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Elmer J. Babin (Name)

06/18/04 (Date)

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

In re the Application of:)
)
Applicant: Alexandria Real Estate Equities, Inc.)
)
Serial No.: 75/982,917)
)
Filed: December 29, 2000)
)
Mark: LABSPACE)
)
Final Refusal Mailing Date: April 22, 2004)
_____)



06-22-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Assistant Commissioner for Trademarks
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APPEAL BRIEF

Introduction

Applicant, Alexandria Real Estate Equities, Inc. (“Applicant”), hereby files its brief pursuant to Trademark Rule 2.142 (b). In the present application, the Examining Attorney has maintained the final refusal of Applicant’s LABSPACE mark (“the Mark”) for Applicant’s business management/development services, financial/investment services and computer rental/leasing services on the grounds that the Mark is merely descriptive of such services.

However, as discussed below, Applicant respectfully submits that under the facts and the applicable law, the Mark is at most suggestive of the services at issue, and is appropriate for registration on the Principal Register.

The services in the present application include:

Class 35: Business consulting services; business incubator services, namely business management and business development services in the form of start-up support for businesses of others; rental and leasing of office machinery and equipment

Class 36: Investment brokerage, consultation, and management; financial portfolio management; financial services, namely financial consultation, financial analysis, financial planning, financial management, financial portfolio management, financing services, and providing debt and equity capital; incubator financing services

Class 42: Rental and leasing of computers

As set forth below, the Mark should be allowed to be registered on the Principal Register because it does not convey any information about the specific nature of these services to the relevant market.

Argument

I. Applicant's Mark Is Not Merely Descriptive Of The Relevant Services

The Examining Attorney bears the burden of demonstrating that a mark is merely descriptive. *See In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233, 1236 (T.T.A.B. 1986). Further, "any doubt with respect to the issue of descriptiveness should be resolved in Applicant's behalf." *In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994). To be deemed "merely descriptive," a mark must immediately convey information concerning the nature of the goods or services to the average consumer with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978). Simply because a mark

imparts information about the characteristics of the goods does not render it incapable of functioning as a trademark. *In Re Sweet Victory, Inc.*, 228 U.S.P.Q. 959, 960 (T.T.A.B. 1986).

If information about the product or services given by the terms used as a mark is indirect or vague, then this indicates that the terms are being used in a “suggestive,” rather than descriptive manner. A suggestive mark requires some degree of imagination, thought and perception to reach a conclusion as to the nature of the underlying goods. *In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987); T.M.E.P. § 1209.01(a). (*AMF Incorporated v. Sleekcraft Boats*, 204 U.S.P.Q. 808, 815 (9th Cir. 1979), the “primary criterion” in reviewing the distinction between descriptive and suggestive marks is “the imaginativeness involved in the suggestion” . . . that it is, how immediate and direct is the thought process from the mark to the particular product . . .”) If the mental leap between the word and product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness. *See* 2 McCarthy, *supra*, §11.67, at 11-128.

Applying these principles to the Applicant’s Mark, and even accepting for purposes of argument the Examining Attorney’s position that “Lab Space” is commonly understood to mean “laboratory space,” or “the real estate where a commercial lab or research lab will be located,” a consumer would have to use his or her imagination to make the leap from that meaning to ascertain the nature of the services that are actually offered in the present application. Applicant’s Mark “requires imagination, thought and perception to reach a conclusion as to the nature” of the goods or services. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); *see also* 2 McCarthy, *Trademarks and Unfair Competition*, §11.67, at 11-116 (4th ed. 1997).

The Examining Attorney states that:

The applicant offers a wide range of services to help others acquire and continue to operate lab space, including obtaining real estate, incubator financing and providing and maintaining proper facility air and electrical systems. When the mark is applied to the applicant's services, the user is directly informed that all the applicant's services are provided for the purpose of acquiring and maintaining lab space. Thus, the mark is descriptive of the applicant's services and must be refused.

While as part of its business Applicant provides services directed to acquiring and maintaining laboratory space, Applicant also offers services that help companies to maximize their business potential and run all aspects of their operations more efficiently, effectively and profitably—e.g, Applicant's services are used to develop and manage non-laboratory or research aspects of their customers' operations. It is not immediately clear to consumers that the mark LABSPACE does not refer to laboratory facilities, but rather refers to certain kinds of business services, namely, providing business consulting, development, and financial services—or that it refers to “rental and leasing of computers.” Thus, Applicant's Mark is not merely descriptive.

Significantly, the U.S. Patent and Trademark Office (“PTO”) has allowed other “SPACE” marks to become registered on the Principal Register for use in connection with related services, i.e.:

MARK	REG. NO.	SERVICES
MEDSPACE	1,487,906	“Medical facility planning and design services.”
TECHSPACE	2,364,892	“Leasing temporary space to technology, new media and entertainment companies.”
ARTSPACE	2,282,852	“Real estate development addressing the space needs of artists and arts organizations, and consulting related thereto.”

As is evident, in each of these instances, the mark is comprised of the word “space” combined with a word that suggests a field of business, i.e., “med.” However, the PTO allowed registration for specific services that can be applied in such settings, e.g., MEDSPACE for “medical facility planning and design services.” Similarly, in the present application, although the phrase “LABSPACE” may in some contexts refer to a physical location associated with a laboratory, it does not describe the particular services at issue.

