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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/325604

**MARK:** VIRTUALWIRES



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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:** Mentor Graphics Corporation

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

1011-324

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

The applicant, Mentor Graphics Corporation, has appealed the previous trademark examining attorney's refusal to register the mark VIRTUALWIRES for "computer hardware and software for electronic design automation." Registration is refused under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127 because the proposed mark, as used on the specimen of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source and does not show use of the mark with the goods specified in the application. The examining attorney respectfully requests that this refusal be affirmed.

## **ISSUES**

The issues on appeal are whether the applicant's use of its mark on the specimen of record functions as a trademark to identify and distinguish applicant's goods from

those of others and to indicate their source and whether the applicant's use of its mark on the specimen of record shows use of the mark with the goods specified in the application. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127.

### **STATEMENT OF FACTS**

On November 10, 2003, applicant applied to register VIRTUALWIRES for "computer hardware and software for electronic design automation." The Office approved the mark for publication on May 26, 2004. The Office issued a Notice of Allowance on September 7, 2004. Applicant applied for three SOU Extension Requests on February 8, 2005, August 29, 2005, and March 1, 2006, each of which the Office granted on March 1, 2005, August 31, 2005, and March 3 2006 respectively.

On August 22, 2006, applicant submitted a statement of use for the mark VIRTUALWIRES. On November 18, 2006, the Office issued an action refusing registration based on a failure to function and on a failure to show use of the mark with the goods specified in the application. On November 28, 2006, applicant responded with arguments against the refusals. On February 3, 2007, the Office issued a final action maintaining the refusal.

This appeal followed. On September 12, 2007, the Office transferred the file to the examining attorney of record.

### **PRELIMINARY OBJECTIONS**

The examining attorney objects to the applicant's attempt to introduce evidence concerning the meaning of the term "electronic design automation" and related website address (url) because applicant did not provide copies of this evidence during the prosecution of the application. Applicant may not now attach this evidence because such

submission would be untimely. “The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Additional evidence filed after appeal normally will be given no consideration by the Board.” TBMP §1207.01

### **ARGUMENT**

#### I. THE USE OF THE MARK ON THE SPECIMEN OF RECORD FAILS TO FUNCTION AS A TRADEMARK TO DISTINGUISH THE APPLICANT’S GOODS FROM THOSE OF OTHERS.

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, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Trademark Act Section 45, 15 U.S.C. §1127. Not everything that a party adopts and uses with the intent that it function as a trademark actually functions as a trademark. The applicant must demonstrate that it is using its mark in the manner described above before that mark may be registered as a trademark with the United State Patent and Trademark Office (USPTO). *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960); TMEP §1202.

Applicant submitted a specimen with its statement of use that it described as a “splash screen<sup>1</sup>, that is displayed during boot up on a monitor associated with a computer on which the subject software is running.” See response to Office action dated November 28, 2006.

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<sup>1</sup> Examining attorney respectfully requests that the Board take judicial notice of the following definition: Splash screen. “Initial screen that is displayed for a few seconds when you start a program. The splash screen normally displays the product logo and gives basic copyright information.” (2000). In *Dictionary of Personal Computing and the Internet*, Peter Collin Publishing. Retrieved October 09, 2007, from <http://www.credoreference.com/entry/1066180>.

Based on this specimen and the description submitted by the applicant, the previous examining attorney refused registration in part based on a failure to function as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127; *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987); TMEP §§1202 *et seq.* The previous examining attorney noted that the mark is embedded in a descriptive sentence, specifically, “[t]his emulation system runs on VIRTUALWIRES(TM) technology,” in small text in the middle of a specimen containing other more prominently placed text and graphic elements.

