



TTAB

Attorney Docket No. G3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Applications Online, LLC)	
)	Trademark Law Office No. 107
Application Serial No. 76/684,479)	
)	Examining Attorney:
Mark: APPLICATIONSONLINE)	Aretha Somerville
)	
Filing Date: November 29, 2007)	571-272-9414
)	

Commissioner of Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPEAL BRIEF

08-27-2010

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A. **Introduction.**

The Applicant hereby submits its Appeal Brief in support of its appeal to the Trademark Trial and Appeal Board from the decision of the Examining Attorney dated January 14, 2010, finally refusing registration of the above mark on the Supplemental Register on the ground that the proposed mark is generic for the services set forth in the application (Trademark Act Section 23; 15 U.S.C. Section 109(c); 37 CFR 2.64(a)).

B. **Applicant's Service Mark - APPLICATIONSONLINE**

Applicant seeks registration on the Supplemental Register of its service mark

APPLICATIONSONLINE

for computer services, namely, development and creation of software for web based applications and Supplements thereto to allow prospective college students to submit admissions applications on line via a global computer network.

C. **The Rejection.**

In the FINAL Office Action dated January 14, 2010, the Examiner refused registration of the mark APPLICATIONSONLINE because it is generic of Applicant's services and therefore unregistrable on the Supplemental Register.

D. **Background of the Prosecution.**

The subject application was filed in the United States Patent and Trademark Office on November 29, 2007, seeking registration of the mark APPLICATIONSONLINE on the Principal Register in International Class 41 based on use in interstate commerce as early as 1998 in connection with services defined as:

“development and creation of web based applications to allow prospective college students to submit admissions applications on line via a global computer network such as, for example, the Internet; providing online interactive forms and customized information for the

college admission process; data reporting and data mining related to the college admission process.”

A first Official Action issued on March 20, 2008, in which the Examiner indicated that a search of the Office records “found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C Section 1052(d), TMEP Section 704.02, but that registration (of the mark) is refused on the Supplemental Register, because the proposed mark is generic for applicant’s services.” The Examiner submitted several print outs of material from the Internet and Lexis/Nexis as evidence in support of her refusal to register on the ground that the mark is generic and incapable of distinguishing applicant’s services. The Examiner also objected to the wording of the definition as being vague and unclear and failing to specifically describe the services.¹

Applicant responded to the Office Action on September 19, 2008. In an attempt to clarify any vagueness and overcome the objection, the services were amended to “computer services, namely development and creation of web based applications online via a global computer network, data mining related to the college application process.” As to the rejection on the ground of genericness, Applicant argued that the Examiner’s proofs failed to meet the Examiner’s burden of establishing by clear evidence that the mark was generic. No reference was made to the Examiner’s reference to the Supplemental Register, since, this juncture, Applicant was seeking registration on the Principal Register.

On November 28, 2008, the Examiner issued a Non-Final Office Action stating that the prior refusal to register was erroneously based on the assumption that Applicant was seeking registration on the Supplemental Register. Registration on the Principal Register was then

¹ A formal objection was raised with respect to whether Applicant was an LLC or corporation. Applicant later clarified its status as an LLC and the Class for which registration was sought was changed to International Class 42.

refused on the ground that the mark is merely descriptive of the function or purpose of Applicant's services, Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP Section 1209 et seq.

On March 5, 2009, Applicant submitted its response by way of a "Combined Amendment, Response to Refusal to Register and in the Alternative, Request to Seek Registration on the Supplemental Register Should the Refusal to Register be Affirmed." The recitation of services were amended to read "computer services, namely, development and creation of web based applications to allow prospective college students to submit admissions applications on line via a global computer network; providing temporary use of non-downloadable software for online college applications and enrollment forms; data mining related to the college admission process." The response was presented in two parts. First as a request for reconsideration and secondly, should registration be denied, as a request to transfer the application to seek registration on the Supplemental Register.

