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**Title:** Applicant's Opening Appeal Brief

**Part 1 of 1**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Applicant: | **Expo Communications, Inc.** |
| Mark: | **VIDEOPINIONS** |
| Serial No.: | **78/654,480** |
| Examiner: | **Steven Foster** |
| Law Office: | **106** |

BEFORE THE
TRADEMARK TRIAL
AND
APPEAL BOARD

## APPLICANT'S OPENING APPEAL BRIEF

Applicant appeals the trademark Examining Attorney's refusal to register the intent-to-use service mark application for VIDEOPINIONS in International Class 35 on the ground that it is merely descriptive within the meaning of § 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). Not only does the Examining Attorney bear the burden of proof in showing that the Applicant's mark is merely descriptive (see, e.g., In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567 (Fed. Cir. 1987), In re Grand Forest Holdings Inc., 78 USPQ2d 1152 (TTAB 2006)), but any factual doubts are resolved in favor of the Applicant. In re The Stroh Brewery, 34 USPQ2d 1796, at *4-5 (TTAB 1995).

The issue presented is whether the United States Patent and Trademark Office ("Office") proffered substantial evidence to show that the Applicant's mark merely describes the Applicant's identified services. But folded into this general issue, the Applicant presents, *inter alia*, several sub-issues for review: (1) whether the Office improperly ignored the identified services claimed by the Applicant in conducting its descriptiveness inquiry; (2) whether the Office improperly defined the Applicant's mark based on two arbitrarily chosen dictionary



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definitions from amongst numerous possibilities; (3) whether the Office failed to make out a *prima facie* case of obviousness when it conceded that there is little evidence of descriptive usage of the proposed mark by third parties and where the only instances of usage found have nothing to do with the Applicant's services; and (4) whether the Office erred in ultimately concluding that Applicant's mark describes, more than just suggesting, the identified services.

## FACTS

Applicant seeks registration on the Principal Register of the mark VIDEOPINIONS, in typed form, for services identified in the application (as amended) as "[p]roviding information on consumer products and services by way of a global computer network" in class 35 (Serial No. 78/654,480).[1] The Examining Attorney refused registration under § 2(e)(1) based on his contention that Applicant's mark is merely descriptive. When the Examining Attorney made the refusal final, Applicant timely filed this appeal.

## ARGUMENT

The Lanham Act § 2(e)(1) holds in pertinent part: "No trademark . . . shall be refused registration . . . unless it . . . consists of a mark which, when used on or in connection with the goods of the applicant is merely descriptive . . . of them . . . ." The word "merely" has been interpreted to mean that a mark is not descriptive unless it immediately conveys information with

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[1] Applicant originally filed for the mark in two international classes (35 and 38) on June 20, 2005 based on applicant's allegation of bona fide intent to use the mark under Trademark Act § 1(b) and added a third (41) based on the examiner's recommendation. Applicant subsequently requested the division of the application into its respective classes in an effort to have the mark examined for each class separately.

a "degree of particularity" concerning a significant quality, characteristic, function, attribute, or feature of the goods or services in connection with which it is used or is intended to be used. In re Cerner Corp., 2001 TTAB LEXIS 87, at *3 (TTAB Jan. 31, 2001); In re On Technology Corp., 41 USPQ2d 1475, at *7 (TTAB 1996); In re Intelligent Medical Sys., 5 USPQ2d 1674 (TTAB 1987); In re TMS Corp. of the Amer.s, 200 USPQ 57, 59 (TTAB 1978); In re Colonial Stores, Inc., 394 F.2d 549 (CCPA 1968).

With all due respect, Applicant contends that several errors were made during the examination of its mark. First, the Office ignored Applicant's actual description of services, and instead, focused on extrinsic evidence to completely redefine Applicant's services as "the provision of opinions by means of video." Second, the Office proceeded to arbitrarily choose—from amongst numerous possibilities—two particular dictionary definitions of the words "video" and "opinion" purported to support the Office's interpretation the applicant's mark as meaning: "the provision of opinions by means of video." Combining these errors, the Office improperly rewrote both the Applicant's services and assigned a meaning of VIDEOPINIONS to the point where the two converged into a singularity, namely, "the provision of opinions by means of video."

Applicant has never claimed use of its mark in connection with a service involving "the provision of opinions by means of video." Applicant's class 35 services claim use in connection with "[p]roviding information on consumer products and services by way of a global computer network." It is legally incorrect to ignore an applicant's recited services, and instead, to redefine the applicant's goods and/or services based on extrinsic evidence and third party uses. Furthermore, Applicant's mark, VIDEOPINIONS, has no known or recognized meaning, and it

was incorrect to arbitrarily choose—from amongst numerous possible meanings—one particular meaning which most supported the Office's refusal to register the mark.

## I. IN DETERMINING WHETHER A MARK IS DESCRIPTIVE, THE OFFICE ERRED BY IGNORING THE APPLICANT'S IDENTIFIED SERVICES

The Examining Attorney in this case held that the Office need not look at the Applicant's identified services in making the descriptiveness refusal, *i.e.*, the Examining Attorney held that the mark VIDEOPINIONS does not have to describe any aspect of the Applicant's identified services to be descriptive. Instead, the Examining Attorney simply characterized Applicant's services (indeed, all three pending classes of services, 35, 38, and 41) as the "provision of opinions by means of video."[2] The Examining Attorney ultimately based his characterization of the Applicant's services on third-party uses of the words "videos" and "opinion," a misrepresentation of the Applicant's responses to the Examining Attorney's information requests, and apparently, based on the mark itself.

### A. The Office Erred By Ignoring the Recited Services in Applicant's Complaint

Whether a particular mark is "merely descriptive" must be determined in relation to the goods or services for which registration is sought. Cerner, 2001 TTAB LEXIS 87, at *3 ("[w]hether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought"); TMS, 200 USPQ 57, 59 ("It is well settled

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[2] The examiner wrote: "It appears that applicant's services will involve the provision of opinions by means of video." Office Action, 1/11/06 (Ex. D at 2); see also Final Office Action, 8/17/07 ("Applicant seeks registration . . . for services wherein consumers offers opinions about products and services on videotape.") (Ex. A at 3). It was because the classes were not being examined separately that Applicant decided to divide its application into its respective classes.

that the question of whether a particular term is merely descriptive within the meaning of Section 2(e)(1) of the Act must be determined not in the abstract, but in relation to the goods or services for which registration is sought. . . ."); Stroh Brewery, 34 USPQ2d 1796, at *4-5 ("[I]n determining whether a mark is descriptive, the mark must not be considered in the abstract, but instead, it must be considered as 'applied to the goods or services involved.'").

Contradicting this proposition of law, the Examining Attorney in this case expressly stated that the Office need not consider the actual recited services in an analysis of descriptiveness, writing:

> Applicant is correct that whether a mark is merely descriptive is determined in relation to the identified goods or services, not in the abstract. . . . However, this does not mean that the descriptive feature of the services has to exist in the recitation of services in order for a mark to be merely descriptive.

Ex. A at 4 (citations omitted; emphasis added); see also Ex. B at 3 ("[T]he fact that the feature described by the mark is not evident in the recitation itself does not mean that it does not exist . . ."). Although binding law holds that a mark need not describe the entirety of the recited goods or services to be descriptive, the law has never held that the mark need not describe any element of an applicant's recited goods or services.[3] And there are sound policy reasons for this.

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[3] The examiner cited a number of cases for the proposition that a mark may be "descriptive of features of goods or services not reflected in the identification of goods or services themselves." (Ex. B at 2-3). For example, in the case of In re Gyulay, 820 F.2d 1216 (Fed. Cir. 1987)—relied upon by the Examiner—the Board refused to register APPLE PIE for use in connection with apple pie scented potpourri. In affirming the decision, the Federal Circuit did not suggest that one may ignore the recitation of goods in the application, it simply held that the apple pie scent was a key characteristic of the applicant's product even though potpourri is not technically apple pie and is not technically used to make

(continued...)

Any descriptiveness refusal must be tied to the actual identified goods or services for which an applicant seeks registration and not based on whether the mark could describe any aspect of the applicant's business. For example, a computer company selling both computer equipment and apples may still be able to obtain a registration for the mark APPLE in connection with use for "computer equipment." However, on the Examining Attorney's statement of the law, if the applicant computer company sold apples or had anything to do with apples whatsoever, the applicant would be barred from a registration of the mark APPLE in any class of goods or services. This is not the law. The Trademark Trial and Appeal Board ("Board") routinely allows for registration of a mark for certain classes (e.g., class 38) while not others (e.g., 9), which again illustrates that the recited goods and services control the inquiry as to whether a mark is descriptive. See, e.g., In re Epigenomics AG, 2006 TTAB LEXIS 85 (TTAB Mar. 14, 2006) (reversing Section 2(e) refusal regarding class 38 services, while affirming refusal regarding *inter alia* services in class 42) (Ex. C). Virtually any recognizable word will be descriptive for something in the universe; but that cannot be the test under Section 2(e).

For the present case, the Applicant's business provides and/or intends to provide various services in addition to the identified services in Applicant's subject application. The Applicant's services involve "[p]roviding information on consumer products and services by way of a global computer network." The Applicant does not produce opinions by means of video as the Examining Attorney has several times indicated, and the issue is not whether VIDEOPINIONS

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apple pie. In the present case, the Applicant intends to use the mark on, *inter alia*, "[p]roviding information on consumer products and services by way of a global computer network.," not on opinions of videos or videos of opinions, neither of which are key characteristics of the recited services.

describes "the provision of opinions by means of video." The question for the purpose of Section 2(e) is not whether the Applicant provides (or could provide) any service for which the mark VIDEOPINIONS could be descriptive, but rather, whether (on a class-by-class basis) the mark VIDEOPINIONS is descriptive of the identified services set forth in the Applicant's application. In other words, the question for this analysis is: Does VIDEOPINIONS describe "[p]roviding information on consumer products and services by way of a global computer network"?

The Examining Attorney has gone so far as to suggest that if the law required him to look at the recitation of goods and/or services in determining descriptiveness of a mark, he would simply begin requiring applicants to amend their description of goods and/or services to support his descriptiveness refusals.

> To hold otherwise would be to insert a new issue into every application where the Office made a refusal based upon descriptiveness; for every refusal under Section 2(e)(1) of the Trademark Act, the examiner would make a corresponding requirement that the applicant insert into the identification of goods or services clause the feature of the goods or services described by the mark.

(Ex. B at 3) (emphasis added). There appears to be no authority under federal law whereby an examiner can arbitrarily require the amendment of services just to help make the examiner's descriptiveness refusal. Although 37 C.F.R. § 2.32(a)(6) requires trademark application to set forth "[a] list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark," the basis for a refusal under this rule rests on the lack of specificity and definiteness of the identified goods or services. See TMEP §§ 805 and 1402.01 (3d ed. Rev. 2, 2003). Thus, although the Examining Attorney could have objected to the recitation of services for indefiniteness, at this time, the Examining Attorney has held that

Applicant's identification of services is acceptable as stated. See, e.g., Ex. D at 2 ("The class 35 recitation is acceptable as stated."). Rewriting an Applicant's specific and definite description of services in order to render them descriptive could constitute an "abuse of discretion" in the classic sense of the term.

The Examining Attorney has also previously indicated that unless the Office is able to look beyond an applicant's recited services, "applicants could easily avoid descriptiveness refusals simply by being careful not to include in the recitation the feature of the goods or services described by the mark." Ex. A at 4. But applicants have no incentive to mis-describe their goods or services in an intent-to-use application because they would never be able to transform an approved application into a registration by submitting a specimen of use coinciding with the recited goods or services: If the goods or services are mis-described, the applicant would not be using its mark in connection with the claimed goods or services. Moreover, it would be counterproductive for an applicant to remove from its recitation of services the very services it wishes to protect. An applicant's rights under the Lanham Act are potentially restricted to the claimed services, and if the applicant left out a description of its true services, the applicant would be potentially surrendering rights for that particular use.

### B. Extrinsic Evidence Should Not be Used to Rewrite the Applicant's Identified Services

In this case, instead of considering the Applicant's recited services in class 35, the Applicant believes that the Office attempted to rewrite the Applicant's claimed services based on extrinsic evidence. First, the Examining Attorney pointed to webpages from third party websites purporting to discuss the products and services of the Applicant. Some of the third parties misused and/or characterized the Applicant's services, and the Applicant has written to third parties asking them to correct their use the Applicant's mark. See, e.g., Ex. E at 135 (Ex. 10).

But more importantly, it is incorrect to rely on third party representations about the Applicant's intended services over and above the Applicant's express identification of its intended services.

Respectfully, Applicant also contends that the Office mischaracterized and misinterpreted Applicant's responses to the his 37 C.F.R. § 2.61(b) request for information. Applicant never stated that its intended services for this mark involves the "provision of opinions by means of video," and instead, Applicant explained that "Applicant itself does not provide opinions about the products or services of others *per se*. . . ." In response to one of the Examining Attorney's questions, the Applicant responded: "The Applicant's services include soliciting, collecting, and sharing audiovisual demonstrations and information about consumer products and services." First, this is not a statement of a class 35 advertising service. Second, the Applicant explained that such works "may not" include a consumer opinion about a particular product or service. Although the Applicant stated that a work could conceivably include an "opinion" as well as a demonstration or general information, a work could also conceivably include an elephant, a goat, a rhinoceros, a belief of an individual, and various other subjects. Applicant has never stated that "the provision of opinions by means of video" was a significant quality, characteristic, function, attribute, or feature of the services with which Applicant's mark is intended to be used in class 35.

Respectfully, Applicant contends that the Office erred by rewriting Applicant's services based on speculation instead of simply looking at the accepted recitation of services. See, e.g., In re Stahlbush Island Farms, Inc., 2005 TTAB LEXIS 548 (TTAB Dec. 20, 2005) (Ex. F) ("The Examining Attorney. . . has been unable to precisely identify what significant aspect of applicant's goods the term 'FARMERS MARKET' immediately describes, speculating instead only as to such generalities as that 'applicant's goods are, in some manner, like those goods

found at farmer's markets'; that applicant's 'goods may have the look, taste and smell of fresh fruits and vegetables'; and that 'the goods are somehow like those purchased at a farmers market'."); In re Epigenomics GmbH, 2003 TTAB LEXIS 114, at *9-10 (TTAB Mar. 6, 2003) (Ex. G) ("The significance of the mark and specifically what it describes about the goods and/or services, when applied to or used in connection with the goods and/or services, is ambiguous and unclear. The Examining Attorney has left too much for speculation and assumption."); In re Air Control Science, 1997 TTAB LEXIS 185, at *3-4 (TTAB June 18, 1997) (Ex. H) ("[W]e find no support in this record for the Examining Attorney's position that DUST ANALYST is merely descriptive of applicant's services because it conveys to prospective purchasers that applicant's services involve the 'analysis of dust itself.' Applicant has identified its services as 'analysis, design and engineering of dust collection systems for others.' There is nothing in this record which indicates that such services involve the analysis of dust, and in fact, applicant's attorney maintains that applicant's services do not include analysis of dust.").[4]

## II. IN DETERMINING THE COMMERCIAL IMPRESSION OF THE APPLICANT'S MARK, THE OFFICE ERRED BY ARBITRARILY CHOOSING TWO DICTIONARY DEFINITIONS MOST CLOSELY MATCHING ITS HIS CHARACTERIZATION OF THE APPLICANT'S SERVICES

Neither the word "video" nor "opinions" is inherently descriptive of class 35 services. There are numerous service marks registered in class 35 which contain both the word "video," e.g., Ex. E at 58-112 (Ex. 6 ) (VIDEOSPACE, VIDEOSHOPPING, VIDEOSEEKER, VIDEORESUMECREATOR, VIDEOMASTERS, VIDEOMARATHON, VIDEOLOGO, VIDEOFINDER, VIDEOVIEW, VIDEOTRONIC, VIDEOSTITIAL, VIDEO-SCRIPT,

[4] Because these dispositions are not citable as precedent, Applicant only cites them (and other non-precedential opinions mentioned in this brief) as an instructive examples, not binding precedent.

VIDEOLINK, VIDEOFARM.COM), and the word "opinion," e.g., Ex. E at 140-161 (Ex. 12) (OPINIONPORT, OPINIONBANK, OPINIONSCOPE, OPINIONSPOT, OPINIONQUEST, OPINIONLAB, OPINIONSITE, VALUEDOPINION, ECHOPINION, QUALITYOPINIONS.COM, INTERNETOPINIONS.COM, WORLDOPINION, OPINION 1).

The Office carefully avoided any explicit statement as to how consumers would interpret the mark VIDEOPINIONS and instead simply concluded that, whatever it means, it must be descriptive of Applicant's services. And although the Examining Attorney concluded that VIDEOPINIONS creates no impression differing from a combination of "video" and "opinion," the Office offered no explication, justification, or evidence to support the conclusion. In re Grand Forest Holdings Inc., 78 USPQ2d 1152 (TTAB 2006) ("What we lack in this case is significant evidence that, when prospective purchasers encounter term FREEDOM FRIES used on frozen French fried potatoes, they will immediately understand that it identifies a feature, quality, or characteristic of the applicant's goods"); Epigenomics GmbH, 2003 TTAB LEXIS 114, at *9 (Ex. G) ("It is not clear how the relevant purchasers would regard the term DIGITAL PHENOTYPE; and there is no evidence that the relevant consumers would readily understand a connection between DIGITAL PHENOTYPE and the various diagnostic kits, laboratory equipment, and research and development and Internet access services."). Although the Examining Attorney proffered a few select dictionary definitions and several webpages purporting to use the words "video" and "opinion," the submissions do not show use of the Applicant's mark for its identified services. Therefore, the Office failed to meet its burden to show that the mark VIDEOPINIONS merely describes some significant aspect of Applicant's services with a degree of particularity.

### A. The Office Concedes That There is a Little Evidence of Descriptive Usage of the Phrase "Video Opinions"

Although the Examining Attorney apparently conducted extensive searches for instances of use of the phrase "video opinions," the Examining Attorney concluded: "[T]he Office cannot supply a large quantity of evidence of descriptive usage of the phrase 'video opinions' by others." Ex. B at 2. Although the Examining Attorney submitted a few articles spanning the past 16 years along with a few random webpages wherein the words "video" and "opinion" were used in conjunction, Applicant objects to the relevance of each article/webpage because in each case, Applicant's mark is not used to describe anything like Applicant's actual and intended services, *i.e.*, information on consumer products.

For example, the 1996 Kansas City Star article entitled "Students view life from both sides of camera" uses the phrase "video opinion poll"—not "videopinions." Not only does the phrase "video opinion poll" have nothing to do with the Applicant's intended and identified service, but also, the term "opinion poll" is a common compound term recognized by the Oxford English Dictionary (Ex. B at 10-12). In the 1991 LA Times article entitled "Private Eyes" concerns how everyday people record odd and diverse subjects on their camcorders ranging from photojournalistic events to their neighbors in hot-tubs. (Ex. B at 12-15). In the passage quoted by the Examining Attorney, "video opinions" is used to refer to recordings of individuals discussing their frustration of network news coverage of the Gulf War. Clearly, the phrase is not used to describe "[p]roviding information on consumer products and services by way of a global computer network."

There are a number of instances in the past and in other cases wherein the Board has come across similar circumstances and held that NEXIS articles and stray webpages submitted as evidence of use cannot show descriptiveness when they do not show the proposed mark being

used to describe the applicant's recited services. In the case of In re Harrington, 219 USPQ 854, 856 (TTAB 1983), the Office refused registration of COLLEGE ACADEMY for "education services, namely, providing special learning programs for gifted and talented children in grades 4 to 8." There was no evidence showing use of the composite term COLLEGE ACADEMY in the academic field. Id. Likewise, in this case, there is no evidence showing use of VIDEOPINIONS (or "video opinions") in the field of providing information on consumer products and services by way of a global computer network. See also In re L.Vad Technology, Inc., 2006 TTAB LEXIS 160 (TTAB Apr. 28, 2006) (Ex. I) (reversing refusal of PATCH BOOSTER for "heart assist devices" and rejecting NEXIS articles because they "do not support a finding that 'patch' is merely descriptive of applicant's goods"); In re Adamchik, 2006 TTAB LEXIS 345, at *8-10 (TTAB Aug. 7, 2006) (Ex. J) (holding that the Office's "single example of use of 'object style' in instructions for working with drawing objects and graphics fails to demonstrate that OBJECTSTYLE merely describes a function, feature or characteristic of the recited services").

**B. Despite the Office's Submission of a Few Dictionary Definitions, the Coined Mark VIDEOPINIONS Has No Meaning at All, and the Combination of "Video" and "Opinions" Evokes a New Commercial Impression**

VIDEOPINIONS is a coined term. The term "video opinion" or "video opinions" appears in no known dictionary. Nonetheless, the Examining Attorney has tried to deconstruct the mark into the words "video" and "opinion" separately, suggesting that each individually describe some aspect of the Applicant's services. The analysis is flawed for several reasons: (1) The words "video" and "opinion" have numerous known meanings and it was improper to arbitrarily select meanings which most closely matched the Examining Attorney's characterization of Applicant's services. (2) In this case, the combination of two otherwise known terms creates an entirely new commercial impress.

**1. Given The Various Definitions of "Video" And "Opinion," The Expression VIDEOPINIONS or "Video Opinion" Has No Clear Meaning**

For the word "video," the Examining Attorney cited the Microsoft® Encarta® dictionary (Ex. A at 39-41) and stated that the word has "its normal meaning." Ex. A at 4. But Encarta® lists five definitions of the noun and two definitions of the adjective. Ex. E at 40-41 (Ex. 1). When one also considers the definitions of www.Infoplease.com (id. at 43-44 (Ex. 2)), Merriam-Webster Online definitions of "video" (id. at 46-48 (Ex. 3)); American Heritage Dictionary (id. at 51 (Ex. 4)); Dictionary.com (id. at 50-51); and the Oxford English Dictionary (id. at 56-57 (Ex. 5)), one is inundated with definitions ranging from, *inter alia*, music videos, movies, video recorders, videocassettes or videotapes, television, and the visual portion of television. See Ex. E at 6-7 (listing more than 30 definitions). Given the various grammatical forms and definitions of the word "video," the question presents itself: What does the term "video" mean to consumers? The Examining Attorney never explains.

For the word "opinion," the Examining Attorney offered definitions from two sources: Infoplease.com and Merriam-Webster Online. Ex. A at 27-28. But again, when one also considers the definitions from Microsoft® Encarta (Ex. E at 114-15 (Ex. 7)), American Heritage (id. at 117-23 (Ex. 8)), and the Oxford English Dictionary (id. at 125-33 (Ex. 9)), one is inundated by definitions ranging from, *inter alia*, favorable esteem, a formal statement by a judge, a belief or conclusion held with confidence but not substantiated by positive knowledge or proof, the public or general opinion, and/or a judgment based on special knowledge. Given the various definitions of the word "opinion," the following question presents itself: What does the word "opinion" mean to consumers? The Examining Attorney defines "opinion" as follows: "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.'" Ex. A at 3. The Examining Attorney offers no justification for choosing this definition from amongst the many and diverse possibilities.

Given all the various meanings of the terms "opinion" and "video," consumers cannot come to any clear understanding as to what "videopinions" (or "video opinions") could possibly mean. In an analogous case, the Office originally refused registration of the mark POLYDECK as descriptive of, *inter alia*, "polyethylene dock sections." In re FineLine Lakeshore Servs., LLP, 2006 TTAB LEXIS 339, at *9-12 (TTAB Aug. 24, 2006) (Ex. K).

> The Examining Attorney argues that POLYDECK is a compound term with two merely descriptive components: 'deck' which is an alternative generic term for 'dock' and 'poly' which is an abbreviation for 'polyethylene.'

*Id.* The Board looked at the proffered dictionary definitions and noted that "poly" had multiple definitions and could mean an abbreviation of "polyethylene" or suggest that the particular goods—dock sections—may be configured in many ways. The Court held that the fact that the terms had multiple meanings made the combined mark POLYDECK more suggestive than descriptive.

> This indicates further that the combination of 'poly' and 'deck' may have a suggestive meaning which is more than the sum of its parts contrary to the Examining Attorney's position.
>
> Accordingly, we conclude that POLYDECK is not merely descriptive of 'polyethylene dock sections.' In concluding so we acknowledge that there is some doubt and that, in such a case under Trademark Act Section 2(e)(1), we must resolve doubt in favor of applicant.

Id. at *9-12 (emphasis added and citations omitted). Like the case in FineLine, the terms "video" and "opinion" have multiple definitions. Indeed, the term "video" may be used as a noun or an adjective and there are literally hundreds of permutations and possibilities, many of

which make no sense (e.g., combining the noun "video" with "opinion" creates nonsense, similar to "cat dog"). The mark VIDEOPINIONS may suggest in the mind of consumers (i) an opinion poll in video format (as indicated in the Kansas City Star article proffered by the examiner); (ii) video recordings of court proceeding or court "opinions"; (iii) a video of political or religious issues; (iv) written movie reviews, i.e., reviews of videos. Applicant's coined term could suggest a lot of different things, none of which describe or even hint of the Applicant's claimed service of "[p]roviding information on consumer products and services by way of a global computer network." Because of the diverse possible consumer interpretations of the mark VIDEOPINIONS, the Applicant's mark should be deemed, if not fanciful, at most suggestive. The ambiguity raised by the various meanings and consumer interpretations weighs in favor of the Applicant because any doubt "must resolve in favor of the applicant." In re Rank Organisation Ltd., 222 USPQ 324, 326 (TTAB 1984).

Even though Applicant contends that a consumer could not possibly ascertain its services from hearing its mark, Applicant is not here arguing that point. Applicant is arguing that the coined word VIDEOPINIONS or the combination of "video" and "opinions" has no meaning whatsoever in the English language or in the minds of consumers. To that extent, the present case resembles the circumstances of Harrington, wherein the Board reversed a descriptiveness refusal of COLLEGE ACADEMY for "education services" in part because "the composite of the two words is not a term in general use to describe educational services (or anything else, for that matter) and has no dictionary meaning." 219 USPQ at 856. In the present case, the Office does not dispute that "videopinions" has no dictionary meaning. There is no evidence that the composite of "video" and "opinions" is in general use to describe providing information on

consumer products and services by way of a global computer network. The Office concedes there is little evidence of the combined use to describe anything whatsoever.

**2. The Combination of "Video" and "Opinions" Evokes a New and Unique Commercial Impression**

Even though the individual terms "video" and "opinions" do not individually describe any aspect of Applicant's class 35 service, assuming *arguendo* that the word "video" was descriptive and the word "opinion" was separately descriptive of something in the abstract, the combination of the words still evokes a new and unique commercial impression. "When two or more merely descriptive terms are combined, [the Board] must determine whether the combination of terms evokes a new and unique commercial impression." FineLine, 2006 TTAB LEXIS 339, at *9-12 (Ex. K); see also Colonial Stores, 394 F.2d 549 (holding that combination of two descriptive elements may result in a non-descriptive composite); In re Werner Electric Brake & Clutch Co., 154 USPQ 328 (TTAB 1967) (ELECTRO-MODULE not descriptive of goods even though each term, considered separately, was found to describe applicant's goods); In re Shutts, 217 USPQ 363 (TTAB 1983) (SNO-RAKE not merely descriptive for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs."); In re Shop Vac Corp., 219 USPQ 470 (TTAB 1983) (WET/DRY BROOM is not merely descriptive of a vacuum cleaner or an electric cleaning appliance of similar appearance); Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 USPQ 557 (TTAB 1975) (BIASTEEL is at most suggestive of the character of tires); In re Idiag, 2001 TTAB LEXIS 475, at *9 (TTAB June 19, 2001) ("we agree with applicant that the combined expression, SPINALMOUSE, is somewhat incongruous, and that no purpose or characteristic is readily described by this combined term, either generally or with particularity.") (Ex. L).

To the extent that the individual words "video" and "opinions" have identifiable meanings, VIDEOPINIONS does not describe either Applicant's service of providing "[p]roviding information on consumer products and services by way of a global computer network," or a function or characteristic of this service. For example, in the case of In re TBG Inc., 229 USPQ 759 (TTAB 1986), the Office initially refused registration of SHOWROOM ONLINE as descriptive for "leasing computer databases and video disks in the field of interior furnishings and related products of others." The applicant in that case provided a database service to third parties which allowed them to show furniture products on the third parties' website. Reversing the refusal, the Board held that the words SHOWROOM and ONLINE did not accurately or merely describe the applicant's leasing or information services. Id. at 759. Analogous to the applicant in TBG, the Applicant more similarly provides something like a database for providing consumer information. The Applicant itself does not create videos and does not provide opinions on products. The Applicant's service includes providing consumer information, but such information does not originate from the Applicant, who merely allows third parties to share such information amongst one another. As such, even if the words "video" and "opinions" means something in the abstract, the words do not merely describe either the Applicant's consumer information service or its function or characteristics.

## III. APPLICANT ARGUES THAT VIDEOPINIONS COULD AT MOST BE SUGGESTIVE

Arranged in ascending order of protectability, trademarks are categorized as generic, descriptive, suggestive, or arbitrary/fanciful. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992). A mark that suggests rather than merely describes a particular good or service is protectable without evidence of secondary meaning. While a descriptive term will directly and clearly convey information about the qualities or characteristics of the associated service, a

"suggestive" term only indirectly suggests certain qualities or characteristics of the service. Courts have held that if the consumer must exercise mature thought or follow a multi-stage reasoning process in order to determine attributes of the services from the mark, the mark is suggestive and not descriptive. In re Tennis in the Round, Inc., 199 USPQ 496, 498 (TTAB 1978).

Simply stated, in the present case, there is no evidence that the words "video" and "opinions" directly and clearly convey information about the qualities or characteristics of a "global computer network" devoted to, *inter alia*, information on consumer products and services. Grand Forest Holdings, 78 USPQ2d 1152 ("What we lack in this case is significant evidence that, when prospective purchasers encounter term FREEDOM FRIES used on frozen French fried potatoes, they will immediately understand that it identifies a feature, quality, or characteristic of the applicant's goods"); In re Telechat Networks, Inc., 2006 TTAB LEXIS 178, at *8 (TTAB May 11, 2006) (Ex. M) (citing Rank, 222 USPQ at 326 (The "fact that the term LASER is cable of being analyzed does not render the term merely descriptive.")); see also In re Remacle, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) ("It is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork."). The words "video" and "opinions" are simply too broad and harbor too many possible meanings to be merely descriptive. See, e.g., In re Hutchinson Technology Inc., 852 F.2d 552 (Fed. Cir. 1988) (TECHNOLOGY too broad a term to be merely descriptive of applicant's particular goods). Consumers must engage in highly mature thought processes and multiple steps to arrive at anything remotely resembling any aspect of the Applicant's specific recited class 35 services.

The Applicant's specific mark is not needed by competitors to identify their own services. The purpose of Section 2(e)(1) is to protect the competitive needs of others, and thus, if the message conveyed by the mark about the services is so direct and clear that competing sellers would be likely to need to use the term in describing or advertising their own services, then this indicates that the mark is descriptive. In re TMS, 200 USPQ at 59; Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1218 (9th Cir. 1987). In the present case, the Applicant's business is novel—or was novel when it filed its application in June 2005.[5] There is no evidence that any television network or consumer information service uses or needs to use "videopinions" or "video opinions" to describe similar services. In re Dollar-A-Day Rent-A-Car Systems, Inc., 173 USPQ 435, 437 (TTAB 1972) ("If the term is as highly descriptive as asserted by the examiner, one would suppose that there would be at least one descriptive use thereof by a competitor but none has been shown."). But also, there is no indication that anyone in the general field of information services would need to use this term. Minnesota Mining & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179, 1180 (C.C.P.A. 1972) (SKINVISIBLE not necessary to describe transparent medical adhesive tape). For this reason too, the Applicant's mark should be deemed suggestive and not "merely descriptive."

As marks go, VIDEOPINIONS is certainly less descriptive than numerous marks which have been deemed to be suggestive by the Board. See, e.g., Grand Forest Holdings, 78 USPQ2d 1152 (TTAB 2006) (FREEDOM FRIES not descriptive of frozen french fries); In re Intelligent Medical Sys., 5 USPQ2d 1674 (INTELLIGENT MEDICAL SYSTEMS not descriptive of

---

[5] Applicant has since learned about several quasi-competitor type companies called ShopWiki (www.shopwiki.com), Zvedo (www.zvdeo.com), CNET Reviews (http://reviews.cnet.com), and ShareReviews (http://sharedreviews.com). None of the sites use the Applicant's mark.

"electronic thermometers for measuring human body temperature."); In re Sundown Technology Inc., 1 USPQ2d 1927, 1928 (TTAB 1986) (GOVERNOR not descriptive for controls used to limit sound from musical amplifier); In re WSI Corp., 1 USPQ2d 1570 (TTAB 1986) (SUPERSAT not descriptive of collecting meteorological information via satellite); In re Southern Nat'l Bank, 219 USPQ 1231 (TTAB 1983) (MONEY 24 not descriptive of automatic teller machines); Harrington, 219 USPQ 854 (COLLEGE ACADEMY not descriptive for education services for gifted children).

## CONCLUSION

For the foregoing reasons, the Applicant respectfully requests the Board reverse the refusal to register its mark. In this case, the Applicant respectfully contends that (at the very least) it has raised doubts as to whether the Applicant's mark is "merely descriptive." Moreover, if the Board agrees, Applicant requests that such doubts be resolved in favor of the applicant. In re The Stroh Brewery, 34 USPQ2d 1796, at *4-5 (TTAB 1995); In re Gourmet Bakers, Inc., 173 USPQ 565, at *1 (TTAB 1972), accord, On Technology, 41 USPQ2d 1475, at *8; Telechat Networks, Inc., 2006 TTAB LEXIS 178, at *8 (Ex. M).

Respectfully submitted,

Dated: July 23, 2007

By: _____

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## TABLE OF AUTHORITIES

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37 C.F.R. § 2.32(a)(6) ..... 7

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Trademark Manual of Examining Procedure § 805 ..... 7

Trademark Manual of Examining Procedure § 1402.01 ..... 7

## CERTIFICATE OF MAILING

I hereby certify that APPLICANT'S OPENING APPEAL BRIEF and Exhibits A thru M are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Trademarks, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 on July 23, 2007.

Andrew R. Schmidt

# EXHIBIT A

| | |
|---|---|
| **To:** | Expo Communications, Inc. (tmdocketny@kenyon.com) |
| **Subject:** | TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/29 |
| **Sent:** | 8/17/06 9:13:37 AM |
| **Sent As:** | ECOM106@USPTO.GOV |
| **Attachments:** | Attachment - 1<br>Attachment - 2<br>Attachment - 3<br>Attachment - 4<br>Attachment - 5<br>Attachment - 6<br>Attachment - 7<br>Attachment - 8<br>Attachment - 9<br>Attachment - 10<br>Attachment - 11<br>Attachment - 12<br>Attachment - 13 |

**[Important Email Information]**

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO**: 78/654480

**APPLICANT**: Expo Communications, Inc.

*78654480*

**CORRESPONDENT ADDRESS**:

JOSEPH F. NICHOLSON, ESQ.

KENYON & KENYON,

1 BROADWAY

NEW YORK, NY 10004-1007

**RETURN ADDRESS**:

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

**MARK**: VIDEOPINIONS

**CORRESPONDENT'S REFERENCE/DOCKET NO**: 13114/29

**CORRESPONDENT EMAIL ADDRESS**:

tmdocketny@kenyon.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

# OFFICE ACTION

**RESPONSE TIME LIMIT**: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION**: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at http://tarr.uspto.gov/, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

This letter responds to the applicant's communication filed on July 13, 2006.

**SECTION 2(e)(1) REFUSAL MADE FINAL**

The refusal to register under Section 2(e)(1) of the Trademark Act is continued and made FINAL.

Applicant seeks registration of VIDEOPINIONS for services wherein consumers offer opinions about products and services on videotape. Applicant indicates that its services include soliciting, collecting, and sharing audiovisual demonstrations and information about consumer products and services, and admits that "such audiovisual works may or may not include or involve a consumer's opinion about a particular product or service."

Attached are two web page articles or listings apparently indicating what is done through applicant's services. Consumers apparently review and

rate different products or services, giving their opinions thereof. Note that in the first attachment, the person reviewing applicant's service regarded it as a place "devoted to online video opinions." The second attachment apparently shows the result of a cooperative effort between the applicant and another party called "GamePro" where consumers offer reviews of games. Note how the term "videopinion" itself is used in lower case letters. See also enclosed results from a search of the *Nexis* research database showing use of the phrase "video opinion" and its plural in descriptive fashion.

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 attached dictionary definitions. There can be little doubt that the personal views, judgments, or appraisals of the products or services reviewed by the consumers in the videos shown by the applicant constitute opinions. The term "video" is also being used for its normal meaning. See attached dictionary definition and the broader definitions of "video" provided below.

Applicant is correct that whether a mark is merely descriptive is determined in relation to the identified goods or services, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). TMEP §1209.01(b). However, this does not mean that the descriptive feature of the services has to exist in the recitation of services in order for a mark to be merely descriptive. If this were the case, applicants could easily avoid descriptiveness refusals simply by being careful not to include in the recitation the feature of the goods or services described by the mark. Moreover, the fact that the mark does not describe how the services are offered

does not foreclose the finding of descriptiveness. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods/services to be merely descriptive. It is enough if the term describes one attribute of the goods/services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). TMEP §1209.01(b).

Even though the applicant itself may not be expressing its own opinions about the goods and services of others, its services nonetheless feature opinions on video.

The telescoping of the terms "video" and "opinion" into one word does not create an impression differing from that created by the two words and still results in a descriptive mark. See, for example, *In re BankAmerica Corp.*, 229 USPQ 852 (TTAB 1986) (PERSONALINE merely descriptive of consumer loan services in which a personal line of credit is provided); *In re U.S. Steel Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE merely descriptive of wire rope); *In re Gagliardi Bros., Ind.*, 218 USPQ 181 (TTAB 1983) (BEEFLAKES is merely descriptive of thinly sliced beef).

The above refusal is FINAL. Any other prior informalities not addressed above are deemed satisfied or are withdrawn.

If the applicant has any questions about this Office action, please telephone the assigned examining attorney.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

/Steven Foster/

Steven Foster, Trademark Attorney

Law Office 106

(571) 272-9318

Fax number for the Law Office: (571) 273-9106

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- ONLINE RESPONSE: You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at http://www.uspto.gov/teas/index.html. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

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**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

108B8C

Print Request: Selected Document(s): 13,19

Time of Request: August 17, 2006 07:45 AM EDT

Number of Lines: 53

Job Number: 1821:113847575

Client ID/Project Name:

Research Information:

US Newspapers

video opinion

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13 of 19 DOCUMENTS

Copyright 1996 The Kansas City Star Co.

Kansas City Star (Kansas & Missouri)

June 19, 1996 Wednesday JOHNSON COUNTY EDITION

**SECTION:** ZONE/SHAWNEE MISSION; Pg. 3

**LENGTH:** 369 words

**HEADLINE:** Students view life from both sides of camera

**BYLINE:** ROBERTA JOHNSON, Staff Writer

**BODY:**

...Amanda Hays, a

seventh-grader at Westridge Middle School. "We got to tape

(yesterday) and today, and I get to do the **video opinion** poll."

Many students were excited about the idea of being on camera.

"It's fun to use our imagination and interview people," ...

19 of 19 DOCUMENTS

Copyright 1991 The Times Mirror Company; Los Angeles Times

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Los Angeles Times

July 25, 1991, Thursday, Home Edition

**SECTION:** View; Part E; Page 1; Column 2; View Desk

**LENGTH:** 1975 words

**HEADLINE:** PRIVATE EYES;

MAKING A HOME VIDEO HAS BECOME SO EASY THAT NOTHING IS TOO MUNDANE OR TOO WEIRD FOR TAPE.

**BYLINE:** By GERALDINE BAUM, TIMES STAFF WRITER

**DATELINE:** NEW YORK

**BODY:**

...article recounted how a consortium of peace groups became frustrated with network news coverage of the Gulf War. They solicited **video opinions** from groups nationwide, received 100 responses and then culled them, broadcasting four short programs on cable and PBS stations.

"Increasingly, ...

Definitions of video on the Web:

the visible part of a television transmission; "they could still receive the sound but the picture was gone"

video recording: a recording of both the video and audio components (especially one containing a recording of a movie or television program)

television: broadcasting visual images of stationary or moving objects; "she is a star of screen and video"; "Television is a medium because it is neither rare nor well done" - Ernie Kovacs

wordnet.princeton.edu/perl/webwn

Note:

In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 2 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:

Email 1 includes the following 5 attachments

1. vid-1

2. vid-2

3. vid-3

4. vid1-1

5. vid1-2

Email 2 includes the following 8 attachments

1. vid1-3

2. op-1

3. op-2

4. op2-1

5. op2-2

6. video-1

7. video-2

8. video-3

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

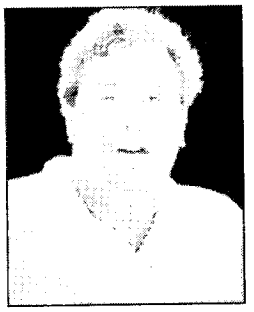
# Branding Ad Vice

**Rants, Raves, Small Business Advertising and Marketing Advice From Walter Koschnitzke**

a Wizard of Ads official partner

« Advertising Tools | Main | Sales Training 101 »

Wizard Of Ads
Walter Koschnitzke



ABOUT

Email Me

**APRIL 26, 2006**

## Today's New Word "Videopinion"

This was going to be a post about the brilliant ad campaign for Tag® Body Spray. But as I searched for the new "Strip Poker" ad I came across a site called Expo Television, devoted to online video opinions, reviews and product demonstrations and buying tips.

According to Expo's Homepage:

*Videopinions is another way Expo TV wants to make you a smarter shopper!*

*A Videopinion is YOU, showing and telling us in FULL MOTION VIDEO what you love and hate about the products and services that make your world go round. Show us everything from why you love your iPod Shuffle,*

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Add me to your TypePad People list

UPCOMING EVENTS

Boom Your Business

RECENT POSTS

Who Manages The Manager

What Will They Do When Your Back Is Turned?

Don't Touch That Dial

So Much For Supplemental Income

My Customers Are Different And Other Fairy Tales

100% What?

If You Believe This...

Here's My Two Cents

CATEGORIES

Advertising

Ad Writing

Books

Current Affairs

LIfe Experiences

Marketing

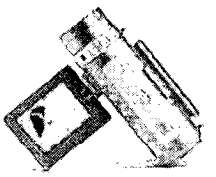
Personal Experience Factor

Radio

Sales

*world go round. Show us everything from why you love your iPod Shuffle, to the essential baby swing that every mom needs, to the pros and cons of your electric razor.*

*Videopinions allows our viewers to share their own unbiased, personalized experiences with other consumers.*



The reviews are hokey, crudely produced but they are real. And real people have often been known to topple the mighty. Here's the review of Tag® Body Spray. Madison Avenue it ain't, but what would someone say if given the opportunity to upload a videopinion of your product or service? With the low cost of cameras everyone can become a producer.

In today's brave new world of virtual communities it's vital that you deliver what you promise and to keep your eyes and ears open and your fingers on the pulse of what people are saying behind your back. If you aren't "Googling" your business every couple of months you may miss what someone says about you good or bad.

But that's just my opinion.

April 26, 2006 in Marketing, Web/Tech | Permalink

**TRACKBACK**

TrackBack URL for this entry:
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Listed below are links to weblogs that reference Today's New Word "Videopinion":

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Stop Selling And Start Hiring Clients

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Making Ads Work

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Wizard Of Ads UK

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Steve Sorenson on 100% What?

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Wonder Branding

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WHERE GAMERS GO FIRST
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password
log in
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PS2 | PS3 | Xbox | Xbox 360 | Wii | GameCube | PSP | DS | GBA | PC
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game finder
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User Reviews
Free Stuff
Build a Profile
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FEATURED MEMBER
Shinobi558
Beware of Ninja
QUICK POLL
Which system will come out first: PS3 or Wii?
Wii
PS3
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## Feature: Expert Gamer Contest: Voters' Top 4 Video Reviews

Feature by The Gamepros | 08/10/2006 | 02:15:41 AM PST

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**As of now, these are the top four videos that voters have found useful. But are they really worthy of the top four position? Do you think they are? Find out for yourself.**

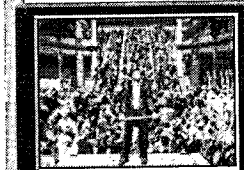
GamePro and Expo TV have joined forces to bring forth a contest that seeks out the best videopinion game review. The main requirements? The reviewer's face must be present and the game being reviewed must be recent. The following four videos have topped the votes so far, but do we think they're worthy of the spot? More importantly, do *you* think they are? Let your voice be heard and rock the vote at Expo TV's videopinion website.

### Trackmania Nation

**Verdict:** Good
**Why it's good:** Aside from the fancy intro and in-game footage, the reviewer actually talks about the benefits of playing this game, and hey!

Most Recent Features
- It Ain't All Just PlayStation 3 [ Domestic ]
- Expert Gamer Contest: Voters' Top 4 Video Reviews [ Domestic ]
- The 14 Freakiest Moments of Prey [ Xbox 360 ]
- Extreme Sports Preview! [ Domestic ]
- MMORPG End of Days [ Domestic ]

Recently Added Screenshots


Dead Rising [Xbox 360]

Thrillville [PS2]

◆ Retro Expert
◆ Ask your question!

THE GAMEPROS
◆ Vicious Sid
◆ Mr. Marbles
◆ Dr. Zombie
◆ Major Mike
◆ Bro Buzz
◆ Rice Burner
◆ Lunchbox
◆ Ahoy_And_Avast
◆ Agent Marmalade

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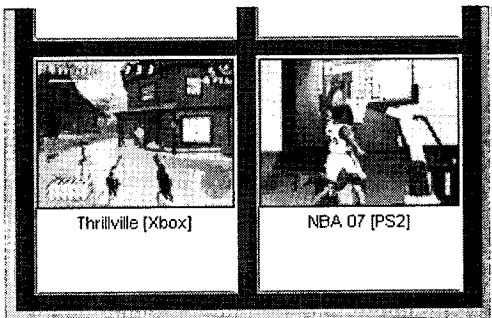
reviewer actually talks about the benefits of playing this game, and hey! it's free to download and play, so why not give it a try? He also leads us through the gameplay by showing and telling, not just telling. No wonder this video's one of the top four.

## Battlefield 2: Armored Fury

**Verdict:** Okay
**Why it's okay:** Similar to the previous review on *Trackmania Nation*, this review also features some in-game footage and a brief overview on what's good and bad about the game itself. He accomplishes the goal of letting me know whether or not he thinks it's worth the purchase. However, he still sounds a bit stiff, knocking this video from "Good" to "Okay." But voters have found his review to be useful so maybe you will too.

## WarCraft 3: Frozen Throne (DoTA Custom Map)

**Verdict:** Enthusiastic
**Why this could be good and bad:** Well, I was certainly surprised to see a review of the ever-beloved custom map "Defense of the Ancients" (or commonly called DoTA), not only because I'm a huge fan of it, but I just never expected a fan-made custom map to be the subject of any review.. This person does a great job of covering why DoTA is awesome and fun, but this review could also be a setback because #1 WC3: FT is an old expansion set, as well as DoTA itself and #2 it brings up the question of whether or not this sort of thing should be reviewable; it sort of implies that either only WC3 veterans would be interested in this review, or that anyone who could be potentially interested would have to buy two games in order to play it. Maybe it's just me, but I'd prefer to view a videopinion on a video game in its entirety rather than one based on a fan-made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custom map. But that's just me. As a review and a review alone, this could be a good one.

**Guitar Hero**

**Verdict:** Good
**Why it's good:** The introduction is funny in that lame way, he covers the basic bases of the game, and even plays a little bit of it for those completely unfamiliar with the game. All in all, it's a great review of Guitar Hero. I'm not surprised it made the top four.

Remember to vote on the videos at Expo TV's videopinion website, and keep it real and safe. Want to read my past videopinion editorials?

- Timesplitters 3, MLB 2K6, and more
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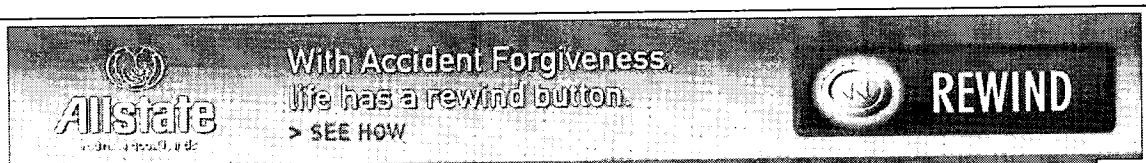




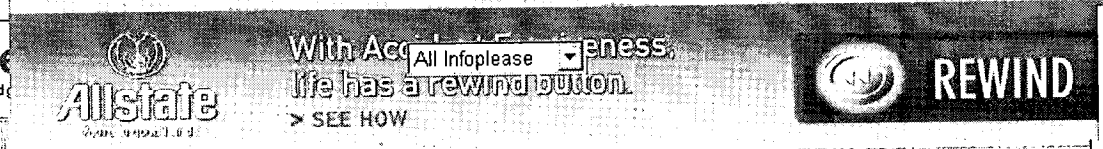


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# Dictionary

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o•pin•ion

*Pronunciation:* (ə-pin'yən), [key]

*—n.*

**1.** a belief or judgment that rests on grounds insufficient to produce complete certainty.
**2.** a personal view, attitude, or appraisal.
**3.** the formal expression of a professional judgment: *to ask for a second medical opinion.*
**4.** *Law.* the formal statement by a judge or court of the reasoning and the principles of law used in reaching a decision of a case.
**5.** a judgment or estimate of a person or thing with respect to character, merit, etc.: *to forfeit someone's good opinion.*
**6.** a favorable estimate; esteem: *I haven't much of an opinion of him.*

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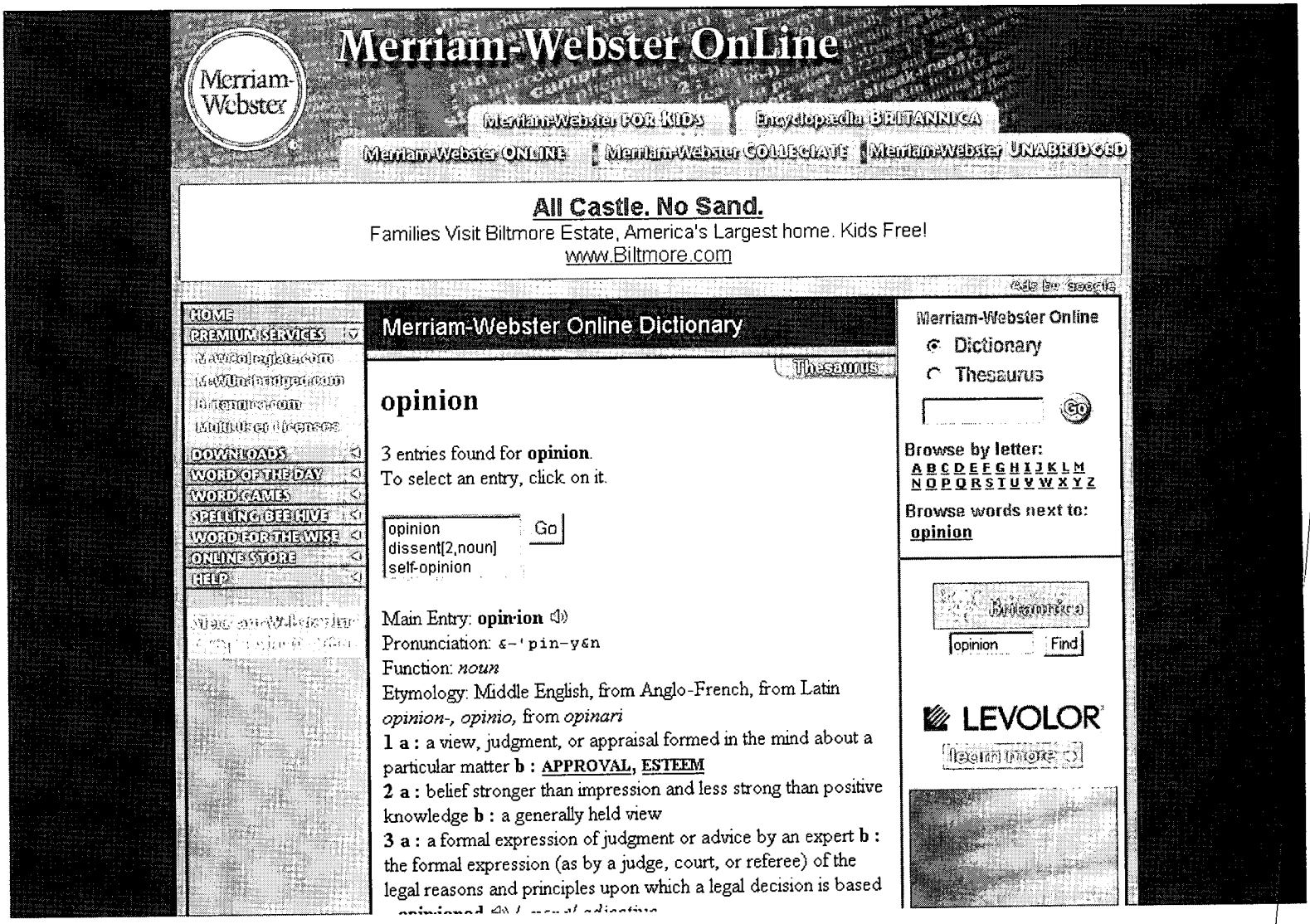

- **opin·ioned** /ə-yənd/ *adjective*

**synonyms** OPINION, VIEW, BELIEF, CONVICTION, PERSUASION, SENTIMENT mean a judgment one holds as true. OPINION implies a conclusion thought out yet open to dispute <each expert seemed to have a different *opinion*>. VIEW suggests a subjective opinion <very assertive in stating his *views*>. BELIEF implies often deliberate acceptance and intellectual assent <a firm *belief* in her party's platform>. CONVICTION applies to a firmly and seriously held belief <the *conviction* that animal life is as sacred as human>. PERSUASION suggests a belief grounded on assurance (as by evidence) of its truth <was of the *persuasion* that everything changes>. SENTIMENT suggests a settled opinion reflective of one's feelings <her feminist *sentiments* are well-known>.

