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Subject: U.S. TRADEMARK APPLICATION NO. 85919183 - CURRICULUM4SCHOOLS - 06300.79513 -  
EXAMINER BRIEF

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## UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<b>U.S. APPLICATION SERIAL NO.</b> 85919183  <b>MARK:</b> CURRICULUM4SCHOOLS	
<b>CORRESPONDENT ADDRESS:</b> JOSEPH S HEINO  DAVIS & KUELTHAU SC  111 EAST KILBOURN AVENUE SUITE 1400  MILWAUKEE, WI 53202-6613	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> Cooperative Educational Service Agency N ETC.	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  06300.79513  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  jheino@dkattorneys.com	

### EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Cooperative Educational Service Agency N, appeals the examining attorney's refusal to register the applied-for mark CURRICULUM4SCHOOLS in standard characters for "Computer software that provides web-based access to applications and services through a web

operating system or portal interface” on the Principal Register on the grounds that the mark is merely descriptive of the identified services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) and the examining attorney’s refusal to register the applied-for mark because the specimen does not show the applied-for mark in use in commerce as a trademark under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a).

#### STATEMENT OF FACTS

Applicant applied to register the proposed compound word mark CURRICULUM4SCHOOLS in standard characters for “Computer software that provides web-based access to applications and services through a web operating system or portal interface”, and the examining attorney refused registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) because the evidence shows that the proposed mark is merely descriptive of the identified goods, and refused registration because the specimen does not show the applied-for mark in use in commerce as a trademark under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), as a web catalog or web page specimen that is not acceptable as a display associated with the goods because it fails to include the means for ordering the goods and thus, appears to be mere advertising material. In response, the applicant argued and presented evidence that the mark as a whole is not merely descriptive of the goods and is capable of registration on the Principal Register and a copy of printed advertising materials describing the goods as a substitute specimen of use of the mark in commerce. However, the examining attorney found the arguments and evidence unpersuasive and issued a final refusal on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) because the proposed mark as shown by the record is merely descriptive of the identified goods, and a final refusal of registration for failure to provide an acceptable specimen of use of the mark in commerce under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), on the grounds that the substitute specimen is only advertising material for the goods.

The applicant submitted a Request for Reconsideration of the descriptiveness refusal and the refusal of registration based on failure to provide an acceptable specimen of use of the mark in commerce. The applicant did not provide any new facts, reasons or evidence to overcome the refusal based on

descriptiveness, and the substitute specimen provided was found unacceptable to show use of the mark in commerce on the goods. Therefore, the Request for Reconsideration was denied and the applicant filed a notice of appeal and appeal brief.

## ARGUMENT

### THE MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES A PURPOSE, FEATURE FUNCTION AND USE OF THE GOODS

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)). The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Here, the applied-for mark CURRICULUM4SCHOOLS in standard characters for "Computer software that provides web-based access to applications and services through a web operating system or portal interface" merely describes software for in managing, mapping, accessing and working on curriculum for schools. The specimens provided with the application, although unacceptable for the reasons stated below, identify and describe that the goods are promoted as an affordable, state-of-the-art curriculum management system that teachers and administrators can use to access and enhance curriculum content on the web from any location, for curriculum mapping and is used to map curriculum for schools district-wide.

Applicant argues that the “notion of a curriculum is not limited to digital media or a software rendition of a curriculum and that a curriculum can evoke a wide variety of notions including the aggregate of courses of study given in a school, college, university.” The examining attorney does not disagree with applicant on the concept that a “curriculum” can be in digital form, for example, as in applicant’s own software. However the examining attorney disagrees with applicant’s statement that “the word “curriculum” is a rather amorphous term having an almost limitless number of meanings in its own right.”

Applicant’s arguments as to the meaning of the wording “curriculum” as too nebulous or amorphous to be merely descriptive in the instant case are made in the abstract, and not in relation to the goods. The specimens filed with the application clearly show that the term “curriculum” is in fact merely descriptive of a purpose, feature, function and use of the goods. The goods are identified as “Computer software that provides web-based access to applications and services through a web operating system or portal interface” and these goods in fact provide the curriculum functions, features, uses and purposes as stated above.

Applicant claims that the fact that “the Examining Attorney had to resort to reference to the Applicant’s specimens to derive a specific meaning is a tacit admission that even the Examining Attorney was not quite sure what the goods meant in view of the name given to the software which is the subject of the mark.” However, this is not accurate. The specimens as provided are the clear proof of the meaning of the use of the wording “curriculum” as it appears in the applied-for mark as merely descriptive of a purpose, function, use or feature of the goods as stated above, namely to describe a state-of-the-art curriculum management system that teachers and administrators can use to access and enhance curriculum content on the web from any location, for curriculum mapping and is used to map curriculum for schools district-wide. In fact, based on the record as a whole, it is entirely fair to state that applicant’s goods are in fact curriculum software.

