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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Laureate Education, Inc.

Serial Nos. 78939646 and 78939650

Mark B. Harrison of Venable for Laureate Education, Inc.

Tara J. Pate, Trademark Examining Attorney, Law Office 112
(Angela Wilson, Managing Attorney).

Before Quinn, Zervas and Mermelstein, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Laureate Education, Inc. filed applications to register on the Supplemental Register the designation VIRTUAL FIELD EXPERIENCE 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" in Class 9; and "component part of pre-recorded digital video discs

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featuring education instruction in the field of teaching techniques, and which allows others to gain experience in a wide variety of fields through the observation of others in those same fields, and printed instructional manuals in the same aforementioned fields sold together therewith as a unit" in Class 9.¹

The trademark examining attorney refused registration in each application on the ground that the proposed mark, when used in connection with the goods, is generic.²

When the refusal to register was made final, applicant appealed in each application. Applicant and the examining attorney filed briefs.

The appeals involve common issues of law and fact. Further, the records are essentially identical. Accordingly, we decide the appeals in this single opinion.³

The examining attorney maintains that the class or

¹ Application Serial Nos. 78939646 and 78939650, respectively. The applications, both filed July 28, 2006, were originally based on a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to seek registration on the Supplemental Register, together with an amendment to allege use setting forth dates of first use of September 2006.

² The above-named examining attorney was not involved in the examination of the application; her first appearance in the file is on the appeal brief.

³ Given the common issues of law and fact in these appeals, they could have been consolidated prior to briefing, which would have saved time for applicant, the examining attorney and the Board. Either applicant or the examining attorney could have requested consolidation.

genus of goods "is the feature of applicant's videos and video discs that provides observations of simulated events or activities via computer media." (Brief, p. 2). That is, the goods "provide users with a simulated experience of being in the field." (Final Refusal, Nov. 25, 2008). As such, according to the examining attorney, the goods provide a "virtual" simulation. The term "field experience," the examining attorney claims, is a commonly used term at colleges and universities to refer to work outside of the classroom for training and credit. The examining attorney argues that the designation VIRTUAL FIELD EXPERIENCE is a combination of generic terms, and that each word retains its generic significance in the combination with the other words. The examining attorney introduced dictionary definitions of each of the terms comprising applicant's proposed mark; and excerpts of NEXIS articles and web sites retrieved from the Internet.

Applicant asserts that its mark

is used to identify a product that allows for observation of others, not interaction. Virtual reality implies that the user can interact in a seemingly physical way with the applicant's goods. Rather, the applicant's goods make one an observer of the actions of others. It is "like going on a field trip to observe someone at work" without actually going anywhere.

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(Brief. p. 3). Applicant concedes that "its mark may be descriptive as applied to a feature of the goods," and that "the evidence of record supports a finding that the applicant's mark is merely descriptive of a significant feature or function of applicant's goods"; but applicant argues that the proposed mark is not generic. (Brief, pp. 1-2). That is to say, "[w]hile the public may understand the term VIRTUAL FIELD EXPERIENCE to refer to a subject matter of the applicant's goods, they would not understand it to refer to the class of goods offered by the applicant." (Brief, p. 4).

To be registrable on the Supplemental Register, the matter sought to be registered must be "capable of distinguishing applicant's goods or services" pursuant to Section 23 of the Trademark Act, 15 U.S.C. §1091. Generic terms are, by definition, incapable of indicating a particular source of the goods or services. "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009), *citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir.

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1986). Determining whether a term is generic involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? *Id.* "An inquiry into the public's understanding of a mark requires consideration of the mark as a whole. Even if the constituent words in a combination mark are generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005). See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." *In re Merrill Lynch, Fenner and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). To be generic, members of the relevant public must primarily use or understand applicant's term as referring to the genus of its goods. *Ginn*, 228 USPQ at 530.

Our first task under Marvin Ginn is to determine, based on the record before us, the genus of applicant's

goods. The record includes references to applicant's product offered under the designation sought to be registered:

Why virtual field experience?

- all programs online
- programs designed for working professionals
- while they require site-based field experiences in the traditional sense, we know we are limited by the schools and times available to our working adult teacher candidates, yet we want them to see and experience certain types of instructional strategies
- thus, designed DVD based experiences.

What is virtual field experience?

- trademarked, copyrighted and tech-based offering of Laureate Education available to teacher preparation programs in its worldwide network of accredited universities, including Walden University
- It is filmed in real classrooms with specially selected teachers who epitomize best practices in a specific area or classroom life that candidates should see and interact with

What is VFE?

- Video based field experience featuring a unique play-by-play teacher reflection and analysis component
- An authentic, higher-order thinking assignment, involving application, analysis, and synthesis
- A method of both promoting and accelerating teacher professional growth along a development continuum

VFE benefits to teacher candidates

- engage in a common set of high quality field experiences

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- get into practitioners' heads, gain an understanding not obtainable through observation alone
- see models of effective practices (theory in practice) in diverse settings
- gain access to all types of classrooms
- connect ideas with experience and classroom demo video
- receive carefully constructed standards-based experiences not otherwise available

(www.d.umn.edu)

Virtual Field Experience™
Kendall's School of Education uses the innovative Virtual Field Experience™ to ensure our students experience the best and most diverse selection of teachers, students, and teaching methods. Using DVD segments to capture master teachers in diverse early childhood settings, this play-by-play technique provides a deeper understanding of the complexities of teaching. Lesson plans, student work samples, assessments, and teacher journal entries accompany each Virtual Field Experience™.

