

TTAB

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

In Re Application of:

Herzog-Elmiger Inc.

Serial No.: 75/898699

Filed: January 19, 2000

Mark: VENEERONLINE.COM

Trademark Law Office: 107

Attorney: David C. Reihner



11-30-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #76

BRIEF FOR APPELLANT

INTRODUCTION

On September 13, 2001, Applicant filed a Notice of Appeal for the above-identified mark. In this brief, Applicant hereby appeals from the Examining Attorney's refusal to register the above-identified mark dated March 14, 2001, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision. Accordingly, this Brief is submitted herewith in triplicate.

APPLICANT'S SERVICE MARK

Applicant seeks registration on the Principal Register of its mark:

VENEERONLINE.COM

for use with "Wholesale mail order, catalog order, and on-line order services in the field of wood veneers, in International Class 35."

THE REJECTION

The Examining Attorney refused registration of Applicant's mark contending that the subject matter for which registration is sought is merely descriptive of the identified services.

ARGUMENT

1. REFUSAL TO REGISTER IS PREMATURE

The Examining Attorney refused registration of Applicant's mark contending that the mark "VENEERONLINE.COM" as applied to wholesale mail order, catalog order, and on-line order services in the field of wood veneers is merely descriptive of the above-mentioned services.

The Examining Attorney has cited *In re Eilberg*, 49 U.S.P.Q.2d. 1955 (TTAB, 1998), for the proposition that "Because the [Applicant's] designation appears to form part of an address commonly used by internet users and merely indicates the location on the internet where applicant's web site could appear, it does not indicate the source of applicant's services."

However, *Eilberg* can be distinguished since that decision was based on a use application, while Applicant's application is based on an intent-to-use its mark. In *Eilberg*, the Trademark Trial and Appeal Board stated that "the asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and distinguishing applicant's legal services and, as presented, is not capable of doing so." The *Eilberg* conclusion was based on an evaluation of specimens submitted by the applicant in that case.

By contrast, since Applicant's application was filed on the basis of an intent-to-use, there are no specimens of record to be evaluated to determine whether the mark functions as a service mark identifying and distinguishing applicant's services.

Furthermore, in *Eilberg*, the TTAB observed that "if used appropriately, [the] asserted mark could serve as [a] service mark." The TTAB went on to say, "This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or services mark[s]. For example, if applicant's law firm name were, say EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable." *Id.*

Additionally, the PTO Examination Guide No. 2-99 (Marks Composed, In Whole Or In Part, Of Domain Names), citing *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960),

stated, "The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it do so."

Also, Examination Guide No. 2-99, in Section E. Intent-to-Use Applications, states that "generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground [that the matter does not function as a mark] until the applicant has submitted specimens of use with either an amendment to allege use under Trademark Act §1(c), or a statement of use under Trademark Act §1(d), 15 U.S.C. §1051 (c) or (d). However, the examining attorney should include an advisory note in the first Office Action that registration may be refused if the proposed mark, as used on the specimens, identifies only an Internet address."

Instead of being provided such an advisory note as a courtesy, and considering applicant's usage of the mark after specimens are submitted, it is Applicant's position that the Examining Attorney prematurely refused registration before being able to review the relevant specimens. Applicant submits that such refusal was premature and that, upon review of its specimens, the Examining Attorney may determine that the mark would function as a service mark.

The Examining Attorney, after submission by Applicant of a Statement of Use, could evaluate the accompanying specimens to determine whether the mark functions as a service mark identifying and distinguishing applicant's services. At that time, if the Examining Attorney is not satisfied that such usage would serve to identify and distinguish Applicant's services, the Examining Attorney could then deny registration. However, at that time, the Examining Attorney, after reviewing Applicant's specimens, may conclude that the mark does function as a service mark identifying and distinguishing Applicant's services.

2. MARK IS NOT MERELY DESCRIPTIVE

Regarding the Examining Attorney's position that the mark is merely descriptive, 15 U.S.C. 1052 (e) (1) presumes a mark is registrable unless it "consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of

them." To overcome the statutory presumption of validity, there must be a finding that a mark is merely descriptive (or deceptively misdescriptive).

According to In re MetPath Inc., 223 U.S.P.Q. 88, 89 (1984), "the question of whether or not a mark is merely descriptive must be determined not in the abstract but rather in relation to the goods or services for which registration is sought, the context in which the mark is used in connection with those goods or services, and the possible significance which the mark would have, because of the context in which it is used, to the average purchaser of the goods or services in the marketplace."

To make a determination of whether or not a mark is merely descriptive, the Examining Attorney should not consider the mark in the abstract but rather in relation to the products. In re MetPath Inc., supra. Furthermore, the Examining Attorney should look at the mark as a whole; not at its component parts. "[T]he commercial impression of a mark is derived not from the elements separated and considered apart from each other, but from the mark as a whole since that is the manner in which it is used and the manner in which it is encountered by those exposed thereto." In re Creative Goldsmiths of Washington Inc., 229 U.S.P.Q. 766, 768 (1986), citing In re American Physical Fitness Research Institute Inc., 181 U.S.P.Q. 127 (1974). "For example, two or more descriptive terms may be combined to form a valid, arbitrary trademark." Q-Tips, Inc. v. Johnson & Johnson, 98 U.S.P.Q. 86 (1953).

Applicant does not dispute that its mark is formed from descriptive terms. However, Applicant submits that its mark as a whole should not be regarded as descriptive. The term VENEERONLINE.COM does not merely describe Applicant's services. After submission by Applicant of a Statement of Use, the Examining Attorney could evaluate the accompanying specimens to determine whether the mark functions as a service mark identifying and distinguishing applicant's services.

CONCLUSION

For the reasons set forth hereinabove, Appellant's mark is entitled to registration on the Principal Register.

The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's mark.

Respectfully submitted,

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CERTIFICATE OF MAILING

I, Jay S. Horowitz, do hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on this 18th date of November, 2001.

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