It is highly likely that based on the specimens and evidence of record that the intended users and purchasers of the goods, namely teachers and school administrators, would immediately understand

that the class, category or type of software is curriculum software for schools. The examining attorney agrees with applicant that “descriptiveness must be adjudged from the standpoint of the ordinary prospective purchaser.” In this case, the users and purchasers of the goods are in fact teachers and school administrators as shown in the specimens and materials describing the goods provided by applicant. It further appears highly likely that such users and purchasers of the goods, namely teachers and school administrators will immediately realize the basic of general purpose, use, function and feature of the goods, namely curriculum for schools.

Applicant argues that the mark CURRICULUM4SCHOOLS is composed of “CURRICULUM,” “4” and “SCHOOLS”, terms of art in the English language that whether or not they have precise connotations, together they do not immediately describe with particularity the goods (again, we are speaking of computer software programs), and the terms are therefore suggestive.” Again, these arguments are made in the abstract as if the goods are merely computer software programs and that because of that one fact, the applied-for mark is not merely descriptive of a purpose, feature, function or use of the goods.

Applicant argues that the meaning of the terms “CURRICULUM” and “SCHOOLS” are “general enough that an ordinary consumer would not generate the immediate and direct idea of the nature of the goods which is necessary to cast the mark as merely descriptive.” However, that is clearly not the case. The specimens show the goods are in fact curriculum software for use by schools personnel. In addition, the examining attorney made of record on page 2 of the office action dated August 7, 2013 a dictionary definition the wording “for” from [www.merriam-webster.com/dictionary](http://www.merriam-webster.com/dictionary) that shows its meaning is “used as a function word to indicate purpose.”

The meaning of the mark as a whole as shown in compound word form, namely “CURRICULUM4SCHOOLS” is therefore “CURRICULUM FOR SCHOOLS.” A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding URBANHOUSING, in standard

character form, would be perceived by consumers as the equivalent of the descriptive term URBAN HOUSING, rather than as including the separate word ZING). Here, the numerical “4” appearing in the applied-for mark is the phonetic equivalent of the merely descriptive term “for” that as it appears in the mark identifies a purpose or function of applicant’s curriculum software, namely “curriculum for schools.”

Applicant presents a number of third-party registrations to support its arguments that the number “4” is not merely descriptive as it appears the applied-for mark. However, the third-party registrations relied upon by applicant show that the numerical “4” appearing in these marks is used to mean the function word “for”, as it does in the applicant’s mark. Contrary to the third-party registrations relied upon, viewed as a whole the wording comprising the applied-for mark is merely descriptive of a purpose, feature, function and use of the goods, namely curriculum for schools and is highly likely to be immediately perceived as identifying such purpose, function, feature and use by users and purchasers of the goods.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (holding BATTLECAM merely descriptive of computer game software with a feature that involve battles and provides the player with the option to utilize various views of the battlefield). Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. Applicant does not argue that the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods, just that it is suggestive, and the individual terms comprising the mark have no meaning in relation to the goods.

However, in this case, both the individual components and the composite result are descriptive of applicant’s goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, applied-for mark CURRICULUM4SCHOOLS in standard characters for “Computer

software that provides web-based access to applications and services through a web operating system or portal interface” merely describes software for in accessing, mapping, managing and working on curriculum for schools. Therefore, the mark as a whole is merely descriptive of the goods.

## ARGUMENT

### SPECIMEN FAILS TO SHOW USE OF THE MARK IN COMMERCE ON THE GOODS

Registration is refused because the specimen is not acceptable as a display associated with the goods and appears to be mere advertising material; thus, the specimen fails to show the applied-for mark in use in commerce. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a). Specifically, the specimen consists of a web page that does not include the means for ordering the goods. See *In re Sones*, 590 F.3d 1282, 1286-89, 93 USPQ2d 1118, 1122-24 (Fed. Cir. 2009). Without this feature, the specimen is mere advertising material, which is not acceptable as a specimen to show use in commerce for goods. *In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006). Nowhere on any of the specimens provided by applicant is the mark shown on the goods or are the means for ordering the goods directly provided. Therefore, the specimens are mere advertising and fail to show the applied-for mark in use in commerce.

## CONCLUSION

For the foregoing reasons, the refusal to register the applied-for mark on the Principal Register on the grounds that the mark is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) should be affirmed.

Respectfully submitted,

/DominicJFerraiuolo/

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