



On March 15, 2001, the applicant filed its Statement of Use. Upon review thereof, the examining attorney issued an Office action refusing registration under Section 2(e)(1) on the grounds that the mark is merely descriptive of the goods. The Office action addressed two significant sub-issues. First, as part of the descriptiveness refusal, the applicant was advised that the mark appears to be generic, and that the examining attorney could not recommend an amendment to seek registration under Section 2(f), or an amendment to the Supplemental Register. Second, the applicant was advised that the evidence of descriptiveness attached thereto was not available in 1997.

The applicant's response to the refusal did not address the merits of the descriptiveness refusal, but instead, focused solely upon the propriety of the timing of the refusal. Specifically, the applicant argued that the nature of the term in 2002 was the same as in 1997. In support of the position, the applicant attached excerpts from 47 articles that were published prior to initial examination of the application.

In the final Office action, the examining attorney noted that the applicant's evidence was primarily from Canadian and Australian sources, and cited the Board decision regarding the impropriety of evidence from foreign sources. After reiterating that the evidence available to the examining attorney in 1997 was primarily from wire sources and foreign sources, and thus, not relevant, the examining attorney summarized and attached the evidence from the same database (Lexis/Nexis) available in 2002. Additional evidence from an Internet search was attached.

On June 13, 2003, the applicant filed a Request for Reconsideration. Therein, the applicant set forth the two-part test for determining whether a mark is generic and argued extensively that the examining attorney had misidentified the relevant class of goods. However, both of

these arguments demonstrate a startling mischaracterization of the refusal, the evidence, and the arguments set forth by the examining attorney.

Although the examining attorney denied the request for reconsideration, the Office action noting that denial clearly and unequivocally stated that the refusal is NOT based upon whether the mark is generic, but is based upon Section 2(e)(1) of the Trademark Act. In addition, the examining attorney repeated the test for determining whether a mark is merely descriptive, i.e., whether the mark immediately describes an ingredient, quality, characteristic, feature, function, purpose, or use of the mark. The applicant was fully advised that the more stringent generic test referred to by the applicant was not an issue in the case because the applicant had never amended the application to seek registration under Section 2(f) or Section 23.

Nonetheless, the applicant filed an appeal brief, which contains arguments that relate only to generic refusals. The appeal brief does not address whether the mark is merely descriptive of the goods, which is the sole issue before the Board.

## ARGUMENT

### **I. THE TERM “NETCAM” IS MERELY DESCRIPTIVE OF THE APPLICANT'S GOODS.**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See 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). The determination of whether a mark is merely descriptive is made in relation to the goods or services for which registration is sought,

not in the abstract. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

The applicant's mark is "NETCAM." The applicant's goods are identified as "video and/or still camera and transmitter for transmitting visual and audio information to a remote location for recordation and/or real time display." The mark is merely descriptive because it is commonly used to identify a video camera that is connected to a computer network to provide live digital images.

**A. The Individual Terms NET and CAM, and the Composite Term NETCAM are Descriptive**

The examining attorney respectfully requests that the Board take judicial notice of the following definitions of NET and CAM (please see attachments for full definition):

**net :**

A network; for example, a network of computers connected to each other.

**cam:**

**short for: camera, a.k.a. Webcam**

An inexpensive, simple video camera that sits on top of or next to your computer monitor, it is designed to send live and recorded video as well as still pictures over the Net to one or more users. It can also be a digital camera placed somewhere, anywhere, in the world, streaming video to a Web site (or other portable device) so that users can see live footage of certain events. The "cam" suffix can be applied to many words to describe specialized cameras, such as "a nannycam," which is used inside a home to monitor a babysitter's activities.

Both of these terms are descriptive of the applicant's video camera and transmitter systems. Cameras are the primary component of the applicant's systems. Moreover, the

applicant's cameras appear to fit the definition set forth above. Therefore, the abbreviation CAM clearly describes the goods. Moreover, the term NET is descriptive of the applicant's goods, because it describes a feature thereof, namely, that cameras are network cameras.

A mark which combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991); *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915 (TTAB 1986); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986); *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). TMEP §1209.03(d). In this case, both the individual terms NET and CAM and the composite mark formed from their combination, namely, NETCAM, are descriptive. The combination of the descriptive terms NET and CAM does not result in a mark with a separate non-descriptive meaning.

