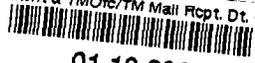




IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re TRADEMARK application of	)	
XMLSolutions Corporation	)	<i>BEFORE THE TRADEMARK</i>
Serial No. 75/816,998	)	<i>TRIAL AND APPEAL BOARD</i>
Filed: October 7, 1999	)	
Mark: XMLSOLUTIONS	)	

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57  
  
 01-18-2002

**APPEAL BRIEF**

Commissioner for Trademarks  
 2900 Crystal Drive  
 Arlington, Virginia 22202-3513

**CERTIFICATE OF MAILING**

**I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on 11-26-01**

Sir:

*S. Strain*

Applicant hereby appeals the trademark examining attorney's refusal to register the above-captioned mark XMLSOLUTIONS under section 2(e)(1) of the Trademark Act. Contrary to the examining attorney's contention, the mark does not describe a characteristic, feature, function, or purpose of the services with which the mark is used. Accordingly, Applicant requests that this refusal be withdrawn.

**FACTS**

1. Applicant is seeking registration of the mark XMLSOLUTIONS for computer software services, namely, computer software consulting, computer software

maintenance and development of computer software for the structuring and managing of data for information exchange in International Class 42.

2. An Office Action was received on November 11, 2000 refusing registration of the subject mark under Section 2(e)(1) of the Trademark Act. The Office Action also included informal issues relating to the classification of Applicant's services and objections to the indefiniteness of the recitation of services.

3. In response to the Office Action, Applicant presented arguments against the examining attorney's refusal under Section 2(e)(1). Applicant also amended the recitation of services to more definitely define the nature of the services used in connection with the mark and to direct the services into one class, namely, International Class 42.

4. A second Office Action was received on June 26, 2000 maintaining the refusal to register the mark under Section 2(e)(1) and notifying Applicant of the acceptability of the amended recitation of services.

5. In response to the second Office Action, Applicant further amended the application to narrow the description to better define the services used in connection with the mark. Applicant also presented additional arguments against the examining attorney's refusal to register.

6. A third Office Action was received on February 26, 2001 accepting Applicant's further amended recitation of services and maintaining the refusal to register the mark under Section 2(e)(1).

**ARGUMENTS****A. APPLICANTS MARK IS AT BEST SUGGESTIVE, AS IT DOES NOT IMMEDIATELY CONVEY TO CONSUMERS THE NATURE OF SERVICES WITH WHICH THE SUBJECT MARK IS USED.**

The subject mark is refused registration on the Principal Register because the mark is alleged to be merely descriptive under Section 2(e)(1) of the Trademark Act. A careful review of the subject compound mark itself and evidence relied upon in the final refusal clearly demonstrates that the subject mark is, at best, suggestive of the services for which it has been applied for registration. The subject mark is a compound mark that must be reviewed in its entirety. Furthermore, the evidence relied upon to support the final refusal does not demonstrate descriptive use of the compound mark and does not show the relationship between the definition of the compound term and the services subject to the instant application.

Specifically, it is the composite, compound mark, XMLSOLUTIONS, for which registration is being requested. To be registrable, a mark need not be devoid of all meaning relative to the services. It is not prohibited, for example, that a mark draw attention to what the services or its characteristics are. Such a mark is “suggestive”, which is not the same as “merely descriptive.” A suggestive mark may bring to mind the product or services on which it is used, so long as imagination, thought, or perception are required to reach a conclusion as to the nature of the goods. In order for a mark to be refused registration as descriptive, it must be “merely” descriptive. A “merely” descriptive mark immediately conveys or describes to the consumer the particular services in connection with which the mark is used in terms commonly used in the trade. *Ex parte Heatube*, 109 U.S.P.Q. 423 (Comm. Pats. 1956).

Applicant's compound mark does not merely or immediately describe the services or features of these services for which it is used. This is apparently been found to be the case in a number of registered marks in the computer field that are attached hereto as "Exhibit A" for the Board's consideration. These registrations appear to make it clear that "solutions" is not per se descriptive with regard to all computer related technologies.

In this case, Applicant's services are very specifically directed to computer services relating to structuring and managing of data for information exchange. In such a context, the term "xmlsolutions" does not immediately convey to a consumer that the services relate to such structuring and managing of data. As a result and for the reasons advanced above with respect to prior "solution" containing registrations, the subject mark XMLSOLUTIONS should not be considered merely descriptive.

