

ESTTA Tracking number: **ESTTA694072**

Filing date: **09/07/2015**

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

Proceeding	86184669
Applicant	Your Holding BV
Applied for Mark	YOURHOSTING
Correspondence Address	YOUR HOLDING BV CEINTUURBAAN 28 ZWOLLE, 8024AA NETHERLANDS b.carlier@yourhosting.nl, b.carlier@yourhosting.nl
Submission	Appeal Brief
Attachments	TTAB Ex Parte Brief - US Serial 86184669.pdf(118155 bytes )
Filer's Name	Valentijn Borstlap
Filer's e-mail	b.carlier@yourhosting.nl
Signature	/Valentijn Borstlap-1976/
Date	09/07/2015

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

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No.: 86184669  
Trademark: YOURHOSTING  
Applicant: Your Holding BV

EX PARTE APPEAL

APPLICANT'S BRIEF

## *Table of Contents*

<i>Record Description</i> .....	3
A. PROSECUTION HISTORY/EPITOME BACKGROUND .....	3
B. ATTORNEY’S EVIDENCE.....	4
July 16, 2014 Office Action .....	4
December 24, 2014 Final Office Action .....	4
July 10, 2015 Request for Reconsideration denied .....	4
C. OUR (APPLICANT’S) EVIDENCE .....	5
November 26, 2014 Response to Non-Final Office Action.....	5
June 23, 2015 Request for Reconsideration after Final Action .....	5
<i>Argument Section</i> .....	6
A. TO DETERMINE .....	6
B. ARGUMENT.....	6
Rules for refusals on descriptive grounds .....	6
Refusal grounds .....	7
Argument.....	7
C. CONCLUSION .....	10

The Applicant, Your Holding BV, hereby respectfully appeals the Examining Attorney's refusal to register the mark YOURHOSTING in standard characters

## *Record Description*

### **A. PROSECUTION HISTORY/EPITOME BACKGROUND**

The YOURHOSTING application was filed on February 5, 2014 and provisionally refused after fifteen weeks by the examining attorney on May 15, 2014.

The provisional refusal was based on the delivery of a substitute specimen and a foreign registration certificate for the application.

According to the Office Action of July 16, 2014, all requirements raised in her first Office Action were satisfied, but she apologized to raise another ground for refusal that the application merely describes our services.

On November 26, 2015, we filed a Response challenging the assigned trademark attorney's arguments that the application was merely descriptive.

On December 24, 2014, the assigned trademark attorney issued a final refusal and reiterated mainly the arguments of her Office Action of July 16, 2014 and did not really address our main argument against the refusal brought up in our Response from November 26, 2015.

On June 23, 2015, we filed a Request for Reconsideration where we stipulated the same issues as before and stressed the point that the assigned trademark attorney did not address our main argument. Furthermore, we addressed the points made by the assigned trademark attorney by supplying the evidence in the correct form and argued extensively that our application is suggestive and not descriptive.

As before, the assigned trademark attorney did not address our arguments in defense of her refusal but denied our Request for Reconsideration on grounds that we did not supply any new arguments or shed any new light on the issue. There's no essential substantive comment in her refusal.

3

## **B. ATTORNEY'S EVIDENCE**

### **July 16, 2014 Office Action**

The main evidence attached to this Office Action consists of screen dumps from websites from online dictionaries and hosting provider containing dictionary definitions and third-party use. See refers also to the initial office action which would contain these attachments. But as far as we know there isn't any evidence attached to her initial Office Action from May 15, 2014.

The assigned attorney seeks evidence that the wording 'HOSTING' describes all our services and that the composite result of 'YOURHOSTING' is also descriptive because there's evidence to be found according to the attorney in the attachments whereby hosting providers advertise to take over one's hosting by "transfer your hosting" and "your host" to their hosting facilities proving that Yourhosting is a common expression.

### **December 24, 2014 Final Office Action**

The main evidence attached to this Final Office Action consists of two screen dumps from a hosting provider (Hostgator.com) and a Wikipedia definition of the word 'hosting' proving, according to the attorney, that this term describes all our services related to our trademark application 'yourhosting'.

With all due respect, also in this case the assigned attorney does not address our main argument in our first Response that 'hosting' is certainly not a genus definition for all the services we applied for under our application but merely related.

### **July 10, 2015 Request for Reconsideration denied**

As stated before in the last sentence under A. PROSECUTION HISTORY/EPITOME the assigned attorney did not supply any evidence or new reasoning in relation with our substantial argumentation but merely pointed to the her earlier Office Actions. She did not find any new compelling evidence or arguments that would shed new light on the case.

## C. OUR EVIDENCE

### **November 26, 2014 Response to Non-Final Office Action**

In our response to the non-final office action of July 16, 2014 we supplied the assigned attorney with different meanings of the wording 'hosting', and compiled a list (Annexe A) with 102 entries with the word hosting in combination with another term and having a IC Class 42 ( webhosting). We also provided the query we used to query TESS. All applications were accompanied with their US Registration numbers.

