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Sent: 9/5/2007 12:35:36 PM

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Subject: TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/29

Attachment Information:

Count: 1

Files: 78654480.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/654480

MARK: VIDEOPINIONS



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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: Expo Communications, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

13114/29

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's FINAL refusal to register under Section 2(e)(1)

of the Trademark Act. 15 U.S.C. Section 1052(e)(1).

FACTS

Applicant seeks registration of the standard character mark VIDEOPINIONS for services recited in

this application as "providing information on consumer products and services by way of a global

computer network," in International Class 35. Registration has been finally refused under Section

2(e)(1) of the Trademark Act on the basis that applicant's mark, when viewed in the context of the

applicant's services, describes a significant feature of the services.

Originally, this application involved additional services that have since been properly classified in

International Classes 38 and 41. These services have now become the subjects of two different

“child” applications, each seeking registration of VIDEOPINIONS for related services.

Application Serial No. 78-978112 covers “television broadcasting, cable television broadcasting,

satellite television broadcasting, and interactive video-on-demand transmission services, all in the

field of information on consumer products and services,” in International Class 38, and application

Serial No. 78-978113 covers “entertainment services in the nature of on-going television programs

in the field of information about consumer products and services,” in International Class 41.

Appeals have been filed in all three cases. Because the Office has used the same rationale in

refusing registration for all three files under Section 2(e)(1) of the Trademark Act, the undersigned

alerts the Board as to the existence of the related files and submits that the cases are appropriate for

consolidation under TBMP Section 1214. Nonetheless, separate appeal briefs have been submitted

with each file.

The record consists of a number of submissions by both the applicant and the Office. Both sides

have submitted dictionary definitions for the terms “video “ and “opinion.” The Office has also

included a number of web page listings and results from searches of the *Nexis* research database in

support of its position that purchasers, upon seeing the mark in the context of its use, would view

the term for the ordinary meanings of the terms comprising the telescoped word. See Office

actions dated August 17, 2006, and March 15, 2007. Also of record is a copy of an unpublished

opinion by the Trademark Trial and Appeal Board, *In re Visual Analytics, Incorporated*, SN 76-

465520 (Decided July 27, 2005), holding DATAALERTS, a telescoped version of DATA ALERTS,

to be a descriptive term, notwithstanding the fact that the telescoped term had one less syllable than

DATA ALERTS as two words. See Office action dated March 15, 2007, for a copy of the Board's

opinion.

The context of applicant's intended use of the proposed mark has been revealed through

information obtained from applicant's responses to Office actions. Applicant has indicated that it

"solicits consumer information about products and services and allows people to upload homemade

audiovisual works describing and demonstrating those products and services." See applicant's

Response dated July 13, 2006, at page 2. According to the applicant, it "solicits, collects,

organizes, and shares objective third party demonstrations, commentary, and reviews of consumer

products and services of others with others." It further indicates that "the demonstrations of and

information on consumer products and services is shared amongst consumers in the form of

homemade digital audiovisual works, i.e., videos with an audio component” and admits that “such

audiovisual works may or may not include or involve a consumer's opinion about a particular

product or service.” *Id* at page 3.

Included with the Response of July 13, 2006, were a video (Exhibit A) and several web pages

(Exhibit B) that the applicant regarded as “showing the Applicant’s services, while also showing

how the mark is used.” See page 2 of the Response of July 13, 2006. The contents of the video

may be seen by accessing the Office’s media files at the electronic address at the end of this brief,

then utilizing the “Shortcut to Media” icon, before accessing the video at Serial No. 78-654480.

The video, Exhibit A, is a compilation of excerpts of some of the videos made by others and then

shown through the rendering of applicant’s services. At several instances, the person participating

in the video regards his or her presentation as a “review” of a product. Exhibit B establishes that

the applicant regards its service as a “video service” where the consumer “in FULL MOTION

VIDEO” tells what he or she loves or hates about the products or services being considered. As

this webpage explains, “Videopinions allows our viewers to share their own unbiased, personalized

experiences with other consumers.”

