drone bot”. However, even if they did, such customers of drones would also be able to easily distinguish visually and phonetically between applicant’s mark DRONABOT and the obscure term “drone bot” due to the completely different appearance and extra syllable. To the extent there is any doubt concerning this, such doubt must be resolved in favor of applicant. See e.g., *In re Fat Boys Water Sports LLC* 118 USPQ2d 1511 (TTAB 2016).

The Examining Attorney’s Refusal Is Arbitrary

Marks don’t need to be devoid of any reference to the goods. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). Indeed, there are numerous marks already registered by the USPTO on its principal register that are marks combining the terms “drone”, robot”, or “bot” for use in connection with goods or services related to drones:

	MARK	U.S. Registration	Goods / Services
1.	AERODRONE	88254277	Aerial cinematography services.
2.	CITYDRONEZ	90331033	Surveying Services Using Drones
3.	CONSTRUCTOBOT	88445565	Automated Machines for Construction
4.	DANGERDRONE	87120271	Drones For IT Security Services

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	MARK	U.S. Registration	Goods / Services
5.	DRONEALYTICS	87705319	Analysis of Data Gathered by Aerial Means
6.	DRONEAWARE	88820425	Analysis of security threats from unmanned aerial systems.
7.	DRONEHUNTER	87334437	Unmanned aerial vehicles.
8.	DRONEMAPSTER	87497823	Mapping services through the use of drones.
9.	DRONEWORKS	88136691	Retail store services featuring drones.
10.	GREETBOT	88155783	Humanoid robots with artificial intelligence.
11.	METEODRONE	88838427	Apparatus for automatic collection of weather parameters.
12.	PANADRONE	88657963	Drones
13.	ROBOKLEEN	90315357	Robotic cleaning machines.
14.	ROBOSENSOR	90118640	Robots with sensors.
15.	ROBOTWORX	88660232	Reseller services for robots.
16.	SHOPBOT	88102762	General purpose robotic machine tool for shaping furniture, boats and the like.
17.	SOFTBOT	88715942	Software for robotics.
18.	TIDYBOT	88214977	Robotic vacuum cleaners.
19.	TRANSBOT	90259776	Transforming robotic toy vehicles.

Evidence of the USPTO registration of the above listed marks was submitted by applicant in response to the examining attorney's second refusal to allow the application and is already a part of the record of this application. See Applicant's

February 16, 2023, Response to Office Action. The examining attorney essentially ignored this substantial evidence in issuing a final refusal.

In the face of this substantial evidence the examining attorney's decision to issue a refusal in this case for DRONABOT on the basis that it is allegedly merely descriptive appears entirely arbitrary. The applicant previously applied for registration of a mark that prominently featured the term DRONABOT in it:



See U.S. trademark application serial No. 87937670 which was referenced in Applicant's August 19, 2022, Response to Office Action at page 2.

For application serial No. 87937670 the USPTO issued a notice of publication without any objection or allegation that DRONABOT was a merely descriptive term for the goods. The USPTO then issued a notice of allowance when no opposition was filed after publication of the application.

There are reasons why the law requires *substantial* evidence to support any government administrative agency decision. See 5 U.S.C. §706. One such reason is to prevent the unequal treatment of the public based on the whims or purely personal opinions of individual government agency employees: Such as individual USPTO examining attorneys processing trademark registration applications.

In this case the *overwhelming* weight of the evidence of record is that the USPTO is routinely willing to register, and does register, trademarks for use in connection with drones or robots that expressly contain the words “drone” or “bot”. The evidence of record also indisputably shows that a different USPTO examining attorney did not find applicant’s unique term DRONABOT to be merely descriptive of drones. The examining attorney’s refusal in this case to allow registration of the DRONABOT mark is thus by all appearances an entirely arbitrary decision based solely on the examining attorney’s personal opinion and not the substantial evidence that is required by law.

The DRONABOT Mark Is Not Descriptive, and Is No More Than Suggestive

That the mark DRONABOT might be suggestive to the average consumer of the goods being a drone does NOT make the mark merely descriptive but rather makes it *suggestive*: Suggestive marks are those that, when applied to the goods or services at issue, require some imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. See TMEP § 1209.01(a). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). A mark does not have to be devoid of all meaning in relation to the goods or services to be registrable. *Id.*

It is respectfully submitted that the average consumer of commercially available drones would need to exercise some imagination, thought, or perception with the applicant’s unique and non-descriptive term DRONABOT. There is no

substantial evidence to the contrary, and any doubts concerning the suggestiveness of applicant's mark must be resolved in favor of applicant. See e.g., *In re Fat Boys Water Sports LLC* 118 USPQ2d 1511 (TTAB 2016).

Applicant's mark DRONABOT is certainly no more descriptive than other marks that the USPTO has registered on the principal register for use in connection with drones such as "AERODRONE", "DRONEAWARE", and "METEODRONE".

Accordingly, because the applicant's DRONABOT mark is at the very least a suggestive mark, it is entitled to registration in the same manner that other suggestive marks used in connections with drones and robots have been registered.

CONCLUSION

For all the reasons stated herein the applicant respectfully requests that the arbitrary and improper refusal by the examining attorney be reversed.

Date: July 19, 2023

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