Twenty nine entries were singled out from that list that were registered in the Principal register and were basically no different than the term 'Yourhosting' we seek protection for. Both evidence were found inadmissible by the assigned attorney because of the form we represented it in and we corrected that of course in our second response.

We also reasoned that hosting is not a synonym for domain name registrations or telecom services and disclaimed the exclusive right to the use of the term 'hosting'.

### **June 23, 2015 Request for Reconsideration after Final Action**

As mentioned in the above paragraph we supplied the evidence in the admissible form as requested by the attorney and also supplied the credentials of thirteen companies that supplied one or two of the services we seek protection for under our application without the other one(s).

We've also extensively argued that the term 'yourhosting' is suggestive and descriptive. As said before the assigned attorney dismissed our evidence and arguments as irrelevant in relation with the case and did not motivate substantially why she refused our Request for Reconsideration.

## *Argument Section*

### **A. TO DETERMINE**

The issue at hand is for the Trademark Trial and Appeal Board (further indicated as the 'Board') to determine whether the term YOURHOSTING is merely descriptive as related to the purposes of Section 2(e)(1) of the Trade Mark Act, in connection with the services in IC Classes 38, 42 and 45 respectively:

- Providing access to telecommunication networks; information about telecommunication; providing electronic telecommunications connections; telecommunications routing and junction services; providing telecommunications connections to a global computer network; transfer of data by telecommunications; telecommunications by e-mail  
(IC 38, based on intent to use)
  
- Design, creation, hosting, maintenance of websites for others; design, creation, hosting and maintenance of internet sites for third parties; Hosting the software, websites and other computer applications of others on a virtual private server.  
(IC 42, based on intent to use)
  
- Domain name registration services  
(IC 45, based on 44(e) )

6

### **B. ARGUMENT**

#### **Rules for refusals on descriptive grounds**

A mark is merely descriptive if it directly or immediately describes the services or goods in connection with which the mark is used. See the Trademark Manual of Examining Procedure, paragraph 1209.01(b); R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp., 226 U.S.P.Q. 169, 177 (TTAB 1985).

'Merely' as in merely descriptive has been indicated by the Board In re Colonial Stores, 394 F.2d 549, 552 as meaning 'Only'. As such, the outcome whether a trademark is descriptive or not, it is not sufficient to establish if the applied mark is in one way or the other descriptive, but rather if the trademark (the term) directly and immediately conveys the function, use, qualities or characteristics of the goods or services described in the application. To be merely descriptive or to be non-registrable, the mark must do nothing other than immediately convey an understanding of the goods for which registration is sought. See In re Quik-Print Copy Shops, 205 U.S.P.Q. 505 n.7 (C.C.P.A. 1980). So for categorizing a mark as 'merely descriptive' the examining attorney should prove that the mark immediately and directly describes the function, characteristic, use or ingredients of

the services or products in the application and does nothing more.

### **Refusal grounds**

The assigned attorney concludes that the mark YOURHOSTING is merely descriptive because it describes all of its services. The assigned attorney states that the wording “HOSTING” describes our hosting, domain name registration and telecommunication services and the composite result by adding the wording “YOUR” create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services.

### **Argument**

It's our position that the mark YOURHOSTING does not immediately and directly describe the features of the services we supply with our trademark YOURHOSTING. We extensively argued in our Response of November 26, 2014 and repeated this in our Request for Reconsideration that the wording 'hosting' is not a genus definition for the services we supply and is certainly not a synonym for telecom services or domain name registration services. The terms that describe the services we supply to know Telecom services, Domain Name Registration and Hosting are related but not indistinguishable from each other. For the services under the IC Classes 38 and 45 we illustrated our argument by presenting a not citable precedent of your board, an opposition dismissal (TTAB 91116582, application Serial No. 75665164 filed on March 22, 1999, BEAUTY EMPORIUM, INC. versus AQUA DAY SPA, L.L.C.) where your Board concluded:

*“...Our primary reviewing court, the Court of Appeals for the Federal Circuit, has made clear that descriptiveness issues generally cannot be determined on the basis of analogies drawn from terms other than the term that is sought to be registered. See In re Seats, Inc., 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985). See also, Levi Strauss & Co. v. R. Josephs Sportswear, Inc., 28 USPQ2d 1464 (TTAB 1993); and Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha, 228 USPQ 672 (TTAB 1985). That is, even if the words “aqua” and “water” and “spa” are related, we cannot focus on the related terms, rather, we must focus on the applied-for term itself.”*

We argued that for the services under Classes 38 (Telecom services) and 45 (Domain Name registration) the examiner did determine the descriptiveness of our mark on the basis of analogy.

We also pointed out in our Request for Reconsideration, that although these services are related one can sell these services autonomous from each other something the examiner disputes in both her non-final and final refusals and tries to substantiate by evidence where the services are named and/or marketed together.

We supplied a dozen examples in our Request for Reconsideration where this is definitely

not the case proving that these services can be “sold” as sole commodities.

