

ESTTA Tracking number: **ESTTA27696**

Filing date: **03/08/2005**

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

Proceeding	78279935
Applicant	Tablus, Inc.
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Submission	Appeal Brief
Attachments	TTAB_Ex Parte Appeal_Content Alarm.pdf (5 pages)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

.....)
In re:)
)
Serial No. 78/279935)
)
Applicant: Tablus, Inc.)
)
Filed: July 28, 2003)
)
CONTENT ALARM)
.....)

APPLICANT'S APPEAL BRIEF

Applicant, Tablus, Inc., hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney's final refusal of registration dated October 6, 2004, and files the foregoing APPEAL BRIEF within 60 days of filing the Notice of Appeal:

FACTS OF THE CASE

The Examining Attorney has refused registration of Applicant's mark CONTENT ALARM for "computer software that uses linguistic analysis to monitor the transmission of sensitive digital content and provides instant visibility into sensitive information in outgoing network traffic" on the Principal Register. The Examining Attorney believes the trademark is descriptive of the goods under Trademark Act section 2(e)(1).

Applicant submitted arguments indicating that the trademark is suggestive of the goods and that the Examining Attorney has not established that the mark, when considered in its entirety is descriptive of the goods.

ISSUE TO BE DECIDED

Whether the applicant's mark in connection with the goods identified in the application is merely descriptive of the goods, when considered in its entirety.

ARGUMENTS

- I. "CONTENT" Falls Short of Describing Applicant's Services in Any One Degree of Particularity**

In *In re TMS Corporation of the Americas*, 200 USPQ 57 (TTAB 1978), the Trademark Trial and Appeal Board decided that “THE MONEY SERVICE” in connection with “financial services wherein funds are transferred to and from a savings account from locations remote from the associate financial institution” was not descriptive. They held that because the mark is composed of commonly used words of the English language, it suggests a number of things, but falls short of describing applicant’s services in any one degree of particularity; thus requiring the actual or prospective customer to use thought, imagination and perhaps an exercise of extrapolation.

This case is similar to THE MONEY SERVICES because “money” and “funds” are synonymous and despite the fact that the applicant’s services involved the transfer of money, the TTAB looked beyond the recitation of services and considered the broad meaning of the words contained in the mark. They decided that despite the mention of “funds,” the wording “MONEY” was too broad to describe the services with any one degree of particularity.

Similarly, as all computer software contains content and manages content, the wording CONTENT in the mark does not sufficiently identify the applicant’s goods with any one degree of particularity, even though the identification of goods states that the software manages digital content.

Since “CONTENT” fails to identify the applicant’s software with any one degree of particularity, the wording requires the customer to use thought, imagination, and extrapolation, and is therefore suggestive.

II. **ALARM is Suggestive Because it is One Step Removed from Descriptiveness.**

For a term to be descriptive, it must immediately describe an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In *re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, in determining descriptiveness, the courts and the TTAB frequently use the “degree of imagination test.” *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 507 (TTAB 1995). As summarized by McCarthy on Trademarks and Unfair Competition, 4th ed. §11:67 at pg. 11-110 (1997), “[i]f the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.”

The wording ALARM does not almost instantaneously describe the products attributes

because it is one step removed from the product's function and purpose. "ALARM" refers to "[a]n electrical, electronic, or mechanical device that serves to warn of danger by means of a sound or signal." American Heritage Dictionary of the English Language, 4th ed (2000). The Examining Attorney states that the goods contain an alarm function, alerting users through a graphical interface that the transmission of sensitive content has occurred. In actuality, the software is monitoring software that provides notice to the user of the transfer of sensitive corporate data. There is no electrical, electronic, or mechanical device within the software that warns of danger by means of a sound or signal. The user of the software, after seeing strange activity may or may not decide to sound an alarm to alert his superiors. Put another way, the CONTENT ALARM software acts like a video camera monitoring an area for activity. The guard is akin to the user, who, after seeing strange activity, may sound an alarm to alert his superiors or conduct further investigation. As applicant's software is monitoring software and not alarm software, ALARM is merely suggestive of what can be accomplished with applicant's software.

