From: Pate, Tara

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Subject: U.S. TRADEMARK APPLICATION NO. 78939646 - VIRTUAL FIELD EXPERI - 29239-234092

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/939646

MARK: VIRTUAL FIELD EXPERI

CORRESPONDENT ADDRESS:
MARK HARRISON
Venable LLP
P.O. Box 34385
WASHINGTON DC 20043-9998

APPLICANT: Laureate Education, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
29239-234092
CORRESPONDENT E-MAIL ADDRESS:

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Laureate Education, Inc.	:	BEFORE THE
Trademark:	VIRTUAL FIELD EXPERIENCE	:	TRADEMARK TRIAL
Serial No:	78/939646	:	AND
Attorney:	Mark B. Harrison	:	APPEAL BOARD
Address:	Venable LLP P.O. Box 34385 Washington, D.C. 20043	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, Laureate Education, Inc., (hereinafter "applicant"), has appealed the trademark examining attorney's refusal to register the proposed mark "VIRTUAL FIELD EXPERIENCE" pursuant to Trademark Act Section 23(c), 15 U.S.C. §1091(c), on the ground that the mark for which registration is sought is generic for applicant's goods.

II. STATEMENT OF FACTS

On July 28, 2006, applicant filed an intent to use application for registration on the Principal Register for the standard character mark "VIRTUAL FIELD EXPERIENCE" for goods identified as "component part or feature of pre-recorded digital video discs featuring teacher education instruction, and which allows teachers to gain experience in teaching methods through the observation of other teachers and the demonstration of classroom teaching techniques, and printed instructional materials offered therewith as a unit, all for use by teachers as part of obtaining graduate credit toward enhancing teacher credentialing teacher credentials/licenses or enhancing professional development" in International Class 9.

In a Preliminary Amendment dated November 2, 2006, applicant submitted a signed declaration.

In the Office Action dated January 1, 2007, the trademark examining attorney refused registration on the Principal Register on the ground that the proposed mark is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and also inquired into the significance of the wording of the mark in the relevant trade or industry, required applicant to identify the "component part" and "feature" of the identified goods, and required applicant to submit a legible declaration.

On July 3, 2007, applicant amended the identification of goods, but argued that the wording "COMPONENT PART" is accurate and appropriate because the mark will not identify the "pre-recorded digital video discs" as a whole, but rather, will identify a component/feature/section of the pre-recorded digital video discs. Applicant indicated that the wording "VIRTUAL FIELD EXPERIENCE" is applicant's trademark, with no

known recognized meaning in the relevant trade or industry, that the individual words "VIRTUAL," "FIELD" and "EXPERIENCE" are not words that are specific to applicant's trade or industry, and submitted a legible declaration. Lastly, applicant argued that the mark is "suggestive" of applicant's goods, not "merely descriptive."

On August 14, 2007, unpersuaded by the arguments made by applicant in the July 3, 2009 Response to Office Action, the trademark examining attorney issued a final action with respect to the refusal to register the mark under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The trademark examining attorney accepted the amended identification of goods and the response to the inquiry into the significance of the wording in the mark.

On January 17, 2008, applicant amended the application to seek registration on the Supplemental Register, and concurrently filed an Amendment to Allege Use.

On March 4, 2008, the newly assigned trademark examining attorney required additional clarification with regard to the identification of goods, advised applicant that the application was a duplicate of applicant's co-pending application serial number 78/939650[1], requested additional product information, and refused registration on the Supplemental Register under Trademark Act Section 23(c), 15 U.S.C. §1091(c) because the proposed mark is generic for applicant's goods.

On August 29, 2008, applicant amended the identification of goods, submitted materials explaining applicant's goods, and requested reconsideration of the refusal to register applicant's mark.

On November 24, 2008, unpersuaded by applicant's arguments, the trademark examining attorney issued a final action with respect to the refusal to register the mark

[1] Please note that application serial number 78/939650 is also on appeal before the Board.

under Trademark Act Section 23(c), 15 U.S.C. §1091(c). The trademark examining attorney accepted the amended identification of goods, accepted the materials submitted in response to the request for information, and indicated that as the co-pending applications are now distinct, there is no concern with regard to duplicate applications leading to duplicate registrations.

On July 27, 2009, applicant filed its appeal brief with the Trademark Trial and Appeal Board.

On August 14, 2009, the Office reassigned the application to the undersigned trademark examining attorney, Tara J. Pate.

III. ISSUE

The issue on appeal is whether the mark "VIRTUAL FIELD EXPERIENCE" is generic for "Component part of pre-recorded digital video which allows others to gain experience in a wide variety of fields through the observation of others in those same fields, and printed instructional materials in the same aforementioned fields sold together therewith as a unit."

