

ESTTA Tracking number: **ESTTA164567**

Filing date: **09/24/2007**

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

Proceeding	78978113
Applicant	Expo Communications, Inc.
Applied for Mark	VIDEOPINIONS
Correspondence Address	JOSEPH F. NICHOLSON KENYON & KENYON 1 BROADWAY NEW YORK, NY 10004-1007 UNITED STATES
Submission	Reply Brief
Attachments	78978113.pdf ( 10 pages )(457601 bytes )
Filer's Name	Michael J. Freno, Esq.
Filer's e-mail	mfreno@kenyon.com, tmdocketny@kenyon.com, amccarthy@kenyon.com, jnicholson@kenyon.com
Signature	/Michael J. Freno/
Date	09/24/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **Expo Communications, Inc.**

Mark: **VIDEOPINIONS**

Serial No.: **78/978,113**

Examiner: **Steven Foster**

Law Office: **106**

BEFORE THE  
TRADEMARK TRIAL  
AND  
APPEAL BOARD

**APPLICANT'S REPLY BRIEF**

Applicant provides a useful service to consumers, allowing them to, *inter alia*, research consumer products by watching third-party demonstrations of products on the Internet and on television. Before buying a product, consumers often want to touch, feel, see, and experience a product (e.g., a HD television, a camera, an MP3 player), which traditionally, they could only accomplish by going to a brick-and-mortar retail store. Before making a decision to purchase a product on the Internet, consumers cannot experience the product because online retailers typically only show a simple image of the product along with its particular specifications. Applicant's VIDEOPINIONS service expands the consumer's experience of products on, *inter alia*, the Internet and television. It allows consumers to see unbiased third parties' reactions and

demonstrations of products. The VIDEOPINIONS service provides the next best thing to physically handling a product: It allows consumers to watch third-parties handle products.<sup>1</sup>

The Applicant fundamentally disagrees with the Examining Attorney on a number of dispositive points. Applicant contends that the Examining Attorney contorts the meaning of VIDEOPINIONS (based on arbitrarily chosen dictionary definitions) and contorts the Applicant's recited services (based on the purported "context") in an effort to make the two converge to describe a fictional service it describes as "the provision of opinions by means of video." Applicant's opening brief contains substantive responses to each of the Examining Attorney's arguments, and in this reply brief, Applicant responds to certain key arguments raised by the Examining Attorney.

**I. IN DETERMINING WHETHER THE MARK IS DESCRIPTIVE, THE OFFICE IGNORED THE APPLICANT'S IDENTIFIED SERVICES**

The question is whether VIDEOPINIONS merely describes with any particularity a significant aspect of "[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services." In the Examining Attorney's appeal brief, the Examining Attorney acknowledged that the PTO should consider the recited goods or services for which the mark is intended to be used. See Examining Attorney's Appeal Brief ("Ex. Br.") at 10-11 ("The Office has not ignored applicant's recitation of services."). Furthermore, the Examining Attorney acknowledged that in this case, Applicant's "mark does not describe all features of applicant's services." Ex. Br. 13.<sup>2</sup> However, the Applicant and

---

<sup>1</sup> The Examining Attorney seems to characterize Applicant as creating individual videos, e.g., publications in International Class 16, and the Examining Attorney appears to characterize such videos as "video opinions." That is not an accurate description of Applicant's business.

<sup>2</sup> The Examining Attorney seems to acknowledge that VIDEOPINIONS does not "merely" describe Applicant's services with a degree of particularity, which is the controlling legal (continued...)

Examining Attorney disagree as to the extent to which to the PTO can reshape the recited goods or services in an intent-to-use application based on an unsupported portrayal of the “context” in which it the mark will be used.

In this case, the Applicant’s intended services are well-defined: “[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services” in class 41. The PTO, however, in making its Section 2(e)(1) refusal to registration, redefined these services as the “provision of opinions by means of video.” See Office Action, 1/11/06 (Ex. D at 2); Final Office Action, 8/17/07 (Ex. A at 3); see also Ex. Br. at 12 (characterizing Applicant’s services as “the presentation of videotaped consumer opinions and the sharing of commentary and reviews of video”).<sup>3</sup>

**A. The Office Erred By Ignoring the Recited Services in Applicant’s Complaint**

In the Examiner’s Appeal Brief, the Examining Attorney combined all recited classes claimed by Applicant into a single, fictional class, stating: “It seems safe to assume that each class of services will include the provision of consumer information in the form of videos made by consumers, expressing their opinions about various goods and services.” Ex. Br. 13. This assumption is neither safe nor fair.<sup>4</sup> The Examining Attorney’s decision to lump together the specific services claimed by the Applicant demonstrates that the Examining Attorney is completely ignoring Applicant’s recited services. The Examining Attorney treats all of

---

standard under Section 2(e)(1). In re On Technology Corp., 41 USPQ2d 1475, at \*7 (TTAB 1996).