ARGUMENT

WHEN VIEWED IN THE PROPOSED CONTEXT OF USE, APPLICANT'S MARK

"VIDEOPINIONS" WOULD BE REGARDED BY PURCHASERS AS A
TELESCOPED

VERSION OF "VIDEO OPINIONS" AND WOULD BE MERELY DESCRIPTIVE OF
A

SIGNIFICANT FEATURE OF APPLICANT'S RECITED SERVICES

It is well settled that a phrase or term is considered to be merely descriptive of goods or services,

within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information

concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of

the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re*

Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not

describe all of the purposes, functions, characteristics or features of the goods and/or services to be

merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term

describe only one attribute of the goods and/or services to be found merely descriptive.
In re

H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Moreover, whether a phrase or term is merely descriptive is determined not in the abstract but in

relation to the goods or services for which registration is sought, the context in which it is being

used on or in connection with those goods or services and the possible significance that the phrase

or term would have to the average purchaser of the goods or services because of the manner of its

use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

The term “video”, when used as an adjective, is defined as “relating to visual image reproduction:

relating to the recording or broadcasting of visual information or entertainment by means of

videotape or television.” The term “opinion” is defined as “a personal view, attitude, or appraisal”

or as “a view, judgment, or appraisal formed in the mind about a particular matter.” See dictionary

definitions provided with the Office action of August 17, 2006. Although the applicant has

included other dictionary definitions of the two terms in question with its Request for

Reconsideration filed on February 23, 2007, the pertinent definitions submitted by the applicant

appear to support the Office’s interpretation of these words, when viewed in the context of

applicant’s services. “Video” is defined as “being, relating to, or involving images on a television

screen or computer display” or “something recorded on videotape.” Applicant’s definitions of

“opinion” include “personal view: the view somebody takes about an issue, especially when it is

based solely on personal judgment,” and “estimation: a view regarding the worth of somebody or

something.”

The record herein makes clear that the services offered by the applicant are offered by means of

recorded video, with the applicant’s own submission indicating that it regards the service as a

“video service.” See FACTS above. This is true for the services in this case and for those listed in

the child applications covering the services in International Classes 38 and 41. Applicant’s

services in each class are designed so that consumers can share their videotaped assessments of the

products or services that they have reviewed. Here, the applicant will provide access to the

videotaped opinions about consumer products and services by means of computer.

Moreover, according to the applicant itself, the services “may or may not include or involve a

consumer’s opinion about a particular product or service.” The context of use shown by Exhibit A

with the response of July 13, 2006, confirms that the services feature “reviews”, and Exhibit B with

the same response shows that the services feature the transmission or display on video of what the

reviewers love or hate about particular products. Certainly, the assessment shown by the person

on video clearly qualifies as “a view, judgment, or appraisal formed in the mind about a particular

matter,” or as “a view regarding the worth of something,” and thus qualifies as an opinion.

Although applicant points to other meanings for the terms comprising its mark, the existence of

such meanings is not controlling. Descriptiveness is considered in relation to the relevant goods

and/or services. The fact that a term may have different meanings in other contexts is not

controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258 (TTAB

1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*,

183 USPQ 318 (TTAB 1974). The question is thus not whether “videopinions” would have

meaning in the abstract, but rather what meaning it would have when used in connection with

applicant’s particular services.

Further, the evidence of uses by others of the phrase “video opinion” or its plural confirms that

purchasers would view the combination of words for the descriptive meanings of the component

terms. Two different web pages were included with the Office action of August 17, 2006, showing

apparent descriptive references for the words used together. Applicant has addressed the second

listing, stating that it has sent a written request to the source of the third-party reference, asking it

to modify its use of “videopinion”. Although the first listed web page clearly was reviewing the

applicant’s services, it nonetheless referred to the applicant’s activities as being “devoted to online

video opinions, reviews, and product demonstrations”. Notably, in reviewing the applicant’s

services, the writer assessed his own review of the applicant’s services as an “opinion”.

Additional evidence was supplied with the Office action of March 15, 2007. Included was a web

page listing for the applicant affirming that the applicant’s services involve “short, unbiased video

product reviews made by consumers for consumers.” But in addition, other web pages showed use

of “video opinions” in highly descriptive fashion by others with respect to the offering of opinions

on video. Admittedly, one of these listings is in the context of a reference to the applicant. (Pages 9

and 10 of the attachments to the March 15, 2007, Office action.) Although a number of these pages

do not involve applicant’s exact services, they do show use of “video opinions” for the feature of

applicant’s services that is described by the purported mark, the provision of opinions by video.

Page 31 of that submission does refer to “video opinions made by real consumers,” and page 37

refers to a person’s provision of his or her “written opinion and video opinions on all things

movies.” Page 38 refers to another’s search index for “video opinions.”