As said before the examiner did not comment on our arguments or evidence at all although at the least a partial refusal (refusal only for IC Class 42, but an allowance in the other Classes 38 and 45) would be fair considering our supported argument above.

Furthermore in our Request for Reconsideration we made another argument that the composite term ‘YOURHOSTING’ is suggestive and not descriptive.

We’ve extensively argued that the composite result of the terms ‘your’ and ‘hosting’ creating the trademark name ‘yourhosting’, gives it more non-descriptiveness than the words ‘your’ and ‘hosting’ on their own.

The examining attorney did elaborate on this matter and argued that in the Board decision Time Solutions Inc., 33 USPQ2d 1156 (TTAB 1994) adding the term ‘your’ to another descriptive term does not create a composite term that’s not descriptive. In this case the discussion was not about adding the term ‘your’ but the primary discussion was about the term ‘manager’ which was found merely descriptive as applied to computer programs which functioned to manage health data for insurance purposes. The board reaches its conclusion in that case with the next paragraphs:

*“When consumers encounter applicant’s mark, YOUR HEALTH INSURANCE MANAGER, used in the context of applicant’s advertising, which describes applicant’s goods as “new PC software to manage your medical records and health insurance” and lists the various tasks performed by the software programs, as recited above, we have no doubt that the mark will immediately convey to them information concerning a significant feature or function of applicant’s programs, namely, that they manage, i.e., handle with skill, personal health insurance matters.*

*Accordingly, we agree with the Examining Attorney’s conclusion that applicant’s mark, as applied to its goods, is merely descriptive of them.”*

In re TCL GoVideo (Ser. No. 78395320, 2006 WL 2558017 (T.T.A.B. August 2, 2006)), although not a citable precedent, the Board emphasizes specifically that:

*“As a result, we do not extrapolate from that decision ( the Time Solutions Inc., 33 USPQ2d 1156 decision ) that whenever the word YOUR is combined with a term that is descriptive of a characteristic of the goods or services, the mark as a whole is merely descriptive.”*

Still the examining attorney in our case maintains in her Office Action from July 16, 2014 that: “Specifically, the word “YOUR” in combination with descriptive or generic matter has been held merely descriptive under Trademark Act Section 2(e)(1). In re Time Solutions Inc., 33 USPQ2d 1156 (TTAB 1994).”

We also argued that although the term 'hosting' by itself has a descriptive significance for the service that we list under the IC 42 category for our application, but the adding of the term 'your' makes the mark suggestive because when a potential customer considers our webhosting services, these services are not yet his so it takes creative mental process on his part to reach this possible conclusion about the nature of these services.

This reasoning is of course based on the 're TCL GoVideo' case and in our opinion this alone makes the composite wording 'Yourhosting' a suggestive trademark rather than a merely descriptive one.

We also pointed out in our Request for Reconsideration that there's no such thing as hosting your own website. Hosting is per definition, even in the broader sense of its meaning, a service that is provided by others like the host of an inn or an hostess aboard a liner providing you with accommodations, beverages and/or meals. Nobody hosts its own drinks or food and nobody hosts his own service. We further elaborated on this matter that we host client websites and the client bears that responsibility for the content only.

We do not use the term 'your' or 'you' on our website ([www.yourhosting.nl](http://www.yourhosting.nl)) implying that there's such a thing as hosting your own website. We provide this kind of service because it's for most infeasible to do it yourself. In that sense we provide a service to them, hence the name service provider and we do not seek protection of the term service provider.

We further stated in our Request for Reconsideration that the term 'Yourhosting' is certainly not a description of the products we offer, it suggests merely a kind of servile almost submissive role or attitude towards our potential customers and in that sense it puts the prospective customer in a uncertain position what the term 'Yourhosting' means in relation to the services we offer and it requires more than some imagination or thought to reach a conclusion that the adding of the word 'your' in front of 'hosting' suggests an 'at your service' mentality from us.

Even when one has perceived this notion, it's still not certain if the right conclusion has been made, right in the sense that one might believe by a solid margin that that's the intention of providing these services under the trademark name 'Yourhosting'. In other words the average customer will be left in a state of uncertainty about the intended or "real" meaning of the term 'Yourhosting' in relation to offered services. He or she can only make a guess about it what the 'Your' part points to in the composition Yourhosting and it does not convey it's meaning.

Again the examining attorney did not respond on the above argument either.

We also want to point out that the Canadian Intellectual Property Office did accept our application Yourhosting for all three services and the trademark has been advertized in their Trademarks Journal at the fifteenth of July 2015. (Application number CIPO: 1662576)

## C. CONCLUSION

For the foregoing reasons, we respectfully request that the Section 2(e)(1) descriptiveness refusal will be reversed and our mark passed to the publication stage.

In the event that the Board elects to affirm the Section 2(e)(1) descriptiveness refusal for the application, the applicant requests a reversal for the refusal regarding the services under IC Class 38 & 45.

Respectfully submitted,

Your Holding BV  
Ceintuurbaan 28  
8024 AA Zwolle  
The Netherlands

Date: September 7, 2015