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**FACSIMILE COVER SHEET**

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NAME: D. BERYL GARDNER, ESQ.  
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FROM: JENNIFER K. CRAFT

RE: REQUESTS FOR SUSPENSION OF PROCEEDINGS AND REMANDS OF APPLICATION

TOTAL NUMBER OF PAGES: (INCLUDING THIS COVER SHEET) 75

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DATE: MARCH 2, 2004

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March 2, 2004

*Via Facsimile only*

Ms. Annie Burroughs  
Paralegal  
US Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

D. Beryl Gardner, Esq.  
Trademark Attorney  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

**RE: Requests for Suspension of Proceedings and Remands of Application for:**  
**RACEBOOK.COM, Class 38, Serial No. 76/259243;**  
**RACEBOOK.COM, Class 41, Serial No. 75/259240;**  
**RACEBOOK.COM, Class 42, Serial No. 75/259237;**  
**RACEBOOK.COM and Design, Class 38, Serial No. 75/259242;**  
**RACEBOOK.COM and Design, Class 41, Serial No. 75/259239;**  
**RACEBOOK.COM and Design, Class 42, Serial No. 75/259236;**  
**RACEBOOK.COM and Design (with color), Class 38, Serial No. 75/259241;**  
**RACEBOOK.COM and Design (with color), Class 41, Serial No. 75/259238;**  
**RACEBOOK.COM and Design (with color), Class 42, Serial No. 75/259235;**  
**RACEBOOK BIZ, Class 41, Serial No. 76/330665;**  
**RACEBOOK BIZ and Design, Class 38, Serial No. 76/330664;**  
**RACEBOOK INFO, Class 41, Serial No. 76/330667; and**  
**RACEBOOK INFO and Design, Class 38, Serial No. 76/330666 (the "Marks")**

Dear Ms. Burroughs and Ms. Gardner:

Per Ms. Anne Burroughs' telephone conversation with Bryce K. Earl, Esq. on or about February 27, 2004, please find transmitted herewith thirteen Requests for Suspension of Proceedings and Remands of Application for the Marks.

Ms. ANNIE BURROUGHS  
D. BERYL GARDNER, ESQ.  
MARCH 2, 2004  
PAGE 2

SANTORO, DRIGGS, WALCH  
KEARNEY, JOHNSON & THOMPSON

Please note that with respect to the appeal proceedings for at least the mark RACEBOOK INFO and Design, Class 38, Serial No. 76/330666, the oral hearing before the Trademark Trial and Appeal Board has been set for Tuesday, March 16, 2004. As such, please contact us *immediately* if the Requests for Suspension of Proceedings and Remands of Application for the Marks cannot be processed by *March 10, 2004*.

If you have any questions or comments regarding the foregoing, please do not hesitate to contact Steven A. Gibson, Esq., Mr. Earl or me.

Best regards,

SANTORO, DRIGGS, WALCH,  
KEARNEY, JOHNSON & THOMPSON



Jennifer K. Craft

JKC:ddl

Enclosures

cc: Steven A. Gibson, Esq.  
Bryce K. Earl, Esq.

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

Applicant: NORTECH INVESTMENTS  
LTD  
Mark: RACEBOOK BIZ and Design  
Serial No.: 76/330664  
Filing Date: October 25, 2001  
Class: 38

APPLICANT'S REQUEST FOR  
SUSPENSION OF PROCEEDINGS AND  
REMAND OF APPLICATION AND  
RESPONSE TO FINAL OFFICE  
ACTION

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Pursuant to 37 C.F.R. 2.142(d); TBMP §1205, Applicant NORTECH INVESTMENTS LTD (the "Applicant") respectfully requests the Trademark Trial and Appeal Board to suspend proceedings with respect to the appeal of the application for the above-captioned mark (the "Application") and remand the Application to the examining attorney (the "Examiner") for consideration of Applicant's response to the United States Patent and Trademark Final Office Action dated January 30, 2003, a true and accurate copy of which is attached hereto and incorporated herein by this reference as **Exhibit A**.

In accordance with TBMP §1205, Applicant hereby submits Applicant's Request For Suspension Of Proceedings And Remand Of Application And Response To Final Office Action (the "Remand") in good faith and believes that the Remand serves the useful purpose of resolving all outstanding issues under appeal.