The Examiner, on May 1, 2009, issued another non-final office action denying Applicant's alternate request for registration on the Supplemental Register, but repeated the "generic" refusal to register Under Section 23(c) of the Trademark Act. The Examiner added a dictionary definition to its Examiner's proofs of "genericness" and several print outs from a "google" search showing use of the terms "applications" and "on line".

Applicant submitted its Response to the Office Action of May 1, 2009, and by way of this Response, the original definition of services was cancelled and the definition of services was redefined as (1) "computer services, namely, development and creation of software for web based applications and Supplements thereto to allow prospective college students to submit admissions applications online via a global computer network" and (2) data mining, namely,

collection, storage and analysis of information derived from college admission applications”.

Both services fall within the International Class 42.

The Request for Registration of “development and creation of software for web based applications” was directed to the Supplemental Register, while “data mining services” served as a basis for a divisional application on the Principal Register.

Because a Formal Request to Divide the Application was not filed by Applicant as a separate written Request under 37 CFR 82.87(d), a Notice of Incomplete Divisional Request was issued on September 15, 2008. The deficiency was corrected on October 1, 2009. A Notice of Divisional Request Completed was issued on November 2, 2009. The services related to creation and development of web based applications formed the basis of subject parent application Serial No. 76/684,479, while data mining services formed the basis of child application 76/979,027. Child application 76/979,027 was published for opposition on March 2, 2010 and registration 3,789,049 for data mining services under the mark APPLICATIONSONLINE was granted to Applicant on May 18, 2010. The TTAB is requested to take judicial notice of the grant of this registration.

An Office Action dated January 14, 2010 was issued FINALLY refusing registration of the mark APPLICATIONSONLINE for the services set forth in parent application 76/684,479, namely, “computer services, namely development and creation of software for web based applications and Supplements thereto to allow prospective college students to submit admissions applications on line via a global computer network” on the ground that the proposed mark is generic and therefore unregistrable on the Supplemental Register.

E. History of the Development of Applicant's Servicemark APPLICATIONSONLINE.

Prior to 1975, there was no central organization that provided a common, standardized and printed application form for colleges and universities. Forms were prepared individually by prospective students and submitted separately to a student's school of choice. In 1975, with the administrative support of the National Association of Secondary School Principals (NASSP) and colleges that wished to provide a common, standardized first year application form, a not-for-profit membership organization named The Common Application (CA) was formed which developed a pilot print version of a common application. The project was in full operation by the school year of 1976.

In the early 1990's, Joshua A. Reiter, Ed.D was an adjunct professor at Johns Hopkins University, which was a member of CA. At the suggestion of a colleague, Dr. Reiter, in 1994-1995, developed software for a standardized version of a common college application form which was presented to CA for evaluation. CA accepted Dr. Reiter's proposal in 1998, at which time Dr. Reiter founded ApplicationsOnline, LLC. (AOL), Applicant herein.

AOL is a software development company specializing in designing and supporting college applications and mining of data collected therefrom. AOL transformed college admissions by creating THE COMMON APPLICATION ONLINE™, which enables prospective college students to submit a single common application online via the internet to multiple colleges and universities through CA's web site. AOL contracted with CA to host CA's website.

AOL's software dubbed APPLICATIONSONLINE, after its company name, is essentially an electronic bridge that permits data entered into THE COMMON APPLICATION ONLINE™, to travel and be properly processed electronically by the respective college requesting the information.

AOL's software and use of its server for processing the standardized college application of CA and the right to use APPLICATIONSONLINE were licensed to CA. The license was renewed periodically until AOL lost the bid to continue services after July 1, 2007 to a competitor.

The relationship between CA and AOL began in 1998, when CA accepted AOL's proposal to form THE COMMON APPLICATION ONLINE™ and continued until July 1, 2007.

From September 1998 to July 1, 2007, AOL provided technical service and support to CA for its licensed software pursuant to a series of license agreements with CA. The Agreements were periodically updated and each such agreement was independent of the others. The latest of said Agreements dated July 1, 2005, superseded all of the earlier agreements.