(www.kendall.edu)

We find that the genus of goods comprises computer and electronic media (in applicant's case, videos and video discs) with a component or feature that allows others to gain experience in a wide variety of fields, including teacher education, through the observation of others in those same fields.

We next must determine whether the designation applicant seeks to register, VIRTUAL FIELD EXPERIENCE, is

understood by the relevant public primarily to refer to that genus of goods. The present examining attorney has neither relied solely on dictionary definitions nor relied on generic uses of only the constituent terms of the mark sought to be registered. Rather, in addition to the dictionary definitions of "virtual," "field" and "experience," and generic uses of "field experience," the record includes evidence to show that "virtual field experience" as a whole is used generically to name a type or class of product like applicant's in the teacher education field. The evidentiary record, when considered in its entirety, satisfies the Office's burden of proof to show the public's understanding of "virtual field experience" as it relates to applicant's goods.

The following definitions are of record:

Virtual: being something in practice: being something in effect even if not in reality or not conforming to the generally accepted definition of the term; generated by computer: simulated by a computer for reasons of economics, convenience, or performance.

Field: area of activity: an activity or subject, especially one that is somebody's particular responsibility, specialty, or interest; place outside institution: the environment outside a workplace, office, school, or laboratory in which somebody has direct contact with clients, the public, or the phenomena being studied.

Experience: active involvement in an activity or exposure to events or people over a period of time that leads to an increase in knowledge or skill; knowledge or skill acquired: knowledge or skill gained through being involved in or exposed to something over a period of time.
(www.encarta.com)

The examining attorney has made of record numerous excerpts of web sites and articles retrieved from the Internet showing generic uses of "virtual field experience." The excerpts include the following:

The virtual field experience creation tool: a tool so user-friendly even a geologist can use it. Virtual field experiences are becoming more popular--not only as a replacement for real field experiences in places where they are cost-prohibitive, but also as supplements to real-world experiences that allow for new perspectives and learning that could never be acquired in the field alone. This web-based tool will be available at no cost on our department server in the near future, and adequate server space has been allocated to house a growing bank of high quality virtual field experiences.
(www.gsa.confex.com)

Virtual Field Experiences: Helping Pre-Service Teachers Learn about Diverse Classrooms through Video Conferencing Connections with K-12 Classrooms
New IP-based video conferencing systems provide good quality video and audio over the Internet at low cost. Pilot projects as part of a PT3

implementation project 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. Limitations include school Internet firewalls, classroom audio and sometimes video problems, and lack of in-person contact.

Field experiences have been identified as a key means to better prepare teachers for the diversity and complexity of today's classrooms. While field experiences are generally recognized as critically important, many colleges of education, particularly those in rural areas, have difficulty placing students in field settings that provide for needed experience with, for example, diverse student populations and technology. Distance education technologies offer capabilities that can be used to provide needed experiences for pre-service teachers when appropriate field sites are not in close proximity...Particularly promising are IP-based video conferencing technologies that support good quality group-to-group or individual-to-individual video conferencing over the Internet...This paper focuses on...the use of distance education technologies to create virtual field experiences for prospective teachers.

After the site visit, the virtual field experiences began and continued weekly through the remainder of the semester.

Despite some challenges, when we consider all factors these virtual field experiences seem to be a worthwhile way to expose pre-service

teachers to experiences they might not otherwise get. Our teacher education program has at its core emphasis on early and continued field experiences, on developing technological skills, and on understanding diverse learners. Virtual field experiences seem to offer significant promise for expanding the options for linking students in teacher preparation programs with K-12 teachers and students. While we do not advocate replacing traditional field experiences with virtual field experiences, these experiences do seem to offer significant potential for augmenting the experiences of prospective teachers in preparation programs.

(www.purdue.edu)

Virtual Field Experiences: Technology alternative to traditional field experiences

Technology can be a powerful tool in helping preservice teachers understand and grasp educational concepts that may be difficult to explain in traditional formats...The traditional format for exploring, planning and implementing instruction is the field experience...This article considers the use of distance education as an alternative to the traditional field experience...Specifically, I consider Virtual Field Experience (VFE) as an alternative to a traditional field experience.

The virtual field experience (VFE) is a videoconference that allows preservice teachers to peek into or participate in a teaching situation. The VFE program brings together schools, university faculty, teacher candidates, and subject area experts as participants in virtual field experiences that provide opportunities for the students to collaboratively reflect about teaching

and learning shared via distance education.

The virtual field experience (VFE) is a videoconference that allows MSU students an early peek into elementary school. Through videoconferencing preservice teachers observe a lesson taught at an elementary school. The students collectively analyze the teaching and learning illustrated in the teaching episode and dialogue with the elementary school children and the cooperating teacher.

