

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 11 2001

Applicant: Nortech Investments LTD : BEFORE THE
Trademark: RACEBOOK BIZ and design : TRADEMARK TRIAL
Serial No: 76330664 : AND
Attorney: Steven A. Gibson, Esq. : APPEAL BOARD
Address: 400 South Fourth Street : ON APPEAL
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's requirement to disclaim the term RACEBOOK BIZ.

FACTS

Applicant seeks registration of RACEBOOK BIZ and design for "netcasting services, namely, broadcasting programs through a global computer network featuring sports events, contests, sweepstakes, casino events, athletic events and entertainment events."

The examining attorney required a disclaimer of the terms RACEBOOK BIZ on the Principal Register under Section 6 of the Trademark Act. Applicant responded and

argued that the terms are arbitrary because RACEBOOK is an amalgam of letters not found in a dictionary, and BIZ elicits a variety of interpretations that are suggestive and not descriptive. The examining attorney reviewed the applicant's response and made a FINAL refusal under Section 6 supported by evidence showing that RACEBOOK is a term of art in the wagering and gaming industry and BIZ is a top-level domain name and newsgroup category for business information retrieved on the Internet or via e-commerce.

The applicant has responded and now contends on appeal that:

- I. The only services of Applicant at issue are those claimed by Applicant in the recitations of Applicant.
- II. The claimed services of Applicant are not the services identified by the Examiner.
- III. The mark is arbitrary and does not immediately convey the qualities or characteristics of the claimed services.
- IV. At a minimum, the mark is merely suggestive of the claimed services as at least one imaginative step is required in order to discern such services.

The examining attorney, however, submits that the terms RACEBOOK BIZ are descriptive of the services and maintains the requirement to disclaim RACEBOOK BIZ under §6 of the Trademark Act of 1946; 15 U.S.C. §1056; TMEP §1213.

ARGUMENT

- I. THE SCOPE OF SUBJECT MATTER AS CLAIMED IN THE APPLICANT'S SERVICES IS BROAD ENOUGH TO ENCOMPASS ANY NEWSWORTHY MATTER IN THE FIELDS OF SPORTS AND ENTERTAINMENT ABSENT ANY EXPRESS LIMITATION BY THE APPLICANT TO THE FIELDS OF SPORTS AND ENTERTAINMENT.

The Examining Attorney finds that the services claimed by the applicant are broad enough to encompass "racebook" matter. Racebook information is within the scope of the subject matter for "sporting events, contests, sweepstakes, casino events, athletic events and entertainment events," as claimed by the applicant.

In the first office action, the Examining Attorney presented evidence from the Internet to show that "racebook" is a recognized term of art in the fields of sports and entertainment. In the FINAL office action, the Examining Attorney presented evidence from LEXIS-NEXIS articles to show further that "racebook" is a term used in conjunction with betting and wagering from a list of odds. All of the evidence submitted by the Examining

Attorney shows that “racebook” is commonly used in the field of sports and entertainment to assist consumers who bet and wager the odds of competitions.

Moreover, the evidence shows how the casino and sporting industries accommodate those who choose to wager by providing racebook information.

A visit to the applicant’s website enables a consumer to view and click on tabs for “live events” for which the applicant may retrieve a racebook or list of odds for the winners of the respective events.

The fact that the applicant has selected alternative language in its recitation, namely, sports and entertainment, instead of racebook information, to circumvent the descriptive nature of its actual services, does not preclude a requirement to disclaim the term RACEBOOK BIZ.

When claiming services, the applicant is entitled to protection of its mark to the full scope of those services as claimed. Yet the applicant now asks the Office to narrow its scope of review and find the term RACEBOOK BIZ not to be descriptive for services broadly defined by the applicant.

As long as a broad term identifies the goods or services that are intended to be covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider

that the mark has been used for all the related goods or services that fall in the designated group. *See In re Dynamit Nobel AG*, 169 USPQ 499 (TTAB 1971)

Because the applicant has not narrowed its scope of “sporting events, casino events, athletic events and entertainment events,” neither should the Office narrow its scope of review for the purpose of determining the descriptive nature of the term RACEBOOK BIZ.

II. APPLICANT’S SERVICES AS AMENDED ARE INTENDED TO
INCLUDE RACEBOOK INFORMATION AND NEWS.

The examining attorney incorporates by reference the arguments made in Section I of this brief.

According to its web page, the subject matter featured in the applicant’s sporting events, casino events, athletic events and entertainment events pertains to a listing of odds also known as a racebook.

Because the applicant, without express limitation, has claimed “... sporting events, contests, sweepstakes, casino events, athletic events and entertainment events” the applicant has inclusively claimed “racebook” information.

III. THE TERM RACEBOOK BIZ IS DESCRIPTIVE OF THE SERVICES CLAIMED AND THEREFORE A DISCLAIMER IS APPROPRIATE.

The examining attorney incorporates by reference the arguments made in Section I of this brief.