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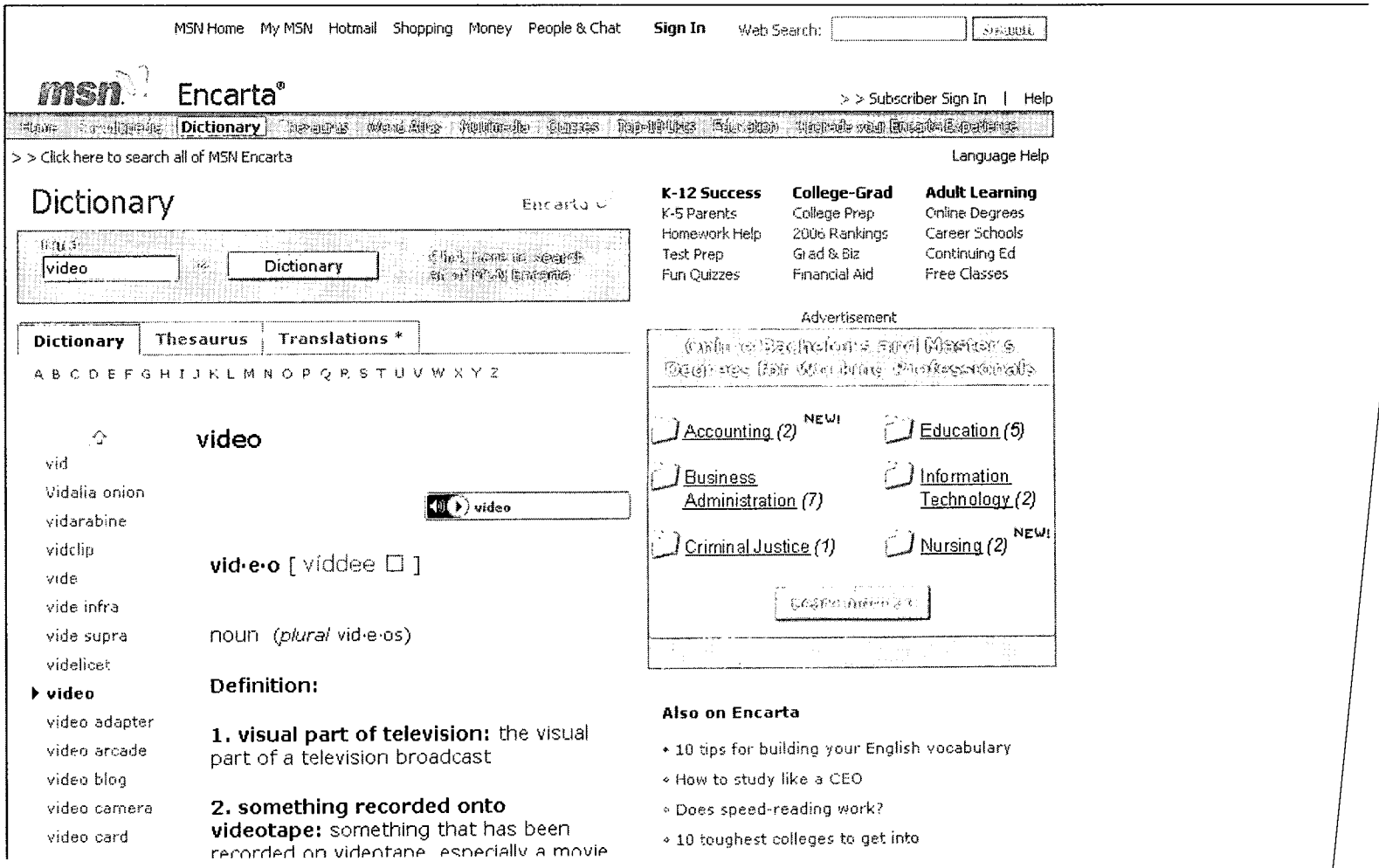

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recorded on videotape, especially a movie or music performance
- *a video of my brother's wedding*

**3. videocassette:** videotape, or a videocassette ( *informal* )
- *now available to rent or buy on video*

**4.** COMPUT **images on computer screen:** the text and graphics images that appear on a computer screen

**5. image reproduction industry:** the industry of recording and broadcasting visual information and entertainment, especially that which can be viewed on a television
- *a star of stage, screen, and video*

adjective

**Definition:**

**1. relating to visual image reproduction:** relating to the recording or broadcasting of visual information or entertainment by means of videotape or television

**2. relating to video frequencies:** relating to or using video frequencies

[Mid-20th century. < Latin *videre* "to see," after audio]

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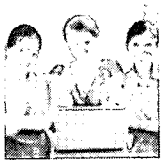

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# EXHIBIT B

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**Conversation:** TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/29 - Message 1 of 5
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**Subject:** TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/~~29~~ 31 - Message 1 of 5

## [Important Email Information]
## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/654480

**APPLICANT:** Expo Communications, Inc.

*78654480*

**CORRESPONDENT ADDRESS:**
JOSEPH F. NICHOLSON, ESQ.
KENYON & KENYON,
1 BROADWAY
NEW YORK, NY 10004-1007

**RETURN ADDRESS:**
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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**MARK:** VIDEOPINIONS

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 13114/29

**CORRESPONDENT EMAIL ADDRESS:**
tmdocketny@kenyon.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/654480

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the point at issue in the final action. TMEP §715.03(a). Accordingly, applicant's request for reconsideration is denied and the refusal to register under Section 2(e)(1) of the Trademark Act is continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

Initially, it is pointed out that the parent application has been successfully divided so that applicant's services in class 35 fall in application 78-654480, while the services in class 38 fall in application 78-978112 and the services in class 41 fall in application 78-978113. All of the services will be addressed

in this Office action, which will be replicated so that it appears in all three files.

Applicant seeks registration for VIDEOPINIONS for: providing information on consumer products and services by way of a global computer network (class 35); 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 (class 38); and entertainment services in the nature of on-going television programs in the field of information about consumer products and services (class 41).

Applicant argues that the terms "video" and "opinion" have multiple meanings. However, this fact is not controlling. The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk" where relevant trade uses the denomination "concurrent" as a descriptor of this particular type of operating system); *see* TMEP §1209.01(b). 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 fact that the compound word is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).

Interestingly, applicant claims that its mark is "not needed by competitors to identify their own services", while at the same time admitting that its business is novel. In fact, in its first response, applicant stated that it was not aware of any third party offering services of the same type. The fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c). Further, a new product that differs from an established product in some significant, functional feature or characteristic may actually become its own genus for purposes of determining registrability. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986); *In re Reckitt & Colman*, 230 USPQ 369 (TTAB 1986). Applicant's admission that its services are novel may well explain why the Office cannot supply a large quantity of evidence of descriptive usage of the phrase "video opinions" by others. However, this does not preclude a finding of descriptiveness when applicant's telescoped word, when viewed in the context of the services, is being used for the ordinary descriptive meanings of its component parts.

Applicant relies upon the fact that its recitation of services never mentions opinions or videotape. It then argues that the Office is incorrect when it states that the feature of the services described by the mark need not appear in the recitation of services itself in order for the mark to be merely descriptive. However, 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. The term "NURSING MAGAZINE" is no less descriptive of goods identified as "medical magazines" than it is of goods identified as "magazines about nursing," if the record shows that the medical magazines feature articles about nursing. To hold otherwise would be to insert a new issue into every application where the Office made a refusal based upon descriptiveness; for every refusal under Section 2(e)(1) of the Trademark Act, the examiner would make a corresponding requirement that the applicant insert into the identification of goods or services clause the feature of the goods or services described by the mark.

As applicant was advised previously, for the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("[A] mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services.") (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). Many goods and services have multiple features that could be described by different terms. Even the applicant's services fall into this realm. Some of the means by which the services are to be offered have been included in the recitations, but not the subject of each service, opinions on video. However, the fact that the feature described by the mark is not evident in the recitation itself does not mean that it does not exist, or wouldn't be recognized by purchasers. Phrases like "made of leather" and "six feet long" may be descriptive of goods identified merely as "couches", if the record shows that the couches are made of leather and are six feet long. This would be so even though neither phrase alone describes *all* of the couch's features.

Turning to the record, applicant admits the following about its services:

.... the Applicant solicits, collects, organizes, and shares objective third party demonstrations, commentary, and reviews of consumer products and services of others with others.

...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.

....The Applicant's services include soliciting, collecting, and sharing audiovisual demonstrations and information about consumer products and services. Such audiovisual works may or may not include or involve a consumer's opinion about a particular product or service, and may instead involve the demonstration of a particular product or service and useful information on it.

Applicant admits that the services may include or involve a consumer's opinion on audiovisual works, and that the services involve the sharing of the information. This also includes the sharing of "commentary and reviews" on video. These are the contexts in which applicant's mark will be viewed, whether the videotaped opinions are provided via computer (class 35), via broadcasting or video-on-demand (class 38), or on a television program (class 41). Marks describing the subject matter of such

activities have been held merely descriptive. *See e.g., In re Conus Communications Co.*, 23 USPQ2d 1717 (TTAB 1992) (ALL NEWS CHANNEL generic for a television channel broadcasting all news); *In re Weather Channel, Inc.*, 229 USPQ 854 (TTAB 1986) (WEATHER CHANNEL merely descriptive). Note how the latter case appears to disagree with the unpublished case quoted by applicant herein, stating that WEATHER CHANNEL was merely descriptive of the intended users of the applicant's programming services, which were directed to the broadcasters or channels.

Applicant states that it cannot fully understand the attachments to the Office action of August 17, 2007, believing that it did not receive all of the attachments. However, it appears that applicant did receive all of the attachments. The Office designates as separate attachments each page sent. Thus multiple page listings appear as separate attachments.

Applicant also wanted full copies of the *Nexis* stories previously provided. The Office obliges by submitting the stories below.

Also added, however, are additional stories from a search of the *Nexis* research database, also submitted in full. Story number 4 shows descriptive use of the phrase "video opinions" in an apparent reference to the applicant's services. Story number 5 refers to another offering a video opinion, and story number 6 shows use of "videopinion" by another writer. Also attached is a web page from the applicant, referring to the subject matter of its "videopinions" as being "short, unbiased video product reviews."

Further still, additional web pages are attached, showing how "video opinions" has become a highly descriptive phrase for opinions expressed on video.

Applicant's mark is a telescoped version of the words "video opinions", with VIDEOPINIONS having the shared "o". Although the resulting term has one less syllable than "video opinions", this does not appear to be controlling. The Trademark Trial and Appeal Board has affirmed a refusal to register in a similar situation, holding DATALERTS, a telescoped version of DATA ALERTS, to be a descriptive term. See attached copy of opinion in *In re Visual Analytics, Incorporated,* SN 76-465520 (Decided July 27, 2005).

The file will now be returned to the Trademark Trial and Appeal Board for resumption of applicant's appeal.

/Steven Foster/
Steven Foster, Trademark Attorney
Law Office 106
(571) 272-9318
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**Time of Request:** Thursday, March 15, 2007 10:37:27 EST
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Advertising Age

October 23, 2006

**SECTION:** DIGITAL; Pg. 35

**LENGTH:** 313 words

**HEADLINE:** Media Morph: **Videopinions**

**BYLINE:** Abbey Klaassen

**BODY:**

What it is: Text is so yesterday. While written user reviews have become a powerful tool for consumers looking to buy, a few firms are betting **video opinions** will be the next driver. ExpoTV has built a business on aggregating videos of its users reviewing products-so far they have more than 13,000 on the website. The beauty of it, said CEO Daphne Kwon, is that the reviews aren't anonymous: ``If you find someone who's maybe like yourself or very credible, it's very effective.'' Wiki-style buying guide ShopWiki also offers user-generated video reviews, but so far the volume of them appears more limited.

Where you'll find it: ExpoTV syndicates its reviews to places such as GoogleVideo and AOL Video and on VOD with cable operators such as Comcast, Time Warner and Charter. A greater number of categories and videos are available online, only because the VOD platform is limited in the type of searching it can do. But the big growth opportunity for video reviews lies in the search engines integrating video and text-something largely considered inevitable.

Why people upload: There are monetary incentives. ShopWiki is offering $50 each for the first 500 videos it accepts. ExpoTV will run similar promotions, paying $10 for a video, and has had a refer-a-friend bonus. Its sustainable payment model, however, is a play-for-pay one-1[#x203a] every time a video is played.

The ad angle: **Video opinion** sites will be mostly ad-supported on a cost-per-click basis. Right now ExpoTV boasts some direct marketers who are making videos, all of which the company marks as advertisements. ``We're inviting advertisers to join the word-of-mouth conversation,'' said Ms. Kwon. ``We believe that if a user is coming and looking for a Dell laptop that if Dell has something in a longer format video the user might value that.'' Soon, she hopes the advertising will evolve into a click-to-buy model.

**LOAD-DATE:** October 25, 2006

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Chicago Daily Herald

October 15, 2006 Sunday
Lake Edition

**SECTION:** NEIGHBOR; Pg. 1

**LENGTH:** 282 words

**HEADLINE:** Justin Gorson's got a gift for gab about PC gaming

**BYLINE:** Georgia Evdoxiadis, Daily Herald Staff Writer

**BODY:**

Your mom may have told you that playing video games was a waste of time.

But for Justin Gorson, it was his affection for PC gaming that helped win him a high-definition, flat-screen Sony TV and surround- sound speaker system.

Gorson, a 23-year-old Hawthorn Woods resident, recently entered an online contest to post a **video opinion** and found himself one of the grand-prize winners.

"I thought I'd try my hand at reviewing," said Gorson of his decision to enter the ExpoTV contest with his thoughts on "Prey", a personal computer game.

As a result of Gorson's win, his **video opinion** also will be featured on the Comcast On Demand network.

"Justin is a perfect example of someone who is really able to convey what he liked or didn't like," said Daphne Kwon, ExpoTV's chief executive officer, about why Gorson's opinion stood out. "He's a great guy and we were really pleased."

Gorson, who attends Illinois Weslyan University in Bloomington, says he will eventually bring the TV-speaker combo home. But first, he plans to set it up for some serious gaming with his brother and college friends.

"I'm gonna have to bring it to school for a while," he said with a laugh.

Gorson named "Final Fantasy 7" as his all-time favorite video game.

"My brother and I have spent many hours playing that game," he said. Gorson said his grandmother first started his fascination with video games when she bought Super Mario Bros. 3 for him and his brother.

At school, Gorson majors in business management and says he's considering a future in intellectual property law, where he can put his interests to use.

"If there's an opportunity into the gaming field, I'd love to (get involved)," he said.

gevdoxiadis@dailyherald.com

**LOAD-DATE:** October 20, 2006

6 of 26 DOCUMENTS

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Deseret Morning News (Salt Lake City)

September 30, 2006 Saturday

**LENGTH:** 514 words

**HEADLINE:** Gaming leads to big prize

**BYLINE:** Jeremy Twitchell Deseret Morning News

**BODY:**

PROVO -- Remember wishing as a kid that someday you could get paid to play video games?

Provo resident Dan Chan may not yet have figured out how to draw a paycheck for pursuing his electronic hobby, but the home theater system he recently won for doing so will probably do for now.

Chan, an electrical engineering/pre-med major at Brigham Young University, was one of five grand prize winners in a contest sponsored by Gamepro.com, an online video-game review site, and ExpoTV.com, an online consumer review site, to create a review of his favorite video game.

In exchange for his 3-minute review of "Battlefield 2: Armored Fury," Chan won a Sony high-definition, flat-screen television and a surround sound system.

"I was shocked," Chan said. "It was the first time I've won something significant, so I was excited."

Chan, who has been creating video reviews -- or "**videopinions**" -- since last November, couldn't pass up the opportunity when he heard about the contest.

"I decided to whip one up since I'm a college student and I do a little computer gaming," Chan said.

In his review, Chan used a "green screen" that allowed him to edit in game footage behind him as he spoke about the game, a trick no other entrant used.

Where did he get the high-tech green screen? His linen closet -- it was simply a green bed sheet. Fortunately for Chan, Carolyn, his wife and partner in making the **videopinions,** is a film major at BYU.

Representatives from ExpoTV.com said the use of the green screen was one of the main reasons Chan's entry was selected for a grand prize.

They said they weren't surprised when they saw Chan's entry because they had a lot of confidence in him to begin with. So much so, in fact, that when they announced the contest, they asked Chan to make a how-to video for other contestants to check out.

"We love Dan and we feel like we know who he is, because we know what he looks like, we know what kind of clothes he wears," ExpoTV.com CEO Daphne Kwon said. "He's been really supportive of what we're trying to do ... he's the perfect example of the consumer voice and he's one of the best we have out there."

Kwon said the idea behind the 2-year-old company is to give consumers a chance to voice their opinions and give others a chance to get informed, independent opinions when shopping for an item.

The company's Web site, www.ExpoTV.com, lists consumer reviews of everything from arts and crafts to travel. Chan's winning entry, as well as the other four grand prize winners, are available for viewing at the site.

"(The **videopinions)** are all real quality, thoughtful and authentic," Kwon said. "And they're really sincere, because you have to put your face on it."

And Chan, who has done more than 30 **videopinions** in the past year, plans to be putting his face on more.

"The cool thing about it is they're online and easy to see," Chan said. "When you're looking at a product, it's nice to get a third-party opinion from someone who isn't influenced by the company ... it's an interesting, novel approach, and it's really taking off," he said. E-mail: jtwitchell@desnews.com

**LOAD-DATE:** September 30, 2006

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September 8, 2006 Friday
ALL EDITIONS

**SECTION:** NEWS; Pg. 003

**LENGTH:** 329 words

**HEADLINE:** `Survivor' star defends battle of the races

**BYLINE:** By SEAN L. McCARTHY

**BODY:**

Can a TV show celebrate ethnic pride by promoting racial divisions?

Host Jeff Probst defended the controversial premise of the upcoming ``Survivor: Cook Islands" (premiering Thursday at 8 p.m. on WBZ, Ch. 4) that calls for the separation of 20 contestants into four groups: white, black, Hispanic and Asian.

``I think when most people hear the idea, the first reaction is to flinch a little bit. It's a sensitive subject," Probst said in a conference call yesterday with reporters.

In previous seasons, producers have separated tribes by age and gender.

But dividing by race and ethnicity has prompted everything from outcries by advocacy groups to

cheers from white supremacists.

Viewers should give the show a chance, Probst said. ``You have to recognize you're condemning our show before you've seen it,'' he said.

The show has played up its racial politics both through TV ads and online, asking fans on the ``Survivor'' Web site to submit **video opinions** on the upcoming season.

Probst said he and producer Mark Burnett knew ``Survivor'' would need a trick to stay competitive in its Thursday night time slot. At first, they intended to answer critics of the show's lack of diversity by merely casting 20 people of different ethnicities.

``We actually felt dividing them ethnically was a positive idea, because it came from our discussions with them in casting,'' Probst said.

They also thought increasing the number of minorities might attract new viewers. Probst acknowledged that ``Survivor'' is mostly a white show watched by white people, with whites submitting more than 80 percent of the applications each year.

In the second episode, one tribe argues about whether they're perpetuating racial stereotypes, said Probst, declining to talk further about how race plays into the results.

``It wouldn't surprise me if people are rooting initially based on ethnicity,'' he said. ``At the end of the day, I think you'll be rooting for people you like.''

- slmccarthy@bostonherald.com

**LOAD-DATE:** September 8, 2006

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Kansas City Star (Kansas & Missouri)

June 19, 1996 Wednesday JOHNSON COUNTY EDITION

**SECTION:** ZONE/SHAWNEE MISSION; Pg. 3

**LENGTH:** 369 words

**HEADLINE:** Students view life from both sides of camera

**BYLINE:** ROBERTA JOHNSON, Staff Writer

**BODY:**

Mike Derting belted out the directions to his crew:

"Look behind you. Still look behind you OK. You're

caught," he said, motioning to the others. "Act like you're putting him on the ground."

Derting laid on the floor and zoomed the camera into the captured student's face.

"It's a wrap," the recent Shawnee Mission South graduate said, getting off the floor.

Derting, who was filming the opening scene to the students' news magazine show, works as a teaching assistant in the Broadcast Explorers class through the summer enrichment program at South, 5800 W. 107th St.

The class has been offered several years and is popular enough that an advanced course will be introduced later this summer.

Broadcast Explorers, which is open to students in the fifth through eighth grades, is taught by South's broadcast and forensics teacher, Cathy McNamara.

During the week, the students will design, tape and edit their own TV show. They'll interview staff and students in the summer enrichment classes for K-SEN, the Summer Enrichment Network. Although they won't get to show off their work for all the enrichment classes, a videotape of the news programs will be in the lobby of the school, McNamara said.

"I like to be on TV," said news anchor Amanda Hays, a seventh-grader at Westridge Middle School. "We got to tape (yesterday) and today, and I get to do the **video opinion** poll."

Many students were excited about the idea of being on camera.

"It's fun to use our imagination and interview people," said anchor Rachel Paradise, a sixth-grader at Sunflower Elementary.

But a few said they like the work behind the scenes better and were interested in taking the advanced class next month.

"I'm really interested in how to take good videos of things," said reporter Adam Fichman, a sixth-grader at Leawood Middle School, who liked to work with the video equipment. "Whenever people come over with their tapes, they have all this stuff in between the things they want to shoot.

"I think the class could teach me more and help me learn more. I like editing and stuff."

**GRAPHIC:** Photo (color), Eleven-year-olds Rachael Berlau and Rachel Paradise have fun pretending they're real life news anchors for KSEN or the Kansas Summer Enrichment News, during their broadcasting class at Shawnee Mission South High School. The class is one of many offered in the Shawnee Mission District's summer enrichment program.; DAWN VILLELLA/The Star

**LOAD-DATE:** June 19, 1996

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Los Angeles Times

July 25, 1991, Thursday, Home Edition

**SECTION:** View; Part E; Page 1; Column 2; View Desk

**LENGTH:** 1975 words

**HEADLINE:** PRIVATE EYES;
MAKING A HOME VIDEO HAS BECOME SO EASY THAT NOTHING IS TOO MUNDANE OR TOO WEIRD FOR TAPE.

**BYLINE:** By GERALDINE BAUM, TIMES STAFF WRITER

**DATELINE:** NEW YORK

**BODY:**

For a moment, put aside the grainy scene of Los Angeles policemen bloodying a lone black man while a bystander records every tragic blow with his new video camera.

Forget the chaos in Detroit on the Fourth of July when a man at a fireworks display randomly videotaped a girls' gang beating up two bystanders.

And briefly put aside Newsweek, which coined "video vigilantes" last week to describe common folk with camcorders who capture the spectacular and send it overnight to CNN.

In other words, forget the important, insistent or socially unjust and for just a second think about yearbooks, doorbells, treasure hunts, camp counselors, grandma's strudel, diaries, funerals, stag parties, employee training.

And Boy Scouts. It is now possible for scouts to earn a merit badge for video production just the way they can for rubbing two sticks together to start a fire. It is also now a snap for Mina Johnson, a fledgling Los Angeles screenwriter, to depict her life on video the way Jane Austen might have portrayed a young woman unraveling her thoughts by writing in a diary.

For each of the last seven years, Johnson, 27, has made a one-hour video of herself comfortably sunk in a chair and rambling about her life. She never watches these 1/2-inch video diaries; rather, she says, she'll wait 30 years to take a look.

"I think of this as a tool to show my kids when they're older, the stages their mother went through," says Johnson, who has no children yet. "I want it to kind of explode in my brain when I see who I was."

In the last few years, the ability to make a home video has become so easy that it seems nothing is too mundane, too routine, too personal, too complicated or too weird to be scrutinized by a camcorder -- the camera that sees and hears all, no matter how dark the scene, how quiet the sound.

With each generation, the camcorder gets smaller, lighter, easier to operate and more affordable. With an $800 camera, a hobbiest can now produce quality video similar to what professionals produce with $50,000 worth of equipment. The same goofy family scenes that cost $7 for a minute of film (Remember the stuff that had to be threaded through the projector while someone put up the screen and turned off the lights?) now cost $2 for hours of instant record-and-review video tape.

Nearly one in six American families owns a camcorder, compared to the Stone Age -- 1985 -- when one in 30 had one. That year, a mere half-million camcorders were sold; this year, the consumer electronics trade group predicts sales of 3.3 million.

Tom Weinberg, executive producer of "The 90s" -- a critically acclaimed show on PBS that airs collages of home videos made by amateur producers around the country -- says we are again outwitting ourselves with technology that is changing our perspective on the world.

"Now that camcorders are so available, television has a different credibility factor because very little of what we see on TV now doesn't pass the test of 'I could have done that myself,' " says Weinberg.

A self-described "grizzled video veteran," Weinberg was among a small group of 1970s documentary makers who called themselves "video freaks" and used 30 pounds of equipment to produce shows about the national political conventions.

"Now, everywhere, people use video to express an opinion, and shows like mine and 'America's Funniest Home Videos' are growing in popularity because the viewer looks at the tape and says, 'I believe what I see because it's not filtered through some TV programmer. I believe *this* is reality.' "

Ubiquitous and persistent, the videomakers, camcorder operators, video artists -- whatever you want to call them -- constantly find new reasons to transfer life's realities onto High 8. (That's videospeak for high-resolution 8-millimeter videotape.)

People use these hand-held or shoulder-schlepped devices to get rich, get famous or just embarrass each other. There's the camp counselor who has become an entrepreneur by recording his campers and selling tapes to parents at summer's end. And there's the young woman who could never get her grandmother to write down her strudel recipe. She made a video with close-ups of grandma's knobby hands and her accented instructions to "use a pinch of this and a handful of that."

There are also the mean-spirited, those who play dirty tricks on animals and make a whole show of them. And there are the good citizens: A man in Southern California wanted a stop sign on a wickedly dangerous corner, so he spent days video taping near-accidents. After he turned his tapes over to his city council, a stop sign was erected.

Birth to death, the action is on video.

Actors Demi Moore and Bruce Willis had three video cameras rolling during the delivery of their first child -- with Moore pushing, Willis catching and a few friends watching.

The last moments of a person's life are also available on tape. A woman called the editor of Videomaker magazine and asked what would be the best equipment to capture her dying daughter's last days. Funeral directors in some cities offer to tape ceremonies following the coffin all the way to graveside.

And what about sex?

Yes, America has long been going at it in front of a camcorder atop a tripod, reviewing the tapes, showing them to friends, playing them back as another avenue to find variation and contrast. Some label this homemade erotica as pornography; others say it's as wholesome as buying sexy lingerie for the wife. In a mall.

In fact, people are so used to the *cinema verite* look produced by home videos -- the grainy scenes

shot at funny angles -- that professionals borrow it to make advertisements and movies.

A whole generation is so used to seeing itself on television that for some young people, there is a blurring of the lines of where the signal comes from, according to Leo Braudy, author of several books on popular culture and the Leo S. Bing professor of English at USC.

Braudy says his oft-videoed 3-year-old grandson, a rock 'n roll aficionado, spontaneously jumped on stage to perform with a mariachi band while vacationing in Mexico. Says Braudy: "The video camera is so often there, it creates a self-consciousness, the sense that we're always being looked at. It's a way to create a more perfect self."

Videography has gone so far beyond Jane Fonda's relentless smile and taut diaphragm that there is even a man out there making money selling videos that demonstrate how to lay asphalt on the front walk.

A Nashville, Tenn., firm is one of several that produces video yearbooks to give a graduate 30 minutes of memories for $40. A Cincinnati firm has pioneered one of the dozens of ways video cameras are used for surveillance: The Ohio company sells "video doorbells" so visitors can be spied on before they're invited beyond the front door.

There are contests, festivals and support groups for camcorder operators as far and wide as Atlanta, Los Angeles and Carbondale, Ill. Scott Blumberg, a New York videographer, travels around the country organizing "treasure hunts" for amateurs to teach them how to better use video equipment often complicated by attachments. He creates teams of 10 people, gives them lists of things to record -- for example, "someone laughing all the way to the bank" -- and judges the results.

"There's a lot of frustrated producers and directors out there who are just sick of recording the kid's birthday party," says Blumberg.

Yet, studies show most camcorders are used for such nostalgic moments as a first haircut, first spin on a two wheeler, baptism or bris. There are also mountains of tapes of inanimate moments: the Eiffel Tower at sunrise, Maui at sunset.

During the Persian Gulf crisis, camcorders also went to war. For the first time, broadcast journalists used the lightweight, discreet equipment in the field; the networks also handed out camcorders on the Kuwaiti border to people sneaking back during the Iraqi occupation.

As well, 450 camcorders, 350 televisions, 370 VCRs and 250,000 blank videocassettes were sent free to soldiers in Saudia Arabia as part of the "Better Than a Letter" program. The soldiers were encouraged to "write" five-minute programs and send them home. Montgomery Ward also loaned VCRs to families who didn't have them and wanted to "read" their video mail.

Manufacturers constantly look for new niches in the home video market. News accounts say Sony first shrunk the shoulder-carried camcorders to palm-sized in the early 1980s primarily to attract a new consumer group.

In addition to new parents -- who seem to think camcorders are as critical as cribs -- Sony wanted to entice younger consumers to take the smaller 1.5-pound camera on vacation. And so goes the Handycam advertisement: "Something happens between the milestones. Between the weddings and the birthday parties. It's called the rest of your life."

Critics like Neil Postman, a professor of media ecology at New York University, believe we are numbing ourselves by recording our lives instead of actually living them: "If it wasn't videoed, it didn't happen? Isn't that the way it goes?

"It's almost as if reality itself is not satisfactory if it's not recorded," he says, launching into a favorite fable about two little old ladies pushing baby carriages in the park. One looks at the other's grandchild and says, "Oooohh, he's such a cute baby." The other responds: "I have even cuter pictures at home."

Postman calls the video invasion downright evil.

"You take a picture of a baby to remember what he or she looks like -- that enriches life," he says. "But do you lug around a camcorder wherever you go to confirm that you actually went some place, taking endless pictures and then never looking at them again? . . . It's frightening. All this snooping, all of us looking at each other and ourselves. It makes you feel remote."

But Matt York sees a different reality.

"Empowerment," the 34-year-old publisher of Videomaker magazine says, almost dreamily. "Camcorders today are more like what paper and ink were 10 years ago, when anybody who was literate could express their spiritual or political feelings on paper. Now, people use videos to get on television. There are more and more outlets that provide more power to the individual."

After failing to make a career in New York City as a video producer, York started publishing Videomaker in 1986 in Chico, Calif. He has 75,000 readers, he says, mostly people who own camcorders for more than a weekend hobby. The magazine focuses on the equipment and how to use it. But the most frequent features are on people who use video to help society -- to teach children, illuminate the public about social ills, create art.

A recent article recounted how a consortium of peace groups became frustrated with network news coverage of the Gulf War. They solicited **video opinions** from groups nationwide, received 100 responses and then culled them, broadcasting four short programs on cable and PBS stations.

"Increasingly, you'll see raw footage by an individual getting into homes of America," says York.

Which comes back to hordes of so-called video vigilantes using their cameras as tools of communication and democracy. Or to spy on their neighbors.

At least one Tampa man thinks it's undemocratic. He and his girlfriend were arrested last week on charges of lewd and lascivious behavior around children after a neighbor videotaped them having sex in their hot tub.

"It seems almost communistic, being arrested at your own house for having sex," said Alfred Stephens, the man caught *au natural.* "It amazes me that someone had the audacity to actually videotape this."

So what would "1984" author George Orwell think of all this now?

Big Brother is watching us and we are watching him.

But mostly we are watching each other.

**GRAPHIC:** Photo, Screenwriter Mina Johnson uses her camcorder as a diary: "I think of this as a tool to show my kids when they're older, the stages their mother went through." ELLEN JASKOL / Los Angeles Times; Photo, COLOR, (Orange County Edition) Screenwriter Mina Johnson uses her camcorder as a diary: "I think of this as a tool to show my kids when they're older, the stages their mother went through." ELLEN JASKOL / Los Angeles Times

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In re Visual Analytics, Incorporated

Serial No. 76465520

Trademark Trial and Appeal Board

2005 TTAB LEXIS 318

July 27, 2005, Mailed

[*1]

Before Quinn, Walters and Bucher, Administrative Trademark Judges.

**COUNSEL:**

Peter J. Willsey and Adam L. Barea of Cooley Godward for Visual Analytics, Incorporated.

Anne Madden, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

**OPINIONBY:** WALTERS

**OPINION:**

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Walters, Administrative Trademark Judge:

Visual Analytics, Incorporated has filed an application to register on the Principal Register the mark **DATALERTS** for "computer software that monitors changes and additions to information in databases and provides automatic notification to users of changes and additions to information in databases," in International Class 9. n1

n1 Serial No. 76465520, filed October 30, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was [*2] not requested. We affirm the refusal to register.

Preliminarily, we note the examining attorney's objection to Exhibits A and D submitted by applicant with its brief on the ground that this matter is untimely. Applicant did not file a reply brief and, so, did not respond to this objection. The examining attorney does not object to Exhibits B and C to the brief because they are copies of the previously submitted dictionary definitions of "data" and "alert." Exhibit A is a printout from applicant's website that is different from the printout submitted during prosecution of the application. As such, it is untimely and has not been considered. Exhibit D consists of

copies from the USPTO database of four third-party registrations. Three of the third-party registrations were listed in applicant's response of October 20, 2003, and, as such, we find that the submission of the actual copies of these registrations is acceptable. Not only did the examining attorney have notice of these registrations, but she did not object to the mere listing of the registrations by applicant in the October response. However, we have given no consideration to the copy of Registration No. 2192630, which was not [*3] previously listed by applicant in its response and, thus, is untimely.

Turning to the substantive refusal in this case, the examining attorney contends that the mark is a telescoping of the two words DATA and ALERT; that the telescoped mark merely describes a significant feature of the identified goods, namely, that applicant's software "processes data and information [and] send[s] notifications or alerts to defined users when a particular event occurs to change data in a database" (brief, p.4); that purchasers will understand that this "is a positive feature and the primary function of the software" (brief, p. 5); and that the combination of the two descriptive terms DATA and ALERT into **DATALERT** creates no incongruity and the mark remains merely descriptive.

Applicant contends that the mark as a whole creates a unique commercial impression different from the individual terms; that the term is not commonly used in this field nor does it possess a common meaning in any field; that competitors have no need to use applicant's mark descriptively; that the mark is, at most, suggestive; and that any doubt should be resolved in favor of publication of the mark.

Both the examining attorney [*4] and applicant have submitted definitions of the individual terms "data" and "alert." We note, of most relevance, the definition from *The American Heritage Dictionary of the English Language* (4<th> ed. 2000) n2 of "data" as "1. factual information, especially information organized for analysis or used to reason or make decisions [and] 2. *computer science* numerical or other information represented in a form suitable for processing by computer" and of "alert" as *"adjective* -- vigilantly attentive; watchful [and] *noun* -- a signal that warns of attach or danger"; and from *TechEncyclopedia,* an online dictionary, a definition of "alert" as a "sound or visual signal that indicates that some predefined event has occurred or some error condition has occurred[;] the terms alert and alarm are often used synonymously."

n2 As downloaded from Internet website bartleby.com on July 23, 2003.

Also in the record are excerpts submitted by applicant from its website wherein applicant makes the following statements *(emphasis added)*:

> **DATAlerts!** (Rules and Alerts) is a monitoring and notification system that automatically notifies defined users when a particular event occurs. [*5] **DATAlerts!** is fully configurable allowing users to define the events that trigger notification. **DATAlerts!** sends notices, through push technology, to **alert** individuals of **data** changes.
>
> The **DATAlerts!** Rules and Alerts can be set up to notify specific users whenever new information is entered into a database, a specific type of data is modified, or a scheduled service returns results.

The examining attorney submitted excerpts from a representative sample of articles retrieved from the Lexis/Nexis database. The following are several examples:

> The Searchspace system combines both human and data-mining rules to generate risk **alerts** at the individual, national, relationship or organizational level. [*Software Development,* May 4, 2004.]
>
> The SEM server then aggregates and correlates the **data** to provide a meaningful look at

events within the environment. It can also archive the data, send out **alerts** and report on events, trends and usage. [*ComputerWorld,* April 5, 2004.]

*Headline:* "An inside look at how one of Symantec's security operations centers protects clients from cyber attacks."

Hillyard stares at a row of computer screens, all of which display [*6] a software application known as the Analyst Response Console (ARC). The color-coded user interface provides **alerts and data** to help analysts focus on the most critical events at any given moment. [*ComputerWorld,* March 29, 2004.]

The examining attorney submitted copies of eight third-party registrations for software products. Four of the registered marks include the disclaimed word "data" and the other four registered marks include the disclaimed word "alert." Applicant submitted copies of three third-party registrations for software or related products. Each is a telescoped mark, PDALERT, DERMALERT and AQUALERT, and none include disclaimers of the word "alert." Prior registrations do not control our determination in this application. *In re Nett Designs, Inc.,* 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We must consider each application on its own merits based on the record in that application and *current* circumstances. *In re Sun Microsystems Inc.,* 59 USPQ2d 1084, 1088 (TTAB 2001). Furthermore, examining attorneys have wide discretion in requiring disclaimers. TMEP § 1213.01(a). In [*7] many instances USPTO policy directs examining attorneys not to require a disclaimer of a particular descriptive term, such as, when the descriptive term is part of a unitary mark. See, e.g., TMEP § 1213.05. Therefore, the presence or absence of a disclaimer in a particular registration does not necessarily indicate whether or not the USPTO considered a term merely descriptive, even at the time the particular application was examined. We find the third-party registrations submitted by the examining attorney and applicant are of little, if any, probative value.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp., 2* USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.,* 204 USPQ 591 (TTAB 1979). 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 [*8] quality, feature, etc. *In re Venture Lending Associates,* 226 USPQ 285 (TTAB 1985). The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.,* 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We agree with applicant that we must consider whether the mark as a whole is merely descriptive and not just the individual elements, *In re Oppedahl & Larson LLP,* 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004). However, it is reasonable to look, first, at the individual terms, "data" and "alert." Regarding the term "data," applicant expressly states that it "does not dispute that data' would be understood by a consumer to relate to computer information" (brief, p. 9). Regarding the term "alert," applicant relies on the definition of "alert" as "a signal that warns of attack or danger" to argue that this is a vague term in connection with software. However, we find the evidence of record, including the examining attorney's dictionary definition [*9] of "alert," applicant's own website and the excerpted articles, clearly establishes that "alert" in the context of applicant's goods would be understood as a synonym for "notify." Further, the evidence clearly establishes that the term "data alert" would be merely descriptive of a significant feature of applicant's software, namely, that it is designed specifically to "alert" users to changes that have occurred to information, or "data," in the user's database.

Applicant's argument that consumers would think that the software is a form of data protection against cyber attacks is not well taken. The identification of goods specifies the exact nature of the software and the question we must consider is whether someone who knows what the goods are will

understand the mark to convey information about those goods. *In re Tower Tech Inc.,* 64 USPQ2d 1314, 1316-17 (TTAB 2002); see *also In re Patent & Trademark Services Inc.,* 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville,* 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation,* 226 USPQ 365 (TTAB 1985). [*10]

We find that the individual terms "data" and "alert" as well as the composite term "data alert" are merely descriptive in connection with the identified goods because the terms describe the above-mentioned feature whereby the software alerts users to changes in data contained in their databases.

However, we must go one step further and consider whether the telescoped term **DATALERT** is merely descriptive. This turns on the question of whether the telescoping of "data" and "alert" evokes a new and unique commercial impression.

Applicant makes the following statement in support of its position that the telescoped mark creates a unique impression (brief, p. 9):

> . . . Upon encountering applicant's mark, a consumer would first have to recognize that applicant's three-syllable **DATALERTS** is suggestive of the four-syllable, different-sounding phrase "data alerts." **DATALERTS** is not simply the mere juxtaposition of the terms "data" and "alerts." Rather, **DATALERTS** is a unique combination of these two terms, whereby the second "A" in "data" and the "A" in "alerts" are shared, creating a suggestive mark possessing one less syllable than the compound term "data alerts."

It is true that a [*11] prospective purchaser may pronounce **DATALERTS** as a three-syllable word. However, 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, and it is equally likely the viewer may automatically supply the missing "A" and pronounce the term as "data alerts." The telescoping creates no double entendre or unique characteristic that results in the telescoped mark **DATALERTS** being somehow more than a merely descriptive combination of the two individual words "data" and "alerts." This is not a situation where the goods are encountered under a mark wherein a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, which would render the mark suggestive. See *In re Abcor Development Corp.,* 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Atavio,* 25 USPQ2d 1361, 1362 (TTAB 1992). Nor do we have any doubt that this mark is merely descriptive in connection with the identified goods. *In re Atavio, supra* at 1363. [*12]

In conclusion, when applied to applicant's goods, the term **DATALERTS** immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, as described above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term **DATALERTS** as it pertains to applicant's goods.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawSubject MatterDescriptive & Laudatory TermsGeneral Overview

*Decision:* The refusal under Section 2(e)(1) of the Act is affirmed.

## Note:

**In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 5 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:**

Email 1 includes the following 7 attachments
1. vop-1
2. vop-2
3. vop2
4. vop3-1
5. vop3-2
6. vop4-1
7. vop4-2

Email 2 includes the following 7 attachments
1. vop5-1
2. vop5-2
3. vop5-3
4. vop6-1
5. vop6-2
6. vop7-1
7. vop7-2

Email 3 includes the following 11 attachments
1. vop8-1
2. vop8-2
3. vop9-1
4. vop9-2
5. vop9-3
6. vop10-1
7. vop10-2
8. vop10-3
9. vop12-1
10. vop12-2
11. vop13-1

Email 4 includes the following 12 attachments
1. vop13-2
2. vop14
3. vop15-1
4. vop15-2
5. vop15-3
6. vop15-4
7. vop15-5
8. vop15-6
9. vop15-7
10. vop15-8
11. vop15
12. vop16-1

Email 5 includes the following 1 attachment
1. vop16-2

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

# EXHIBIT C

LEXSEE 2006 TTAB LEXIS 85

In re Epigenomics AG n1

n1 The application was originally filed by Epigenomics GmbH and a change of name to Epigenomics AG was subsequently recorded at Reel/Frame No. 2699/0960.

Serial No. 76089226

Trademark Trial and Appeal Board

2006 TTAB LEXIS 85

March 14, 2006, Mailed

[*1]

Before Hairston, Drost, and Zervas, Administrative Trademark Judges.

**COUNSEL:**

Edward M. Kriegsman of Kriegsman & Kriegsman for Epigenomics AG.

Glenn Clark, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

**OPINIONBY:** DROST

**OPINION:**

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Drost, Administrative Trademark Judge:

On July 14, 2000, Epigenomics AG (applicant) applied to register the mark 5TH BASE GENOMICS, in standard character form, on the Principal Register for the following goods and services:

> Diagnostic reagents for scientific purposes including forensic examination; diagnostic test kits for scientific purposes, consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit in Class 1.
>
> Diagnostic reagents for medical purposes for diagnosing inflammations, infections, diseases of the central nervous system, heart, circulation, neurologic, endocrine, autoimmune and genetic diseases and cancers, consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit; medical diagnostic comprising reagents, working [*2] solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit, for determining the presence of pathogens in the environment in Class 5.
>
> Laboratory equipment, namely, an apparatus for testing a sample, for demonstrating the presence of analytical elements in samples and to determine types of samples in connection with distribution patterns and an apparatus for the production of a series of mole biological data and parts thereof in Class 9.
>
> Providing multiple-user access to the Internet in Class 38.

> Research and development services for third parties in the field of diagnostic chemicals, forensic methods, compositions and devices, measuring apparatuses for use in product research and development, in methods for preparation and purification in water treatment plants; methods for testing the environment and determining industrial quality; chemical separation analysis and diagnosis, forensic and medical genetics testing for third parties; computer programming for others in the field of data processing; computer services, namely, providing a searchable database in the field of DNA-related data on a global computer network in Class 42.

[*3]

The application is based on applicant's claim of priority under 15 U.S.C. § 1126(d) because of its ownership of German application No. 300 04 091.1/42 filed January 14, 2000, and on its ownership of German registration No. 300 04 091 issued April 17, 2000.

The examining attorney refused registration on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because:

> The term "5TH BASE" is a commonly used term in the field of genomics. Based on the information provided in the applicant's web site, it is clear that the term "5TH BASE" immediately names and describes a specific molecule, methylated cytosine ("mC"), that forms DNA and RNA molecules. The applicant's goods and services will be used to modify or change this "5TH BASE" in the DNA to treat certain complex diseases to which the identified goods and services relate.
>
> Brief at 5.
>
> Applicant, in turn, argues (Brief at 6):
>
> Applicant notes, for example, that none of the recited goods contains "5th bases."
>
> Similarly, with respect to the term "genomics," the Trademark Examining Attorney has [*4] failed to explain how "genomics" conveys anything meaningful about the recited goods and services. At best, all the Trademark Examining Attorney has done is to conclude that the recited goods and services "will be used in the field of genomics.'"
>
> Applicant notes that none of the search results provided by the Trademark Examining Attorney have disclosed the mark, **as a whole**, or have shown the mark, as a whole, being used to describe the recited goods/services.
>
> In addition, Applicant notes that, to the best of its knowledge, 5TH BASE GENOMICS is being used exclusively by Applicant.

When the examining attorney made the refusal final, applicant appealed to this board.

A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service." In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). See also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). [*5] We consider descriptiveness of a mark in the context of the particular goods or services for which registration is sought and not in the abstract. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). A mark need only describe a single significant quality or property of the goods in order to be descriptive. Gyulay, 3 USPQ2d at 1009. In addition, we must consider the mark in its entirety. P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 545-46 (1920). However, "it is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof . . . provided that the ultimate determination is made on the basis of the mark in its entirety." In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986).

We begin our discussion of the descriptiveness issue by considering the evidence that the examining attorney has made of record. The examining attorney has included a definition of "genomic" as "Genetics. Of or relating to the genome." *Academy Press Dictionary of Science and Technology.* First [*6] Office Action, attachment. The examining attorney also included evidence from the Internet concerning the term "Genomics."

*Cambridge Healthtech Institute's Fifth Annual Impact of Genomics on Medicine [2002 Program]* . . . Genomic information is being applied as a critical component of drug development strategies for identifying therapeutic targets and for mapping out pathways of genes and proteins to gain a comprehensive view of biology. This meeting will look into the technologies underlying proteomics, gene expression, and functional genomics as well as applying genomics to overall strategies in drug discovery.

The examining attorney also submitted numerous trademark registrations in which the word "genomics" was used in the identification of goods and services or in which either the term "genomics" is disclaimed or the mark is registered on the Supplemental Register. "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." Institut National Des Appellations D'Origine v. Vintners International Company, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). [*7] Several examples are set out below.

Registration No. 2,644,582 -- INVERSE GENOMICS ("Genomics" disclaimed) for, inter alia, scientific research and development relating to the discovery and validating of drug target genes

Registration No. 2,737,705 -- BEYOND GENOMICS ("Genomics" disclaimed) for, inter alia, chemicals and software for use in genomics

Registration No. 2,694,203 -- GENOMICSCOLLABORATIVE (Supplemental Register) for, inter alia, collecting and storing biological samples in the field of genomics

Registration No. 2,637,715 -- PHYSIOLOGICAL GENOMICS (Supplemental Register) for, inter alia, publications in the field of genomics

Registration No. 2,384,178 -- ORION GENOMICS LLC and design ("Genomics LLC" disclaimed) for, inter alia, consultation and research services in the field of structural and functional genomics

Registration No. 2,475,197 -- WE TAKE GENOMICS PERSONALLY. ("Genomics" disclaimed) for, inter alia, genomic and bioinformatics services

Registration No. 2,348,435 -- CG CLEVELAND GENOMICS and design ("Cleveland Genomics" disclaimed) for DNA sequencing

Registration No. 2,193,432 -- APOCOM CLIENT TOOL FOR GENOMICS (ACTG) ("Client Tool for Genomics [*8] (ACTG)" disclaimed) for computer software for locating genes for DNA sequencing

We also note that, from applicant's website, the following definitions were provided:

Genome:
The genome is the total DNA of a species. Since all the DNA is wrapped up in chromosomes, the number of chromosomes is characteristic for a species, for example 23 in humans.

Genomics:
The science and commercial exploitation of genomes and the function of genes.

Furthermore, applicant is described as follows (http://informagen.com):

Epigenomics is a young, growth-oriented biotech company, offering a unique technology platform. Epigenomics aims at introducing the first routine diagnostics based on molecular biology for complex genetic disease into clinical reality on a global scale. Epigenomics pioneers the massive collection of epi-

genetic information for a description of cells and individuals by digital phenotypes.' With its technology Epigenomics will be a leader in the revolution towards tomorrow's personalized medicine.

Therefore, the evidence shows that applicant is operating in the field of genomics to the extent that its goods and services use, locate, or develop a database of genomic information. [*9]

Regarding the term "Fifth Base" or its numerical equivalent "5TH Base," the examining attorney has supplied several references to explain that the term 5TH Base is merely descriptive. At the EpiGenx Pharmaceuticals website under "EpiGenx in the News," there is an entry entitled "Epigenetics, Methylation, and DNA's mysterious 5th base" that goes on to explain: "Epigenetic mechanisms are implicated . . . DNA methylation holds the key to understanding these changes."

The Glossary section from applicant's website contains the following information:

5th BASE genomics(R)
Cytosine, one of DNA's four bases, can also be present in a methylated version (mC). It then has an important impact on gene activity, which is why it is being acknowledged as DNA's fifth base. Each cell contains the entire genome, but only uses a subset of it according to its function (e.g., a liver cell switches on different genes than a skin cell). In complex genetic diseases such as cancer, cardiovascular, or autoimmune, different genes are active than in healthy cells, with each disease featuring a characteristic pattern of active and inactive cells. Reading the pattern of mC in DNA in the first place and correlating [*10] it to disease is what we named 5th BASE genomics(R) and what opens up fundamentally new diagnostics and therapeutic opportunities.

DNA (Desoxyribonucleic acid):
The carrier of genetic information for all complex organisms. DNA is shaped like a twisted step-ladder -- the famous "double helix." The genetic information consists of nucleotide bases bound to a sugar-phosphate-backbone and is carried on the rungs of the ladder. As yet, only four bases were known: adenine (A), cytosine (C), guanine (G); [and] thymidine (T). Now, it is becoming clear that there is a fifth: When a methyl group is bound to C, cytosine, a very different base is produced with a dramatic effect on gene activity.

DNA-Methylation:
The DNA consists of the bases A, T, G, and C that encode an organism's genetic blueprint, but also the 5th base mC (methylated C), DNA methylation provides information on gene regulation that is specific for cell types and diseases, because cells can actively exchange C with mC when they switch genes off or on.

Epigenetic:
Unlike conventional belief, human DNA consists of 5 different bases: A, T, G, C, and the 5th base, methylated cytosine "mC."

The examining attorney also submitted [*11] the following excerpts from electronic databases.

The drug is known for its ability to keep DNA undermethylated. Methyl groups are known for their ability to keep genes turned off. In fact, of the four nucleic-acid bases -- adenine, cytosine, guanine, and thymine -- only cytosine accepts methyl groups and the resulting 5-methylcytosine is considered the "fifth base" in DNA.
*McGraw-Hill's Biotechnology Newswatch*, January 17, 1983

A little-known and long-neglected component of DNA is the focus of recently intensified research -- looking for keys to cancer, tissue regeneration, cell differentiation, and gene control. It's "the fifth base" on the DNA double helix, says Arthur D. Riggs, who heads up the biology department at the City of Hope National Medical Center here . . .

A fifth base, he recalls, is 5-methylcytosine (5-MeC), a variant of cytosine that makes up about 1% of the nucleotides in mammalian DNA. This minor base was first described in 1950 by Gerald R. Wyatt, a Canadian agricultural researcher . . .

> Altering a cell's expression by thus preventing formation of its "fifth base," 5-MeC, may some day have important effects on cancer and tissue regeneration in humans.
> [*12] *McGraw-Hill's Biotechnology Newswatch*, January 4, 1982

> Besides modulating specific DNA-protein interactions, methylated cytosine, frequently referred to as the fifth base of the genome, also influences DNA structure, recombination, repair, imprinting, and mutagenesis.
> *J Biol Chem*, Aug 4, 1995 (MEDLINE Database)

> The existence in eukaryotes of a fifth base, 5-methylcytosine, and of tissue-specific methylation patterns have been known for many years, but except for a general association with inactive genes and chromatin the exact function of this DNA modification has been elusive. The different hypotheses regarding the role of DNA methylation in regulation of gene expression, chromatin structure, development, and diseases, including cancer are summarized, and the experimental evidence for them is discussed. *Experienta* Dec. 1, 1991 (MEDLINE database)

From this evidence, we draw the following conclusions. First, the term "genomics" is a commonly used term that describes the exploitation of genes in the field of biotechnology, which is the field in which applicant operates. See Applicant's website included with Office action dated November 22, 2002. See also, [*13] "*Impact of Genomics on Medicine [2002 Program]* . . . Genomic information is being applied as a critical component of drug development strategies for identifying therapeutic targets and for mapping out pathways of genes and proteins to gain a comprehensive view of biology." The numerous registrations of record show that "genomics" is a term that is commonly disclaimed or registered on the Supplemental Register for goods and services in the area of biotechnology.

Second, the evidence of record shows that the term 5TH BASE is a merely descriptive term in the field of biotechnology. The term certainly was used prior to any date associated with applicant. One article indicates that the "Fifth base" was first described in 1950 by a Canadian researcher and articles between 1982 and 1995 refer to the "Fifth Base." These articles describe the "Fifth Base" in a similar way that applicant's website does, i.e., as a methylated version of cytosine. Cytosine, along with adenine, guanine, and thymine, are the four bases normally associated with DNA.

Third, we likewise find that when the terms are combined in the term 5TH BASE GENOMICS, the combined term is equally descriptive. "Methyl groups [*14] are known for their ability to keep genes turned off. In fact, of the four nucleic-acid bases -- adenine, cytosine, guanine, and thymine -- only cytosine accepts methyl groups and the resulting 5-methylcytosine is considered the fifth base' in DNA." *McGraw-Hill's Biotechnology Newswatch*, January 17, 1983. Applicant's website (emphasis added) similarly touts the same quality: "DNA methylation provides information on gene regulation that is specific for cell types and diseases, because cells can actively exchange C with mC *when they switch genes off or on.*" Furthermore, these "DNA methylation signals, comparable to a switch turning on or off individual genes, can be digitized to create a unique fingerprint for each cell." *Impacts of Genomics on Medicine*, Description of remarks by Dr. Alexander Olek, Epigenomics, p.8. Obviously, to the extent that applicant is involved with the science and commercial exploitation of the human genome and the function of genes that involve using methylated cytosine (the Fifth Base) the term would immediately describe its goods and services.

At this point we note that it is simply not sufficient to find that the term for which registration [*15] is sought is descriptive of something. We must, of course, consider the mark for which applicant seeks registration in relation to the goods and services set out in the application. The examining attorney makes the following argument (Brief at 10) regarding the mark in relation to the goods and services:

> The applicant will be marketing and developing novel diagnostic and pharmacodiagnostic products based on DNA methylation. These novel diagnostic and pharmacodiagnostic products are clearly the goods that are identified in International Classes 1 and 5. The laboratory goods are described in International Class 9, which will be used to develop and research the diagnostic and pharmacodiagnostic products. The word "genomics" also describes the functions, features, uses and subject matter of the applicant's communication services in International Class 38 and research and development services in International Class 42.

The examining attorney concludes (Brief at 12) by arguing that the "combination simply results in a term that is readily understood: the science and commercial exploitation of genomes and the functions of genes regarding DNA's

fifth base, methylated cytosine. As such, [*16] the term sought to be registered, 5TH BASE GENOMICS, immediately describes the salient functions, features, uses and purposes of the relevant goods and services."

We agree that the term 5TH BASE GENOMICS is merely descriptive of goods and services that are in the field of genomics and that involve locating, testing for, or using DNA methylation patterns. The term would describe applicant's medical and scientific reagents, laboratory equipment and testing services in Classes 1, 5, 9, and 42 to the extent that they detect or interpret DNA methylation patterns. The presence of methylated cytosine, the fifth base, is significant because of its possible role in such areas as cancer research, tissue regeneration, cell differentiation, and gene control. Therefore, the term 5TH BASE GENOMICS would describe a significant feature of applicant's goods and services in Classes 1, 5, 9, and 42.

However, we reach the opposite conclusion for the services of providing multiple-user access to the Internet in Class 38. Viewing the mark 5TH BASE GENOMICS in the context of providing users access to the Internet, we are unable to determine what characteristic, quality, or feature of the services in Class [*17] 38, the term would describe. The examining attorney does not point to specific evidence to show that providing access for multiple-users to the Internet is described by the term 5TH BASE GENOMICS. The Internet can be used to research virtually any topic. It would require some thought to understand that the term 5TH BASE GENOMICS for providing multiple-users access to the Internet described providing these users access to the Internet for research that may include the subject matter of 5TH Base Genomics. Therefore, the examining attorney's refusal regarding the services in Class 38 is reversed.

