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ESTTA Tracking number: **ESTTA156052**

Filing date: **08/10/2007**

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

Proceeding	78325604
Applicant	Mentor Graphics Corporation
Applied for Mark	VIRTUALWIRES
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Submission	Appeal Brief
Attachments	VIRTUALWIRES 78325604 Appeal Brief.pdf (8 pages)(64394 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trademark Application of Mentor Graphics Corporation
Application Serial No.: 78/325604
Mark: VIRTUALWIRES
Filing Date of Application: November 10, 2003
Attorney's Ref. No.: 1011-324/ddh

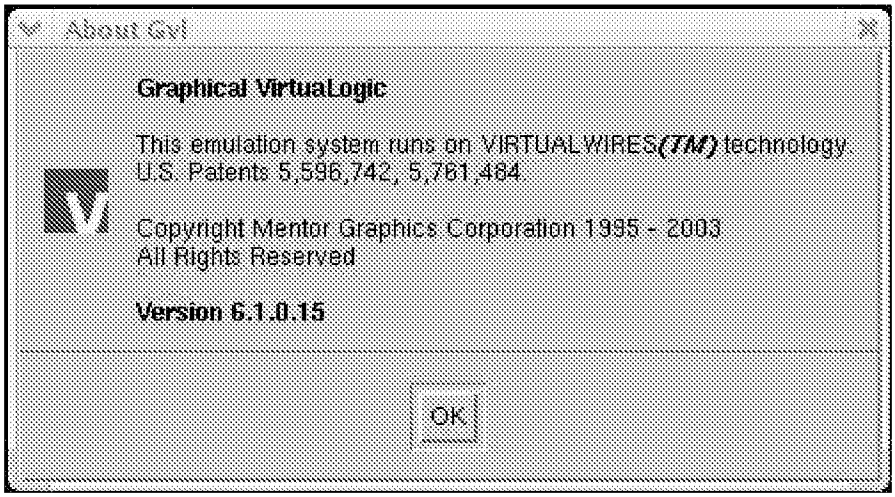
APPLICANT'S APPEAL BRIEF

I. Introduction

Applicant Mentor Graphics Corporation appeals the Examining Attorney's final refusal to register the subject mark. Registration has been refused pursuant to Trademark Act Sections 1, 2 and 45 (15 U.S.C. §§ 1051, 1052 and 1127) on the basis that the specimens submitted with the Statement of Use fail to show use of the mark as a trademark.

II. The Specimen

The specimen is reproduced below:



The goods in the application are "computer hardware and software for electronic design automation." The specimen is a screen that is displayed on the monitor when the computer user requests "About" information from the software's Help menu.

III. Question Presented

Does the mark VIRTUALWIRES as used on the specimen show use of the mark as a trademark?

IV. Argument

1. As Used on the Specimen, the Mark *Identifies* and *Distinguishes* the Goods

The Examining attorney argues that the mark on the specimen "is being used to describe a technology and not "computer hardware and software for electronic design automation."" Although VIRTUALWIRES is used as the name of a "technology" rather than as a name for "software" in the sentence on the specimen, the mark clearly functions as a source indicator. For the reasons detailed below, Applicant respectfully disagrees with the Examining Attorney's basis for refusing registration.

Section 45 of the Trademark Act defines a trademark as "any word, name, symbol, or device, or any combination thereof used by a person * * * to identify and distinguish his or her goods * * * from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127. Thus, to function as a trademark, a term must be used in a way that it is readily perceived by consumers as identifying the goods and distinguishing a single source of origin for the goods.

A few details about the goods and the specimen are helpful. VIRTUALWIRES is software. VIRTUALWIRES software enables a technology that is used in several different kinds of software and hardware sold by Applicant. In a variety of marketing materials, and on the specimen, Applicant uses the word "technology" to describe its VIRTUALWIRES product, in part because it is a background software system that is used in numerous other, separately branded products. It is appropriate therefore from a product marketing viewpoint to identify the VIRTUALWIRES product as a technology.

In the case of the specimen submitted with the Statement of Use, VIRTUALWIRES is software that is used in another software tool called GVL. GVL is an emulation system that helps users to emulate complex circuits. VIRTUALWIRES is software used in GVL that enables certain scaling technologies used in electronic design automation emulation.

On the specimen the mark is used in the following sentence:

> "This emulation system runs on VIRTUALWIRES (TM) technology."

