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

Proceeding	85134539
Applicant	Future Ads LLC
Applied for Mark	ARCADEWEB
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II. INTRODUCTION

Applicant Future Ads LLC has appealed the Examining Attorney's final refusal to register the mark the ARCADEWEB & design for "dissemination of advertising for others via the internet and via downloadable computer games; promoting the goods and services of others by means of downloadable computer games and via electronic transmission of advertisements over the internet; promoting the goods and services of others by attracting, referring, and analyzing consumer traffic to the online promotions and incentive award programs of others; promoting the goods and services of others by providing gaming websites to generate consumer traffic for others; referral services in the field of online marketing" in International Class 35.

Pursuant to 15 U.S.C. § 1056(a), Examining Attorney required Applicant to submit a disclaimer of "ARCADEWEB" on the grounds that the wording allegedly "identifies a feature of the applicant's services, namely, promoting arcade games via the web or Internet." However, the Examining Attorney appears to have disregarded the specific scope of Applicant's recitation of services in comparing the services to the mark. On the present record, the mark cannot be characterized as merely descriptive of the services. Further, the Examining Attorney has offered insufficient evidence to support a finding of descriptiveness of a feature or any other aspect of the services. For all these reasons, the final refusal should be reversed.

III. PROSECUTION HISTORY

Applicant filed the present application on September 21, 2010. The mark appears as follows:



The Examining Attorney sent a non-final Office Action on January 11, 2011, requiring the Applicant to disclaim the term “ARCADEWEB” on the grounds that it allegedly identifies a feature of Applicant’s services—without adducing any evidence that the combined term “ARCADEWEB” describes anything, much less Applicant’s particular services. On July 8, 2011, Applicant responded to the Office Action, arguing that disclaimer of the term “ARCADEWEB” was not necessary on the grounds that the wording failed to specify any feature of Applicant’s services. Applicant also disclaimed any exclusive right to use “WEB” apart from the mark as applied for.

In a Final Office Action sent August 9, 2011, the Examining Attorney stated that the disclaimer of “WEB” is unacceptable. The Examining Attorney maintained the requirement that the term “ARCADEWEB” be disclaimed. On September 6, 2011, Applicant filed a timely Notice of Appeal.

IV. ARGUMENT

A. The Examining Attorney has failed to give proper weight to Applicant’s goods and services in judging descriptiveness

The Examining Attorney’s actions basically allege that “ARCADEWEB” identifies a feature of applicant’s services, and that “promoting arcade games via the web or Internet” allegedly is a feature of applicant’s services. Although there is no evidence of record that “ARCADEWEB” describes *anything* on the Internet or elsewhere, the Examining Attorney has improperly recharacterized the goods and services for which Applicant is seeking registration to support the requirement of a disclaimer. Applicant is not seeking registration for “promoting arcade games” and the Examining Attorney has proffered no evidence to support that theory. Instead, the services listed are directed to:

1. Dissemination of advertising for others;
2. Promoting the goods and services of others;

3. Analyzing consumer traffic to the online promotions and incentive award program of others;
4. Generating consumer traffic for others; and
5. Referral services.

Downloadable computer games and gaming websites are used in the goods and services description only to identify the means by which some of these services are provided.

Downloadable computer games and gaming websites are not listed as a good or service for which Applicant seeks registration. Because there is no evidence that "ARCADEWEB" merely describes any of the above-listed services, the Examining Attorney must be reversed.

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Applied to the present application, the rule of *Omaha National* compels reversal of the disclaimer requirement.

Applicant is in the business of marketing and promotion, and running advertising services for others, as stated in the Response to Office Action dated July 8, 2011. These are also the services for which registration is sought. By requiring a disclaimer of the wording "ARCADEWEB," the Examining Attorney appears to have ignored the true goods and services for which registration is sought, and has also ignored the context in which the mark is used and is intended to be used.

Applicant's conclusion is further supported by the Board's decision in *In re Bills.com, Inc.*, Ser. No. 75/700,831 (TTAB August 1, 2001). The Applicants in *Bills.com* offered online bill paying services, and sought registration for the mark BILLS.COM for "dissemination of

advertising for others via an on-line electronic communications network" in International Class 35. The Examining Attorney had refused registration of the mark, arguing that the asserted mark merely described a characteristic or feature of applicant's services. The Board reversed based on *Omaha National*. Because the Office Actions are not based on the actual services for which registration is sought, the Examining Attorney must be reversed.