(www.montclair.com)

Virtual Field Experience I

This course utilizes the Math Forum's online system to provide teachers with opportunities to engage with students and take part in diagnosing student understandings and implementing appropriate instructional responses.

(www.drexel.com)

A model for video-based virtual field experience.

Proceedings of the 7th international conference on learning sciences

The purpose of this project is to introduce a model of using video-based virtual field experiences for pre-service teachers mainly in social studies. Although video-based virtual fields become more practical for pre-service teachers to observe various teaching situations, the use of such video-based classroom cases may be limited to provide meaningful experiences.

(www.portal.acrm.org)

Virtual field experiences, modeling excellent elementary science teaching in urban schools, and the infusion of cultural literacy in content course throughout the college career of

prospective teachers should help to alleviate some of the challenges.
(www.ed.psu.edu)

"Virtual Field Experiences: Can Technology Replace Being There?"
This conference will focus on what higher-education institutions are doing to address student teaching through the use of technology-mediated field experiences.
(www.westerncourier.com)

Of particular relevance, deeper understandings between buddies helped sustain virtual field experiences as pre-service teachers who were more invested in their relationships reported in journals being more excited about the two-way video connections...Through actions developed out of virtual field experiences that encouraged altruism and empowerment, pre-service teachers had the opportunity to envision themselves as capable educators...Considering all factors, however, virtual field experiences help meet the multicultural challenge of educating White pre-service teachers in rural settings about diversity and equality in relation to the students they might someday teach.
(www.eastern.edu)

A Freirian framework for technology-based virtual field experiences.
Contemporary Issues in Technology and Teacher Education
(www.citejournal.org)

Investigating Virtual Field Experiences Using Video Conferencing in Undergraduate Teacher Education Programs
In this study I propose to explore factors that influence the success of

utilizing video conferencing in virtual field experiences and virtual student teaching observations at a large teacher education program in the Midwest...The guiding question for this research study is: do virtual field experiences and virtual student teaching experiences for undergraduate preservice teachers offer a high quality alternative to face-to-face field experiences? This proposed study will explore virtual field experiences using video conferencing technologies to determine if virtual field experiences and virtual student teaching observations can be used as an alternative to face-to-face field experiences via the video conferencing medium. Colleges and schools of education are exploring new uses of technology to address areas of need in teacher education programs and further enhance preservice teachers experience by linking theory and practice. Video conferencing technologies hold promise for providing enhanced learning experiences for preservice teachers by providing access to diverse classroom settings for virtual field observations, practicum experiences, and student teaching experiences.
(www.ux1.eiu.edu)

We sought to expand the opportunity described by McDevitt (1996) for preservice teachers to share a common virtual field experience and reflect by way of interactive video conferencing with K-12 teachers.
(Journal of Technology and Teacher Education, March 22, 2001)

Virtual Field Experience: Preparing Future Teachers for e-Learning in Secondary Schools
(www.virtualschooling.wordpress.com)

The record also includes numerous uses of the term "field experience" in relation to gaining personal knowledge in a specific field or area. More specifically, the record establishes that "field experience" is an important feature of teacher educational programs.

Examples include the following:

Field experiences are an integral part of the teacher preparation program...All field experiences are planned and sequenced to extend the principles and practices of the program's theme and knowledge base. In addition, all of the field experience and course work sequences work together to contribute to a teacher candidate's portfolio which is developed over the course of the professional program.
(www.teachered.ccsu.edu)

Career Services - Field Experience
Field Experience is available to all currently enrolled University of Houston - Downtown students who meet the requirements below. Field Experience is designed to help students gain experience in their field of interest while earning credit hours that count toward their degrees.
(www.uhd.edu)

Field Experience Program
Welcome to the Field Experience Program (FEP) at the Harvard Graduate School of Education
The 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.
(www.gse.harvard.edu)

The evidence shows that the terms "virtual" and "field experience" are generic as applied to the goods. We also find, as we must under the case law, that "virtual field experience" as a whole is generic for the goods. The commonly understood and well recognized meanings of the words, as used in "virtual field experience," coupled with the numerous examples showing public use of the designation as a whole in connection with the education of teachers, convince us that relevant consumers will perceive the designation as the name of a product that simulates a field experience. In applicant's case, the "virtual field experience" product is computer media that allows others to gain experience in a given field (as, for example, teaching) through the observation of others in that same field. In applicant's words, the "goods make one an observer of the actions of others. It is 'like going on a field trip to observe someone at work' without actually going anywhere." (Brief, p. 3). That is exactly the type or class of product that is named by the mark, that is, a product that simulates a field experience. While we recognize that applicant's goods are not in the nature of an interactive computer application, the goods still

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provide a "virtual field experience" through the observation of pre-recorded scenarios in a given field, including teaching. Contrary to applicant's argument, the definition of "virtual" does not require that the experience be interactive in nature. Given the widespread generic use of "virtual field experience" in the training of future teachers in the education field, it is incapable of distinguishing applicant's goods from the same or similar goods of others.

Decision: The refusal to register on the Supplemental Register is affirmed.