(emphasis in original)

Certainly it is true that in this sentence, VIRTUALWIRES is used as a name for a "technology" that the GVL emulation system runs on. But it is just as true that the "technology" that runs the GVL emulation system is software. The critical question is whether consumers perceive the mark as a source indicator for software.

Although the Examining attorney argues that the specimen does not show trademark use because it is being used to describe a technology and not software, perhaps it would be more accurate to say that in the sentence on the specimen the word VIRTUALWIRES is used to *name* (i.e., brand) a technology. VIRTUALWIRES cannot describe a technology because other than as a trademark, the word VIRTUALWIRES has no recognizable meaning whatsoever.[1]

Rather than the mark VIRTUALWIRES describing the technology, as urged by the Examining Attorney, the word "technology" in the subject sentence is a generic description that follows the trademark to describe what the trademark relates to. "Technology" thus describes the goods associated with the mark, not the other way around. While Applicant could use the word "software" after its mark to describe the product, it has instead chosen to use the broader term "technology" for marketing purposes. Proper trademark use does not require that the mark include a descriptor of the goods. A splash screen that said only VIRTUALWIRES (TM) would

[1] The Examining attorney does not allege that the mark VIRTUALWIRES is "merely descriptive" under 15 U.S.C. § 1052(e).

be perfectly acceptable trademark use. But when a trademark owner chooses to use a descriptive term after a mark, there is no reason why the description must recite the specific goods identified in an application to register the mark, especially as here where the consumers know exactly what the word means.[2]

It is no less accurate or correct to say "This emulation system runs on VIRTUALWIRES (TM) software" than it is to say "This emulation system runs on VIRTUALWIRES (TM) technology." The two sentences mean precisely the same thing, at least to the consumers of these products, and in both sentences the mark has a source identifying function.

Although Applicant chose the word "technology" to describe its goods rather than what might be considered a more conventional word "software," consumers are clearly given the impression that VIRTUALWIRES is a brand name for the a product. Use of the word "technology" does not result in the trademark losing its source identifying function.

2. Consumers Perceive the Mark as Being a Source Identifier

The most important factor in determining whether a term is being used as a trademark considers the impression the mark makes on the relevant public. Would the term be perceived by the relevant consuming public as a source indicator? To be a trademark, the term must be used in a manner calculated to project to consumers or potential purchasers a source of origin for the goods. This is determined by examination of the specimens.

In this case there are at least three distinct reasons why Applicant's consumers immediately perceive the mark VIRTUALWIRES as used on the specimens as an identification of the source of software.

First, the consumers of Applicant's goods are sophisticated engineers who, when dealing with software understand that the words "VIRTUALWIRES (TM) technology" identifies the source of a good that is enabled by proprietary software, despite the fact that the broad and encompassing word "technology" is used to

[2] "VIRTUALWIRES (TM) technology" is equivalent to VIRTUALWIRES (TM) software" and is analogous to, for example, WINDOWS® software and FORD® automobiles.

describe the brand name. As noted above, the goods described in the application are "computer hardware and software for electronic design automation." Electronic design automation ("EDA") is a highly specialized field of electronics and electrical engineering that deals with the modeling, development and engineering of complex circuits (see www.edac.org/industry_what_is_eda.jsp). Engineers who use EDA software are highly trained and educated—they typically are electrical engineers who specialize in complex circuit design. The software they use in their profession is just as sophisticated as the users. When a customer or prospective purchaser such as an EDA engineer uses a software product and sees a splash screen that says "This emulation system runs on VIRTUALWIRES (TM) technology", they know that the word VIRTUALWIRES is being used to identify the source of the technology—the source of the software. Indeed, many engineers purchase specific software tools from Applicant because the tools use the VIRTUALWIRES technology. These consumers don't need to be told that the "technology" in this case is in fact software for use in EDA.

During prosecution of the application and in response to the Examining attorney's initial refusal to register the mark based on the perceived problems with the specimen, Applicant argued that to consumers of these goods, the words "technology" and "software" are indistinguishable. Citing dictionary definitions for the words, the Examining attorney disagreed. But words have different meanings to different users and in different contexts. Here, an electrical engineer who works in the EDA field is well-suited to understand that in the sentence "This emulation system runs on VIRTUALWIRES (TM) technology", the mark is identifying the source of Applicant's goods, software, even though the word "technology" is used.