The applicant argues that its goods are not necessarily connected to a computer. However, this argument is not persuasive for two reasons. First, the applicant's cameras could be connected to a computer, even if the applicant's statement that they are not necessarily connected to a computer is correct. Second, even if the camera is not directly connected to a computer, the camera and the transmitter are linked such that the transmitter sends images over a computer network. Therefore, the cameras are network cameras.

**B. The Examining Attorney Did Not Misidentify the Applicant's Class of Goods.**

The descriptiveness refusal was based upon the identification of goods provided by the applicant, namely, "video and/or still camera and transmitter for transmitting visual and audio information to a remote location for recordation and/or real time display."

Significantly, the applicant's arguments seem to be premised in significant part on the alleged mischaracterization of the applicant's goods as webcams by the examining attorney. However, a quick review of page 2 of the final Office action, which is the only place where the examining attorney ever mentioned webcams, clearly shows that the applicant has misinterpreted and mischaracterized the analogy that the examining attorney was making. The analogy was not between the applicant's goods and webcams, as alleged by the applicant, but rather, was to the combination of a term (web or net) with the abbreviation CAM (for camera). At no time, did the examining attorney contend that the applicant's goods are, or are not webcams. The statement below is the sole reference to webcams by the examining attorney during the prosecution of this case:

*Like the term WEBCAM (web + camera), the term NETCAM is comprised of commonly recognized abbreviations (network + camera), which immediately tells purchasers the exact nature of the goods.*

Thus, all of the applicant's arguments that its goods are not webcams are not relevant. The issue before the Board is whether the term NETCAM is descriptive, not whether the term WEBCAM is descriptive, or even whether the applicant's goods are webcams.

The identification of goods clearly indicates that the applicant's goods are cameras. Moreover, the goods are used in connection with a transmitter to transmit audio and video to a remote location. This transmission is accomplished via a computer network. Thus, the relevant determination is whether NETCAM is descriptive of cameras and transmitters for transmitting visual and audio information to a remote location for recordation and/or real time display.

**C. TMEP Section 1109.08 Provides Authority for Refusal**

TMEP Section 1109.08 states in relevant part:

*The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error. If a significant length of time has elapsed since the initial examination, in some cases, the mark may have become descriptive or even generic as applied to the goods or services. In such a case, the evidence of the descriptive or generic use would not have been available during initial examination, so the clear error standard would not apply.*

It is unequivocal that the computer industry is a rapidly evolving industry. In 1997, the technology in the industry was vastly different from the technology a couple of years later. Indeed, new products are developed all of the time and products that did not even exist in 1997, are well integrated into consumer lifestyles several years later. Such is the case with the term netcam. Although there was minimal evidence of the descriptive use

of the term in 1997, the evidence was insufficient to base a refusal upon, because the evidence showed use of the term outside the United States to identify an Internet camera. The approval of the mark for publication in 1997 was based solely upon the lack of quantity and quality evidence at the time.

Upon receipt of the Statement of Use five years later, the examining attorney conducted a supplemental search of the Internet, and Lexis/Nexis and found drastically different evidence available. No longer was the evidence limited to foreign sources and wire sources. Instead, the term was being widely used in the United States to identify a particular type of camera.

In view thereof, registration was properly refused upon examination of the Statement of Use.

The applicant argues that the evidence available in 1997 was acceptable because it referred to locations within the United States. This argument is not persuasive. The subject matter of the evidence is not what determines the relevance of the evidence; rather, the location of the provider of the news is determinative. This makes logical sense. If an article about the United States is written in a foreign country, it does not necessarily follow that the article will ever be seen in the United States. However, if a news article or magazine is published in the United States, no matter what the content, the article will be circulated within this country. Therefore, even if the original foreign sources featured netcams within the United States, such evidence would not be relevant of the descriptiveness of the term netcam within the United States.



This same argument does not extend to evidence that is taken from the Internet, because by its very existence on a global computer network, the information is circulated within the United States. In fact, the reference that the applicant specifically objects to is the TRAVELSPOTS web site, and the only way that the applicant even determined where TRAVELSPOTS is located was by going to an alternate web site and inquiring about the company. Nowhere on the web site was the geographic location of the web site provider available. Thus, neither the examining attorney nor any other visitor to the web site would know that the provider is from Canada, and the information contained on the web site would be available to anyone in the United States or elsewhere, with access to the Internet.

