

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

APR Network, Inc.)	
A California corporation)	
)	Cancellation No.:
Petitioner,)	
)	
v.)	
)	Registration No.: 2514183
JupiterMedia Corporation,)	Date of Issue: December 4, 2001
A Delaware corporation)	
)	
)	
Respondent)	
_____)	

PETITION FOR CANCELLATION

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

Dear Sir:

Petitioner, APR Network, Inc. ("APR"), a California corporation, having a place of business in Tarzana California, and a mailing address of 19360 Rinaldi St., #467, Porter Ranch, CA 91326, believes that it will be damaged by Registration No. 2514183 for the mark SEARCH ENGINE STRATEGIES in International Class 41 for educational services, namely conducting professional seminars in the field of information technologies, stating a date of first use as of November 11, 1999.

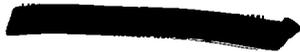
and petitions to cancel same.

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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #64

As grounds for cancellation, it is alleged that:

1. Petitioner has used the name as its domain name “searchenginestrategies.biz” and as part of a **description** of its services since February, 2004.

2. Petitioner acquired the domain name from a party that had used the domain name and the words “search engine strategies” since at least 2002 for information and services related to “search engine strategies,” without objection by the Registrant.

3. Upon information and belief, the phrase “search engine strategies” is widely used as a description of services related to search engine optimization, i.e., search engine strategies; and said phrase has been used by third parties descriptively since prior to the date of application, and has been used by third parties in relation to seminars, which is the exact service offered by the Registrant.

4. Respondent applied to register SEARCH ENGINE STRATEGIES, but was originally refused registration by the U.S. Patent and Trademark Office (“PTO”) on the grounds that the mark was merely descriptive.

5. In response to examining attorney’s July 17, 2000 Office Action refusing registration, Registrant argued that the mark was not merely descriptive, but suggestive. Registrant offered two alternate possible “meanings” for the mark, other than the meaning used by the Registrant. Registrant argued that because there are “several” possible definitions, the mark cannot be descriptive. The “several” meanings were essentially two meanings, at least one of which is descriptive.

6. Registrant failed to note that even if a mark may be suggestive or arbitrary as applied to some goods or services, that mark should be deemed descriptive if it is descriptive of **any** of the

goods or services for which registration is sought. *See 2 McCarthy on Trademarks*, § 11:51. *See also In re American Greetings Corp.*, 226 USPQ 365(TTAB 1985) (Whether consumers could guess product [or service] from consideration of mark alone is not the test); *In re Home Builders Assn. of Greenville*, 18 USPQ 1313 (TTAB 1990) (question is whether **someone who knows what the goods or services are** will understand the mark to convey information about them).

7. Registrant argued that the mark was not descriptive because a consumer does not draw an immediate connection between SEARCH ENGINE STRATEGIES and either the educational services offered by Registrant, or the characteristic or quality of services of the Registrant's mark.

8. Registrant failed to note that the question of whether a MARK is merely descriptive must not be determined in the abstract, but in relation to the goods and services for which the registration was sought, the context in which the designation was being used, or in connection with said goods or services. *In re Morton-Norwich Products.*, 209 USPQ 791 (TTAB 1981).

9. A mark is merely descriptive if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute, or feature of the product or services in connection with which it is used, or intended to be used. *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978).

10. The goods that the Registrant offers are **seminars that teach strategies for optimization of search engines**. The relevant consumer, in this case domain name owners and other technology professionals, can readily understand the services that the mark describes.

11. In this case, the consumer does not need to use any imagination or additional thought

process to realize that SEARCH ENGINE STRATEGIES describes services related to strategies used for search engines. Therefore the mark is merely descriptive and not suggestive.

12. Registrant also responded to the Examiner's initial refusal by alleging that the mark was not descriptive, and citing a series of trademarks which were registered and included the terms "SEARCH ENGINE" or "STRATEGIES."

13. In its response, Registrant failed to cite the numerous trademark registrations that **disclaimed** the word "STRATEGIES" or the term "SEARCH ENGINE" apart from the mark as shown.

14. The examining attorney only allowed the mark to be published for opposition after receiving a thirteen page response from Registrant, and requiring a disclaimer of the words "search engine."

15. Registrant also argued that the rule of *In re Bel Paese Sales Co.*, and other cases should govern, where doubts regarding descriptiveness should be resolved in favor of the applicant. *In re Bel Paese Sales Co.*, 1 USPQ2d 1233 (TTAB 1986).

16. Registrant recognized in its response that its mark could be subject to challenge as descriptive by competitors who would be entitled to clarify whether or not the mark was descriptive. As such, the Examiner's ultimate decision to allow the application could have been predicated on the assumption that third parties with an interest in using the descriptive words SEARCH ENGINE STRATEGIES would challenge the application or registration on such grounds, and "resolved doubt" in favor of the applicant.

17. The Petitioner, having such an interest in the registration of the mark, is now

challenging the registration on those very grounds. Although previous doubt was resolved in favor of the applicant, now that evidence has been presented that the mark is descriptive, the registration should be cancelled.

WHEREFORE, the Petitioner prays Registration No. 2514183 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

The filing fee of \$300 per class for one mark in once class is enclosed pursuant to CFR §2.111.

Respectfully submitted,

Dana B. Robinson

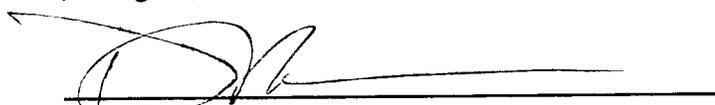
Dated: 9-15-2004

By: 

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. ER 899453505 US, in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on September 15, 2004.


Dana B. Robinson, Esq.