RACEBOOK BIZ is descriptive of the services claimed because the terms identify the nature and origin of the broadcasting programs featuring the sporting events, casino events, athletic events and entertainment events as claimed by the applicant. The evidence attached and the evidence submitted with the FINAL office action show that BIZ is a recognized term in e-commerce and as a top-level domain name. The combination of RACEBOOK and BIZ does not create a separate nondescriptive meaning. *C.f., Dranoff-Perstin Associates v. Sklar*, 23 USPQ2d 1174 (3d Cir. 1992); *In re Page*, 51 USPQ2d 1660 (TTAB 1999)

Consumers seeing the term RACEBOOK BIZ will be apprised of an opportunity to go on-line, gather business information and place a bet in a sporting competition or an entertainment competition before viewing a broadcast of the events.

Therefore a disclaimer of RACEBOOK BIZ is appropriate. TMEP §1213.

IV. RACEBOOK BIZ IS NOT SUGGESTIVE BUT IS DESCRIPTIVE OF THE SERVICES AS CLAIMED BY THE APPLICANT.

The applicant argues that racebook information is not part of its express recitation of services and therefore RACEBOOK BIZ is not descriptive of its expressly claimed services even if the applicant happens to also provide racebook information.

By analogy, the applicant contends that an owner “may claim mark protection for computers under the mark APPLE, even while also selling the fruit apples.”

Before the examining attorney distinguishes this analogy from the applicant’s mark, the examining attorney refers to the precedence of case law. “Various tests have been used in determining whether a mark is ‘merely descriptive.’ ... [The U.S. Court of Customs and Patent Appeals]... has also looked to whether the mark conveys information regarding a function, or purpose or use of the goods. Other considerations include whether the mark describes a feature of part of the goods.” In re Abcor Development Corporation, 200 USPQ 215, 218 (CCPA 1978). See also In re Zanova Inc. 59 USPQ2d 1300, In re Styleclick.com Inc. 57 USPQ2d 1445; In re Gyulay, 3 USPQ2d 1009, and In re Quik-Print Copy Shop, Inc., 205 USPQ 505. “However, implicit in this test is the requirement that descriptiveness of a mark, when applied to the goods or services involved, is to be determined from the standpoint of the average prospective purchaser.” 200 USPQ 215, 218 (CCPA 1978) .

To apply the test used by the CCPA, the term RACEBOOK BIZ conveys information about a feature or part of the services. Thus, the examining attorney finds that the average purchaser who wagers the odds in sporting competitions, will pursue the applicant's services because the term RACEBOOK BIZ tells that purchaser that they can obtain facebook information on line and in fact they can. The applicant's services may expressly provide general news about sports but implicitly their general news also provides facebook information as their own website illustrates.

Given this case law, the examining attorney now distinguishes the applicant's analogy. The examining attorney concedes that an owner who claims only "computers" and seeks the mark APPLE for those goods, would have an arbitrary mark. There is nothing about computers that is remotely related to an apple even if the applicant happens to sell apples, not claimed in its identification of goods. However, if the applicant claims "retail store services featuring computers and fruit juices" then APPLE is more likely to be descriptive of the services if the fruit juices include apple juice.

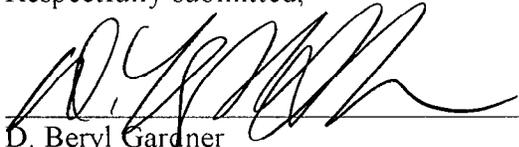
Thus, the latter analogy more closely parallels the issues pertaining to the applicant's broadly defined services and the term RACEBOOK BIZ. The sporting events, casino events, athletic events and entertainment events broadcast on the applicant's web page include facebook matter which features lists of odds for the sports and entertainment competitions.

Thus, given the case law, the specimens and the evidence of record, the examining attorney finds that terms RACEBOOK BIZ are descriptive of the applicant's services as claimed.

CONCLUSION

For the foregoing reasons, it is urged that the Board find that the term RACEBOOK BIZ is descriptive of the services and that a disclaimer of the term RACEBOOK BIZ be affirmed under §6 of the Trademark Act of 1946. TMEP §1213; 15 U.S.C. §1056.

Respectfully submitted,



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RESULTS

Exact Match

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Similar Matches:

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Definition for: biz

Top-level newsgroup category for a business newsgroup.

Look Up

A B C D E F G H I J K L M N O P Q R S T U V W X Y Z NUMBERS

Internet

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SECTION: BUSINESS; Pg. 1

LENGTH: 926 words

HEADLINE: Usenet an overlooked but rich branch of Internet

SOURCE: Staff

BYLINE: DWIGHT SILVERMAN

BODY:

... called newsgroups. For example, one of the largest hierarchies is alt, or alternative. There's also comp (computers), rec (recreation), sci (science), biz (business) , misc (miscellaneous). There are also hierarchies that serve specific communities. There's a set of Houston newsgroups, for example. And many Internet providers have ...

SUBJECT: INTERNET & WWW (90%); ELECTRONIC MAIL (74%); CD & DVD DRIVES (50.);