One final point we make is that even though applicant may be the first or only user of the term, this does not mean that the term is not merely descriptive. In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993) ("We observe that even if applicant has been the first and/or, unlike its competitors, is presently the only user of the term LIGHTWEIGHTS' in connection with shoes, such fact cannot alter the merely descriptive significance of the term").

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawProtection of RightsRegistrationSupplemental Register

Decision: The refusal to register under Section 2(e)(1) is reversed regarding the services in Class 38. The refusal [*18] to register under Section 2(e)(1) regarding the goods and services in Classes 1, 5, 9, and 42 is affirmed.

# EXHIBIT D

**Kissell, Joanie**

**From:** ECom106 [Ecom1063@USPTO.GOV]
**Posted At:** Tuesday, January 10, 2006 5:38 PM
**Conversation:** TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/29
**Posted To:** TMDocketNY
**Subject:** TRADEMARK APPLICATION NO. 78654480 - VIDEOPINIONS - 13114/29

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/654480

**APPLICANT:** Expo Communications, Inc.

*78654480*

**CORRESPONDENT ADDRESS:**
JOSEPH F. NICHOLSON, ESQ.
KENYON & KENYON,
1 BROADWAY
NEW YORK, NY 10004-1007

**RETURN ADDRESS:**
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**MARK:** VIDEOPINIONS

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 13114/29

**CORRESPONDENT EMAIL ADDRESS:**
tmdocketny@kenyon.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

**RESPONSE TIME LIMIT**: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION**: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at http://tarr.uspto.gov/, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/654480

The assigned examining attorney has reviewed the referenced application and determined the following.

**DESCRIPTIVENESS REFUSAL**

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods/services, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). TMEP §1209.01(b).

Applicant's mark is a telescoped version of the phrase "Video Opinions". A telescoped mark is one that comprises two or more words that share letters and is subject to refusal if the phrase is merely descriptive. See TMEP Section 1213.05(a)(1). The mark herein amounts to a slight misspelling of "Video Opinions".

It appears that applicant's services will involve the provision of opinions by means of video.

**INDEFINITE IDENTIFICATION OF SERVICES**

The recitation of services is unacceptable as indefinite because it suggests services in multiple classes without delineating them by class and uses broad language. Amendment is required. TMEP §1402.11.

The class 35 recitation is acceptable as stated.

However, the currently listed recitation of services in class 38 is unacceptable. Class 38 is not appropriate for information services, per se, merely because the means of the provision falls in that class. Information services fall in the class where the activities to which the information pertains would fall. Class 38 is reserved only for the true communication activity. It is possible that the mark will identify a broadcasting service in the field of specific information. This should be clear, however, in the recitation, because this is different than the provision of an information service itself. The only information services falling in class 38 would be those dealing with subject matter in that class. Further, if the provision of the information is in the form of a television show of some kind, the provision of on-going television programs would fall in class 41.

The applicant may adopt the following recitation, if accurate:

Providing information on consumer products and services by way of a global computer network. In class 35. (No change)

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 class 38.

Entertainment services in the nature of on-going television programs in the field of information about consumer products and services. In class 41.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at http://tess2.uspto.gov/netahtml/tidm.html.

**MULTIPLE CLASS REQUIREMENTS**

The application identifies services that may be classified in several international classes. Therefore, the applicant must either: (1) restrict the application to the number of class(es) covered by the fee already paid, or (2) pay the required fee for each additional class(es). 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1401.04, 1401.04(b) and 1403.01.

The filing fee for adding classes to an application is as follows:

(1) $325 per class, when the fees are submitted with a response filed online via the Trademark Electronic Application System (TEAS) at http://www.uspto.gov/teas/index.html; and

(2) $375 per class, when the fees are submitted with a paper response.

37 C.F.R. §§2.6(a)(i) and (ii); TMEP §810.

The applicant must list the services by international class number in ascending numerical order. TMEP §§801.01(b) and 1403.01.

**INFORMATION REQUEST**

The nature of the service is not clear from the present record. In order to allow proper examination of the services on which the applicant intends to use the mark, the applicant must submit samples of advertisements or promotional materials for services of the same type. If such materials are not available, the applicant must describe the nature, purpose and channels of trade of the services with which the applicant has asserted a bona fide intent to use the mark. 37 C.F.R. §2.61(b); TMEP §§814 and 1402.01(d).

Specific inquiry is made as to whether the services will in any way involve the use of or provision of opinions about the products or services of others. Will any of the opinions be provided by means of a video presentation, video recording, or video transmission of any kind? Will any of the opinions be *about* videos? Will the services in any way feature opinions recorded or presented by consumers on video? Explain in detail the exact nature of the services.

Note that the above information request and factual inquiries form an important part of this Office action. An applicant may not rely upon its own failure to provide information legitimately sought by the Office in claiming that its mark is registrable. See *In re Page*, 51 USPQ2d 1660 (TTAB 1999). Therefore, should applicant wish to pursue this application further by responding to this Office action, any failure to address the above information request and inquiries will be considered grounds for abandonment for failure to file a complete response. See 37 C.F.R. Section 2.65(a).

**SEARCH CLAUSE**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

If the applicant has any questions about this Office action, please telephone the assigned examining attorney.

/Steven Foster/
Steven Foster, Trademark Attorney
Law Office 106
(571) 272-9318
Fax number for the Law Office: (571) 273-9106

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- ONLINE RESPONSE: You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://www.uspto.gov/teas/index.html and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov.

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**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

# EXHIBIT E

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| Serial No.: | **78/654,480** |
| Mark: | **VIDEOPINIONS** |
| Applicant: | **Expo Communications, Inc.** |
| Filed: | **June 20, 2005** |

Examiner: Steven Foster

Law Office: 106

**CERTIFICATE OF MAILING**

I certify that the foregoing is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22213-1451.

Commissioner for Trademarks
P.O. 1451
Arlington, VA 22313-1451

**February 20, 2007**
**Date of Deposit**

Michael J. Fiero
**Name of person mailing papers:**

**Signature**

**REQUEST FOR RECONSIDERATION TO FINAL OFFICE ACTION**

This letter is in response to the Office Action dated August 17, 2006.

**REMARKS**

**I. APPLICANT RESPECTFULLY REQUESTS RECONSIDERATION OF THE EXAMINER'S DECISION TO MAKE THE AUGUST 17, 2006 ACTION FINAL**

The Applicant respectfully asks the Examiner to reconsider its decision to make the August 17, 2006 action final. The Applicant understands that an action may only be made final

when an examiner has raised in a previous action "all outstanding issues" and the "applicant has had an opportunity to respond to them":

> Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, i.e., the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.

TRADEMARK MANUAL OF EXAMINATION PROCEDURES ("TMEP") (4th Edition) § 714.03 (emphasis added). In this case, at least one new issue was raised in the August 17, 2006 office action even though the action was made final.

In particular, for the first time in the August 17, 2006 action, a refusal to register the Mark was made under Section 2(e)(1) for class 41. Office Action, 8/17/06 at 2 ("The refusal to register under Section 2(e)(1) of the Trademark Act is continued and made FINAL."). This issue was never raised in the original and first January 10, 2006 office action, and could not been raised in the first office action because the Applicant did not claim services in class 41 until the Examiner recommended that the Applicant claim such services in the January 10, 2006 office action. The Applicant has never had an opportunity to respond to the Examiner's refusal to register the VIDEOPINIONS mark in class 41 under Section 2(e)(1). Indeed, the Applicant argues below (for the first time) that VIDEOPINIONS is not descriptive for the claimed class 41 services, but only presents the argument for the first time because it was never raised before the August 17, 2006 office action. Quite simply, the Applicant did not know it was an issue—especially since it was the Examiner who recommended that the Applicant include a claim of services in class 41.

Furthermore, an office action cannot be made final in piecemeal: To make an action final at all, all requirements must have been made in the earlier action.

> For a second action to be made final, all requirements or refusals must have been made in the first action. No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

TMEP § 714.03 (emphasis added). In this case, since the refusal to register the VIDEOPINIONS mark in class 41 was never made in an earlier action, Applicant respectfully contends that the refusal to register the mark in the August 17, 2006 office action should not have been made final.[1]

Therefore, the Applicant respectfully asks the Examiner to find that the August 17, 2006 action to have been made final prematurely and asks the Examiner to issue a new non-final action. *See* TMEP § 714.06. However, if the Examiner decides on reconsideration that the application should publish, Applicant concedes that no new non-final action would be necessary.

## II. REQUEST TO DIVIDE: 37 C.F.R. § 2.87

The Applicant separately files a request to divide the application into the three pending classes, International Class 35, International Class 38, and International Class 41.

## III. SECTION 2(E)(1) REFUSAL OF CLASS 35

The Examiner has refused registration of the Applicant's mark in class 35 under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), stating that "[t]he refusal to register under Section 2(e)(1) of the Trademark Act is continued and made FINAL." Office Action, 8/17/06 at

[1] Additionally, the Examiner presented new evidence in the August 17, 2006 action, and the Applicant never had an opportunity to respond to this evidence. This is a separate and additional reason the August 17, 2006 should not have been made final. Furthermore, the Examiner has changed his characterization the Applicant's services to "offer[ing] opinions about products and services on videotape" from "the provision of opinions by means of video," which was his original characterization of the Applicant's service from the January 10, 2006 office action. See discussion below. Although Applicant disputes both characterizations, the Applicant was never given an opportunity to respond to the Examiner's latest characterization.

2. The Applicant respectfully traverses and requests reconsideration of the Examiner's refusal to register the VIDEOPINIONS mark in class 35.

The Lanham Act § 2 reads, in relevant part, as follows:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— (e) consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them . . . .

§ 1052(e)(1) (emphasis added). The word "merely" means that the mark cannot be deemed descriptive unless it immediately conveys information with a "degree of particularity" concerning a significant quality, characteristic, function, attribute, or feature of the goods or services in connection with which it is used or is intended to be used. *In re Cerner Corp.*, 2001 TTAB LEXIS 87, at *3 (TTAB Jan. 31, 2001); *In re On Technology Corp.*, 41 USPQ2d (BNA) 1475, at *7 (TTAB 1996); *In re Intelligent Medical Sys.*, 5 USPQ2d (BNA) 1674 (TTAB 1987); *In re TMS Corporation of the Americas*, 200 USPQ (BNA) 57, 59 (TTAB 1978); *In re Colonial Stores, Inc.*, 394 F.2d 549 (C.C.P.A. 1968).

The Applicant contends that VIDEOPINIONS does not describe anything whatsoever, let alone "[p]roviding information on consumer products and services by way of a global computer network." Respectfully, the Applicant believes the Examiner has chosen (without justification) dictionary definitions of the words "video" and "opinion" from among many possible definitions to define the mark VIDEOPINIONS to mean offering opinions by means of videotape, and then (ignoring the Applicant's recited services, and at times instead relying on extrinsic evidence and representations by third parties) characterized the Applicant's services as the service of the offering opinions by means of videotape. By bending and twisting the mark VIDEOPINIONS and bending and twisting the recited services of class 35, the Examiner unnaturally attempts to

force the Applicant's VIDEOPINIONS mark and the Applicant's services to converge. Such an analysis begs the question. An analysis under Section 2(e)(1) requires, *inter alia*, an objective analysis of the mark to determine what it means, if anything, to consumers; and a determination of whether the mark describes with a degree of particularity the recited class 35 services claimed by the Applicant.

**A. The Coined Mark VIDEOPINIONS Has No Known Meaning**

Applicant contends that even though the word "video" has multiple known meanings in the English language, and even though "opinions" has multiple known meanings in the English language, the combination "video opinions" has no recognized meaning. Without actually ever asserting what the Examiner takes the mark VIDEOPINIONS to mean or what the Examiner takes the mark VIDEOPINIONS to mean to consumers, the Examiner has provided dictionary definitions of the terms "video" and "opinion." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) (reversing Examiner and Board finding of descriptiveness, but holding that evidence of the public's understanding of a term may be obtained from any competent source, including dictionaries).

**1. The Term "Video" Has Multiple Meanings**

There are numerous definitions of the word "video," with conventional uses of the word as either a noun or an adjective. The Examiner provided the definitions of "video" from a single source, the Microsoft® Encarta® dictionary. Encarta® lists at least the five definitions of the noun word "video" and two definitions of the adjective word "video." Ex. 1 (Microsoft® Encarta definitions of "video"). To eliminate any bias in picking and choosing definitions of the words and to complete the record, the Applicant provides additional dictionary definitions. *See, e.g.*, Ex. 2 (www.Infoplease.com definitions of "video"); Ex. 3 (Merriam-Webster Online

definitions of "video"); Ex. 4 (American Heritage Dictionary definitions of "video"),[2] Ex. 4 (Dictionary.com definitions of "video");[3] and Ex. 5 (Oxford English Dictionary definitions of "video."). The various dictionary sources provide definitions of "video" ranging from, *inter alia*, music videos, movies, video recorders, videocassettes or videotapes, television, and the visual portion of television. The definitions include each of the following:

| | |
|---|---|
| A music video. | Ex. 4 |
| a program, movie, or the like, that is available commercially on videocassette | Ex. 2 |
| a recording similar to a videotape but stored in digital form (as on an optical disk or a computer's hard drive) | Ex. 3 |
| A video recorder; also, a VDU. | Ex. 5 |
| A video recording; videotape as a recording medium. | Ex. 5 |
| A videocassette or videotape, especially one containing a recording of a movie, music performance, or television program. | Ex. 4 |
| being, relating to, or involving images on a television screen or computer display <a video terminal> | Ex. 3 |
| being, relating to, or used in the transmission or reception of the television image <a video channel> -- compare AUDIO | Ex. 3 |
| comput images on computer screen: the text and graphics images that appear on a computer screen | Ex. 1 |
| Computer Science Of or relating to the production of images on video displays | Ex. 4 |
| Computer Science The appearance of text and graphics on a video display. | Ex. 4 |
| image reproduction industry: the industry of recording and broadcasting visual information and entertainment, especially that which can be viewed on a television a star of stage, screen, and video | Ex. 1 |
| Informal.television: She is a star of stage and video. | Ex. 2 |
| Informal.videotape | Ex. 2 |
| of or pertaining to television, esp. the visual elements | Ex. 2 |
| of or pertaining to the electronic apparatus for producing the television picture: video amplifier | Ex. 2 |
| of or pertaining to videocassettes, videocassette recorders, music video, etc.: a video shop | Ex. 2 |
| Of or relating to television, especially televised images | Ex. 4 |
| Of or relating to videotaped productions or videotape equipment and technology | Ex. 4 |
| pertaining to or employed in the transmission or reception of television pictures | Ex. 2 |
| relating to video frequencies: relating to or using video frequencies | Ex. 1 |
| relating to visual image reproduction: relating to the recording or broadcasting of visual | Ex. 1 |

[2] The American Heritage® Dictionary of the English Language, Fourth Edition. Retrieved February 18, 2007, from Dictionary.com website: http://dictionary.reference.com/browse/video.

[3] Dictionary.com. Dictionary.com Unabridged (v 1.1). Random House, Inc. http://dictionary.reference.com/browse/video (accessed: February 18, 2007).

| | |
|---|---|
| information or entertainment by means of videotape or television | |
| something recorded onto videotape: something that has been recorded on videotape, especially a movie or music performance a video of my brother's wedding | Ex. 1 |
| Television as a broadcasting medium. U.S. colloq. | Ex. 5 |
| Television. the elements of television, as in a program or script, pertaining to the transmission or reception of the image (distinguished from audio). | Ex. 2 |
| Television. the video part of a television broadcast. | Ex. 2 |
| Television: a star of stage, screen, and video. | Ex. 4 |
| TELEVISION; also : the visual portion of television | Ex. 3 |
| That which is displayed or to be displayed on a television screen or other cathode-ray tube; the signal corresponding to this | Ex. 5 |
| The production or use of video recordings. | Ex. 5 |
| The visual portion of a televised broadcast. | Ex. 4 |
| videocassette: videotape, or a videocassette ( informal ) now available to rent or buy on video | Ex. 1 |
| VIDEOTAPE: as a : a recording of a motion picture or television program for playing through a television set b : a videotaped performance of a song often featuring an interpretation of the lyrics through visual images | Ex. 3 |
| visual part of television: the visual part of a television broadcast | Ex. 1 |

Given the various definitions of the word "video" and given the different definitions of the noun and adjective forms of the word "video," the question presents itself: What does the term "video" mean to consumers? The Examiner never explains. Instead, the Examiner simply states: "The term "video" is . . . being used for its normal meaning." Office Action, 8/17/06 at 2 (emphasis added). However, in view of the diverse meanings of the word "video," it is unclear which meaning is "normal" and which meaning the Examiner believes to be attributed to this word.[4]

**2. The Term "Opinion" Has Multiple Meanings**

Similarly, there are numerous definitions of the noun word "opinion." The Examiner provides definitions of "opinion" from two sources, a website called Infoplease.com and

[4] The word "video" is not inherently descriptive of the services of class 35. For example, there are numerous registered service marks containing the word "video" in class 35, including VIDEOSPACE, VIDEOSHOPPING, VIDEOSEEKER, VIDEORESUMECREATOR, VIDEOMASTERS, VIDEOMARATHON, VIDEOFINDER, VIDEOVIEW, VIDEOLINK, and VIDEOLOGO. *See* Ex. 6.

Merriam-Webster Online. Office Action, 8/17/07 (attachments). To round out the record, the Applicant provides definitions of "opinion" from additional dictionaries. *See, e.g.*, Ex. 7 (Microsoft® Encarta definitions of "opinion"); Ex. 8 (American Heritage definitions of "opinion"); and Ex. 9 (Oxford English Dictionary online definitions of "opinion"). The Oxford English Dictionary's ("OED") definition of "opinion" is the following.

> **opinion**, n.
> I. Simple uses.
> 1. As a count noun: a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction. Formerly (also): a plan, an intention (obs.).
> 2. a. What is thought of a person by others; the (esp. good) estimation in which one stands; reputation (of being such, or of possessing some quality). Obs.
> b. Report, rumour. Obs.
> 3. a. With specifying adjective, as common, general, public, vulgar, etc. A judgement, belief, or conviction held by the majority of or many people; what is generally thought about something. See also opinion poll, opinion survey, sense 7.
> b. More generally: what or how one thinks about something; judgement or belief. Esp. in in my opinion: according to my thinking; as it seems to me. a matter of opinion: a matter about which each may have his or her own opinion; a disputable point.
> c. to be of (the) opinion (that): to hold the belief or view; to think (that). Also with further syntactic variation.
> d. Public or general opinion.
> 4. A formal statement by a judge or other competent authority of what he or she judges or advises on a matter; professional advice; as a legal (also medical) opinion, to get an opinion of counsel, etc. In a second (also another) opinion: the opinion of a second (esp. medical) expert or adviser. Also in transferred and extended uses.
> 5. a. Favourable estimate of oneself; conceit, arrogance; self-confidence. Obs. rare.
> b. spec. A good or favourable estimate of someone or something; esteem. Esp. in to have no (great) opinion of: to regard as inferior or unworthy.
> c. What one thinks of a person or thing; an estimate of character, quality, or value.
> 6. Thought of what is likely to be the case, knowledge; expectation based on knowledge or belief. Obs.
> II. Compounds.

> 7. General attrib., as opinion-former, holder, leader, -maker, etc.; opinion-breeding, -making n. and adj.; opinion-forming, -tapping adjs. opinion column, a column in a newspaper or periodical which contains an opinion piece; an article in such a column (quot. 1947 refers to a regular column entitled 'Opinion'). opinion mill, a person who or organization which speculates on or disseminates public opinions. opinion piece, an article in a newspaper or periodical expressing the opinion (freq. one which is controversial or biased) of the writer on a particular item of news. opinion poll, an assessment of public opinion taken by questioning a random or representative sample of the public, often as a basis for forecasting patterns of voting (cf. sense 3a). opinion polling, the compiling of opinion polls. opinion pollster, a person or organization engaged in compiling opinion polls. opinion survey = opinion poll. opinion trade, the business of polling or expressing opinions.

*Id.* Although the OED provides compound forms of the word "opinion," the OED does not recognize the compound "video-opinion."

The word "opinion" has multiple meanings, with definitions ranging from, *inter alia*, favorable esteem, a formal statement by a judge, a belief or conclusion held with confidence but not substantiated by positive knowledge or proof, the public or general opinion, and/or a judgment based on special knowledge. The definitions include each of the following.

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| A belief or conclusion held with confidence but not substantiated by positive knowledge or proof | Ex. 8 |
| a belief or judgment that rests on grounds insufficient to produce complete certainty | Infoplease.com |
| a favorable estimate; esteem: I haven't much of an opinion of him. | Infoplease.com |
| a formal expression of judgment or advice by an expert b : the formal expression (as by a judge, court, or referee) of the legal reasons and principles upon which a legal decision is based | Merriam-Webster OnLine |
| A formal statement by a judge or other competent authority of what he or she judges or advises on a matter; professional advice; as a legal (also medical) opinion, to get an opinion of counsel, etc. In a second (also another) opinion: the opinion of a second (esp. medical) expert or adviser. Also in transferred and extended uses | Ex. 9 |
| A judgment based on special knowledge and given by an expert: a medical opinion | Ex. 8 |
| a judgment or estimate of a person or things with respect to character, merit, etc.: to forfeit someone's good opinion. | Infoplease.com |
| A judgment or estimation of the merit of a person or thing: has a low opinion of | Ex. 8 |

| | |
|---|---|
| braggarts | |
| a personal view, attitude, or appraisal | Infoplease.com |
| a view, judgment, or appraisal formed in the mind about a particular matter b : APPROVAL, ESTEEM | Merriam-Webster OnLine |
| As a count noun: a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction | Ex. 9 |
| belief stronger than impression and less strong than positive knowledge b : a generally held view | Merriam-Webster OnLine |
| body of generally held views: the view or views held by most people or by a large number of people | Ex. 7 |
| estimation: a view regarding the worth of somebody or something | Ex. 7 |
| expert view: an expert assessment of something | Ex. 7 |
| Favourable estimate of oneself; conceit, arrogance; self-confidence. Obs. rare. | Ex. 9 |
| Law A formal statement by a court or other adjudicative body of the legal reasons and principles for the conclusions of the court | Ex. 8 |
| law conclusion of fact: a conclusion drawn from observation of the facts | Ex. 7 |
| Law. The formal statement by a judgment or court of the reasoning and the principles of law used in reaching a decision of a case | Infoplease.com |
| More generally: what or how one thinks about something; judgement or belief. Esp. in in my opinion: according to my thinking; as it seems to me. a matter of opinion: a matter about which each may have his or her own opinion; a disputable point | Ex. 9 |
| personal view: the view somebody takes about an issue, especially when it is based solely on personal judgment | Ex. 7 |
| Public or general opinion | Ex. 9 |
| Report, rumour. Obs. | Ex. 9 |
| spec. A good or favourable estimate of someone or something; esteem. Esp. in to have no (great) opinion of: to regard as inferior or unworthy. | Ex. 9 |
| the formal expression of a professional judgment: to ask for a second medical opinion | Infoplease.com |
| The prevailing view: public opinion | Ex. 8 |
| Thought of what is likely to be the case, knowledge; expectation based on knowledge or belief. Obs. | Ex. 9 |
| to be of (the) opinion (that): to hold the belief or view; to think (that). Also with further syntactic variatio | Ex. 9 |
| What is thought of a person by others; the (esp. good) estimation in which one stands; reputation (of being such, or of possessing some quality) | Ex. 9 |
| What one thinks of a person or thing; an estimate of character, quality, or value. | Ex. 9 |
| With specifying adjective, as common, general, public, vulgar, etc. A judgement, belief, or conviction held by the majority of or many people; what is generally thought about something. See also opinion poll, opinion survey. | Ex. 9 |

Given the various definitions of the word "opinion," the following question presents itself: What does the word "opinion" mean to consumers? In this case, the Examiner provides the following definition of the word "opinion."

> 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 attached dictionary definitions. . . .

Office Action, 8/17/06 at 2. Although the Examiner focuses on a single definition of "opinion" from among many, no explanation or evidentiary basis is given for choosing this particular definition over the others.[5]

### 3. The Coined Mark VIDEOPINIONS Has No Meaning at All, and the Combination of "Video" and "Opinions" Evokes a New Commercial Impression

The Applicant's VIDEOPINIONS mark is a unique expression, coined by the Applicant for use in connection with its service of "[p]roviding information on consumer products and services by way of a global computer network." The mark VIDEOPINIONS has no dictionary definition, and no meaning in common language. There is no such thing as a "videopinions" or a "video opinions." This is undisputed.

#### a. Given The Various Definitions of "Video" And "Opinion," The Expression VIDEOPINIONS or "Video Opinion" Has No Clear Meaning

Given the all the various meanings of the terms "opinion" and "video," one cannot come to any clear understanding as to what "videopinions" or "video opinions" could possibly mean. There are hundreds of permutations and possibilities, many of which make no sense.

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[5] The word "opinion" is also not inherently descriptive of the services of class 35. For example, there are numerous registered service marks containing the word "opinion" in class 35, including WORLDOPINION, VALUEDOPINION, INTERNETOPINIONS.COM, QUALITYOPINIONS.COM, OPINIONBANK, OPINIONLAB, and OPINIONSITE. See Ex. 12.

For example, taking the noun form of the word "video" and placing it beside the noun word "opinion" creates nonsense: It is like referring to "cat dog." For example, taking the first occurring definitions from the OED, the definition of "video" is "that which is displayed or to be displayed on a television screen or other cathode-ray tube. . . ." (Ex. 5) and the definition of "opinion" is "a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction." Ex. 9. The combination makes no sense, *e.g.*, "that which is displayed or to be displayed on a television screen or other cathode-ray tube a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction." The same applies for the various other combinations of definitions for the respective words.[6]

The Applicant is not arguing that a consumer would have difficulty figuring out what the Applicant's services are from looking at the mark VIDEOPINIONS (which the Applicant also believes to be the case), but rather, the Applicant is here arguing that the coined word VIDEOPINIONS or the combination of "video" and "opinions" has no meaning whatsoever in the English language. Reaffirming this conclusion that VIDEOPINIONS has no meaning, the Examiner himself never actually states what he takes the combined terms to mean. The present case is analogous to the case of *In re Harrington*, 219 USPQ 854, 856 (TTAB 1983), where the applicant filed for the mark COLLEGE ACADEMY for "education services, namely, providing special learning programs for gifted and talented children in grades 4 to 8." Reversing the examining attorney's refusal to register the mark under Section 2(e)(1), the Trademark Trial and Appeal Board ("Board") found that "the composite of the two words is not a term in general use

[6] Even when the word "video" is taken as an adjective instead of a noun, the combination of terms still makes no sense: "of or pertaining to the electronic apparatus for producing the television picture a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction."

to describe educational services (or anything else, for that matter) and has no dictionary meaning." *Id.* at 856 (emphasis added). No dictionary defines "videopinions."

In the *Harrington* case, there was no evidence showing use of the composite term COLLEGE ACADEMY in the academic field. *Id.* Likewise, in this case, there is no evidence showing use of the term VIDEOPINIONS (or "video opinions") in the field of providing information on consumer products and services by way of a global computer network. Although the Examiner has attached two documents to the August 17, 2006 office action which the Examiner alleges "show[] use of the phrase 'video opinion' and its plural in descriptive fashion," the Applicant disputes the relevance and admissibility of the documents.[7]

The first proffered document comprises excerpts apparently from a Kansas City Star article entitled "Students view life from both sides of camera" by Roberta Johnson. The excerpts apparently (though it is unclear because the full article and context was not provided) quote a seventh-grade student as saying: "We got to tape (yesterday) and today, I get to do the video opinion poll." The Applicant objects to the admissibility of this document because it is impossible to understand what the limited text means and the Applicant requests the entire article be submitted.[8] At the same time, based on the limited text provided, a "video opinion poll" is clearly not a use of VIDEOPINIONS. Moreover, whereas the term "opinion poll" is a common

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[7] Note that the Examiner's attachments to his August 17, 2007 cannot fully be understood or appreciated. According to the August 17, 2007 office action, the "Office Action has been split into 2 smaller e-mail messages." According to the office action, Email 1 includes 5 attachments, and Email 2 includes 8 attachments. The Applicant only received 7 attachments in total, which include: (1) webpages titled "Branding Ad Vice"; (2) webpages titled "GamePro.com"; (3) webpage for Infoplease dictionary; (4) webpage for Merriam-Webster Online; (5) webpage from MSN Encarta®; (6) excerpts apparently from a Kansas City Star article entitled "Students view life from both sides of camera" by Roberta Johnson; and (7) an unknown and unidentified excerpt titled "Private Eyes" by Garaldine Baum. If the Examiner intended to attach more exhibits than described herein, the Applicant never received such attachments and such other attachments are not part of the public record accessible on the www.uspto.gov website.

[8] Federal Rule of Evidence 106 states: "When a writing or recorded statement or part thereof is introduced by a party, an adverse party may require the introduction at that time of any other part or any other writing or recorded statement which ought in fairness to be considered contemporaneously with it."

compound term recognized by the Oxford English Dictionary (see above), the compound term "video opinion" is not a recognized compound term.

The second document proffered by the Examiner is from an unknown and unidentified source, but appears to be entitled "Private Eyes" by Geraldine Baum. The document states:

> ...article recounted how a consortium of peace groups frustrated with network news coverage of the Gulf War. They solicited video opinions from groups nationwide, received 100 responses and then culled them, broadcasting four short programs on cable and PBS stations.

It is unclear from this excerpt what the article is exactly saying or how "video opinions" is being used. Again, the Applicant objects to this evidence under Federal Rules of Evidence 106 as failing to proffer the full document and context and the Applicant requests the full document be submitted for examination. However, even from the limited text provided, it is clear that the use does not involve "[p]roviding information on consumer products and services by way of a global computer network," which is the Applicant's class 35 services at issue.

Perhaps the most compelling fact derived from the evidence proffered by the Examiner is that from a NEXIS database search, not a single instance of use of the coined term VIDEOPINIONS was apparently found. Moreover, the Examiner's submission of a single use of the phrase "video opinions" is not sufficient to demonstrate that VIDEOPINIONS merely describes the Applicant's recited class 35 services. For example, *In re Adamchik*, Ser. No. 76571862, 2006 TTAB LEXIS 345 (TTAB Aug. 7, 2006), an applicant sought registration for the mark OBJECTSTYLE for "providing web and e-mail hosting services to the open-source software development community" in class 38. The examiner submitted a webpage as an example of use of the term "object style," but the Board held that a single example of use is not enough to show descriptiveness.

> The only example of use of the term "object style," or a variation thereof, in the examining attorney's evidence occurs in an Internet web page instructing a user in a method to "Save a drawing object style as the default." However, it is not clear from this evidence whether the term "object style" is used as a term of art, or merely in syntax. In any event, this single example of use of "object style" in instructions for working with drawing objects and graphics fails to demonstrate that OBJECTSTYLE merely describes a function, feature or characteristic of the recited services.

*Id.* at *8-10. A single unclear use in not enough to show descriptiveness.

Furthermore, not only is a single occurrence of the use of "video opinions" insufficient, but also, that particular and indefinite use identified by the Examiner (by an unknown source) clearly does not describe anything related to the Applicant's services—it clearly has nothing to do with consumer information provided via a global computer network. In the case of *In re L.Vad Technology, Inc.*, Ser. No. 78/285,714, 2006 TTAB LEXIS 160 (TTAB Apr. 28, 2006), the examiner refused to register PATCH BOOSTER under Section 2(e)(1) for class 10 goods identified as, *inter alia*, "permanent and temporary heart assist devices utilizing intra arterial air pressure to assist the circulating assist machinery and controls therefor. . . ."[9] The examiner in that case proffered "excerpts of articles obtained from the NEXIS database which refer to a medical procedure involving a patch of tissue (from human and/or animal cells) used to patch a hole in the heart or to mend damaged heart tissue." *Id.* at *6-7. On appeal, the Board reversed the examiner's refusal, and rejected the examiner's evidence stating:

> These articles do not support a finding that "patch" is merely descriptive of applicant's goods. There is no evidence in the record from which we might conclude that applicant's goods, as identified in the application, are, or involve, tissue patches of the type mentioned in these articles.

[9] Because this disposition is not citable as precedent, the Applicant only cites the case (and other non-precedential opinions mentioned in this paper) as an instructive example.

*Id.* at *8 (emphasis added). Again, even if the "Private Eyes" article constituted one of the only instances wherein the term "video opinions" was ever used by anyone in the past, apart from the fact that it is not a use of the coined VIDEOPINIONS mark claimed by the Applicant, there is further no evidence in the record from which one might conclude that the Applicant's class 35 services—"[p]roviding information on consumer products and services by way of a global computer network"—are, or involve, the unidentified object of the "Private Eyes" article. In other words, the person quoted in the "Private Articles" article was clearly not talking about "[p]roviding information on consumer products and services by way of a global computer network."

**b. The Combination of "Video" and "Opinions" Evokes a New and Unique Commercial Impression**

The individual terms "video" and "opinion" do not individually describe the Applicant's class 35 service of "[p]roviding information on consumer products and services by way of a global computer network." However, assuming *arguendo* that the word "video" was descriptive and the word "opinion" was separately descriptive of something in the abstract, the combination of the words still evokes a new and unique commercial impression.

"When two or more merely descriptive terms are combined, [the Board] must determine whether the combination of terms evokes a new and unique commercial impression." *In re FineLine Lakeshore Servs., LLP* , Serial No. 76/428,109, 2006 TTAB LEXIS 339, at *9-12 (Trademark Trial & App. Bd. Aug. 24, 2006); *see also Colonial Stores*, 394 F.2d 549 (holding that combination of two descriptive elements may result in a non-descriptive composite). Without any supporting evidence, the Examiner simply concluded that VIDEOPINIONS does not create an impression differing from that created by the two words.

> The telescoping of the terms "video" and "opinion" into one word does not create an impression differing from that created by the two words and still results in a descriptive mark.

Office Action, 8/17/06 at 2 (citations omitted). Nothing proffered by the Examiner—including the dictionary definitions—supports this conclusion.[10]

In an analogous case, an applicant sought registration of the mark POLYDECK and the examiner refused registration under Section 2(e)(1) as descriptive of, *inter alia*, "polyethylene dock sections." *FineLine*, 2006 TTAB LEXIS 339, at *9-12.

> The Examining Attorney argues that POLYDECK is a compound term with two merely descriptive components: "deck" which is an alternative generic term for "dock" and "poly" which is an abbreviation for "polyethylene."

*Id.* In that case, the Board looked at the dictionary definitions proffered by the examiner, noting that "poly" had multiple definitions and could mean an abbreviation of "polyethylene" or suggest that the particular goods—dock sections—may be configured in many ways. The Court held that the fact that the terms had multiple meanings made the combined mark POLYDECK more suggestive than descriptive.

> This indicates further that the combination of "poly" and "deck" may have a suggestive meaning which is more than the sum of its parts contrary to the Examining Attorney's position.
>
> Accordingly, we conclude that POLYDECK is not merely descriptive of "polyethylene dock sections." In concluding so we acknowledge that there is some doubt and that, in such a case under Trademark Act Section 2(e)(1), we must resolve doubt in favor of applicant.

*Id.* at *9-12 (emphasis added and citations omitted). Like the case in *FineLine* and as explained above, the terms "video" and "opinion" have multiple definitions, and the term "video" may be

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[10] The Examiner cited the following cases: *In re BankAmerica Corp.*, 229 USPQ 852 (TTAB 1986) (PERSONALINE merely descriptive of consumer loan services in which a personal line of credit is provided); *In re U.S. Steal Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE merely descriptive of wire rope); *In re Gagliardo Bros., Ind.*, 218 USPQ 181 (TTAB 1983) (BEEKFLAKES is merely descriptive of thinly sliced beef).

used as a noun or an adjective. The mark VIDEOPINIONS may suggest in the mind of consumers an opinion poll in video format (as indicated in the Kansas City Star article presented by the Examiner), or may suggest video recordings of court proceeding or court "opinions," or may suggest a video of political or religious issues (as indicated in the other article presented by the Examiner), or may suggest written movie reviews. The coined term could suggest a lot of different things, none of which describe or are even related to the Applicant's claimed service of "[p]roviding information on consumer products and services by way of a global computer network." Because of the diverse possible consumer interpretations of the mark VIDEOPINIONS, the Applicant's mark should be deemed at most suggestive. The ambiguity raised by the various interpretations weighs in favor of the Applicant because any doubt "must resolve in favor of the applicant." *In re Rank Organisation Ltd.*, 222 USPQ 324, 326 (TTAB 1984).

**c. The mark VIDEOPINIONS Is At Most Suggestive**

Arranged in an ascending order of protectability, trademarks are categorized as (1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d (BNA) 1081, 1083 (1992). A mark that suggests, rather than merely describes, a particular good or service is protectable without evidence of secondary meaning. Even if the definitions of the individual terms "video" and "opinions" could be contorted to mean something like a "global computer network" devoted to, *inter alia*, information on consumer products and services, such a conclusion is not immediately evoked by the mark VIDEOPINIONS. While a descriptive term will directly and clearly convey information about the qualities or characteristics of the associated service, a "suggestive" term only indirectly suggests certain qualities or characteristics of the service. It has often been said

that if the consumer must exercise mature thought or follow a multi-stage reasoning process in order to determine attributes of the services from the mark, the mark is suggestive and not descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ (BNA) 496, 498 (TTAB 1978).

There is no evidence that the Examiner's own interpretation of the mark —"offer[ing] opinions about products and services on videotape"—will immediately come to mind when prospective consumers encounter the term VIDEOPINIONS used in association with the Applicant's services. *In re Telechat Networks, Inc.*, 2006 TTAB LEXIS 178, at *8 (TTAB May 11, 2006) (citing *Rank*, 222 USPQ at 326 (The "fact that the term LASER is cable of being analyzed does not render the term merely descriptive.")); *see also In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) ("It is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork.") *and In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006) ("What we lack in this case is significant evidence that, when prospective purchasers encounter term FREEDOM FRIES used on frozen French fried potatoes, they will immediately understand that it identifies a feature, quality, or characteristic of the applicant's goods").

The Applicant contends that upon hearing VIDEOPINIONS, a consumer must engage in highly mature thought processes and multiple steps to arrive at anything remotely resembling any aspect of the Applicant's specific recited class 35 services. As marks go, VIDEOPINIONS is certainly much less descriptive than numerous marks which have been deemed to be suggestive by the Trademark Trial and Appeal Board. *See, e.g., In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006) (FREEDOM FRIES not descriptive of frozen french fries); *In re Intelligent Medical Sys.*, 5 USPQ2d (BNA) 1674 (INTELLIGENT MEDICAL SYSTEMS not descriptive of "electronic thermometers for measuring human body temperature."); *In re*

*Sundown Technology Inc.*, 1 USPQ2d 1927, 1928 (TTAB 1986) (GOVERNOR not descriptive for controls used to limit sound from musical amplifier); *In re WSI Corp.*, 1986 TTAB LEXIS 60, 1 USPQ2d (BNA) 1570 (TTAB 1986) (SUPERSAT not descriptive of collecting meteorological information via satellite); *In re Southern Nat'l Bank*, 219 USPQ (BNA) 1231 (TTAB 1983) (MONEY 24 not descriptive of automatic teller machines); *Harrington*, 219 USPQ 854 (COLLEGE ACADEMY not descriptive for education services for gifted children).[11]

Moreover, the Applicant's specific mark is not needed by competitors to identify their own services. The purpose of Section 2(e)(1) is to protect the competitive needs of others, and thus, if the message conveyed by the mark about the services is so direct and clear that competing sellers would be likely to need to use the term in describing or advertising their own services, then this indicates that the mark is descriptive. *In re TMS*, 200 USPQ at 59; *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987). In the present case, the Applicant's business is novel. There is no evidence that any television network or consumer information service uses or needs to use "videopinions" or "video opinions" to describe similar services. *In re Dollar-A-Day Rent-A-Car Systems, Inc.*, 173 USPQ (BNA) 435, 437 (TTAB 1972) ("If the term is as highly descriptive as asserted by the examiner, one would suppose that there would be at least one descriptive use thereof by a competitor but none has been shown.").

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[11] There are numerous non-precedential decisions as well. *See, e.g., L.Vad Technology, Inc.*, 2006 TTAB LEXIS 160 (PATCH BOOSTER for heart devices); *In re Telechat Networks, Inc.*, 2006 TTAB LEXIS 178, at *8 (TTAB May 11, 2006) (TELECHAT NETWORK for telephone and online dating service); *In re Orincon Indus.*, 2004 TTAB LEXIS 560 (TTAB Sept. 14, 2004) (TRAC SYSTEM for computer and software designed to track traffic patterns); *In re Sierra Design Group*, 2004 TTAB LEXIS 279 (TTAB May 6, 2004) (CASINO MERCHANDISING TECHNOLOGY as a trademark for goods described as "networked gaming system comprising gaming machines and accounting and gaming software."); *In re Thomas J. Manski*, 2005 TTAB LEXIS 250 (TTAB Apr. 28, 2004) (FLAT VU not descriptive for flat video display devices, including televisions); *In re IdaTech*, LLC, 2004 TTAB LEXIS 259 (TTAB Apr. 19, 2004) (ADVANCED FUEL CELL SOLUTIONS not descriptive of, *inter alia*, "electrical power generation equipment, namely, fuel cells"); *In re Intermedia Advertising Group, Inc.*, 2004 TTAB LEXIS 152 (TTAB Mar. 19, 2004) (REWARDTV not descriptive for a website providing information on television programs); *In re BrainLAB AG*, 2003 TTAB LEXIS 543 (TTAB Nov. 14, 2003) (iPLAN not descriptive for Internet planning software); *In re Gast Mfg. Corp.*, Ser. No. 74/541,668, 1997 TTAB LEXIS 182 (TTAB June 18, 1997) (SMART AIR not descriptive for "air compressors and vacuum pumps").

But also, there is no indication that anyone in the general field of information services would need to use this term. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 1180 (C.C.P.A. 1972) (SKINVISIBLE not necessary to describe transparent medical adhesive tape). For this reason too, the Applicant's mark should be deemed suggestive and not "merely descriptive."

**B. The Coined Mark VIDEOPINIONS Does Not Describe Applicants' Recited Class 35 Services, Namely, "Providing Information On Consumer Products And Services By Way Of A Global Computer Network"**

The Applicant contends that VIDEOPINIONS—a meaningless coined term—does not describe with a degree of particularity any aspect of the Applicant's recited class 35 services, namely, "[p]roviding information on consumer products and services by way of a global computer network." Rather than looking that the recited services of class 35 in the Applicant's application, the Examiner appears to have rewritten the Applicant's services as "services wherein consumers offer opinions about products and services on videotape."

> Applicant seeks registration of VIDEOPINIONS for services wherein consumers offer opinions about products and services on videotape.

Office Action, 8/17/07 at 2. [12] Again, the Applicant's service recited in class 35 is for the following:

> Providing information on consumer products and services by way of a global computer network.

The Applicant's recited class 35 service never mentions opinions and never mentions videotape. It appears that the Examiner has attempted to bend and twist the Applicant's services such that it conforms to the Examiner's chosen definitions of the words "opinions" and "video."

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12 Even though an analysis descriptiveness of a mark for services must be applied on a class-by-class basis, the Examiner appears to conflate the various classes claimed by Applicant and simple attributes to the Applicant a single service.

In so far as the VIDEOPINIONS mark has nothing to do with the actual services claimed by the Applicant, the present case resembles the situation in *In re Major League Baseball Properties, Inc.*, Ser. Nos. 78/183,355 and 78/183,381, 2005 TTAB LEXIS 94 (TTAB Mar. 2, 2005). There, the applicant, Major League Baseball Properties, Inc., filed an application to register, *inter alia*, THE BASEBALL CHANNEL for "entertainment services, namely baseball games. . . through broadcast media including television" and "providing, producing and distributing programming for others in the nature of baseball games." *Id.* at *1. The examiner refused to register the mark as descriptive under Section 2(e)(1) after citing the American Heritage Dictionary definitions of "baseball" and "channel" and concluding that the "the combined term THE BASEBALL CHANNEL may be used to describe a television channel about the game of baseball or featuring baseball games." *Id.* at *3. On appeal, the Board held that even though each individual term described something, and even though the combination of terms may even describe something, the mark does not describe the actual and specific services recited in the applicant's trademark application.

> There is no dispute that the word BASEBALL is descriptive of applicant's services. Indeed, it is clear from the recitation of services that the programming applicant intends to produce and distribute is in the nature of baseball games. Therefore a significant characteristic of such programming is that it will feature baseball games.
>
> Further, we recognize that the word CHANNEL is descriptive of television broadcasting services. However, the services at issue in this case are not television broadcasting services, but rather the production and distribution of programming. It is not at all clear from the definition of "channel" of record that the term has descriptive significance as applied to such services. Moreover, the record is devoid of any descriptive uses of "channel" for the production and distribution of programming. Thus, we are not persuaded that the phrase THE BASEBALL CHANNEL as used in connection with such services conveys an immediate idea about the services with any degree of particularity. Specifically what THE BASEBALL CHANNEL

> describes about the services of producing and distributing programming is ambiguous and unclear.
>
> In sum, based on the limited record before us, we conclude that THE BASEBALL CHANNEL when considered as a whole in connection with "producing and distributing programming for others in the nature of baseball games . . . through broadcast media including television" is not merely descriptive. To the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor.

*Id.* at *7-8 (emphasis). Like that case, the Applicant here contends that regardless of whether the words "video" and "opinions" could be deemed to describe something in the abstract, the combination simply does not describe any aspect of the Applicant's services with any degree of particularity. *See also In re TMS*, 200 USPQ at 59 (finding THE MONEY SERVICE non-descriptive for financial services wherein funds are transferred to and from a savings account because it "falls short of describing applicant's services in any one degree of particularity"); *In re On Technology*, 41 USPQ2d (BNA) 1475 (finding AUDITTRACK non-descriptive for computer software for monitoring activity); *In re Cerner*, 2001 TTAB LEXIS 87.

**1. Respectfully, the Applicant Believes the Examiner Posits an Incorrect Proposition of Law When the Examiner States that the "Descriptive Feature of the Services" Does Not Have To Exist "in the Recitation of Services"**

The Examiner argues that VIDEOPINIONS does not have describe any aspect of the Applicant's recited class 35 services to be descriptive. The Applicant respectfully believes that this is an incorrect statement of the law. Although the Examiner acknowledges that whether a "mark is merely descriptive is determined in relation to the identified goods or services, not in the abstract" (Office Action, 8/17/07 at 2 (emphasis added)), the Examiner goes on to proffer a new proposition of law. The Examiner writes:

> Applicant is correct that whether a mark is merely descriptive is determined in relation to the identified goods or services, not in the abstract. . . . However, this does not mean that the descriptive

> feature of the services has to exist in the recitation of services in order for a mark to be merely descriptive. If this were the case, applicants could easily avoid descriptiveness refusals simply by being careful not to include in the recitation the feature of the goods or services described by the mark.

Office Action, 8/17/07 at 2 (citations omitted).

First, the Applicant respectfully contends that this proposition is incorrect. The Examiner does not cite any legal authority or precedent for this proposition. In fact, binding courts have consistently held that whether a particular term is "merely descriptive" must be determined in relation to the goods or services for which registration is sought. *In re Cerner*, 2001 TTAB LEXIS 87, at *3; *TMS*, 200 USPQ at 59; *In re The Stroh Brewery*, 34 USPQ2d (BNA) 1796, at *4-5 (TTAB 1995); *In re Majestic Distilling Co.*, 420 F.2d 1086 (C.C.P.A. 1970). And there are good reasons for this law. For example, imagine the situation where a computer manufacturer (who also sells apples) seeks the registration of the mark APPLE for only "computer manufacturing." The applicant should not be denied a registration of the mark for the claimed services simply because it also sells apples on the side. However, on the Examiner's reasoning, the Examiner need not consider the applicant's recited services for "computer manufacturing."

Second, the proper battlefield for disputing the recitation of services is, namely, a determination of whether the recitation of services was proper. If an examiner believes that the Applicant's recited services do not clearly, definitively, and/or accurately describe the Applicant's services, the Examiner may refuse registration on that basis. 37 C.F.R. § 2.32(a)(6); TMEP § 1402.01. However, in the present case, the Examiner has accepted the Applicants' recited services (but has simply chosen to ignore them). And third, the Applicant respectfully disagrees that a hypothetical "clever applicant" could easily avoid descriptiveness refusals by being careful not to include in the recitation of services the feature of the goods or services

described by the mark. Applicants choose descriptions for its services to accurately and definitively describe the services for which the mark will be used. It would be counterproductive for an applicant to remove from the applicant's recitation of services the very services it wishes to protect. An applicant's rights under the Lanham Act are restricted to the claimed services (and perhaps natural zones of expansion). If an applicant left out a feature for his description of services, the applicant would be surrendering rights for that particular use or service.

The Applicant, Expo Communications, Inc., provides and/or intends to provide various services. The only way to determine whether VIDEOPINIONS is descriptive for the purpose of Section 2(e)(1) is to look at the recited services claimed by the Applicant on a class-by-class basis.

**2. Respectfully, the Applicant Believes the Examiner Has Used Extrinsic Evidence In an Effort to Rewrite the Applicant's Recited Services**

Rather than simply looking at the Applicant's recited services in class 35, the Applicant respectfully believes that the Examiner has attempted to rewrite the Applicant's claimed services based on extrinsic evidence. The Examiner first looked to the webpages of two third party websites. The Examiner wrote:

> Attached are two web page articles or listings apparently indicating what is done through applicant's services. Consumers apparently review and rate different products or services, giving their opinions thereof. Note that in the first attachment, the person reviewing applicant's service regarded it as a place 'devoted to online video opinions." The second attachment apparently shows the result of a cooperative effort between the applicant and another party called "GamePro" where consumers offer reviews of games. Note how the term "videopinion" itself is used in lower case letters.

Office Action, 8/17/07 at 2. This passage indicates that the Examiner may be improperly using third party representations about Expo Communications, Inc. to rewrite the Applicant's services class 35 services.

The person referenced in the first attachment, Walter Koschnitzke, is an unrelated third party who apparently wrote the following on his blog: ". . . Expo Television, devoted to online video opinions, reviews and product demonstrations and buying tips." Clearly, the person is either not using the Applicant's mark, VIDEOPINIONS, at all or is misusing the Applicant's service mark. Nonetheless, Mr. Koschnitzke certainly has no authority to alter the Applicant's recited class 35 services for use of its VIDEOPINIONS mark. The Applicant cannot fathom a reasonable justification for giving greater weight to Mr. Koschnitzke's statement about as apsect of Expo Communications, Inc.'s business than the Applicant's own recited services in class 35. The second attachment refers to a webpage from a site called GamePro.com. The Examiner suggests that the Applicant condoned an improper and descriptive use of the mark "videopinion" when the Examiner points to GamePro's webpage and observes: "Note how the term 'videopinion' itself is used in lower case letters." The Applicant has taken steps to correct GamePro.com's inadvertent misuse of the Applicant's service mark. The Applicant has written to the third party and asked GamePro.com to modify its usage of VIDEOPINIONS. See Ex. 10. However and regardless, an example of a third party's inadvertent misuse of the Applicant's mark does constitute evidence that the Applicant's mark is descriptive.

The Examiner also apparently suggests that the Applicant indirectly limited its recited services when it answered the Examiner's questions posed in his January 10, 2006 office action. The Examiner writes:

> Applicant indicates that its services include soliciting, collecting, and sharing audiovisual demonstrations and information about consumer products and services, and admits that 'such audiovisual works may or may not include or involve a consumer's opinion about a particular product or service.

Office Action, 8/17/07 at 2. Applicant respectfully disagrees. The Applicant believes the Applicant's answers to the Examiner's questions from its January 10, 2006 office action is not an admission of descriptiveness—if that is what the Examiner is suggesting. The Examiner never asked about the Applicant's intended class 35 services and did not ask whether the Applicant intended to use VIDEOPINIONS in connection with any particular service. The Applicant said:

> The Applicant's services include soliciting, collecting, and sharing audiovisual demonstrations and information about consumer products and services. Such audiovisual works may or may not include or involve a consumer's opinion about a particular product or service, and may instead involve the demonstration of a particular product or service and useful information on it.

Applicant's statement that Expo Communications, Inc.'s overall services (at that time) included product demonstrations was not intended to limit its claimed class 35 services, which again, recites: "[p]roviding information on consumer products and services by way of a global computer network." Applicant contends that the best indication of an applicant's claimed services—especially for an intent-to-use application—is simply the applicant's recited services, not third party representations about the applicant's business or even the applicant's statements about some unspecified existing services—which may differ from the intended services defined exclusively by the recitation of services in the application.

### 3. The VIDEOPINIONS Mark Does Not Even Describe the Examiner's Revised Version of the Applicant's Services

The literal application of the definitions posited by the Examiner for "video" and "opinion" is not an accurate description of the Applicant's services. According to the Examiner, "video" is "being used for its normal meaning." Office Action, 8/17/06 at 2. Although it is unclear what that the normal meaning of "video" is, the Applicant presumes that the Examiner means the first of five definitions occurring from Miscrosoft® Encarta®'s dictionary, which is

the only dictionary source relied upon by the Examiner for the word "video." Encarta® states that "video" means: "visual part of television: the visual part of a television broadcast." According to the Examiner, "opinion" means "a view, judgment, or appraisal formed in the mind about a particular matter." Office Action, 8/17/06 at 2. Combining the terms, one obtains:

> Examiner's Definition of VIDEOPINIONS: "visual part of television: the visual part of a television broadcast; a view, judgment, or appraisal formed in the mind about a particular matter."

Moreover, the Examiner has apparently defined the Applicant's class 35 services thus:

> Examiner's Statement of Applicant's Services: "offer[ing] opinions about products and services on videotape"

Although Applicant disagrees with the Examiner's definition of VIDEOPINIONS and his depiction of Applicant's services, nevertheless, Applicant contends that there is no logical or rational way to get from the Examiner's definition of VIDEOPINIONS to the Examiner's rendition of the Applicant's services.

In the Examiner's first office action, the Examiner stated that "[i]t appears that the applicant's services will involve the provision of opinions by means of video." Office Action, 1/10/06 at 2. In the Applicant's response to that office action, the Applicant explained that the Applicant itself does not provide opinions in the form of videos, but rather, provides a means by which people can submit, share, and obtain product (and service) information. Now, the Examiner acknowledges that VIDEOPINIONS does not describe the services he originally attributed to the Applicant in the January 10, 2006 office action.

> Even though the applicant itself may not be expressing its own opinions about the goods and services of others, its services nonetheless feature opinions on video.

Office Action, 8/17/07 at 2. To circumvent the Applicant's response, the Examiner has simply changed his version of what he takes to be the Applicant's class 35 services. Instead of stating that the Applicant's services involve "the provision of opinions by means of video," the Examiner now states that the Applicant's service involves "consumers offer[ing] opinions about products and services on videotape." The Examiner now writes:

> Applicant seeks registration of VIDEOPINIONS for services wherein consumers offer opinions about products and services on videotape.

