

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

APR Network, Inc. )  
A California corporation )  
 )  
Petitioner, )  
 )  
v. )  
JupiterMedia Corporation, )  
A Delaware corporation )  
 )  
 )  
Respondent )  
\_\_\_\_\_ )

Cancellation No.: 92043766  
Serial NO: 75905816  
Registration No.: 2514183  
Date of Issue: December 4, 2001



Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

12-01-2004  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

**MOTION TO EXPEDITE**

Plaintiff APR Network ("APR"), by and through its attorneys, Dana B. Robinson, Esq., and Nicholas "Steel" Gillaspey, Esq., hereby moves this Board for an expedited review of the instant proceeding. Plaintiff has filed a civil suit in the United States District Court for the Central District of California, which the Petitioner has moved to stay pending this Cancellation. Plaintiff asserts that there are issues in this cancellation proceeding that will bear upon the civil suit and will have preclusive effect on the District Court. Expedited review of the Cancellation will ensure that the court and parties to the civil action have a decision from this Board before proceeding with the civil action. Petitioner's points and authorities in support of this motion follow.

## POINTS AND AUTHORITIES

### **I. Facts**

Respondent JupiterMedia Corporation ("Jupiter") currently owns a trademark registration for SEARCH ENGINE STRATEGIES for educational services, namely conducting professional seminars in the field of information technologies, in Class 41. Declaration of Dana B. Robinson ("Robinson Decl.") Exhibit 1. Its seminars target industry professionals, who are often professional website operators who would like to learn strategies for optimizing web pages for better search engine ranking. Jupiter's trademark application was initially refused based on the PTO examiner's opinion that the mark was merely descriptive under the Trademark Act Section 2(e)(1) because the term "search engine strategies" describes an "ingredient, quality, characteristic, function, feature, purpose or use of the relevant services." Robinson Decl. Exhibit 2. The United States Patent and Trademark Office ("PTO") examining attorney stated that the "applicant offers seminars which provides (sic) attendees with *strategies* for marketing their *search engines*." *Id.* (emphasis in original).

In a response to the first Office Action, Jupiter argued, among other things, that the mark was registrable because there were other registered marks that contain the words "search engine" or "strategies" but were not required to disclaim exclusive rights in these terms. However Jupiter failed to include any references to dozens, if not hundreds, of registrations that did disclaim the terms "search engine" and/or "strategies." Robinson Decl. Exhibit 3.

In addition, Jupiter's arguments in favor of registration relied on a line of cases that indicate that a trademark should be registered if there is any doubt as to whether the

mark is descriptive. *Id.* However, this line of reasoning does not render a trademark registration impervious. Instead, the theory of the cases relies on the "competitors" to oppose registration of descriptive marks; if a mark is descriptive, it will inevitably be challenged by a competitor who does not want to see a descriptive word taken from the competitive marketplace. APR has done just this; it has challenged the validity of the registration in an effort to ensure that a phrase of such wide use is not removed from fair use by competitors.

APR believes that the use of the term "search engine strategies" is descriptive, and that the issuance of a trademark registration to Jupiter for the mark SEARCH ENGINE STRATEGIES should have never occurred. APR has asked the Federal District Court for the Central District of California to stay the civil action until the Board has had an opportunity to review the present cancellation action. In order to facilitate judicial economy, APR moves the Board to expedite the review of the present cancellation action.

## **II. Argument**

The Plaintiff urges that the TTAB expedite this cancellation proceeding. The expedition of this proceeding will cause no harm to either party. Both parties are currently involved in a suit before the District Court and are preparing for litigation. Therefore, both sides have already begun gathering evidence and information, and researching the relevant law. Neither side will be disadvantaged by a speedy resolution of this proceeding. As this is an administrative review case, there will be little need for witness testimony so third parties will not be inconvenienced. Plaintiff's further argue that there is a strong factual nexus between the cancellation proceeding and the claims before the District Court. Currently, the District Court has claims before it based on the same facts

that are pertinent in this cancellation proceeding before the TTAB. A speedy resolution of this proceeding will allow the District Court to utilize the TTAB's decision on the registration or cancellation of the SEARCH ENGINE STRATEGIES mark when ruling on the claims of declaratory relief and trademark infringement. Plaintiff believes that the resolution of this cancellation proceeding will bear heavily upon the various claims pending before the District Court, and will have possible preclusive effect.