Results from searches of *Nexis* research database were also included in the record. The two *Nexis*

stories originally included with the Office action of August 17, 2006, were repeated in full at

applicant's request in the Office action dated March 15, 2007. Although story number 20, referring

to a "video opinion poll," may be less relevant than the other stories, other *Nexis* stories show

highly descriptive uses, sometimes in reference to the applicant and sometimes not. Story number

4, for example, does refer to the applicant, but uses the phrase "video opinions" descriptively in

relation to how "a few firms are betting video opinions will be the next driver" as a powerful tool

for consumers looking to buy. Similarly, although story number 5 makes reference to an ExpoTV

contest (presumably the applicant), the use of "video opinion" in the body of the story appears to

be for the normal dictionary significance of the terms.

Nexis story number 6 is admittedly a reference to someone who participated in a contest run by the

applicant, but is offered as confirmation of other submissions made by the applicant itself

indicating that the activities referred to by "videopinions" in the context of the story relate to the

provision of "video reviews" through the applicant's services.

Nexis stories 7 and 26 show use highly descriptive use of "video opinions" by persons with no

apparent connection to the applicant, in relation to opinions offered by video means.

Although the evidence of third-party use is not extensive, this is partially explainable by the

fact that, according to the applicant itself, its business is somewhat novel. In fact, in its first

response, the applicant stated that it was not aware of any third party offering services of the same

type. See page 2 of Response of July 13, 2006. Of course, this case itself is based upon intent to

use in commerce, so the evidence even of use by the applicant may also be limited.

Although

limited in extent, the above evidence does serve to confirm that, upon seeing the words “video

opinions” used together, purchasers would view the resulting expression for the significance of the

component terms.

The question still remains as to whether the applicant’s telescoping of these words into

VIDEOPINIONS removes the mark from the realm of being merely descriptive.

Numerous cases

have held that telescoping two words which as a whole are merely descriptive of the goods into a

single term does not avoid a finding of mere descriptiveness for the combined term. See *In re Cox*

Enterprises, Inc., 82 USPQ2d 1040 (TTAB 2007) and cases cited therein at page 1044.

In fact, a

compound word can even be held *generic* without any evidence of use of the combined term by

others. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir, 1987)

(SCREENWIPE held generic based upon meanings of the component terms). Moreover, the

particular facts of this case appear analogous to those in the unpublished case referred to in the

FACTS section, *In re Visual Analytics, Incorporated*, SN 76-465520 (Decided July 27, 2005).

There, the Board found that the term DATAALERTS, a telescoping of DATA ALERTS, was

merely descriptive. Holding first that the phrase DATA ALERTS is merely descriptive based upon

the individual meanings of the component terms, “data” and “alerts”, and upon the context of use

by the applicant, the Board then addressed the telescoping of the words. Although the applicant

argued that the shared vowel in DATAALERTS results in a term having one less syllable than

DATA ALERTS, the Board nevertheless held the telescoped term descriptive, stating that the two

words comprising the mark, "data" and "alerts," are obviously apparent when viewing the mark in

connection with the identified goods, regardless of the telescoping of the two words. The Board

further referred to the likelihood that consumers may automatically supply the missing vowel and

pronounce the term as “data alerts.” The same rationale should apply in the present case. As was

the case in the above case, the telescoping here creates no double entendre or unique characteristic

that results in the telescoped mark being somehow more than a merely descriptive combination of

individual words used for their ordinary meanings.

Throughout prosecution, applicant has relied heavily upon the fact that the recitation of services

itself makes no reference to the feature of the services that the Office believes is described by the

mark, and goes so far as to contend that the Office has unfairly ignored its recitation of services in

making the refusal herein. It accuses the Office of “redefining” the services to reflect things not

apparent from the recitation of services itself, which reads, “providing information on consumer

products and services by way of a global computer network,” stating that “the applicant never

claimed use of its mark in connection with a service involving the provision of opinions by means

of video.” See page 3 of applicant’s Appeal Brief. Applicant’s position seems to be that, as long as

the feature described by the mark is not apparent from the recitation of services itself, any reliance

upon evidence or information of record in reviewing the context of proposed use is unwarranted.

Extending the applicant’s logic, terms like “SIX FEET LONG” and “LEATHER” could not be

held merely descriptive of goods identified in an application simply as “couches,” because the

feature described by the mark would not be apparent from the identification of goods clause, even

if the record showed elsewhere that the goods were both six feet long and made of leather. Any

reliance upon information of record beyond what is in the identification of goods clause would then

be categorized by the applicant as a “redefining” of the goods.

