

From: Kim, Janice

Sent: 11/10/2008 12:49:49 PM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 76668415 - STRIPPER SOCIETY.COM
- N/A

Attachment Information:

Count: 1

Files: 76668415.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/668415

MARK: STRIPPER SOCIETY.COM



CORRESPONDENT ADDRESS:

Steven A. Gibson
Clary Gibson Lowry LLP
7201 West Lake Mead Boulevard, Suite 503
Las Vegas NV 89128

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Interactive Media Communications

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

sgibson@clarygibsonlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final requirement to disclaim the descriptive wording "STRIPPER SOCIETY.COM" apart from the mark as shown. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

FACTS

On November 1, 2006, the applicant applied to register the mark STRIPPER SOCIETY.COM and design for "Computer services, namely hosting online web facilities for others for interactive discussions; Computer services in the nature of customized web pages featuring user-defined information, personal profiles, photographs and information; Providing a search engine for members to locate other members."

On March 19, 2007, an Office Action was issued requiring Applicant to submit a new drawing and to disclaim the wording “STRIPPER SOCIETY.COM” because it was merely descriptive of Applicant’s services.

On September 14, 2007, the applicant responded to the First Office Action by submitting a new drawing and arguing against the requirement to disclaim the descriptive wording “STRIPPER SOCIETY.COM”.

On November 30, 2007, the examining attorney issued a Final Office Action maintaining the requirement to disclaim “STRIPPER SOCIETY.COM”.

On June 02, 2008, the applicant filed a notice of appeal and on September 02, 2008, the applicant filed its appeal brief. On September 11, 2008, the applicant’s brief was forwarded to the undersigned examining attorney.

The only issue on appeal is whether the wording “STRIPPER SOCIETY.COM” is merely descriptive of the Applicant’s services.

ARGUMENT

The wording “STRIPPER SOCIETY.COM” in Applicant’s mark is merely descriptive of Applicant’ services and should therefore be disclaimed.

The law applicable to this requirement is well settled. The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with

the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); see *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); see *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

In this case, the wording “STRIPPER SOCIETY.COM” merely describes the intended users and the nature of Applicant’s computer services. The term STRIPPER is (1) a person who performs a striptease¹ or (2) a performer who provides erotic entertainment by undressing to music.² The term “SOCIETY” is defined as (1) a voluntary association of individuals for common ends, especially an organized group working together or periodically meeting because of common interests, beliefs, or professions; or (2) a social circle or group of social circles having a clear marked identity.³ The phrase “.COM” is a generic top-level domain (TLD) which merely indicates an Internet address for use by commercial, for-profit organizations and, in

¹ See page 4 of Applicant’s 9/14/2007 Response

² Id.

³ The examining attorney requests that The Trademark Trial and Appeal Board take judicial notice of the definition of the word SOCIETY from Merriam-Webster’s Dictionary® Dictionary of the English Language (2008). The Trademark Trial and Appeal Board can take judicial notice of dictionaries that are readily available and capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. See Fed. R. Evid. 201; 37 C.F.R. §2.122(a); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); TBMP §1208.04; TMEP §710.01(c).

general, adds no source identifying significance. E.g., *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-76, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060-61 (TTAB 2002). Therefore, when the terms STRIPPER and SOCIETY and .COM are combined to form “STRIPPER SOCIETY.COM”, the mark merely refers to the internet address of (1) a voluntary association or social circle of people with common interests who perform a striptease or (2) a voluntary association or a social circle of people with common interests who provide erotic entertainment by undressing to music.

Applicant’s services are “Computer services, namely, hosting online web facilities for members for interactive discussions; computer services in the nature of customized web pages featuring user-defined information, personal profiles, photographs and information; providing a search engine for members to locate other members.” The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); see, e.g., *In re Polo Int’l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In this case, the members of Applicant's computer services who "engage in the interactive discussions," "who customize their web pages with user-defined information, personal profiles, photographs and information," and "who use the search engines to seek other members" will be a social circle of STRIPPERS with common interests, or a STRIPPER SOCIETY. Moreover, STRIPPER SOCIETY.COM also conveys the overall nature of Applicant's computer services. Applicant's "hosting of online web facilities for members for interactive discussions" and "search engines for members to locate other members" create a forum or outlet for STRIPPERS to gather and interact with one another on the basis of common interests. In other words, the computer services facilitate the voluntary association of STRIPPERS online, and thus create an online STRIPPER SOCIETY.