<sup>3</sup> All “exhibits” cited in this brief refer to the exhibits submitted with Applicant’s opening brief.

<sup>4</sup> The Applicant repeatedly asked the Examining Attorney to examine its application for VIDEOPINIONS on a class-by-class basis, and ultimately divided the application into three separate applications in an effort to obtain a separate examination of its mark with respect to classes of 35, 38, and 41.

Applicant's services the same because the Examining Attorney does not even consider the recited services.

As explained in Applicant's opening brief, the present case is analogous to the case of In re TBG Inc., 229 USPQ 759 (TTAB 1986), where the PTO refused registration of SHOWROOM ONLINE as descriptive for "leasing computer databases and video disks in the field of interior furnishings and related products of others." The applicant in TBG provided a database service to third parties which allowed them to show furniture products on the third parties' website. Reversing the refusal, the Board held that the words SHOWROOM and ONLINE did not merely describe the applicant's leasing or information services. Id. at 759. Analogous to the applicant in TBG, the Applicant in this case provides something like a database for providing consumer information. The Applicant itself does not create videos and does not provide opinions on products.<sup>5</sup>

Any recognizable word will be descriptive for something in the universe, but that cannot be the test under Section 2(e). If a company provides 35 distinct products and services, all bearing the same mark APPLE, it stands to reason that even though the mark could be descriptive for some services, that would not render all goods and services descriptive. Nonetheless, the Examining Attorney argues that so long as the PTO can pin its understanding of a mark to any aspect of an applicant's services (even if the applicant does not claim rights to such services in the application), then the PTO can refuse registration for any and all classes of products or services. Applicant disagrees.

---

<sup>5</sup> Although the Examining Attorney suggests that TBG is "easily distinguishable" (Ex. Br. at 14-15), the Examining Attorney points to no particular factual difference, and instead, observes that the two cases generally have different records (as every two cases do). Arguably, the present record harbors a stronger case against descriptiveness because, as the Examining Attorney acknowledged, there is a dearth of third party uses of the mark. Ex. Br. 8 ("evidence of third-party use is not extensive"); see also Ex. B at 2.

Although the Examining Attorney cites In re Abcor, 588 F.2d 811 (CCPA 1978) and In re Gyulay, 820 F.2d 1216 (Fed. Cir. 1987) for the proposition that the PTO may look beyond the recited services to determine descriptiveness, neither of those cases suggest that the PTO may ignore the recitation of goods in an application.<sup>6</sup> Moreover, neither of those cases involved applications based on a bona fide intent-to-use a particular mark under 15 U.S.C. § 1051(b). For a use-based application, an applicant's actual use can provide insights to whether an applicant's recited goods or services accurately and definitively describes those goods or services.

**B. Extrinsic Evidence Should Not be Used to Rewrite the Applicant's Identified Services**

The record does not show that Applicant's services primarily involve the "provision of opinions by means of video." See, e.g., In re Stahlbush Island Farms, Inc., 2005 TTAB LEXIS 548 (TTAB Dec. 20, 2005) (Ex. F) ("The Examining Attorney. . . has been unable to precisely identify what significant aspect of applicant's goods the term 'FARMERS MARKET' immediately describes, speculating instead only as to such generalities as that 'applicant's goods are, in some manner, like those goods found at farmer's markets'; that applicant's 'goods may have the look, taste and smell of fresh fruits and vegetables'; and that 'the goods are somehow like those purchased at a farmers market'."); In re Epigenomics GmbH, 2003 TTAB LEXIS 114, at \*9-10 (TTAB Mar. 6, 2003) (Ex. G); In re Air Control Science, 1997 TTAB LEXIS 185, at \*3-4 (TTAB June 18, 1997) (Ex. H). The Examining Attorney's chief argument appears to be that Applicant itself indicated that the mark describes a significant feature of its service during

---

<sup>6</sup> Indeed, to the extent that the Federal Circuit affirmed, in Abcor, the refusal to register GASBADGE for "device to determine and monitor personal exposure to gaseous pollutants," the PTO went on to allow the applicant to register the same mark for "analysis and reporting of concentration of vapors and gases to which individuals are exposed," in International Class 42. See Reg. No. 1,082,999. Since the PTO allowed one recitation of services but not the other, clearly, the PTO considers the recitation of services as controlling.

examination. Ex. Br. at 2-3. As explained in its opening brief, Applicant contends that its responses to the 37 C.F.R. § 2.61(b) request for information have been misconstrued. The Examining Attorney apparently and originally believed that Applicant generated videos reviewing products or that Applicant provided video reviews (*i.e.*, movie reviews) and asked whether that was the case. Applicant clarified, stating that it does not produce videos or provide movie reviews.