IV. ARGUMENTS

a. The mark "VIRTUAL FIELD EXPERIENCE" is generic for a feature of the identified component part of pre-recorded digital video which allows others to gain experience in a wide variety of fields through the observation of others in those same fields, and printed instructional materials in the same aforementioned fields sold together therewith as a unit.

Registration was refused on the Supplemental Register because the applied-for mark is generic for a key feature of applicant's goods, namely, component part of pre-recorded digital video which allows others to gain experience in a wide variety of fields

through the observation of others in those same fields, and printed instructional materials in the same aforementioned fields sold together therewith as a unit. Trademark Act Section 23(c), 15 U.S.C. §1091(c); *see In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (holding SCREENWIPE generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (holding BUNDT, a term that designates a type of cake, generic for ring cake mix); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (holding ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel, Inc.*, 16 USPQ2d 1469 (TTAB 1990) (holding ICE PAK generic for reusable ice substitute for use in food and beverage coolers); TMEP §§1209.01(c) *et seq.*

A two-part test is used to determine whether a designation is generic:

(1) What is the class or genus of goods and/or services at issue?; and

(2) Does the relevant public understand the designation primarily to refer to that class or genus of goods and/or services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1209.01(c)(i).

With regard to the first part of the test, the class or genus of goods in the present case is the feature of applicant's videos that provides observations of simulated events or activities via computer media. The January 1, 2007 Office Action includes dictionary evidence from *MSN® Encarta®* and *RhymeZone* that defines the term "VIRTUAL" as "simulated by a computer for reasons of economics, convenience, or performance," "FIELD" as "an activity or subject, especially one that is somebody's particular responsibility, specialty, or interest" and "EXPERIENCE" as "the content of

direct observation or participation in an event." The November 24, 2008 Office Action includes additional dictionary evidence from *American Heritage*® that defines the term "VIRTUAL" as "created, simulated, or carried on by means of a computer or computer network."

The term "FIELD EXPERIENCE" is a commonly used term at colleges and universities to refer to work outside of the classroom for credit. The November 24, 2008 Office Action attached evidence from the UNC degrees and programs website, the Central Connecticut State University Department of Teacher Education website, the UHD career services website, the Northwestern University Graduate School Programs in Public Health website, and the Harvard Graduate School of Education website showing use of the term "FIELD EXPERIENCE."

The UNC degrees and programs webpage, found at http://sils.unc.edu/programs/msls/field_exp.html, indicates that "[t]he SILS field experience program enables students to gain professional experience in an information organization, while receiving class credit."

The Harvard Graduate School of Education webpage, found at http://www.gse.harvard.edu/academics/other/fep/team.html, indicates that "[t]he field experience program (FEP) is an internship for credit program open to all students at HGSE. This custom-designed course provides the opportunity to apply theory to practice, do research, develop new skills, and explore different kinds of work."

Thus, applicant's mark is a combination of generic terms. A combination of generic words may result in a unitary designation that is registrable if the meaning is incongruous or the juxtaposition of such words evokes a unique commercial

impression. However, if the combination of two or more generic words is such that each word retains its generic significance, then the combined expression is generic and incapable of denoting source. *See In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE); *see also In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994) (POCKET SURVIVAL TOOL); *In re Lowrance Elecs.*, 14 USPQ2d 1251 (TTAB 1989) (COMPUTER SONAR); *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534 (TTAB 1987) (WASH WAX); TMEP §1209.01(c)(i).

The combination of "VIRTUAL" and "FIELD EXPERIENCE" retains its generic significance for a feature of the identified goods, namely, videos that provide observations of simulated events or activities via computer media.

With regard to the second part of the test, the relevant public of persons in the education field, including those studying various teaching techniques, understands the designation primarily to refer to that class or genus of goods. The trademark examining attorneys attached an abundance of Internet and *LexisNexis* ® evidence, incorporated by reference herein, showing common usage of the mark "VIRTUAL FIELD EXPERIENCE" in connection with the observation or participation in simulated events and activities that occur outside the classroom. A sampling of the Internet evidence shows the generic usage of the mark "VIRTUAL FIELD EXPERIENCE."

The "*Virtual Field Experience: Technology alternative to traditional field experience*" article attached to the January 1, 2007 Office Action explains that "[t]he **virtual field experience (VFE)** is a videoconference that allows MSU students an early peek into elementary school. Through video conferencing preservice teachers observe a lesson taught at an elementary school."

The *"Virtual Field Experiences: Helping Pre-Service Teachers Learn about Diverse Classrooms through Video Conferencing Connections with K-12 Classrooms"* article attached to the January 1, 2007 Office Action states that "[p]ilot projects … have developed models for linking pre-service teachers with K-12 teachers/students for **virtual field experiences**. Advantages of this approach include: developing pre-service teachers' observational skills, experiencing diversity, and providing opportunities for learning to use this technology.