The Office has not ignored applicant’s recitation of services. Instead, the Office has viewed the

mark in the context in which it will likely be encountered by consumers, a legitimate concern.

In the oft cited case, *In re Abcor Development Corporation*, supra, the applicant attempted to

register the mark GASBADGE for goods identified as “device to determine and monitor personal

exposure to gaseous pollutants.” In affirming the refusal to register under Section 2(e)(1), the court

held that descriptiveness must be determined from the standpoint of the average prospective

purchaser. Evidence of the context of use on labels, packages, or in advertising material is

probative of the reaction of prospective purchasers to the mark, and therefore must be considered.

This is so notwithstanding the fact that the identification of goods or services may not mention the

feature of the goods or services described by the mark. There are abundant decisions holding

marks descriptive of features of goods or services not reflected in the identifications of goods or

services themselves. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE

PIE held merely descriptive of goods identified as “potpourri”); *In re Tower Tech, Inc.*, 64

USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial

cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d

1084 (TTAB 2001) (AGENTBEANS held merely descriptive of “computer software for use in the

development and deployment of application programs on a global computer network”); *In re Shiva*

Corp., 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT held merely descriptive for

“computer hardware and computer programs to control, reduce and render more efficient wide area

network (WAN) usage and printed user manuals sold therewith”); *In re Putnam Publishing Co.*, 39

USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ON-LINE merely descriptive of “a news and

information service updated daily for the food processing industry, contained in a database”); *In re*

Digital Research Inc., 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT DOS and CONCURRENT

PC-DOS held merely descriptive of “computer programs recorded on disk”). The context of use

and reaction of purchasers to how the mark is used in connection with the goods or services allow

for tribunals to hold marks descriptive even where the features described by the mark do not appear

in the identification of goods or services clause. Although applicant claims that the *Gyulay* case

merely held APPLE PIE descriptive of “apple pie scented potpourri,” the point here is that the

identification of goods clause itself made no mention of the apple pie scent, and referred to the

goods only as “potpourri.” However, the record included a catalog that revealed that the potpourri

had a feature not apparent from the identification of goods itself, the apple pie scent. The fact that

this feature of the goods was not evident from the identification of goods clause itself did not

preclude the refusal.

Thus, it is appropriate for the Office to review the context of the proposed use in determining the

descriptiveness issue. This is not a redefining of the services, as alleged by the applicant, but rather

is a consideration of the mark from the standpoint of the average purchaser, who would view the

mark in relation to the advertising materials used in relation thereto.

Nor has the Office relied upon what the applicant calls “extrinsic evidence” to rewrite the applicant’s identified services. See page 8 of applicant’s Appeal Brief. Most of the information

relied upon by the Office in discovering the context of use of applicant’s mark has been supplied

by applicant itself. Note that this information was supplied in response to the Office’s inquiries

and request for information about the nature of the services in the application, making it difficult to

embrace any notion or inference by the applicant that the information does not concern the services

herein. Also, since the potential reaction of purchasers to an applicant's use of a mark is so

important to the determination of whether a mark is merely descriptive, it is also important to see

how consumers react to applicant's mark and services. Thus, that evidence is also relevant. Yet

applicant insists upon applying what amounts to a classic "abstract" test, comparing only the

language in the recitation of services with the language in the mark, defying the Office to make a

connection between the two. However, an applicant is not required to list every feature of its

services in the recitation clause, leaving open the real possibility that the services listed have

significant features not mentioned there. Such is the case here. Moreover, it is settled that "[t]he

question is not whether someone presented with only the mark could guess what the goods or

services are. Rather, the question is whether someone who knows what the goods or services are

will understand the mark to convey information about them." *In re Tower Tech Inc.*, supra, at 1316-

17.

As is clear from the applicant's submissions, its services will include the presentation of

videotaped consumer opinions and the sharing of commentary and reviews on video. This appears

to be the case for all three classes of services referred to in the Response of July 13, 2006. Were

this not the case, the applicant could have said so in that response, in which it had already amended

the recitation to the three current classes now consumed by this case and the two child applications.

Instead it submitted Exhibits A and B with that response, “showing the applicant’s services while

also showing how the mark is used.” See page 2 of the Response of July 13, 2006. Note that this

response came while all three classes of services still existed in the parent application, Serial No.