The PTO has also allowed registration of other marks that suggest an industry, but do not “merely describe” the specific services that are sought to be registered, i.e., CITIBANK for (among other things) “financial services; namely banking, credit card services... commercial and consumer lending and financing...” (Registration No. 2,636,299) and PETCARE for “providing pet accident and illness insurance services and pet insurance brokerage services.(Registration No. 2,840,705)” As the Trademark Trial and Appeal Board stated in *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 U.S.P.Q. 832 (T.T.A.B. 1977):

The mark AIR-CARE is, moreover, not merely descriptive as applied to applicant’s services. The literal meaning of the mark, namely “care of the air”, may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant’s services, but it does not in any clear or precise way, serve merely to describe applicant’s preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment.

In *In re TMS Corporation of The Americas*, 200 U.S.P.Q. 57 (T.T.A.B. 1978), the mark THE MONEY SERVICE was found registrable. In determining that THE MONEY SERVICE was suggestive of financial services rather than descriptive, the Trademark Trial and Appeal Board stated:

To effect a readily understood connection between applicant’s mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. *Id.* at 59.

To connect LABSPACE with Applicant's services similarly requires an average customer to use thought, imagination and extrapolation. There is no immediate connection conveyed between the Mark and Applicant's services, and therefore the Mark is not merely descriptive.

II. The Evidence Submitted By The Examining Attorney Fails To Show Use Of The Term LABSPACE For The Relevant Services

To refuse registration on the ground that a mark is descriptive, the Examining Attorney must make a substantial showing based on clear evidence of descriptive use. *In re Kopy Kat, Inc.*, 182 U.S.P.Q. 372 (C.C.P.A. 1974). In the final office action, the Examining Attorney attached Nexis and Internet articles that allegedly indicate that the Mark is descriptive because they "discuss how critical obtaining real estate, incubator financing and proper air and electrical systems are when one is looking to acquire lab space."

However, the references provided by the Examining Attorney do not tie the phrase "LABSPACE" to any offerings of "critical" services, and do not demonstrate use of the Mark descriptively for the types of services at issue. For example, the first attached article from the Pittsburgh Business Times discusses the shortage of suitable laboratory space for the region's growing biotech industry. This article does not use the Mark to refer to any specific services, rather the phrase "lab space" is used to refer to physical laboratory facilities: "This is not generic office space...Typically, lab space will require double the mechanicals. Each biotech company requires something different." In this passage, the author is discussing the fact that laboratory facilities have specific equipment and space needs that can be quite different than what is needed by "generic office space," e.,g, the author points out that laboratory space requires twice as much capacity for HVAC, electrical and plumbing systems.

Similarly, the remaining articles and references use the term “lab space” to refer to the laboratory facilities themselves. The fact that these articles also include a discussion of things like venture financing and the equipment needed in such laboratories, does not mean that they evidence of use of the term “Lab Space” descriptively for such services. For example, just because an article discussing a new office complex might include the phrase “Office Space” to refer to such facilities, the fact that it also discusses the computer needs of the offices would not mean that the term “OFFICESPACE” is descriptive of computer services. The articles cited by the Examining Attorney do not support a conclusion that “LABSPACE” is descriptive when applied to the Applicant’s services.

III. IF APPLICANT’S MARK IS STILL DEEMED TO BE DESCRIPTIVE OF THE PRESENT SERVICES, IN THE ALTERNATIVE APPLICANT REQUESTS THAT ITS APPLICATION BE AMENDED TO SEEK REGISTRATION ON THE SUPPLEMENTAL REGISTER.

Although Applicant believes its mark is entitled to registration on the Principal Register for the reasons set forth above, if the mark is ultimately deemed to be descriptive, Applicant hereby requests that the present Application be amended to seek registration on the Supplemental Register.

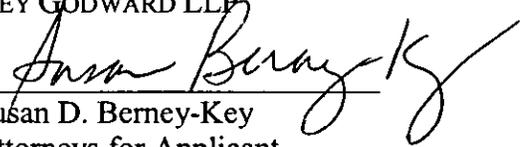
CONCLUSION

It is noted that a search of the Patent and Trademark Office records fails to show that Applicant's Mark so resembles any registered mark or pending application as to be likely to cause confusion, mistake or deception. In view of the foregoing, Applicant submits that this application is now in condition for acceptance. Favorable action is therefore requested.

Date: June 17, 2004

Respectfully submitted,

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June 18, 2004

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Re: Appeal Brief
Applicant: Alexandria Real Estate Equities, Inc.
Serial No.: 75/982,917
**Our File: Alexandria Real Estate Equities, Inc./LABSPACE/US Classes, 35,
36, 42**

Dear Sir or Madam:

Enclosed for filing in connection with the above referenced trademark application for the mark LABSPACE, please find the following:

1. Appeal Brief;
2. A self-addressed stamped return postcard.

Please charge any deficiency for any fee that may be required to Deposit Account No. 03-3118. A duplicate copy of this letter as authorization is attached hereto for your convenience.

Please return the enclosed stamped, self-addressed postcard evidencing the date of receipt of the Response. Thank you.

Very truly yours,

COOLEY GODWARD LLP


Susan D. Berney-Key

Enclosures

cc: Joel S. Marcus, Esq.
Janet L. Cullum, Esq.

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