In its appeal brief, applicant altered its description of the specimen to read “a screen that is displayed on the monitor when the computer user *requests* ‘About’ information from the software’s Help menu.” Emphasis added; Applicant's Brief p. 1. Based on the description, applicant's mark does *not* appear when its program starts. This description further weakens applicant's position because, by the applicant's own admission, the users of the program must affirmatively seek out this About screen by choosing the “About” option from the software's “Help menu.” An “About” window does not contain information that is required or necessarily helpful to the use of the program.<sup>2</sup> The intended users of applicant's software may never see the applicant's mark, even if they use the software on a daily basis.

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<sup>2</sup> Examining attorney respectfully requests that the Board take judicial notice of the following definitions: About. “(in the SAA CUA front end) a menu selection that tells you who developed the program and gives copyright information.” In *Dictionary of Computing*. Bloomsbury Publishing Plc, 5th ed. (2004); About. “(1) In SAA Common User Access architecture, a help action that displays ownership and copyright information about the application. (2) In SAA Common User Access architecture, a help action that displays the logo window of the application.” In *IBM Dictionary of Computer Terms*. McGraw Hill Inc., 10th ed. (1994); About. “In most Macintosh and Windows programs, you can get a little background information about the software by choosing the **About** menu item . . . [i]n Windows programs, ‘About . . .’

Regardless, even if applicant's mark were on a splash screen, the applicant does not display the mark in a manner that a consumer would perceive as a trademark.

Applicant makes three points to argue why the relevant consumers of its goods would recognize its use of the mark as a trademark: the sophistication of its consumers, the particular use of the mark in a sentence, and the bolded TM symbol beside the mark.

First, applicant argues that its consumers are sophisticated users who will understand that the word VIRTUALWIRES refers to applicant's goods in the sentence, "[t]his emulation system runs on VIRTUALWIRES(TM) technology." Applicant describes its users as "sophisticated" because they are engineers; however, applicant offers no evidence to substantiate this claim. Applicant's Brief p. 4. Similarly, applicant argues that its goods, "computer hardware and software for electronic design automation," are of a kind that would only be used by sophisticated users and offers only a url as evidence. As explained above, this evidence is proffered neither in a timely manner nor in an appropriate form. Therefore, for the purposes of this argument, applicant offers no evidence to support the contention that its users are "sophisticated." On its face, applicant's goods consist of computer software and hardware. Computers are ubiquitous and widely used by experts and laymen alike. Where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) (as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir.

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is usually the final choice on the *Help menu*." In *Jargon, An Informal Dictionary of Computer Terms*, Peach Pit Press (1993).

2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285, 60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)).

Applicant attempts to build on its unsupported contention that its users are "sophisticated" by claiming that these sophisticated users have a particular understanding of the term "technology" as used in the specimen. Applicant's Brief p. 5. As with its previous contentions, applicant offers no evidence to support this claim. According to the definitions submitted in the Office action dated February 3, 2007, the term "software" is defined as "[t]he programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation" and the term "technology" is defined as "[t]he scientific method and material used to achieve a commercial or industrial objective." "Technology" is a very broad term that encompasses countless modalities from physical machines to theoretical physics. "Software" is a very specific thing for a very specific purpose, namely, "controlling the functioning of a computer." In the context of software, technology could reasonably refer to any number of things: algorithms, methods of data transmission, etc. Consumers are likely to believe that the term "technology" when used in conjunction with software refers to something underlying or enabling that software, using the applicant's own reasoning, to "distinguish" it as an abstract or intangible system rather than the software itself. For instance, "algorithm" is defined as "[a] mathematical or logical procedure for solving a problem;" "[a]n algorithm is a recipe for finding the right answer to a difficult problem by breaking down the problem into simple steps" or "[i]n data compression, the standard used to compress or decompress the data."<sup>3</sup> Based

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<sup>3</sup> Examining attorney respectfully requests that the Board take judicial notice of the following definition: Algorithm. In *Webster's New World Computer Dictionary* (2003). Retrieved October 08, 2007, from <http://www.credoreference.com/entry/3481961>.

on its specimen, applicant would more likely be perceived as supplying a patented algorithm—a *scientific method* for solving a problem with a commercial objective—that is being used in the system of which the software in the specimen is part, rather than supplying software itself, even by very sophisticated users.