The Agreement was a two-year license agreement whereby AOL licensed its software for use on CA's website in connection with the solicitation and processing of online common college applications.

In January 2006, CA announced a Proposal (RFP) for the development and management of CA's common application service.

On February 28, 2006, AOL submitted a response to the RFP, but lost its bid to a competing software developer. The matter is now in litigation before the U.S. District Court for the Eastern District of Virginia.

F. **The Ultimate and Sole Issue Before the Trademark Trial and Appeal Board Is Whether The PTO Has Met Its Burden Of Proof As To Genericness.**

Applicant does not contest the legal contention that generic marks cannot be registered on the Supplemental Register.

Applicant and the Examiner are also in agreement that the test for determining whether a mark is generic is two-pronged: 1) what is the class of goods or services at issue; and 2) whether the relevant public understands the proposed mark primarily to refer to that class of goods or services. *H. Marvin Ginn Corp. v. Internat'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986). However, the Examining Attorney has the burden to establish that a term is generic by clear and convincing evidence. *In re Analog Devices, Inc.*, 6 U.S.P.Q.2d 1808 (TTAB 1988), *aff'd* 871 F.2d 1097, 10 U.S.P.Q.2d 1879 (Fed. Cir. 1989). In order to establish that a proposed mark is generic, an examining attorney must make a substantial showing that the matter is in fact generic based on clear evidence of generic use. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987). This showing must consist of evidence demonstrating the genus of the services at issue and that the relevant public understands that the mark refers primarily to that class of goods. *In re Am. Fertility Soc'y*, 51 U.S.P.Q.2d 1832 (Fed. Cir. 1999).

G. Determination of Genericness.

The two part test related to class of services and understanding of the relevant public are but legal guidelines to be followed after a factual determination based on the evidence and facts of record, In Re Am Fertility Society (Supra).

Whether a particular term is generic, and therefore cannot be a trademark or service mark, is a question of fact. *In re Reed Elsevier Props., Inc.*, 482 F. 3d 1376, 1378 (Fed. Cir. 2007). The Patent and Trademark Office (PTO) bears the burden of establishing that a proposed mark is generic, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, *supra*, and must demonstrate generic status by clear and convincing evidence. See Trademark Manual of Examining Procedure 1209.01(c)(i) (4th ed. 2005) ("The examining attorney has the burden of proving that a

term is generic by clear evidence.”); 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition Section 12:12 (4th ed. 2008).

The purpose of a standard of proof is “to instruct the fact finder concerning the degree of confidence our society thinks he should have in the correctness of factual conclusions for a particular type of adjudication.” *California ex rel. Cooper v. Mitchell Bros.’ Santa Ana Theater* 454 U.S. 90, 92-93 (1981) (quoting *In re Winship*, 397 U.S. 358, 370 (1970) (Harlan, J., concurring)). See *Oriel v. Russell*, 278 U.S. 358, 362-63 (1929). (“A mere preponderance of evidence in such a case is not enough [and] the court . . . should therefore require clear evidence . . .”); *Ramsey v. United Mine Workers of America*, 401 U.S. 302, 309 (1971) (stating that “clear evidence” or “clear proof” is equivalent to “clear and convincing evidence”); *Am-Pro Protective Agency, Inc. v. United States*, 281 F.3d 1234, 1239-40 (Fed. Cir. 2002) (explaining that “clear evidence” is equivalent to “clear and convincing evidence,” which is a heavier burden than preponderance of the evidence).

Evidence of the public understanding of the term may be found from such sources as dictionary listings, trade journals, newspapers and other publications. *In re Northumberland Aluminum Prods*, 777 F.2d 15556, 1559, 227 U.S.P.Q.961. 963 (Fed. Cir. 1985). Any doubt as to whether a mark is generic must be resolved in the applicant’s favor. *In re Waverly Inc.*, 27 U.S.P.Q.2d 1620, 1624 (TTAB 1993).

