Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA654693**

Filing date: **02/09/2015**

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

Proceeding	85919183
Applicant	Cooperative Educational Service Agency N
Applied for Mark	CURRICULUM4SCHOOLS
Correspondence Address	JOSEPH S HEINO DAVIS & KUELTHAU SC 111 EAST KILBOURN AVENUE, SUITE 1400 MILWAUKEE, WI 53202-6613 UNITED STATES jheino@dkattorneys.com, pbergin@dkattorneys.com
Submission	Reply Brief
Attachments	Applicant's Reply Brief (12063311).pdf(174881 bytes)
Filer's Name	Joseph S. Heino
Filer's e-mail	jheino@dkattorneys.com
Signature	/Joseph S. Heino/
Date	02/09/2015

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

In re Application of Cooperative Educational Service Agency No. 6 Serial No. 85/919,183 Filed: April 30, 2013 Trademark: CURRICULUM4SCHOOLS	Law Office 102 Trademark Attorney: Dominic J. Ferraiuolo, Esq.

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S REPLY BRIEF
UNDER TBMP § 1203.02(c)

Introduction

Applicant respectfully submits that the Examining Attorney's Appeal Brief, in and of itself, demonstrates that there is at least some doubt as to whether the Applicant's Mark is merely descriptive of Applicant's goods. In reaching the Examining Attorney's conclusion that, "[B]ased on the record as a whole, it is entirely fair to state that applicant's goods are in fact curriculum software." Examining Attorney's Brief at page 3. Applicant respectfully submits that this statement requires substantially more than looking at Applicant's composite mark and the identification of goods, which identifier has been accepted by the Examining Attorney without requiring any disclaimer of any component of the composite mark.

The great variation in facts from case to case [in Sec. 2(e)1 refusal to register cases] prevents the formulation of specific rules for specific fact situations. Each case must be decided

on its own merits. See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977); and TMEP § 1209.01(b).

In this case, the Examining Attorney has summarily dismissed the probative value of certain registrations cited by the Applicant in its Request for Reconsideration. More significantly, however, the Examining Attorney states that "Applicant does not argue that the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise non-descriptive (sic) meaning in relation to the goods." Further, Applicant's substitute specimen was rejected.

Applicant addresses each points below.

Applicant Effectively Argued that Its Mark is Unique When Applicant Also Argued that Its Mark was Improperly Dissected

The Applicant's CURRICULUM4SCHOOLS mark is, without question, a composite mark. There is no challenge from the Examining Attorney on that point. The composite mark is "unique" because it includes several run-on words combined with the number "4" interposed between two of those words. That is the mark – CURRICULUM4SCHOOLS, not CURRICULUM FOR SCHOOLS. Further, no disclaimers for any of the words were requested at any time during the substantive prosecution of this composite mark.

Therefore, to conclude that CURRICULUM4SCHOOLS immediately conveys the Applicant's goods, i.e. "*Computer software that provides web-based access to applications and services through a web operating system or portal interface,*" a consumer would necessarily need to engage in a multistage reasoning process whereby the same consumer realizes that the CURRICULUM portion and/or the SCHOOLS portion of the mark refer, individually and collectively, to computer software – and not just to computer software, but to curriculum software as stated at the outset of this Reply. This methodical analysis does not meet the "immediate" conveyance test because neither of the words mentioned above, individually or

collectively, has any computer connotation to it (again, a fact borne out by the absence of any disclaimer in this case, which one would expect if the immediate conveyance test was met) and because the composite mark is unique.

If, when the goods or services are encountered under the mark, a multistage 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, the mark is suggestive. See, e.g., *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). In this case, because a multistage reasoning process must be applied to determine the attributes that are indicated by the mark, the mark is suggestive. As such, the Examining Attorney has not met his burden of establishing that the mark is merely descriptive of computer software.

Summary Dismissal of Applicant's Evidence of Record is Improper

There are any number of "4-something" marks that have not been deemed descriptive, including many in Int'l Class 9, which is the same class in which the Applicant's CURRICULUM4SCHOOLS mark is applied for. Applicant's mark should not be treated differently than currently existing registrations. Applicant supplied such list in its February 7, 2014 Response to Office Action and in its September 18, 2014 Request for Reconsideration. Indeed, a total of 35 such marks were cited by Applicant. The Applicant requests that the Board review that list relative to the "merely descriptive" refusal to register position taken by the Examining Attorney in this case, which evidence was summarily dismissed in the final Office Action.

The Refusal of Applicant's Substitute Specimen is Improper

In the Examining Attorney's Brief, at page 5, he asserts that "the specimen consists of a web page that does not include the means for ordering the goods." Applicant respectfully directs the Board's attention to pages 4 and 5 of the Applicant's substitute specimen which provide the

Applicant's address, e-mail address, phone number, toll free number and fax number, any one of which can be used for contacting the Applicant for the purpose of ordering the goods.

Conclusion

Inasmuch as all doubts with respect to the descriptiveness/suggestiveness issue are to be resolved in favor of the applicant, *In re Bel Paese Sales Co.,* 1 U.S.P.Q.2d 1233 at 1236, 1986 WL 83304 (T.T.A.B. 1986), the refusal to register Applicant's Mark should be withdrawn, the substitute specimen accepted and the application passed to publication.

Respectfully submitted,
Cooperative Educational Service Agency No. 6
By Its Attorneys

Dated: February 9, 2015

Joseph S. Heino
Patrick M. Bergin
Davis & Kuelthau, s.c.
111 East Kilbourn Avenue, Suite 1400
Milwaukee, WI 53202
414.225.1452
414.278.3652
jheino@dkattorneys.com
pbergin@dkattorneys.com

N:\DOCS\06300\79513\12063062