

Applicant: IEEE Industry Standards and Technology Organization : BEFORE THE
Trademark: VOICEXML FORUM : TRADEMARK TRIAL
Serial No: 76106084 : AND #13
Attorney: Christine W. Trebilcock : APPEAL BOARD
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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

This is an appeal from the examining attorney's final refusal to register applicant's mark, VOICEXML FORUM, because the mark is merely descriptive of the services pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e).

FACTS

On August 9, 2000, applicant filed an application seeking registration on the Principal Register for the mark VOICEXML FORUM for "trade association services, namely, developing and promoting standards, educating the industry on such standards and providing conformance programs related to voice extensible language." The application is based on Trademark Section 1(b), intent to use. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C., Section 1052(e)(1) because the mark merely describes the services. On January 22, 2002, applicant responded to the refusal to register the mark and amended the recitation of services to "association services, namely, promoting the interests of companies in the voice extensible language industry, including developing and promoting standards and increasing the understanding of voice extensible

language standards and conformance programs.” The refusal was made final on July 23, 2002 and applicant filed a timely Notice of Appeal to the final action.

ISSUE

The sole issue for consideration is whether applicant’s mark is merely descriptive of the identified services pursuant to Trademark Act Section 2(e)(1).

ARGUMENT

I. Evidence of Third-Party Registrations

As a preliminary matter, the examining attorney expressly objects to the evidence submitted in applicant’s brief and refuses to discuss such evidence as it was not properly made of record prior to appeal. TMEP 710.01(c)

II. Mark is Merely Descriptive

Under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), a mark is merely descriptive 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 determination as to whether a mark is merely descriptive must be made in relation to the identified services, not in the abstract. *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); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). The term VOICEXML FORUM is descriptive because it describes the subject matter and a feature of the services. Specifically, applicant’s services concern a VoiceXML forum.

The term VOICEXML describes the subject matter of the services. VOICEXML is a recognized acronym for "Voice Extensible Markup Language."¹ Techencyclopedia defines VOICEXML as "an extension to XML that defines voice segments and enables access to the Internet via telephones and other voice-activated devices."² The numerous Lexis®-Nexis® articles and Internet materials accompanying the final refusal establish that VOICEXML is commonly used to refer to voice extensible markup language. For example, please note the following Lexis®-Nexis® excerpts:

Fiber Optic News, June 3 2002

...Telera Corp., a Campbell Calif.-based company that provides a voice-web platform using *voice extensible markup language (VoiceXML)* to make web content accessible by telephone.

RBOC Update, June 2002

...a Verizon company, have jointly marketed BBN's voice recognition Call Director and other speech-based applications with VoiceGenie's *VoiceXML (Voice Extensible Markup Language) Gateway*. *VoiceXML* is the standard computer language for building interfaces between voice-recognition software and Web content.

Tele.com., July 9, 2001

Intel Corp. product manager David Spencer is a self-proclaimed speech evangelist. These days, he thumping the bible of *voice extensible markup language (VoiceXML)* as the speech recognition technology that will let customers access data using voice commands. (Emphasis added.)

Applicant's identification of record as well as the Internet materials submitted in the final refusal without a doubt evidence applicant's services concern voice extensible markup language, or VOICEXML. Furthermore, the fact that VOICEXML identifies a voice extensible markup computer programming language developed by the applicant and several companies does not mean the term is not descriptive. To the contrary, the

¹ Initial Office Action mailed on March 21, 2001.

following Lexis®-Nexis® selections submitted with the final refusal show the term VOICEXML being used in a descriptive manner.

Mass High Tech, April 15, 2002

Late last month the duo announced that they have found a way to send newspaper content to *VoiceXML-based servers*, which can be accessed by phone using DocKinetics product.

Detroit Free Press, July 30, 2001

Based on the powerful *VoiceXML standard*, it improves the speed and accuracy of voice-controlled commands and has the potential to run everything on a car's dashboard...

Chicago Sun-Times, May 1, 2001

... Voice Platform group recently installed Voice Developer Gateway product in the MAGNET Center to support developer testing of *VoiceXML applications*.

The Washington Post, March 8, 2001

TellMe's tools could have a similar effect. They are based on a scripting standard called *VoiceXML*, a voice version of the Web's basic HTML code. Webmasters post *VoiceXML programs* on their sites, enter the Web address for... (Emphasis added.)

Similarly, the term FORUM is descriptive for a feature of the services; namely, the services involve an on-line association forum. A "forum" is "a discussion group on a particular subject hosted by a BBS, newsgroup, or a mailing list, or another online service."³ The July 18, 2002 article obtained from applicant's website entitled "Press Releases" clearly shows applicant provides an on-line forum for developing VoiceXML standards and procedures.⁴ Additionally, the countless Lexis®-Nexis® articles contained

² Initial Office Action mailed on March 21, 2002.

³ Initial Office Action mailed on March 21, 2001.

⁴ Final Refusal mailed on July 23, 2002.

in the final refusal feature the term FORUM used in relation to ASSOCIATION. The examining attorney offers the following excerpts:

The Advertiser, June 24, 2002

...increasing the demand for Internet and e-mail facilities at conferences, international sporting events, school or community fairs, *association forums*, exhibitions and expos.

IDEA Health and Fitness Source, June 1, 2002

Norma has also given back to IDEA, by serving on different committees and taking part in various *association forums*.

Mortgage Banking, August 1, 2002

...pay for housing, "said Andrew D. Woodward, president of the Mortgage Bankers Association of America (MBA) at an *association forum* in San Diego in February. (Emphasis added.)

In this case, the applicant has combined two descriptive terms to form a descriptive mark. In fact, the material obtained from applicant's website contained in the final refusal shows the proposed mark being used in a descriptive manner. For instance, the October 4, 2001 article refers to the "VoiceXML Forum Conformance Program," "VoiceXML Forum Conformance Activities" and "VoiceXML Forum Sample Documents." Moreover, the descriptive nature of applicant's mark is best demonstrated by applicant's collective membership mark, Registration No. 2554306, for the identical mark, VOICEXML FORUM, which is registered on the Supplemental Register.

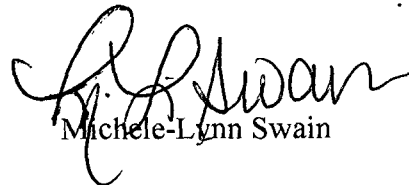
The record of evidence demonstrates that applicant's mark, VOICEXML FORUM, directly refers to the nature of the services. No imagination or supposition is required to deduce that the proposed mark, when used in connection with "trade association services, namely, developing and promoting standards, educating the industry

on such standards and providing conformance programs related to voice extensible language" refers to a VoiceXML forum.

CONCLUSION

Based on the foregoing, it is respectfully requested that the refusal to register the mark on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), be affirmed.

Respectfully Submitted,



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