

TRADEMARK
Docket No. 45385.00020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

U.S. Encode Corporation

Mark: ENCODE

Serial No.: 78/163,615

Filing Date: 9/12/2002

Trademark Atty: Kelly F. Boulton

Law Office: 102

BOX RESPONSES NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

REQUEST FOR RECONSIDERATION

This is intended to be a complete response to the Office Action dated September 14, 2003. The Office Action has been carefully reviewed, and every effort has been made to put the application in condition for approval for publication. A timely Notice of Appeal and a Statement of Use with requisite fees are being filed herewith.

IDENTIFICATION OF GOODS AND SERVICES

Please amend the identification of goods and services as follows:

“Transaction tokens for use with a computer, namely, computer discs, computer cassettes, computer cartridges, electronic chip cards, and electronic apparatus for recording and storing data, all of which are used to store transaction information, transaction account information, and security information, and containing programming used to engage in online transactions using the stored information and for generating pop-up advertising in International Class 09;

Advertising services, namely creating corporate logos and marketing campaigns for others to be displayed through the use of transaction tokens for use with a computer, namely computer discs, computer cassettes, computer cartridges, electronic chip cards, and electronic apparatus for recording and storing data in International Class 035; and

Financial services, namely credit card account services and pre-paid account services, namely processing electronic payments made using transaction tokens for use with a computer, namely, computer discs, computer cassettes, computer cartridges, electronic chip cards, and electronic apparatus for recording and storing data in International Class 036.”

Consistent with the Examining Attorney's recommendation, Applicant has amended the identification of goods to specify on-line transactions, to delete the term “and the like,” to replace the trademark “MEMORY STICK” with the common commercial name of the goods associated therewith, and to include the term “all of which” so as to indicate that all of the goods, including the electronic chip cards, contain programming.

REMARKS

The Examining Attorney has refused registration under Trademark Act §2(e)(1). The Examining Attorney has asserted that the term ENCODE is defined as “to format (electronic data) according to standard format” or “to convert data or some physical quantity into a given format.” The

Examining Attorney reasons that Applicant's goods contain programming, and therefore Applicant has converted data into a standard format used with those goods, *i.e.*, the applicant has encoded goods." Applicant respectfully disagrees for the following reasons.

The determination of whether a mark is merely descriptive of the goods for which it is used "requires consideration of the context in which the mark is used or is intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace."¹ A term that might relate to an unremarkable feature of a product does not necessarily operate to "immediately convey...knowledge of the ingredients, qualities, or characteristics of the goods...with which it is used" as required by *Gyulay*.² In order for refusal to be proper, the term must additionally fulfill the larger requirement of being truly descriptive of the goods for which it is used.

According to the Examining Attorney's definition of the term "ENCODE," all media is considered to be encoded. For that matter, a wide array of products including such unrelated goods as appliances and automobiles are considered to be encoded. When a given quality or characteristic is so ubiquitous as to exist across wide ranges of unrelated products and technologies, that quality does nothing to describe any one particular product or technology.

¹ TEMP §1209.01(b) citing *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

² *In re Gyulay*, 820 F.2d 1216, 1217, (Fed. Cir. 1987) citing *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525, (CCPA 1980).

For example, all model airplanes have wings. Moreover, a wide variety of other goods also have wings. However, the term "WINGS" is a registered trademark for model airplanes.³ This is presumably because the term is such a basic, integral part of all goods of the type for which it is used, as well as other unrelated goods, that the term does not function as descriptive of any one particular thing. That is, the average purchaser would not immediately associate the mark with the identified goods. Similarly, an average purchaser would not immediately associate the term "ENCODE" with any particular type of goods, including those for which Applicant uses the mark. Accordingly, Applicant maintains that the term "ENCODE" is not descriptive of Applicant's goods and respectfully requests reconsideration of refusal.

AMENDMENT TO SUPPLEMENTAL REGISTER

Should the Examining Attorney maintain refusal after consideration of the foregoing remarks, Applicant requests that the words "Principal Register" be changed to "Supplemental Register." TEMP § 1115.01.