78-654480; the divisional request was not made until February 23, 2007. The contents of these

exhibits, as well as the other factual admissions by the applicant regarding the services, have

already been addressed above. All three classes of services involve the presentation of information

on consumer products and services, although by different means. It seems safe to assume that each

class of services will include the provision of consumer information in the form of videos made by

consumers, expressing their opinions about various goods and services. In fact, the applicant itself

states that “the demonstrations of and information on consumer products and services is shared

amongst consumers in the form of homemade digital audiovisual works, i.e., videos with an audio

component.” See page 3 of applicant’s Response of July 13, 2006. When the mark is viewed in

this context, it describes what is being shown by applicant, whether the videotaped opinions are

provided via computer (International Class 35), via broadcasting or video-on-demand

(International Class 38), or on a television program (International Class 41). Marks describing the

subject matter of such activities have been held merely descriptive. See *In re Ethnic Home*

Lifestyles Corp., 70 USPQ2d 1156 (TTAB 2003) (ETHNIC ACCENTS held merely descriptive of

“entertainment in the nature of television programs in the field of home décor” because the phrase

describes “significant features or subject matters of such programs”); *In re Conus*

Communications Co., 23 USPQ2d 1717 (TTAB 1992) (ALL NEWS CHANNEL generic for a

television channel broadcasting all news). The subject matter shown through the applicant’s

services in each class includes opinions on video.

It is true that the mark herein does not describe all of the features of applicant’s services; the

means by which the services are provided in each class are not specifically laid out by the mark.

However, it is not necessary, in order to find that a mark is merely descriptive, that the mark

describe each feature of the goods or services, only that it describe a single, significant quality,

feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). The fact that the

applicant chooses not to include in the recitation of services the feature of the services described by

the mark does not mean that this feature does not exist nor would be appreciated by purchasers of

the services.

Applicant uses an example in its Appeal Brief that illustrates its misinterpretation of the Office's

position in this case. There, it states its belief that the mere fact that a company sells apples under

the mark APPLE would be used by the Office, under the rationale of this case, to refuse

registration to that company for any class of goods or services utilizing APPLE as a mark,

including computer equipment, merely because APPLE is descriptive of "apples." See page 6 of

applicant's appeal brief. This example is inapposite to the facts of this case and to the Office's

position herein. The term APPLE would be held descriptive for any goods or services having

apples as a significant feature, not because the applicant also sells apples, but only because the

goods or services had apples as a significant feature. This would be the case not only when the

term "apple" appeared descriptively in the identification of goods or services clause, but also

anywhere that the record showed that the term APPLE, when used in connection with the listed

goods or services, would be perceived by purchasers as descriptive of a significant feature of the

goods and services. It would not be held descriptive for goods and services where the record,

context of use, or other information failed to show that consumers would perceive it as being used

to describe any significant feature of the listed goods or services. In the present case, the

information of record shows that applicant's services will provide for the sharing of videotaped

opinions by means of computer, thereby justifying the descriptiveness refusal. Applicant's failure

to mention this feature in the recitation of services does not surgically remove it as a feature of the

services with which the mark is intended to be used.

Applicant also relies heavily upon *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986), wherein the

Board held that SHOWROOM ONLINE was not merely descriptive of "leasing computer databases and video disks in the field of interior furnishings and related products of others." This

case is easily distinguishable. There the Board thoroughly examined the total record to get a full

understanding of the nature of the applicant's services and specifically found that showrooms had

no direct significance in relation to the applicant's leasing or information services. In sharp

contrast here, any thorough examination of the present record will reveal that the applicant's

services will include the provision of opinions on video.

Applicant also lists numerous third-party registrations having the terms VIDEO or variations of

OPINION as parts thereof, in an effort to show that these terms are not merely descriptive.

Initially, it is pointed out that a number of these registrations show reliance upon claims of acquired distinctiveness under Section 2(f) of the Trademark Act, while others are on the Supplemental Register, recognizing the descriptiveness of the overall marks. Other registrations involve unitary or compound terms for which the Office would not require a disclaimer of a descriptive portion. See TMEP Section 1213.05. Further, third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. A proposed mark that is merely descriptive does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

CONCLUSION

For the foregoing reasons, it is urged that the refusal to register under Section 2(e)(1) of the Trademark Act be affirmed.

Respectfully submitted,

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