Office Action, 8/17/07 at 2. Although the this characterizes the Applicants' class 35 services as "offer[ing] opinions about products and services on videotape," the Examiner has conspicuously left out from his rendition of the Applicant's services anything involving the Applicant. According to the Examiner "consumers offer opinions about products and services on videotape." Applicant is not a consumer offering opinion about products and services on videotape. The Applicant does not create videos. The Applicant does not create opinions. The Applicant provides information by means of a global computer network. This is not the same as consumers offering opinions about products and services on videotape.[13]

The situation resembles that of the case of *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986), where the applicant applied for the mark SHOWROOM ONLINE for "leasing computer databases and video disks in the field of interior furnishings and related products of others." Reversing the examining attorney's refusal to register the mark under Section 2(e)(1), the Board

[13] The Examiner seems to recognize the awkwardness of his depiction of the Applicant's services when he writes: "the fact that the mark does not describe how the services are offered does not foreclose the finding of descriptiveness." Office Action, 8/17/06 at 2. However, when the services of the applicant are defined to include "how the services are offered" (as in this case), one cannot simply ignore this aspect of the Applicant's services. The Applicant's services in this case are "[p]roviding information on consumer products and services by way of a global computer network." One cannot ignore the fact that these services related to information distributed "by way of a global computer network."

noted that even though the mark could be viewed as describing some service in the abstract, it did not accurately describe the applicant's particular service.

> The theory on which the refusal of registration rests depends almost entirely on the definitions of the terms "showroom" and "online" and a literal application of those definitions to appellant's services. Thus, since a "showroom" is a room where merchandise is exposed for sale or where samples are displayed, and "online" indicates information that may be requested by and transmitted to a user through a computer terminal, the combination in relation to appellant's services, in the view of the Examining Attorney, conveys the immediate idea of providing an interior furnishings showroom by means of a computer terminal.
>
> While the definitions are accurate, the literal application of them to appellant's services is not. The product information which is provided in appellant's disks relates to the products of others. Appellant does not represent the manufacturers of these products, does not sell or lease interior furnishings, and is not otherwise in the interior furnishing business. Moreover, appellant does not take a pictorial representation of a showroom, or even data relating to a showroom, and place such online. Rather, it leases the means by which a user may obtain interior furnishings product information. Such information is typically found in catalogues. Although catalogues, as well as the products themselves, may be found in some furniture showrooms, showrooms have no direct significance in relation to appellant's leasing or information service. Accordingly, we disagree that the mark SHOWROOM ONLINE merely describes either the appellant's leasing service or its function or characteristics.

*Id.* at 759 (emphasis added). Like the applicant in *TBG*, the Applicant does not represent the manufacturers of the products demonstrated in videos, and does not sell each and every of the particular products demonstrated through its service. Moreover, Applicant's services here do not include offering opinions in the form of videotapes and do not include making videos containing opinions. The services include providing information via a global computer network. No matter how one unpacks and reinterprets "video opinion," it still does not describe any aspect of this service.

The Examiner also argues that if a proposed mark describes any small aspect of an applicant's services, the mark should be deemed descriptive of all of the applicant's services. Thus, the Examiner propounds that he need not prove that VIDEOPINIONS describes the recited class 35 services, but rather, the Examiner propounds that he only needs to show that it touches upon any single attribute of the services.

> It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods/services to be merely descriptive. It is enough if the term describes one attribute of the goods/services. . . .

Office Action, 8/17/06 at 2 (citations omitted). This proposition is more applicable where an applicant recites twenty different services in a single class, in which case, the mark could be deemed descriptive if it described with a degree of particularity any one of the twenty different services. This proposition may also be more applicable where the applicant recites a particular product—not a service—comprising multiple features, characteristics, and attributes.[14] Such the proposition clearly does not mean that a mark could be descriptive of a particular service without telling consumers anything about the service. Moreover, the Examiner still fails to point to a single attribute of the Applicant's recited class 35 services which is described by its mark.

## IV. SECTION 2(e)(1) REFUSAL OF CLASS 38

The Examiner has also refused registration of the Applicant's mark in class 38 under Section 2(e)(1). The Applicant respectfully traverses and requests reconsideration of the Examiner's refusal to register the VIDEOPINIONS mark in class 38. The Applicant contends that VIDEOPINIONS does not describe anything whatsoever, let alone "[t]elevision broadcasting, cable television broadcasting, satellite television broadcasting, and interactive

[14] The cases relied by the Examiner are distinguishable because they both deal with products, not services. *See, e.g., In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982) (bathroom toiletry); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973) (non-lethal weapon which fires a deformable projectile, tear gas cannisters).

video-on-demand transmission services, all in the field of information on consumer products and services." An analysis under Section 2(e)(1) requires, *inter alia*, an objective analysis of the mark to determine what it means, if anything, to consumers; and a determination of whether the mark describes with a degree of particularity the recited class 38 services claimed by the Applicant. As many of the Applicant's arguments for registration of the mark in class 35 overlap with class 38, for the convenience the Examiner, the Applicant incorporates those arguments by reference and does not repeat all arguments in full, but provides a brief summary instead.

### A. The Coined Mark VIDEOPINIONS Has No Known Meaning

As discussed in detail above, whereas the words "video" and "opinion" have many known meanings, the combination "video opinions" has no recognized meaning.[15] The Applicant's VIDEOPINIONS mark is a unique expression, coined by the Applicant for use in connection with its service (and/or intended service) of "[t]elevision 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." The mark VIDEOPINIONS has no dictionary definition, and there is no such thing as a "videopinions" or a "video opinions." *See, e.g.*, *Harrington*, 219 USPQ 854, 856 ("the composite of the two words is not a term in general use to describe educational services (or anything else, for that matter) and has no dictionary meaning").

Given the various meanings of the terms "opinion" and "video," one cannot come to any clear understanding as to what "videopinions" or "video opinions" could possibly mean. There are hundreds of permutations of the various definitions, many of which make no sense. Moreover, there is no evidence of common usage of VIDEOPINIONS or "video opinions" in

[15] Neither "video" nor "opinion" is descriptive for class 38. See Ex. 6 (video-related registrations) and Ex. 12 (opinion-related registrations).

"[t]elevision 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." The two attachments proffered by the Examiner purporting to show instances of use of "video opinions" are not relevant. Apart from other deficiencies described above, neither attachment shows a use of "video opinions" to mean "[t]elevision 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," which is the Applicant's class 38 services at issue. *L.Vad Technology*, 2006 TTAB LEXIS 160 at *8. For example, the person quoted in the "Private Articles" article was clearly not talking about "interactive video-on-demand transmission services, all in the field of information on consumer products and services." Regardless, finding a single use of the phrase "video opinions" itself would not be sufficient to demonstrate descriptiveness of the Applicant's mark. *Adamchik*, 2006 TTAB LEXIS 345, *8-10.

Although the Examiner concluded (without supporting evidence) that VIDEOPINIONS does not create an impression differing from that created by the two words, it has been found that when a new mark is subject to multiple meanings, the mark is suggestive—not descriptive. *See, e.g., FineLine*, 2006 TTAB LEXIS 339, at *9-12. The Applicant contends that upon hearing VIDEOPINIONS, a consumer must engage in highly mature thought processes and multiple steps to arrive at anything remotely resembling any aspect of the Applicant's specific recited class 38 services. *Tennis in the Round*, 199 USPQ at 498. Moreover, the Applicant's specific mark is not needed by competitors to identify their own services. *TMS*, 200 USPQ at 59; *Dollar-A-Day Rent-A-Car Systems*, 173 USPQ at 437.

**B. The Coined Mark VIDEOPINIONS Does Not Describe Applicants' Recited Class 38 Services, Namely, "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."**

The Applicant also contends that VIDEOPINIONS does not describe with a degree of particularity any aspect of the Applicant's recited class 38 services, namely, "[t]elevision 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." Rather than looking that the recited services of class 38, the Examiner appears to have rewritten the Applicant's services to be the following:

> Applicant seeks registration of VIDEOPINIONS for services wherein consumers offer opinions about products and services on videotape.

Office Action, 8/17/07 at 2. But the services recited in class 38 is for the following:

> 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.

The Applicant's recited class 38 services never mentions opinions and never mentions videotape. It appears that the Examiner has attempted to rewrite the Applicant's services such that it conforms to the Examiner's chosen definitions of the words "opinions" and "video." Regardless of whether the words "video" and "opinions" could be deemed to describe something in the abstract, the combination simply does not describe any aspect of the Applicant's services with any degree of particularity. *See Major League Baseball Properties*, 2005 TTAB LEXIS 94; *TMS*, 200 USPQ at 59; *On Technology*, 41 USPQ2d 1475; *In re Cerner*, 2001 TTAB LEXIS 87.

## V. SECTION 2(e)(1) REFUSAL OF CLASS 41

The Examiner has also refused registration of the Applicant's mark in class 41 under Section 2(e)(1). The Applicant respectfully traverses and requests reconsideration of the Examiner's refusal to register the VIDEOPINIONS mark in class 41. The Applicant contends that VIDEOPINIONS does not describe anything whatsoever, let alone "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services." As many of the Applicant's arguments for registration of the mark in class 35 and 38 overlap with class 41, for the convenience the Examiner, the Applicant incorporates those arguments by reference and does not repeat all arguments in full, but provides a summary instead.

### A. The Coined Mark VIDEOPINIONS Has No Known Meaning

As discussed in detail above, whereas the words "video" and "opinion" have many known meanings, the combination "video opinions" has no recognized meaning.[16] The Applicant's VIDEOPINIONS mark is a unique expression, coined by the Applicant for use in connection with its service (or intended service) of "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services." The mark VIDEOPINIONS has no dictionary definition. *Harrington*, 219 USPQ 854, 856.

Given the various meanings of the terms "opinion" and "video," one cannot come to any clear understanding as to what "videopinions" or "video opinions" could possibly mean. Moreover, there is no evidence of common usage of VIDEOPINIONS or "video opinions" in "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services." The two attachments proffered by the

[16] Neither "video" nor "opinion" is descriptive for class 41. See Ex. 6 (video-related registrations) and Ex. 12 (opinion-related registrations).

Examiner purporting to show instances of use of "video opinions" are not relevant as neither attachment shows a use of "video opinions" to mean "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services," which is the Applicant's class 41 services at issue. *L.Vad Technology*, 2006 TTAB LEXIS 160 at *8.[17] Although the Examiner summarily concluded that VIDEOPINIONS does not create an impression differing from that created by the two words, when a new mark is subject to multiple meanings, the mark is suggestive—not descriptive. *See, e.g.*, *FineLine*, 2006 TTAB LEXIS 339, at *9-12. The Applicant also contends that the Applicant's specific mark is not needed by competitors to identify their own services. *TMS*, 200 USPQ at 59. There is no evidence that any television network or consumer information service uses "videopinions" or "video opinions" to describe similar services. *Dollar-A-Day Rent-A-Car Systems*, 173 USPQ at 437.

**B. The Coined Mark VIDEOPINIONS Does Not Describe Applicants' Recited Class 41 Services, Namely, "[E]ntertainment Services In The Nature Of On-Going Television Programs In The Field Of Information About Consumer Products And Services."**

The Applicant contends that VIDEOPINIONS does not describe with any degree of particularity any aspect of the Applicant's recited class 41 services, namely, "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services." Rather than looking at the Applicant's recited services for class 41, the Examiner appears to have rewritten the Applicant's services to be the following:

> Applicant seeks registration of VIDEOPINIONS for services wherein consumers offer opinions about products and services on videotape.

Office Action, 8/17/07 at 2. Again, the service recited in class 41 is for the following:

[17] Moreover, finding a single use of the phrase "video opinions" itself would not be sufficient to demonstrate descriptiveness of the Applicant's mark. *Adamchik*, 2006 TTAB LEXIS 345, *8-10.

> Entertainment services in the nature of on-going television programs in the field of information about consumer products and services.

The Applicant's recited class 41 services never mentions opinions and never mentions videotape. It appears that the Examiner attempted to rewrite the Applicant's services such that it conforms to the Examiner's chosen definitions of the words "opinions" and "video." Regardless of whether the words "video" and "opinions" could be deemed to describe something in the abstract, the combination simply does not describe any aspect of the Applicant's services with any degree of particularity. *See Major League Baseball Properties*, 2005 TTAB LEXIS 94; *TMS*, 200 USPQ at 59; *On Technology*, 41 USPQ2d 1475; *In re Cerner*, 2001 TTAB LEXIS 87.

* * * *

On the issue of whether a particular mark is merely descriptive, the examiner bears the burden of showing that the mark only describes the identified goods or services. *See In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987); *Grand Forest Holdings*, 78 USPQ2d 1152. The Board has indicated time-and-again that if there are any doubts on the issue of descriptiveness after considering the evidence, such doubt must be resolved in favor of the applicant, allowing the mark to be published so that if competitors have a need to use the term, they may oppose registration of it to applicant. *In re Gourmet Bakers, Inc.*, 173 USPQ (BNA) 565, at *1 (TTAB 1972), *accord*, *On Technology*, 41 USPQ2d (BNA) 1475, at *8; *In re Telechat Networks, Inc.*, 2006 TTAB LEXIS 178, at *8 (TTAB May 11, 2006) ("Because we have doubts as to whether applicant's mark is merely descriptive, we resolve those doubts, as we are required to do, in applicant's favor."). In this case, the Applicant contends that it has raised several doubts as to the Examiner's initial identification of the Applicant's mark as "merely descriptive."

## VI. NOTICE OF APPEAL

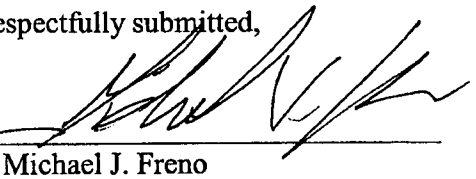
As the Examiner August 17, 2006 refusal to register was made final, Applicant is also filing, concurrently herewith, a Notice of Appeal to preserve the application. A copy of that filing is attached herewith at Ex. 11.

## CONCLUSION

For the foregoing reasons, the Applicant respectfully requests that the Examiner: (i) reconsider the decision to make the August 17, 2006 action final; and (ii) reconsider the refusal to register the mark in classes 35, 38, and 41 under Section 2(e)(1). For the foregoing reasons, the Applicant respectfully requests the Examiner to pass the mark on for publication in the *Official Gazette*. If the Examiner should have any questions regarding this application, the undersigned attorney would be happy to speak with him and answer any questions.

Respectfully submitted,

Dated: February 20, 2007

By: 

Michael J. Freno
KENYON & KENYON LLP
One Broadway
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(212) 425-7200

*Attorney for Applicant*

# EXHIBIT 1

# Dictionary

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**Dictionary** **Thesaurus** **Translations**

A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

- *vid*
- *Vidalia onion*
- *vidarabine*
- *vidclip*
- *vide*
- *vide infra*
- *vide supra*
- *videlicet*
- **video**
- *video adapter*
- *video arcade*
- *video blog*
- *video camera*
- *video card*
- *video display terminal*
- *video frequency*
- *video game*

## *video*

video

**vid·e·o** [ víddee ò ]

noun (*plural* vid·e·os)

**Definition:**

1. **visual part of television:** the visual part of a television broadcast

2. **something recorded onto videotape:** something that has been recorded on videotape, especially a movie or music performance
   - *a video of my brother's wedding*

3. **videocassette:** videotape, or a videocassette ( *informal* )
   - *now available to rent or buy on video*

4. COMPUT **images on computer screen:** the text and graphics images that appear on a computer screen

5. **image reproduction industry:** the industry of recording and broadcasting visual information and entertainment, especially that which can be viewed on a television
   - *a star of stage, screen, and video*

adjective

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See pronunciation key

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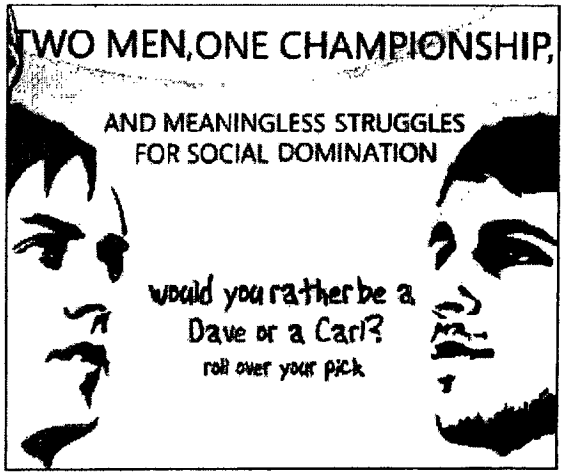


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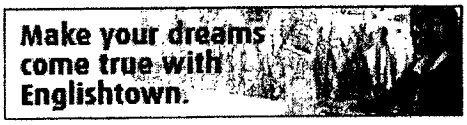


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**Definition:**

**1. relating to visual image reproduction:** relating to the recording or broadcasting of visual information or entertainment by means of videotape or television

**2. relating to video frequencies:** relating to or using video frequencies

[Mid-20th century. < Latin *videre* "to see," after audio]

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# Dictionary

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*vid•e•o*

*Pronunciation: (vid'ē-ō"), [key]*
*—n.*
**1.** *Television.*
**a.** *the elements of television, as in a program or script, pertaining to the transmission or reception of the image (distinguished from audio).*
**b.** *the video part of a television broadcast.*
**2.** *Informal.videotape.*
**3.** *Informal.television: She is a star of stage and video.*
**4.** *a program, movie, or the like, that is available commercially on videocassette.*
**5.** *See* **music video.**

*—adj.*
**1.** *of or pertaining to the electronic apparatus for producing the television picture: video amplifier.*
**2.** *of or pertaining to television, esp. the visual elements.*
**3.** *of or pertaining to videocassettes, videocassette recorders, music video, etc.: a video shop.*
**4.** *pertaining to or employed in the transmission or reception of television pictures.*

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*videlicet** *video art*

***See also:*** *video (Thesaurus)*

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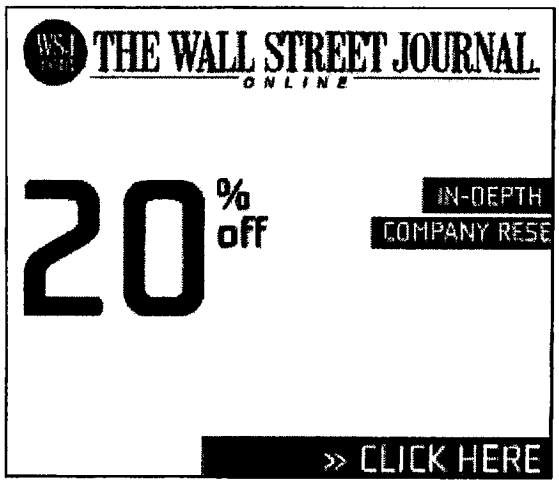


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# video

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video[1,noun]
video[2,adjective]
digital video disc
home video
video camera
video card
Go

Main Entry: **1vid·eo**
Pronunciation: 'vi-dE-"O
Function: *noun*
Etymology: Latin *vidE*re to see + *-o* (as in *audio*)
**1 :** TELEVISION; *also* : the visual portion of television
**2 :** VIDEOTAPE: as **a :** a recording of a motion picture or television program for playing through a television set **b :** a **videotaped** performance of a song often featuring an interpretation of the lyrics through visual images
**3 :** a recording similar to a **videotape** but stored in digital form (as on an optical disk or a computer's hard drive)

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MilitaryConne

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# video

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video[1,noun]
video[2,adjective]
digital video disc
home video
video camera
video card
Go

Main Entry: **2video**
Function: *adjective*
**1 :** being, relating to, or used in the transmission or reception of the television image <a *video* channel> -- compare AUDIO
**2 :** being, relating to, or involving images on a television screen or computer display <a *video* terminal>

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Pronunciation Symbols



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**vid·e·o** [**vid**-*ee-oh*] Pronunciation Key – Show IPA Pronunciation

*-noun*

1. *Television.*
   a. the elements of television, as in a program or script, pertaining to the transmission or reception of the image (distinguished from AUDIO).
   b. the video part of a television broadcast.
2. *Informal.* VIDEOTAPE.
3. *Informal.* television: *She is a star of stage and video.*
4. a program, movie, or the like, that is available commercially on videocassette.
5. MUSIC VIDEO.

*-adjective*

6. of or pertaining to the electronic apparatus for producing the television picture: *video amplifier.*
7. of or pertaining to television, esp. the visual elements.
8. of or pertaining to videocassettes, videocassette recorders, music video, etc.: *a video shop.*
9. pertaining to or employed in the transmission or reception of television pictures.

[Origin: 1930–35; < L *vidé(re)* to see + *-o* as in AUDIO]

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**music video**

*-noun*

a commercial videotape featuring a performance of a popular song, often through a stylized dramatization by the performers with lip-synching and special effects.

Also called **video, video record.**

*Dictionary.com Unabridged (v 1.1)*
*Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006.*

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**vid·e·o** (vĭd'ē-ō') Pronunciation Key

adj.

1. Of or relating to television, especially televised images.
2. Of or relating to videotaped productions or videotape equipment and technology.
3. *Computer Science* Of or relating to the production of images on video displays.

n. *pl.* **vid·e·os**

1. The visual portion of a televised broadcast.
2. Television: *a star of stage, screen, and video.*
3. A videocassette or videotape, especially one containing a recording of a movie, music performance, or television program.
4. A music video.
5. *Computer Science* The appearance of text and graphics on a video display.

[From Latin `videō`, first person sing. present tense of `vidēre`, *to see*; see **vide**.]

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**video**

*noun*

1. the visible part of a television transmission; "they could still receive the sound but the picture was gone"
2. a recording of both the video and audio components (especially one containing a recording of a movie or television program) [syn: video recording]
3. broadcasting visual images of stationary or moving objects; "she is a star of screen and video"; "Television is a medium because it is neither rare nor well done" - Ernie Kovacs [syn: television]

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**video** (adj., n., pref.)

1935, as visual equivalent of audio, from L. *video* "I see," first person singular present indicative of *videre* "to see" (see vision). *Videotape* (n.) is from 1953; the verb is 1959, from the noun; *videocassette* is from 1971; *video game* is from 1973. *Videocassette recorder* is from 1971, now usually *VCR* (also 1971).

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**video**[1] ['vidiəu] *noun — plural* **'videos**

the recording or broadcasting (by means of a **video recorder**) of television pictures and sound

*Arabic:* فيديو
*Chinese (Simplified):* □□□□□
*Chinese (Traditional):* □□□□□
*Czech:* videofonie
*Danish:* video
*Dutch:* het opnemen, uitzenden op video
*Estonian:* videosalvestis
*Finnish:* kuvanauhoitus
*French:* vidéophonie
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*Portuguese (Brazil):* vídeo
*Portuguese (Portugal):* video
*Romanian:* videofonie
*Russian:* видеозапись
*Slovak:* video
*Slovenian:* video
*Spanish:* vídeo
*Swedish:* video
*Turkish:* video kaydı

**video**[2] ['vidiəu] *noun*

a videotape

*Arabic:* شريط تسجيل فيديو
*Chinese (Simplified):* □□□
*Chinese (Traditional):* □□□
*Czech:* videokazeta
*Danish:* videomaskine
*Dutch:* videoband
*Estonian:* videolint
*Finnish:* videonauha
*French:* bande magnétoscopique
*German:* das Video
*Greek:* βιντεοταινία
*Hungarian:* videoszalag
*Icelandic:* myndband
*Japanese:* □□□□□□
*Latvian:* videolente; videokasete
*Lithuanian:* vaizdajuostė
*Norwegian:* videokassett
*Polish:* taśma video
*Portuguese (Brazil):* videoteipe
*Portuguese (Portugal):* filme video
*Romanian:* bandă video
*Russian:* видеоплёнка
*Slovak:* videokazeta
*Slovenian:* magnetni trak
*Spanish:* cinta de

*Italian:* video, videocassetta

*Swedish:* videoband

*Turkish:* teyp

**video**[3] ['vidiəu] *noun*

(*also* **video cassette recorder; ~VCR**) a machine used for watching or recording television films and programmes on videotape

*Arabic:* جهاز فيديو

*Chinese (Simplified):* [illegible]

*Chinese (Traditional):* [illegible]

*Czech:* video(rekordér)

*Danish:* videomaskine

*Dutch:* videorecorder

*Estonian:* videomagnetofon

*Finnish:* videonauhuri

*French:* magnétoscope

*German:* der Video(rekorder)

*Greek:* συσκευή μαγνητοσκόπησης, βίντεο

*Hungarian:* videomagnó

*Icelandic:* myndbandstæki

*Indonesian:* mesin perekam, *pemutar pita video

*Italian:* video, videoregistratore

*Japanese:* [illegible]

*Latvian:* videomagnetofons

*Lithuanian:* kasetinis vaizdo magnetofonas

*Norwegian:* videospiller, videoopptaker

*Polish:* magnetowid

*Portuguese (Portugal):* gravador video

*Romanian:* videocasetofon

*Russian:* видеомагнитофон

*Slovak:* videorekordér

*Slovenian:* videorekorder

*Spanish:* vídeo, grabador de vídeo

*Swedish:* videobandspelare

*Turkish:* video kayıt cihazı

**video** ['vidiəu] *verb*

to record on a video recorder or videotape

Example: *He videoed the television programme on volcanoes.*

*Arabic:* يُسَجِّل على شريط تسْجيل فيديو

*Chinese (Simplified):* [illegible]

*Chinese (Traditional):* [illegible]

*Czech:* nahrát na video

*Danish:* optage på video

*Dutch:* op een videoband opnemen

*Estonian:* videosalvestama

*Finnish:* videoida

*French:* enregistrer au magnétoscope

*German:* auf Video aufzeichnen

*Greek:* μαγνητοσκοπώ

*Icelandic:* taka upp á myndband

*Indonesian:* merekam dengan video

*Italian:* registrare (su videocassetta)*

*Korean:* [illegible]

*Latvian:* ierakstīt videolentē

*Lithuanian:* įrašyti į vaizdajuostę

*Norwegian:* ta opp på video

*Polish:* nagrać na taśmie video

*Portuguese (Brazil):* gravar em vídeo

*Portuguese (Portugal):* passar em video

*Romanian:* a înregistra pe video

*Russian:* записывать на видео

*Slovak:* zachytiť na video

*Slovenian:* posneti na

*Spanish:* grabar en vídeo
*Swedish:* spela in på video
*Turkish:* videoya çekmek, *almak

*See also:* video (cassette) recorder, video arcade, video camera, video jockey, videotape

*Kernerman English Multilingual Dictionary (Beta Version), © 2000–2006 K Dictionaries Ltd.*

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# EXHIBIT 5

Entry printed from *Oxford English Dictionary Online*

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# video, *n.*

*SECOND EDITION 1989*

('vɪdɪəʊ) [f. L. *vidē-re* to see + -O, after AUDIO-.]

Absol. use of VIDEO-.

**1.** That which is displayed or to be displayed on a television screen or other cathode-ray tube; the signal corresponding to this.

**1937** *Printers' Ink Monthly* May 45/2 *Video*, the sight channel in television, as opposed to audio, the sound channel. **1940** *Broadcasting* 1 June 32 Video seen 230 miles at sea. Clear steady images picked up during test. **1946** [see DISPLAY *n.* 1c]. **1949** *Hollywood Q.* Winter 157 And pipe the finished output of these segments, both video and audio, instantaneously and simultaneously to the kinescope recorders. **1951** *Proc. IRE* XXXIX. 8/1 One cycle of video during active horizontal scanning represents one dark and one light picture element on a particular scanning line. **1960** J. L. BERNSTEIN *Video Tape Recording* p. vii, Directors, editors, cameramen, and others..would benefit if they could learn the processes involved in recording video on tape. **1964** *Times* 7 Feb. p. iv/3 Except for its width..video tape looks exactly like sound recording tape. But it records not only sound but a continuous picture—video—as well! **1976** *Aviation Week* 10 May 131/1 An IBM scan converter transforms radar video into a format suitable for presentation on the TV monitors. **1977** *Gramophone* Aug. 361/2, I see it as the precursor of the all-purpose high quality cassette recorder that will record both video and audio. **1979** W. C. BRANDENBURG *Introd. Television Servicing* ii. 4/2 Both the audio and video can be broadcasted from the same antenna. **1982** G. WHITE *Video Techniques* vi. 134 Sound is as important as the video and often more difficult to edit.

**2.** Television as a broadcasting medium. *U.S. colloq.*

**1941** *Amer. Mercury* Nov. 581/2 *Vidio*,..television. **1946** *Time* 25 Feb. 72 NBC published a 55-page booklet, listing words & phrases commonly used in video. **1954** *Billboard* 13 Nov. 21 Most of the big name spinners have taken a fling in video during the last five years, but their survival-average has been low. **1979** *Boston Globe* 10 Apr. 32 Their play was flashed by video to an adjoining room where experts commented on it before a throng.

**3.** A video recorder; also, a VDU.

**1958** *Observer* 26 Jan. 14/6 The Video is like a combined tape-recorder and cinema camera. It records your television appearance complete with sound track and can be played back at the touch of a switch. **1979** *Television & Home Video* Mar. 7/2 There's not a lot of point in owning a home video and using it to record the rubbish you might otherwise have missed. **1982** *Times* 7 May 17/5 Last year over 900,000 videos were

rented or sold in Britain. **1983** *What's New in Computing* Jan. 5/1 The rest of the machine, the discs, the power supplies and the videos are all retained or upgraded and existing software can be run side by side with new software. **1984** S. TOWNSEND *Growing Pains A. Mole* 190 We are the only family in our street who haven't got a video.

**4.** A video recording; videotape as a recording medium.

**1968** *Observer* 14 Jan. 28/4 The days of the disc, in the pop world at least, are numbered. For soon will come the video. We will have the top 20 videos which you plug into your home video-machine. **1978** *Radio Times* 4-10 Mar. 4/2 We've got some video of a man he has already made contact with... We'll just have to cut in with that if necessary. **1981** *Church Times* 7 Aug. 5/3 They..went down to BBC television... Later he popped round to the school and showed them a video of themselves. **1983** *New Scientist* 3 Mar. 569/1 The BBC recognised early on that there was money to be made from selling archive programmes on video. **1984** *Melody Maker* 6 Oct. 3/1 Spandau Ballet have just returned from Hong Kong where they filmed the video for 'Highly Strung'.

**5.** The production or use of video recordings.

**1970** *It* 9-24 Apr. 7 There are also groups of people exploiting video in any way they can think of. **1977** *N.Y. Rev. Bks.* 23 June 25/4 Made images move (cinema) and achieved their simultaneous recording and transmission (video). **1980** *Times* 31 Mar. 24/6 There are enough able practitioners around to demonstrate how effectively video, like any other artistic tool, can be used. **1980** C. MACCABE *Godard* 26 You envisaged a different kind of distribution: film and video as a handcraft industry. **1982** *Listener* 11 Feb. 34/3 The good news is that things in video could be worse. The bad news is that things in video will get worse.

---

DRAFT ADDITIONS JUNE 2001

**video**, *n.*

▸ **video on demand** *Broadcasting*, a pay-per-view television service accessed via a telephone line, which allows a customer to select at any time from a list of programmes; abbreviated *VOD*.

**1983** *Telephone Engineer & Managem.* (Nexis) 15 July 92 Customers..will demand not only voice service, but access to data, text display, remote telemetry, *video on demand, and broadband services. **1990** M. M. MIRABITO & B. MORGENSTEIN *New Communications Technol.* vii. 137/2 The new system, the so-called 'video on demand,' could offer the same collection of television shows in addition to self-help and exercise videotapes, movies, and a library of older television programs. **2000** *Atlanta Jrnl. & Constit.* (Electronic ed.) 26 Nov., Once it reaches the head end, the customer's order triggers a server that holds hundreds of digitized movies. The server signals the cable company's billing system, and the video-on-demand order is added to the customer's cable bill.

# EXHIBIT 6

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFASHION |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Entertainment, namely a continuing fashion and lifestyle show distributed over Television, satellite, audio, and video media; production and distribution of motion pictures; production of television fashion and lifestyle programs; videotape production. FIRST USE: 19770100. FIRST USE IN COMMERCE: 19770100 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78025083 |
| **Filing Date** | September 8, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | November 26, 2002 |
| **Registration Number** | 2688697 |
| **Registration Date** | February 18, 2003 |
| **Owner** | (REGISTRANT) Video Edition, Inc. CORPORATION NEW YORK 100 Avenue of the Americas, 12th Floor New York NEW YORK 10013 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL-2(F) |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEO/VISUALS, INC. |
| **Goods and Services** | IC 040. US 106. G & S: VIDEOTAPE DUPLICATION SERVICES. FIRST USE: 19750000. FIRST USE IN COMMERCE: 19750000<br><br>IC 041. US 107. G & S: VIDEOTAPE PRODUCTION SERVICES AND VIDEO EQUIPMENT RENTAL SERVICES. FIRST USE: 19750000. FIRST USE IN COMMERCE: 19750000 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 73672405 |
| **Filing Date** | July 16, 1987 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 5, 1988 |
| **Registration Number** | 1506452 |
| **Registration Date** | September 27, 1988 |
| **Owner** | (REGISTRANT) VIDEO/VISUALS, INC. CORPORATION MASSACHUSETTS 63 CHAPPEL STREET NEWTON MASSACHUSETTS 02158 |
| **Attorney of Record** | MARGARET M. GEARY |
| **Disclaimer** | NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INC." APART FROM THE MARK AS SHOWN |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSTORE1 |
| **Goods and Services** | IC 038. US 100 101 104. G & S: BROADCASTING SERVICES, NAMELY, FILE BROADCASTING OF VIDEO DATA VIA A GLOBAL INFORMATION NETWORK. FIRST USE: 19970201. FIRST USE IN COMMERCE: 20001001 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75598650 |
| **Filing Date** | December 3, 1998 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | November 16, 1999 |
| **Registration Number** | 2470164 |
| **Registration Date** | July 17, 2001 |
| **Owner** | (REGISTRANT) TRANZ-SEND BROADCASTING NETWORK, INC. CORPORATION CALIFORNIA 601 Van Ness Avenue Suite E3613 San Francisco CALIFORNIA 94102 |
| **Attorney of Record** | Teresa C. Tucker |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSPACE |
| **Goods and Services** | IC 035. US 100 101 102. G & S: online retail store services provided via a global computer network featuring DVDs, movies, music, compact discs, books, magazines, posters, clothing, toys, games and computer, video and electronic games. FIRST USE: 20030328. FIRST USE IN COMMERCE: 20030328<br><br>IC 041. US 100 101 107. G & S: Providing a web site containing information and content on movies, videos, music, toys, games and electronic games. FIRST USE: 20030328. FIRST USE IN COMMERCE: 20030328 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78301725 |
| **Filing Date** | September 17, 2003 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | June 8, 2004 |
| **Registration Number** | 2929837 |
| **Registration Date** | March 1, 2005 |
| **Owner** | (REGISTRANT) Razor & Tie Direct, L.L.C. LTD LIAB CO NEW YORK 214 Sullivan Street, Suite 4A New York NEW YORK 10012 |
| **Attorney of Record** | Todd Braverman |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSHOPPING |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Conducting market and consumer research and preparing advertisements for others; namely, developing new product ideas and store or section layouts. FIRST USE: 19900712. FIRST USE IN COMMERCE: 19900712 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75688239 |
| **Filing Date** | April 21, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | December 7, 1999 |
| **Change In Registration** | CHANGE IN REGISTRATION HAS OCCURRED |
| **Registration Number** | 2324504 |
| **Registration Date** | February 29, 2000 |
| **Owner** | (REGISTRANT) New Product Insights, Inc. CORPORATION MISSOURI 8700 Indian Creek Parkway Overland Park KANSAS 66210<br><br>(LAST LISTED OWNER) NPI, INC. CORPORATION MISSOURI ONE WARD PARKWAY, SUITE 236 OVERLAND PARK KANSAS 64112 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | MARCIA J. RODGERS |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | **LIVE** |

## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSEEKER |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Preparing and placing advertising in an electronic magazine accessed through a global computer network; Promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through computer networks. FIRST USE: 19980420. FIRST USE IN COMMERCE: 19980420<br><br>IC 041. US 100 101 107. G & S: Providing information regarding television programming, entertainment, music and video, recreational activities and cultural and civic events via a global computer network; providing multi-user on-line computer games and contests; providing an online computer data base of links to other websites in the field of music and entertainment. FIRST USE: 19980420. FIRST USE IN COMMERCE: 19980420<br><br>IC 042. US 100 101. G & S: Computer services, namely, providing an on-line database of information, web sites and other resources in a wide variety of subjects; providing search engines for obtaining data on a global computer network. FIRST USE: 19980420. FIRST USE IN COMMERCE: 19980420 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75604593 |
| **Filing Date** | December 21, 1998 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | November 2, 1999 |
| **Registration Number** | 2311563 |
| **Registration Date** | January 25, 2000 |
| **Owner** | (REGISTRANT) National Broadcasting Company, Inc. CORPORATION DELAWARE 30 Rockefeller Plaza New York NEW YORK 10112<br><br>(LAST LISTED OWNER) NBC UNIVERSAL, INC. CORPORATION DELAWARE 30 ROCKEFELLER PLAZA NEW YORK NEW YORK 10112 |
| **Assignment** | ASSIGNMENT RECORDED |

| | |
|---|---|
| **Recorded** | |
| **Attorney of Record** | Gillian M. Lusins |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSECRETS |
| **Goods and Services** | (CANCELLED) IC 035. US 100 101 102. G & S: [ Dissemination of advertisements for others via a global on-line computer communications network ]. FIRST USE: 19961230. FIRST USE IN COMMERCE: 19961230<br><br>IC 038. US 100 101 104. G & S: Broadcast of live adult entertainment via a global on-line computer communications network. FIRST USE: 19961230. FIRST USE IN COMMERCE: 19961230<br><br>IC 041. US 100 101 107. G & S: Production of live adult entertainment for distribution by web sites of others via a global on-line computer communications network. FIRST USE: 19961230. FIRST USE IN COMMERCE: 19961230 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75796295 |
| **Filing Date** | September 10, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | February 29, 2000 |
| **Change In Registration** | CHANGE IN REGISTRATION HAS OCCURRED |
| **Registration Number** | 2352104 |
| **Registration Date** | May 23, 2000 |
| **Owner** | (REGISTRANT) VS Media, Inc. CORPORATION CALIFORNIA 250 North Westlake Boulevard Westlake Village CALIFORNIA 91362 |
| **Attorney of Record** | BERNARD R. GANS |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. PARTIAL SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 87 out of 167**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEORESUMECREATOR |
| **Goods and Services** | IC 035. US 100 101 102. G & S: providing an online computer database in the field of employment. FIRST USE: 20000801. FIRST USE IN COMMERCE: 20000801 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76119038 |
| **Filing Date** | August 25, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 18, 2001 |
| **Registration Number** | 2516936 |
| **Registration Date** | December 11, 2001 |
| **Owner** | (REGISTRANT) QuikView, Inc. CORPORATION CALIFORNIA 4280 Brisbane Circle El Dorado Hills CALIFORNIA 95762 |
| **Attorney of Record** | Robert D. Fish |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOPLAN |
| **Goods and Services** | IC 041. US 107. G & S: RENTAL OF VIDEOCASSETTES THROUGH LIBRARIES. FIRST USE: 19831204. FIRST USE IN COMMERCE: 19831204 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 73521479 |
| **Filing Date** | February 11, 1985 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 22, 1986 |
| **Registration Number** | 1413686 |
| **Registration Date** | October 14, 1986 |
| **Owner** | (REGISTRANT) VIDEOPLAN, INC. CORPORATION CALIFORNIA 19122 SOUTH VERMONT AVENUE GARDENA CALIFORNIA 90248 |
| **Attorney of Record** | ALAN H. LEVINE |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 172 out of 722**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOMINING |
| **Goods and Services** | IC 041. US 100 101 107. G & S: PROVIDING AN ONLINE COMPUTER DATABASE IN THE FIELD OF VIDEO CLIPS THAT ARE SEARCHABLE USING KEY WORDS AND OTHER FIELDS. FIRST USE: 19990900. FIRST USE IN COMMERCE: 19990900<br><br>IC 039. US 100 105. G & S: ELECTRONIC STORAGE AND ARCHIVING OF VIDEO CLIPS AND VIDEO MATERIALS OF OTHERS ON A COMPUTER SERVER ACCESSIBLE VIA GLOBAL COMPUTER NETWORK. FIRST USE: 19990900. FIRST USE IN COMMERCE: 19990900 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75732869 |
| **Filing Date** | June 21, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | May 15, 2001 |
| **Registration Number** | 2571867 |
| **Registration Date** | May 21, 2002 |
| **Owner** | (REGISTRANT) Technology Education Network, Inc. CORPORATION DELAWARE 450 Saw Mill River Road Ardsley NEW YORK 105022605 |
| **Attorney of Record** | ANNA C. SILVA |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOMATE |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Casino gaming services |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76329471 |
| **Filing Date** | October 24, 2001 |
| **Current Filing Basis** | 44E |
| **Original Filing Basis** | 1B;44D |
| **Published for Opposition** | October 29, 2002 |
| **Registration Number** | 2677069 |
| **Registration Date** | January 21, 2003 |
| **Owner** | (REGISTRANT) Aristocrat Technologies Australia Pty Ltd CORPORATION AUSTRALIA 71 Longuevile Road Lane Cove, New South Wales AUSTRALIA |
| **Attorney of Record** | Michael D. Hobbs Jr |
| **Priority Date** | April 30, 2001 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 129 out of 167**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOMASTERS |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Business marketing consulting services. FIRST USE: 20000401. FIRST USE IN COMMERCE: 20000401 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75710507 |
| **Filing Date** | June 17, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | January 11, 2000 |
| **Registration Number** | 2672504 |
| **Registration Date** | January 7, 2003 |
| **Owner** | (REGISTRANT) VIDEOMASTERS, INC CORPORATION VIRGINIA 2200 Dunbarton Drive, Suite D Chesapeake VIRGINIA 23325 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOMARATHON |
| **Goods and Services** | IC 035. US 100 101 102. G & S: ADVERTISING AGENCY SERVICES |
| | IC 041. US 100 101 107. G & S: MOTION PICTURE FILM PRODUCTION; ORGANIZING CULTURAL EVENTS, NAMELY AN AWARD SHOW FOR THE ASSIGNMENT AND PRESENTMENT OF PRIZES FOR FILMS; ENTERTAINMENT SERVICES, NAMELY PROVIDING A WEBSITE FEATURING FILM CLIPS AND OTHER MULTIMEDIA MATERIALS |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76348964 |
| **Filing Date** | December 14, 2001 |
| **Current Filing Basis** | 44E |
| **Original Filing Basis** | 1B;44D |
| **Published for Opposition** | December 17, 2002 |
| **Registration Number** | 2695075 |
| **Registration Date** | March 11, 2003 |
| **Owner** | (REGISTRANT) True Stories v/ David Peter Fox SOLE PROPRIETORSHIP DENMARK Burmeistersgade 2, 3. tv. DK-1429 Copenhagen K. DENMARK |
| **Attorney of Record** | David Ehrlich |
| **Priority Date** | June 15, 2001 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOMAKER |
| **Goods and Services** | IC 041. US 100 101 107. G & S: providing on-line information on the subject of video production, video equipment and other video-related goods and services. FIRST USE: 19941201. FIRST USE IN COMMERCE: 19941201 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 74536472 |
| **Filing Date** | June 13, 1994 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | October 15, 1996 |
| **Registration Number** | 2028128 |
| **Registration Date** | January 7, 1997 |
| **Owner** | (REGISTRANT) VIDEOMAKER, INC. CORPORATION NEW HAMPSHIRE 1350 East 9th Street Chico CALIFORNIA 95928 |
| **Attorney of Record** | GRACE M. ARUPO |
| **Prior Registrations** | 1442045 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060922. |
| **Renewal** | 1ST RENEWAL 20060922 |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



# VIDEOLOGO

| | |
|---|---|
| **Word Mark** | VIDEOLOGO |
| **Goods and Services** | IC 009. US 021 023 026 036 038. G & S: Photographic, cinematographic, optical, signaling apparatus and instruments namely projection apparatus, projection screens both for projecting pictures, movies and holographic films and projection apparatus for holographic images and films; apparatus for regulating and controlling electricity namely steel security boxes used in connection with installation of projection apparatus and players; apparatus for recording, transmission or reproduction of sound and images namely players and recorders including DVD players/recorders, CD players/recorders, tape players/recorders, hard disc players/recorders and steel; magnetic and digital data carriers namely magnetic discs, CDs, DVDs, and software for monitoring and operating projectors and projection screens; data processing equipment and computers<br><br>IC 011. US 013 021 023 031 034. G & S: Apparatus for lighting namely projector lamps<br><br>IC 035. US 100 101 102. G & S: Advertising; business management; business administration; office functions<br><br>IC 041. US 100 101 107. G & S: Entertainment namely development and production of motion pictures, movies and holographic films for entertaining and advertising purposes |
| **Mark Drawing Code** | (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM |
| **Design Search Code** | |
| **Serial Number** | 79004267 |
| **Filing Date** | March 15, 2004 |
| **Current Filing Basis** | 66A |
| **Original Filing Basis** | 66A |
| **Published for Opposition** | October 25, 2005 |
| **Registration Number** | 3046341 |
| ***International* Registration Number** | 0830246 |
| **Registration** | |

| | |
|---|---|
| **Date** | January 17, 2006 |
| **Owner** | (REGISTRANT) Delfin Produktion v/Peter Allan Simonsen PRIVATE COMPANY DENMARK Jesper Brochmands Gade 15, 2th. DK-2200 Copenhagen N. DENMARK |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOLAW |
| **Goods and Services** | IC 041. US 107. G & S: Educational Services-Namely, Offering Videotaped Continuing Legal Education Seminars to Lawyers. FIRST USE: 19791024. FIRST USE IN COMMERCE: 19791024 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 73462445 |
| **Filing Date** | January 25, 1984 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | October 2, 1984 |
| **Registration Number** | 1309409 |
| **Registration Date** | December 11, 1984 |
| **Owner** | (REGISTRANT) American Bar Association CORPORATION ILLINOIS 321 NORTH CLARK STREET Chicago ILLINOIS 60610 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | ELISABETH A EVERT |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20041207. |
| **Renewal** | 1ST RENEWAL 20041207 |
| **Live/Dead Indicator** | **LIVE** |

# VIDEOGRAPHY

| | |
|---|---|
| **Word Mark** | VIDEOGRAPHY |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Online publication of a magazine dealing with the television broadcast field. FIRST USE: 19960800. FIRST USE IN COMMERCE: 19960800 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78643653 |
| **Filing Date** | June 3, 2005 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | February 14, 2006 |
| **Registration Number** | 3090350 |
| **Registration Date** | May 9, 2006 |
| **Owner** | (REGISTRANT) CMP ENTERTAINMENT MEDIA, INC. CORPORATION DELAWARE 460 PARK AVENUE SOUTH 9TH FLOOR NEW YORK NEW YORK 10016 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Susan L. Heller and Amanda Laura Nye |
| **Prior Registrations** | 1043865 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL-2(F) |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFORUM |
| **Goods and Services** | IC 016. US 002 005 022 023 029 037 038 050. G & S: printed journals providing information on independent films and film resources on various topics. FIRST USE: 19921130. FIRST USE IN COMMERCE: 19921130<br><br>IC 041. US 100 101 107. G & S: providing on-line information on independent films and film resources on various topics. FIRST USE: 19980100. FIRST USE IN COMMERCE: 19980100 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75871518 |
| **Filing Date** | December 15, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 12, 2000 |
| **Registration Number** | 2410593 |
| **Registration Date** | December 5, 2000 |
| **Owner** | (REGISTRANT) National Video Resources, Inc. NOT-FOR-PROFIT DELAWARE 73 Spring Street New York NEW YORK 10012 |
| **Attorney of Record** | Gloria C. Phares |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFINISH |
| **Goods and Services** | IC 009. US 021 023 026 036 038. G & S: Computer software, namely, software for the processing of images, in particular of movement, including television applications of any kind; data processing equipment, namely, computers and computer peripherals for use in the processing of images, in particular of movement, intended for television applications<br><br>IC 038. US 100 101 104. G & S: Television broadcasting; cable television transmission and satellite transmission<br><br>IC 041. US 100 101 107. G & S: Video editing, namely, providing video signal containing virtual images in view of the broadcasting of television programs<br><br>IC 040. US 100 103 106. G & S: Services of digital image processing in view of the editing and performance on television |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75518443 |
| **Filing Date** | July 14, 1998 |
| **Current Filing Basis** | 44E |
| **Original Filing Basis** | 44D |
| **Published for Opposition** | February 22, 2000 |
| **Registration Number** | 2349420 |
| **Registration Date** | May 16, 2000 |
| **Owner** | (REGISTRANT) Ayer, Serge INDIVIDUAL SWITZERLAND 9, chemin des Perrettes 1024 Ecublens SWITZERLAND |
| **Attorney of Record** | CLIFFORD W BROWNING |
| **Priority Date** | January 15, 1998 |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |

**Live/Dead Indicator** LIVE

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFINDER |
| **Goods and Services** | IC 016. US 038. G & S: promotional kit comprising catalogs, brochures, pamphlets and printed informational sheets pertaining to videos and merchandising, printed order forms, decals, printed advertisements, display cards, paper signs, and ornamental novelty buttons, all sold as a unit. FIRST USE: 19910215. FIRST USE IN COMMERCE: 19910215<br><br>IC 042. US 100. G & S: mail and phone special order and locating services for video titles; phone ordering services permitting video stores and other retailers to place orders and receive confirmation by phone; database and information storage and retrieval services in the field of videos. FIRST USE: 19880707. FIRST USE IN COMMERCE: 19880707<br><br>IC 035. US 101. G & S: information storage, database and retrieval services in the field of videotapes. FIRST USE: 19880707. FIRST USE IN COMMERCE: 19880707 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 74160747 |
| **Filing Date** | April 25, 1991 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | March 21, 1995 |
| **Registration Number** | 1898856 |
| **Registration Date** | June 13, 1995 |
| **Owner** | (REGISTRANT) BAKER & TAYLOR INC. CORPORATION DELAWARE 2550 West Tyvola Road Suite 300 Charlotte NORTH CAROLINA 28217 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Prior Registrations** | 1134490;1185534 |
| **Type of Mark** | TRADEMARK. SERVICE MARK |

| | |
|---|---|
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060523. |
| **Renewal** | 1ST RENEWAL 20060523 |
| **Live/Dead Indicator** | **LIVE** |

## Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



# VIDEOVIEW

| | |
|---|---|
| **Word Mark** | VIDEOVIEW |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Employment recruiting services. FIRST USE: 19891215. FIRST USE IN COMMERCE: 19891215 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78349228 |
| **Filing Date** | January 8, 2004 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 28, 2004 |
| **Registration Number** | 2913389 |
| **Registration Date** | December 21, 2004 |
| **Owner** | (REGISTRANT) Nutter, Roger W. INDIVIDUAL UNITED STATES 11427 Reed Hartman Highway, No. 205 Cincinnati OHIO 45241 |
| **Attorney of Record** | J. Michael Hurst |
| **Prior Registrations** | 1816694 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOTRONIC |
| **Goods and Services** | IC 037. US 100 103 106. G & S: Installation, maintenance and/or repair of point of purchase and point of sale video equipment, namely units for recording, transmitting and replay of picture and sound, specially magnetic recording and replay units, optical recording and replay units, digital recording and replay units, transmitting and transceiver units for wireless transmitting, units of multimedia technic for picture, sound and scent, namely, multimedia computer terminals, video monitor flat screens, video monitors and computer touch screens. FIRST USE: 19880400. FIRST USE IN COMMERCE: 19990300<br><br>IC 009. US 021 023 026 036 038. G & S: Point of purchase and point of sale video equipment, namely, television sets with built in video cassette recorders, multimedia computer terminals, video monitor flat screens, video monitors, computer touch screens. FIRST USE: 19880400. FIRST USE IN COMMERCE: 19990300<br><br>IC 035. US 100 101 102. G & S: Business merchandising point of purchase and point of sale display services in the field of video equipment, namely units for recording, transmitting and replay of picture and sound, specially magnetic recording and replay units, optical recording and replay units, digital recording and replay units, transmitting and transceiver units for wireless transmitting, units of multimedia technic for picture, sound and scent, namely, multimedia computer terminals, video monitor flat screens, video monitors and computer touch screens. FIRST USE: 19880400. FIRST USE IN COMMERCE: 19990300<br><br>IC 041. US 100 101 107. G & S: Rental of point of purchase and point of sale video equipment, namely units for recording, transmitting and replay of picture and sound, specially magnetic recording and replay units, optical recording and replay units, digital recording and replay units, transmitting and transceiver units for wireless transmitting, units of multimedia technic for picture, sound and scent, namely, multimedia computer terminals, video monitor flat screens, video monitors and computer touch screens. FIRST USE: 19880400. FIRST USE IN COMMERCE: 19990300 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75832434 |
| **Filing Date** | October 26, 1999 |
| **Current Filing Basis** | 1A;44E |
| **Original Filing Basis** | 1A;44E |
| **Published for Opposition** | November 6, 2001 |
| **Registration** | 84 |

| | |
|---|---|
| **Number** | 2533371 |
| **Registration Date** | January 29, 2002 |
| **Owner** | (REGISTRANT) Videotronic International GmbH LTD LIAB CO FED REP GERMANY Im Steingerust 27 D-76437 Rastatt FED REP GERMANY |
| **Attorney of Record** | CHARLES T. CALIENDO |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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# VideoStitial

| | |
|---|---|
| **Word Mark** | VIDEOSTITIAL |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Online advertising on computer communication networks in a format that plays an audio and/or video file on an Internet browser between the origin and destination page of a click. FIRST USE: 20040501. FIRST USE IN COMMERCE: 20040511 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 76612012 |
| **Filing Date** | September 13, 2004 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | August 9, 2005 |
| **Registration Number** | 3010428 |
| **Registration Date** | November 1, 2005 |
| **Owner** | (REGISTRANT) EyeWonder, Inc. CORPORATION DELAWARE 1447 Peachtree Street Suite 900 Atlanta GEORGIA 30309 |
| **Attorney of Record** | Jerome F. Connell, Jr. |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSEAT |
| **Goods and Services** | IC 041. US 100 101 107. G & S: entertainment services; namely, special cable programming services by which subscribers pay only for the programs watched. FIRST USE: 19890908. FIRST USE IN COMMERCE: 19890908 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 74127111 |
| **Filing Date** | December 31, 1990 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 16, 1991 |
| **Registration Number** | 1660161 |
| **Registration Date** | October 8, 1991 |
| **Owner** | (REGISTRANT) HOST COMMUNICATIONS, INC. CORPORATION KENTUCKY 546 East Main Street Lexington KENTUCKY 40596 |
| **Attorney of Record** | J. Ralph King |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20010901. |
| **Renewal** | 1ST RENEWAL 20010901 |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEO-SCRIPT |
| **Goods and Services** | IC 042. US 100 101. G & S: videotaping of legal proceedings, legal documents and other evidence. FIRST USE: 19830801. FIRST USE IN COMMERCE: 19830801<br><br>IC 035. US 100 101 102. G & S: transcription of legal proceedings. FIRST USE: 19830801. FIRST USE IN COMMERCE: 19830801 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75104066 |
| **Filing Date** | May 14, 1996 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 9, 1997 |
| **Registration Number** | 2117448 |
| **Registration Date** | December 2, 1997 |
| **Owner** | (REGISTRANT) Video-Script Enterprises, Inc. CORPORATION NEW YORK 1565 Franklin Avenue Mineola NEW YORK 11501 |
| **Attorney of Record** | Shelley J. Safer |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL-2(F) |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