The TTAB is the sole tribunal to decide the cancellation petition. Thus, if the registration is cancelled as the Petitioner has requested, then the district court will have the benefit of the TTAB's decision; the burdens will be shifted; and the discovery from the TTAB action will be available for re-use in the civil action. Trademark law is a very complex and specialized area. The TTAB has expert knowledge in this field and is more capable of making an informed decision based on its specialized experience and knowledge in the area of trademark law. The Central District has even stated this fact in an opinion in *Citicasters Co. v. Country Club Communs.*, 1997 44 U.S.P.Q.2D (BNA) 1223 (D. Cal., 1997). In *Citicasters*, the court stated that "the court is confident that the TTAB will exercise its specialized knowledge in effecting a determination that will prove valuable to this court." *Id.* Thus, the present case will likely rely upon the final determination of the TTAB before it can make a decision about the matters before it.

The District Court has stayed proceedings to await a TTAB decision "because of the efficiencies generated by the TTAB first addressing the issues involved." *Id.* Therefore, the present case is important for the parallel civil case, and the motion to expedite the cancellation proceeding should be granted.

**III. Conclusion**

Based on the foregoing arguments, the Plaintiff urges that this Court grant the Plaintiffs' motion to expedite the cancellation proceedings.

DATED: December 1, 2004

DANA ROBINSON & ASSOC.

And

GILLASPEY & GALLASPEY

  
Dana B. Robinson

3803 Mission Blvd. Ste. 100

San Diego, CA 92109

Attorneys for Petitioner

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. E0950899215 US US, in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on December 1, 2004.

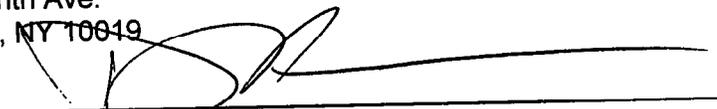


Dana B. Robinson, Esq.

Certificate of Service

I Dana Robinson hereby certify that on this day, December 1, 2004, I mailed by first class United States mail, postage prepaid, the foregoing MOTION TO EXPEDITE to the following:

Lee Thayer  
Willkie Farr & Gallagher, LLP  
787 Seventh Ave.  
New York, NY 10019



Dana B. Robinson, Esq.

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

APR Network, Inc.	)	
A California corporation	)	
	)	Cancellation No.: 92043766
Petitioner,	)	
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v.	)	
	)	Registration No.: 2514183
JupiterMedia Corporation,	)	Date of Issue: December 4, 2001
A Delaware corporation	)	
	)	
	)	
Respondent	)	
_____	)	

Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

**DECLARATION OF DANA B. ROBINSON IN SUPPORT OF**  
**APRNETWORK INC'S MOTION TO EXPEDITE**

1. I am the attorney for APRNetwork, Inc. ("APR"). I represent APR in the civil action Case No. 04-7578 DSF (the "Federal Case") in the Central District of California.
2. I submit this declaration in support of APR's motion to expedite the cancellation proceeding.
3. Respondent JupiterMedia Corporation ("Jupiter") currently owns a trademark registration for SEARCH ENGINE STRATEGIES for educational services, namely conducting professional seminars in the field of information technologies, in Class 41. A true and correct copy of the application is attached as Exhibit 1.
4. A true and correct copy of the refusal is attached as Exhibit 2.

5. A true and correct copy of the Jupiter's response to the refusal (without exhibits)  
is attached as Exhibit 3.

Executed on December 1, 2004 at San Diego, California.



---

Dana B. Robinson, Esq.

**APPLICANT:**

internet.com Corporation  
Delaware corporation

**ADDRESS:**

23 Old Kings Highway South  
Darien, Connecticut 06820

**FIRST USE/  
FIRST USE IN  
COMMERCE IN CLASS 41:**

November 18, 1999

**SERVICES:**

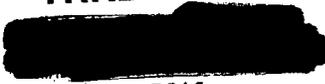
PROFESSIONAL SEMINARS (INTL. CL. 41)

**SEARCH ENGINE STRATEGIES**

  
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U.S. Patent & TMOfo/TM Mail Ropt Dt. #64

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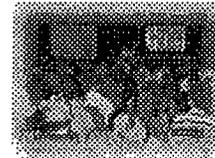
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23 Old Kings Highway South  
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# UNITED STATES PATENT AND TRADEMARK OFFICE