B. Applicant's Use of "ARCADEWEB" Is Not Merely Descriptive of Even the Means by Which the Applicant Provides the Services for which Registration Is Sought

Moreover, "ARCADEWEB" is not merely descriptive of anything. For a term to be merely descriptive, it must immediately convey knowledge of a significant quality, characteristic, function, feature or purpose of the goods. *See In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987). A mark cannot be descriptive if it requires a multi-stage reasoning process to establish a connection between the mark and services, from the standpoint of the prospective consumer of the services. *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984). Yet here, the term "ARCADEWEB" does not immediately bring to mind any particular product, service, or means of providing a product or service. There is no evidence that any relevant consumer would recognize an "ARCADEWEB" as any particular thing.

Although the Examining Attorney asserts that the mark should not be dissected, even consideration of the terms "arcade" and "web" separately fails to indicate that the mark is merely descriptive. "Web" is well understood as an electronic document display and distribution facility of the internet. The Merriam-Webster Dictionary, available at <http://www.merriam-webster.com/dictionary/arcade>, defines "Arcade" as:

1. a long arched building or gallery
2. an arched covered passageway or avenue (as between shops)
3. a series of arches with their columns or piers
4. an amusement center having coin-operated games

None of these definitions describe the services for which registration is sought. Even the last-listed definition—an “amusement center having coin-operated games”—is not at all related to Applicant’s services of disseminating advertising for others, promoting the goods and services of others, analyzing consumer traffic to the online promotions and incentive award programs of others, generating consumer traffic for others, and referral services. Even if one considers the means by which Applicant provides its services, the only definition even related to “downloadable computer games” or “gaming websites” is listed last. Applicant does not provide services by means of coin-operated games that reside in an amusement center. Instead, applicant provides its services by means of computer games that can be downloaded or games that can be played online at a website. The term arcade is, at best, suggestive of the means by which Applicant provides its services.

Furthermore, the USPTO has granted registration to a numerous marks containing the term “Arcade” in the context of electronic and computer games. For example, the mark ARCADE POKER was allowed registration for the goods and services of “computer game program,” and the mark VIRTUAL ARCADE was granted registration for the goods and services of “virtual reality game software.” If these marks are suggestive, surely ARCADEWEB also is.

If any evidence or arguments raise doubts about the merely descriptive character of applicant’s mark, such doubts are to be resolved in applicant’s favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. *See e.g., In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). For at least this reason, the refusal to register should be reversed.

C. The Examining Attorney Has Provided No Evidence in Support of the Allegation that the Term ARCADEWEB Identifies a Feature of Applicant's Services

If an Examining Attorney refuses registration on the grounds that a mark is merely descriptive, the Examining Attorney is required to support the refusal with appropriate evidence. *TMEP 1209.02*. In both the Non-Final Office Action and the Final Office Action, the Examining Attorney merely states, without supporting evidence, that “ARCADEWEB” identifies a feature of applicant’s services. The only other comment related to the issue is a mischaracterization of Applicant’s services as “promoting arcade games via the web or Internet.” The Examining Attorney has failed to provide any evidence in support of the allegation of descriptiveness—and on appeal no new evidence may be introduced.

Of course, in common parlance there is no thing known as “an arcadeweb.” Moreover, if the Examining Attorney had introduced evidence about the meaning of the separate terms “arcade” and “web”, that evidence would be immaterial for the reasons given above, and because the Examining Attorney has already insisted that the mark cannot be dissected into independent terms.

Thus, the Examining Attorney has failed to carry the burden of showing that the mark ARCADEWEB is descriptive of the relevant goods and services. On the present record, the final refusal and the disclaimer requirement must be reversed.

V. CONCLUSION

The term ARCADEWEB is not descriptive of the goods or services provided by Applicant. The Examining Attorney has failed to provide any evidence to the contrary. The disclaimer requirement and refusal to register are unsupported.

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