The *"Virtual Field Experiences Using Video Conferencing I"* study attached to the August 14, 2007 Office Action discusses the "effectiveness of **virtual field experiences** including virtual student teaching observations and how virtual experiences can enhance teacher education programs by linking theory and practice."

The "*Virtual Field Experiences using IP videoconferencing: Benefits and Challenges"* abstract included in the March 4, 2008 Office Action indicates that "IP videoconferencing technology is being used to provide connections to PK12 classrooms for observations of teaching[.] A **virtual field experience** allows over 300 students per semester to observe practicing professionals and their classrooms, with faculty to guide the discussion."

The "*A model for video-based virtual field experience"* abstract that was attached to the November 24, 2008 Office Action discusses the use of a model of using "video-based **virtual field experiences** for pre-service teachers" to observe various teaching situations.

This evidence clearly demonstrates that "VIRTUAL FIELD EXPERIENCE" is a common technique used by those in the education field, the field in which applicant's

goods are provided, to refer to the exact feature that is identified as the component part of applicant's goods, namely, gaining experience through the observation of others.

Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Additionally, material obtained from computerized text-search databases, such as LEXISNEXIS®, is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Boulevard Entm't Inc.*, 334 F.3d 1336, 1342-43, 67 USPQ2d 1475, 1479 (Fed. Cir. 2003) (LEXISNEXIS® evidence accepted by the Court to show the offensive nature of a term); *In re Giger*, 78 USPQ2d 1405, 1407 (TTAB 2006) (LEXISNEXIS® evidence accepted by the Board to show surname significance); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (LEXISNEXIS® evidence

accepted by the Board to show descriptiveness); *In re Wada*, 48 USPQ2d 1689, 1690 (TTAB 1998) (LEXISNEXIS® evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Decombe*, 9 USPQ2d 1812, 1815 (TTAB 1988) (LEXISNEXIS® evidence accepted by the Board to show relatedness of goods in a likelihood of confusion determination); TBMP §1208.01; TMEP §710.01(a).

Applicant argues in its brief that virtual reality implies that the user can interact in a seemingly physical way with the identified goods. Because the mark is used to identify a product that allows for observation of others, not interaction, the term "VIRTUAL FIELD EXPERIENCE" fails the "genericness test." (See Applicant's Appeal Brief, page 3)

However as the previously cited dictionary evidence demonstrates, interaction in a seemingly physical way with the goods is not a necessary component of being "VIRTUAL." The videos need only be simulated for reasons of economics, convenience, or performance, or by means of a computer or computer network. Furthermore, the Trademark Trial and Appeal Board has established that "VIRTUAL" immediately informs the potential purchaser that applicant's goods and/or services are "VIRTUAL" or non-physical, or are simulated or provided electronically or online. *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1526 (TTAB 2001) (stating that "people have come to recognize that the term 'virtual,' when used in connection with computers and related goods and services, means that someone at a computer is able to encounter certain things in a non-physical or 'virtual' manner"). Thus, the term "VIRTUAL" in applicant's mark informs the potential purchaser that the videos include content that is simulated, or provided electronically or online.

Applicant also argues that like the "VIRTUAL FASHION" mark in *In re Styleclick.com Inc.*, its mark may be merely descriptive of a significant feature or function of applicant's pre-recorded digital video, but it is not a generic designation for such goods. (See Applicant's Appeal Brief, page 3)

However, the issue before the Trademark Trial and Appeal Board in *In re Styleclick.com Inc.*, was whether the mark at issue, "VIRTUAL FASHION," was descriptive under Section 2(e)(1) of the Trademark Act or merely suggestive. In finding that the mark was indeed descriptive of the identified goods and/or services, it was not necessary for the Board to consider whether the mark is generic. Therefore, it does not follow that all marks containing the term "VIRTUAL" are merely descriptive.

Moreover, a word or term that is the name of a key ingredient, characteristic or feature of the goods and/or services can be generic for those goods and/or services and thus, incapable of distinguishing source. A term does not need to be the name of the goods and/or services to be found incapable of serving as an indicator of origin. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (holding SUDSY generic for ammonia); *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of

candy"); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA 'N' PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); *see* TMEP §§1209.01(c) *et seq.*

In the present case, the mark "VIRTUAL FIELD EXPERIENCE" is the name of a key feature and the function of the identified videos. The videos provide observations of simulated events or activities. Given the common generic usage of the term "VIRTUAL FIELD EXPERIENCE" in the teaching industry, applicant's mark on goods that function to provide that very experience should be refused registration under Trademark Act Section 23(c), 15 U.S.C. §1091(c).

V. CONCLUSION

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal to registration on the Supplemental Register under Trademark Act Section 23(c), 15 U.S.C. §1091(c), be affirmed.

Respectfully submitted,

/Tara J. Pate/
Trademark Examining Attorney
Law Office 112
Phone: 571-272-4714
Fax: 571-273-9112
Angela Wilson
Managing Attorney
Law Office