<b>SERIAL NO.</b> 75/905816	<b>APPLICANT</b> internet.corn Corporation <span style="float: right;">SH</span>	<b>PAPER NO.</b>
<b>MARK</b> SEARCH ENGINE STRATEGIES		<b>ADDRESS:</b> Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov  If no fees are enclosed, the address should include the words "Box Responses - No Fee."
<b>ADDRESS</b> CLAUDIA CANTARELLA WILLKIE FARR & GALLAGHER 787 SEVENTH AVENUE NEW YORK, NEW YORK 10019	<b>ACTION NO.</b> 01	
	<b>MAILING DATE</b> 07/17/00	
	<b>REF. NO.</b>	
<b>FORM PTO-1525 (5-90)</b>	<b>U.S. DEPT. OF COMM. PAT. &amp; TM OFFICE</b>	<b>Please provide in all correspondence:</b>  1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.

**A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.** For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/905816

The assigned examining attorney has reviewed the referenced application and determined the following.

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.*

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The applicant seeks to register SEARCH ENGINE STRATEGIES for "professional seminars." The proposed mark merely indicates the subject matter of the applicant's services. The applicant offers seminars which provides attendees with *strategies* for marketing their *search engines*. Ample evidence of this is found in the applicant's own specimens. Those specimens repeatedly refer to "search engines." For example, the specimens state that the applicant's seminar is "the

definitive event for understanding search engines and how to make them work for YOUR site!" Thus, the proposed mark is clearly descriptive and therefore unregistrable under Section 2(e)(1).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informality.

The recitation of services is unacceptable as indefinite. The applicant may adopt the following recitation, if accurate: "Educational services, namely conducting seminars in the field of computer search engines." TMEP section 1301.05.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



James A. Rauen  
Trademark Attorney  
Law Office 103  
(703) 308-9103 Ext. 157

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERVICE MARK APPLICATION ON THE  
PRINCIPAL REGISTER, WITH DECLARATION

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

**Mark:** SEARCH ENGINE STRATEGIES

**Intl. Class:** 41

**Applicant:** internet.com Corporation  
a Delaware corporation

**Address:** 23 Old Kings Highway South  
Darien, Connecticut 06820

Applicant requests registration of the above-identified service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 105, *et seq.*, as amended) for the following services:

**--PROFESSIONAL SEMINARS (INTL. CL. 41)**

and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Trademark Act of July 5, 1946, 15 U.S.C. § 1051 (a), as amended.

The mark was first used in connection with the services at least as early as November 18, 1999. The mark was first used in connection with the services in interstate commerce at least as early as November 18, 1999. The mark is now in use in such commerce.

**DECLARATION**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that: he is properly authorized to execute this application on behalf of the applicant; he believes applicant to be the owner of the service mark sought to be registered, to the best of his knowledge and belief no other person, firm, corporation or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: January 26, 2000

Respectfully submitted,

**internet.com Corporation**

By: Christopher S. Cardell  
Name: Christopher S. Cardell  
Title: President

The mark is used in advertising or on promotional materials and in other ways customary to the trade, and three specimens depicting the mark as actually used are presented herewith.

**POWER OF ATTORNEY**

Applicant hereby appoints WILLIAM M. RIED, CLAUDIA CANTARELLA, KIM A. WALKER, MARCI A. BLAZER, ROBERT A. ROSENBERG and JOSEPH N. ZARRO of WILLKIE FARR & GALLAGHER, 787 Seventh Avenue, New York, New York 10019, who are members of the Bar of the State of New York, as its attorneys, to prosecute this application for registration, to transact all business in the U.S. Patent and Trademark Office in connection therewith with full power of substitution and revocation, and to receive the Certificate of Registration.

Please direct all inquiries concerning this application to Claudia Cantarella at (212) 728-8640.

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

**Applicant** : **Internet.com Corporation**  
**Mark** : **SEARCH ENGINE STRATEGIES**  
**Serial No.** : **75/905,816**  
**Filed** : **January 28, 2000**  
**Int'l Class Nos.** : **41**  
**Attention** : **James A. Rauhen, Esq.**  
**Examining Attorney**  
**Law Office 103**



**01-17-2001**

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**RESPONSE TO OFFICE ACTION MAILED JULY 17, 2000**

In an Office Action mailed July 17, 2000 (the "Office Action"), the Examining Attorney refused registration of application Serial No. 75/905,816 ("Applicant's Mark") under Section 2(e)(1) of the Trademark Act of 1946 (the "Lanham Act"), 15 U.S.C. § 1052(e)(1), finding that Applicant's Mark merely describes the services identified in the application. The Examining Attorney has also requested that Applicant amend its recitation of services. Applicant submits the following amendment and response in support of registration:

It is well-established that a combination of arguably descriptive or even generic terms can and often does result in an arbitrary, unitary term that functions independently as a trademark. See TMEP § 1209.01(b)(4), and cases cited therein. See also *BellSouth Corp. v. Planum Technology Corp.*, 14 USPQ2d 1555 (TTAB 1988) (PHONE FORWARD suggestive of automatic telephone call diverters); *Citibank, N.A. v. Citibanc Group, Inc.*, 222 USPQ 292 (11th Cir. 1984) (CITIBANK not descriptive of banking services by New York City based bank); *In re American Hospital Supply Corporation*, 219 USPQ 949 (TTAB 1983) (HEPATIC AID not descriptive of nutritional supplement for patients with liver ("hepatic") disease); *In re TMS Corporation of the Americas*, 200 USPQ 57 (TTAB 1978) (THE MONEY SERVICE registrable even though its component parts, viewed separately, are descriptive); *In re Publishers Clearing House*, 231 USPQ 973 (TTAB 1986) (PUBLISHERS CLEARING HOUSE not merely descriptive of services of selling magazines on subscription basis for others); *In re Disc Systems Inc.*, 228 USPQ 964 (TTAB 1986) (DISC/TRAC applied to prepackaged computer programs not merely descriptive of a feature, character or quality of the goods).

Applicant submits that Applicant's Mark consists of the terms "SEARCH ENGINE" and "STRATEGIES," the combination of which creates a mark which is suggestive of Applicant's services.

As stated in TMEP § 1209.01(a): "a designation does not have to be devoid of all

5

It is our opinion that because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language, it suggests a number of things, but falls short of describing

6

2. Other Marks Containing the Term "Search Engine" Have Been Registered By The United States Patent and Trademark Office

In support of the conclusion that SEARCH ENGINE STRATEGIES is at least suggestive of Applicant's educational seminars, Applicant submits that the PTO has seen fit to register, or approve for publication, other marks which include the term "search engine," along with additional, arguably descriptive words, on a wide variety of goods and services pertaining to Internet search engines. The following marks are a sampling:

- **GLOBAL INFORMATION NETWORK THE SEARCH ENGINE FOR GLOBAL BUSINESS and design**, Reg. No. 2299616 in Class 42 for "computer services for business professionals, namely creating indexes of business directory information; searching and retrieving information, sites, and other resources available on computer networks", and "GLOBAL INFORMATION NETWORK" and "THE SEARCH ENGINE FOR GLOBAL BUSINESS" disclaimed;
- **POPULARITY SEARCH ENGINE**, Reg. No. 2320647 in Class 42 for "computer services, namely, providing search engines for obtaining data on a global computer network" and "SEARCH ENGINE" disclaimed;
- **THE SEARCH ENGINE THAT PAYS**, Reg. No. 2354699 in Class 42 for "computer services, namely, providing an online guide to information on topics of general interest accessible via a global information network" and "SEARCH ENGINE" disclaimed;
- **THE FIRST ANTI-SEARCH ENGINE**, Serial No. 75-790876 in Class 42 for "computer services, namely, creating indexes of information, sites and other resources available on computer networks for others";
- **SEARCH ENGINE FOR THE REAL WORLD**, Serial No. 75-852290 in Class 9 for "computer software which presents, in a manner dependent on a user's given location as well as other user-defined criteria, information about recreational destinations, listings, reviews, navigational directions, preference-based advertisements, user request input forms, and user comment input forms, and which updates itself over a network at user request, for use with hand-held computers, namely, palm-top computers, notebook computers, cellular telephones, data-enabled cellular units, and alphanumeric pagers" and "SEARCH ENGINE" disclaimed;
- **A SEARCH ENGINE IS LIKE A COMPASS, WHILE CONCERTO IS LIKE A GPS FOR THE INTERNET**, Serial No. 75-912138 in Class 35 for "marketing for others for their services and goods through distribution to the public free computer software which interfaces with radio and television broadcasts, and a computer keyboard automation appliance which interfaces with the software and remotely and automatically launches web sites on a global computer network; marketing for others; specifically vendors and manufacturers of goods and services, through distribution to vendors and manufacturers of

products and services, computer data from a database of digitized sounds and machine readable codes which interface with radio and television broadcasts, and publications, which remotely launches web sites on a global computer network";

- **ONE SEARCH ENGINE. MILLIONS OF MINDS**, Reg. No. 2417430 in Class 42 for "computer services, namely, providing a search engine on the global computer network which organizes, focuses, and provides users with access to information"; and
- **IT'S YOUR SEARCH ENGINE**, Serial No. 75-932837 in Class 42 for "computer services, namely, providing search engines for obtaining data on a global computer network."