The Examining Attorney’s evidence purporting to establish that APPLICATIONSONLINE is generic for development of web based applications, providing temporary use of a non-downloadable software is a series of definitions related to the term “applications”, and responses to Internet inquiries using keywords “applications” and “online”. The Examiner’s search revealed that there are multiple definitions of the term “applications” but the Examiner’s search failed to develop any unauthorized use of APPLICATIONSONLINE.

This manifestly demonstrates that in order to determine what is meant by the mark, one would have to engage in a series of mental gymnastics. This is hardly what is meant by “generic”. For example, the mark could refer to any computer program accessed on line, see definition 7; request for employment, see definition 3e; a new process disclosed on line, see definition 3a; and/or special curative agent, see definition 2. The fact that only one of the multiple definitions relates to a request for admission to a school does not mandate a finding of genericness particularly where the words relied on by the Examiner for her search do NOT utilize or form the string of words which make up Applicant’s composite mark APPLICATIONSONLINE for which registration is sought.

In making a determination as to the matter of genericness, it is first necessary to determine the “relevant public” or “consumers” to which the mark is directed and then the class of services at issue and whether that universe understands the proposed mark primarily to refer to that class of services. In the present case, the Examiner has clearly and improperly attributed multiple different classes of services to which the mark allegedly “primarily” refers and improperly dissected Applicant’s composite mark. For example, on the one hand, in the Official Action dated May 1, 2009, the Examiner stated “In this case, the Applicant’s mark is primarily used to refer to applications to allow prospective college students to submit applications online.” The Examiner further states in the Official Action that “A consumer encountering the mark APPLICATIONSONLINE in connection with the services described would be immediately aware of the nature of the services.” On the other hand, in the Official Action dated January 14, 2010, the Examiner stated “‘applicationsonline’ is the generic term for a service that develops and create [sic] web based applications online.” The Examiner then states “The applicant’s identification of services and specimen demonstrate that applicant offers such a service.” These competing conclusions of the mark being generic are simply not credible, because for the mark to be generic it must cause the relevant public to think that it “primarily” refers to a class of

service. The fact that the software that is developed can be used to submit college admission applications over the Internet does not change the nature of the services from the development and creation of software for web based applications.

As a result, it would seem that the mark APPLICATIONSONLINE could more appropriately be viewed as a double entendre, since it does not necessarily create a composite term that would primarily only refer to “the development and creation of software for web based applications.” A “double entendre” is a word or expression capable of more than one interpretation. Specifically, APPLICATIONSONLINE could refer to “college admission applications that are available online,” or “job applications that are available online,” or “copies of application programs (i.e., computer programs) that are available online,” or “special curative agent(s) that are available for order online.” For trademark purposes, a “double entendre” is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. (*See*, TMEP § 1213.05(c).)

Applicant understands that “[t]he multiple interpretations that make an expression a ‘double entendre’ must be associations that the public would make fairly readily, and *must be readily apparent from the mark itself*. *See In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005)” (*see, Id.*). Given the above provided examples, Applicant clearly believes that the public would fairly readily make these associations. Applicant also understands that “[i]f all meanings of a ‘double entendre’ are merely descriptive in relation to the goods, then the mark comprising the ‘double entendre’ should be refused registration as merely descriptive. (*See, Id.*) However, in the instant case, for the reasons given herein, Applicant believes that at best the mark APPLICATIONSONLINE is suggestive and at worst it is capable of distinctiveness, for

“computer services, namely development and creation of software for web based applications and Supplements thereto to allow prospective college students to submit admissions applications online via a global computer network.”

The Examiner’s search strategy for Google results failed to include the mark for which registration is sought, namely APPLICATIONSONLINE. The search strategies included:

1. college applications online
2. applications online
3. online college applications

It is puzzling to Applicant as to why a search strategy did not use the complete mark for which registration is sought, namely the continuous string of words APPLICATIONSONLINE. Had the Examiner used the mark for her search strategy the results would have shown that the “consumer” Google search would have shown various printable commercial job applications available online. See for example, Applicant’s Exhibit C in its Response of Applications OnLine, LLC to Office Action dated November 2, 2009.