³ U.S. Registration No. 1,086,533 (Principle Register).

CONCLUSION

It is believed that Applicant has responded to all of the Examining Attorney's questions and objections and that the application is now in condition to proceed to publication. Should the Examining Attorney have any questions about the application or information contained herein, the Examining Attorney is invited to telephone or e-mail the undersigned at (858) 720-2832 or dianegardner@paulhastings.com.

Dated: 5/14/2004

Respectfully submitted,

By: 
Diane L. Gardner, Esq.
Attorney for Applicant
U.S. Encode Corporation

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TRADEMARK
Docket No: 45850070

STATEMENT OF USE

Mark	ENCODE
Serial No.	78/163,615

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS

Applicant Name U.S. Encode Corporation

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Supplemental Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq. as amended). One specimen (2 copies) showing the mark as used in commerce is submitted herewith.

Applicant is using or is using through a related company the mark in commerce on or in connection with all of the goods identified in this application.

The mark was first used in connection with the goods and services in Int. Classes 9, 35 & 36 at least as early as June 7, 2002 and was first used in connection with said goods and services in commerce at least as early as June 7, 2002 and is now in use in such commerce in connection with said goods and services.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this Statement of Use on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; the trademark/service mark is now in use in commerce; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

5-14-04

Date

Signature

(858) 546 1122
Telephone No

Brian Murray CEO
Name and Title

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:	U.S. Encode Corporation	Trademark Atty:	Kelly F. Boulton
Mark:	ENCODE	Law Office:	102
Serial No.:	78/163,615		
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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

BOX RESPONSES- NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

I hereby certify that the attached Request for Reconsideration Responsive to the Office Action dated November 14, 2003 in connection with the above-referenced application, Statement of Use, Specimen of Use (2 copies), check in the amount of \$300 (\$100 per class), Certificate of Mailing under 37 C.F.R. § 1.8, and our receipt verification postcard are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on 5/14/2004.

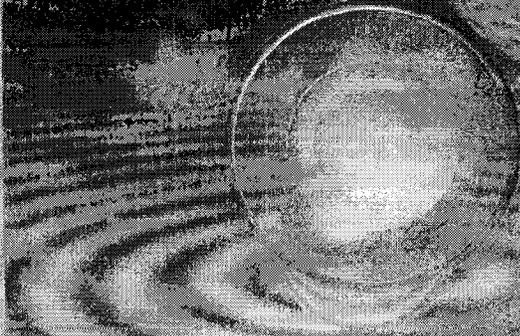
Date: 5/14/2004

Respectfully submitted,



Timothy F. Lasher

ENCODE EN-CARD



NET.
ENCODE

MasterCard
SecureCard

✓
VERIFIED
by VISA

1 378 2 5557 338709 JOHN DOE

ENCODE EN-CARD



TEST
ENCODE

MasterCard
SECURECARD

VERIFIED
by VISA

1976 43857 338709 JOHN DOE

PaulHastings

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May 14, 2004

BOX RESPONSES – NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: U.S. Service Mark Application No.: 78/163,615
Mark: ENCODE
Class(es): 9, 35, 36
Our reference: 45385.00020

Dear Sir:

Enclosed for filing is a Request for Reconsideration responsive to the Office Action dated November 14, 2003 in connection with the above-referenced application. Also enclosed is a Statement of Use, 1 Specimen of Use (2 copies), check in the amount of \$300 (\$100 per class), Certificate of Mailing under 37 C.F.R. § 1.8, and our receipt verification postcard.

The Assistant Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment, to **Deposit Account No. 50-2613**. A duplicate copy of this letter is enclosed for this purpose.

Very truly yours,



Diane L. Gardner
Enclosure(s)



05-17-2004

SAN /90109.1

U.S. Patent & TMOs/TM Mail Rept Dt. #72

PaulHastings

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May 14, 2004

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Diane. L. Gardner
Enclosure(s)