Respectfully submitted,

  
\_\_\_\_\_  
Steven A. Gibson  
Santoro, Driggs, Walch  
Kearney, Johnson & Thompson  
400 South Fourth Street, Third Floor  
Las Vegas, Nevada 89101  
(702) 791-0308

Applicant's Request For Suspension Of  
Proceedings And Remand Of Application  
And Response To Final Office Action

Applicant: NORTECH INVESTMENTS LTD  
Mark: RACEBOOK BIZ and Design  
Serial No: 76/330664  
Filing Date: October 25, 2001  
Class: 38

**CERTIFICATE OF TRANSMISSION**

I hereby certify that the Applicant's Request For Suspension Of Proceedings And Remand Of Application And Response To Final Office Action and exhibits attached thereto are being transmitted by facsimile to the United States Patent and Trademark Office on the date shown below to:

Annie Burroughs at fax number: (703) 308-9092 and  
D. Beryl Gardner at fax number: (703) 746-8112

  
Signature

Typed or Printed Name: Raisha Y. DeLeon

Date of Signature: March 2, 2004

Trademark Law Office: 112  
 Serial Number: 76/330664  
 Mark: RACEBOOK BIZ and Design

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: NORTECH INVESTMENTS  
 LTD  
 Mark: RACEBOOK BIZ and Design  
 Serial No.: 76/330664  
 Filing Date: October 25, 2001  
 Class: 38

**D. Beryl Gardner**  
 Trademark Attorney

Law Office: 112

Commissioner for Trademarks  
 2900 Crystal Drive  
 Arlington, VA 22202-3514

**RESPONSE TO FINAL OFFICE ACTION**

Applicant NORTECH INVESTMENTS LTD (the "Applicant") hereby responds to the United States Patent and Trademark Office's ("USPTO") Office Action ("Office Action") dated January 30, 2003. In the Office Action the examining attorney ("Examiner") refuses registration of the application for the captioned mark (the "Mark") requiring the text RACEBOOK BIZ ("Examiner's Text") to be disclaimed. Applicant respectfully requests registration of the Mark in International Class 38 for the following reasons and on the following bases:

**I. DISCLAIMER**

The Examiner asserts that the Examiner's Text must be disclaimed because: (1) the text RACEBOOK is merely descriptive of "a listing of information about the entities that are racing, such as their rank or placement in racing"; and (2) the text BIZ is merely descriptive of "a top level domain name for a business entity." *Office Action*, at 1-2.

While Applicant maintains that the text RACEBOOK need not be disclaimed, Applicant is willing to disclaim the text RACEBOOK as follows:

No claim is made to the exclusive right to use "RACEBOOK" apart from the mark as shown.

However, the text BIZ indeed need not be disclaimed. As set forth in Applicant's First Response to Office Action dated August 9, 2002 ("Office Action Response"), the text BIZ need not be disclaimed, at minimum, because: (1) the text BIZ is inherently distinctive due to the fanciful nature of the text BIZ and (2) the services claimed in the application do not describe the text BIZ, but at least are arbitrarily applied and, at worst, merely suggestive. *Office Action Response*, at 1-5<sup>1</sup>. As more fully set forth in the Office

<sup>1</sup> The Office Action Response was filed online through the USPTO's Trademark Electronic Application System. As such, all references to certain pages of the Office Action Response are page references to the Office Action Response as set forth in the PrinTEAS email confirmation provided by the USPTO.

Applicant: NORTECH INVESTMENTS LTD  
Mark: RACEBOOK BIZ and Design  
Serial No: 76/330664  
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Class: 38

Action Response, Applicant respectively maintains that the text BIZ can reasonably be interpreted to mean any number of different words or terms in addition to slang for a business reference identified by the Examiner, including, without limitation: (a) bizarre, (b) a top level domain name biz, (c) busy, (d) bizonal, or (e) buys (utilizing a pronunciation of the term with a long i). Such words have multiple definitions depending upon the context.

Indeed, the USPTO has previously determined that the text BIZ was sufficiently differentiated and need not be disclaimed, as set forth by the following marks (true and accurate copies of the Trademark Electronic Search System results for same are attached hereto and incorporated herein as **Exhibit 1**), at minimum:

- (a) PRODIGY BIZ, Class 38, Registration No: 2509125;
- (b) BIZ CARD, Class 38, Registration No: 2328413;
- (c) SPORTSBETTING BIZ, Class 38, Serial No: 76/330657 and
- (d) SPORTSBET BIZ, Class 38, Serial No: 76/330660.

Notably, Applicant is the owner of the marks SPORTSBETTING BIZ and SPORTSBET BIZ and the Examiner in each respective application has recently determined that the text BIZ need not be disclaimed based on the same or substantially similar reasons as set forth herein.

While Applicant respectfully acknowledges that merely because the USPTO granted registration without disclaimer of the text BIZ for one, it need not do so for all, Applicant respectfully urges that fundamental fairness and due process requires consistency in the application of the rules and judgments, particularly if some citizens benefit from those rules where others do not. At a minimum, the Applicant acknowledges the USPTO's preference to be consistent in determining registrability of certain text comprising a mark and positively urges the USPTO to exercise its preferences in the application of the Mark.

## II. CONCLUSION

Based upon the foregoing response, the Applicant herein respectfully requests earliest registration of the Mark on the Principal Register.

Respectfully submitted,

  
\_\_\_\_\_  
Steven A. Gibson  
Santoro, Driggs, Walch  
Kearney, Johnson & Thompson  
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