H. **The Case Of In re National Council for Therapeutic Recreation Certification (NCTRC), 2006TTAB 411, (TTAB September 15, 2006).**²

In 1999, NCTRC filed an application to register the certification mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST on the Principal Register. The PTO initially refused registration on the ground that the mark was merely descriptive. NCTRC responded by amending its application to claim acquired distinctiveness based on use of the mark for 18-plus years. The PTO found this lengthy use insufficient to establish acquired distinctiveness.

² An article discussing the NCTRC case was published in Trademark World, March 2007. The authors David M. Kelly and Linda K. McLeod discuss the use of terms like “certified” or “professional” with the name of a professional corporation and the treatment of refusals on the ground of genericness”.

The PTO issued a final refusal to register NCTRC's mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST on the ground it was generic or, in the alternative, lacked sufficient evidence of acquired distinctiveness assuming the mark was only descriptive. After amending the application to seek registration on the Supplemental register, the PTO based its genericness refusal primarily on the dictionary definitions of the individual words making up the mark and on news articles and Internet excerpts showing use of NCTRC's mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST in all lower-case letters.

On appeal, in an unpublished decision, the TTAB reversed the PTO's holding of lack of acquired distinctiveness as well as "genericness".

In determining whether the mark is generic, the TTAB applied the two-step legal test for genericness established by the Court of Appeals for the Federal Circuit. First, what is the genus (i.e., category or class) of services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of services.

Regarding the proper genus or category or class of services, the Federal Circuit has made clear that defining the genus too narrowly is improper. In this case, the PTO argued that the genus of services should be narrowly defined as "therapeutic recreation specialists who have been certified." The TTAB, however, rejected this argument and held that the description of services in the application is controlling if it is sufficiently definite to serve as the genus of services.

The TTAB then considered whether the mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST was a phrase or a compound word for purposes of analyzing the second part of the genericness test, whether the relevant public primarily understood the mark to refer to the genus of services at issue so that the whole mark was generic under the rationale of In re Gould Paper Corp., 834 F2d 1017 (1987). In Gould, the Federal Circuit held that evidence

of the generic meaning of the separate terms SCREEN and WIPE was sufficient to prove that the compound word SCREENWIPE was generic for cleaning wipes for television and computer screens.

NCTRC argued that the TTAB should follow In re American Fertility Society (AFS), 188 F.3d 1341 (Fed. Cir. 1999), in which the Federal Circuit distinguished between “phrases consisting of multiple terms, which are not ‘joined’ in any sense other than appearing as a phrase,” and compound terms “formed by the union of words”. In the AFS case, the Federal Circuit held that evidence that the separate terms SOCIETY and REPRODUCTIVE MEDICINE were each generic was insufficient to prove that the overall phrase SOCIETY FOR REPRODUCTIVE MEDICINE was generic for association services promoting the interests of the reproductive medicine industry.

The TTAB held that evidence that the separate words “certified” and “therapeutic recreation specialist” in NCTRC’s mark were generic was not sufficient to prove that the complete phrase was generic.

Turning to the second part of the genericness test, the TTAB found that the PTO failed to show by clear evidence that the phrase CERTIFIED THERAPEUTIC RECREATION SPECIALIST was understood by the relevant public to refer to “recreational therapy and recreational therapy counseling.” In other words, the PTO did not “demonstrate that the term designates, and is understood by those in the field of recreational therapy and persons who receive such services, as signifying a class or category of such therapy or therapy counseling.”

Although the PTO submitted significant evidence of newspaper and magazine articles showing uses of “certified therapeutic recreation specialist” in lower-case letters in the manner of a generic term, NCTRC demonstrated that the vast majority of the persons named in those articles were in fact authorized by NCTRC to use the mark.