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# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSCAPE |
| **Goods and Services** | IC 038. US 100 101 104. G & S: ON DEMAND VIDEO TO BE USED IN CONNECTION WITH CUSTOMIZED TRAINING CURRICULA VIA VIDEO CONFERENCING AND A GLOBAL COMPUTER NETWORK AND RELATED PRODUCTS AND SERVICES. FIRST USE: 19980430. FIRST USE IN COMMERCE: 19980430 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75670138 |
| **Filing Date** | March 29, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | March 27, 2001 |
| **Registration Number** | 2460846 |
| **Registration Date** | June 19, 2001 |
| **Owner** | (REGISTRANT) VideoScape Corporation CORPORATION DELAWARE 27 Spectrum Point, Suite 302 Irvine CALIFORNIA 92630 |
| **Attorney of Record** | Nancy O. Dix |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

# Trademarks > Trademark Electronic Search System(Tess)

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 71 out of 722**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOSAIC |
| **Goods and Services** | IC 041. US 100 101 107. G & S: VIDEOTAPE PRODUCTION. FIRST USE: 20000911. FIRST USE IN COMMERCE: 20001009 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78029247 |
| **Filing Date** | October 5, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A;1B |
| **Published for Opposition** | July 17, 2001 |
| **Registration Number** | 2496428 |
| **Registration Date** | October 9, 2001 |
| **Owner** | (REGISTRANT) Steranko, Robert Scott INDIVIDUAL UNITED STATES 1845 Clayton Avenue Suite 302 Pittsburgh PENNSYLVANIA 15214 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOLOCITY |
| **Goods and Services** | IC 038. US 100 101 104. G & S: electronic transmission of entertainment programming via telephone lines, cables, and global computer networks. FIRST USE: 20001100. FIRST USE IN COMMERCE: 20001100 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76171237 |
| **Filing Date** | November 27, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | August 21, 2001 |
| **Registration Number** | 2636758 |
| **Registration Date** | October 15, 2002 |
| **Owner** | (REGISTRANT) VIDEOLOCITY INTERNATIONAL, INC. CORPORATION NEVADA 358 SOUTH 700 EAST SUITE B604 SALT LAKE CITY UTAH 84102 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Eric M Barzee |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 115 out of 167**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOLINK |
| **Goods and Services** | IC 035. US 100 101 102. G & S: ON-LINE RETAIL STORE SERVICES FEATURING VIDEOCONFERENCING EQUIPMENT. FIRST USE: 19990701. FIRST USE IN COMMERCE: 19990806 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75920370 |
| **Filing Date** | February 5, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A;1B |
| **Published for Opposition** | March 19, 2002 |
| **Registration Number** | 2577222 |
| **Registration Date** | June 11, 2002 |
| **Owner** | (REGISTRANT) VideoLink, LLC LLC COLORADO 4101 E. Louisiana Ave Suite 301 Denver COLORADO 80246 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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# Trademarks > Trademark Electronic Search System(Tess)

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VIDEOJET

| | |
|---|---|
| **Word Mark** | VIDEOJET |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Technical training in the use of ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers and controllers for controlling production and bindery lines. FIRST USE: 20020300. FIRST USE IN COMMERCE: 20020300<br><br>IC 002. US 006 011 016. G & S: Inks, make-up fluids and cleaning solutions for ink jet printers and imagers. FIRST USE: 20020300. FIRST USE IN COMMERCE: 20020300<br><br>IC 009. US 021 023 026 036 038. G & S: Contact and non-contact equipment and apparatus for coding, imaging, marking, printing or labeling, namely, ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers, ink jet and laser coders and markers; computer programs and operating systems for the ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers; printer controllers, printheads, nozzles, and filters for ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers; electronic controllers for production and bindery lines. FIRST USE: 20020300. FIRST USE IN COMMERCE: 20020300<br><br>IC 037. US 100 103 106. G & S: Installation, maintenance, and repair services in the fields of ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers and controllers for controlling production and bindery lines. FIRST USE: 20020300. FIRST USE IN COMMERCE: 20020300<br><br>IC 042. US 100 101. G & S: Technical support services, namely, troubleshooting to identify problems with and provide solutions for ink jet printers and imagers, laser printers and imagers, thermal transfer overprinters and imagers and controllers for controlling production and bindery lines. FIRST USE: 20020300. FIRST USE IN COMMERCE: 20020300 |
| **Mark Drawing Code** | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| **Design Search Code** | 26.05.21 - Triangles that are completely or partially shaded<br>26.05.25 - Triangles with one or more curved sides |
| **Serial Number** | 78243165 |
| **Filing Date** | April 29, 2003 |
| **Current Filing** | 1A |

| | |
|---|---|
| **Basis** | |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | August 31, 2004 |
| **Registration Number** | 2904765 |
| **Registration Date** | November 23, 2004 |
| **Owner** | (REGISTRANT) Videojet Technologies Inc. CORPORATION DELAWARE 1500 Mittel Boulevard Wood Dale ILLINOIS 60191 |
| **Attorney of Record** | Kirk Vander Leest |
| **Prior Registrations** | 0873692;1011903;1345617;1391366;1442859;2695961;2719508;2791277;AND OTHERS |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

*TESS was last updated on Fri Feb 16 04:16:48 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFLOW |
| **Goods and Services** | IC 041. US 100 101 107. G & S: entertainment in the nature of on-going television programs, or programming segments, featuring music videos. FIRST USE: 19880905. FIRST USE IN COMMERCE: 19880905 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75396849 |
| **Filing Date** | November 26, 1997 |
| **Current Filing Basis** | 1A;44E |
| **Original Filing Basis** | 1A;44D |
| **Published for Opposition** | March 16, 1999 |
| **Registration Number** | 2251096 |
| **Registration Date** | June 8, 1999 |
| **Owner** | (REGISTRANT) CHUM Limited CORPORATION CANADA 299 QUEEN STREET WEST Toronto, Ontario, M5V 2Z5 CANADA |
| **Attorney of Record** | LINDA M BYRNE |
| **Priority Date** | May 27, 1997 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOFARM.COM |
| **Goods and Services** | IC 038. US 100 101 104. G & S: Providing on-line chat rooms for transmission of messages among computer users concerning video production, editing and distribution as well as other topics of general interest; providing on-line electronic bulletin boards for transmission of messages among computer users concerning video production, editing and distribution as well as other topics of general interest. FIRST USE: 19981201. FIRST USE IN COMMERCE: 19981201<br><br>IC 041. US 100 101 107. G & S: Producing, editing and distributing videos over a global communications network. FIRST USE: 19981201. FIRST USE IN COMMERCE: 19981201<br><br>IC 042. US 100 101. G & S: Hosting the web sites of others on a computer server for a global computer network. FIRST USE: 19981201. FIRST USE IN COMMERCE: 19981201<br><br>IC 035. US 100 101 102. G & S: Computerized database management. FIRST USE: 19981201. FIRST USE IN COMMERCE: 19981201 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75707501 |
| **Filing Date** | May 17, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | May 1, 2001 |
| **Registration Number** | 2470935 |
| **Registration Date** | July 24, 2001 |
| **Owner** | (REGISTRANT) JAVU TECHNOLOGIES, INC. CORPORATION DELAWARE Chelsea Piers - Pier 62 New York NEW YORK 10011 |
| **Attorney of Record** | Karin Segall |
| **Type of Mark** | SERVICE MARK |

| | |
|---|---|
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOEM |
| **Goods and Services** | IC 041. US 100 101 107. G & S: PRODUCTION OF CDS AND DVDS FROM INFORMATION OBTAINED FROM SCIENTIFIC INSTRUMENTATION TO BE BROADCASTED OVER THE WEB, INTERNET, OR A TELEVISION MEDIUM. FIRST USE: 20021215. FIRST USE IN COMMERCE: 20021215 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78212007 |
| **Filing Date** | February 7, 2003 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | December 30, 2003 |
| **Registration Number** | 2825146 |
| **Registration Date** | March 23, 2004 |
| **Owner** | (REGISTRANT) Hood, Darden INDIVIDUAL UNITED STATES 12785 SW 64 Court Miami FLORIDA 33156 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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# VIDEODE

| | |
|---|---|
| **Word Mark** | VIDEODE |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Video production services, namely production of videos for a range of video projects including producing personal video tributes and videos for events such as weddings, bar mitzvahs, retirements and anniversary parties. FIRST USE: 20050706. FIRST USE IN COMMERCE: 20050706 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78670049 |
| **Filing Date** | July 13, 2005 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 25, 2006 |
| **Registration Number** | 3157192 |
| **Registration Date** | October 17, 2006 |
| **Owner** | (REGISTRANT) MILLIGRACE PRODUCTIONS, LLC. LTD LIAB CO NEW YORK Suite 29D 60 West 66th Street New York NEW YORK 10023 |
| **Attorney of Record** | Jennifer Finn |
| ***Type of Mark*** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOCOM |
| **Goods and Services** | IC 038. US 100 101 104. G & S: television broadcasting; satellite transmission services, namely, distribution of television broadcast programs, news, sporting events, commercial, and data, namely, weather and radio network information in digitized form. FIRST USE: 19701123. FIRST USE IN COMMERCE: 19701222<br><br>IC 041. US 100 101 107. G & S: distribution of television programs for others, television show production, videotape production. FIRST USE: 19701123. FIRST USE IN COMMERCE: 19701222 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75484460 |
| **Filing Date** | May 13, 1998 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | January 7, 2003 |
| **Registration Number** | 2701605 |
| **Registration Date** | April 1, 2003 |
| **Owner** | (REGISTRANT) Videocom, Inc. CORPORATION DELAWARE 502 Sprague Street Dedham MASSACHUSETTS 02026 |
| **Attorney of Record** | DAVID WOLF |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL-2(F) |
| **Live/Dead Indicator** | LIVE |

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 56 out of 87**

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEO-CENTREX |
| **Goods and Services** | IC 038. US 100 101 104. G & S: multipoint video conferencing services. FIRST USE: 20021029. FIRST USE IN COMMERCE: 20021029 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75906723 |
| **Filing Date** | January 31, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | July 2, 2002 |
| **Registration Number** | 2976415 |
| **Registration Date** | July 26, 2005 |
| **Owner** | (REGISTRANT) Compunetix, Inc. CORPORATION PENNSYLVANIA Compunetix Building 2420 Mosside Boulevard Monroeville PENNSYLVANIA 15146 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Ansel M. Schwartz |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOBOB |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Video production services. FIRST USE: 19930102. FIRST USE IN COMMERCE: 19950802 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76463799 |
| **Filing Date** | November 4, 2002 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | September 2, 2003 |
| **Registration Number** | 3013569 |
| **Registration Date** | November 8, 2005 |
| **Owner** | (REGISTRANT) Johnson, Robert Brian INDIVIDUAL UNITED STATES 519 Camino Bailen Escondido CALIFORNIA 92029 |
| **Attorney of Record** | Charles E. Baxley |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEO SYSTEMS |
| **Goods and Services** | IC 041. US 100 101 107. G & S: PROVIDING INFORMATION ABOUT VIDEO PRODUCTION AND PRESENTATION VIA A GLOBAL COMMUNICATIONS NETWORK. FIRST USE: 19980500. FIRST USE IN COMMERCE: 19980500<br><br>IC 016. US 002 005 022 023 029 037 038 050. G & S: MAGAZINE ABOUT VIDEO PRODUCTION AND PRESENTATION. FIRST USE: 19750000. FIRST USE IN COMMERCE: 19750000<br><br>IC 042. US 100 101. G & S: PROVIDING AN ON-LINE MAGAZINE ABOUT VIDEO PRODUCTION AND PRESENTATION VIA A GLOBAL COMMUNICATIONS NETWORK. FIRST USE: 19980500. FIRST USE IN COMMERCE: 19980500 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75653936 |
| **Filing Date** | March 4, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Supplemental Register Date** | July 15, 1999 |
| **Registration Number** | 2305009 |
| **Registration Date** | December 28, 1999 |
| **Owner** | (REGISTRANT) INTERTEC PUBLISHING CORPORATION CORPORATION DELAWARE 9800 METCALF OVERLAND PARK KANSAS 662122216<br><br>(LAST LISTED OWNER) PRISM BUSINESS MEDIA INC. CORPORATION DELAWARE 249 W. 17TH STREET, 4TH FLOOR NEW YORK NEW YORK 10011 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Jordan A. LaVine |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | SUPPLEMENTAL |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEO MATCH |
| **Goods and Services** | IC 038. US 100 101 104. G & S: television broadcasting of programs consisting of sketches, comic acts, and interviews<br><br>IC 041. US 100 101 107. G & S: entertainment in the nature of on-going television programs in the field of sketches, comic acts, and interviews |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75417944 |
| **Filing Date** | January 14, 1998 |
| **Current Filing Basis** | 44E |
| **Original Filing Basis** | 1B;44E |
| **Published for Opposition** | April 18, 2000 |
| **Registration Number** | 2538765 |
| **Registration Date** | February 19, 2002 |
| **Owner** | (REGISTRANT) TELEVISION FEDERAL S.A. TELEFE CORPORATION ARGENTINA Pavon 2444 BUENOS AIRES ARGENTINA |
| **Attorney of Record** | JOHN CLARKE HOLMAN |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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Start List At: OR Jump to record: **Record 24 out of 87**



## Typed Drawing

| | |
|---|---|
| **Word Mark** | STUPIDVIDEOS |
| **Goods and Services** | IC 038. US 100 101 104. G & S: Streaming of video material on the Internet. FIRST USE: 20010620. FIRST USE IN COMMERCE: 20021020 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78218643 |
| **Filing Date** | February 25, 2003 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | May 24, 2005 |
| **Registration Number** | 2984918 |
| **Registration Date** | August 16, 2005 |
| **Owner** | (REGISTRANT) AKLUVIS LTD LIAB JT ST CO CALIFORNIA 1571 Mission Meadows Drive Oceanside CALIFORNIA 92057<br><br>(LAST LISTED OWNER) APOLLO 11, LLC LTD LIAB CO CALIFORNIA 880 APOLLO STREET SUITE 222 EL SEGUNDO CALIFORNIA 90245 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | John M. Kim |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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# PRIMEVIDEO

| | |
|---|---|
| **Word Mark** | PRIMEVIDEO |
| **Goods and Services** | IC 038. US 100 101 104. G & S: SATELLITE, CABLE, NETWORK TRANSMISSION OF SOUNDS, IMAGES, SIGNALS AND DATA. FIRST USE: 20041215. FIRST USE IN COMMERCE: 20041215 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 76639217 |
| **Filing Date** | May 23, 2005 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | February 14, 2006 |
| **Registration Number** | 3089300 |
| **Registration Date** | May 9, 2006 |
| **Owner** | (REGISTRANT) PRIMEVISION COMMUNICATIONS LLC. LTD LIAB CO FLORIDA 1485 North Park Drive Weston FLORIDA 33326 |
| **Attorney of Record** | WILLIAM J. UTERMOHLEN |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 7 out of 722**



# MuzeVideo

| | |
|---|---|
| **Word Mark** | MUZEVIDEO |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Providing an online database of entertainment-related information available for licensing by others. FIRST USE: 20020131. FIRST USE IN COMMERCE: 20020131 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78786490 |
| **Filing Date** | January 6, 2006 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 5, 2006 |
| **Registration Number** | 3174034 |
| **Registration Date** | November 21, 2006 |
| **Owner** | (REGISTRANT) Muze Inc. CORPORATION NEW YORK 8th Floor 304 Hudson Street New York NEW YORK 10013 |
| **Attorney of Record** | J. David Mayberry |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | ENGAGEVIDEO |
| **Goods and Services** | IC 038. US 100 101 104. G & S: Telecommunication conference services, namely, end-user, video teleconference launching services in which the services are provided by means of a telecommunication network or global computer network; end-user, video teleconference launching services for video teleconferences that are conducted over a telecommunication network or global computer network. FIRST USE: 20030131. FIRST USE IN COMMERCE: 20030131 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75930735 |
| **Filing Date** | February 28, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | July 23, 2002 |
| **Registration Number** | 2940301 |
| **Registration Date** | April 12, 2005 |
| **Owner** | (REGISTRANT) V-Span 1, Inc. CORPORATION DELAWARE 1100 First Avenue King of Prussia PENNSYLVANIA 19406 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Christopher J. Kulish |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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# AIRVIDEO

| | |
|---|---|
| **Word Mark** | AIRVIDEO |
| **Goods and Services** | IC 038. US 100 101 104. G & S: COMMUNICATION SERVICES NAMELY, BROADCASTING LIVE AND PRE-RECORDED INFORMATION SERVICES IN THE FORM OF MOVIES, PICTURE, SOUND, VOICE AND DATA VIA A GLOBAL COMPUTER OR WIRELESS NETWORK. FIRST USE: 20041026. FIRST USE IN COMMERCE: 20041026 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 76620005 |
| **Filing Date** | November 10, 2004 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | October 4, 2005 |
| **Registration Number** | 3034009 |
| **Registration Date** | December 27, 2005 |
| **Owner** | (REGISTRANT) Securityland, Inc. CORPORATION DELAWARE 11208 Waples Mill Road, Suite 109 Fairfax VIRGINIA 22030 |
| **Attorney of Record** | Eugene Berman |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead** | 110 |

# Trademarks > Trademark Electronic Search System(Tess)

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Start List At: [ ] OR Jump to record: [ ] **Record 87 out of 87**

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TARR Status | ASSIGN Status | TDR | TTAB Status *( Use the "Back" button of the Internet Browser to return to TESS)*

## Typed Drawing

| | |
|---|---|
| **Word Mark** | VIDEOWAY |
| **Goods and Services** | IC 037. US 103. G & S: REPAIR AND MAINTENANCE OF TV CONVERTERS TELECOMMUNICATIONS SYSTEMS<br><br>IC 038. US 104. G & S: TELECOMMUNICATIONS SERVICES<br><br>IC 009. US 021 026. G & S: TELECOMMUNICATIONS APPARATUS, NAMELY CONVERTERS AND DECODERS FOR TELEVISION SIGNALS; INTERFACES; CONCENTRACTORS; MULTIPLEXORS AND TELECOMMUNICATIONS CONTROLLERS |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 73528175 |
| **Filing Date** | March 22, 1985 |
| **Current Filing Basis** | 44E |
| **Original Filing Basis** | 44E |
| **Published for Opposition** | April 29, 1986 |
| **Registration Number** | 1401875 |
| **Registration Date** | July 22, 1986 |
| **Owner** | (REGISTRANT) LE GROUPE VIDEOTRON LTEE CORPORATION CANADA 4TH FLOOR 2000 BERRI STREET MONTREAL, QUEBEC CANADA |
| **Attorney of Record** | LAWRENCE E. ABELMAN |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

# EXHIBIT 7

# Dictionary

**Find** opinion in Dictionary

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**Dictionary** **Thesaurus** **Translations**

A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

*ophthalmol.*
*ophthalmology*
*ophthalmoscope*
*ophthalmoscopy*
*-opia*
*opiate*
*OPIC*
*opine*
**opinion**
*opinion poll*
*opinion shopping*
*opinionated*
*opinionative*
*opioid*
*opioid peptide*
*opisthobranch*
*opisthognathous*

## *opinion*

opinion

**o·pin·ion** [ ə pínnyən ] (*plural* o·pin·ions)

noun

**Definition:**

1. **personal view:** the view somebody takes about an issue, especially when it is based solely on personal judgment
   - *In my opinion it's all a waste of time.*

2. **estimation:** a view regarding the worth of somebody or something
   - *They had a pretty low opinion of me.*

3. **expert view:** an expert assessment of something
   - *I told the doctor I wanted a second opinion.*

4. **body of generally held views:** the view or views held by most people or by a large number of people
   - *pundits and other opinion formers*

5. LAW **conclusion of fact:** a conclusion drawn from observation of the facts

[14th century. Via French < Latin *opinion-* < *opinari* "suppose"]

**be a matter of opinion** to be open to dispute or debate

**be of the opinion that** to think that

Print Preview

See pronunciation key

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- 2 years to a new career
- FAFSA online: Making aid applications easy
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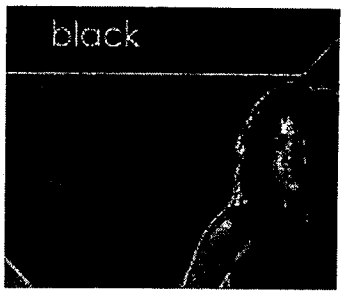
something is the case

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*Laptops*

*Monitors*

*Software*

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# EXHIBIT 8

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opinion

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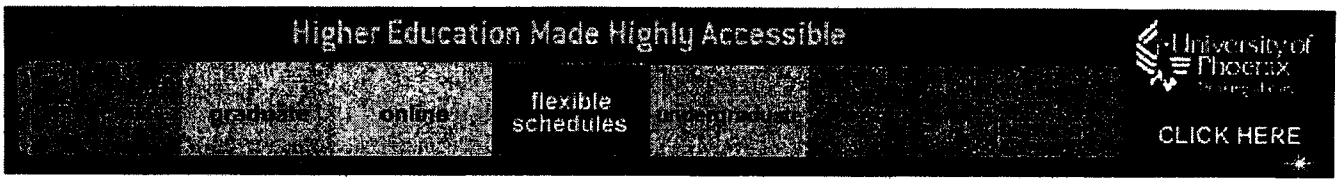


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# 11 results for: *opinion*

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*Dictionary.com Unabridged (v 1.1)* – *Cite This Source*

**o·pin·ion** [*uh*-**pin**-*yuh n*] Pronunciation Key – Show IPA Pronunciation

*–noun*

1. a belief or judgment that rests on grounds insufficient to produce complete certainty.
2. a personal view, attitude, or appraisal.
3. the formal expression of a professional judgment: *to ask for a second medical opinion.*
4. *Law.* the formal statement by a judge or court of the reasoning and the principles of law used in reaching a decision of a case.
5. a judgment or estimate of a person or thing with respect to character, merit, etc.: *to forfeit someone's good opinion.*
6. a favorable estimate; esteem: *I haven't much of an opinion of him.*

[Origin: 1250–1300; ME < OF < L *opīniōn-* (s. of *opīniō*), deriv. of *opīnārī* to OPINE]

—*Synonyms* 1. persuasion, notion, idea, impression. OPINION, SENTIMENT, VIEW are terms for one's conclusion about something. An OPINION is a belief or judgment that falls short of absolute conviction, certainty, or positive knowledge; it is a conclusion that certain facts, ideas, etc., are probably true or likely to prove so: *political opinions; an opinion about art; In my opinion this is true.* SENTIMENT (usually *pl.*) refers to a rather fixed conviction, usually based on feeling or emotion rather than reasoning: *These are my sentiments.* VIEW is an estimate of something, an intellectual judgment, a critical survey based on a mental examination, particularly of a public matter: *views on governmental planning.*

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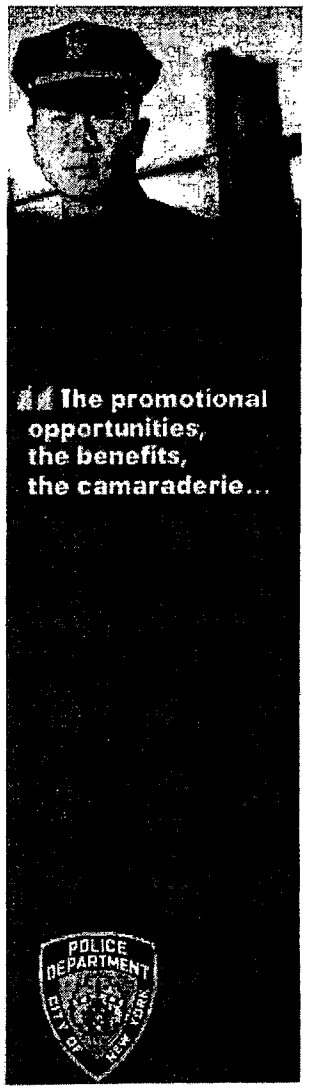

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*American Heritage Dictionary – Cite This Source*

**o·pin·ion** (ə-pĭn'yən) Pronunciation Key

n.

1. A belief or conclusion held with confidence but not substantiated by positive knowledge or proof: *"The world is not run by thought, nor by imagination, but by opinion" (Elizabeth Drew).*
2. A judgment based on special knowledge and given by an expert: *a medical opinion.*
3. A judgment or estimation of the merit of a person or thing: *has a low opinion of braggarts.*
4. The prevailing view: *public opinion.*
5. *Law* A formal statement by a court or other adjudicative body of the legal reasons and principles for the conclusions of the court.

[Middle English, from Old French, from Latin opīniō, opīniōn-, from opīnārī, *to think.*]

***Synonyms***: These nouns signify something a person believes or accepts as being sound or true. *Opinion* is applicable to a judgment based on grounds insufficient to rule out the possibility of dispute: *"A little group of willful men, representing no opinion but their own, have rendered the great Government of the United States helpless and contemptible"* (Woodrow Wilson).
*View* stresses individuality of outlook: *"My view is . . . that freedom of speech means that you shall not do something to people either for the views they have or the views they express"* (Hugo L. Black).
*Sentiment* and especially *feeling* stress the role of emotion as a determinant: *"If men are to be precluded from offering their sentiments on a matter which may involve the most serious and alarming consequences . . . reason is of no use to us"* (George Washington). *"There needs protection . . . against the tyranny of the prevailing opinion and feeling"* (John Stuart Mill).
A *belief* is a conclusion to which one subscribes strongly: *"Our belief in any particular natural law cannot have a safer basis than our unsuccessful critical attempts to refute it"* (Karl Popper).
*Conviction* is belief that excludes doubt: *"the editor's own conviction of what, whether interesting or only important, is in the public interest"* (Walter Lippmann).
*Persuasion* applies to a confidently held opinion: *"He had a strong persuasion that Likeman was wrong"* (H.G. Wells).

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**opinion**

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1. a personal belief or judgment that is not founded on proof or certainty; "my opinion differs from yours"; "what are your thoughts on Haiti?"
2. a belief or sentiment shared by most people; the voice of the people; "he asked for a poll of public opinion" [syn: public opinion]
3. a message expressing a belief about something; the expression of a belief that is held with confidence but not substantiated by positive knowledge or proof; "his opinions appeared frequently on the editorial page"
4. the legal document stating the reasons for a judicial decision; "opinions are usually written by a single judge"
5. the reason for a court's judgment (as opposed to the decision itself)
6. a vague idea in which some confidence is placed; "his impression of her was favorable"; "what are your feelings about the crisis?"; "it strengthened my belief in his sincerity"; "I had a feeling that she was lying" [syn: impression]

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**opinion**

c.1300, from O.Fr. *opinion* (12c.), from L. *opinionem* (nom. *opinio*) "opinion, conjecture, what one thinks," from stem of *opinari* "think, judge, suppose, opine," from PIE **op-* "to choose." *Opinionated* "obstinate" is attested from 1601.

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**opinion**

see form an opinion; matter of opinion.

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*Merriam-Webster's Medical Dictionary* - *Cite This Source*

Main Entry: **opin·ion**
Pronunciation: &-'pin-y&n
Function: *noun*
: a formal expression of judgment or advice by an expert <wanted a second *opinion* on the advisability of performing the operation>

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*Merriam-Webster's Dictionary of Law* - *Cite This Source*

Main Entry: **opin·ion**
Pronunciation: &-'pin-y&n
Function: *noun*
**1 a** : a belief stronger than impression and less strong than positive knowledge **b** : a formal expression of a judgment or appraisal by an

given by an attorney to a client <an *opinion* of title> called also *legal opinion* —see also *opinion letter* at LETTER 1 **b** : an advisory opinion issued by an authorized public official (as an attorney general) or a recognized body (as the American Bar Association)
**3 a** : the formal written expression by a court or judge of the reasons and principles of law upon which the decision in a case is based —compare HOLDING, JUDGMENT, RULING

---

**advisory opinion**
: a nonbinding opinion or evaluation of a court or other judicial or quasi-judicial authority or body regarding the effect of the law on a situation that does not present an actual controversy between parties <to answer questions which were not brought before this Court would be to issue an *advisory opinion —JBC of Wyoming Corporation v. City of Cheyenne*, 843 Pacific Reporter, Second Series 1190 (1992)>
*NOTE: Advisory opinions are issued esp. by administrative agencies and by some state courts. Federal courts are constrained by the U.S. Constitution to deciding only cases or controversies and cannot issue advisory opinions.*

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**concurring opinion**
: an opinion by a judge who agrees with the result in a case but not necessarily with the reasoning used to reach it

---

**dissenting opinion**
: an opinion by a judge who disagrees with the result in a case

---

**majority opinion**
: an opinion in a case that is written by one judge and in which a majority of the judges on the court join

---

**memorandum opinion**
**1** : a brief opinion of a court that announces the result of a case without extensive discussion and that is usually unpublished and cannot be cited as precedent
**2** : an opinion of the U.S. Tax Court that is ordered not to be published but that is authoritative as precedent
**3 a** : an opinion of a court that sets forth the court's views or intended decision in a case but does not constitute the judgment **b** : an opinion of a court or judge setting forth the conclusions and findings and containing or constituting the actual order, judgment, or decree in the case

---

**per curiam opinion**
: a usually very brief unanimous opinion attributed to the court as a whole and not to any particular judge

---

**plurality opinion**
: an opinion with which a majority of the judges on the court concur in result but not in reasoning

---

**sep·a·rate opinion**
: an opinion written separately by a judge who dissents or who concurs only in the result of the majority opinion

---

***slip opinion***
: an opinion published in temporary form soon after the decision is rendered **b** : a written explanation for a decision reached by an official (as

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**opinion**

A Certified Public Accountant's written attestation as to the fairness of presentation of financial statements. Anything other than an opinion that the statements have been presented fairly is a matter of serious concern to investors. *Also called* **accountant's opinion, auditor opinion**. *See also* adverse opinion, clean opinion, disclaimer of opinion, qualified opinion, subject to opinion.

*Wall Street Words: An A to Z Guide to Investment Terms for Today's Investor by David L. Scott.*
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*Kernerman English Multilingual Dictionary (Beta Version)* – *Cite This Source*

**opinion**[1] [ə'pinjən] *noun*

what a person thinks or believes

Example: *My opinions about education have changed.*

*Arabic:* رأي
*Chinese (Simplified):* □□
*Chinese (Traditional):* □□
*Czech:* názor
*Danish:* mening; holdning
*Dutch:* opinie
*Estonian:* arvamus
*Finnish:* mielipide
*French:* opinion
*German:* die Meinung
*Greek:* γνώμη, άποψη
*Hungarian:* vélemény
*Icelandic:* álit, skoðun
*Indonesian:* pendapat
*Italian:* opinione
*Japanese:* □□
*Korean:* □□
*Latvian:* uzskats; domas
*Lithuanian:* nuomonė, pažiūra, požiūris
*Norwegian:* mening, oppfatning
*Polish:* pogląd, zdanie
*Portuguese (Brazil):* opinião
*Portuguese (Portugal):* opinião
*Romanian:* opinie, părere
*Russian:* взгляд; убеждение
*Slovak:* názor
*Slovenian:* mnenje
*Spanish:* opinión
*Swedish:* mening, åsikt
*Turkish:* görüş, düşünce, fikir

**opinion**[2] [ə'pinjən] *noun*

a (professional) judgement, usually of a doctor, lawyer etc

Example: *He wanted a second opinion on his illness.*



*Arabic:* □□□ *Japanese:* □

*Chinese (Traditional):* [illegible]
*Czech:* posudek
*Danish:* vurdering
*Dutch:* advies
*Estonian:* hinnang
*Finnish:* lausunto
*French:* avis
*German:* das Gutachten
*Greek:* επαγγελματική γνώμη
*Hungarian:* szakvélemény
*Icelandic:* álit
*Indonesian:* penilaian
*Italian:* parere
*Latvian:* viedoklis
*Lithuanian:* patarimas, konsiliumas, išvada
*Norwegian:* uttalelse, vurdering, bedømmelse
*Polish:* porada
*Portuguese (Brazil):* opinião
*Portuguese (Portugal):* opinião
*Romanian:* opinie, părere
*Russian:* заключение специалиста
*Slovak:* posudok
*Slovenian:* mnenje
*Spanish:* opinión
*Swedish:* utlåtande
*Turkish:* profesyonel görüş ve tavsiye

**opinion**[3] [ə'pinjən] *noun*
what one thinks of the worth or value of someone or something
Example: *I have a very high opinion of his work.*

*Arabic:* تقدير، فكرة حسنة عن
*Chinese (Simplified):* [illegible]
*Chinese (Traditional):* [illegible]
*Czech:* mínění
*Danish:* tanke; opfattelse
*Dutch:* dunk
*Estonian:* arvamus
*Finnish:* arvostus
*French:* opinion
*German:* die Meinung
*Greek:* γνώμη για κπ. ή για κτ.
*Hungarian:* vélemény
*Icelandic:* álit
*Indonesian:* penghargaan
*Italian:* opinione
*Japanese:* [illegible]
*Korean:* [illegible]
*Latvian:* domas; vērtējums
*Lithuanian:* nuomonė, įvertinimas
*Norwegian:* stor tillit; oppfatning
*Polish:* ocena
*Portuguese (Brazil):* opinião
*Portuguese (Portugal):* opinião
*Romanian:* părere
*Russian:* оценка; мнение
*Slovak:* mienka
*Slovenian:* mnenje
*Spanish:* opinión
*Swedish:* tanke, tankar
*Turkish:* düşünce

*See also:* a matter of opinion, be of the opinion (that), in my, your opinion

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# EXHIBIT 9

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# opinion, *n.*

*DRAFT REVISION June 2004*

*Brit.* /əˈpɪnjən/, *U.S.* /əˈpɪnj(ə)n/ Forms: ME **openion, openyoun, opeynyon, opinioun, opiniyon, opiniyoun, opinyoun, oppinyon, oppynioun, oppynyoun, oppynyown, opunioun, opynioun, opynioune, opynnyoun, opynyone, opynyounn, vpynyoun,** ME-15 **oppinioun, oppynion, oppynyon, opynion, opynyon, opynyoun,** ME-16 **opinyon,** ME-17 **oppinion,** ME- **opinion,** 15 **apenyon, oponion, oppynyone,** 16 **openen, oppenion;** *Sc.* pre-17 **apenion, apinioun, apownȝowne, openioun, openyon, openyoun, opinȝoun, opinione, opinioun, opinioune, opiniounn, opiniyone, oponȝoune, oppenyon, oppinȝeoun, oppinioun, oppinioune, oppiniowne, oppinnion, oppinnioun, oppinyoun, opponȝeone, opponyon, oppunȝeon, oppunȝeoun, oppunyeon, oppynion, oppynnyown, oppynyon, opunȝeoun, opunȝone, opunȝoun, opunion, opunione, opunyone, opvnioune, opvnyone, opynione, opynioun, opynyon,** pre-17 17- **opinion,** 18 **opingan, opingin, opingon, opinyon,** 18- **opeenion,** 19- **opinyan.** [< Anglo-Norman *opinion, oppinion, opiniun* and Middle French *opinion, oppinion* view, belief (*c*1200 in Old French), reputation (early 13th cent.), intention (late 14th cent.), judgement (early 15th cent.; *c*1590 in *opinion publique*; French *opinion*) and their etymon classical Latin *opīniōn-, opīniō* view, belief, what is thought of a person by others, reputation, report, rumour, what or how one thinks about something, what one thinks of a person, estimation, favourable estimate, expectation < *opīnārī* OPINE *v.* + *-iō* -ION[1]. Cf. Italian *opinione* (*a*1250), Spanish *opinión* (*c*1250), Portuguese *opinião* (1370).

Cf. also the following isolated attestation of the aphetic formation *punȝoun* in Older Scots:

**1488** HARY *Actis & Deidis Schir William Wallace* X. 419 ȝeid nayn away was contrar our punȝoun [**1570** *Lekprevik ed.* opinioun].]

**I.** Simple uses.

**1.** As a count noun: a view held about a particular issue; a judgement formed or a conclusion reached; a belief; a religious or political conviction. Formerly (also): †a plan, an intention (*obs.*).

**1340** *Ayenbite* 69 Ofte hi ualleþ ine errour and ine ualse opinions and ine eresye. **c1385** CHAUCER *Knight's Tale* 1269, I..wende and hadde a greet opinioun That if I myghte scapen..Than hadde I been in ioye. **c1385** CHAUCER *Knight's Tale* 1480 This was his opynyoun, That in that groue he wolde him hyde al day. ***a1425*** WYCLIF *Sel. Eng. Wks.* (1871) II. 287 Alle þes newe sectis..have newe opynyouns. **c1450** (*c*1405) *Mum & Sothsegger* (BL Add.) 1167 Thenne fareth he [*sc.* Lucifer] forth felaship to gete, To holde his opinion ouer alle þingz. **?1503-5** H. WATSON tr. *Valentine & Orson* (1937) 88 To that thyng I am not consenting by am of the oppynyon that we shal kepe Valentine in prison, the whiche can not escape vs. **1579** E. K. in Spenser *Shepheardes Cal.* June 25 Gloss., The opinion of Faeries and elfes is very old, and yet sticketh very religiously in the

myndes of some. **1600** SHAKESPEARE *Merch. V.* III. v. 80 Nay, but aske my opinion to of that? **1611** *Bible* (A.V.): *1 Kings* xviii. 21 How long halt ye between two opinions? **1665** R. BOYLE *Occas. Refl.* IV. xi. sig. Ee4$^{v}$, As for my Opinions, whether of Persons, or things, I cannot in most cases command them my self, but must suffer them to be such as the Nature of the things I judge of requires. **1705** G. STANHOPE *Paraphr.* III. 312 No Opinion truly good can promote any Moral Evil. **1789** W. BELSHAM *Ess.* II. xli. 526 It is not to controul opinions, but actions, that Government is instituted. **1844** B. DISRAELI *Coningsby* III. VIII. iii. 217 As for your opinions, you have no business to have any other than those I uphold. **1877** J. MORLEY *Crit. Misc.* 2nd Ser. 89 Our opinions are less important than the spirit and temper with which they possess us. **1906** J. GALSWORTHY *Man of Property* 56 She was getting to have opinions of her own. He didn't know what she wanted. **1940** J. BUCHAN *Memory Hold-the-door* iii. 48, I do not think that at that time he had any strong political opinions..except on the question of the Church. **1988** *Which?* July 321/2 Opinions on the usefulness of home banking varied widely. **2001** *Village Voice* (N.Y.) 27 Nov. 58/1 An articulate 36-year-old woman..who spoke fragrantly accented English and expressed feisty opinions.

**†2. a.** What is thought of a person by others; the (esp. good) estimation in which one stands; reputation (*of* being such, or *of* possessing some quality). *Obs.*

**c1384** *Bible* (Wycliffite, E.V.): *Matt.* (Douce 369(2)) iv. 24 His opynyoun, or fame [*a1425 L.V.* fame; L. *opinio*], wente in to al Syrie. ***a1420*** LYDGATE *Troyyes Bk.* (Augustus) II. 7909 He was most of oppinioun Amongis Grekis, and reputacioun. **c1450** tr. Aelred of Rievaulx *De Institutione Inclusarum* (Bodl.) 4 Chese the a confessour, the whiche is an auncyant man of gode fame and of gode oppinyon. **1532** *Test. Creseyde* in *Wks. G. Chaucer* sig. Qqvi, Of al women protectour and defence Thou were, and helped their opynioun. **1551** R. ROBINSON tr. T. More *Utopia* (1895) II. vi. 196 Which for the opinion of nobilitie reioyse muche in their owne conceite. **1598** SHAKESPEARE *1 Hen. IV* V. iv. 47 Thou hast redeemed thy lost opinion. **1605** W. CAMDEN *Remaines* I. 121 The change of names, hath most commonly proceeded from a desire to avoyd the opinion of basenes. **1637** J. SHIRLEY *Gamester* I. sig. B2$^{v}$, I meane you have the opinion Of a valiant genleman. **1685** C. COTTON tr. Montaigne *Ess.* I. 222 These fellows to make parade and to get opinion..are perpetually perplexing and entangling themselves in their own nonsense. **1705** G. STANHOPE *Paraphr.* II. 65 Every Counterfeit supposes something, not only of Reality but of Excellence too, which it hopes to gain the Opinion of, by such artful Dissimulation.

**b.** Report, rumour. *Obs.*

**c1384** *Bible* (Wycliffite, E.V.): *Matt.* (Douce 369(2)) xxiv. 6 ȝe ben to heere bateyls, and opynyouns of bateyls. [L. *Audituri enim estis praelia, et opiniones praeliorum.*]. ***a1425*** WYCLIF *Sel. Eng. Wks.* (1871) II. 23 And opynyoun of Crist wente þourȝ al þe lond of Siry. [Vulgate (Matthew 4:24) *Et abiit opinio eius in totam Syriam.*].

**3. a.** With specifying adjective, as *common, general, public, vulgar*, etc. A judgement, belief, or conviction held by the majority of or many people; what is generally thought about something. See also *opinion poll, opinion survey*, sense 7.

**c1390** CHAUCER *Pardoner's Tale* 601 If that a prynce vseth hasardrye..He is as by commune opynyoun Yholde the lasse. **?c1450** *Life St. Cuthbert* 743 þe comoun opynyon and tellyng..scottys men..say þat many myracles..God schewed be him. **1494** *Loutfut MS* f. 33$^{v}$, Eftir the opinion wlgair he [*sc.* the tench] hantez. **c1500** (?*a*1475) *Assembly of Gods* 1739 From Adam to Moyses, was idolatry Thorow the world vsyd in comon opynyoun. ***a*1538** A. ABELL *Roit or Quheill of Tyme* f. 6, And..he..slew hir eftir the common opunȝone. **1601** B. JONSON *Every Man in his Humor* V. i. sig. M, You see, How abiectly your Poetry is ranckt, in generall opinion. **1658** SIR T. BROWNE *Hydriotaphia* iv. 57 Mourning without hope, they had an happy fraud against excessive lamentation, by a common opinion that deep sorrows disturbed their ghosts. **1689-90** W. TEMPLE *Ess. Pop. Discontents* in *Wks.* (1731) I. 258 Nothing is so easily cheated, nor so commonly mistaken, as vulgar Opinion. **1735** VISCT. BOLINGBROKE *Diss. upon Parties* (ed. 2) Ded. p. xxxi, Let them stand, or fall in the publick Opinion, according to their Merit. **1763** LD. CHESTERFIELD *Let. to Duke of Newcastle* in *Lett.* (1845) II. 463 The public opinion put him below his level: for though he had no..eminent talents, he had a most indefatigable industry, a perseverance. **1792** T. PAINE *Rights of Man* II. v. 170 When such a time, from the general opinion of the nation, shall arrive. **1801** T. JEFFERSON in G. Tucker *Life* (1837) II. 101 The mighty wave of public opinion which has rolled over our republic. **1871** *Daily News* 20 Apr. 5 That is a question..in which 'general opinion must assume the ultimate arbitrement'. **1892** *Pall Mall Gaz.* 29 Nov. 5/1 When the court has pronounced its decision, then let it be freely commented upon; but until then parties must not attempt to influence public opinion. **1915** W. S. MAUGHAM *Of Human Bondage* xcvii. 513 Someone suggested that, if the war went on,..they would be glad to take anyone who was qualified; but the general opinion was that it would be over in a month. **1939** G. GALLUP (*title*) Public opinion in a democracy. **1983** J. BARZUN *Stroll with W. James* 2 Professional opinion was divided about what he really meant. **2002** *Times* 2 Jan. I. 4/3 Experts say that public opinion in all three countries will inevitably be influenced.

**b.** More generally: what or how one thinks about something; judgement or belief. Esp. in ***in my opinion***: according to my thinking; as it seems to me. ***a matter of opinion***: a matter about which each may have his or her own opinion; a disputable point.

***a*1393** GOWER *Confessio Amantis* (Fairf.) VIII. 2782 Of hem that walken up and doun Ther was diverse opinioun. ***a*1420** LYDGATE *Troyyes Bk.* (Augustus) I. 74 For wisdam & prudent aduertence..in myn opinioun..this fable of amptis was contreved. **1447** O. BOKENHAM *Lives of Saints* 156 They shul sone han helthe & bote..Thys is fully myn opynyounn. **1483** in H. Ellis *Orig. Lett. Eng. Hist.* (1827) 2nd Ser. I. 157 In myn openion it shuld be gretly for the wele of that toune. **1532** (*c*1385) *Usk's Test. Love* in W. W. Skeat *Chaucerian & Other Pieces* (1897) 103 Opinion is whyl a thing is in non-certayn, and hid from mens very knowleging. ***a*1538** T. STARKEY *Dial. Pole & Lupset* (1989) 8 Saying ther ys no dyfference betwyx vyce & vertue but strong opynyon. ***a*1628** J. PRESTON *Breast-plate of Faith* (1630) 118 The object of opinion is something in its own nature uncertain. **1644** MILTON *Areopagitica* 31 Opinion in good men is but knowledge in the making. **1704** J. NORRIS *Ess. Ideal World* II. ii. 130 What we call opinion, which is an imperfect assent or judgment. **1814** J. AUSTEN *Mansfield Park* I. xviii. 346 To see such an undersized, little, mean-looking man, set up for a fine actor, is very ridiculous in my opinion. **1852** H. B. STOWE *Uncle Tom's Cabin* xv. 141 Well, the position may be a matter of opinion. **1875** B. JOWETT tr. Plato *Dialogues* (ed. 2) IV. 23 Opinion is based on

perception, which may be correct or mistaken. **a1902** S. BUTLER *Way of All Flesh* (1903) xxxvii. 160, I never believed in the project, and have seen no reason to alter my original opinion. **1949** 'G. ORWELL' *1984* II. vi. 159 That is not only my own opinion. **1988** *Jrnl. Theol. Stud.* **39** 560 This is, of course, a matter where there is legitimate difference of opinion. **2000** J. GOODWIN *Danny Boy* iv. 95 He turned aside to help the kid, who was, in my opinion, not playing with a full team.

**c.** ***to be of (the) opinion (that)***: to hold the belief or view; to think (that). Also with further syntactic variation.

**a1420** LYDGATE *Troyyes Bk.* (Augustus) II. 817 Iacobus de Vitriaco Is contrarie of oppynioun. **1485** CAXTON tr. *Charles the Grete* 103 Thyery and the other were of thoppynyon of Rolland. **1548** *Hall's Vnion: Richard III* f. l, Noble men..which emongest theim selfes were not of one opinion. **1589** G. PUTTENHAM *Arte Eng. Poesie* I. xviii. 30 Some be of opinion..that the pastorall Poesie..should be the first of any other. **1623** J. BINGHAM tr. Xenophon *Hist.* 49 All, that are of the same opinion, let them hold vp their hands. **1714** J. PURCELL *Treat. Cholick* 93, I am of Opinion..that the hitherto unknown use of the Spleen, is to interrupt the Fermentation of the Blood. **1735** B. FRANKLIN *Man of Sense* 11 Feb. in *Papers* (1960) II. 16, I am really of that Opinion. **1785** T. JEFFERSON *Let.* 25 Sept. in *Papers* (1953) VIII. 549 If you are of the same opinion I would trouble you to send me two sets of table cloths and napkins. **1818** W. CRUISE *Digest Laws Eng. Property* (ed. 2) VI. 455 He was clearly of opinion they were both liable. **1856** R. W. EMERSON *Eng. Traits* vi. 106 They require you to dare to be of your own opinion. **1886** H. JAMES *Bostonians* (1966) xii. 79, I am of the opinion..there was a lady behind everything. **1904** L. F. BAUM *Marvelous Land of Oz* 129 These females are..of the opinion that men have ruled the land long enough. **1947** G. VIDAL *In Yellow Wood* I. iii. 37, I am of the opinion that this is a rising market. **1991** *Washington Post* 14 July F4/2, I am firmly of the opinion that ecocide is our certain future. **2000** *Canoeist* Apr. 21/1 We were both of the opinion that this was a force 9 gale.

**d.** Public or general opinion.

**1598** J. MARSTON *To Detraction* 17 in *Scourge* sig. A3$^{v}$, True iudgement, slight regards Opinion. **1603** J. FLORIO tr. Montaigne *Ess.* I. xl. 133 Opinion is a power-full, bold, and vnmeasurable party. **1638** R. BAKER tr. J. L. G. de Balzac *New Epist.* II. 96 It is not now onely that opinion governes the world; there hath beene disputing against Reason in all ages. **1753** J. HANWAY *Hist. Acct. Brit. Trade Caspian Sea* (1762) II. I. i. 4 Those..who offer incense to this..stupid idol, opinion. **1837** H. MARTINEAU *Society in Amer.* III. 7 The worship of Opinion is, at this day, the established religion of the United States. **1841** I. D'ISRAELI *Amenities Lit.* (1867) Pref. 3 Authors are the creators or the creatures of opinion. **1872** 'G. ELIOT' *Middlemarch* I. vi. 88 There is no part of the county where opinion is narrower than it is here. **1910** *Encycl. Brit.* I. 429/2 Opinion is divided between Darius Hystaspes and Xerxes. **1946** W. IVINS *Art & Geometry* iv. 74 Opinion about such a matter could in the most literal, faggot, sense become a burning question. **1996** *SFX* May 63/1 Opinion is divided straight down the gender lines over whether Frank is right to indulge in a spot of extra-marital. **2002** *Evening Standard* (Palmerston North, N.Z.) (Nexis) 11 Nov. 3 Opinion is divided on what caused an increase in unemployment during the last economic quarter.

**4.** A formal statement by a judge or other competent authority of what he or she judges or advises on a matter; professional advice; as a ***legal*** (also ***medical***) ***opinion, to get an opinion of counsel***, etc. In ***a second*** (also ***another***) ***opinion***: the opinion of a second (esp. medical) expert or adviser. Also in transferred and extended uses.

***a1393*** GOWER *Confessio Amantis* (Fairf.) II. 3214 Therto thei [*sc.* doctors] acorden alle As for final conclusioun, And tolden here opinioun To themperour. ***c1485*** (1456) G. HAY *Bk. Knychthede* (1914) 148 Quhen thou askis at thy counsailouris thair opyniounis. ***1488*** HARY *Actis & Deidis Schir William Wallace* III. 332, 'I gif consell, or this gud knycht be slayne, Tak pes a quhill, suppos it do ws payne.' So said Adam the ayr of Rycardtoune; And Kneland als grantyt to thar opynyoun. ***a1533*** LD. BERNERS tr. *Huon* lxxxii. 254, I desyre you all..to shew me your opynyons. ***1563*** N. WINȝET *Certain Tractates* (1888) I. 66 To ansuer till ws in writt ȝour opinioun and auctoritie thairfor concerning the articlis subsequent. ***1598*** *Let. to Stowe* (Ashm. MSS.), Your oppinioun in wrytinge or otherwise is expected. ***1627*** *Rep. Parishes Scotl.* (1835) 43 Oure judgement and oppinioun concerneing the articles proponit wnto ws. ***1696*** E. PHILLIPS *New World of Words* (ed. 5), *Opinion*, the Thought of him who gives his Advice upon any thing that is debated or consulted upon. ***1742*** H. FIELDING *Joseph Andrews* I. i. xiii. 87 He would be obliged to him, if he would let him know his opinion of his Patient's Case above stairs. ***1779*** T. JEFFERSON *Let.* 27 Mar. in *Papers* (1950) II. 239 Perhaps the magnitude of this question..may render it worth while to await the opinion of the national council. ***1817*** J. MILL *Hist. Brit. India* II. v. v. 496 The Supreme Council..came to an opinion..that [etc.]. ***1861*** H. S. MAINE *Anc. Law* ii. 33 Collections of opinions interpretative of the Twelve Tables. ***1885*** C. M. YONGE *Nuttie's Father* II. xvii. 201 Dr. Brownlow..said it was a surgical case, and he should like to have another opinion. ***1888*** *Chambers's Encycl.* s.v. *Barrister*, Barristers in England advise on the law by giving an opinion on a case stated. ***1899*** *Westm. Gaz.* 9 Nov. 1/2 The three clergymen..who have refused obedience to the Archbishops' 'Opinion' on the legality of incense and processional lights. ***1924*** J. BUCHAN *Three Hostages* xvi. 237 There's no cause to worry about Peter John... But if you want another opinion, why not get it? ***1954*** M. SHARP *Gipsy in Parlour* xxiv. 228 So my father and Miss Jones agreed... I didn't think my father would be quite so pleased to know of this second opinion, so to speak. ***1970*** P. LOVESEY *Wobble to Death* v. 52 Perhaps—another opinion. Your colleague..may see the possibility of a faster recovery. ***1976*** A. CLARE *Psychiatry in Dissent* viii. 329 Two medical opinions..are required and the order is valid for twenty-eight days. ***2000*** *Internat. Jrnl. Advertising* **19** 68 The editor may call for a 'second opinion' before accepting or rejecting [an article].

**5.** **†a.** Favourable estimate of oneself; conceit, arrogance; self-confidence. *Obs. rare.*

***a1420*** LYDGATE *Troyyes Bk.* (Augustus) v. 67 Palladioun, Whiche Vlixes..vniustly doth possede, On hym vsurpinge by fals oppinioun. ***1598*** SHAKESPEARE *1 Hen. IV* III. i. 181 Pride, hautinesse, opinion, and disdaine. ***1609*** SHAKESPEARE *Tr. & Cr.* I. iii. 347 What heart receiues from hence a conquering part, To steele a strong opinion to them selues.

**b.** *spec.* A good or favourable estimate of someone or something; esteem. Esp. in ***to have no (great) opinion of***: to regard as inferior or unworthy.

***a1450*** (?c1421) LYDGATE *Siege Thebes* (Arun.) 2463 Euery man hath swich opynyoun In Tydeus for his gentyllesse..That he was holde the moste famous knyght. ***c1451*** J.

CAPGRAVE *Life St. Gilbert* 112 He led a solitary lif in þe mountes and was in gret opinion both to þe Pope & þe court. **1545** BP. S. GARDINER *Let.* 7 Nov. (1933) 179 If we leave nowe, we shal wynne this opinion, that we leave required and desired. **1597** T. MORLEY *Plaine & Easie Introd. Musicke* 115 Those who stande so much in opinion of their owne sufficiencie. ***a*1687** W. PETTY *Polit. Anat. Ireland* (1691) 94 They have a great Opinion of Holy-Wells, Rocks, and Caves, which have been the reputed Cells and Receptacles of..Saints. **1729** W. LAW *Serious Call* (1920) xix. 254 If a woman had no opinion of her own person and dress. **1749** H. FIELDING *Tom Jones* V. XV. vi. 239, I know you have no Opinion of my Parts; but I'll shew you on this Occasion who is a Fool. **1813** J. AUSTEN *Pride & Prejudice* I. ii. 9 She is a selfish, hypocritical woman, and I have no opinion of her. **1861** DICKENS *Great Expectations* I. xvii. 282, I must tell you I should have no opinion of you, Biddy, if he danced at you with your own consent. **1886** R. L. STEVENSON *Kidnapped* v. 38, I had a great opinion of my shrewdness. **1929** J. B. PRIESTLY *Good Companions* I. i. 10 Leonard might be the darling of his mother's heart, as indeed he was, but it was clear that his father had no great opinion of him. **1976** N. FREELING *Lake Isle* xx. 140 I've no opinion of the stuff the supermarket calls Scotch. **1986** P. O'BRIAN *Reverse of Medal* viii. 237 Stephen had no opinion of that vapouring quack.