See U.S. Patent and Trademark Office Web site printouts, attached hereto Exhibit B.

While prior decisions may not ultimately determine whether a given mark is to be refused registration as merely descriptive, they nonetheless illustrate the need for the PTO to treat similarly situated applicants similarly. Applicant respectfully submits that, like Applicant's Mark, each of the above registrations make use of the term "search engine" to denote services relating to Internet search engines. In addition, each mark also contains additional arguably descriptive terms. However, the PTO has recognized that each of these marks require the exercise of imagination, additional thought process, or supplementary information in order for a consumer to deduce the exact nature of the goods or services provided. This is true even though many of the marks cited above, when gauged on the generic to arbitrary spectrum of marks, are less clearly suggestive than Applicant's Mark.

Applicant's Mark conveys less about the identified services than do these cited registrations and, at least as much as with the cited marks, consumers must exercise imagination thought and perception to make the connection between SEARCH ENGINE STRATEGIES and Applicant's services. Certainly, if POPULARITY SEARCH ENGINE, THE SEARCH ENGINE THAT PAYS, and THE FIRST ANTI-SEARCH ENGINE are all worthy of trademark protection, SEARCH ENGINE STRATEGIES is worthy of the same protection.

3. Other Marks Containing the Word "Strategies" Have Been Registered by The United States Patent and Trademark Office

In addition, Applicant submits that the addition of the word "Strategies" does not automatically render a mark unregistrable if used in connection with educational services.

Applicant respectfully submits that the PTO has seen fit to register a multitude of marks which contain the term "strategies" for educational services. The following marks are a sampling.

- **TELESTRATEGIES**, Reg. No. 1572518 in Class 41 for "educational services, namely, conducting seminars in the field of telecommunications";
- **STRATEGIES FOR TODAY'S ENVIRONMENTAL PARTNERSHIP**, Reg. No. 1781802 in Class 41 for "providing technical and communication services; namely, developing and disseminating educational and technical materials in the field of improving environmental, health and safety performance in the petroleum industry and conducting conferences aimed at improving environmental, health and safety performance in the petroleum industry through the exchange of information";
- **PACKAGING STRATEGIES & Design**, Reg. No. 1753884 in Class 16 for "printed matter; namely, newsletters, reports and conference materials relating to the subject of packaging" and Class 41 for "educational services; namely, arranging and conducting conferences and seminars in the field of packaging" and "PACKAGING" disclaimed;
- **STRATEGIES FOR HIGH INVOLVEMENT LEADERSHIP**, Reg. No. 1903832 in Class 41 for "educational services, namely conducting meetings, seminars, and conferences in the fields of business management leadership and professional training/development for business/organizational managers";
- **STRATEGIES & Design**, Reg. No. 2188038 in Class 41 for "education, namely, conducting seminars, conferences, classes, workshops and one-on-one instruction in the fields of financial planning, investments, marketing and the future value of money";
- **CONSTRUCTION STRATEGIES, INC.**, Reg. No. 2029737 in Class 41 for "training sessions in the field of construction partnering and the business aspects of the construction industry," Class 35 for "business consultation services in the field of construction, namely, consultation in regard to construction business planning; construction project risk identification, allocation, and abatement; advice and assistance in construction bidding, in construction policies and procedures, and in construction contract negotiation, drafting, and administration; advice and assistance in regard to construction project scheduling and implementation; and construction partnering advice and assistance" and Class 42 for "consultation services in regard to awareness and avoidance of construction disputes and claims; dealing with and resolving construction disputes and claims, construction partnering

facilitation; and third party neutral and mediator facilitation services for the construction industry” and “CONSTRUCTION” and “INC.” disclaimed;