I. Applying the Rationale Of the NCTRC Case It Is Easy to See Why The Examiner Has Failed to Meet Her Burden of Establishing That The Mark Is Generic By Clear Evidence of Generic Use

During prosecution, the Examiner characterized Applicant's services as follows:

"In this case, the applicant's mark is primarily used to refer to 'applications to allow prospective college students to submit admissions applications on line.' The applicant uses the wording "applications online" to describe its services because that is exactly the nature of the services" (emphasis added) at the outset, it should be noted that this is a misidentification of Applicant's mark, APPLICATIONSONLINE, which is an uninterrupted string of words forming a composite mark.

Secondly, the nature of Applicant's services is the development of software for web based applications. Since 1998 Applicant has provided its services primarily to a consortium of colleges which are members of CA. CA is licensed by Applicant to use its software and trademark APPLICATIONSONLINE. The common online application adopted by Applicant's licensee, CA, avoids the use of hand print versions and enables prospective students to file a single common application to several schools online. Applicant hosts the web site for CA and works with the consortium of colleges making up a membership association.

The Examiner's Google search using "college applications on line", or individual terms thereof rather than the complete mark APPLICATIONSONLINE is a biased entry, reminiscent of the "bearded man test" used for criminal line ups. In such a test, a bearded candidate is presented with four or five clean shaven candidates of the same physical stature and a victim is asked to identify the one who committed a crime, knowing the perpetrator to have a beard the end result is flawed. Notwithstanding the use of the terms "college" and "applications" in the Examiner's Google search, no hits uncovered the mark APPLICATIONSONLINE. Further, not

all hits were for college applications. The first attachment to the Google search in the first rejection is for Texas schools. The second page, Attachment No. 5, is from an Illinois admission process. The exact mark APPLICATIONSONLINE is not present. The third exhibit, Attachment No. 6 relates to job or career applications, as does Attachment Nos. 7-9. Thus, even the Examiner's biased Google search does not support her conclusion, and makes it abundantly clear that APPLICATIONSONLINE has alternate meanings and does not immediately and primarily bring to mind the services for which registration is sought: "computer services, namely development and creation of software for web based applications and Supplements thereto to allow prospective college students to submit admissions applications on line via a global computer network.

The term "APPLICATIONSONLINE," as noted previously, is used as a composite mark made up of a string of words put together by Applicant to name its operating entity, and could very well relate to an employment application, a tax form for submission to the IRS or any general application by which the user sought such special consideration. There is no immediate tie or link between the mark and Applicant's services other than to suggest one convenient use for Applicant's services. The mark is a composite mark made up of a string of words "APPLICATIONS," "ON" and "LINE".

It is not a dictionary term, but made up of words which are only descriptive in their own right when used alone.

The services for which Applicant seeks registration are not "applications" or hard copy printouts of applications completed by students. The services for which registration of the mark is sought are the development and creation of software for web based applications related to the college admission process. Such services may be suggestive of the end result, but they are not something that are immediately described by the mark.

It is well recognized that the combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is non-descriptive, Q Tips, Inc. v. Johnson & Johnson 98 USPQ (CA3 1953), cert. denied, 99 USPQ 491. The commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive. That is, the composite may be more than the mere sum of its parts.

There are a number of cases where composite marks comprising two or more words, each descriptive in its own right, have been held distinctive or capable of becoming distinctive when used in combination. Examples were cited by Applicant during prosecution and are called to the Board's attention, and can be found on pages 7 and 8 of Applicant's September 10, 2009 response to the May 1, 2009 Office Action.

The underlying basis of these decisions in the whole, in trademark law, is often greater than the sum of its parts and common words, in which no one may acquire a trademark because they are descriptive or generic, may, when used in combination become a valid distinctive trademark. Assoc. of Cooperative Members, Inc. v. Farmland Industries, Inc., 216 USPQ 361 (CA5 1982) cert. denied 460 U.S. 1038.

Applicant does recognize that a combination of two or more highly descriptive terms, both of which cooperate to literally describe a service may result in a composite that is just as descriptive at its component parts. For example, SCREENWIPE, in Gould, supra, or INVESTACORP for investment brokerage services, Investacorp Inc. v. Arabian Investment Banking Corp. 19 USPQ 2d 1056, (CA11, 1991). But that is not the case here, because APPLICATIONSLINE does not primarily and immediately convey to the consumer the services which registration is sought, namely, computer services for development and creation of software for web based applications and Supplements thereto the purpose of which is to allow

college students to complete and submit multiple applications on line to multiple colleges via a global computer network under a single control of CA.