**c.** What one thinks *of* a person or thing; an estimate of character, quality, or value.

***c*1480** *St. Blaise* (Cambr.) 9 in W. M. Metcalfe *Legends Saints Sc. Dial.* (1896) I. 361 Sume men gud opunyone Has..Quhat man he was. ***c*1510** T. MORE tr. G. F. Pico della Mirandola *Lyfe J. Picus* in *Wks.* 14/2 Ye haue not knowen the opinion, y^e^ philosophers haue of them self. **1551** in A. I. Cameron *Sc. Corr. Mary of Lorraine* (1927) 345 That the King..sulde have..the better oppenyon in him. ***a*1616** SHAKESPEARE *Macb.* (1623) I. vii. 33, I haue bought Golden Opinions from all sorts of people. **1638** R. BAKER tr. J. L. G. de Balzac *New Epist.* II. 203 It is impossible for mee to expresse the high opinion I conceive of you. **1675** W. WYCHERLEY *Country-wife* III. 43 His kindness only is not enough for me, without your favour; your good opinion, dear Madam, 'tis that must perfect my happiness. **1722** D. DEFOE *Moll Flanders* 16, I..had as good an Opinion of myself, as any body else could have of me. **1771** *Junius Lett.* xlviii. 253 Their constituents would have a better opinion of their candour, and..not a worse opinion of their integrity. **1811** J. AUSTEN *Sense & Sensibility* I. i. 1 For many generations, they had lived in so respectable a manner, as to engage the general good opinion of their surrounding acquaintance. **1847** C. BRONTË *Jane Eyre* III. i. 29 But, Jane, I see by your face you are not forming a very favourable opinion of me just now. **1897** M. KINGSLEY *Trav. W. Afr.* 12 The Coast..formed an even higher opinion of my folly than it had formed on our first acquaintance, which is saying a good deal. **1909** L. M. MONTGOMERY *Anne of Avonlea* vi. 57 'It's really a beautiful world.' 'You won't have such a high opinion of it when you've lived as long in it as I have,' retorted Miss Eliza sourly. **1965** E. J. HOWARD *After Julius* II. vii. 104 She didn't clear up much..and his opinion of her dropped further still. **2000** A. GHOSH *Glass Palace* (2001) xxx. 353 Their CO had taken no pains to disguise his low opinion of his Indian officers.

**†6.** Thought of what is likely to be the case, knowledge; expectation based on knowledge or belief. *Obs.*

***a*1420** LYDGATE *Troyyes Bk.* (Augustus) V. 3179 He..smot þe kyng..Having þo noon

oppinioun þat he was kyng, nor suspecioun. **a1425** (c1385) CHAUCER *Troilus & Criseyde* IV. 1495 In me ther may nat synke A good opynyoun, if that ye wende. **c1450** J. CAPGRAVE *Life St. Katherine* (Arun. 396) I. 162 Whan þing is ferthest fro ovre oppynyon, Than werketh he his wondrys ryght at his wille. **1548** *Hall's Vnion: Henry VI* f. cviij$^{v}$, [He] thought now, that al thynges succeeded, accordyng to his opinion and good hope. **1568** G. SKEYNE *Breue Descr. Pest* (1860) 27 Quhay..most remoue the opinione of dethe, but not the dredour of God. **1601** R. JOHNSON tr. G. Botero *Travellers Breviat* (1603) 197 The warre continuing beyonde opinion, the State was inforced to procure pay for the armie. **1605** J. DOVE *Confutation of Atheisme* 5 When their consciences are possessed with an opinion of hell fire. **1658** SIR T. BROWNE *Hydriotaphia* Ep. Ded. to T. Le Gros sig. A2, Having no old experience of the duration of their Reliques, [men] held no opinion of such after considerations.

**II.** Compounds.

**7.** General *attrib.*, as ***opinion-former, holder, leader, -maker***, etc.; ***opinion-breeding, -making*** n. and adj.; ***opinion-forming, -tapping*** adjs. **opinion column**, a column in a newspaper or periodical which contains an opinion piece; an article in such a column (quot. 1947 refers to a regular column entitled 'Opinion'). **opinion mill**, a person who or organization which speculates on or disseminates public opinions. **opinion piece**, an article in a newspaper or periodical expressing the opinion (freq. one which is controversial or biased) of the writer on a particular item of news. **opinion poll**, an assessment of public opinion taken by questioning a random or representative sample of the public, often as a basis for forecasting patterns of voting (cf. sense 3a). **opinion polling**, the compiling of opinion polls. **opinion pollster**, a person or organization engaged in compiling opinion polls. **opinion survey** = *opinion poll*. **opinion trade**, the business of polling or expressing opinions.

**1875** W. CORY *Lett. & Jrnls.* (1897) 375 Morbid combination of piety with *opinion-breeding.

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**1947** R. B. MCCALLUM & A. READMAN *Brit. Gen. Election 1945* xi. 206 Its '*Opinion' column was available for the development of his own peculiar election policy. **1955** *Amer. Econ. Rev.* **45** 493 A regular refrain in the opinion columns of the several trade magazines read by exhibitors. **1997** *Esquire* Feb. 113/2 His old friend..asked him to contribute occasional opinion columns.

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**1906** G. W. E. RUSSELL *Social Silhouettes* xiii. 90, I should, I confess, resent any change which interfered with my position as chief *opinion-former. **1962** *Times Lit. Suppl.* 24 Aug. 633/4 To hear well over half the electors of Britain talk, or read or listen to their favourite opinion-formers, one would conclude that it would be best..if no profits were made by any business. **2001** *Times* 30 Nov. II. 21/3 The Government believes..newspapers..'often consider themselves to be opinion-formers as much as conveyors of news.'

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**1901** *Amer. Jrnl. Sociol.* **6** 551 They [*sc.* artists, speakers, preachers, etc.] constitute the other *opinion-forming sections of society. **1959** *Encounter* Nov. 66 Literary

parties..the opinion-forming fringe of the United States. **2002** *Grocer* 9 Mar. 88 (*advt.*) Your brief will be to..continue to improve the brand status through key outlets and opinion forming consumers.

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**c1449** R. PECOCK *Repressor* 87 Summe..ben clepid Doctour-mongers, and summe ben clepid *Opinioun-holders. ***a1500*** tr. A. Chartier *Traité de l'Esperance* (Rawl.) 81 That hope..to opinion holders and obstinates is hope opynatyffe. **1996** *Jrnl. Polit.* **58** 664 The property among opinion-holders of being for or against the nomination. **2002** *Afr. News* (Nexis) 7 Sept., We have all decided to form a consortium of like-minded opinion holders against the return of Alamieyeseigha in 2003.

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**1936** J. K. POLLOCK in E. B. Logan *Amer. Polit. Scene* v. 228 *Opinion leaders used every means available for making their propaganda perceived. **1968** *Internat. Encycl. Soc. Sci.* III. 51 The hard-core noncommissioned officers constituted a cadre of 'opinion leaders' who supported the control structure. **2002** *N.Y. Mag.* 6 May 18/3 There were 1,500 'decision-makers' at the top of the pyramid..then 15,000 opinion-leaders below them.

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**1858** *Harper's Mag.* Dec. 61/1 She knew every body's business, talked to every body, and acted as *opinion-maker to a large majority of ladies. **1952** *Time* 27 Oct. 20/1 To intellectuals and other 'opinion makers', Eisenhower was infinitely preferable to the other two. **1975** S. RANGANATHAN in H. M. Patel et al. *Say not Struggle Nought Availeth* 297 There are limits to growth as world opinion-makers are trying to explain. **2001** *Wall St. Jrnl.* 17 Sept. A18/1 Gen. Musharraf spent yesterday meeting with religious officials and opinion-makers to persuade them to back his policy.

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**1900** *Internat. Jrnl. Ethics* **10** 173 (*heading*) The ethics of *opinion-making. **1956** C. W. HILLS *Power Elite* xiii. 310 The means of opinion-making..have paralleled in range and efficiency the other institutions of greater scale. **2001** *N.Y. Mag.* 10 Sept. 40/3 Venture outside the opinion-making precincts..and the view of [Mayor] Giuliani is far more mixed.

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**1867** J. G. WHITTIER *Tent on Beach* 85 One..Who..Had left the Muses' haunts to turn The crank of an *opinion-mill, Making his rustic reed of song A weapon in the war with wrong. **1994** M. BÉRUBÉ *Public Access* 3 Since all the debates were taking place in the space of ten days, the opinion mill was working overtime. **2001** *Slate Mag.* (Nexis) 26 Feb., Our occasional exasperation with the opinion mill is literally the fallout of an overly disparate social and political context.

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**1957** A. E. ROWSE *Slanted News* iii. 43 This *opinion piece, presenting the Hearst editorial line for the day, appeared in other papers in the chain. **2002** *Guardian* 17 Dec. 14/2 There are now,..more than 120 people in the British media who write regular week-in-week-out opinion pieces about domestic politics.

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[**1937** *Sociometry* **1** I. II. 155 (*title*) Public opinion polls.] **1939** C. W. SMITH *Public Opinion in Democracy* 414 To the social scientist, *opinion polls offer at least two other

possibilities of usefulness. **1965** *New Statesman* 30 Apr. 670/3 The substantial pro-Labour swing indicated by the opinion polls. **1976** *Times* 27 Feb. 14/4 It is clear from opinion polls that the very large majority of people in Scotland wish to remain part of Britain. **2001** *Financial Times* 27 Jan. 6/8 Opinion polls published yesterday confirmed Mr Sharon showed no sign of losing his 18 percentage point margin over Mr Barak.

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**1941** *Amer. Jrnl. Sociol.* **47** 463 The organization known as 'War-Time Social Survey', which resembles American *opinion-polling organizations. **1982** A. BRINKLEY *Voices of Protest* Pref. p. x, Both movements existed in an era before modern opinion-polling. **2001** *Times* 12 Sept. (Terror in Amer. Suppl.) 14/3 Khalil Shikaki, an expert on Palestinian politics..runs an opinion polling centre.

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**1951** M. MCLUHAN *Mech. Bride* 47/1 The cabdriver tends to be the *opinion-pollster hero. **1977** *News of World* 17 Apr. 1/1 Its existence is unknown to two out of every three women in the country, according to opinion pollsters. **2002** *Times* (Nexis) 12 Nov. II. 14 Opinion-pollsters found his popularity running at 80 per cent.

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**1939** G. GALLUP *Public Opinion in Democracy* 12 If elections themselves do not impose clôture on debate, is it likely that *opinion surveys will? **1958** *New Statesman* 23 Aug. 213/3 The first would entail many interviews with people by the well-tried opinion-survey methods. **2000** *Amer. Heritage* Nov. 58/1 Those experimental days of 50 and 60 years ago were the dinosaur era of scientific opinion surveys.

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**1948** J. TOWSTER *Polit. Power in U.S.S.R.* vii. 153 The Party conference..is primarily..an *opinion-tapping and effort-mobilizing agency.

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**1787** J. BENTHAM *Corr.* 27 Aug. (1971) III. 560 The being seen to be ignorant..gives me not the least concern. I have no *opinion-trade to spoil. **1808** J. BENTHAM *Sc. Reform* 23 On the part of the non-lawyer, conscious ignorance, thence consultation and advice (opinion-trade). **2001** *Columbian* (Vancouver, WA.) (Nexis) 9 Nov. C11 The great failing of the opinion trade, we assured one another, was its practitioners' proclivity for pontificating on the distant mystery.

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# EXHIBIT 10

## Freno, Michael

**From:** Daphne Kwon [dkwon@expotv.com]
**Sent:** Monday, February 19, 2007 7:00 PM
**To:** Freno, Michael
**Cc:** Bill Hildebolt; Thi Luu
**Subject:** RE: Please revise usage of VIDEOPINIONS

Please see below the notice to Dan Orum, CEO of IDG Entertainment, holding company of Gamepro.com.

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**From:** Daphne Kwon
**Sent:** Monday, February 19, 2007 6:56 PM
**To:** 'dorum@idg-entertainment.com'
**Cc:** Bill Hildebolt; Thi Luu
**Subject:** Please revise usage of VIDEOPINIONS

Dan Orum,

Thank you again for all the help with the promotion of our website. We have discovered the incorrect usage of one of our service marks. We would like to request that you change the following:

1) Regarding your webpage: http://www.gamepro.com/gamepro/domestic/games/features/79168.shtml
2) Please revise the phrase "...vote at Expo TV's videopinion website" to "...vote at Expo TV's VIDEOPINIONS website."

Apart from using the proper plural usage, VIDEOPINIONS is a service mark for which Expo Communications, Inc. claims rights, and is currently seeking federal protection. Although we do not believe that you were using the mark descriptively, the proper use of the mark is "Videopinions" and preferably, "VIDEOPINIONS". Thank you in advance for your cooperation.

Many thanks,
Daphne Kwon
CEO, Expo Communications, Inc.

# EXHIBIT 11

## Freno, Michael

**From:** estta-server@uspto.gov
**Posted At:** Tuesday, February 20, 2007 1:41 PM
**Conversation:** ESTTA. Notice of Appeal. confirmation receipt ID: ESTTA125758
**Posted To:** Microsoft Office Outlook Embedded Message

**Subject:** ESTTA. Notice of Appeal. confirmation receipt ID: ESTTA125758

Notice of Appeal.

Tracking No: ESTTA125758

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

We have received your Notice of Appeal. submitted through the Trademark Trial and Appeal Board's ESTTA electronic filing system.
This is the only receipt which will be sent for this paper. If the Board later determines that your submission is inappropriate and should not have been accepted through ESTTA, you will receive notification and appropriate action will be taken.

Please note:

Unless your submission fails to meet the minimum legal requirements for filing, the Board will not cancel the filing or refund any fee paid.

If you have a technical question, comment or concern about your ESTTA submission, call 571-272-8500 during business hours or e-mail at estta@uspto.gov.

The status of any Board proceeding may be checked using TTABVUE which is available at http://ttabvue.uspto.gov Complete information on Board proceedings is not available through the TESS or TARR databases. Please allow a minimum of 2 business days for TTABVUE to be updated with information on your submission.

The Board will consider and take appropriate action on your filing in due course.

Printable version of your request is attached to this e-mail

---
ESTTA server at http://estta.uspto.gov

ESTTA Tracking number: ESTTA125758
Filing date: 02/20/2007

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

Application Serial No.:78654480

Applicant: Expo Communications, Inc.

Notice of Appeal

Notice is hereby given that appeal to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 78654480.

Applicant has filed a request for reconsideration of the refusal to register, and requestssuspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following classes of goods/services:

IC 035
IC 038
IC 041

Respectfully submitted,
JOSEPH F. NICHOLSON, ESQ.
/Joseph F. Nicholson/
02/20/2007
JOSEPH F. NICHOLSON, ESQ.
KENYON & KENYON,
1 BROADWAY
NEW YORK, NY 10004-1007
UNITED STATES
tmdocketny@kenyon.com Phone:212-425-7200

# EXHIBIT 12

*TESS was last updated on Tue Feb 20 04:17:44 EST 2007*



# OPINIONPORT

| | |
|---|---|
| **Word Mark** | OPINIONPORT |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Public opinion polling; public policy research services; business research and surveys; consultancy services regarding business strategies; conducting business and market research surveys; public opinion surveys. FIRST USE: 20000100. FIRST USE IN COMMERCE: 20000100<br><br>IC 042. US 100 101. G & S: Providing online non-downloadable software for use in conducting public opinion polling and public opinion surveys. FIRST USE: 20000100. FIRST USE IN COMMERCE: 20000100 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78791234 |
| **Filing Date** | January 13, 2006 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 5, 2006 |
| **Registration Number** | 3174111 |
| **Registration Date** | November 21, 2006 |
| **Owner** | (REGISTRANT) Schulman, Ronca & Bucuvalas, Inc. CORPORATION NEW JERSEY 145 East 32nd Street, Suite 500 New York NEW YORK 10016 |
| **Attorney of Record** | Roxanne A. Esch |

| | |
|---|---|
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

*TESS was last updated on Tue Feb 20 04:17:44 EST 2007*



# Opinionbank

| | |
|---|---|
| **Word Mark** | OPINIONBANK |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Customer Experience Surveys. FIRST USE: 20021109. FIRST USE IN COMMERCE: 20030501 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78346462 |
| **Filing Date** | December 30, 2003 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | October 12, 2004 |
| **Registration Number** | 2916459 |
| **Registration Date** | January 4, 2005 |
| **Owner** | (REGISTRANT) Opinionbank LTD LIAB CO GEORGIA 3130 Milford Chase Marietta GEORGIA 30008 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

*TESS was last updated on Tue Feb 20 04:17:44 EST 2007*



# ValuedOpinion

| | |
|---|---|
| **Word Mark** | VALUEDOPINION |
| **Goods and Services** | IC 035. US 100 101 102. G & S: BUSINESS, MARKETING AND CUSTOMER RESEARCH; MYSTERY SHOPPING, NAMELY, SHOPPING BY RESEARCHERS WHO POSE AS CUSTOMERS TO EVALUATE THE QUALITY OF SERVICE DELIVERED; AND BUSINESS EVALUATION SERVICES, NAMELY, COMPETITIVE GATHERING OF BUSINESS INTELLIGENCE FOR RETAIL AND HOSPITALITY INDUSTRIES. FIRST USE: 20020226. FIRST USE IN COMMERCE: 20020404 |
| **Mark Drawing Code** | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| **Design Search Code** | 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters |
| **Serial Number** | 78120351 |
| **Filing Date** | April 8, 2002 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | December 10, 2002 |
| **Registration Number** | 2693480 |
| **Registration Date** | March 4, 2003 |
| **Owner** | (REGISTRANT) Herbert, Anne R. INDIVIDUAL UNITED STATES 271 Tyler Street Pittsfield MASSACHUSETTS 01201 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

*TESS was last updated on Tue Feb 20 04:17:44 EST 2007*



## Typed Drawing

| | |
|---|---|
| **Word Mark** | OPINIONSCOPE |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Market research in the nature of conducting on-line focus group interviews and testing to assess the performance and effectiveness of the web sites of others; marketing research; conducting business research and surveys. FIRST USE: 20001101. FIRST USE IN COMMERCE: 20010515 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 78068609 |
| **Filing Date** | June 12, 2001 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | December 11, 2001 |
| **Registration Number** | 2644621 |
| **Registration Date** | October 29, 2002 |
| **Owner** | (REGISTRANT) Netsch, Steven P. INDIVIDUAL UNITED STATES 11705 Shannon Court #214 Eden Prarie MINNESOTA 55344 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

*TESS was last updated on Tue Feb 20 04:17:44 EST 2007*



# ECHOPINION

| | |
|---|---|
| **Word Mark** | ECHOPINION |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Marketing services, namely the promotion of goods and services of others through a membership based Internet portal designed to capture, measure and research the effects of social networks and the flow of information between members inside these networks; Creation, design, development and implementation of promotional print/interactive material as it directly relates to "word of mouth" marketing; Consulting services relating to the creation, design, development and implementation of promotional print/interactive material as used directly in connection with consumer-to-consumer or "word of mouth" marketing. FIRST USE: 20041101. FIRST USE IN COMMERCE: 20041101 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 76618241 |
| **Filing Date** | October 28, 2004 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | September 27, 2005 |
| **Registration Number** | 3101373 |
| **Registration Date** | June 6, 2006 |
| **Owner** | (REGISTRANT) Research Associates of Syracuse, Inc. CORPORATION NEW YORK 6780 Northern Boulevard, Suite 100 East Syracuse NEW YORK 13057 |
| **Attorney of** | Virginia A. Hoveman |

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| **Record** | |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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## Typed Drawing

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|---|---|
| **Word Mark** | OPINIONSPOT |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Providing organized quantitative and qualitative statistical information over a computer network community based upon survey and discussion data obtained through a computer network community. FIRST USE: 20000320. FIRST USE IN COMMERCE: 20000331 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76083412 |
| **Filing Date** | July 6, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | March 26, 2002 |
| **Registration Number** | 2581024 |
| **Registration Date** | June 18, 2002 |
| **Owner** | (REGISTRANT) OpinionWare.com CORPORATION DELAWARE 8362 Tamarack Village Suite 119-207 Woodbury MINNESOTA 55125<br><br>(LAST LISTED OWNER) SILK ROAD TECHNOLOGY, INC. CORPORATION DELAWARE 111 N. CHESNUT ST. STE. 200 WINSTON-SALEM NORTH CAROLINA 27101 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | MATTHEW W. WALCH |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| ***Live/Dead Indicator*** | **LIVE** |

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# OpinionQuest™

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|---|---|
| **Word Mark** | OPINIONQUEST |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Business consulting services, namely, employee opinion surveys, interviews and assessments to determine employee attitudes, assess performance and the effectiveness of management communication in the workplace. FIRST USE: 19981221. FIRST USE IN COMMERCE: 19981221 |
| **Mark Drawing Code** | (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM |
| **Design Search Code** | |
| **Serial Number** | 75633351 |
| **Filing Date** | February 4, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | November 23, 1999 |
| **Registration Number** | 2319121 |
| **Registration Date** | February 15, 2000 |
| **Owner** | (REGISTRANT) Paragon, Inc. CORPORATION NEBRASKA 1320 P Street Lincoln NEBRASKA 68508<br><br>(LAST LISTED OWNER) KENEXA CORPORATION CORPORATION PENNSYLVANIA 650 EAST SWEDESFORD ROAD WAYNE PENNSYLVANIA 19087 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | PAUL J. KENNEDY |
| **Type of Mark** | SERVICE MARK |

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|---|---|
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | OPINIONLAB |
| **Goods and Services** | IC 009. US 021 023 026 036 038. G & S: Computer software to monitor web sites for others. FIRST USE: 20000503. FIRST USE IN COMMERCE: 20000503<br><br>IC 035. US 100 101 102. G & S: Conducting advertising and marketing studies for web sites for others. FIRST USE: 20000503. FIRST USE IN COMMERCE: 20000503<br><br>IC 042. US 100 101. G & S: Computer services, namely, designing and implementing web site monitoring systems; and providing measurement evaluations of the use and design of web sites. FIRST USE: 20000503. FIRST USE IN COMMERCE: 20000503 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75933648 |
| **Filing Date** | March 3, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | October 9, 2001 |
| **Registration Number** | 2636259 |
| **Registration Date** | October 15, 2002 |
| **Owner** | (REGISTRANT) OPINIONLAB, INC. CORPORATION DELAWARE 513 CENTRAL AVENUE, 3RD FLOOR HIGHLAND PARK ILLINOIS 60035 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | ANITA NESSER |
| **Type of Mark** | TRADEMARK. SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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## Typed Drawing

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|---|---|
| **Word Mark** | QUALITYOPINIONS.COM |
| **Goods and Services** | IC 035. US 100 101 102. G & S: business consulting services, namely providing customized information to others as to the best clinical approaches to care for ambulatory and hospital-based conditions and disease management for patients, physicians, health systems, managed care companies and pharmaceutical companies. FIRST USE: 19991015. FIRST USE IN COMMERCE: 19991015 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75877901 |
| **Filing Date** | December 22, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Supplemental Register Date** | February 28, 2001 |
| **Registration Number** | 2463003 |
| **Registration Date** | June 19, 2001 |
| **Owner** | (REGISTRANT) DoctorQuality.com CORPORATION NEW JERSEY 195 Davis Road Lawnside NEW JERSEY 08045 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Camille M. Miller |
| **Type of Mark** | SERVICE MARK |
| **Register** | SUPPLEMENTAL |
| **Live/Dead Indicator** | LIVE |

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internetOpinions.com

| | |
|---|---|
| **Word Mark** | INTERNETOPINIONS.COM |
| **Goods and Services** | IC 035. US 100 101 102. G & S: Opinion polling for business or advertising purposes. FIRST USE: 19990521. FIRST USE IN COMMERCE: 19991022 |
| **Mark Drawing Code** | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| **Design Search Code** | 24.17.15 - Check marks |
| **Serial Number** | 75867282 |
| **Filing Date** | December 9, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | December 5, 2000 |
| **Registration Number** | 2431248 |
| **Registration Date** | February 27, 2001 |
| **Owner** | (REGISTRANT) BRUNO AND RIDGWAY RESEARCH ASSOCIATES, INC. CORPORATION NEW JERSEY 3131 Princeton Pike, Building 2A Lawrenceville NEW JERSEY 08648 |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

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## Typed Drawing

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|---|---|
| **Word Mark** | OPINIONSITE |
| **Goods and Services** | IC 035. US 100 101 102. G & S: MARKET RESEARCH SERVICES. FIRST USE: 19990400. FIRST USE IN COMMERCE: 19990400 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75741772 |
| **Filing Date** | June 30, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | September 26, 2000 |
| **Registration Number** | 2413724 |
| **Registration Date** | December 19, 2000 |
| **Owner** | (REGISTRANT) Lieberman Research Group LLC LTD LIAB CO NEW YORK 98 Cutter Mill Road Great Neck NEW YORK 11021 |
| **Attorney of Record** | SETH NATTER |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | **LIVE** |

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## Typed Drawing

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|---|---|
| **Word Mark** | WORLDOPINION |
| **Goods and Services** | IC 035. US 100 101 102. G & S: providing marketing research information, reports, lists and advertising via a home page on a global computer network. FIRST USE: 19960415. FIRST USE IN COMMERCE: 19960415 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75097454 |
| **Filing Date** | May 1, 1996 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | January 7, 1997 |
| **Registration Number** | 2049085 |
| **Registration Date** | April 1, 1997 |
| **Owner** | (REGISTRANT) Survey Sampling, Inc. CORPORATION CONNECTICUT One Post Road Fairfield CONNECTICUT 06430<br><br>(LAST LISTED OWNER) SURVEY SAMPLING INTERNATIONAL, LLC LTD LIAB CO BY ASSIGNMENT DELAWARE ONE POST ROAD FAIRFIELD CONNECTICUT 06430 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | JANIK MARCOVICI |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). |
| **Live/Dead Indicator** | LIVE |

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# OPINION 1

| | |
|---|---|
| **Word Mark** | OPINION 1 |
| **Goods and Services** | IC 035. US 101. G & S: market research services. FIRST USE: 19920110. FIRST USE IN COMMERCE: 19920110 |
| **Mark Drawing Code** | (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM |
| **Design Search Code** | |
| **Serial Number** | 74253723 |
| **Filing Date** | March 9, 1992 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | March 2, 1993 |
| **Registration Number** | 1773144 |
| **Registration Date** | May 25, 1993 |
| **Owner** | (REGISTRANT) BURKE MARKETING RESEARCH, INC. CORPORATION OHIO 800 Broadway Cincinnati OHIO 45202<br><br>(LAST LISTED OWNER) CAVI ACQUISITION, INC. CORPORATION DELAWARE 1 WEST FOURTH STREET SUITE 601 CINCINNATI OHIO 45202 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | SCOTT C. WELLS |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Affidavit Text** | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040224. |
| **Renewal** | 1ST RENEWAL 20040224 |
| ***Live/Dead Indicator*** | **LIVE** |

## Typed Drawing

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|---|---|
| **Word Mark** | MYCASINOPINIONS |
| **Goods and Services** | IC 038. US 100 101 104. G & S: Providing online forums for transmission of messages among computer users concerning all aspects of the gaming industry. FIRST USE: 20000628. FIRST USE IN COMMERCE: 20000628<br><br>IC 041. US 100 101 107. G & S: Providing and on-line database in the field of gambling whereby users can submit their analysis and opinion of on-line and land-base casinos and review the opinions of others. FIRST USE: 20000628. FIRST USE IN COMMERCE: 20000628 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76156330 |
| **Filing Date** | October 30, 2000 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | December 24, 2002 |
| **Registration Number** | 2697053 |
| **Registration Date** | March 18, 2003 |
| **Owner** | (REGISTRANT) iGlobal Media Group, Ltd. CORPORATION BR.VIRGIN ISLANDS Lake Building, 1st Floor Box 3152, Wickhams Cay 1 Road Town BR.VIRGIN ISLANDS<br><br>(LAST LISTED OWNER) ELECTRAWORKS LIMITED CORPORATION GIBRALTAR 711 EUROPORT GIBRALTAR GIBRALTAR |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | Nathaly J Vermette |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead** | LIVE |

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## Typed Drawing

| | |
|---|---|
| **Word Mark** | OPINIONIST |
| **Goods and Services** | IC 038. US 100 101 104. G & S: Online subscription services for others whereby subscribers can access and utilize chat rooms and discussion boards in the fields of opinion polls and opinions on various subjects; and providing on-line chat rooms and discussion boards for transmission of messages among computer users concerning opinion polls and opinions on various subjects. FIRST USE: 20030704. FIRST USE IN COMMERCE: 20030704 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 76544125 |
| **Filing Date** | September 11, 2003 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 6, 2004 |
| **Registration Number** | 2888654 |
| **Registration Date** | September 28, 2004 |
| **Owner** | (REGISTRANT) Opinion Exchange, LLC, The LIMITED LIABILITY CORPORATION DELAWARE 3540 N. Southport, No. 250 Chicago ILLINOIS 60657 |
| **Attorney of Record** | Richard L. Morris, Jr. |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

## Typed Drawing

| | |
|---|---|
| **Word Mark** | SECONDOPINION.COM |
| **Goods and Services** | IC 042. US 100 101. G & S: providing consumer related information in the areas of medicine and health via a website that includes online links to other websites. FIRST USE: 20000425. FIRST USE IN COMMERCE: 20050425<br><br>IC 038. US 100 101 104. G & S: Providing online electronic bulletin boards for transmission of messages among computer users concerning the areas of medicine and health. FIRST USE: 20050425. FIRST USE IN COMMERCE: 20050425 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 75639630 |
| **Filing Date** | February 11, 1999 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1B |
| **Published for Opposition** | March 12, 2002 |
| **Registration Number** | 2976349 |
| **Registration Date** | July 26, 2005 |
| **Owner** | (REGISTRANT) FIRST OPINION CORPORATION CORPORATION CALIFORNIA 8258 PRESTWICK DRIVE LA JOLLA CALIFORNIA 92037 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | PETER H. KARLEN |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# Trademarks > Trademark Electronic Search System(Tess)

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Logout Please logout when you are done to release system resources allocated for you.

Start List At: [ ] OR Jump to record: [ ] **Record 7 out of 7**

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## Typed Drawing

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| **Word Mark** | OPINIONGRAM |
| **Goods and Services** | IC 038. US 104. G & S: telegraph transmission and communication services. FIRST USE: 19820000. FIRST USE IN COMMERCE: 19820000 |
| **Mark Drawing Code** | (1) TYPED DRAWING |
| **Design Search Code** | |
| **Serial Number** | 74398330 |
| **Filing Date** | June 3, 1993 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | January 9, 2001 |
| **Registration Number** | 2439709 |
| **Registration Date** | April 3, 2001 |
| **Owner** | (REGISTRANT) WESTERN UNION HOLDINGS, INC. CORPORATION GEORGIA 6200 SOUTH QUEBEC STREET ENGLEWOOD COLORADO 80111 |
| **Assignment Recorded** | ASSIGNMENT RECORDED |
| **Attorney of Record** | ELISABETH A LANGWORTHY |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | **LIVE** |

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# OPINIONATION

| | |
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| **Word Mark** | OPINIONATION |
| **Goods and Services** | IC 041. US 100 101 107. G & S: Entertainment services, namely, providing on-line computer games. FIRST USE: 20021108. FIRST USE IN COMMERCE: 20021108 |
| **Standard Characters Claimed** | |
| **Mark Drawing Code** | (4) STANDARD CHARACTER MARK |
| **Design Search Code** | |
| **Serial Number** | 78752259 |
| **Filing Date** | November 11, 2005 |
| **Current Filing Basis** | 1A |
| **Original Filing Basis** | 1A |
| **Published for Opposition** | July 18, 2006 |
| **Registration Number** | 3153984 |
| **Registration Date** | October 10, 2006 |
| **Owner** | (REGISTRANT) Game Show Network, LLC LTD LIAB CO DELAWARE 2150 Colorado Avenue Santa Monica CALIFORNIA 90404 |
| **Attorney of Record** | Francie R. Gorowitz |
| **Type of Mark** | SERVICE MARK |
| **Register** | PRINCIPAL |
| **Live/Dead Indicator** | LIVE |

# EXHIBIT F

LEXSEE 2005 TTAB LEXIS 548

In re Stahlbush Island Farms, Inc.

Serial No. 78224345

Trademark Trial and Appeal Board

2005 TTAB LEXIS 548

December 20, 2005, Mailed

[*1]

Before Hohein, Walters and Kuhlke, Administrative Trademark Judges.

**COUNSEL:**

Owen Von Flue of Clark, Lindauer, Fetherston, Edmonds, Lippold & Collier, LLC for Stahlbush Island Farms, Inc.

Karen Bracey, Trademark Examining Attorney, Law Office 116 (Meryl L. Hershkowitz, Managing Attorney).

**OPINIONBY:** HOHEIN

**OPINION:**

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Hohein, Administrative Trademark Judge:

Stahlbush Island Farms, Inc. has filed an application to register on the Principal Register the mark "FARMERS MARKET," in standard character form, for "canned and frozen fruit and vegetables sold through supermarkets and other retail grocery outlets" in International Class 29. n1

n1 Ser. No. 78224345, filed on March 11, 2003, which is based an allegation of a date of first use anywhere and in commerce of September 1, 2002.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "THE FARMERS MARKET," which is registered on the Supplemental Register in standard character form for "roasted nuts; processed garlic used as [*2] a vegetable, not seasoning; processed artichokes; candied nuts; processed pumpkin seeds; candied fruit; processed sunflower seeds; yogurt covered raisins; dried soybeans; salads, except macaroni, rice and pasta salad; and cole slaw" in International Class 29; "minced garlic; croutons; and bread sticks" in International Class 30; "fresh nuts; raw and fresh vegetables; fresh herbs; fresh mushrooms; and fresh fruits" in International Class 31; and "apple cider" in International Class 32, b2 as to be likely to cause confusion, or to cause mistake, or to deceive. n3 Registration has also been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that, when used in connection with applicant's goods, the term "FARMERS MARKET" is merely descriptive thereof.

n2 Reg. No. 2,610,955, issued on August 20, 2002, which sets forth a date of first use anywhere and in commerce of: December 31, 1995 for the goods in International Classes 29 and 31; September 1998 for the goods in International Class 30; and September 1999 for the goods in International Class 32.

n3 Although registration was also finally refused in light of the following two registrations, the Examining Attorney withdrew such registrations as grounds for refusal in her brief: (i) Reg. No. 2,049,764, issued on the Principal Register on April 1, 1997 to the owner of the above-cited Reg. No. 2,610,955, for the mark "THE

FARMERS MARKET" and design (with a disclaimer of the words "THE FARMERS MARKET"), as illustrated below,

[SEE ILLUSTRATION IN ORIGINAL]

for "produce, namely fresh fruits and vegetables, distributed through supermarkets" in International Class 31 and which sets forth a date of first use anywhere of March 5, 1995 and a date of first use in commerce of December 31, 1995; combined affidavit §§ 8 and 15; and (ii) Reg. No. 2,203,928, issued on the Principal Register on November 17, 1998 to a third-party for the mark "FARMERS MARKET" and design (with a disclaimer of the words "FARMERS MARKET"), as reproduced below,

[SEE ILLUSTRATION IN ORIGINAL]

for "vegetable salad, garden salad, vegetable salads containing sliced meat, fish or poultry and other salads not containing macaroni, rice or pasta" in International Class 29 and "bagels, bagel sandwiches, breakfast sandwiches, delicatessen sandwiches, hamburger sandwiches, [and] hot dog sandwiches" in International Class 30 and which sets forth a date of first use anywhere and in commerce for the goods in each class of April 7, 1997; combined affidavit §§ 8 and 15.

[*3]

Applicant has appealed. Briefs have been filed, n4 but an oral hearing was not requested. We affirm the refusal to register under Section 2(d) but reverse the refusal under Section 2(e) (1).

n4 It is noted that applicant's brief is not double-spaced as required by Trademark Rules 2.142(b)(2) and 2.126(a)(1). Nonetheless, inasmuch as the Examining Attorney has not objected thereto and it is clear that applicant's brief would not exceed the 25-page limitation imposed by Trademark Rule 2.142(b)(2) if it were properly double-spaced, such brief has been considered.

The Examining Attorney, however, has objected in her brief to consideration of "applicant's evidence [which was] not properly made of record, or in a form acceptable to be included in the record," asserting that:

> Specifically, the examining attorney objects to the third[-] party registrations noted in the applicant's response to the first Office action. The registrations are merely listed by registration number with no information as to the marks contained in those registrations and they were not accompanied by copies from any Office database. The applicant lists these registrations again in its brief and also references information obtained from an online Google(r) search. The applicant had neither mentioned nor submitted any evidence from an online search until its submission of its brief. The examining attorney submits that this evidence is not properly of record and objects to its inclusion.

Applicant, we note, has not responded thereto by filing a reply brief.

Ordinarily, a mere list of third-party registrations would be insufficient to make such registrations properly of record. The Board does not take judicial notice of third-party registrations, see, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974), and thus the proper procedure for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the U.S. Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 n. 3 (TTAB 1995); In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); and In re Melville Corp., 18 USPQ2d 1386, 1388 n. 2 (TTAB 1991). Nonetheless, because the Examining Attorney, in reply to applicant's response to the initial Office action, failed to so advise applicant of the deficiency therein and thus waived any subsequent objection thereto on such basis, the information provided by applicant as to the third-party registrations listed in its initial response and reiterated in its appeal brief is considered to be of record for whatever limited probative value (due to the absence of an indication of the specific third-party marks which are the subjects of the registrations) it may have. See TBMP § 1208.02 (2d ed. rev. 2004). However, the objection to the information referenced in applicant's brief, which it asserts it obtained from an online search, is sustained since such information is plainly un-

timely under Trademark Rule 2.142(d). Accordingly, such information does not form part of the record herein. Nonetheless, it is pointed out that even if consideration were to be given thereto, it would make no difference in the disposition of this appeal.

[*4]

Turning first to the refusal under Section 2(e)(1) inasmuch as whether applicant's mark is merely descriptive or is instead suggestive has an obvious bearing on the strength of such mark for purposes of the refusal under Section 2(d), it is well settled that a 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, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which [*5] registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently [*6] being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992); and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Applicant, in its brief, concedes that, "without more," the term "FARMERS MARKET" in the cited mark and the other two marks which had been cited against its mark "is descriptive." Applicant also admits in its brief that the fact that the cited mark is registered on the Supplemental Register, as well as the fact that the other two marks which formerly had been cited are each registered on the Principal Register with a disclaimer of the term "FARMERS MARKET," constitute evidence, as relied upon by the Examining Attorney, of the mere descriptiveness of such term. Applicant argues, however, that because its goods are identified as "canned and frozen fruit and vegetables sold through supermarkets and other [*7] retail grocery outlets," such an identification "is sufficient to avoid [mere] descriptiveness." In particular, applicant contends that:

> The mark [FARMERS MARKET] is merely descriptive if it was used in connection with goods actually purchased and sold at a fruit and vegetable stand or other open-air type market. Canned and frozen fruits and vegetables such at the Applicant's are not sold in a "farmer's market" as that noun is commonly understood.
>
> The examining attorney found Applicant's mark [merely] descriptive because it describes the taste and appearance of the items as items that may be purchased in an open-air market. With all due respect to the examining attorney, it seems clear from this statement that she has not recently visited an open-air farmers market. Farmers markets do not have for sale canned and frozen fruit and vegetable[s]. Moreover, canned and frozen vegetables taste markedly different from fresh. . . . In the context of shopping in a supermarket, the use of FARMERS MARKET on applicant's canned and frozen fruits and vegetables becomes suggestive rather than descriptive.

The Examining Attorney, on the other hand, maintains that "the proposed mark, when considered [*8] in conjunction with the identified goods, does nothing more than [merely] describe a feature or characteristic of the goods, namely, that the applicant's goods are, in some manner, like those goods found at farmer's markets." Specifically, the Examining Attorney insists that "applicant's assertion that the mark is not [merely] descriptive because the goods are not sold in an open-air market or fruit stand is not the appropriate test" and that:

> Here, there are several facets associated with the goods beyond where they were purchased. The goods may have the look, taste and smell of fresh fruits and vegetables. Additionally, goods at a farmer's market may indeed be in a can or a glass container such as a jar. Items such as applesauce, fruit preserves, pickles, vegetables and the like are frequently seen at farmer's markets and in grocery stores. Given this, the proposed mark is [merely] descriptive of a characteristic or feature of goods that are of a type that stem from a farmer's market.

While, in support of her contention that "applicant's proposed mark FARMERS MARKET' is [merely] descriptive of a characteristic, quality or feature of the [applicant's] goods," the Examining [*9] Attorney relies in her brief upon the above-noted facts that both the cited registration, as well as the two formerly cited registrations, respectively are registered on the Supplemental Register and on the Principal Register with the term "FARMERS MARKET" disclaimed, the record also contains the following definitions of such term which the Examining Attorney made of record, from a search of "Dictionary.com (2000)," with the her initial Office Action: (i) "A public market at which farmers and often other vendors sell produce directly to consumers. Also called greenmarket" (definition from *"The American Heritage Dictionary of the English Language, Fourth Edition Copyright (r) 2000 by Houghton Mifflin Company");* and (ii) "an open-air marketplace for farm products [syn: greenmarket]" (definition from *"WordNet(r) 1.6, (r) 1997 Princeton University").* In light of such evidence, the Examining Attorney urges that, "when the [applicant's] mark and the identified goods are considered together, no thought or imagination is needed to understand that the goods are somehow like those purchased at a farmers market." She concludes, therefore, that the term "FARMERS MARKET" is merely descriptive [*10] of applicant's goods.

Upon consideration of the evidence and arguments presented, we agree with applicant that, when considered in relation to its particular goods, the term "FARMERS MARKET" is suggestive rather than merely descriptive of applicant's "canned and frozen fruit and vegetables sold through supermarkets and other retail grocery outlets." Specifically, we concur with applicant that such term does not describe, with the requisite particularity, any characteristic, feature or quality of canned and frozen fruits and vegetables of the kinds typically sold through supermarkets and similar retail grocery outlets. The Examining Attorney, we note, has been unable to precisely identify what significant aspect of applicant's goods the term "FARMERS MARKET" immediately describes, speculating instead only as to such generalities as that "applicant's goods are, *in some manner*, like those goods found at farmer's markets"; that applicant's "goods *may* have the look, taste and smell of fresh fruits and vegetables"; and that "the goods are *somehow* like those purchased at a farmers market" (emphasis added).

At most, while the term "FARMERS MARKET," when used in connection with [*11] applicant's goods, serves to evoke or suggest that the canned and frozen fruits and vegetables which it sells through supermarkets and other retail grocery outlets have such characteristics, features or qualities as the taste, texture, appearance and/or smell of the freshly harvested fruits and vegetables which are typically available at farmers markets, it requires imagination, cogitation or a multi-stage reasoning process in order to reach such a determination. Moreover, notwithstanding that the registrations relied upon by the Examining Attorney as evidence of mere descriptiveness are for goods which are specifically different from those marketed by applicant, to the extent that such registrations may nevertheless serve to raise any doubt as to our conclusion that the term "FARMERS MARKET" does not immediately convey significant information about a characteristic, feature or other attribute of applicant's goods, we resolve such doubt, in accordance with the Board's settled practice, in favor of the publication, if otherwise eligible therefor, of applicant's mark for opposition. See, e.g., In re Rank Organization, Ltd., 222 USPQ 324, 326 (TTAB 1984); In re Conductive Systems, Inc., 220 USPQ 84, 86 (TTAB 1983); [*12] In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565, 565 (TTAB 1972).

Turning now to consideration of the issue of likelihood of confusion, our determination thereof under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on such issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties. n5 Here, inasmuch as applicant's "FARMERS MARKET" mark and the cited registrant's "THE FARMERS MARKET" mark, when considered in their entireties, are virtually identical in sound, appearance, meaning and commercial impression, n6 the focus of our inquiry is accordingly on the strength or weakness [*13] of such marks and the similarity or dissimilarity of the respective goods.

n5 The court, in particular, pointed out that: "The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

n6 Applicant, we observe, does not contend otherwise in its brief nor has it filed a reply brief taking issue with the Examining Attorney's assertion in her brief, with which we concur, that "the inclusion, or not, of the article THE' is inconsequential to the 2(d) analysis."

Applicant urges in its brief that "consumers can easily distinguish slight differences in goods and services offered in connection with weak marks." The cited registrant's mark, applicant insists, is weak, and thus is entitled to only a narrow scope of protection, "for two reasons: (1) the usage of the mark FARMERS MARKET is relatively ubiquitous; and (2) without more, the mark is descriptive." In this regard, applicant refers to a list of various third-party registrations n7 which it maintains constitute evidence which shows that (case citation omitted): [*14]

> Consumers are thus exposed to the mark FARMERS MARKET in connection with a wide variety of related products within the same shopping experience. As a consequence of such wide usage, consumer confusion is unlikely because consumers can easily distinguish slight differences in goods and services offered under the same mark even if the goods are related. . . .

n7 Specifically, although we note that the list recited sets forth one registration twice and fails to list another (Reg. No. 2648695) which applicant included in its response to the initial Office action, applicant asserts that:

> In addition to the registrations [initially] cited by the Examining Attorney, there are at least a dozen . . . registrations in effect for a wide scope of consumer goods and services: farmers market and flee market services, Reg. No. 2642918; retail grocery store services, Reg. No. 2798632 and Reg. No. 2548845; raw and fresh vegetables, fresh and roasted nuts, salads, bread, fresh fruit and vegetables, retail grocery store services, Reg. No. 1854765; cosmetics, Reg. No. 2146503; soup, Reg. No. 2247790 and Reg. No. 2247791; seafood, poultry, meats, meats and cheese, salads, bread, fresh fruit and vegetables, retail grocery services, Reg. No. 1854765; fresh fruit and produce, Reg. No. 1954180; stoneware, Reg. No. 1912565; fruit juice beverage, Reg. No. 1881575; [and] hone [sic], ketchup, spaghetti sauce, barbeque sauce, fruit butter, preserves and salad dressing, Reg. No. 1141346.

[*15]
Applicant, in view thereof, further contends that the "limitation on the scope of goods in the . . . application is sufficient to enable consumers to distinguish Applicant's . . . goods," and thus preclude a likelihood of confusion, because its frozen and canned fruits and vegetables, unlike the goods set forth in the cited registration, "are found in decidedly different areas of modern supermarket and retail grocery stores."

The Examining Attorney, however, contends in her brief that even if the cited mark, as evidenced by its registration on the Supplemental Register, is merely descriptive and hence is weak, such mark is "still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods," citing King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) and Hollister Inc. v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976) and cases cited therein. While correctly noting, in particular, that "even marks that are registered on the Supplemental Register may be cited under § 2(d)," citing In re Clorox Co., 578 F.2d 305, 198 USPQ 337 (CCPA 1978), [*16] it is still the case that such a mark is generally entitled to only a narrow scope of protection and thus will preclude registration of another mark only when the respective marks are identical or substantially so. Here, the Examining Attorney observes, the marks at issue are virtually identical. Consequently, she maintains that, if such marks are used in connection with related goods, confusion as to the source or sponsorship of such products would be likely to occur.

As the Examining Attorney goes on to properly point out, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration,

and not in light of what such goods may actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); [*17] Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Moreover, as she also correctly observes, it is well established that the goods at issue need not be identical or even directly competitive in nature in order to support a finding of likelihood of confusion. It is sufficient, instead, that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Here, the Examining Attorney insists, the fact that the goods at issue may be "shelved [*18] or otherwise displayed in different areas of [supermarkets and grocery] store[s]" does not mean that such goods are unrelated. Instead, she maintains that the evidence which she has made of record, which as stated in her final refusal consists of both Internet excerpts showing that "many well known companies produce a variety of food items that may include both fresh produce, prepared foods and frozen or canned items" and copies of third-party registrations for marks registered for "fresh produce and canned, frozen and prepared fruits and vegetables," demonstrates that applicant's goods and those of the cited registrant are indeed related. Specifically, she notes that:

> In support of this, the examining attorney submitted evidence in the Final refusal that shows, for example, fruit in varying forms that stem from the same source. Fresh pineapples are not found next to canned pineapples or next to packaged fruit cups or bags of raisins or cans of pineapple juice, but they all come from the same source, namely, Dole (r). The registrant's goods include "processed food items. These processed foods could certainly be in canned or frozen form and as such, constitute the legal equivalents [*19] of the applicant's goods. . . . The applicant's identification does not exclude "processed" fruits and vegetables, which, as noted, may be in canned or frozen form. As a result, the goods of the applicant are legally equivalent to the goods of the registrant. Further, the . . . third[-] party registrations . . . are probative in that they demonstrate the goods offered by the applicant and registrants [sic] do indeed emanate from the same source.

In addition to the specific example mentioned above in her brief, it is pointed out that the Internet excerpts submitted in support of the Examining Attorney's position variously show that "Dole Food Company, Inc." uses the mark "DOLE" not only on canned pineapple but also in connection with fresh fruit, such as bananas, and packaged salads of field greens; that "Sunkist Growers, Inc." uses the mark "Sunkist" in connection with not only fresh citrus fruit but also orange soda, fruit candy, fruit and grain bars, individually wrapped fruit snacks, and packaged pistachios and almonds; and that "Welch's" uses the mark "Welch's" not only for grape juices, jams and jellies but also for fresh table grapes and fruit juice cocktails. Moreover, of [*20] the three use-based, third-party registrations n8 which are of record, one covers such goods as "canned fruits, frozen fruits, . . . fruit salads, garden salads, [and] vegetable salads," on the one hand, and "fresh fruits, namely apples, blueberries, olives, oranges, peaches, tomatoes; [and] fresh vegetables," on the other; another registration by a different third party lists both "canned fruit, dried fruit, frozen vegetables, . . . and fruit-based snack foods" as well as "raw fruits, fresh fruits, raw vegetables, and fresh vegetables"; while a third registration by another third-party sets forth "frozen fruits; namely, frozen avocados, guacamole and dates; and prepared and dried fruits" in addition to listing "fresh fruits; namely, avocados, pineapple, mangos, papaya, and kiwi-fruit."

> n8 We note in this regard that it is settled that while use-based third-party registrations are not proof that the different marks shown therein are in use or that the public is familiar with them, it nevertheless is the case that such registrations have some probative value to the extent that they serve to suggest that the various goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988).

[*21]

Based upon consideration of the evidence and arguments presented, we concur with the Examining Attorney that confusion as to the origin or affiliation of applicant's and the cited registrant's goods is likely to result from contempora-

neous use in connection therewith of, respectively, the virtually identical marks "FARMERS MARKET" and "THE FARMERS MARKET." Contrary to applicant's assertion, the list of third-party registrations upon which it relies in an attempt to demonstrate the asserted weakness of marks which consist of or include the term "FARMERS MARKET" fail to establish such. Aside from the fact that applicant's list is of essentially no probative value inasmuch as it does not set forth the specific marks which are the subjects of the third-party registrations or state the owners thereof or divulge whether the term "FARMERS MARKET" has been disclaimed or indicate whether the registrations issued on the Principal Register (with or without a claim of acquired distinctiveness) or on the Supplemental Register, it is well settled that the third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace or that the consuming public [*22] is familiar with the use of those marks and has learned to distinguish between them. See, e.g., Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Applicant, consequently, has not offered any evidence of third-party use to support its argument that the cited mark is so weak that consumers will easily distinguish the source of the cited registrant's goods from that of applicant's goods. Although it is also the case that third-party registrations may in general be given some weight to show the meaning of a mark in the same way that dictionary definitions would be so used, see, e.g., Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976), the deficiencies in the factual information provided by applicant with respect thereto, as noted above, preclude such use in this instance.

Nonetheless, while the fact that the cited mark is registered on the Supplemental Register is evidence that such mark is merely [*23] descriptive of the registrant's goods and thus is weak, the Examining Attorney is correct that even a weak mark is entitled to protection against registration by a subsequent user of the same or substantially identical mark for the same or closely related goods. Here, the rather limited evidence made of record by the Examining Attorney is nevertheless sufficient to persuade us that applicant's "canned and frozen fruit and vegetables sold through supermarkets and other retail grocery outlets" would be considered by ordinary consumers to be so closely related to the cited registrant's fresh and processed fruits and vegetables, namely, its "roasted nuts; processed garlic used as a vegetable, not seasoning; processed artichokes; candied nuts; processed pumpkin seeds; candied fruit; processed sunflower seeds; yogurt covered raisins; dried soybeans; salads, except macaroni, rice and pasta salad; . . . cole slaw"; its "minced garlic;" its "fresh nuts; raw and fresh vegetables; fresh herbs; fresh mushrooms; and fresh fruits"; as well as its "apple cider," that confusion as to source or sponsorship of the respective products would be likely to occur. In particular, it would even appear that, [*24] as identified, applicant's canned and frozen vegetables would at least encompass the cited registrant's "processed garlic used as a vegetable, not seasoning" and its "processed artichokes." Moreover, notwithstanding that applicant's canned and frozen fruits and vegetables would be sold in different sections of supermarkets and other retail grocery stores, consumers could readily regard such products as processed versions of the raw and fresh vegetables, fresh mushrooms and fresh fruits marketed by the cited registrant in the fresh produce section of the same retailers, especially when such goods are sold under such virtually identical marks as "FARMERS MARKET" and "THE FARMERS MARKET."

Accordingly, we conclude that consumers who are familiar or otherwise acquainted with the cited registrant's "THE FARMERS MARKET" mark for, *inter alia*, "processed garlic used as a vegetable, not seasoning; processed artichokes;" "raw and fresh vegetables; . . . fresh mushrooms; and fresh fruits" would be likely to believe, upon encountering applicant's virtually identical "FARMERS MARKET" mark for "canned and frozen fruit and vegetables sold through supermarkets and other retail grocery outlets," [*25] that such closely related food products emanate from, or are otherwise sponsored by or affiliated with, the same source.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawProtection of RightsRegistrationSupplemental Register

**Decision:** The refusal under Section 2(e)(1) is reversed, but the refusal under Section 2(d) is affirmed.

Illustration 1, no caption; Illustration 2, no caption

# EXHIBIT G

LEXSEE 2003 TTAB LEXIS 114

In re Epigenomics GmbH

Serial No. 76/000,873

Trademark Trial and Appeal Board

2003 TTAB LEXIS 114

March 6, 2003, Decided

[*1]

Before Quinn, Hairston and Chapman, Administrative Trademark Judges.

**COUNSEL:**

Edward M. Kriegsman of Kriegsman & Kriegsman for Epigenomics GmbH.

Glenn G. Clark, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

**OPINIONBY:** CHAPMAN

**OPINION:**

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Epigenomics GmbH (a German corporation) to register on the Principal Register the mark DIGITAL PHENOTYPE for the following goods and services:

> "diagnostic reagents for scientific purposes including forensic examination; diagnostic test kits for scientific purposes, consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit" in International Class 1;
>
> "diagnostic reagents for medical purposes for diagnosing inflammations, infections, diseases of the central nervous system, heart, circulation, neurologic, endocrine, autoimmune and genetic diseases and cancers, consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit; medical diagnostic test kits [*2] consisting of reagents, working solutions, plasters, namely, adhesive tape, slides and solid matrix material, all sold together as a unit, for determining the presence of pathogens in the environment" in International Class 5;
>
> "laboratory equipment, namely, an apparatus for testing a sample, for demonstrating the presence of analytical elements in samples and to determine types of samples in connection with distribution patterns and an apparatus for the production of a series of molecular biological data and parts thereof" in International Class 9;
>
> "providing multiple-user access to the Internet" in International Class 38; and
>
> "research and development services for third parties in the field of diagnostic chemicals, forensic methods, compositions and devices, measuring apparatuses for use in product research and development, in methods for preparation and purification in water treatment plants; methods for testing the environment and determining industrial quality; chemical separation analysis and diagnosis, forensic and medical genetics testing for third parties; computer programming for others in the field of data processing; computer

services, namely, providing a searchable [*3] database in the field of DNA-related data on a global computer network" in International Class 42. n1

n1 Application Serial No. 76/000,873, filed March 15, 2000. The application is based on Section 44 of the Trademark Act, 15 U.S.C. § 1126, German Registration No. 399 58 557 (filed September 16, 1999, issued November 19, 1999 and expiring September 30, 2009).

The Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that the mark DIGITAL PHENOTYPE, when used on and in connection with the goods and services of applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The Examining Attorney states in his brief that "applicant's proposed mark, DIGITAL PHENOTYPE, merely describes the functions, features, uses, characteristics and purposes of the relevant goods and services," and that "the most persuasive evidence of record in support of the refusal under Section 2(e)(1) is the applicant's own web site" (unnumbered pp. [*4] 4-5), which includes the following statement: "Epigenomics' proprietary technology makes the detection of hundreds of thousands of DNA methylation signals a reality. **These signals can be digitized into a long string of ones and zeros**, creating a Digital Phenotype(R) that reflects genetic activity in a particular cell or tissue, i.e., whether it is functioning normally or whether it is sick." (Emphasis added by Examining Attorney). n2 The Examining Attorney also points to the following definitions from The American Heritage Dictionary (Third Edition 1992):

(1) "digital...4. Expressed in digits, especially for use by a computer. 5. Using or giving a reading in digits: a digital clock"; n3

(2) "digital computer A computer that performs calculations and logical operations with quantities represented as digits, usually in the binary number system"; and

(3) "phenotype 1.a. The observable physical or biological characteristics of an organism, as determined by both genetic makeup and environmental influences. b. The expression of a specific trait, such as stature or blood type, based on genetic and environmental influences."

n2 The Examining Attorney submitted two pages from applicant's website and he quoted the material in his October 24, 2001 Final Office action. The wording on the printouts of both website pages is cut off on the right side and thus, the Board cannot read the full statement from applicant's web pages, but rather only from the Examining Attorney's quote thereof.

[*5]

n3 The Examining Attorney requested in his brief on appeal that the Board take judicial notice of three more dictionary definitions of "digital." The request is granted. See TBMP § 712.01.

Further, the Examining Attorney argues that "a 'digital' recording or observation will more accurately record and communicate data and research [than] an 'analog' recording" (brief, unnumbered p. 7); that applicant's goods and services are "digital"; that applicant's laboratory equipment in International Class 9 "is presumed to use or include digital computers"; that "applicant's goods in International Classes 1 and 5 appear to be highly specialized goods that will be used with the applicant's computerized services in International Class[es] 38 and 42 and the computerized laboratory equipment in International Class 9" (brief, unnumbered p. 8); that "the word 'phenotype' describes the functions, features, uses and subject matter of the applicant's services"; and that specifically, "applicant's goods and services are used to digitize the visible properties of an organism that are produced by the interaction of the genotype and the environment." (Brief, unnumbered p. 8.) n4

n4 In his brief, the Examining Attorney referred to some of the excerpted stories retrieved from the Nexis database as well as the printouts of pages from third-party Internet sites which he had previously made of record. The stories retrieved from the Nexis database were either uses of the two words "digital" and "phenotype" in completely separate contexts or were uses which referred to applicant corporation and used DIGITAL PHENOTYPE in a trademark manner. Several of these stories were repeats of the same story. Of the few third-party websites, all but one also referred to applicant corporation and generally the term DIGITAL PHENOTYPE was used in a trademark manner.

[*6]

Finally, the Examining Attorney argues that the two words when combined do not form a unique or incongruous mark with a separate, non-descriptive meaning.

Applicant argues that the Examining Attorney has improperly dissected the mark into its component words and failed to consider the mark as a whole; that the Examining Attorney must establish that the mark, considered in its entirety, immediately describes an ingredient, quality, characteristic, or feature of the identified goods and services, and he has failed to meet his burden of proof; that applicant's goods and services are not "digitized readouts" but are various diagnostic reagents, diagnostic test kits, laboratory equipment, research and development services and Internet access services; that the term is incongruous because the dictionary definitions show the word "digital" refers to expressing in digits, especially for a computer, while the word "phenotype" refers to observable physical characteristics which are not generally reducible to digital expression; and that the mark DIGITAL PHENOTYPE is used exclusively by applicant with no evidence of use by others.

A mark is merely descriptive if it "forthwith conveys an [*7] immediate idea of the ingredients, qualities or characteristics of the goods [or services]." Abercrombie & Fitch Company v. Hunting World, Incorporated, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also, In re Abcor Development Corporation, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Entenmanns Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991.

Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995). [*8]

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In this case, we agree with the Examining Attorney that applicant's goods and services are highly specialized. n5

n5 A requirement by the Examining Attorney under Trademark Rule 2.61(b) that applicant provide information about its "highly specialized" and rather complex goods and services could have been helpful in this case.

The evidence of record (dictionary definitions, printouts of two pages from applicant's website, some excerpted stories retrieved from the Nexis database, printouts from a few third-party websites, and the arguments of the Examining Attorney and applicant) does not establish that the mark DIGITAL PHENOTYPE as a [*9] whole is merely descriptive of the identified goods and/or services. See Bose Corp. v. International Jensen Inc., 963 F.2d 1517, 22 USPQ2d 1704 (Fed. Cir. 1992); In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1988); and Manpower, Inc. v. The Driving Force, Inc., 212 USPQ 961 (TTAB 1981), aff'd 538 F.Supp. 57, 218 USPQ 613 (EDPA 1982). That is, based on the record now before us, it has not been established that applicant's mark, when used on or in connection with its goods and services recited above, conveys an immediate idea about the goods and/or services with any degree of particularity. It is not clear how the relevant purchasers would regard the term DIGITAL PHENOTYPE; and there is no evidence that the relevant consumers would readily understand a connection between DIGITAL PHENOTYPE and the various diagnostic kits, laboratory equipment, and research and development and Internet access services. The significance of the mark and specifically what it describes about the goods and/or services, when applied to or used in connection with the goods

[*10] and/or services, is ambiguous and unclear. The Examining Attorney has left too much for speculation and assumption. n6

n6 The Board must assume that the dictionary, Nexis and Internet evidence submitted by the Examining Attorney is the best case possible for the Examining Attorney's position that the mark is merely descriptive of the identified goods and services. See In re Homes & Land Publishing Corp., 24 USPQ2d 1717, 1718 (TTAB 1992).

The Board has noted many times that if there is doubt about the "merely descriptive" character of a mark, that doubt is resolved in applicant's favor, allowing publication of the mark so that any third party may file an opposition to develop a more comprehensive record. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992).

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawForeign & International ProtectionsApplicationsTrademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGeneral Overview

Decision: The refusal to register under Section 2(e)(1) is reversed.

# EXHIBIT H

LEXSEE 1997 TTAB LEXIS 185

In re Air Control Science, Inc.

Serial No. 74/590,809

Trademark Trial and Appeal Board

1997 TTAB LEXIS 185

June 18, 1997, Decided

[*1]

Before Simms, Hanak and Hairston, Administrative Trademark Judges

**COUNSEL:**

E. Michael Byorick of Duft, Graziano & Forest, P.C. for Air Control Science, Inc.

Susan K. Leslie, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

**OPINIONBY:** HAIRSTON

**OPINION:**

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Air Control Science, Inc. to register the mark DUST ANALYST for "analysis, design and engineering of dust collection systems for others." n1

n1 Application Serial No. 74/590,809 filed October 26, 1994; alleging dates of first use of October 25, 1994.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that, when used in connection with applicant's services, the mark is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney maintains that when the words "dust" and "analyst" are combined, the resulting term DUST ANALYST conveys information regarding the nature of applicant's services, namely, that applicant's services [*2] involve "the analysis of dust itself, or the analysis of the method of removing dust." Final office action, p. 2. In support of her position, the Examining Attorney has submitted dictionary definitions of the terms "dust" and "analyst." In Webster's Ninth New Collegiate Dictionary (1990) "dust" is defined, inter alia, as "fine dry particles of earth or pulverized matter," and "to make free of dust"; and "analyst" is defined as "a person who analyzes or who is skilled in analysis."

Applicant, however, contends that the plain meaning of the term "dust analyst" is one who analyzes dust, that applicant's services do not involve the analysis of dust, and that DUST ANALYST only suggests something about what applicant does, but does not convey information about the specific nature of applicant's services.

A mark is considered to merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of the ingredients, qualities, characteristics or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215, 217-218 (CCPA 1978). [*3] Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199,

1204-1205 (TTAB 1981); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952d (TTAB 1981); In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986).

There is no dispute, given the dictionary definitions of record, about the readily understood meanings of the individual words comprising the mark sought to be registered. We do not believe, however, that the combination of these words results in a term which is merely descriptive of the identified services, namely, the analysis, design and engineering of dust collection systems for others.

First, we find no support in this record for the Examining Attorney's position that DUST ANALYST is merely descriptive of applicant's services because it conveys to prospective purchasers that applicant's services [*4] involve the "analysis of dust itself." Applicant has identified its services as "analysis, design and engineering of dust collection systems for others." There is nothing in this record which indicates that such services involve the analysis of dust, and in fact, applicant's attorney maintains that applicant's services do not include analysis of dust. We note in this regard that applicant's specimen of record--page 2 of a Proposal For Dust Collection Engineering Evaluation--provides little information about applicant's services. In particular, there is no indication from this one page that applicant's services involve the analysis of dust. We note that the Examining Attorney did not request that applicant submit the remaining pages of the specimen or, for that matter, any other informational literature concerning applicant's services and the activities applicant performs under this mark. See Trademark Rule 2.61 and TMEP Section 1105.02. Accordingly, in determining mere descriptiveness, we have relied upon uncontradicted representations made by applicant's attorney.

Second, the mark sought to be registered here is DUST ANALYST, not DUST COLLECTION SYSTEM ANALYST. We see a [*5] problem with reading the words "collection system" into this mark. Thus, this case is distinguishable from Abcor, supra, where the term GASBADGE was held merely descriptive of gas monitoring badges. Furthermore, we agree with applicant that the plain meaning of the term "dust analyst" is one who analyzes dust, not one who analyzes ways to remove dust. Prospective customers would have to pause and reflect on the significance of DUST ANALYST in order to understand that, as applied to applicant's services, the services include the analysis of dust collection systems or ways to remove dust. In short, applicant's mark DUST ANALYST does not convey an immediate idea about applicant's services with any degree of particularity.

Based on the sparse record before us, we conclude that the mark DUST ANALYST, when used in connection with the analysis, design and engineering of dust collection systems for others, is not merely descriptive. To the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor so as to permit publication of the mark.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawProtection of RightsPriorityGeneral OverviewTrademark LawProtection of RightsRegistrationPrincipal Register

**Decision:** The refusal to register under Section 2(e)(1) is reversed.

# EXHIBIT I

LEXSEE 2006 TTAB LEXIS 160

In re L.Vad Technology, Inc.

Serial No. 78285714

Trademark Trial and Appeal Board

2006 TTAB LEXIS 160

April 28, 2006, Decided

[*1]

Before Bucher, Grendel and Drost, Administrative Trademark Judges.

**COUNSEL:**

Molly B. Markley of Young & Basile, P.C. for L.Vad Technology, Inc.

Georgia Ann Carty Ellis, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

**OPINIONBY:** GRENDEL

**OPINION:**

**THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark PATCH BOOSTER (in standard character form) for International Class 10 goods identified in the application as:

> permanent and temporary heart assist devices utilizing intra arterial air pressure to assist the circulating assist machinery and controls therefor; percutaneous access devices consisting of a disk implantable beneath the skin for use in transmitting fluid, air, or electricity through the collar and attachments therefor; implanted blood pumps and attachments therefor; and external drive units serving as pump actuators and controllers and attachments therefor.

The application is based on applicant's asserted bona fide intent to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

At issue [*2] in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground that it is merely descriptive of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). The appeal is fully briefed. No oral hearing was requested. We reverse the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2 (e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., 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 immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); [*3] *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a 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 term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "the 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.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); [*4] and *In re American Greetings Corporation,* 226 USPQ 365 (TTAB 1985).

The Trademark Examining Attorney contends that PATCH is merely descriptive of applicant's goods, and relies on three different arguments to support that contention.

First, she cites to dictionary evidence in the record defining "patch," in its noun form, as "something that covers or mends: a piece of material used to cover, strengthen, or mend a hole in something," n1 and as "a piece of material used to mend a hole or strengthen a weak point." n2 She also cites to dictionary evidence defining "patch," in its verb form, as "repair something with material: to cover or mend a hole in something or to strengthen a weak place using cloth or a pasty substance," n3 and as "mend, strengthen or protect by means of a patch." n4 She argues that "patch," so defined, merely describes applicant's goods because the goods "are used for the purpose of mending and strengthening the ability of the heart to function." (Trademark Examining Attorney's brief at 4.) She also notes that applicant, at page 5 of its brief, states that "applicant's heart pump and heart assist devices in a sense act as a patch in [*5] that they help to keep the patient's heart working," and she argues that this statement essentially is a concession that applicant's goods function as a patch and that "patch" therefore is merely descriptive of the goods.

n1 MSN Encarta Dictionary.

n2 Compact Oxford English Dictionary.

n3 MSN Encarta Dictionary.

n4 Compact Oxford English Dictionary.

We disagree. Applicant's statement that its goods "in a sense" act as a patch is not a concession that "patch" is merely descriptive. Rather, we agree with applicant's contention that its goods can be deemed to be a patch only figuratively, not literally. This purely figurative significance of "patch" as applied to applicant's goods does not suffice as a basis for finding that "patch" is merely descriptive, i.e., that it immediately and directly conveys information about applicant's goods.

Second, the Trademark Examining Attorney cites to dictionary evidence of record which defines "patch" as a "cover for wound: a piece of material used to cover a wound," n5 as well as to excerpts of articles obtained from the NEXIS database which refer to a medical procedure involving a patch of tissue (from human [*6] and/or animal cells) used to patch a hole in the heart or to mend damaged heart tissue. Representative examples of these excerpts include the following:

n5 MSN Encarta Dictionary.

Jessica, who is only 3 years old, has very few bruises after a medical procedure that inserted a **patch** to cover a hole in her heart -- all without open-heart surgery. Doctors found the hole in her heart -- called an atrial septal defect -- when she was 2 years old.

The **patch,** which looks like a small, coiled white flower blossom, is made of a special type of Gore-Tex material used for medical purposes. Unlike its predecessor, which was made mostly of wire, the new **patch** is made of Gore-Tex and less wire, so it's more flexible and adaptable to the heart muscle tissues. . . .

Doctors such as Javois place a catheter -- a thin, flexible tube -- into the largest vein in the leg to carry the **patch** to the heart, where it is placed to cover the hole.
(Chicago Sun Times, May 30, 2003);

. . . Melanie rallied enough that the cardiologists decided the time had come for immediate surgery to **patch** her heart. By closing the hole, it would decrease the amount of blood flowing to her lungs, [*7] which was already three times as much as it should have been. . . .
(The Times (Albany, NY), November 18, 1994);

The recipe for growing a **patch** of heart tissue in the bioreactor begins with 54 million or so individual mammalian heart cells. . . .

It takes about one week for the bioreactor to produce a **patch** of tissue 5 mm in diameter and a mere 0.10 mm thick. The heart tissue **patch** acts just like real heart tissue and beats spontaneously.
(Aerospace America, July 2002); and

HEADLINE: Local Bioengineers Want to Build **Patch** for Heart

BODY: Local scientists are working on a tissue engineering project that could one day allow doctors to repair a damaged heart with a bioengineered blood vessel or a **patch** of cardiac muscle. . . .

To make the engineered blood vessels and heart **patches,** the researchers have created a biodegradable polymer "scaffold" that is flexible and porous. . . .

The challenge is that the cardiac **patch** should be able to contract with the healthy heart muscle and replacement blood vessels should be able to dilate and constrict like the real thing. . . .

The researchers have been working with a **patch** that's about a third of an inch [*8] wide and aim to be testing a quarter-sized **patch** in large animal studies by the end of the five-year grant period. It could ultimately be used to strengthen scarred, nonfunctioning areas of heart muscle that have been damaged by a heart attack.
(Pittsburgh Post-Gazette, August 5, 2003).

These articles do not support a finding that "patch" is merely descriptive of applicant's goods. There is no evidence in the record from which we might conclude that applicant's goods, as identified in the application, are, or involve, tissue patches of the type mentioned in these articles.

The Trademark Examining Attorney's third argument in support of her contention that "patch" is merely descriptive of applicant's goods is based on dictionary evidence in the record which defines "patch" as "drug-impregnated material: a piece of material impregnated with a drug and worn on the skin to allow the gradual absorption of the drug -- *a nicotine patch, n6* and as "an adhesive piece of drug-impregnated material worn on the skin so that the drug may be gradually absorbed." n7 She also cites to the following NEXIS evidence showing this usage of the term:

n6 MSN Encarta Dictionary.

n7 Compact Oxford English Dictionary.

[*9]

You've heard of the nicotine **patch** for smokers? The estrogen **patch** for menopausal women? The nitroglycerine patch for heart patients? Now there's an anti-wrinkle **patch.** (The Vancouver Sun (British Columbia), August 1, 1998);

. . . Alza makes what it calls drug-delivery **patches** -- small adhesive **patches** worn by the patient that work like an intravenous infusion, but without the needle. The patches consist of a thin system of layered membranes: an impermeable backing, a minute drug reservoir, a rate-controlling membrane and an adhesive surface that keeps the **patch** on the skin. . . .

And Alza's popular Transderm Nitro, a **patch** for heart patients, is being challenged by a similar product from Key Pharmaceuticals Inc., of Miami.
(PC Week, March 18, 1986).

Finally, she cites to the following dictionary definitions of "percutaneous": "passed, done, or effected through the skin," n8 and "performed through the skin, as injection of radiopaque material in radiological examination, or the removal of tissue for biopsy accomplished by a needle. *Cf. transdermal."* n9

n8 The American Heritage Dictionary of the English Language (4th ed. 2000).
[*10]

n9 Dorland's Illustrated Medical Dictionary.

Based on this evidence, the Trademark Examining Attorney argues that those goods identified in the application as "percutaneous access devices consisting of a disk implantable beneath the skin for use in transmitting fluid, air, or electricity through the collar and attachments therefor," although they might not be "the conventional type of patch' goods, such as the very commonly known nicotine or birth control type patches," nonetheless "function exactly the same as these other patches because the goods have the capacity to introduce substances [including medical fluids, i.e., medicine] into the body via a device under the skin." (Trademark Examining Attorney's brief at 4-5.)

We are not persuaded by this argument. Even assuming that applicant's goods identified as a "disk implantable beneath the skin" are used or can be used to transmit medicine into the body, just as a "patch" does, we cannot conclude that "patch" merely describes the goods. Significantly, applicant's disk is implanted beneath the skin; it is not adhered to the skin like the patches identified in the dictionary and NEXIS evidence of record. There is no evidence [*11] that medication delivery devices implanted beneath the skin are called "patches." It is not enough, even if true, that applicant's goods could be used to deliver medicines like a "patch" does. On this record, "patch" has a particular connotation, that of a drug delivery device that is adhered to the skin, not one which is implanted beneath the skin.

In short, we are not persuaded by any of the Trademark Examining Attorney's three arguments in support of her contention that "patch" is merely descriptive of applicant's goods. Applicant's goods do not comprise or involve a "patch" of the types identified in the evidence (i.e., a heart tissue patch or a medication skin patch). That applicant's goods might figuratively be viewed as a "patch" for the heart does not suffice to render the term merely descriptive of the goods. We find that the term is at most suggestive of the goods.

We also find, on this record, that the word BOOSTER is at most suggestive, rather than merely descriptive, of applicant's goods. The Trademark Examining Attorney relies on dictionary evidence showing that "booster" is defined as "something which improves or increases something," n10 and she argues that the word [*12] is merely descriptive of applicant's goods because the goods "are used to boost the ability of the heart to work." (Trademark Examining Attorney's brief at page 6.) We find, however, that this significance of the word "booster," as applied to applicant's goods, is too vague and generalized to be deemed merely descriptive of the goods. We note that the record also includes a reference to a heart "booster pump" in an August 12, 1971 New York Times Abstracts news article (see *infra)* concerning applicant's goods. We find, however, that this isolated reference does not suffice to establish that "booster" would be perceived today as a merely descriptive term in connection with applicant's goods.

n10 Cambridge Advanced Learner's Dictionary (2004).

In addition to finding that "patch" and "booster" are at best suggestive of applicant's goods, we also find that the composite created by combining the two words is suggestive, not merely descriptive. "Patch booster" would seem to have two possible grammatically correct constructions, neither of which appears to make sense as applied to applicant's identified goods. Whether the composite is viewed to mean "a patch which boosts," [*13] or is viewed to mean "a booster for a patch," the construction is awkward and does not directly describe applicant's goods, which do not involve a "patch" as that term is defined in the record (i.e., a heart tissue patch or a medication skin patch).

Finally, we acknowledge that the record includes evidence of four instances of use of the designation "patch booster." Applicant asserts that each of these instances of use are in reference to applicant's goods, and that Dr. Kantrowitz is a principal of applicant. The instances of use are as follows:

> Sinai Hosp, Detroit, drs led by Dr A Kantrowitz implant permanent, partly mechanical booster pump in H Shanks, 63-yr-old man suffering from congestive heart failure: device, known as **patch booster,** was inserted during 5-hr operation; is air powered and can be used as long as required; is made of silicone rubber and Dacron, is 6 inches long and 1 1/4 inches wide and is powered by 8-lb portable driving unit powered by batteries mounted on belt . . .

(New York Times Abstracts, August 12, 1971);

H Shanks, recipient of **patch booster,** permanently implanted mechanical heart pump, dies of complications stemming from kidney failure, [*14] Sinai Hosp, Detroit

(New York Times Abstracts, November 15, 1971;

Dr A Kantrowitz says he and his Detroit team have modified their partly mechanical heart device and are preparing 4 persons with chronic heart disease for implantation with pump-controlled balloon, meeting, NYS Med Soc; modifications follow intensive study of cause of death of H Shanks, who recd permanently implanted mechanical heart pump at Sinai Hosp in Aug '71; pump worked, but Shanks died 3 mos later from kidney failure following massive doses of antibiotics to counteract chest infection that developed as complication of surgery; modifications, designed to eliminate cause of infection, described; device, known as **patch booster,** does not replace natural heart; device described . . .

(New York Times Abstracts, February 17, 1972);

and, from an online article entitled "The 2 5 Landmark Milestone' Papers Published by ASAIO 1955-2003" (echo.gmu.edu/bionics/Toppapers5.htm):

I was very fortunate to train with Dr. Adrian Kantrowitz. Dr. Kantrowitz pioneered the development and implantation of temporary and permanent heart pumps -- devices that, to date, have saved many thousands of lives. [*15] . . . As I remember, one afternoon in 1967, Dr. Kantrowitz called me and said, "Steve, we're ready to implant the balloon pump in a patient." . . . From its initial clinical use, over 37 years ago, to its current extensive use of over 100,000 times annually in the US alone, the balloon pump, developed and pioneered by Dr. Adrian Kantrowitz, remains the first choice intervention for mechanical circulatory assistance. A permanent balloon pump, (the experimental **patch booster),** was commercialized as the CardioVad System and successfully implanted in a number of patients. . . .

We are not persuaded that this evidence of use of the designation "patch booster" in connection with applicant's goods, whether considered by itself or in connection with the other evidence of record, establishes the mere descriptiveness of the designation as applied to applicant's goods. These are isolated instances of use spread over thirty-five years, and we therefore accord these articles little or no probative value as evidence of how the designation "patch booster" is or would be perceived today. Moreover, these instances of use of "patch booster" are somewhat nebulous, to the extent that they may be [*16] the writer's attempt to refer to the trademark of applicant's specific product, i.e., "known as patch booster." If the term were in fact merely descriptive as applied to applicant's goods or competitors' similar goods, we would expect to see more numerous and more clearly descriptive usages of the term in the press and the literature in the thirty-plus years since the appearance of the articles quoted above. The paucity of the evidence of use of the term "patch booster" weighs against a finding of mere descriptiveness.

In summary, we find that the evidence of record does not support a conclusion that PATCH BOOSTER is merely descriptive of applicant's goods. To the extent that any doubts might exist as to the mere descriptiveness of applicant's mark, we resolve such doubts in favor of applicant and in favor of publication of the mark for opposition. *See In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994).

**CONCURBY:** BUCHER

**CONCUR:**

Bucher, Administrative Trademark Judge, concurring:

I agree that the combined term, PATCH BOOSTER, is not merely descriptive of this [*17] device. Since Dr. Kantrowitz first implanted a similar device in a patient with terminal heart failure in 1971, it seems no one else has used this

combination of terms. Nonetheless, those knowledgeable about these goods will understand the etymology of each individual word. This left ventricular assist device helps patients with severe chronic congestive heart failure by permitting the failing heart to work more effectively -- assisting the circulation by diastolic augmentation. The patient can turn the device off and disconnect the external power source for minutes or hours. The involved item has three main parts as set out in the identification of goods.

1 In the accompanying picture one can see illustrated the inflatable polyurethane bladder which has been sutured to replace an excised portion of the aorta, making it an "aortic patch." This is a patch in the general sense that it covers a hole' made by a surgeon in the lateral aspect of the descending thoracic aorta. 2 This is a connector through which the patch, or internal portion of the pumping mechanics, connects to an external power source. This collar is a percutaneous access device designed to provide a through-the-skin [*18] coupling between the implanted, dynamic aortic patch and the external unit. 3 This is the external drive unit that operates the pump.

[SEE ILLUSTRATION IN ORIGINAL] n11

n11 The image was taken from applicant's website and introduced into the record by the Trademark Examining Attorney. This author has added the numbers 1, 2 and 3 to clarify the three portions of applicant's identified device.

As noted by the majority, the word BOOSTER has meaning in that this entire device, given its augmentation function, appears to serve the patient as a "booster pump."

However, even if the word PATCH conveys information about the nature of the implanted balloon pump portion of the device, and even if the word BOOSTER conveys information about the function of the entire device, I agree with applicant's alternative position herein, that when these two arguably descriptive words are combined, the composite appears to be nothing more than suggestive of the device. As noted by the majority, to the extent we have doubt, we must resolve such doubt in favor of applicant.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawForeign & International ProtectionsRegistrationTrademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral Overview

Decision: The refusal to register is reversed.

Illustration, no caption

# EXHIBIT J

LEXSEE 2006 TTAB LEXIS 345

In re Adamchik

Serial No. 76571862

Trademark Trial and Appeal Board

2006 TTAB LEXIS 345

August 7, 2006, Decided

[*1]

Before Quinn, Kuhlke and Cataldo, Administrative Trademark Judges.

**COUNSEL:**

Thomas Perkowski of Thomas Perkowski, Esq., P.C. for Andrei Adamchik.

Hannah Fisher, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

**OPINIONBY:** CATALDO

**OPINION:**

**THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.**

Opinion by Cataldo, Administrative Trademark Judge:

Andrei Adamchik, an individual citizen of Belarus, has applied to register the mark OBJECTSTYLE in standard character form on the Principal Register for "providing web and e-mail hosting services to the open-source software development community." n1

n1 Application Serial No. 76571862, filed January 16, 2004, based on applicant's assertion of March 15, 2001 as the date of first use of the mark anywhere and in commerce in connection with the services.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of a feature or quality of applicant's services. In addition, the examining attorney required applicant to amend the identification and classification of the recited services, and provide an acceptable specimen of use in support [*2] of its services recited in International Class 38.

When the refusal and requirements were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant contends that his mark is suggestive and does not immediately convey to consumers the nature of the services. More specifically, applicant claims that his services under the OBJECTSTYLE mark include an Internet web site for hosting the development of open-source software by the open-source software development community, and also email services to such open-source software developers so that they can collaborate on such open-source software development projects. Applicant argues that in presenting her arguments in support of the descriptiveness refusal, the examining attorney has improperly dissected the OBJECTSTYLE mark rather than considering it as a whole; that the OBJECTSTYLE mark does not describe a characteristic of the services; that, rather, the mark merely suggests characteristics thereof; and that applicant's use of his mark in connection with his services does not prevent others from using the component terms "OBJECT" and "STYLE" in the marketplace. With regard [*3] to the services identified by the mark, applicant asserts that the examining attorney has improperly classified and identified his services; that developers utilizing applicant's services "participate in the development of open-source software projects involving primarily the creation of Java frameworks (i.e. organized sets of Java classes) which are used to construct Java-based object-oriented

systems...[that] can ultimately be used by others (e.g. graphic designers and artists) to create 'digital content' (e.g. graphics, music, natural human language works, etc.);" (applicant's brief, page 3) and that, essentially, the examining attorney's suggested amendments to the recitation of services are inaccurate.

The Examining Attorney maintains that the OBJECTSTYLE mark merely describes a feature or quality of the services. In particular, the examining attorney argues that "the wording 'object style' merely describes the focus of applicant's web site;" (examining attorney's brief, unnumbered page 8) that applicant's mark is "an abbreviated version of the generic phrase 'object-oriented style' or 'object-oriented programming style' appearing in the evidence of record;" (examining attorney's [*4] brief, unnumbered page 9) and that "[b]ecause the composite wording OBJECTSTYLE does not create a unitary mark with unique, nondescriptive meaning, it still is descriptive, especially for software developers, professionally familiar with technology terminology." (Id.) The examining attorney further argues that "software developers using applicant's web site are likely to perceive that OBJECTSTYLE pertains to their use of the site's resources - that they are to be mindful of style, while manipulating objects in the site's contents." (examining attorney's brief, unnumbered page 10) The examining attorney further maintains that applicant's recitation of services in his original application identifies services falling into two International Classes. Specifically, the examining attorney contends that applicant's e-mail services are classified in International Class 38 as telecommunications services provided via the Internet; and that applicant's hosting digital content via the Internet on which open-source software developers can work is classified in Class 42. Thus, the examining attorney argues that applicant's services are unacceptable as identified and classified in his original application. [*5] The examining attorney further maintains that applicant has failed to provide a specimen in support of his Class 38 services. In support of the refusal to register, the examining attorney has relied upon Internet dictionary and Internet computer technology encyclopedia entries for the word "object," and made of record articles retrieved from Internet web pages. Excerpts from these definitions and web pages follow (emphasis in originals):

> Object: Generally, any item that can be individually selected and manipulated. This can include shapes and pictures that appear on a display screen as well as less tangible software entities. In object-oriented programming, for example, an object is a self-contained entity that consists of both data and procedures to manipulate the data. (Webopedia Online Encyclopedia of Computer Technology www.pcwebopaedia.com)
>
> Object: <*object-oriented*> In object-oriented programming, an instance of the data structure and behaviour defined by the object's class. Each object has its own values for the instance variables of its class and can respond to the methods defined by its class. For example, an object of [*6] the "Point" class might have instance variables "x" and "y" and might respond to the "plot" method by drawing a dot on the screen at those coordinates. (FOLDOC Free On-Line Dictionary of Computing foldoc.doc.ic.ac.uk)
>
> Object-Oriented Style Rules: Consistency of style is important to software success. To help further this goal, ISE is making available for public use the basic style rules applied within ISE and recommended to other developers...To help software developers apply an effective and consistent style in their products, we are publishing here a general description of the style rules that ISE uses for its own development and that we strongly encourage others to use too... (Eiffel Software homepage www.eiffel.com)
>
> Object Oriented Style: Widget sets are designed around an object oriented programming style. All widgets are associated with a particular *class*. For each widget class there is a set of fixed features and a set of configurable features. When a program creates a widget, it creates an *instance* of that widget.... (www.manualy.sk/XxwindowGuide/node57.html)
>
> Save a drawing object style as the default: This procedure applies the attributes you select to new drawing [*7] objects. 1. Select the object that has the attribute you want to use as the default. 2. On the **Drawing** toolbar, click **Draw,** then click **Set AutoShape Defaults.** (www.office.microsoft.com/assistance/preview)

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. *See* Sec-

tion 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052. *See also In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for [*8] which registration is sought. *See In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In the instant case, the evidence made of record by the examining attorney fails to support a finding that, as used in connection with applicant's services, the term OBJECTSTYLE would immediately describe, without conjecture or speculation, a significant characteristic or feature of the services. Specifically, and as noted above, the examining attorney submits two definitions of "object" in relation to computer software development. From these definitions, it appears that an "object" identifies an instance of data structure and behavior defined by its class, or any item that can be individually selected and manipulated in a programming environment. From these definitions, it appears that the term "object" may suggest the type of data manipulation that occurs in computer software development. However, these definitions fail to demonstrate that either the term "object" [*9] or the applied-for mark, OBJECTSTYLE, merely describes applicant's services. The only example of use of the term "object style," or a variation thereof, in the examining attorney's evidence occurs in an Internet web page instructing a user in a method to "Save a drawing object style as the default." However, it is not clear from this evidence whether the term "object style" is used as a term of art, or merely in syntax. In any event, this single example of use of "object style" in instructions for working with drawing objects and graphics fails to demonstrate that OBJECTSTYLE merely describes a function, feature or characteristic of the recited services. Finally, the examining attorney's evidence includes two instances of use of the term "object oriented style" in support of her contention that the term is generic and that the mark OBJECTSTYLE is a merely descriptive abbreviation thereof. We note that the examining attorney does not indicate the goods or services for which "object oriented style" assertedly is a generic indicator. In addition, we note that this evidence fails to indicate that OBJECTSTYLE is an abbreviation for "object oriented style" or any other term. Finally, this [*10] evidence fails to demonstrate that the applied-for mark has any recognized meaning in the software development field. In short, we find that the evidence made of record by the examining attorney in this case falls short of supporting a finding that the mark OBJECTSTYLE merely describes a function, feature or characteristic of the services.

We turn next to the examining attorney's requirement that applicant submit an acceptable identification of services. In order to be eligible for registration, an application must specify the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. *See* Sections 1(a)(2) and 1(b)(2) of the Trademark Act; 15 U.S.C. §§ 1051(a)(2) and 1051(b)(2). *See also* Trademark Rule 2.32(a)(6). The identification of goods or services must be specific, definite, clear, accurate and concise. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), [*11] *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974). In addition, an application based upon Section 1(a) of the Trademark Act seeking registration of a mark for multiple classes of goods and services must contain the following: the class numbers for which registration is sought; the goods or services appropriately classified in each class; the dates of first use of the mark anywhere and in commerce for each class of goods and/or services; one specimen supporting use of the mark in each class of goods and/or services; and a filing fee for each class. *See* TMEP § 1403.01 (4<th> ed. rev. 2005).

As noted above, applicant's recitation of services reads as follows: "providing web and e-mail hosting services to the open-source software development community." Applicant further explains in his brief that he provides an Internet web site for hosting the development of open-source software as well as e-mail services to facilitate communication among open-source software developers. Electronic mail, or e-mail, services are classified with telecommunications services in International Class 38. *See International Classification* [*12] *of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement-Part I* (8<th> ed. 2002), published by the World Intellectual Property Organization. *See also* TMEP § 1401.02(a). In addition, while there appears to be some disagreement between applicant and the examining attorney regarding the precise nature of applicants' remaining services, it is settled that, for instance, providing an Internet web site for hosting the development of open-source software for others or, in the alternative, Internet web site hosting services, are classified with computer, scientific and legal services in International Class 42. *See Id.*

In consequence thereof, applicant's recitation of services in unacceptable because, at a minimum, it identifies services that fall into two International Classes. We further note that applicant submitted a filing fee with his application sufficient for a single International Class of goods or services. Finally, the record in this case indicates that the examining attorney explained the shortcomings of applicant's identification of services in her first and final Office actions. The record further indicates that applicant failed to [*13] submit either an amendment to his identification of services or an additional filing fee for each class of services identified in his application.

We find, therefore, that the identification of services submitted by applicant with his involved application is unacceptable; and that, in addition, applicant failed to submit either an amended identification of services or an additional filing fee for each class of services recited in his application.

Finally, we turn to the examining attorney's requirement that applicant submit an acceptable specimen to support use of his mark in connection with the services recited in International Class 38. Turning to the specimen submitted by applicant with the original application, we note that the specimen displays the applied-for mark and indicates use thereof in connection with the services identified in International Class 42. The only reference to electronic mail in the specimen is a statement that "If you have any question, comments or ideas, drop a line to andrus@objectstyle.org." Thus, it appears from the specimen of record that visitors to applicant's web site may communicate with applicant regarding matters pertaining to applicant's Class [*14] 42 services. However, nowhere in applicant's proffered specimen is there any indication or even suggestion that applicant provides "e-mail hosting services to the open-source software development community" to facilitate communication among open-source software developers. We find, therefore, that applicant's specimen fails to support applicant's assertion that he is using his mark in connection with the services identified in Class 38. n2 *See* Trademark Rules 2.34(a) (1) (iv) and 2.86(a)(3).

> n2 We note that applicant submitted a substitute specimen with his response to the examining attorney's first Office action. However, applicant failed to submit a verified statement that the substitute specimen "was in use in commerce at least as early as the filing date of the application" in a notarized affidavit or signed declaration in accordance with Trademark Rules 2.20, 2.59(a) and 2.71(c). Accordingly, we have not considered applicant's proposed substitute specimen in this decision. Nonetheless, we note that upon cursory examination, the proposed substitute specimen fails to support use of the mark in connection with the services identified in International Class 38.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawForeign & International ProtectionsInternational TreatiesTrademark LawProtection of RightsPriority-General OverviewTrademark LawProtection of RightsRegistrationPrincipal Register

Decision: [*15] The examining attorney's refusal to register is reversed on the ground of mere descriptiveness; and affirmed on the requirements that applicant submit an acceptable amendment to the recitation of services and submit an acceptable specimen to support use of the mark in connection with the Class 38 services.

# EXHIBIT H

LEXSEE 1997 TTAB LEXIS 185

In re Air Control Science, Inc.

Serial No. 74/590,809

Trademark Trial and Appeal Board

1997 TTAB LEXIS 185

June 18, 1997, Decided

[*1]

Before Simms, Hanak and Hairston, Administrative Trademark Judges

**COUNSEL:**

E. Michael Byorick of Duft, Graziano & Forest, P.C. for Air Control Science, Inc.

Susan K. Leslie, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

**OPINIONBY:** HAIRSTON

**OPINION:**

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Air Control Science, Inc. to register the mark DUST ANALYST for "analysis, design and engineering of dust collection systems for others." n1

n1 Application Serial No. 74/590,809 filed October 26, 1994; alleging dates of first use of October 25, 1994.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that, when used in connection with applicant's services, the mark is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney maintains that when the words "dust" and "analyst" are combined, the resulting term DUST ANALYST conveys information regarding the nature of applicant's services, namely, that applicant's services [*2] involve "the analysis of dust itself, or the analysis of the method of removing dust." Final office action, p. 2. In support of her position, the Examining Attorney has submitted dictionary definitions of the terms "dust" and "analyst." In Webster's Ninth New Collegiate Dictionary (1990) "dust" is defined, inter alia, as "fine dry particles of earth or pulverized matter," and "to make free of dust"; and "analyst" is defined as "a person who analyzes or who is skilled in analysis."

Applicant, however, contends that the plain meaning of the term "dust analyst" is one who analyzes dust, that applicant's services do not involve the analysis of dust, and that DUST ANALYST only suggests something about what applicant does, but does not convey information about the specific nature of applicant's services.

A mark is considered to merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of the ingredients, qualities, characteristics or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215, 217-218 (CCPA 1978). [*3] Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199,

1204-1205 (TTAB 1981); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952d (TTAB 1981); In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986).

There is no dispute, given the dictionary definitions of record, about the readily understood meanings of the individual words comprising the mark sought to be registered. We do not believe, however, that the combination of these words results in a term which is merely descriptive of the identified services, namely, the analysis, design and engineering of dust collection systems for others.

First, we find no support in this record for the Examining Attorney's position that DUST ANALYST is merely descriptive of applicant's services because it conveys to prospective purchasers that applicant's services [*4] involve the "analysis of dust itself." Applicant has identified its services as "analysis, design and engineering of dust collection systems for others." There is nothing in this record which indicates that such services involve the analysis of dust, and in fact, applicant's attorney maintains that applicant's services do not include analysis of dust. We note in this regard that applicant's specimen of record--page 2 of a Proposal For Dust Collection Engineering Evaluation--provides little information about applicant's services. In particular, there is no indication from this one page that applicant's services involve the analysis of dust. We note that the Examining Attorney did not request that applicant submit the remaining pages of the specimen or, for that matter, any other informational literature concerning applicant's services and the activities applicant performs under this mark. See Trademark Rule 2.61 and TMEP Section 1105.02. Accordingly, in determining mere descriptiveness, we have relied upon uncontradicted representations made by applicant's attorney.

Second, the mark sought to be registered here is DUST ANALYST, not DUST COLLECTION SYSTEM ANALYST. We see a [*5] problem with reading the words "collection system" into this mark. Thus, this case is distinguishable from Abcor, supra, where the term GASBADGE was held merely descriptive of gas monitoring badges. Furthermore, we agree with applicant that the plain meaning of the term "dust analyst" is one who analyzes dust, not one who analyzes ways to remove dust. Prospective customers would have to pause and reflect on the significance of DUST ANALYST in order to understand that, as applied to applicant's services, the services include the analysis of dust collection systems or ways to remove dust. In short, applicant's mark DUST ANALYST does not convey an immediate idea about applicant's services with any degree of particularity.

Based on the sparse record before us, we conclude that the mark DUST ANALYST, when used in connection with the analysis, design and engineering of dust collection systems for others, is not merely descriptive. To the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor so as to permit publication of the mark.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawProtection of RightsPriorityGeneral OverviewTrademark LawProtection of RightsRegistrationPrincipal Register

**Decision:** The refusal to register under Section 2(e)(1) is reversed.

# EXHIBIT I

LEXSEE 2006 TTAB LEXIS 160

In re L.Vad Technology, Inc.

Serial No. 78285714

Trademark Trial and Appeal Board

2006 TTAB LEXIS 160

April 28, 2006, Decided

[*1]

Before Bucher, Grendel and Drost, Administrative Trademark Judges.

**COUNSEL:**

Molly B. Markley of Young & Basile, P.C. for L.Vad Technology, Inc.

Georgia Ann Carty Ellis, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

**OPINIONBY:** GRENDEL

**OPINION:**

**THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark PATCH BOOSTER (in standard character form) for International Class 10 goods identified in the application as:

> permanent and temporary heart assist devices utilizing intra arterial air pressure to assist the circulating assist machinery and controls therefor; percutaneous access devices consisting of a disk implantable beneath the skin for use in transmitting fluid, air, or electricity through the collar and attachments therefor; implanted blood pumps and attachments therefor; and external drive units serving as pump actuators and controllers and attachments therefor.

The application is based on applicant's asserted bona fide intent to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

At issue [*2] in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground that it is merely descriptive of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). The appeal is fully briefed. No oral hearing was requested. We reverse the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2 (e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., 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 immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); [*3] *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a 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 term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "the 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.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); [*4] and *In re American Greetings Corporation,* 226 USPQ 365 (TTAB 1985).

The Trademark Examining Attorney contends that PATCH is merely descriptive of applicant's goods, and relies on three different arguments to support that contention.

First, she cites to dictionary evidence in the record defining "patch," in its noun form, as "something that covers or mends: a piece of material used to cover, strengthen, or mend a hole in something," n1 and as "a piece of material used to mend a hole or strengthen a weak point." n2 She also cites to dictionary evidence defining "patch," in its verb form, as "repair something with material: to cover or mend a hole in something or to strengthen a weak place using cloth or a pasty substance," n3 and as "mend, strengthen or protect by means of a patch." n4 She argues that "patch," so defined, merely describes applicant's goods because the goods "are used for the purpose of mending and strengthening the ability of the heart to function." (Trademark Examining Attorney's brief at 4.) She also notes that applicant, at page 5 of its brief, states that "applicant's heart pump and heart assist devices in a sense act as a patch in [*5] that they help to keep the patient's heart working," and she argues that this statement essentially is a concession that applicant's goods function as a patch and that "patch" therefore is merely descriptive of the goods.

n1 MSN Encarta Dictionary.

n2 Compact Oxford English Dictionary.

n3 MSN Encarta Dictionary.

n4 Compact Oxford English Dictionary.

We disagree. Applicant's statement that its goods "in a sense" act as a patch is not a concession that "patch" is merely descriptive. Rather, we agree with applicant's contention that its goods can be deemed to be a patch only figuratively, not literally. This purely figurative significance of "patch" as applied to applicant's goods does not suffice as a basis for finding that "patch" is merely descriptive, i.e., that it immediately and directly conveys information about applicant's goods.

Second, the Trademark Examining Attorney cites to dictionary evidence of record which defines "patch" as a "cover for wound: a piece of material used to cover a wound," n5 as well as to excerpts of articles obtained from the NEXIS database which refer to a medical procedure involving a patch of tissue (from human [*6] and/or animal cells) used to patch a hole in the heart or to mend damaged heart tissue. Representative examples of these excerpts include the following:

n5 MSN Encarta Dictionary.

> Jessica, who is only 3 years old, has very few bruises after a medical procedure that inserted a **patch** to cover a hole in her heart -- all without open-heart surgery. Doctors found the hole in her heart -- called an atrial septal defect -- when she was 2 years old.
>
> The **patch,** which looks like a small, coiled white flower blossom, is made of a special type of Gore-Tex material used for medical purposes. Unlike its predecessor, which was made mostly of wire, the new **patch** is made of Gore-Tex and less wire, so it's more flexible and adaptable to the heart muscle tissues. . . .
>
> Doctors such as Javois place a catheter -- a thin, flexible tube -- into the largest vein in the leg to carry the **patch** to the heart, where it is placed to cover the hole.
> (Chicago Sun Times, May 30, 2003);

. . . Melanie rallied enough that the cardiologists decided the time had come for immediate surgery to **patch** her heart. By closing the hole, it would decrease the amount of blood flowing to her lungs, [*7] which was already three times as much as it should have been. . . .
(The Times (Albany, NY), November 18, 1994);

The recipe for growing a **patch** of heart tissue in the bioreactor begins with 54 million or so individual mammalian heart cells. . . .

It takes about one week for the bioreactor to produce a **patch** of tissue 5 mm in diameter and a mere 0.10 mm thick. The heart tissue **patch** acts just like real heart tissue and beats spontaneously.
(Aerospace America, July 2002); and

HEADLINE: Local Bioengineers Want to Build **Patch** for Heart

BODY: Local scientists are working on a tissue engineering project that could one day allow doctors to repair a damaged heart with a bioengineered blood vessel or a **patch** of cardiac muscle. . . .

To make the engineered blood vessels and heart **patches,** the researchers have created a biodegradable polymer "scaffold" that is flexible and porous. . . .

The challenge is that the cardiac **patch** should be able to contract with the healthy heart muscle and replacement blood vessels should be able to dilate and constrict like the real thing. . . .

The researchers have been working with a **patch** that's about a third of an inch [*8] wide and aim to be testing a quarter-sized **patch** in large animal studies by the end of the five-year grant period. It could ultimately be used to strengthen scarred, nonfunctioning areas of heart muscle that have been damaged by a heart attack.
(Pittsburgh Post-Gazette, August 5, 2003).

These articles do not support a finding that "patch" is merely descriptive of applicant's goods. There is no evidence in the record from which we might conclude that applicant's goods, as identified in the application, are, or involve, tissue patches of the type mentioned in these articles.

The Trademark Examining Attorney's third argument in support of her contention that "patch" is merely descriptive of applicant's goods is based on dictionary evidence in the record which defines "patch" as "drug-impregnated material: a piece of material impregnated with a drug and worn on the skin to allow the gradual absorption of the drug -- *a nicotine patch, n6* and as "an adhesive piece of drug-impregnated material worn on the skin so that the drug may be gradually absorbed." n7 She also cites to the following NEXIS evidence showing this usage of the term:

n6 MSN Encarta Dictionary.

n7 Compact Oxford English Dictionary.

[*9]

You've heard of the nicotine **patch** for smokers? The estrogen **patch** for menopausal women? The nitroglycerine patch for heart patients? Now there's an anti-wrinkle **patch.** (The Vancouver Sun (British Columbia), August 1, 1998);

. . . Alza makes what it calls drug-delivery **patches** -- small adhesive **patches** worn by the patient that work like an intravenous infusion, but without the needle. The patches consist of a thin system of layered membranes: an impermeable backing, a minute drug reservoir, a rate-controlling membrane and an adhesive surface that keeps the **patch** on the skin. . . .

And Alza's popular Transderm Nitro, a **patch** for heart patients, is being challenged by a similar product from Key Pharmaceuticals Inc., of Miami.
(PC Week, March 18, 1986).

Finally, she cites to the following dictionary definitions of "percutaneous": "passed, done, or effected through the skin," n8 and "performed through the skin, as injection of radiopaque material in radiological examination, or the removal of tissue for biopsy accomplished by a needle. *Cf. transdermal."* n9

n8 The American Heritage Dictionary of the English Language (4th ed. 2000).
[*10]

n9 Dorland's Illustrated Medical Dictionary.

Based on this evidence, the Trademark Examining Attorney argues that those goods identified in the application as "percutaneous access devices consisting of a disk implantable beneath the skin for use in transmitting fluid, air, or electricity through the collar and attachments therefor," although they might not be "the conventional type of patch' goods, such as the very commonly known nicotine or birth control type patches," nonetheless "function exactly the same as these other patches because the goods have the capacity to introduce substances [including medical fluids, i.e., medicine] into the body via a device under the skin." (Trademark Examining Attorney's brief at 4-5.)

We are not persuaded by this argument. Even assuming that applicant's goods identified as a "disk implantable beneath the skin" are used or can be used to transmit medicine into the body, just as a "patch" does, we cannot conclude that "patch" merely describes the goods. Significantly, applicant's disk is implanted beneath the skin; it is not adhered to the skin like the patches identified in the dictionary and NEXIS evidence of record. There is no evidence [*11] that medication delivery devices implanted beneath the skin are called "patches." It is not enough, even if true, that applicant's goods could be used to deliver medicines like a "patch" does. On this record, "patch" has a particular connotation, that of a drug delivery device that is adhered to the skin, not one which is implanted beneath the skin.

In short, we are not persuaded by any of the Trademark Examining Attorney's three arguments in support of her contention that "patch" is merely descriptive of applicant's goods. Applicant's goods do not comprise or involve a "patch" of the types identified in the evidence (i.e., a heart tissue patch or a medication skin patch). That applicant's goods might figuratively be viewed as a "patch" for the heart does not suffice to render the term merely descriptive of the goods. We find that the term is at most suggestive of the goods.

We also find, on this record, that the word BOOSTER is at most suggestive, rather than merely descriptive, of applicant's goods. The Trademark Examining Attorney relies on dictionary evidence showing that "booster" is defined as "something which improves or increases something," n10 and she argues that the word [*12] is merely descriptive of applicant's goods because the goods "are used to boost the ability of the heart to work." (Trademark Examining Attorney's brief at page 6.) We find, however, that this significance of the word "booster," as applied to applicant's goods, is too vague and generalized to be deemed merely descriptive of the goods. We note that the record also includes a reference to a heart "booster pump" in an August 12, 1971 New York Times Abstracts news article (see *infra)* concerning applicant's goods. We find, however, that this isolated reference does not suffice to establish that "booster" would be perceived today as a merely descriptive term in connection with applicant's goods.

n10 Cambridge Advanced Learner's Dictionary (2004).

In addition to finding that "patch" and "booster" are at best suggestive of applicant's goods, we also find that the composite created by combining the two words is suggestive, not merely descriptive. "Patch booster" would seem to have two possible grammatically correct constructions, neither of which appears to make sense as applied to applicant's identified goods. Whether the composite is viewed to mean "a patch which boosts," [*13] or is viewed to mean "a booster for a patch," the construction is awkward and does not directly describe applicant's goods, which do not involve a "patch" as that term is defined in the record (i.e., a heart tissue patch or a medication skin patch).

Finally, we acknowledge that the record includes evidence of four instances of use of the designation "patch booster." Applicant asserts that each of these instances of use are in reference to applicant's goods, and that Dr. Kantrowitz is a principal of applicant. The instances of use are as follows:

> Sinai Hosp, Detroit, drs led by Dr A Kantrowitz implant permanent, partly mechanical booster pump in H Shanks, 63-yr-old man suffering from congestive heart failure: device, known as **patch booster,** was inserted during 5-hr operation; is air powered and can be used as long as required; is made of silicone rubber and Dacron, is 6 inches long and 1 1/4 inches wide and is powered by 8-lb portable driving unit powered by batteries mounted on belt . . .

(New York Times Abstracts, August 12, 1971);

H Shanks, recipient of **patch booster,** permanently implanted mechanical heart pump, dies of complications stemming from kidney failure, [*14] Sinai Hosp, Detroit

(New York Times Abstracts, November 15, 1971;

Dr A Kantrowitz says he and his Detroit team have modified their partly mechanical heart device and are preparing 4 persons with chronic heart disease for implantation with pump-controlled balloon, meeting, NYS Med Soc; modifications follow intensive study of cause of death of H Shanks, who recd permanently implanted mechanical heart pump at Sinai Hosp in Aug '71; pump worked, but Shanks died 3 mos later from kidney failure following massive doses of antibiotics to counteract chest infection that developed as complication of surgery; modifications, designed to eliminate cause of infection, described; device, known as **patch booster,** does not replace natural heart; device described . . .

(New York Times Abstracts, February 17, 1972);

and, from an online article entitled "The 2 5 Landmark Milestone' Papers Published by ASAIO 1955-2003" (echo.gmu.edu/bionics/Toppapers5.htm):

I was very fortunate to train with Dr. Adrian Kantrowitz. Dr. Kantrowitz pioneered the development and implantation of temporary and permanent heart pumps -- devices that, to date, have saved many thousands of lives. [*15] . . . As I remember, one afternoon in 1967, Dr. Kantrowitz called me and said, "Steve, we're ready to implant the balloon pump in a patient." . . . From its initial clinical use, over 37 years ago, to its current extensive use of over 100,000 times annually in the US alone, the balloon pump, developed and pioneered by Dr. Adrian Kantrowitz, remains the first choice intervention for mechanical circulatory assistance. A permanent balloon pump, (the experimental **patch booster),** was commercialized as the CardioVad System and successfully implanted in a number of patients. . . .

We are not persuaded that this evidence of use of the designation "patch booster" in connection with applicant's goods, whether considered by itself or in connection with the other evidence of record, establishes the mere descriptiveness of the designation as applied to applicant's goods. These are isolated instances of use spread over thirty-five years, and we therefore accord these articles little or no probative value as evidence of how the designation "patch booster" is or would be perceived today. Moreover, these instances of use of "patch booster" are somewhat nebulous, to the extent that they may be [*16] the writer's attempt to refer to the trademark of applicant's specific product, i.e., "known as patch booster." If the term were in fact merely descriptive as applied to applicant's goods or competitors' similar goods, we would expect to see more numerous and more clearly descriptive usages of the term in the press and the literature in the thirty-plus years since the appearance of the articles quoted above. The paucity of the evidence of use of the term "patch booster" weighs against a finding of mere descriptiveness.

In summary, we find that the evidence of record does not support a conclusion that PATCH BOOSTER is merely descriptive of applicant's goods. To the extent that any doubts might exist as to the mere descriptiveness of applicant's mark, we resolve such doubts in favor of applicant and in favor of publication of the mark for opposition. *See In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994).

