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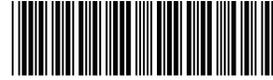
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85134539

MARK: ARCADEWEB



CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

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SAN JOSE, CA 95110-1083

TTAB INFORMATION:
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Future Ads LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
60227-0026

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the Examining Attorney's final refusal to register the applicant's stylized mark ARCADEWEB 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." Registration was refused because the applicant failed to

disclaim the required wording “arcadeweb” apart from the mark shown pursuant to Trademark Act Section, 15 U.S.C. Section 1056, TMEP Sections 1213 and 1213.02(a).

FACTS AND PROCEEDINGS

On September 24, 2010, the applicant applied for registration on the Principal Register the mark



under Trademark Section 1(b) filing basis for “dissemination of advertising for others within online computer games, promoting the goods and services of others by means of online 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, or promoting the goods and services of others by providing gaming websites to generate consumer traffic for others,” in International Class 35.

On January 11, 2011, an Office Action was issued requiring the applicant to amend the identification of services, claim ownership of prior registration (U.S. Registration No. 3881836), and disclaim the wording “arcadeweb” apart from the mark as shown. The applicant responded on July 8, 2011, amending the identification of services to

“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,” and claiming ownership of U.S. Registration No. 3881836. However, the applicant failed to disclaim the wording “arcadeweb” but instead entered a disclaimer of “web.” Subsequently, a final refusal was issued on August 9, 2011.

The applicant submitted its Notice of Appeal on September 6, 2011 and brief on November 7, 2011. This is the Examining Attorney’s Appeal Brief.

ISSUE ON APPEAL

Whether the word “arcadeweb” describes a feature, characteristic, purpose, function, an ingredient or the intended audience of the applicant’s services, and must be disclaimed apart from the mark shown prior to registration on the Principal Register, pursuant to 15 U.S.C. §§1052(e)(1), 1056(a); TMEP §§1213, 1213.03(a).

JUDICIAL NOTICE

The Examining Attorney respectfully requests that the Trademark Trial and Appeal Board (hereinafter, "Board") take judicial notice of the following dictionary evidence:

<http://www.merriam-webster.com/dictionary/arcade;>

<http://www.yourdictionary.com/arcade> (taken from Webster's New World College Dictionary);

<http://dictionary.cambridge.org/dictionary/american-english/arcade;>

<http://www.merriam-webster.com/dictionary/web;> and

<http://www.yourdictionary.com/web> (taken from Webster's New World College Dictionary

"Judicial notice" refers to a court or adjudicating body's authority to accept as evidence well-known and indisputable facts for the purpose of convenience and without requiring a party's proof. *Black's Law Dictionary* 923 (9th ed. 2009). The Trademark Trial and Appeal Board can take judicial notice of definitions obtained from dictionaries in printed format. TBMP §1208.04; *see* Fed. R. Evid. 201; 37 C.F.R. §2.122(a). In addition, the Board can also take judicial notice of online dictionaries available in printed format or online dictionaries that are readily available and capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); TMEP §710.01(c).

ARGUMENT

It is the examining attorney's position that the terms "arcade" and "web" merely describes a feature of the applicant's services 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." The term "arcade" is defined as "an amusement center having coin-operated games" or "an area where there are many electronic or other coin-operated games for the public." See <http://www.merriam-webster.com/dictionary/arcade> and <http://dictionary.cambridge.org/dictionary/american-english/arcade>. The term "web" is defined as "world wide web" or "the Internet." See <http://www.merriam-webster.com/dictionary/web> and <http://www.yourdictionary.com/web>. The applicant states that it "provides its service by means of computer games that can be downloaded or games that can be played online at a website." Essentially, the applicant promotes the goods and services of others by operating an online arcade web site. The applicant provides its advertising and promotional services through an *arcade* on the *web*, such that it disseminates advertising and promotes goods and services of others by means of arcade games on the web. Although the applicant argues that this is only suggestive, instead it clearly describes a feature of the identified services.

Moreover, the applicant's prior registration supports the finding that the mark "arcadeweb" is descriptive in relation to the services. The applicant claims ownership of U.S. Registration No. 3881836 for ARCADEWEB (standard character), registered on the Supplemental Register. If a mark has been refused registration on the Principal Register, the applicant may seek registration on the Supplemental Register. See 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. In *Perma Ceram Enterprises Inc. v. Preco Industries, Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992), the Board stated that "the general rule has not changed, however, that a registrant owner of a Supplemental Register registration impliedly admits that the registered term was descriptive (or deceptively misdescriptive) at least at the time of the registrant's first use of the term. 1 J. T. McCarthy, *Trademarks and Unfair Competition*, Section 19:8F (2d ed. 1984). See also: Richard L. Kirkpatrick, *The Supplemental Register Under The Trademark Law Revision Act: Additions, Deletions and Omissions*, 79 TMR 248, 251-52 (1989)." Therefore, it is reasonable to conclude that the applicant's registration of the mark ARCADEWEB on the Supplemental Register is an implied admission that term is descriptive. And, as such it follows that the term is also descriptive in the present case, and the requirement to disclaim the wording apart from the mark is with merit.

CONCLUSION

For the foregoing reasons and authorities, the examining attorney submits that the wording ARCADEWEB is descriptive with respect to the recited services, thereby requiring a disclaimer of such component apart from the proposed mark as shown, should be affirmed.

Respectfully submitted,

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- arcade (noun)
- arcade game (noun)
- intersecting arcade (noun)

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ar·cade *noun* \är-ˈkād\

Definition of ARCADE

- 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
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Origin of ARCADE
French, from Italian arcata, from arco arch, from Latin

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French, from Italian arcata, from arco arch, from Latin arcus
 First Known Use: 1725

Other Architecture Terms
 buttress, casita, cornice, fanlight, garret, lintel, parapet, pilaster, plinth

Rhymes with ARCADE
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arcade

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PHONETIC

1. a passage having an arched roof
2. any covered passageway, esp. one with shops along the sides
3.
 - a. penny arcade
 - b. a place somewhat like a penny arcade, containing coin-operated video games
4. ARCHIT.
 - a. a line of arches and their supporting columns
 - b. an arched building

transitive verb **arcaded, arcading**
to make into or provide with an arcade

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