**D. The Evidence of Record Clearly Supports the Descriptiveness Refusal**

The term NETCAM is commonly used to identify a camera that is connected to a computer network to provide live digital images. Since 1997, the usage of netcams has grown dramatically, and netcams are now used in a wide variety of settings to provide frequently updated, if not continuous, digital images via a computer network.

The following representative excerpts from the Lexis/Nexis research were attached to the January 18, 2002 Office action (the first action upon examination of the Statement of Use):

*“The latest example of this trend is called netcam. It’s a tiny video device that plugs into a computer and lets the user send out visual images.”* (The Christian Science Publishing Society, Story No. 138 of 364).

*"Tiny cheap video cameras known as netcams are quickly becoming a hot new accessory for web users; for \$150 or less, netcams allow people in separate locations to see each other on their computer monitors via the Web."* (The New York Times Company, Story No. 161 of 364).

*"Q: What is the difference between different types of Internet "cams," such as Webcam, Netcam, and live cams?"* (USA Today, Story No. 196 of 364).

The TRAVELSPOTS web site printout, which was attached to the final Office action, shows use of the term netcam as a synonym for Internet camera, and advertises transmittal of photos via the Internet from all over the world.

The applicant argues extensively about the difference between its goods and webcams, arguing that its goods are not webcams, without really clarifying the use or purpose of its own network cameras. However, even if the applicant's goods are used for a different purpose than what other netcams are used for, e.g., viewing images of geographic locations, sporting events, day care centers, public places, etc., the term is still descriptive of the applicant's goods, because it immediately describes the applicant's video camera and transmission system. The term NET describes how the images are transmitted and the term CAM is short for camera. Simply put, no matter what their purpose or use, the applicant's goods are network cameras, and NETCAM immediately tells purchasers this important feature of the cameras.

It is well settled that even if an applicant is the first and only user of a term, the term is merely descriptive if it describes an ingredient, quality, characteristic, function, feature,

purpose or use of the relevant goods. Thus, even if the applicant is using NETCAM to identify cameras that are different than the netcams referred to in the evidence, registration of the term is not justified. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). TMEP §1209.03(c). The applicant's goods are network cameras, or netcams. Therefore, the mark is merely descriptive of a feature of the goods.

## II. THE APPLICANT'S ARGUMENTS ARE NOT ON POINT

### A. The Issue of Genericness is Not Before the Board

In spite of repeated clarification by the examining attorney, the applicant's appeal brief focuses upon arguments that the mark is not generic. However, as stated previously, the issue before the Board is descriptiveness. The reference to the generic nature of the mark is part of an advisory Section 2(e)(1) paragraph that advises the applicant that an amendment to Section 2(f) or Section 23 would not be accepted.

### B. The Applicant Has Not Even Attempted to Refute the Descriptiveness Arguments.

The applicant has not submitted one single argument regarding the descriptiveness of its mark. Instead, it incorrectly focuses upon a test for a different refusal. The two-part test for determining whether a mark is generic, which the applicant discusses at length, is not an issue before the Board. The applicant has improperly focused upon this test, and has not responded to the descriptiveness arguments set forth by the applicant.

**C. The “Clear Error” Standard is Not Applicable.**

As stated above, TMEP Section 1109.08 provides the underlying authority for issuing a refusal at the examination of the Statement of Use stage. That section clearly states that if evidence was not available previously, but changed circumstances exist, the clear error standard does not apply:

*The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error. If a significant length of time has elapsed since the initial examination, in some cases, the mark may have become descriptive or even generic as applied to the goods or services. In such a case, the evidence of the descriptive or generic use would not have been available during initial examination, so the clear error standard would not apply.*

In this case, the refusal was issued due to changed circumstances, not due to “clear error.” Moreover, if the examining attorney had issued the refusal pursuant to the clear error standard, the applicant’s recourse would not be through the Board. In such a case, the applicant must file a petition to the Commissioner’s Office under 37 C.F.R. §2.146. *See In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997) regarding the timeliness of the refusal. Only the substance of the refusal itself would be at issue before the Board.

**CONCLUSION**

For the reasons set forth above, the Section 2(e)(1) refusal to register is proper and the examining attorney respectfully requests that the Board affirm the refusal.

Respectfully Submitted,

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Definition for: net

A network, for example, a network of computers connected to each other.

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