**B. THE FINAL REFUSAL IMPROPERLY RELIED ON THIRD-PARTY USAGE OF THE TERMS "XML" AND "SOLUTIONS" IN REFUSING REGISTRATION.**

The citations relied upon in the final refusal are not directed to the subject mark XMLSOLUTIONS and do not support the Examining attorney's conclusions. The Examining attorney included a large number of Nexis citations with the Office Actions to support the refusal. These citations are attached hereto as "Exhibit B". Although the citations appear to include uses by the term "xml" and "solutions", they do not demonstrate that the composite term "XMLSOLUTIONS" is actually descriptive of the services applied for in this case.

Specifically, the citations included in Exhibit B are merely a large number of uses of “xml” and “solutions” that are used separately are not used in the composite, compound manner of the instant mark., but instead include additional terms, such as, “solutions for XML” or “XML-based solutions”. These examples are different from the instant composite, compound mark, XMLSOLUTIONS. It is clear from these examples that the Examining attorney improperly equated the different uses of the terms “xml” and “solutions” with Applicant’s mark, which is not sufficient to demonstrate descriptiveness of the composite mark.

Also cited in the Office Action were uses of “XML solutions” with a space between the two terms. Such use of these terms does not necessarily imply that the instant mark is descriptive. Rather, these uses may represent infringing uses of Applicant’s mark.

**C. APPLICANT’S MARK MUST BE ANALYZED AS COMMONLY ENCOUNTERED BY CONSUMERS AND NOT IMPROPERLY DISSECTED.**

Finally, Applicant’s mark is the compound mark XMLSOLUTIONS as a single word. The citations noted with the Office Action fail to include a single use of this compound mark. In this regard, the instant mark must be examined in its entirety as a whole, and not dissected into its component parts. The final refusal merely addresses each of the component parts, but fails to address the composite, compound mark. Moreover, as noted above, all other cited uses of the terms provided by the Examining attorney to support the final refusal include additional terms used in association with

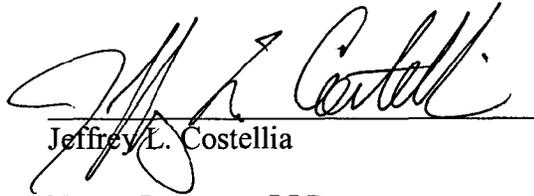
them, or include a space in combination with other explanatory terms. These additional terms must be considered when considering the supporting citations from the Examining attorney, since it is these additional terms that renders the terminology provided therein descriptive when combined with the terms “xml” and “solutions”. The other uses include substantial separation between the terms “xml” and “solutions” which is not relevant to show that the subject compound mark is descriptive of Applicant’s services. Therefore, the compound mark XMLSOLUTIONS should not be considered merely descriptive.

#### **D. CONCLUSION**

Applicant’s mark is at best suggestive and, therefore, qualifies for registration on the Principal Register. Contrary to the Examining attorney’s contention, the mark does immediately convey the nature of the services with which the mark is used. Rather, a significant degree of imagination is required to arrive at the characteristics, qualities, features and purpose of the services. The mere fact that the Examining attorney has cited instances of third-party usage of the individual terms that comprise the subject mark is inconclusive. When the mark is envisioned in its entirety, rather than being improperly dissected into its component parts, it becomes clear that the mark does not merely describe the aspects of the services with which the mark is used. As a result, registration of Applicant’s mark will not result in the exclusive appropriation of a term which is the ordinarily used to describe the subject goods, nor would the registration of Applicant’s mark be detrimental to others who deal in the same goods by hindering their use of normal language used in association of such products. See, *In re Universal Package*, 222 U.S.P.Q. 344 (T.T.A.B. 1984).

In view of the foregoing, it is respectfully requested that the application be passed to publication.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey L. Costellia", is written over a horizontal line.

Jeffrey L. Costellia

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*THANK*



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re TRADEMARK application of	)	
XML Solutions Corporation	)	Trademark Attorney:
Serial No. 75/816,998	)	Heather D. Thompson
Filed: October 7, 1999	)	Law Office No.: 103
Mark: XML SOLUTIONS	)	Date: November 26, 2001

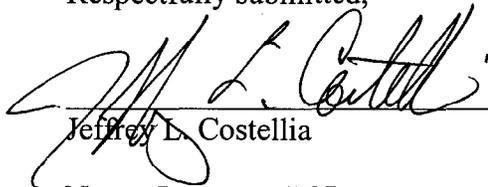
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Sir:

Transmitted herewith is the following:

1. Appeal Brief (triplicate) in the above-identified application.
- A check in the amount of \$ -0- to cover the filing fee is enclosed.
- The Commissioner is hereby authorized to charge fees under 37 CFR 2.6 which may be required now or hereafter, or credit any overpayment, to Deposit Account No. 19-2380. A duplicate copy of this sheet is attached.

Respectfully submitted,



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