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APPLICATIONSONLINE - G3199-14007U - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76684479

**MARK:** APPLICATIONSONLINE



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Applications Online, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

G3199-14007U

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the examining attorney's final refusal to register the mark APPLICATIONSONLINE on the ground that it is generic under Trademark Act SectionRegistration is refused on the Supplemental Register because the applied-for mark is generic for applicant's goods. Trademark Act Section 23(c), 15 U.S.C. §1091(c); *see In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (holding SCREENWIPE generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (holding BUNDT, a term that designates a type of cake, generic for ring cake mix); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for light bulbs, lighting fixtures, and candle sleeves); TMEP §§1209.01(c) *et seq.*

## **FACTS**

On November 29, 2007, Applications Online, LLC filed a use based application to register the mark APPLICATIONSONLINE for “development and creation of web based applications to allows prospective college students to submit admissions applications online via a global computer network, such as, for example, the Internet.”

In an office action dated March 20, 2008, the examining attorney refused registration on the Principal Register, stating that the proposed mark was generic for the applicant’s services. On November 28, 2008, the examining attorney issued a second non-final action stating that the prior refusal to register was erroneously based on the assumption that the applicant was seeking registration on the Supplemental Register. Registration on the Principal register was then refused under section 2(e)(1) of the Trademark Act on the ground that the proposed mark is merely descriptive of the identified services.

On March 5, 2009, applicant responded to the refusal to register and in the alternative, requested registration on the Supplemental Register. The recitation of services was amended to read as “computer services, namely, development and creation of web based applications to allow prospective college students to submit admissions applications online 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.

On May 1, 2009, examining attorney issued another non-final office action denying applicant's alternate request for registration on the Supplemental Register and issued the genericness refusal to register under Section 23(c) of the Trademark Act.

On May 1, 2009, applicant submitted its response and amended the recitation of services to "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 "data mining, namely, collection, storage and analysis of information derived from college admission application." A request to divide was filed and the services related to "creation and development" became the parent application. "Data mining services" became the child application and was approved for registration.

On January 14, 2010, examining attorney issued a final office action refusing registration on the Supplemental Register on the ground that the mark is generic. The applicant timely filed a notice of appeal and submitted an appeal brief on July 2, 2010.

## **ARGUMENT**

**Registration is refused on the Supplemental Register on the ground that**

**APPLICATIONSONLINE is a generic term for applicant's services, "computer**

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

**1. “APPLICATIONSONLINE” IS A GENERIC TERM**

The proposed mark APPLICATIONSONLINE is a generic term for the source of applicant’s services, “computer services, namely, development and creation of software for web based applications to allow prospective college students to submit admissions applications online via a global computer network.”

A word or term that identifies the source or provider of a product or service, using only generic wording, is generic for those goods and/or services. *See In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for lighting fixtures because “electric candle” is a unitary generic term of a type of lighting fixture and “company” is simply an entity designation without source-identifying capability); *In re Paint Prods. Co.*, 8 USPQ2d 1863 (TTAB 1988) (holding PAINT PRODUCTS COMPANY so highly descriptive for paint that it cannot function as a mark); *In re E. I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984) (holding OFFICE MOVERS, INC. generic for moving services); TMEP §1209.03(q).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. TMEP §1209.01(c); *see In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods and/or services, and cannot be registered as trademarks and/or service marks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c).

A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of goods and/or services at issue?; and
- (1) Does the relevant public understand the designation primarily to refer to that class or genus of goods and/or services?

*In re 1800Mattress.com IP LLC*, 586 F. 3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

The class or genus at issue is the source or provider of “applications online” services.

The genus of the services involved is providing “applications online.” The relevant public readily understands “applications” to refer to a form to be filled out by an applicant, and “online” to mean connected to the Internet or an online service.

For proof that applicant's designation is incapable of identifying and distinguishing its computer services, one need only look at dictionary definitions of the two elements in the mark. Dictionary.com defines "applications" as a form or document on which such request is made and "online" as "available or operating on a computer network." Clearly, in light of the above evidence, the term "APPLICATIONSONLINE" directly conveys significant information about the nature of the applicant's services, namely, that they involve the development of web based applications.

**2. "APPLICATIONSONLINE" IS A COMPOUND TERM AND IS NOT A DOUBLE ENTENDRE**

Applicant, in its brief, states that the relevant public would not automatically refer to the mark APPLICATIONSONLINE as being generic because the mark is a "double entendre" that is capable of more than one interpretation. As demonstrated by the "dictionary definitions of "applications" and "online", and third-party use of "applications online", what applicant seeks to register is incapable of functioning as a trademark. "Applicationsonline" is a unitary generic term. The addition of the non-source identifying term "online" to a generic term, "applications" creates a compound term. Combining "applications" and "online" does not create a composite which is so incongruous or unusual, or which otherwise possesses a new meaning different from its constituent terms as to possess no definitive meaning or significance other than that of an identifying mark.

Although the applicant claims that the essence of the service it provides is the development and creation of software for web based applications, the word “applications” identifies the goods that are central characteristics of the applicant’s services. The designation “online” merely identifies the Internet connection, which when combined indicates that potential purchasers could access, by way of the Internet, applicant’s services involving applications.

In this way, APPLICATIONSONLINE is similar to the mark BLINDSANDDRAPERY.COM which was found to be generic in *In re Eddie Z’s Blinds and Drapery, Inc.* 74 USPQ2d 1037 (TTAB 2005). The court in that case determined that Gould, in *In re Gould Paper, Corp.* 834 f2D 1017 (1987), applied and that the compound term comprised of the generic term “blinds and drapery” coupled with non-source identifying term “.com,” was generic. The court further determined that because *Gould* applied, the burden of genericness was met by providing evidence of the genericness of “blinds and drapery” and “.com” separately.

For purposes of consideration of whether APPLICATIONSONLINE is generic, the examining attorney considered the evidence related to the field of college applications online. As support, the following examples were provided to the applicant, which utilize the term “applications” and “online:”

**“APPLY ONLINE: Complete and submit your admissions and scholarship applications online – [www.applytexas.org](http://www.applytexas.org) (accessed from 5/1/2009)**

**“CommonApp is a not for profit organization that services students and member institutions by providing admissions applications online” – [www.commonapp.com](http://www.commonapp.com) (evidence from 5/1/2009)**

**“fill out an application online” – [www.admissions.illinois.edu/apply/](http://www.admissions.illinois.edu/apply/) (accessed from 5/1/2009)**

The Office has supplied ample evidence to support this position. Evidence of the public’s understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, and publications. TMEP Section 1209.0(c)(i). So widespread is the use of the term “APPLICATIONS ONLINE” that it can be safely said it is as readily employed and recognized as a term of art in the college application process. See also: *In re Randall & Hustedt*, 226 USPQ 1031 (TTAB 1985); and *Exxon v. Motorgas*, 219 USPQ 440 (TTAB 1983). (Use of a term of art, even if only in the relevant field or trade, is sufficient to support a refusal of registration under Section 2(e)(1):

## **CONCLUSION**

As such, APPLICATIONSONLINE would not be recognized by consumers as a trademark, but merely as the generic term for the source of the services. Accordingly, the proposed mark APPLICATIONSONLINE cannot be registered on the supplemental register because it is a generic term for a service provider of “applications online.”

Respectfully submitted,

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