

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

In re Application of: )  
)  
IEEE Industry Standards and Technology Organization )  
)  
Serial No. 76-106,084 )  
)  
Filed: August 9, 2000 )  
)  
Mark: VOICEXML FORUM )  
)  
Trademark Law Office: 103 )  
)  
Trademark Examiner: Michelle-Lynn Swain )  
)  
Attorney Docket No.: 00-104 )

04-14-2003  
U.S. Patent & TMO/TM Mail Rpt Dt. #22

Assistant Commissioner for Trademarks  
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April 14, 2003

**REPLY BRIEF**

This Brief is in reply to the Examining Attorney's Appeal Brief dated March 25, 2003 concerning Appellant's Notice of Appeal filed on December 23, 2002 of the Examining Trademark Attorney's action finally refusing to register Applicant's VOICEXML FORUM service mark.

The Trademark Attorney premises her argument on the assumption that "VoiceXML" is descriptive and that such determination must be made in relationship to the identified services, not in the abstract. The Trademark Attorney fails to heed such advise, rather she starts with a conclusion, namely: Applicant's service concerns a VoiceXML Forum. Applicant's services concern association services which relate to its proprietary code VoiceXML.

Contrary to the Trademark Attorney's conclusion that because the programming code was developed by founders of Applicant "does not mean that it is not descriptive," Applicant submits that it does mean it is not descriptive. Every one of the illustrations in the Trademark Attorney's Brief show "VoiceXML" being used as a trademark identifying a specific descriptive term such as "standard" which references a specific code identified as VoiceXML. VoiceXML is not, as stated by the Trademark Attorney, "commonly used to refer to voice extensible markup language." The quoted references properly use the term as a mark and as one of a number of languages to interface voice and web content.

The use of "Forum" does not make "VoiceXML Forum" descriptive. The Trademark Attorney refers to a "forum" as a discussion group. Applicant's services are for association services. As pointed out by the Trademark Attorney, the Applicant provides a "Conformance Program," "Conformance Activities" and "Sample Documents". It is difficult to see how the term "forum" is descriptive or even suggestive of any of these programs.

Importantly, even if the terms "VoiceXML" and "Forum" were each considered to be descriptive, "it does not follow, however, that because the components of a compound mark are descriptive, ... the mark in its entirety is descriptive." In re Matsushita Electric Corporation of America, 2002 TTAB LEXIS 488, Serial No. 76/021,398 (TTAB July 29, 2002), *citing* Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 USPQ 557, 559 (TTAB 1975), and stating further: "Instead, the issue of whether a combination of descriptive terms is registrable depends not on the descriptiveness of the terms individually but whether the combination thereof creates a new and different commercial impression. *See, e.g., In re Colonial Stores Inc.*, 394 F.2d 549, 157, USPQ 382, 384-85 (CCPA 1968). Consequently, it is well established that

otherwise descriptive terms may be combined to form a composite mark which is not merely descriptive and hence is registrable."

"VoiceXML Forum" does not describe Applicant's identified services. Only with piecemeal segmentation of the mark with hindsight does that occur.

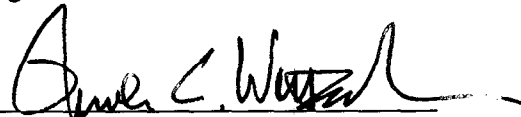
### CONCLUSION

For at least the reasons set forth above, Applicant respectfully requests a reversal of the Trademark Examining Attorney's final action and allowance and registration of the present application.

Respectfully submitted,

IEEE Industry Standards and Technology  
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