Second, applicant argues that its mark is printed in all capital letters, distinguishing it from other words in the specimen. The examining attorney agrees that the applicant's printing the word VIRTUALWIRES in uppercase letters does tend to distinguish the mark from the other words on the specimen; however, it does not add to the impression of the mark as a trademark. Simply displaying a mark in uppercase letters does not change the perception of its meaning in the context of a highly suggestive sentence. In fact, the terms VIRTUAL<sup>4</sup> and WIRES<sup>5</sup> are both highly descriptive terms

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<sup>4</sup> Examining attorney respectfully requests that the Board take judicial notice of the following definition: Virtual. "1. Existing or resulting in essence or effect though not in actual fact, form, or name: *the virtual extinction of the buffalo*. 2. Existing in the mind, especially as a product of the imagination. Used in literary criticism of a text. 3. *Computer Science*. Created, simulated, or carried on by means of a computer or computer network: *virtual conversations in a chatroom*. [Middle English *virtuall*, effective, from Medieval Latin *virtulis*, from Latin *virtus*, excellence. See virtue.] Usage Note: When virtual was first introduced in the computational sense, it applied to things simulated by the computer, like virtual memory—that is, memory that is not actually built into the processor. Over time, though, the adjective has been applied to things that really exist and are created or carried on by means of computers. Virtual conversations are conversations that take place over computer networks, and virtual communities are genuine social groups that assemble around the use of e-mail, webpages, and other networked resources. The adjectives virtual and digital and the prefixes e- and cyber- are all used in various ways to denote things, activities, and organizations that are realized or carried out chiefly in an electronic medium. There is considerable overlap in the use of these items: people may speak either of virtual communities or of cybercommunities and of e-cash or cybercash. To a certain extent the choice of one or another of these is a matter of use or convention (or in some cases, of finding an unregistered brand name). But there are certain tendencies. Digital is the most comprehensive of the words, and can be used for almost any device or activity that makes use of or is based on computer technology, such as a digital camera or a digital network. Virtual tends to be used in reference to things that mimic their real equivalents. Thus a digital library would be simply a library that involves information technology, whether a brick-and-mortar library equipped with networked computers or a library that exists exclusively in electronic form, whereas a virtual library could only be the latter of these. The prefix e- is generally preferred when speaking of the commercial applications of the the Web, as in e-commerce, e-cash, and e-business, whereas cyber- tends to be used when speaking of the computer or of networks from a broader cultural point of view, as in cybersex, cyberchurch, and cyberspace. But like everything else in this field, such usages are evolving rapidly, and it would be rash to try to predict how these expressions will be used in the future." In *The American Heritage Dictionary of the English Language* (2003). Retrieved October 08, 2007, from <http://www.credoreference.com/entry/4145946>.

that, when used together, create a phrase that consumers are likely to mistake for a generic technology when not displayed in a separated and prominent manner. The descriptive nature of applicant's mark is reinforced by its insertion into the informational sentence "[t]his emulation system runs on VIRTUALWIRES(TM) technology." Therefore, consumer's will not perceive applicant's mark as a trademark simply because the applicant displays it in uppercase letters.

Third, applicant argues that its use of (TM) in bold font beside its mark distinguishes it as a trademark. However, use of the TM symbol beside the otherwise defective use of a mark will not obviate a failure to function refusal. *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992); *In re B. C. Switzer & Co.*, 211 USPQ 644 (TTAB 1981); *In re Union Carbide Corporation*, 171 USPQ 510 (TTAB 1971); *In re Nosler Bullets, Inc.*, 169 USPQ 62 (TTAB 1971).

