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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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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 REPLY BRIEF

This replies to the Examining attorney's October 12, 2007 brief.

1. Evidentiary Issues

The Examining attorney has objected to several aspects of Applicant's arguments based on the allegation that there was no evidentiary support for the arguments in the application prior to the filing of the appeal. Specifically, the Examining attorney objects to the following:

a. evidence concerning the meaning of the phrase "electronic design automation" ("EDA") and a website address that leads to an EDA industry organization (Examining attorney's brief, page 3); and

b. Applicant's characterization of the users of its software as sophisticated electrical engineers (Examining attorney's brief, page 4).

The Examiner attorney's allegations are incorrect for a number of reasons.

First, Applicant introduced the material the Examining attorney objects to during prosecution of the application and as such there is ample support in the record. In the response Applicant filed on November 28, 2006 to an Office action dated November 18, 2006, Applicant provided information about the nature of the highly specialized field of electronic design automation. The information supplied in the November 28 response included the reference to the EDA industry web site noted in the appeal brief, and explained that users of EDA software are sophisticated electrical engineers. There can be no question that there is ample evidentiary support for each of the allegations that the Examining attorney objects to and on this basis alone the objections should be overruled.

Second, and perhaps more fundamentally, the identification of goods in this case describes the goods as “computer software for electronic design automation.” An important inquiry in determining whether a mark is being used as a trademark considers the impression the mark makes on the relevant consumers—would the term be perceived by the relevant consuming public as a source indicator? Where the goods identification in an application includes a specific use, it is entirely appropriate to provide information on appeal that details the nature of the goods and the users of them. Absent such information, the Board could not properly consider the impact of the specimens on *relevant* consumers.

In this case, information about the type of software and the sophistication of those who use it has significant probative value because it gives context to mark, the identification of goods, and the specimen. This context sheds light on the characteristics of the relevant consuming public, and therefore helps to explain why the specimen shows use of the mark as a trademark.

Finally, Applicant points out that in this *ex parte* proceeding, the stringency of the evidentiary rules are somewhat relaxed. See e.g., TBMP § 1208. Where evidence has substantial probative value and assists in determination of the issue at hand, it should be considered.¹

2. The Examining Attorney’s Basis for Refusing Registration

In its principal brief, Applicant points out that during prosecution the Examining attorney supported the refusal on the basis that on the specimen, the mark demonstrates use of the mark to describe technology, not software. On appeal, Applicant argues that this is an inappropriate basis for refusing registration. In the response brief, the Examining attorney denies that the Examiner below refused registration on this basis, arguing that “Applicant erroneously states that the previous examining attorney refused registration on the basis of “use of mark to describe technology.” (Examining Attorney’s Brief, page 7.)

¹ “Material obtained through the Internet or from websites is acceptable as evidence in *ex parte* proceedings. * * * Material obtained from an applicant’s website, or that of a third party, may provide information about, for example, products or services, customers, and channels of trade, although their probative value will vary depending on the facts of the particular case.” TBMP § 1298.03, citations omitted.

Applicant respectfully disagrees. Quoting from the Examining attorney's refusal in the November 18 Office action: "The specimen is unacceptable as evidence of actual trademark use because as used on the specimen of record, it is being used to describe a technology and not "computer software for electronic design automation."" (November 18, 2006 Office action).

The statutory basis for refusing registration in this case is of course sections 1, 2 and 45 of the Trademark Act. But as Applicant points out in its brief, when an Examining attorney refuses registration under sections 1, 2 and 45 on the basis that the mark is not being used as a trademark, the attorney should provide an explanation of the specific reasons *why*. See TMEP § 1202.02.² When the refusal is being made based on the alleged shortcomings of the specimen, the TMEP's requirement that the Examining attorney support the refusal with an explanation of his or her basis is necessary in order for the Applicant to adequately respond.

The TMEP gives the Examining attorney guidance by providing a list of 14 specific reasons *why*. (See TMEP § 1202.01 et seq.) Nowhere in the list is there anything resembling "description of technology". Applicant is not suggesting that the TMEP's list of bases for refusing registration is exclusive. Instead, 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 is indicative that the Examining attorney's basis for refusing registration in this case merits close scrutiny in this appeal.

3. Splash Screen v. About Screen

The specimen is an *About* screen; the statement of use erroneously indicated that it is a splash screen. Regardless, an About screen is an entirely appropriate specimen for showing trademark use with software, and the Examining attorney's argument that use of an About screen as a specimen somehow weakens Applicant's position is unfounded and has no bearing on this appeal.

4. The Specimen must be Considered Contextually

As noted above, an essential component in determining whether a term is being used as a trademark considers the impression the mark makes on the

² Applicant's Appeal Brief incorrectly cited this requirement to TMEP § 1201.01 et seq.—the correct cite is TMEP § 1202 et. Seq.

relevant public. To be a trademark, the term must be used in a manner that projects to consumers or potential purchasers a single source of origin for the goods. This is determined by examination of the specimens, and its effect on consumers. Software used in performing EDA is highly sophisticated. Electrical engineers who use software such as Applicant's goods are exposed to EDA software of all types, and industry jargon on a daily basis. These consumers know and understand at a very fundamental level that in the context of the sentence on the specimen,³ "technology" and "software" designate the same thing and that VIRTUALWIRES is the proprietary brand name for Applicant's software. On the other hand, it may be equally true that a lay person having no experience in EDA would not readily understand that in the context of the specimen, the word technology is a reference to what is making the emulation system run—i.e., the software. But that is why we must look to the relevant consumers and what the effect is on them, and that is why context is important.

Applicant urges the Board to consider the specimen in the context of what it means to the actual users of the goods: sophisticated electrical engineers who are using software for use in electronic design automation in the course of their professional lives. These consumers know that VIRTUALWIRES technology is software and they know that VIRTUALWIRES is a trademark that designates Applicant's software.

Respectfully submitted,



Douglas Hancock, October 18, 2007

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³ i.e., "This emulation system runs on VIRTUALWIRES (TM) technology."