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

Test Masters Educational Services, Inc. ) Concurrent Use No. 94002016  
)  
)  
v. )  
)  
)  
Robin Singh )  
)  
)  
)



04-24-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

**REQUEST FOR ACCEPTANCE OF LATE RESPONSE TO CONCURRENT USE  
ACTION AND TO "COMMUNICATION" AND RESPONSE TO THE SAME**

Robin Singh, through his attorneys, O'Melveny & Myers, LLP, hereby, replies to the Board Order dated January 9, 2003 and to the "Communication" filed by Test Masters Educational Services, Inc., which is in the nature of a Motion, dated March 10, 2003.

**I REQUEST FOR ACCEPTANCE OF LATE RESPONSE**

The Board Order dated January 9, 2003 was not received by Mr. Singh, nor any of his attorneys. Mr. Singh received the Order when it was transmitted via facsimile to his attorney, Francie R. Gorowitz by the Trademark Trial & Appeal Board, on April 3, 2003. Accordingly, it is respectfully requested that this late filed response be accepted.

Test Masters Educational attempted to serve the document entitled "Communication" on Mr. Singh, personally on March 10, 2003 by mailing it to his former business address, 8383

Wilshire Boulevard, Ste. 532, Beverly Hills, CA 90211. It is believed that the document was returned to counsel because it was re-sent to Mr. Singh at his current address, 1620 26<sup>th</sup> Street, Suite 1000 North, Santa Monica, CA 90404 on March 26, 2003 and was received by Mr. Singh on April 2, 2003. Test Masters Educational's counsel, Michelle Schwartz indicated that she would not object to Mr. Singh's filing a response after the deadline.

## **II RESPONSE**

### **A. BACKGROUND**

In August 1991, Robin Singh and his partner David Killoran started Testmasters. Initially, the company tutored students to help them prepare for the SAT, GMAT, GRE, MIT, Millers Analogy Tests and ACT. In September 1991 Testmasters taught its first test preparation classes at the University of Southern California and California State College at Northridge. The classes were preparatory for the Law School Admissions Test (LSAT). Testmasters also conducted admissions consulting to help students applying to college or graduate school.

Thereafter, the rights were transferred to Mr. Singh, who operated the Testmasters business as a sole proprietor. The business has expanded rapidly and Testmasters now offers test preparation courses in more than thirty states. Testmasters is one of the five largest test preparation companies in the country. Thousands of students take TESTMASTERS courses annually.

Mr. Singh recently incorporated the business and his rights were transferred to Robin Singh Educational Services, Inc.

In March 1992, Haku Israni started offering a preparatory course for the EIT or fundamentals of engineering at Southwest Houston University. Dr. Israni's son Vivek (Roger) Israni worked with him. They called their business "Test Masters." In his direct examination at trial, Dr. Haku Israni testified: "We picked Test Masters because it is extremely descriptive. Test Masters means mastering the test. We don't have even have to explain to anybody what Test Masters is. It is mastering of the test." Test Masters Educational Services, Inc. vs. Robin Singh, DBA Testmasters – Transcript of Trial Proceedings before the Honorable Vanessa Gilmore – Volume I, page 122 lines 8 –11 (A copy of which is attached hereto.) The course offerings were expanded to include the SAT. They incorporated under the name Test Masters Educational Services, Inc.(TES) in 1994. Currently the company offers various preparatory courses, primarily in Houston, Texas and in the eastern portions of Texas.

In October 1995, TES registered the domain name "testmasters.com." In August 1999, Mr. Singh learned of this registration and sent a cease and desist letter to TES. On August 30, 1999, TES filed a declaratory judgment action in the United States District Court for the Southern District of Texas requesting a declaration of non-infringement and asserting that Singh's mark was invalid because it was descriptive and there was no secondary meaning.

During the proceeding Mr. Singh moved for Partial Summary Judgment that the Geographic Scope of TES' Service Mark Rights did not extend outside of Texas. **TES did not oppose this motion** and it was granted on November 27, 2000. During trial, Dr. Haku Israni testified: "We have offered classes in following areas; Houston which includes Clear Lake also, Dallas/Fort Worth, Austin, San Antonio, Corpus Christi, Laredo." Test Masters Educational Services, Inc. vs. Robin Singh, DBA Testmasters – Transcript of Trial Proceedings before the

Honorable Vanessa Gilmore – Volume I, page 127 lines 9 – 11, (A copy of which is attached hereto.).

At trial, the jury held the mark to be descriptive, but also held that Mr. Singh had established secondary meaning.

In the final judgment, the Court ordered the Director of the PTO to restrict Robin Singh's registration for TESTMASTER to the entire United States except the State of Texas and to grant Test Masters "exclusive rights to use the federally-registered service mark 'Testmasters' only in the State of Texas." This order precipitated this Concurrent Use Action.

TES appealed the District Court's ruling. The 5<sup>th</sup> Circuit found that Mr. Singh had not submitted evidence of secondary meaning and ordered the Director of the United States Patent & Trademark Office to cancel Registration No. 2,234,514. Said registration was cancelled on February 10, 2003.