III. "CONTENT ALARM" is Not Descriptive of the Goods when Viewed in its Entirety

Even if CONTENT or ALARM were descriptive individually, the Examining Attorney must provide evidence that the public would view the wording CONTENT ALARM as in its entirety as a descriptive mark. The Examining Attorney has only provided explanations for why each individual component of the mark is descriptive. The TTAB has found that an Examining Attorney's failure to cite any third-party uses of a mark rejected for being "merely descriptive" can corroborate an applicant's assertion that the mark has no immediate, obvious meaning in relation to its services. See *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986)(TTAB's conclusion that the mark SHOWROOM ONLINE is suggestive of applicant's services corroborated by the fact that not a single third-party use of the term had been identified).

Further, it is well settled that the combination of two or more descriptive elements as a composite mark can result in a non-descriptive mark. See *Q-tips, Inc. v. Johnson & Johnson*, 206 F.2d 144, 98 USPQ 86 (3d Cir. 1953; cert. denied, 346 US 867, 98 1.Ed 377 S. Ct. 106, 99 USPQ 401 (1953)). As the Examining Attorney has provided no arguments or evidence that CONTENT ALARM as a whole immediately describes the software, the Examining Attorney is

respectfully requested to withdraw the refusal even if he believes that the individual words are descriptive.

IV. The Examining Attorney Erroneously Uses the Word ALERT and ALARM Interchangeably in Order to Support His Argument that CONTENT ALARM is Descriptive.

Applicant submits that the Examining Attorney's arguments are insufficient to support descriptiveness of Applicant's mark because he sets forth arguments supporting descriptiveness of CONTENT ALERT (and not CONTENT ALARM), without showing how arguments for one support arguments for the other.

The Examining Attorney argues "contrary to applicant's claims, the goods serve to *alert* the user that sensitive content is leaving the network" (emphasis added). He then cites an excerpt from the applicant's website "...Another Content Alarm installed at the perimeter of the provider's network *alerts* the security officer immediately if any propriety data leaves the partner's network..." (emphasis added). Then the Examining Attorney concludes "while no bell, whistle or buzzer may sound, the program clearly *alerts* the auditor when predefined conditions are met" (emphasis added).

Accordingly, the Examining Attorney fails to show how CONTENT ALARM (not CONTENT ALERT) is descriptive of the software.

V. The Examining Attorney Misapplies the Definition of ALARM

While the Examining Attorney and Applicant have proposed various definitions of the word "ALARM," even the Examining Attorney's own definition does not support descriptiveness. The Examining Attorney offers the American Heritage Dictionary definition of "Alarm" which refers to "a warning of existing or approaching danger." The Examining Attorney argues that because CONTENT ALARM notifies an auditor of a violation and alerts a security officer immediately if any proprietary data leaves the network, it fits the definition of "alarm."

The Examining Attorney would be correct if the software worked to prevent data from leaving the network or notify a security officer before the data left. "A warning of existing or approaching danger" connotes that the danger has not yet occurred, or is in the process of occurring. In fact, the same dictionary defines "warning" as "[a]n intimation, threat, or sign of

impending danger or evil" (emphasis added). Instead, the software merely notifies the security officer AFTER the purported "danger" occurred so that appropriate persons may be held accountable. As a practical matter, data leaving a network operates too fast to be stopped by human action. The Examining Attorney's own excerpt of the Applicant's website corroborates this:

"Another Content Alarm installed at the perimeter of the provider's network alerts the security officer immediately if any proprietary data *leaves* the partner's network." (Final Office Action, Pg. 2) (emphasis added).

This language does not indicate that Content Alarm is capable of alerting the security officer immediately if any proprietary data is leaving the network, or before the data leaves. Thus, there is no "warning" per se, and applicant's use of the wording "ALARM" is merely suggestive of the software's monitoring ability.

VI. Supplemental Register

Should the Board agree with the Examining Attorney that Applicant's mark is descriptive of its goods, Applicant respectfully request that the Board permit registration on the Supplemental Register.

CONCLUSION

WHEREFORE, Applicant prays that the Examining Attorney's refusal of registration be reversed and that registration be granted on the Principal Register.

Submitted on January 11, 2005

By 

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