Applicant contends on multiple occasions that "given the variety of definitions for STRIPPER, STRIPPER SOCIETY.COM does not forthwith convey an immediate idea of the qualities or characters of the computer services set forth in the Mark application."⁴ However, Applicant's argument is flawed. Descriptiveness is considered in relation to the relevant goods and/or services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e). Further, that there is an entire audience of consisting of "non-strippers" (e.g. clubs, clientele) who may utilize Applicant's services does not obviate the fact that an end-user of Applicant's computer services are STRIPPERS. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or

⁴ See pg. 8 of Applicant's brief.

services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b). In this case, STRIPPER SOCIETY may not identify all possible users, but it nonetheless identifies an intended and as such is immediately descriptive.

Applicant also contends that “the examining attorney inappropriately relied on what the Examining Attorney perceived to be the Mark’s actual use in commerce, rather than on the scope of services described in the Mark application.” The Applicant goes on further to say, the Federal Circuit has made clear that:

“the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”

Applicant’s assertion is again unsupported. The determination that Applicant’s mark is descriptive is based on the mark’s actual use as evidenced by the Applicant’s specimen of use. Specimens provide part of the basis for examination because they show the manner in which the mark is seen by the public. To that end, Applicant’s specimen of use indisputably shows that the computer services cater to a STRIPPER SOCIETY. This is evidenced by the following wording and images on the specimen:

- “THE SMART CHOICE FOR ENTERTAINERS, CLUBS & CLIENTELE TO CONNECT WORLD-WIDE”;
- “Ultimate Place for Strippers, Entertainers and Clubs to Connect”;
- An ad for STRIPPERS which reads, “STRIPPERS! Do you want to make more money? Learn How to Increase Your Income...” with a photograph of a topless woman adjacent to the ad;

- Several photographs of women scantily dressed;
- A link to an article in the Chicago Sun Times titled, “Strip club’s big women night proves a bust”;
- A link to an article in the Columbia Daily Tribune titled, “Strip club owner guilty of tax evasion”;
- A link to an article or blog about “LAS VEGAS STRIP CLUBS PAYING AGAIN!”;
- A link to an article or blog about “What entices a client to get a dance?”;
- An ad for “ADULT SUPERSTORES” 6 LOCATIONS TO SERVE YOU; and
- An ad for “TREASURES GENTLEMEN CLUB”

In the aggregate, the content of the specimen reflects that Applicant’s computer services cater to and facilitate the coming together of a STRIPPER SOCIETY. There is no ambiguity about the nature of Applicant’s services or who would engage Applicant’s services. The specimen of use clearly shows with verbal and visual cues that the “members for interactive discussions” are STRIPPERS, and that the “web pages featuring user-defined information, personal profiles, photographs and information” will be utilized by STRIPPERS. Therefore, based on the actual use of the mark as evidenced by Applicant’s own specimen of use, the mark is immediately descriptive.⁵

Applicant also contends that “the components of the Mark, when juxtaposed with one another, are inventive and require at least a mental leap in the mind of the consumer to understand that the services to be provided under the Mark consist of web hosting or search engines.” Applicant also argues, “nothing in the text ‘STRIPPER SOCIETY.COM’ indicates with any degree of particularity what this computer-related

⁵ See *Phillips Petroleum Co. v C.J. Webb, Inc. By Change of Name From Chas. J. Webb Sons Co. Inc., D.B.A. Corrosion Reaction Consultants*, 442 F.2d 1376 (C.C.P.A. 1971) where the TTAB stated, “in trying to visualize what other forms the mark might appear in we are aided by specimens submitted with Webb’s application as illustrating ‘the mark as actually used.’” In that case, the Board specifically relied on the specimen of use to determine how the mark would be perceived by purchasers to come to conclusion on the issue of likelihood of confusion.

service is and who this group of people is.” However, not only is Applicant’s position flawed, but this is not the test for descriptiveness. The test is not whether consumers could guess that the services to be provided consist of web hosting or search engines. The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); see, e.g., *In re Polo Int’l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). Thus, after the services are known, the question is whether the mark immediately conveys something about those services and/or goods – and in this case, the answer is “yes”. The mark conveys with extreme particularity who the intended users of the computer services will be, a group of STRIPPERS unified by a common interest or a STRIPPER SOCIETY.