If the Examining attorney's argument were adhered to in all cases, then trademark applicants would lose their ability to use descriptive terms *appropriate to their fields* to describe the goods that the mark identifies. Many trademark owners place colloquial or slang terms in their marketing materials after their brands. For example, a ski manufacturer might promote its racing skis with the following: "VOLKL® racing sticks"—the words "racing sticks" being a popular term among ski racers for high end racing skis. However, the Examining attorney might refuse

registration if such a term were used on a specimen based on the argument that the mark is being used to describe racing sticks, not skis, despite the fact that consumers of high end racing skis know precisely what the term means, that VOLKL® is a source identifier, and that the sticks are in fact skis. The same is true with Applicant's consumers, who intuitively know that "technology" in this case is a reference to software.

Second, the mark is used in the sentence in a manner that tells consumers that the word is the source identifier of the goods and not a description of them. Although the Examining attorney states that on the specimen the mark "does not appear prominently separately on the splash screen like the wording 'GRAPHICAL VIRTUALLOGIC' or the 'V DESIGN'", inspection of the specimen shows that the Examining attorney overstates the position. In this case the mark is printed in all capital letters while all other text in the sentence is presented in all small letters. Consumers understand that in any sentence in which one word is printed in all CAPITALS the author intended to distinguish that word and to draw attention to it. In this case, Applicant used capital letters to point out that the word is a trademark.

Third, TM symbol is used next to the mark and it is printed in bold typeface font. This is a further indication to consumers that VIRTUALWIRES is Applicant's trademark. Clearly, the word is set apart from the rest of the text to indicate that it is being used as a trademark.

When all these factors are considered and the specimen is taken as a whole, the commercial impression given by the mark on the specimen is inescapable: the specimen clearly informs consumers that VIRTUALWIRES is a trademark used by Applicant to identify the source of its goods.

3. "Use of a Mark to Describe a Technology" is Not a Proper Basis for Refusing Registration

When an Examining attorney refuses registration on the basis that the mark is not being used as a trademark, then she must explain the specific reasons for the conclusion that the subject matter is not used as a trademark. *See* TMEP §§ 1202.01. In this case the Examining attorney supports the conclusion that the mark

is not being used as a trademark but instead is being used to describe a technology with the argument that the words “technology” and “software” have different definitions.

The Examining Attorney’s basis for refusing registration is misplaced. The TMEP provides a list of situations in which it may be appropriate, depending upon the circumstances, for the Examining attorney to refuse registration on the ground that the asserted trademark does not function as a trademark. The list includes the following situations:

-trade names (TMEP § 1201.01);
-functionality (TMEP § 1201.02);
-ornamentation (TMEP § 1201.03);
-informational matter (TMEP § 1201.04);
-color marks (TMEP § 1201.05);
-goods in trade (TMEP § 1201.06);
-columns or sections of publications (TMEP § 1201.07);
-title of single creative work (TMEP § 1201.08);
-names of artists and authors (TMEP § 1201.09);
-model or grade designations (TMEP § 1201.10);
-background designs and shapes (TMEP § 1201.11);
-varietal and cultivar names (TMEP § 1201.12);
-scent or fragrance (TMEP § 1201.13);
-holograms (TMEP § 1201.14); and
-sound marks (TMEP § 1201.14).

Nowhere in the list does anything akin to “Description of technology” appear. And with good reason, since in this case Applicant chose the word “technology” for very valid reasons, and most importantly, consumers understand exactly what it means. While an argument could be made that the Examining attorney’s refusal falls within the scope of the “informational matter” category (TMEP § 1201.04), this refusal clearly would not be appropriate because the term VIRTUALWIRES does not convey any information in the sense required to support a refusal based on the mark merely being informational, either alone or in the context of the sentence on the specimens. Applicant does not suggest or imply that the TMEP’s list of bases for refusing registration is exclusive. However, the absence from the list of any examples where a mark is refused registration on the basis that it is used in a

manner that describes something else indicates that in this case the Examining attorney's basis for refusing registration is, at best, a close call.

4. Conclusion

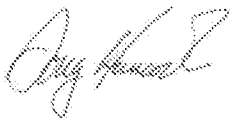
This appeal likely would not have been necessary had Applicant used the following sentence instead of the one discussed above:

> This emulation system runs on VIRTUALWIRES (TM) software.

But trademark owners should not be constrained in the language they use to market their goods to customers, especially where the customers are sophisticated and know exactly what they are purchasing and what the goods do. In this case Applicant has used the mark in a manner calculated to distinguish the mark and imbue it with source identifying function.

Applicant requests that the refusal to register on the ground that the specimen is unacceptable evidence of trademark use in connection with the identified goods be reversed.

Respectfully submitted,



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