## **B. ARGUMENT**

### **1. While this concurrent use proceeding is moot, the concurrent rights of the parties is not.**

The purpose of the current proceedings was to provide TES with rights restricted to the State of Texas, and to restrict Mr. Singh's Reg. No. 2,234,514 to reflect TES's rights in Texas. The cancellation of Reg. No. 2,234,514 renders the current proceeding moot, however, the issue of concurrent use remains.

In addition to the application at issue in this proceeding, Ser. No. 76/306,308 for the mark TEST MASTERS for "educational services, namely, providing courses of instruction and

materials to prepare students to take and achieve higher scores on standardized tests” in Class 41, TES owns the following trademark applications:

Ser. No. 76/413,999 for the mark TESTMASTERS for “educational services, namely, providing courses of instruction and materials to prepare students to take and achieve higher scores on standardized tests” in Class 41, which was filed on May 24, 2002;

Ser. No. 78/148099 for the mark TESTMASTERS for “educational services, namely, providing courses of instruction and materials to prepare students to take and achieve higher scores on standardized tests” in Class 41, which was filed on July 26, 2002;

Ser. No. 78/148101 for the mark TEST MASTERS for “educational services, namely, providing courses of instruction and materials to prepare students to take and achieve higher scores on standardized tests” in Class 41, which was filed on July 26, 2002; and

Ser. No. 76/456163 for the mark TESTMASTERS for “computer software for test preparation and for educational and career services “ in Class 9; “printed materials, namely, workbooks, textbooks, and instructors guides in the field of preparation for standardized tests “ in Class 16; and “providing temporary use of on-line non-downloadable computer software for use in the field of preparation for standardized tests” in Class 42, which was filed on October 7, 2002;

Mr. Singh owns Ser. No. 78/148012 for the mark TESTMASTERS for “educational services, namely, providing courses of instruction and materials to prepare students to take and achieve higher scores on standardized admission tests for graduate and professional schools” in Class 41, which was filed on July 26, 2002.

The issue of territorial rights was decided in the law suit. Mr. Singh's Motion for Partial Summary Judgment that the Geographic Scope of TES' Service Mark Rights did not extend outside of Texas, was granted. TES is now collaterally estopped from denying the restriction on its rights.

It is respectfully requested that all of the foregoing applications owned by TES be restricted to the State of Texas.

**2. Ser. No. 76/306,308 should be remanded to the Examining Attorney for further prosecution.**

The first official action on Ser. No. 76/306,308, which issued on January 15, 2002, requested a disclaimer of the descriptive wording "test." The mark in its entirety was not rejected as being merely descriptive.

However, in its law suit, TES attacked Mr. Singh's rights on the grounds that mark TESTMASTERS, which is virtually indistinguishable from the mark TEST MASTERS, used on courses for test preparation, virtually the identical services, is merely descriptive. TES asserted that Mr. Singh's failure to advise the PTO that the mark was descriptive constituted "fraud on the PTO."

TES admitted that its mark TEST MASTERS is "extremely descriptive. Dr. Haku Israni, one of the founders of TES, testified: "We picked Test Masters because it is extremely descriptive. Test Masters means mastering the test. We don't have even have to explain to anybody what Test Masters is. It is mastering of the test." Test Masters Educational Services, Inc. vs. Robin Singh, DBA Testmasters – Transcript of Trial Proceedings before the Honorable Vanessa Gilmore – Volume I, page 122 lines 8 –11

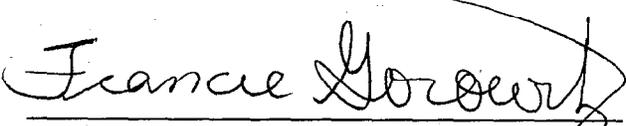
Accordingly, Ser. No. 76/306,308 should be remanded to the Examining Attorney and then refused registration on the grounds that it is merely descriptive.

**C. CONCLUSION**

Based on the foregoing, it is respectfully requested that the Board order all of TES' pending applications (Ser. Nos. 76/306,308; 76/413,999; 78/148,099; 78/148,101; and 76/456163) be geographically restricted to the State of Texas; and that Ser. No. 76/306,308 be remanded to the Examining Attorney for the purpose of refusing registration on the grounds that the mark is merely descriptive.

Dated: April 21, 2003

Respectfully submitted,

  
Francie R. Gorowitz, Attorneys for Robin Singh

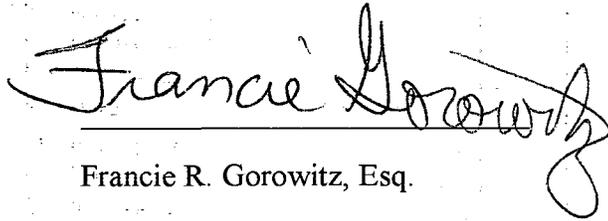
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on April 21, 2003

  
Francie R. Gorowitz

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the forgoing, REQUEST FOR ACCEPTANCE OF LATE RESPONSE TO CONCURRENT USE ACTION AND TO "COMMUNICATION" AND RESPONSE TO THE SAME was served by depositing it with the United States Postal Service as first class mail in an envelope addressed to Michelle P. Schwartz, Esq., Hughes & Luce L.L.P., 1717 Main Street, Suite 2800, Dallas, Texas 75201 on April 21, 2003.

  
Francie R. Gorowitz, Esq.