- **STRATEGIES**, Reg. No. 1893763 in Class 41 for "educational services, namely conducting classes, seminars, and conferences in the field of management leadership and development and training services”;
- **WEBSTRATEGIES**, Reg. No. 2298605 in Class 35 for “organizing and conducting business conferences and seminars in the field of electronic commerce,” and Class 41 for "educational services, namely organizing and conducting conferences and seminars in the field of electronic commerce”;
- **STRATEGIES FOR SUCCESS**, Reg. No. 2197988 in Class 41 for "conducting educational seminars and training in the field of operating carpeting cleaning businesses”;
- **TRUQUEST STRATEGIES & Design**, Reg. No. 2203855 in Class 41 for "conducting workshops, seminars, conferences, lectures, classes, and demonstrations in the field of building character and personal integrity and achieving personal goals and a balanced lifestyle”;
- **PRACTICE STRATEGIES**, Reg. No. 2337074 in Class 41 for "educational services, namely conducting seminars and conferences on the subject of behavioral healthcare practice management, and distributing course material in connection therewith” and Class 16 for “newsletters featuring behavioral healthcare practice management” and “PRACTICE” disclaimed;
- **SALTWATER STRATEGIES**, Serial No. 75-600522 in Class 9 for “pre-recorded video cassettes featuring saltwater, recreational, and sporting activities” and Class 41 for "production of radio and television programs, and entertainment in the nature of an ongoing television and radio show featuring instruction, demonstration; and information on fishing techniques” and “SALTWATER” disclaimed;
- **WINNING STRATEGIES FOR WOMEN**, Reg. No. 2319477 in Class 41 for "seminar services and conducting conferences and workshops in the field of motivational empowerment for women”;
- **SOLUTIONS OPPORTUNITIES STRATEGIES**, Serial No. 75-732832 in Class 35 for “individual, group and corporate consulting in the fields of personal, professional, and business organizational development” and Class 41 for " individual, group and corporate coaching; educational seminars and workshops in the fields of personal, professional and business organizational development;” and
- **CREATING STRATEGIES TO ACHIEVE BALANCE**, Serial No. 75-869799 in Class 41 for “educational services, namely conducting workshops in the field of personal improvement for individuals and corporations.”

See U.S. Patent and Trademark Office Web site printouts, attached hereto Exhibit C. None of the marks cited above were registered or approved for publication pursuant to Section 2(f) of the Trademark Act.

Applicant respectfully submits that, just as the PTO has recognized that these marks are at most suggestive of their respective goods and services, the inclusion of the term "strategies" in Applicant's Mark in no way renders SEARCH ENGINE STRATEGIES descriptive of Applicant's educational seminars.

C. **All Doubts Regarding Descriptiveness Should be Resolved in Favor of Applicant**

The Trademark Examiner bears the burden of demonstrating that the mark SEARCH ENGINE STRATEGIES is merely descriptive. *In re Bel Paese Sales Co.*, 1 USPQ2d 1233 (TTAB 1986). To meet this burden, the Examiner would have to show Applicant's Mark does not function as a trademark. *See In re National Training Center of Lie Detection, Inc.*, 226 USPQ 798 (TTAB 1985) (admittedly laudatory phrase "Dedicated to Achieving the Highest Level of Professionalism" for journals dedicated to polygraph profession allowed in view of lack of showing that such phrase did not function as a trademark). The Examining Attorney has not made this showing.

In addition, where there is doubt whether a mark is suggestive or descriptive, any such doubt must be resolved in the applicant's favor. *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Intelligent Medical Systems, Inc.* 5 USPQ 1674, 1676 (TTAB 1987). *See also In re Conductive Systems, Inc.*, 220 USPQ 791 (TTAB 1981). *In In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1985), the Board recognized:

that there is often a thin line separating merely descriptive from suggestive terms and that judgments in these cases are frequently subjective. However, where there is doubt in the matter, the doubt should be resolved in applicant's behalf and the mark should be published for opposition.

This presumption at the examination stage reflects the "hazy and only subjectively definable" borderline between suggestive and descriptive marks, J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11.66 (1997), and the fact that competitors have the opportunity to oppose the application once published and to present evidence that is usually not present in *ex parte* examination. An objective analysis of Applicant's Mark, in the context of the cited registrations, at least raises a doubt as to whether Applicant's Mark is suggestive or descriptive. Under *In re Morton-Norwich Products, Inc.*, this doubt should be resolved in favor of publishing Applicant's Mark for opposition purposes.

CONCLUSION

Applicant is pleased to note that the Examining Attorney's search of the office records disclosed no similar registered or pending mark which would bar registration of Applicant's Mark.

Applicant respectfully submits it has addressed all of the issues raised by the Examining Attorney. Accordingly, Applicant submits that the application is in condition for publication for opposition, and respectfully requests such publication.

Respectfully submitted,

internet.com Corporation

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