It is respectfully submitted that applicant has so combined the words "APPLICATIONS" and "ON" and "LINE" into a unitary composite phrase so as to result in a mark which does not in any way immediately and primarily describe the services for which the mark is applied and for which registration is sought.

There is nothing to immediately tie "APPLICATIONSONLINE" with Applicant's services. To do so, would require, as the Examiner has done, a dissection of the mark into its separate parts contrary to the Anti Dissection Rule as applied to trademark examination (McCarthy On Trademarks, cf 11.10(2)).

As stated in McCarthy:

"Under the anti-dissection rule, a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts. As the United States Supreme Court stated: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538- 545- 546, 64 L. 705, 40 S. Ct. 414 (1920). See California Cooler Inc. v. Loretto Winery Ltd., 774 F.2d 1451, 1455, 228 USPQ 808, 810 (9th Cir. 1985). The mark CALIFORNIA COOLER "is a composite term and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark as a whole . . . Thus, the composite may become a distinguishing mark even though its component parts individually cannot."

Applicant recognizes that it is not a violation of the anti-dissection rule to separately view the component parts as a preliminary step on the way to an ultimate determination of probable customer reaction to the composite as a whole. As McCarthy goes on to state, the question of descriptiveness provides that the ultimate determination is made on the basis of the mark in its

entirety (emphasis added). An Examining Attorney's discussion of each word separately in order to show that the term in its entirety is descriptive may not be the same thing as dissecting a mark. but in the final analysis it is the mark in its entirety which must be considered.

A search of the United States Patent and Trademark Office data base via TESS for use of "ON LINE" and "APPLICATIONS" produced, respectively 6904 and 1552 records. A partial printout of pages showing records 1-250 for the "ONLINE" search and a partial printout of pages showing records 1-100 for the "APPLICATIONS" search enclosed, along with copies of selected records in Applicant's March 5, 2009 response to the Examiner's refusal to register. While, the printouts were resubmitted here, a listing of the selected records is provided for the Board's convenience.

<u>Record</u>	<u>Mark</u>	<u>Reg. No.</u>	<u>Goods/Services</u>
20	EUROSALESMAN ONLINE	3291216	advertising services
54	ONLINE BUDDIES	3565917	computer dating services
96	SCAN ONLINE	3158802	check verification
118	EASY ONLINE PAYROLL	3469554	online payroll preparation
170	ONLINE LIVE		printed instructional materials related to the use of software and hardware
177	UNIPAY ONLINE	3253813	temporary use of software for online banking
225	CASKETS ONLINE	3344056	funeral and cremation services

<u>Record</u>	<u>Mark</u>	<u>Reg. No.</u>	<u>Goods/Services</u>
64	ILLUSTRATION BY APPLICATION	3438047	advertising services
73	APPLICATION PLUS	3385465	computer programs, and software
80	APPSNOW	3324503	online market place for sellers of software
81	APPSNOW	3312482	software for use in developing and operating computer applications

These registrations vividly demonstrate that "APPLICATIONSONLINE" is capable of becoming distinctive for the specific services as amended in connection with which the mark is used.

CONCLUSION

In view of the foregoing remarks and based on the evidence of record, it is clear that APPLICATIONSONLINE is not generic and is capable of functioning as an indication of origin for Applicant's services. The foregoing remarks, evidence submitted and file history of the application clearly demonstrate that the Examiner has failed to present sufficient evidence to establish by clear and convincing evidence that APPLICATIONSLINE is a generic term for development and creation of web based applications.

Accordingly, the Examiner's refusal of registration should be removed and the mark APPLICATIONSONLINE passed for registration on the Supplemental Register. Any doubt with respect thereto must be resolved in favor of Applicant.

Respectfully submitted,

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