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

Bonita  
10/30/02

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
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**MARK: INTERACTIVE PROFILE CARD**

**Filing Date: September 14, 2000**



**USPTO Serial No.: 76/128,628**

10-21-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #34

**Law Office: 109**

**Examining Atty: Marlene M. Menard, Esq.**

**ATTORNEY DOCKET NO.: 040.0055**

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**APPEAL BRIEF**

This Appeal Brief is submitted in accordance with Applicant's Notice of Appeal filed in the U.S. Patent and Trademark Office on August 19, 2002. Entry of this paper along with favorable action by the Board is earnestly requested, as is allowance, publication, and registration of the MARK on the principal register.

On appeal there exists only one (1) issue:

**Issue: Whether the Examining Attorney's refusal to register the mark on the principal register under Trademark Act Section 2(e)(1) (mere descriptiveness) is proper?**

**Answer: The Examiner's refusal to register the mark on the principal register under Trademark Act Section 2(e)(1) is improper and, thus, the mark must be allowed to pass to publication for opposition.**

**ARGUMENT:**

The Examiner's refusal to register the Mark on the principal register under Trademark Act Section 2(e)(1), 15 USC §1052(e)(1) is improper, unlawful and must be overturned by the Board. The Mark must be allowed and passed to publication for opposition.

Throughout examination on the merits in the instant application, the Examining Attorney has maintained a refusal to register the Mark on the Principal Register under Trademark Act

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Section 2(e)(1) – alleging that the Mark is merely descriptive. In essence, the Examining Attorney has maintained that the MARK immediately identifies a feature of the Applicant's goods, i.e., that the MARK describes the services identified in the application. See e.g., Action No. 3 – February 19, 2002. Additionally, the Examining Attorney previously provided exhibits to support his assertions, including articles containing information related to individual parts of the Mark (e.g., “INTERACTIVE,” “PROFILE,” and “CARD”) See e.g., Action No. 3 – February 19, 2002.

The Applicant has disagreed with the Examiner Attorney and earlier presented several arguments clearly and properly supporting registration:

**The Applicant's MARK is a catchy term that its customers associate with high quality consulting services. The Applicant's MARK is NOT merely descriptive as the Examining Attorney alleges, and is instead, a suggestive mark deserving registration.**

A suggestive mark, one that suggests rather than describes, is protectable through registration without evidence of a secondary meaning. In *Re Gyulay*, 820 F.2d 1216 (citing *Vision Center v. Opticks, Inc.*, 596 F. 2d 111, 115 202 U.S.P.Q. (BNA) 333, 338 (5<sup>th</sup> Cir. 1979), cert. denied, 444 U.S. 1016, 100 S. Ct. 668, 62 L. Ed. 2d 646, 204 U.S.P.Q. (BNA) 696 (1980)). Whether a mark is merely descriptive or is suggestive depends on whether the mark “immediately conveys...knowledge of the ingredients, qualities, or characteristics of the goods...with which it is used”, or whether **(in the case of registerable, suggestive marks) “imagination, thought, or perception is required to reach a conclusion on the nature of the goods.”** In *Re Gyulay*, 820 F.2d 1216 (citing *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. (BNA) 505, 507 (CCPA 1980).

In the present case, the Examining Attorney asserts that the MARK would describe the services specified in the description simply because the MARK contains component parts (e.g., “INTERACTIVE,” “PROFILE,” and “CARD”) that may otherwise have particular meanings in the relevant marketplace. The Examining Attorney has provided no specific basis as to why the MARK merely describes the services specified in the description – consulting services designed to help others build interactive type marketing materials. To come to the Examining Attorney's conclusions, an ordinary customer must use imagination, thought, or perception since none of the component parts of the MARK either alone or in combination immediately describes “consulting services” such as assisting clients in designing and facilitating implementation of electronic

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compact disc based business cards for use in personal computer compact disc players as stated in the description of services. In essence, the Examining Attorney has used some form of improper hindsight to break apart the MARK into component parts and to apply meanings to fit the refusal to register.

**The MARK is suggestive as contemplated by the court in In Re Gyulay. That is, consumers must use thought and imagination to determine the nature of the MARK – there is no immediate way to perceive the MARK and to immediately determine that consulting services in the creative marketing via compact disc field (among others) may be obtained – FOR THIS REASON REGISTRATION IS PROPER.**

For the foregoing reasons, it is respectfully requested that the Board overturn the Examining Attorney's refusal to register the MARK and remand the case to the Examining Attorney with instructions to pass the MARK to publication for opposition.

**CONCLUSION**

This Brief has been submitted to the Board in accordance with the Notice of Appeal filed on August 20, 2002. Entry and consideration of this Brief along with a decision favorable to the Applicant are earnestly solicited.

If it is believed that a telephonic or in-person interview will in any way expedite the processing of this paper and its attachments, the Board is hereby invited to contact the undersigned attorney of record at the address and telephone number listed below.

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Finally, as it is believed that this paper fully responds to and satisfies all outstanding issues, it is respectfully requested that the instant application be ALLOWED and that Mark be published for opposition.

Respectfully Submitted,

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*Oct. 19, 2002 was a Saturday - EBC*