**CONCURBY:** BUCHER

**CONCUR:**

Bucher, Administrative Trademark Judge, concurring:

I agree that the combined term, PATCH BOOSTER, is not merely descriptive of this [*17] device. Since Dr. Kantrowitz first implanted a similar device in a patient with terminal heart failure in 1971, it seems no one else has used this

combination of terms. Nonetheless, those knowledgeable about these goods will understand the etymology of each individual word. This left ventricular assist device helps patients with severe chronic congestive heart failure by permitting the failing heart to work more effectively -- assisting the circulation by diastolic augmentation. The patient can turn the device off and disconnect the external power source for minutes or hours. The involved item has three main parts as set out in the identification of goods.

1 In the accompanying picture one can see illustrated the inflatable polyurethane bladder which has been sutured to replace an excised portion of the aorta, making it an "aortic patch." This is a patch in the general sense that it covers a hole' made by a surgeon in the lateral aspect of the descending thoracic aorta. 2 This is a connector through which the patch, or internal portion of the pumping mechanics, connects to an external power source. This collar is a percutaneous access device designed to provide a through-the-skin [*18] coupling between the implanted, dynamic aortic patch and the external unit. 3 This is the external drive unit that operates the pump.

[SEE ILLUSTRATION IN ORIGINAL] n11

n11 The image was taken from applicant's website and introduced into the record by the Trademark Examining Attorney. This author has added the numbers 1, 2 and 3 to clarify the three portions of applicant's identified device.

As noted by the majority, the word BOOSTER has meaning in that this entire device, given its augmentation function, appears to serve the patient as a "booster pump."

However, even if the word PATCH conveys information about the nature of the implanted balloon pump portion of the device, and even if the word BOOSTER conveys information about the function of the entire device, I agree with applicant's alternative position herein, that when these two arguably descriptive words are combined, the composite appears to be nothing more than suggestive of the device. As noted by the majority, to the extent we have doubt, we must resolve such doubt in favor of applicant.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawForeign & International ProtectionsRegistrationTrademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral Overview

Decision: The refusal to register is reversed.

Illustration, no caption

# EXHIBIT J

LEXSEE 2006 TTAB LEXIS 345

In re Adamchik

Serial No. 76571862

Trademark Trial and Appeal Board

2006 TTAB LEXIS 345

August 7, 2006, Decided

[*1]

Before Quinn, Kuhlke and Cataldo, Administrative Trademark Judges.

**COUNSEL:**

Thomas Perkowski of Thomas Perkowski, Esq., P.C. for Andrei Adamchik.

Hannah Fisher, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

**OPINIONBY:** CATALDO

**OPINION:**

**THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.**

Opinion by Cataldo, Administrative Trademark Judge:

Andrei Adamchik, an individual citizen of Belarus, has applied to register the mark OBJECTSTYLE in standard character form on the Principal Register for "providing web and e-mail hosting services to the open-source software development community." n1

n1 Application Serial No. 76571862, filed January 16, 2004, based on applicant's assertion of March 15, 2001 as the date of first use of the mark anywhere and in commerce in connection with the services.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of a feature or quality of applicant's services. In addition, the examining attorney required applicant to amend the identification and classification of the recited services, and provide an acceptable specimen of use in support [*2] of its services recited in International Class 38.

When the refusal and requirements were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant contends that his mark is suggestive and does not immediately convey to consumers the nature of the services. More specifically, applicant claims that his services under the OBJECTSTYLE mark include an Internet web site for hosting the development of open-source software by the open-source software development community, and also email services to such open-source software developers so that they can collaborate on such open-source software development projects. Applicant argues that in presenting her arguments in support of the descriptiveness refusal, the examining attorney has improperly dissected the OBJECTSTYLE mark rather than considering it as a whole; that the OBJECTSTYLE mark does not describe a characteristic of the services; that, rather, the mark merely suggests characteristics thereof; and that applicant's use of his mark in connection with his services does not prevent others from using the component terms "OBJECT" and "STYLE" in the marketplace. With regard [*3] to the services identified by the mark, applicant asserts that the examining attorney has improperly classified and identified his services; that developers utilizing applicant's services "participate in the development of open-source software projects involving primarily the creation of Java frameworks (i.e. organized sets of Java classes) which are used to construct Java-based object-oriented

systems...[that] can ultimately be used by others (e.g. graphic designers and artists) to create 'digital content' (e.g. graphics, music, natural human language works, etc.);" (applicant's brief, page 3) and that, essentially, the examining attorney's suggested amendments to the recitation of services are inaccurate.

The Examining Attorney maintains that the OBJECTSTYLE mark merely describes a feature or quality of the services. In particular, the examining attorney argues that "the wording 'object style' merely describes the focus of applicant's web site;" (examining attorney's brief, unnumbered page 8) that applicant's mark is "an abbreviated version of the generic phrase 'object-oriented style' or 'object-oriented programming style' appearing in the evidence of record;" (examining attorney's [*4] brief, unnumbered page 9) and that "[b]ecause the composite wording OBJECTSTYLE does not create a unitary mark with unique, nondescriptive meaning, it still is descriptive, especially for software developers, professionally familiar with technology terminology." (Id.) The examining attorney further argues that "software developers using applicant's web site are likely to perceive that OBJECTSTYLE pertains to their use of the site's resources - that they are to be mindful of style, while manipulating objects in the site's contents." (examining attorney's brief, unnumbered page 10) The examining attorney further maintains that applicant's recitation of services in his original application identifies services falling into two International Classes. Specifically, the examining attorney contends that applicant's e-mail services are classified in International Class 38 as telecommunications services provided via the Internet; and that applicant's hosting digital content via the Internet on which open-source software developers can work is classified in Class 42. Thus, the examining attorney argues that applicant's services are unacceptable as identified and classified in his original application. [*5] The examining attorney further maintains that applicant has failed to provide a specimen in support of his Class 38 services. In support of the refusal to register, the examining attorney has relied upon Internet dictionary and Internet computer technology encyclopedia entries for the word "object," and made of record articles retrieved from Internet web pages. Excerpts from these definitions and web pages follow (emphasis in originals):

> Object: Generally, any item that can be individually selected and manipulated. This can include shapes and pictures that appear on a display screen as well as less tangible software entities. In object-oriented programming, for example, an object is a self-contained entity that consists of both data and procedures to manipulate the data. (Webopedia Online Encyclopedia of Computer Technology www.pcwebopaedia.com)
>
> Object: <*object-oriented*> In object-oriented programming, an instance of the data structure and behaviour defined by the object's class. Each object has its own values for the instance variables of its class and can respond to the methods defined by its class. For example, an object of [*6] the "Point" class might have instance variables "x" and "y" and might respond to the "plot" method by drawing a dot on the screen at those coordinates. (FOLDOC Free On-Line Dictionary of Computing foldoc.doc.ic.ac.uk)
>
> Object-Oriented Style Rules: Consistency of style is important to software success. To help further this goal, ISE is making available for public use the basic style rules applied within ISE and recommended to other developers...To help software developers apply an effective and consistent style in their products, we are publishing here a general description of the style rules that ISE uses for its own development and that we strongly encourage others to use too... (Eiffel Software homepage www.eiffel.com)
>
> Object Oriented Style: Widget sets are designed around an object oriented programming style. All widgets are associated with a particular *class*. For each widget class there is a set of fixed features and a set of configurable features. When a program creates a widget, it creates an *instance* of that widget.... (www.manualy.sk/XxwindowGuide/node57.html)
>
> Save a drawing object style as the default: This procedure applies the attributes you select to new drawing [*7] objects. 1. Select the object that has the attribute you want to use as the default. 2. On the **Drawing** toolbar, click **Draw,** then click **Set AutoShape Defaults.** (www.office.microsoft.com/assistance/preview)

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. *See* Sec-

tion 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052. *See also In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for [*8] which registration is sought. *See In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In the instant case, the evidence made of record by the examining attorney fails to support a finding that, as used in connection with applicant's services, the term OBJECTSTYLE would immediately describe, without conjecture or speculation, a significant characteristic or feature of the services. Specifically, and as noted above, the examining attorney submits two definitions of "object" in relation to computer software development. From these definitions, it appears that an "object" identifies an instance of data structure and behavior defined by its class, or any item that can be individually selected and manipulated in a programming environment. From these definitions, it appears that the term "object" may suggest the type of data manipulation that occurs in computer software development. However, these definitions fail to demonstrate that either the term "object" [*9] or the applied-for mark, OBJECTSTYLE, merely describes applicant's services. The only example of use of the term "object style," or a variation thereof, in the examining attorney's evidence occurs in an Internet web page instructing a user in a method to "Save a drawing object style as the default." However, it is not clear from this evidence whether the term "object style" is used as a term of art, or merely in syntax. In any event, this single example of use of "object style" in instructions for working with drawing objects and graphics fails to demonstrate that OBJECTSTYLE merely describes a function, feature or characteristic of the recited services. Finally, the examining attorney's evidence includes two instances of use of the term "object oriented style" in support of her contention that the term is generic and that the mark OBJECTSTYLE is a merely descriptive abbreviation thereof. We note that the examining attorney does not indicate the goods or services for which "object oriented style" assertedly is a generic indicator. In addition, we note that this evidence fails to indicate that OBJECTSTYLE is an abbreviation for "object oriented style" or any other term. Finally, this [*10] evidence fails to demonstrate that the applied-for mark has any recognized meaning in the software development field. In short, we find that the evidence made of record by the examining attorney in this case falls short of supporting a finding that the mark OBJECTSTYLE merely describes a function, feature or characteristic of the services.

We turn next to the examining attorney's requirement that applicant submit an acceptable identification of services. In order to be eligible for registration, an application must specify the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. *See* Sections 1(a)(2) and 1(b)(2) of the Trademark Act; 15 U.S.C. §§ 1051(a)(2) and 1051(b)(2). *See also* Trademark Rule 2.32(a)(6). The identification of goods or services must be specific, definite, clear, accurate and concise. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), [*11] *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974). In addition, an application based upon Section 1(a) of the Trademark Act seeking registration of a mark for multiple classes of goods and services must contain the following: the class numbers for which registration is sought; the goods or services appropriately classified in each class; the dates of first use of the mark anywhere and in commerce for each class of goods and/or services; one specimen supporting use of the mark in each class of goods and/or services; and a filing fee for each class. *See* TMEP § 1403.01 (4<th> ed. rev. 2005).

As noted above, applicant's recitation of services reads as follows: "providing web and e-mail hosting services to the open-source software development community." Applicant further explains in his brief that he provides an Internet web site for hosting the development of open-source software as well as e-mail services to facilitate communication among open-source software developers. Electronic mail, or e-mail, services are classified with telecommunications services in International Class 38. *See International Classification* [*12] *of Goods and Services for the Purposes of the Registration of Marks Under the Nice Agreement-Part I* (8<th> ed. 2002), published by the World Intellectual Property Organization. *See also* TMEP § 1401.02(a). In addition, while there appears to be some disagreement between applicant and the examining attorney regarding the precise nature of applicants' remaining services, it is settled that, for instance, providing an Internet web site for hosting the development of open-source software for others or, in the alternative, Internet web site hosting services, are classified with computer, scientific and legal services in International Class 42. *See Id.*

In consequence thereof, applicant's recitation of services in unacceptable because, at a minimum, it identifies services that fall into two International Classes. We further note that applicant submitted a filing fee with his application sufficient for a single International Class of goods or services. Finally, the record in this case indicates that the examining attorney explained the shortcomings of applicant's identification of services in her first and final Office actions. The record further indicates that applicant failed to [*13] submit either an amendment to his identification of services or an additional filing fee for each class of services identified in his application.

We find, therefore, that the identification of services submitted by applicant with his involved application is unacceptable; and that, in addition, applicant failed to submit either an amended identification of services or an additional filing fee for each class of services recited in his application.

Finally, we turn to the examining attorney's requirement that applicant submit an acceptable specimen to support use of his mark in connection with the services recited in International Class 38. Turning to the specimen submitted by applicant with the original application, we note that the specimen displays the applied-for mark and indicates use thereof in connection with the services identified in International Class 42. The only reference to electronic mail in the specimen is a statement that "If you have any question, comments or ideas, drop a line to andrus@objectstyle.org." Thus, it appears from the specimen of record that visitors to applicant's web site may communicate with applicant regarding matters pertaining to applicant's Class [*14] 42 services. However, nowhere in applicant's proffered specimen is there any indication or even suggestion that applicant provides "e-mail hosting services to the open-source software development community" to facilitate communication among open-source software developers. We find, therefore, that applicant's specimen fails to support applicant's assertion that he is using his mark in connection with the services identified in Class 38. n2 *See* Trademark Rules 2.34(a) (1) (iv) and 2.86(a)(3).

> n2 We note that applicant submitted a substitute specimen with his response to the examining attorney's first Office action. However, applicant failed to submit a verified statement that the substitute specimen "was in use in commerce at least as early as the filing date of the application" in a notarized affidavit or signed declaration in accordance with Trademark Rules 2.20, 2.59(a) and 2.71(c). Accordingly, we have not considered applicant's proposed substitute specimen in this decision. Nonetheless, we note that upon cursory examination, the proposed substitute specimen fails to support use of the mark in connection with the services identified in International Class 38.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawForeign & International ProtectionsInternational TreatiesTrademark LawProtection of RightsPriority-General OverviewTrademark LawProtection of RightsRegistrationPrincipal Register

Decision: [*15] The examining attorney's refusal to register is reversed on the ground of mere descriptiveness; and affirmed on the requirements that applicant submit an acceptable amendment to the recitation of services and submit an acceptable specimen to support use of the mark in connection with the Class 38 services.

# EXHIBIT K

LEXSEE 2006 TTAB LEXIS 339

In re FineLine Lakeshore Services, LLP and Dock & Lift, Inc.

Serial No. 76428109

Trademark Trial and Appeal Board

2006 TTAB LEXIS 339

August 24, 2006, Decided

[*1]

Before Quinn, Zervas and Walsh, Administrative Trademark Judges.

**COUNSEL:**

Hugh D. Jaeger, Esq. for FineLine Lakeshore Services, LLP and Dock & Lift, Inc.

William H. Dawe III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

**OPINIONBY:** WALSH

**OPINION:**

**THIS DECISION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Walsh, Administrative Trademark Judge:

On June 27, 2002, FineLine Lakeshore Services, LLP and Dock & Lift, Inc. ("applicants") applied as joint applicants to register the mark POLYDECK in standard-character form for goods now identified as "polyethylene dock sections" in International Class 19. Applicants assert both first use anywhere and first use of the mark in commerce on May 1, 2002.

The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Reg. No. 2586508, which issued on June 25, 2002, for the mark POLYDECK in standard-character form for goods identified as "vinyl boards for building products" in International Class 19. The registration claims first use anywhere on April 1, 2001 and first use of the mark in commerce on July 1, 2001. [*2] The Examining Attorney has also refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 2(e)(1), on the ground that applicants' mark merely describes the goods. Applicants responded to the refusals, and the Examining Attorney made both refusals final. Applicants and the Examining Attorney have filed briefs. For the reasons stated below, we affirm the refusal under Section 2(d) and reverse the refusal under Section 2(e)(1).

The Section 2(d) Refusal Likelihood of Confusion

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion ..." 15 U.S.C. § 1052(d). To determine whether there is a likelihood of confusion, we must consider all evidence of record bearing on the factors delineated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity [*3] of the goods of the applicants and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Comparison of the Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In this case the marks are identical. Both the mark in the application and the mark in the cited registration are POLYDECK, and both marks are in standard-character form. Furthermore, as the Board observed in a similar case, "... in a situation such as this, where both parties are using the identical designation, ... the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Indus., Inc., 210 USPQ 70, 78 (TTAB 1981).

Comparison of the Goods and Channels of Trade

To find goods related for the purposes of Trademark [*4] Act Section 2(d), the goods need not be identical. The goods need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Applicants' entire argument, not only as to the goods but with regard to both grounds for refusal, is as follows:

> The issue regarding refusal of registration is very simple--the goods are not the same and the goods are not sold in the same channels of commerce. There is no confusion as to the source of the goods and there never has been any confusion as to the source of the goods.

The Examining Attorney argues that the goods of applicants and the registrant are related in that both are "building products that pass through the same trade channels." In support of his position that the goods are related, the Examining Attorney has presented records of third-party, use-based registrations, including the following:

> Reg. No. 2488246 for the mark "21POLY" for goods including "wood coated with protective [*5] polymer coating, namely, ... boards, ... and beams for use in waterfront walls, sea walls, retaining walls, piers, bulkheads, docks and decks";
>
> Reg. No. 2048875 for the mark "PHOENIX" for goods identified as "recycled plastic lumber, sheets, boards and posts for use in building structures, such as, ... decks, docks, ... fencing, outdoor furniture, plant boxes and shipping pallets";
>
> Reg. No. 2504695 for the mark "YARDCRAFTERS" for goods identified as "non-metal deck board and/or panels ... for the decks, docks ...";
>
> Reg. No. 2159249 for the mark "YOU WILL NEVER GO BACK TO WOOD!" for goods identified as "vinyl decks, docks, fences and component parts thereof"; and
>
> Reg. No. 1787500 for the mark "Vecor" and design for goods identified as "vinyl panels for the construction of docks, decks, ... and accessories therefor";

Applicants' goods are "polyethylene dock sections"; the goods in the cited registration are "vinyl boards for building products." In determining whether the goods are related, we must consider the goods as identified in the application and registration and, in the absence of any restrictions, assume that the goods include all goods identified and that those goods [*6] travel in all trade channels appropriate for such goods. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

The registrations provided by the Examining Attorney have some probative value in this regard; specifically, they may indicate that the goods are the types of goods which may emanate from the same source. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993). In this case the goods in the cited registration are vinyl boards which could be component parts of applicants' polyethylene dock sections. The third-party registrations indicate that finished goods, such as applicant's dock sections, could include component parts, such as, the vinyl boards identified in the registration. As such, applicants' goods and those identified

in the cited registration, as the Examining Attorney notes, are both closely related building products. Accordingly, we conclude that applicants' goods and the goods identified [*7] in the cited registration are related.

Although applicants state that the channels of trade for the goods differ, applicants do not either explain how they might differ or provide any evidence to show that they differ. Neither the application nor the cited registration specifies any restrictions as to trade channels. Consequently, we must assume that the goods identified in both the application and the cited registrations move in the same trade channels, namely, trade channels which would apply generally to building products. See In re Melville Corp., 18 USPQ2d at 1388. Accordingly, we conclude that the trade channels for the goods of applicants and the cited registrant could be overlapping or the same.

Actual Confusion

Applicants also argue that the absence of actual confusion indicates no likelihood of confusion without further explanation. However, there is no evidence that there has been an opportunity for confusion to occur in this case, for example, evidence that the applicants and the registrant have sold their goods in the same territory. Furthermore, particularly in an ex parte proceeding, "uncorroborated statements of no known instances [*8] of actual confusion are of little evidentiary value." In re Majestic Distilling Co., 65 USPQ2d at 1205. See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Therefore, we find applicants' argument regarding actual confusion unpersuasive.

In sum, after considering all evidence of record bearing on the du Pont factors, we conclude that there is a likelihood of confusion in this case. We conclude so principally because applicants' mark and the mark in the cited registration are identical and because the goods identified in the application and the cited registration are related and could travel in the same trade channels.

The Section 2(e)(1) Refusal Descriptiveness

The Examining Attorney has also refused registration on the ground that POLYDECK is merely descriptive of "polyethylene dock sections." The Examining Attorney argues that PLOYDECK is a compound term with two merely descriptive components: "deck" which is an alternative generic term for "dock" and "poly" which is an abbreviation for "polyethylene." To support his position that "poly" is an abbreviation for "polyethylene" the Examining Attorney [*9] made the following definition of record: "pol-y **noun** 1. polyester 2. polyethylene." This definition is from the electronic version of the American Heritage(R) Dictionary of the English Language (3<rd> ed. 1992). Applicant has not presented any evidence or arguments with regard to the descriptiveness refusal.

A term is merely descriptive of goods within the meaning of Trademark Act Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

To determine whether a term is merely descriptive we must consider the term not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods in that context. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

When two or more merely descriptive [*10] terms are combined, we must determine whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, then the resulting combination is also merely descriptive. See, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002)(SMARTTOWER merely descriptive of commercial and industrial cooling towers).

The definition for "poly" which the Examining Attorney provided is for "poly" standing alone and includes two alternative meanings. The same dictionary also includes a definition for "poly-" when used as a prefix. We must consider this additional definition in view of the fact that, in this instance, relevant purchasers may also perceive "poly" as a prefix. The definition for the prefix "poly-" is as follows: "**prefix** 1. more than one; many; much: *polyatomic*. 2. more than usual; excessive; abnormal: *polydipsia* 3. polymer; polymeric: *polyethylene* **[From Greek** polus, many]." n1 The dictionary also includes scores of entries for terms indicating the common use of "poly-" as a prefix, for example: **polychromatic, polygon, polygamy, polysyllabic,** [*11] etc. n2 This evidence indicates that relevant consumers may view POLYDECK as a coined term with "poly-" as a prefix suggesting, for example, that the goods, dock sections, may be configured in many ways. In re Remacle, 66 USPQ2d 1222, 1224 (TTAB 2002)(BIO-CD held not merely descriptive for various scientific and medical products and services). This indicates further that the combination of "poly" and "deck" may have a suggestive meaning which is more than the sum of its parts contrary to the Examining Attorney's position.

n1 We take judicial notice of this dictionary definition. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

n2 We take judicial notice of these examples from the Merriam-Webster's Collegiate Dictionary (11<th> ed. 2003). Id.

Accordingly, we conclude that POLYDECK is not merely descriptive of "polyethylene dock sections." In concluding so we acknowledge that there is some doubt and that, in such a case under Trademark Act Section 2(e)(1), we [*12] must resolve doubt in favor of applicant. In re Rank Organisation Ltd., 222 USPQ 324, 326 (TTAB 1984).

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawProtection of RightsGeneral OverviewTrademark LawSubject MatterDescriptive & Laudatory TermsGeneral Overview

**Decision:** The refusal under Section 2(d) is affirmed and the refusal under Section 2(e)(1) is reversed. Registration is refused.

# EXHIBIT L

LEXSEE 2001 TTAB LEXIS 475

In re Idiag

Serial No. 75/592,564

Trademark Trial and Appeal Board

2001 TTAB LEXIS 475

June 19, 2001, Decided

[*1]

Before Hohein, Hairston and Bucher, Administrative Trademark Judges.

**COUNSEL:**

Peter C. Michalos and John Zaccaria of Notaro & Michalos P.C. for Idiag.

David T. Taylor, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

**OPINIONBY:** BUCHER

**OPINION:**

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Bucher, Administrative Trademark Judge:

Idiag, a Swiss joint stock company, seeks registration of the term SPINALMOUSE for "data processors and computers; computer operating programs; computer programs and software for operating and measuring the input from spinal measuring devices and for collecting, processing and presentation of data in the field of orthopedic and sports medicine, neurology, physical rehabilitation and therapy; [and] computerized noninvasive scanning devices used to measure the shape and mobility of the spine and other parts of the body," in International Class 9, and for "medical apparatus and instruments, namely, physical exercise apparatus for medical purposes," in International Class 10. n1

n1 Application serial number 75/592,564, filed on November 20, 1998. This application is based upon an allegation of a *bona fide* intention to use the mark in commerce.

[*2]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that, when used in connection with applicant's goods, the term SPINALMOUSE is merely descriptive of them. Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

There is no dispute that applicant's goods include, but are not limited to, an electronic-measuring device and software for assessing back shape, mobility and flexibility. The sole issue before us, then, is whether the combined term SPINALMOUSE is merely descriptive of applicant's goods listed above in International Class 9. n2

n2 Applicant's brochure and manual seem to give meaning to the collection of items enumerated in International Class 9. Further, we note that the Trademark Examining Attorney has submitted extensive evidence directed toward the "spinal measuring device" in International Class 9. Hence, we consider that the Section 2(e)(1) refusal was directed toward the goods in this class. It is not clear to us exactly what is included in the "physical exercise apparatus" of International Class 10, but to the extent this identifies something different from the spinal measuring device, we do not find anything in the record directed to a Section 2(e)(1) refusal of the goods in that class.

[*3]

Based upon the record as a whole, the Trademark Examining Attorney argues that clearly the word "spinal" is descriptive of applicant goods. Considering the identification of goods, a dictionary definition, n3 the contents of applicant's responses to the Office actions, and the detailed text of applicant's manual and brochure accompanying applicant's response to the first Office action, we agree that the word "spinal," considered alone, is descriptive of the location of the body on which applicant's tracking device is used and the bodily structure that provides it with a purpose.

n3 **Spinal** Of, relating to, or situated near the spine or spinal cord; vertebral; spinal injury. [The American Heritage Dictionary of the English Language, Electronic Version (Third Edition 1992)].

Furthermore, the Trademark Examining Attorney argues that the word "mouse" is also descriptive of the hand-held tracking device used to measure the shape and mobility of the spine. However, applicant argues that this small hand-held device, whose operation is admittedly dependent upon a computer, is not a computer mouse. n4 It does not perform any of the defined moving and pointing functions of a computer [*4] mouse. Applicant notes that it is not structured like a computer mouse and its operation is distinctly different. Applicant's tracking device is guided in one direction only, down the patient's back over the skin along the spinal column.

n4 Applicant's counsel states that "... it is not stated anywhere in applicant's manual or brochure that applicant's goods are a 'mouse.'" Actually, several places on page 7 of the manual, for example, the hand-held device is indeed referred to as a "mouse." Additionally, throughout the text in the manual, applicant's trademark itself is misused as the name of the product and on page 23 is incorrectly pluralized (e.g., "... the SpinalMouse ...," "... two SpinalMice in the same room..."). However, we hasten to add that this is still an intent-to-use application, and that these materials were requested by the Trademark Examining Attorney under Trademark Rule 2.61(b). Upon submission, applicant's counsel expressly qualified these written materials as being "in draft" and "not yet ... distributed to the public." Presumably applicant's U.S. trademark counsel will ensure that when translated from the German language original into the English language editions, the literature as distributed will avoid such imprudent misuses of the trademark and ensure the adoption and consistent usage of a correct generic designation for this device.

[*5]

The Trademark Examining Attorney, having concluded that each word individually ("Spinal" and "Mouse") is descriptive, then finds that the composite term (SPINALMOUSE) is merely descriptive. By contrast, applicant points out that arguably SPINALMOUSE is an arbitrary, coined term, or at worst, that the combined term is suggestive of the goods.

During the prosecution of this application, the focus of much of the evidence placed into the record by the Trademark Examining Attorney was on the definition of a computer "mouse." n5 Accordingly, we are faced with the question of exactly what minimal features are necessary for a computer mouse to still qualify as a mouse?

n5 **Mouse** A common pointing device, popularized by its inclusion as standard equipment with the Apple MacIntosh. With the rise in popularity of graphical user interfaces in MS-DOS, UNIX, and OS-2, use of mice is growing throughout the personal computer and workstation worlds. The basic features of a mouse are a casing with a flat bottom, designed to be gripped by one hand; one or more buttons on the top; a multidirectional detection device (usually a ball) on the bottom; and a cable connecting the mouse to the computer. By moving the mouse on a surface (such as a desk), the user typically controls an on-screen cursor. A mouse is a relative pointing device because there are no defined limits to the mouse's movement and because its placement on a surface does not map directly to a specific location. To select items or choose commands on the screen, the user presses one of the mouse's buttons, producing a "mouse click."

[Computer Dictionary, Microsoft Press (Second Edition, 1994) p. 262].

> **Mouse** An input device, equipped with one or more control buttons, that is housed in a palm-sized case and designed so that you can roll it about on the table, next to your keyboard. As the mouse moves, its circuits relay signals that correspondingly move a pointer on screen. A mouse is distinguished by the internal mechanism it uses to generate its signal and by its means of connection with the computer.

[Webster's New World Dictionary of Computer Terms (Seventh Edition 1999) p. 346].

> **Mouse** An input device designed to assist in the use of a computer system. For example, in a graphical user interface environment like Macintosh or Windows, an icon is displayed on the screen. The user selects the icon by moving the cursor to point to the icon with a mouse, automatically activating a set of commands without the user having to enter complex instructions...

[Prentice Hall's Illustrated Dictionary of Computing (Third Edition 1998) p.442].

[*6]

There are certainly some superficial similarities between these two devices. Both devices have a "palm sized case" that is "gripped in one hand." This tracking device communicates with its base station via a radio link, not a cable. However, while most computer mice still have a "cable" attaching them to the computer terminal (see first definition *supra*), a state-of-the-art cordless mouse is in every way still a mouse. Like a computer mouse, this device has several "buttons" on top (viz. on applicant's device, merely "Stop" and "Start") that would be pressed with one's forefinger.

As to the dissimilarities, applicant correctly notes the significant difference in function between a computer mouse and its hand-held device. All the definitions cited in this record emphasize that a computer mouse is a pointing device designed to assist the computer user in interacting with the computer. By contrast, applicant's hand-held device is not a pointing device and is not designed to make a computer easier to use. While the sole mission of a computer mouse is to assist one in operating a computer, applicant has designed a high-tech, medical tracking device that relies upon computerized technology [*7] to accomplish its mission. As to form and operation, because a mouse is a *relative* pointing device, it is necessarily multi-directional. In its design and operation, applicant's device is strictly unidirectional. The computer mouse has a flat bottom. The bottom of applicant's tracking device is arcuate and offset at various points with tracking wheels. The tracking device cannot rest on a flat surface but rather, when not in use, sits in a cradle in the base station. While a computer mouse is moved on a flat surface, applicant's device is designed to move down the highly irregular surface of a patient's back along the spine. n6

> n6 This is a rough outline view of the hand-held device at the center of this debate.
>
> [SEE ILLUSTRATION IN ORIGINAL]

On balance, we find this device falls outside the scope of a computer mouse. n7 Certainly, this device could never replicate the critical functionalities of a computer mouse. This device could not be used with a computer that does not have the base station/receiver and applicant's software. n8 Applicant's entire set of goods listed in International Class 9 are useful only to trained medical professionals in the fields of chiropractic [*8] medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine.

> n7 The conclusion that "applicant's device is an atypical mouse" appears quite early in the dissenting opinion, *infra*. Of course, whether applicant's hand-held device is enough like a computer mouse to be deemed a "mouse" is really what the debate herein is all about. The dissenting judge has handed us a *non-sequitur* hardly capable of removing the doubt of the majority members.

> n8 It would be misleading to equate the sophisticated computer-applications software supporting applicant's measuring device with "the associated *driver* software" (see dissent, pp. 20 - 21) routinely required for any computer device, including all pointing devices.

Hence, while the word "spinal" alone is merely descriptive of these goods, we find that the word "mouse" is not merely descriptive of this tracking device. Beyond the fact that this device is not technically a mouse, we agree with

applicant that the combined expression, SPINALMOUSE, is somewhat incongruous, and that no purpose or characteristic is readily described by this combined term, either generally or with particularity. [*9] *See In re Shutts*, 217 USPQ 363 (TTAB 1983) [SNO-RAKE not merely descriptive for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs."]; *In re Shop Vac Corp.*, 219 USPQ 470 (TTAB 1983) [WET/DRY BROOM is not merely descriptive of a vacuum cleaner or an electric cleaning appliance of similar appearance]; *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975) [BIASTEEL is suggestive of the character of tires]; and *In re Werner Electric Brake & Clutch Co.*, 154 USPQ 328 (TTAB 1967) [ELECTRO-MODULE not descriptive of goods even though each term, considered separately, was found to describe applicant's goods].

Finally, to the extent that there may be any doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. *See In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) [*10] and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

**DISSENTBY:** HOHEIN

**DISSENT:**

Hohein, Administrative Trademark Judge, dissenting:

I would affirm the refusal to register. It is well settled that a 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, e.g., 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). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a 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 [*11] on or in connection with those goods or services and the possible significance that the 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).

Thus, "whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). In addition, registration must be refused if the mark is merely descriptive of any of the goods or services for which registration is sought. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980) and In re American Society of Clinical Pathologists, Inc., 442 F.2d 1404, 169 USPQ 800, 801 (CCPA 1971).

Applying the above principles to the present case, there is simply no question that the evidence and admissions of record establish that the word "spinal" is merely descriptive of, in particular, applicant's "computer programs and software for operating and measuring the input from [*12] spinal measuring devices" and its "computerized noninvasive scanning devices used to measure the shape and mobility of the spine." While applicant, in light of the specious arguments to the contrary presented in its reply brief, n1 seems to lack the backbone to admit it, the majority properly concedes that the Examining Attorney is correct that the term "spinal" merely describes applicant's goods, stating that it "agree[s] that the word 'spinal,' considered alone, is descriptive of the location of the body on which applicant's tracking device is used and the bodily structure that provides it with a purpose."

n1 Such arguments also effectively undermine whatever credibility might otherwise be given to applicant's arguments in its main brief.

In this case, however, I also agree with the Examining Attorney, and respectfully disagree with the majority, that applicant's computerized noninvasive spinal scanning device, along with the computer programs and software for operating and measuring the input from such a device, in essence constitute a highly specialized type of computer mouse. Moreover, when the words "spinal" and "mouse" are combined to form the designation "SPINALMOUSE," [*13] the

result is a term which merely describes a significant purpose, use or function of such goods within the meaning of the statute.

As the majority notes, the record contains a number of definitions of a what generally constitutes a computer "mouse," and judicial notice may usefully be taken of several additional definitions. n2 Unlike the majority, however, which views the inquiry in this case as being whether applicant's computerized noninvasive spinal scanning device possesses the minimum features necessary to still qualify as an ordinary computer mouse, I find that such a device has enough significant features in common with a generalized computer mouse that, to the sophisticated purchasers and users of applicant's goods, its computerized noninvasive spinal scanning device would be readily understood and regarded as a specialized version of a computer mouse.

n2 For example, The Dictionary of Computer Words (rev. ed. 1995) at 180-81 defines "**mouse** Plural **mice** or **mouses**" in relevant part as (*italics in original*):

> A hand-held, button-activated *input device* that when rolled along a flat surface controls the movement of a *cursor* or *pointer* on a display screen. A mouse largely frees the user from the keyboard. With *menu-driven* applications the user simply points to a command choice and clicks a button on the mouse. With *draw* or *paint programs* the mouse can be used like a pen or brush. Mice are distinguished by the way they work internally and by how they connection to the computer.
>
> A mechanical mouse has a rubber-coated ball on its underside that rotates as you move the mouse. Optical sensors detect the motion and move the screen pointer correspondingly. You can roll the mouse over almost any surface, but using a *mousepad* gives the best results.

Similarly, the Random House Personal Computer Dictionary (2d ed. 1996) at 324 sets forth **"mouse"** as meaning, in pertinent part:

> A device that controls the movement of the cursor or pointer on a display screen. A mouse is a small object you can roll along a hard, flat surface ... Its name is derived from its shape, which looks a bit like a mouse, its connecting wire that one can imagine to be the mouse's tail, and the fact that one must make it scurry along a surface. As you move the mouse, the pointer on the display screen moves in the same direction. Mice contain at least one button and sometimes as many as three, which have different functions depending on what program is running.
>
> Invented ... in 1963, and pioneered ... in the 1970s, the mouse is one of the great breakthroughs in computer ergonomics because it frees the user to a large extent from using the keyboard. In particular, the mouse is important for graphical user interfaces because you can simply point to options and objects and click a mouse button.... The mouse is also useful for graphics programs that allow you to draw pictures by using the mouse like a pen, pencil, or paintbrush.

Such dictionary at 235 also points out that, of the three ways mice connect to a computer, "**cordless mice** aren't physically connected at all. Instead they rely on infrared or radio waves to communicate with the computer." In the IBM Dictionary of Computing (10th ed. 1994) at 441, **"mouse"** is listed as connoting:

> (1) In computer graphics, a hand-held locator operated by moving it on a flat surface. A mouse generally contains a control ball or a pair of wheels... (2) In SAA usage, a device that a user moves on a flat surface to position a pointer on the screen. It allows a user to select a choice or function to be performed or to perform operations on the screen ...

In a similar vein, The Dictionary of Computing & Digital Media (1999) at 202 lists **"mouse"** as signifying:

> An input device for a computer. A mouse rolls on a smooth surface and determines the location of the cursor on the screen. A mouse has one or more buttons, which are used to "click" on icons or hot spots on the screen. The computer interprets these mouse clicks as instructions...

[*14]

In particular, while the Examining Attorney focuses on perhaps the broadest of the definitions of what basically constitutes a computer mouse in arguing that, as set forth in Prentice Hall's Illustrated Dictionary of Computing (3rd ed. 1998) at 442, "the relevant definition of a 'MOUSE' is 'an input device designed to assist in the use of a computer system'," it is still the case that, as persuasively pointed out in his brief (**bold in original**):

> Applicant's goods include ... a computer input device (*i.e.*, a **mouse**) used to measure and characterize different sections of a person's spine (*i.e.*, to take **spinal** measurements and make **spinal** characterizations). According to the brochures, pictures, and user's manual submitted by the applicant, the device is placed on a surface--in this case, on the ... back--and run ... down a person's spine from a start point to a finish point. The person using the "SPINALMOUSE" takes the mouse from its base station and then presses a button to select a measurement mode for the patient's particular standing or seated position. Once that is selected, the mouse is then placed on the spine in the proper starting position and the [*15] user presses the start button found on top of the mouse. The user then runs the mouse along the spinal column until the measurement is finished, at which point the user presses the start button to terminate the measurement. The pair of wheels at the base of the mouse enables the movement of the mouse along the spinal column. The brochure, pictures, and user's manual make readily apparent that a chief device for which the mark "SPINALMOUSE" is used happens to be a specialized medical computer peripheral input device (*i.e.*, a **mouse**) that can be used with a standard personal computer--whether desktop, laptop or otherwise--to take **spinal** measurements. Idiag, *Spinal Mouse Manual* 15-19 (1999) (emphasis added).

Applicant's contention, however, that in terms of cursor movement, its device apparently does not perform any of the defined moving and pointing functions of a typical computer mouse is not dispositive of the issue of mere descriptiveness because applicant's device is an atypical mouse in that it measures and inputs data concerning spinal shape and mobility directly into a computer. This is clearly seen from applicant's advertising literature, which under the heading [*16] "FUNCTION AND DESCRIPTION," states in relevant part that (**bold in original**):

> The computer-assisted SpinalMouse is a newly developed device of medical and therapeutic use **to measure the spine's shape and mobility in the sagittal plane**. The movement is simple, fast, accurate and harmless to the patient.
>
> The handy device is manually guided over the skin of the back along the spinal column; the measuring head follows automatically the sagittal shape. Clinically relevant parameters such **as length, inclination** relative to a vertical line, **sagittal curvature, segmental angles** of the thoracic and lumbar spine and pelvic tilt are registered and shown in an easily understandable drawing.
>
> In comparison to existing methods the SpinalMouse offers many advantages in terms of **accuracy, objectivity**, data presentation, **non-invasiveness, absence of radiation, ease of use** and excellent cost-benefit ratio.

Notwithstanding that, like an ordinary computer mouse, applicant's device is *manually guided* over a surface, applicant further asserts that the operation of its device is distinctly different in that the device, which is guided down a patient's spinal column, is moved [*17] in only one direction. However, while it is plain that, in order to take its measurements and input the data gathered into a computer, applicant's device does indeed, generally speaking, travel down a person's spine, in actuality such a device, like a typical computer mouse, is multi-directional rather than merely unidirectional as claimed by applicant and the majority. Just as an ordinary mouse can move in a variety of directions (up or down, left or right, or a combination thereof) within the planar surface of a mousepad, applicant's device in effect uses the skin covering a person's spinal column as a three-dimensional (down, left or right, in or out, or a combination thereof) n3 mousepad surface as it measures sagittal shape and such relevant spinal parameters as length, inclination to vertical, curvature, segmental angles and pelvic tilt. The measurements so gathered by applicant's device are automatically entered, through the use of applicant's programs and operating software, into a computer. Applicant's user manual at 17 states, for example, that "as you run down the patients [sic] back, the back curve will be generated real-time on the computer screen." Clearly, like an [*18] ordinary computer mouse, such ease of operation assists the user in the use of the computer to provide various data presentations for evaluation.

n3 While applicant's device can also travel in an upward direction, it is designed to provide useful data only when moved downwards. As stated in the user manual at 19:

> Always begin measurement at the upper marker and roll down the back ... The SpinalMouse is not bi-directional. If you try measurements in the opposite direction the data will be meaningless.

Thus, it is fair to say that applicant's device is uni-directional only in the vertical plane; in terms of horizontal and depth measurements, it is clearly multi-directional.

Accordingly, I simply cannot agree with the stated view of the majority, set forth below, that applicant is correct as to there being a "significant difference in function between a computer mouse and its hand-held device," based principally upon the lack of both cursor-pointing capability and user ease of computer interaction:

> All the definitions cited in this record emphasize that a computer mouse is a pointing device designed to assist the computer user in interacting with the computer. By contrast, [*19] applicant's hand-held device is not a pointing device and is not designed to make a computer easier to use. While the sole mission of a computer mouse is to assist one in operating a computer, applicant has designed a high-tech, medical tracking device that relies upon computerized technology to accomplish its mission. As to form and operation, because a mouse is a *relative* pointing device, it is necessarily multi-directional. In its design and operation, applicant's device is strictly uni-directional... While a computer mouse is moved on a flat surface, applicant's device is designed to move down the highly irregular surface of a patient's back along the spine.

As noted earlier, applicant's device is specifically engineered so as to not require a corresponding cursor movement in order for the user to interact with a computer; instead, all the user need do, after selecting a measurement mode, is to start at the top of a patient's spine and move the device down the spinal column, with the measurements so registered being automatically entered into a computer.

The majority, moreover, glosses over the several additional similarities shared by applicant's device and an ordinary [*20] computer mouse, while seizing upon inconsequential dissimilarities. As to those similarities which the majority deems "superficial," I find it significant that in terms of ease of use and interaction with a computer, applicant's device, like a general purpose computer mouse, features a palm-sized case which is gripped in one hand and has two buttons on top which are "clicked" with a forefinger. With respect to the dissimilarities, the majority to its credit does not regard the absence of a cable or "tail" on applicant's device as a notable difference, accurately noting that:

> This tracking device communicates with its base station via a radio link, not a cable. However, while most computer mice still have a "cable" attaching them to the computer terminal ..., a state-of-the-art cordless mouse is in every way still a mouse.

The majority, nonetheless, finds that applicant's device "is not technically a mouse," observing among other things that:

> The computer mouse has a flat bottom. The bottom of applicant's tracking device is arcuate and offset at various points with tracking wheels. The tracking device cannot rest on a flat surface but rather, when not in use, sits in a cradle [*21] in the base station.

To me, however, such distinctions are without a meaningful difference. While an ordinary mouse, which is designed to roll along a flat surface, would typically have a flat bottom, it must be kept in mind that applicant's specialized device has an arcuate bottom, and rests in a cradle when not use, precisely because it is designed to roll along the curves of a

patient's spinal column. Moreover, the fact that applicant's device uses wheels instead of a ball does not, according to most of the pertinent definitions, make it something other than a mouse.

Applicant, in fact, not only finds it necessary in its user manual to distinguish between its "SpinalMouse" device and an ordinary computer mouse, variously referring to the latter (at 14, 15, 21 and 25, respectively) as a "PC-mouse," "computer mouse," "PC Mouse" and "PC mouse," but even refers to its own device as a "mouse". In particular, under the heading "Problems and Solutions," applicant indicates in its user manual at 7 that the possible cause of the program-error message "Leave energy-saving mode - press Marker button twice" is (*emphasis added*): "The SpinalMouse was not used for at least 30 seconds. [*22] The *mouse* is now in energy-saving mode." Likewise, with respect to the program-error message "Movement too fast. Repeat the measurement," applicant on the same page of such manual states that the possible cause thereof is (*emphasis added*): "You exceeded the maximum speed which the *mouse* can handle." These instances not only show that it would be natural for applicant's "SPINALMOUSE" device to be called a mouse, but more significantly that the medically knowledgeable and highly sophisticated purchasers and users of applicant's device would readily understand that such a device, while quite specialized, in essence is nevertheless a type of computer mouse. n4

> n4 Although the majority rightfully chastises applicant for counsel's demonstrably false representation that "it is not stated anywhere in applicant's manual or brochure that applicant's goods are a 'mouse'," and properly takes applicant to task for the misuse of its mark, counsel's characterization (if such can be believed) of applicant's written materials as being "in draft" and "not yet ... distributed to the public" does not alter the fact the applicant's literature plainly evidences that applicant's computerized noninvasive spinal scanning device is a kind of computer mouse and would be so regarded by customers therefor and users thereof.

[*23]

In consequence of the above, I am unable to subscribe to the majority's strained conclusion that:

> On balance, we find this device falls outside the scope of a computer mouse. Certainly, this device could never replicate the critical functionalities of a computer mouse. This device could not be used with a computer that does not have the base station/receiver and applicant's software. Applicant's entire set of goods listed in International Class 9 are useful only to trained medical professionals in the fields of chiropractic medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine.

The finding by the majority that applicant's goods could not duplicate the usual workings of an ordinary computer mouse fails in my view to give sufficient consideration to the fact that, as previously explained, applicant's device is a specialized kind of mouse designed solely for measuring and recording spinal parameters. That such device, as well as applicant's other goods, are therefore of use only to trained professionals in the fields of chiropractic medicine, orthopedics, physical medicine, physiotherapy, rehabilitation, neurology and sports medicine [*24] does not alter the fact that applicant's device in essence is still a kind of mouse. Furthermore, that such a device could not be used with a computer that does not have the requisite base station/receiver and operating software dismisses the very fact, recognized by the majority, that a state-of-the-art cordless mouse--including applicant's device--is still in every way a mouse and that no mouse, whether cordless or linked to a computer by a cable, will function absent the associated driver software required for its operation.

Accordingly, since for all of the above reasons, applicant's computerized noninvasive spinal scanning device, together with the computer programs and software for operating and measuring the input from such a device, basically constitute a highly specialized type of computer mouse, I would find that combining the descriptive terms "spinal" and "mouse" into the designation "SPINALMOUSE" creates a term which immediately describes, without conjecture or speculation, a significant purpose, use or function of such goods. Contrary to the majority's holding, there is nothing in the term "SPINALMOUSE" which, to the highly trained and medically knowledgeable customers [*25] for and users of applicant's goods, is in the least bit incongruous, n5 nor is there anything which is ambiguous or even suggestive of another plausible meaning. No imagination, cogitation or mental gymnastics is required in order for purchasers and users alike to readily understand the merely descriptive significance of such term. Instead, the designation "SPINALMOUSE," especially in light of the manner in which it is chiefly used (*i.e.*, "SpinalMouse"), is merely descriptive of applicant's goods because it conveys forthwith that the purpose, use or function of applicant's computerized noninvasive scanning device and associated software is that of a mouse for measuring the spinal column or, in short, that

such goods are a spinal mouse. See, e.g., In re Abcor Development Corp., supra at 219 (Rich, J., concurring) [term "GASBADGE" held merely descriptive of a device to determine and monitor pollution due to fact that, since "users of language have a universal habit of shortening full names," it is "*inevitable* that a gas monitoring badge will be called a gas badge as the name of the goods to the same extent as gas monitoring badge is the [full] name" of such goods].

n5 What the majority perceives as an incongruity in the mark may more likely be the apparent novelty of the applicant's device itself. However, the fact that spinal shape and mobility have not previously been measured using a computer-assisted noninvasive scanning device in the form of a mouse does not make the designation "SPINALMOUSE" even "somewhat incongruous" as contended by the majority.

[*26]

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawForeign & International ProtectionsGeneral OverviewTrademark LawProtection of RightsRegistration-Principal RegisterTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGeneral Overview

Decision: The refusal to register is reversed.

Picture, no caption

# EXHIBIT M

LEXSEE 2006 TTAB LEXIS 178

In re TelechaT Network, Inc.

Serial No. 76535248

Trademark Trial and Appeal Board

2006 TTAB LEXIS 178

May 11, 2006, Decided

[*1]

Before Quinn, Drost, and Zervas, Administrative Trademark Judges.

**COUNSEL:**

Robert J. Schapp, Esq. for TelechaT Network, Inc.

Melvin T. Axilbund, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

**OPINIONBY:** DROST

**OPINION:**

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Drost, Administrative Trademark Judge:

On July 24, 2003, applicant TelechaT Network, Inc. applied to register the mark shown below on the Principal Register for services identified as "telephone and on-line dating service allowing participants to select, obtain and provide information and communicate with potential companions" in Class 45.

[SEE ILLUSTRATION IN ORIGINAL]

The application (Serial No. 76535248) contains a disclaimer of the term "network" and an allegation of a date of first use anywhere and a date of first use in commerce of September 1996.

The examining attorney n1 refused to register applicant's mark because the examining attorney required applicant to disclaim the term TELECHAT inasmuch as the term was held to be merely descriptive of applicant's services. 15 U.S.C. § 1056(a). See also 15 U.S.C. § 1052 [*2] (e)(1). The examining attorney argues (brief at 3) that:

>FTNT>

n1 The current examining attorney was not the original examining attorney in this case.>ENDFN>

In the application the services are "telephone and on-line dating service[s] allowing participants to select, obtain and provide information, and communicate with potential companions." In part, therefore, applicant's service allows "participants to . . . communicate with potential companions." Since this is what TELECHAT signifies, the requirement that it be disclaimed is proper.

In response, applicant argues (brief at 8):

Applicant is not a telephone company, nor does applicant offer any other communication technology.

Therefore, the relevant public would not commonly understand the word TELECHAT as relating to dating services. In fact, based upon the actual definition of the prefix TELE and the word CHAT, it is far more likely that the relevant public would assume the word to be related to instant messaging. As such, the Examining Attorney has failed to show that the word is generic, or a compound word, because the word fails to meet the test as articulated in the Examiner's own Manual.

After the examining [*3] attorney made the refusal final, applicant appealed to this board. n2

>FTNT>

n2 We note that on April 18, 2006, Registration No. 3,081,158 issued to applicant for the following mark on the Principal Register for the identical services:

[SEE ILLUSTRATION IN ORIGINAL]

There is no disclaimer in that registration.>ENDFN>

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). n3 Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which [*4] registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

>FTNT>

n3 Obviously, applicant's argument that its mark is not generic and that the examining attorney did not show by clear evidence that its mark was generic is not relevant to the descriptiveness issue in this case.>ENDFN>

We begin our analysis by looking at the evidence of record in this case. This evidence includes the following definitions:

Tele -- 1. Distance; distant: *telesthesia.*

2. a. Telegraph; telephone: *telegram.*

b. Television: *telecast.*

Chat -- To converse in an easy, familiar manner; talk lightly and casually n4

>FTNT>

n4 The evidence also includes a definition of "network" and evidence supporting the descriptiveness of "network." Applicant has now disclaimed that term in this application.>ENDFN>

The examining attorney also included several printouts from an automated database and the Internet that involve the term "Telechat."

ACC May Put Off Vote Our esteemed academics -- The Negotiating Nine -- reportedly are scheduled for another telechat this morning. They will debate. They will deliberate. [*5] They will not ask how each other's chemistry departments are doing.
*Richmond Times Dispatch*, June 18, 2003.

My Britney Problem -- And Yours Her telechat unwittingly displayed her shallow knowledge of the musical traditions she references, but she may be completely aware of the how to use sex as a sales tool.
*Salon.com*, December 3, 2001.

E-Help Yourself The company will provide telechat (real time chat) support.
*ASAP*, March 1, 2000.

This discussion was conducted by international conference call with 180 other people, with the help of a firm that specializes in largescale, hassle-free telechat.
*Newsweek*, May 24, 1993. n5

>FTNT>

n5 There are also a few isolated references on website use guidelines that use the term "telechat.">ENDFN>

The remainder of the evidence consists of newswire reports and Internet and electronic database articles from publications in countries such as Canada, Israel, and Australia. While the board no longer excludes evidence that consists of wire service excerpts and foreign publications, they are not entitled to as much weight as United States publications.

> This Board would be blind if it did not recognize that during the past [*6] fifteen years, there has been a dramatic change in the way Americans receive their news. In the 1980's personal computers were in their infancy as was the transmission of news stories via the Internet. Put quite simply, we believe that communications have changed dramatically during the past fifteen years such that by now it is by no means uncommon for even ordinary consumers (much less sophisticated doctors and researchers) to receive news not only via tangible newspapers and magazines, but also electronically through personal computers. Thus, it is much more likely that newswire stories will reach the public because they can be picked up and "broadcast" on the Internet. In short, while we are not saying that newswire stories are of the same probative value as are stories appearing in magazines and newspapers, we think that the situation has changed such that said newswire stories have decidedly more probative value than they did when this Board decided the Professional Tennis Council and Appetito Provisions cases.

In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1798 (TTAB 2003).

In another case, the board discussed the change in the traditional [*7] method of considering foreign publications.

> It is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely available to these same professionals and to the general public in the United States. Particularly in the case before us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin.

In re Remacle, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002)

In this case, we do not think that potential users of applicant's telephone and online dating services are as likely to refer to foreign publications and newswire services and, therefore, the significance of the term in Israel, Australia, and even Canada, is less significant in helping us arrive at a conclusion as to the descriptiveness of the term in the United States. n6

>FTNT>

n6 We add that the examining attorney did include two similar references from websites for radio stations that use the same phrase: "proud to be a member of the telechat network." This phrase is equivocal because it is not

in proper trademark style but it appears to identify a single source. We note that applicant's specimen indicates that its services are marketed through radio stations.>ENDFN>

[*8]

We now look at the evidence in light of the mark that applicant seeks to register, TELECHAT NETWORK and design. The examining attorney maintains that "applicant's service allows participants to . . . communicate with potential companions.' Since this is what TELECHAT signifies, the requirement that it be disclaimed is proper." The problem we have with this case is that it has been well more than one hundred years since Alexander Graham Bell invented the telephone and the Internet is no longer a novelty. There has been a significant length of time for people to "communicate with potential companions" by telephone or the Internet. Nevertheless, there is little evidence that consumers would understand that the examining attorney's suggested meaning is the one that will immediately come to mind when these consumers encounter the term. This is likely the case because of the nebulous nature of the term "Telechat." While consumers may understand that the term can mean using a telephone to converse in an easy, familiar manner with potential companions, it is not at all clear that consumers will draw this conclusion. See In re Sundown Technology Inc., 1 USPQ2d 1927, 1928 (TTAB 1986) [*9] ("We find that GOVERNOR' applied to applicant's [controls used to affect, compress, limit and shape the sound from the output stage of an electrical musical amplifier] is nebulous in meaning"); In re WSI Corporation, 1 USPQ2d 1570, 1572 (TTAB 1986) ("No doubt the SAT element [in SUPERSAT] would suggest satellite involvement to many but the nature of such involvement would not be at all clear, without imagination, perception or reflection on the part of potential customers"); In re Harrington, 219 USPQ 854, 856 (TTAB 1983) (COLLEGE ACADEMY "is at most suggestive of special summer learning programs for gifted and talented children in grades 4 to 8"). Similarly, it is not apparent that the examining attorney's interpretation of the mark will immediately come to mind when prospective purchasers encounter the term TELECHAT used in association with applicant's services. In re The Rank Organization Limited, 222 USPQ 324, 326 (TTAB 1984) (The "fact that the term LASER' is capable of being analyzed does not render the term merely descriptive"). See also Remacle, 66 USPQ2d at 1224 [*10] ("It is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork"). When the terms are combined, they create a term that appears nebulous and non-specific.

Because we have doubts as to whether applicant's mark is merely descriptive, we resolve those doubts, as we are required to do, in applicant's favor. In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"). See also Remacle, 66 USPQ2d at 1224.

**Legal Topics:**

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawSubject MatterGrades & Styles

Decision: The refusal to register applicant's mark without a disclaimer of the term "Telechat" is reversed.

Illustration 1, no caption; Illustration 2, no caption