Applicant further argues that if it supplied a specimen comprising a splash screen showing only its mark, the Office would have accepted it. Applicant's Brief pp. 2-3. Applicant provided neither a splash screen nor a screen showing the mark alone. Not every word on a splash screen automatically functions as a trademark. For instance, neither "U.S. Patents 5,596,742, 5,761,484" nor "Copyright Mentor Graphics Corporation" on applicant's About screen functions as a trademark. Even though "Mentor

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<sup>5</sup> Examining attorney respectfully requests that the Board take judicial notice of the following definition: Wires, "1. A usually pliable metallic strand or rod made in many lengths and diameters, sometimes clad and often electrically insulated, used chiefly for structural support or to conduct electricity. 2. A group of wire strands bundled or twisted together as a functional unit; cable. 3. Something resembling a wire, as in slenderness or stiffness. 4. An open telephone connection. 5. Slang. A hidden microphone, as on a person's body or in a building. 6. a. A telegraph service. b. A telegram or cablegram. 7. A wire service. 8. Computer Science. A pin in the print head of a computer printer. 9. The screen on which sheets of paper are formed in a papermaking machine. 10. Sports. The finish line of a racetrack. wire." In *The American Heritage Dictionary of the English Language* (2003). Retrieved October 08, 2007, from <http://www.credoreference.com/entry/4148309>.

Graphics” is not descriptive as used on the About screen, it functions only as a trade name identifying a business. *In re Diamond Hill Farms*, 32 USPQ2d 1383, 1384 (TTAB 1994); *In re Univar Corp.*, 20 USPQ2d 1865, 1867 (TTAB 1991).

Therefore applicant’s mark does not function as a trademark to identify and distinguish applicant’s goods from those of others and to indicate their source.

II. THE APPLICANT’S SPECIMEN OF RECORD DOES NOT SHOW USE OF THE MARK WITH GOODS SPECIFIED IN ITS IDENTIFICATION OF GOODS.

Applicant erroneously states that the previous examining attorney refused registration on the basis of "use of mark to describe technology," and that "use of mark to describe technology" is not an appropriate basis to refuse registration. The examining attorney agrees with applicant's assertion that "use of mark to describe technology" is indeed an inappropriate basis for refusal; however, the examining attorney disagrees that the previous examining attorney refused application on that basis. Refusal is based on a failure to function as a mark as explained above *and on the failure of applicant to use the mark with the goods specified in the application*. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051 and 1127. Under 37 C.F.R. §2.34(a)(1), the applicant must submit a “verified statement that the mark is in use in commerce on or in connection with the goods . . . listed in the application” and “one specimen showing how the applicant actually uses the mark in commerce.”

As used in the specimen, the mark separates itself from the underlying software and suggests another technology that is used in conjunction with the software in the specimen. For instance, the specimen could be referring to fiber optic cables used to

transmit data for mainframe emulation or an algorithm that reduces the size of the data packets, virtually creating more "wires" over which that data may flow.

Applicant argues that it chose to use "technology" rather than "software" for "very valid reasons." Applicant's Brief p. 7. The applicant states that these reasons are for "marketing purposes" because its goods comprise "a background software system that is used in numerous other, separately branded products." Applicant's Brief p. 2. Applicant offers no evidence that referring to "background software" as "technology" rather than "software" is a common practice in the software industry and supplies no rationale for why labeling "background" software as technology rather than software creates a commercial advantage. Furthermore, applicant fails to provide evidence that users would recognize that the term "technology" refers to "software," whether those users were sophisticated or not. See discussion above. Applicant's multiple assertions that these two words have precisely the same meaning in the context of the specimen are supported neither by the evidence nor the common meanings of the words.

Therefore applicant failed to submit a specimen that shows use of the mark with the goods specified in the application.

### **CONCLUSION**

The specimen submitted by the applicant, an about screen featuring its mark in a informational sentence, neither functions as a trademark to identify and distinguish applicant's goods from those of others and to indicate their source nor shows use with the goods specified in the application as required under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. For the foregoing reasons, the examining attorney respectfully requests that the refusal of registration be affirmed.

Respectfully submitted,

/DETJr/

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