Applicant also argues that “the Examining Attorney unequivocally ‘separated and considered in detail’ the various elements of the Mark in arriving at the conclusion that the Mark was descriptive.” While it is true that close attention was paid to each term comprising the mark, this is not an instance of “dissection”. In determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the

term or mark as a whole. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”); *In re Med. Plastics, Inc.*, 192 USPQ 239, 240 (TTAB 1976) (holding a mark generic when noting that “[t]he Examiner did discuss each word in the mark separately in order to show that the term in its entirety was the apt name of the applicant’s goods. This is not the same thing as dissecting a mark.”) In this case, each element of Applicant’s mark was considered in detail in order to make a comprehensive assessment about the entire meaning of Applicant’s mark.

Applicant also contends that “even if the terms in the text ‘STRIPPER SOCIETY.COM’ were...merely descriptive, the combination of the terms is not necessarily merely descriptive.” Applicant’s position is again unsupported. The mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. See, e.g., *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive for theater ticket sales services). This is not a situation where the combination of two merely descriptive words creates something with a separate and nondescriptive meaning. *In re*

Colonial Stores, Inc., 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark's immediate association with the nursery rhyme "sugar and spice and everything nice"). Rather, this is simply the case where three terms, STRIPPER, SOCIETY and .COM, are coming together to create similarly descriptive term which requires no imagination to understand. There is no incongruity and no leaps are needed to conclude that the mark is the internet address (.COM) for a group of individuals (STRIPPERS), with common interests (a SOCIETY). See, e.g., *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (holding SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084 (TTAB 2001) (holding AGENTBEANS merely descriptive of "computer software for use in development and deployment of application programs on a global computer network"); *In re Putman Publ'g Co.*, 39 USPQ2d 2021 (TTAB 1996) (holding FOOD & BEVERAGE ON-LINE merely descriptive of news and information service for the food processing industry); *In re Copytele, Inc.*, 31 USPQ2d 1540 (TTAB 1994) (holding SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); *In re Entenmann's, Inc.*, 15 USPQ2d 1750 (TTAB 1990) (holding OATNUT merely descriptive of bread containing oats and hazelnuts), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991).

Applicant also argues the third party registrations attached to the Office Action of March 19, 2007 do not support the requirement to disclaim the entire text "STRIPPER SOCIETY.COM" since such registrations only indicate a disclaimer of

the term “SOCIETY” and not the entire text of the marks. The attached third party registrations were attached to illustrate that in the context of a variety of services (e.g. “Providing on-line electronic bulletin boards and chat rooms for transmission of messages among computer users concerning philanthropic activities for creating a better world and performance of community services”; “Association services, namely, promoting the interests of physicians”; “Gemological services, namely, grading, analyzing and testing diamonds”) the Office has found descriptive and required a disclaimer for the term “SOCIETY.” Applicant further argues that “the USPTO has permitted registration on the Principal Register of a variety of similar marks incorporating the word “SOCIETY” without requiring a disclaimer as to the term “SOCIETY” or the entire text of the marks” and provides a list of marks, one of which is not a registered mark (RED SEAL SOCIETY, Serial No. 78673274). While Applicant is correct that Registration Nos. 3148346, 3346104 and 3280713 have not disclaimed the term “SOCIETY,” the nature of these marks are so starkly different from Applicant’s mark because they contain coined phrases or wording. Moreover, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

A better comparison would be to examine Applicant’s mark against Registration Nos. 2936156, 3222387 and 3035215 because like Applicant’s mark, these marks

consist of the combination of merely descriptive terms. Just as a STRIPPER SOCIETY is a group of individuals holding interests common to STRIPPERS, AMERICAN QUILTERS SOCIETY (RN 2936156) is a group of individuals holding interest common to AMERICAN QUILTERS, THE WILDLIFE SOCIETY (RN 3222382) is a group of individuals having common interests about WILDLIFE and SOCIETY FOR HUMANISTIC JUDIASM (RN 3035215) is a group of individuals holding common interests related to HUMANISTIC JUDIASM. Registrations 2936156, 3222382 and 3035215 are all registrations that Applicant has provided in the Response of September 14, 2008, and which have all been registered on the Principal Register on a showing of 2(f) acquired distinctiveness.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the requirement to disclaim the descriptive wording "STRIPPER SOCIETY.COM" be affirmed.

Respectfully submitted,

/janice kim/
Trademark Examining Attorney
Law Office 103
Phone - (571)272-8869
Fax - (571)273-8869
Michael Hamilton
Managing Attorney
Law Office - 103