**II. IN DETERMINING THE COMMERCIAL IMPRESSION OF THE APPLICANT’S MARK, THE OFFICE ERRED BY ARBITRARILY CHOOSING TWO DICTIONARY DEFINITIONS MOST CLOSELY MATCHING ITS CHARACTERIZATION OF THE APPLICANT’S SERVICES**

During the more than two years of examination of the Applicant’s mark, the Examining Attorney carefully avoided any explicit statement as to how consumers would interpret the mark VIDEOPINIONS. Instead, the Examining Attorney simply implied that, whatever the mark means, it must be descriptive of Applicant’s services. Now, for the first time, in the Examining Attorney’s Appeal Brief, the Examining Attorney provides a conclusory statement as to what “video” and “opinion” presumably means to consumers in International Class 41 based on dictionary definitions. But the Examining Attorney still provides no evidence or reason to support its selection of particular definitions.<sup>7</sup>

In Applicant’s Opening Brief, the Applicant noted that the Examining Attorney conceded that there is virtually no evidence of VIDEOPINIONS being used descriptively. Ex. B at 2 (“[T]he Office cannot supply a large quantity of evidence of descriptive usage of the phrase ‘video opinions’ by others.”). In its appeal brief, the Examining Attorney does not substantively

---

<sup>7</sup> The Examining Attorney does assert that VIDEOPINIONS can be found in a dictionary. In re Harrington, 219 USPQ 854, 856 (TTAB 1983) (reversing a descriptiveness refusal of COLLEGE ACADEMY for “education services” in part because “the composite of the two words is not a term in general use to describe educational services (or anything else, for that matter) and has no dictionary meaning.”).

contest this, stating: “Although the evidence of third-party use is not extensive, this is partially explainable by the fact that, according to the applicant itself, its business is somewhat novel.” Ex. Br. 8. Since the Examining Attorney concedes that it has no evidence of third party use, the Examining Attorney failed to meet its burden of proof in showing that the Applicant’s mark is merely descriptive. In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567 (Fed. Cir. 1987); In re Grand Forest Holdings Inc., 78 USPQ2d 1152 (TTAB 2006).

**1. Given The Various Definitions of “Video” And “Opinion,” The Expression VIDEOPINIONS or “Video Opinion” Has No Clear Meaning**

Applicant argued in its Opening Brief that there are a lot of possible meanings for “opinion,” “video,” and their combination. The mark VIDEOPINIONS may suggest in the mind of consumers an opinion poll in video format; video recordings of court proceedings or court “opinions”; a video of political or religious issues; written movie reviews, *i.e.*, reviews of videos—none of which would accurately describe Applicant’s intended services. In response, the Examining Attorney states that “[t]he fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness.” Ex. Br. at 5. To the contrary, and as argued in its opening brief, in the case of In re FineLine Lakeshore Servs., LLP, 2006 TTAB LEXIS 339, at \*9-12 (TTAB Aug. 24, 2006) (Ex. K), the Board observed that the fact that a mark has multiple possible meanings makes it more suggestive than descriptive (*id.* at \*9-12), and the Examining Attorney fails to distinguish FineLine. Although the Examining Attorney also insists that “the pertinent definitions submitted by the applicant appear to support the Office’s interpretation of these words, when viewed in the context of applicant’s services” (Ex. Br. at 5), the Examiner offers no explanation or evidence for this proposition. An arbitrary and hindsight selection of dictionary definitions cannot prove descriptiveness.



**2. The Combination of “Video” and “Opinions” Evokes a New and Unique Commercial Impression**

Applicant contends that, irrespective of any dictionary meanings for the words “video” and “opinion,” the mark VIDEOPINIONS evokes a new and unique commercial impression: “When two or more merely descriptive terms are combined, [the Board] must determine whether the combination of terms evokes a new and unique commercial impression.” FineLine, 2006 TTAB LEXIS 339, at \*9-12 (Ex. K).<sup>8</sup> The Examining Attorney relies on the unpublished opinion of In re Visual Analytics, Incorporated, Ser. No. 76-465520, 2005 WL 1822538 (TTAB July 27, 2005) for the general proposition that telescoping words is merely descriptive. Ex. Br. at 8-9.<sup>9</sup> Applicant never argued that telescoped words cannot be descriptive, but rather, Applicant contends that telescoping words is not always descriptive and that the combination of “video” and opinion” is not descriptive of “[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services.” See e.g., Colonial Stores, 394 F.2d 549; In re Werner Electric Brake & Clutch Co., 154 USPQ 328 (TTAB 1967); In re Shutts, 217 USPQ 363 (TTAB 1983); In re Shop Vac Corp., 219 USPQ 470 (TTAB 1983); Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 USPQ 557 (TTAB 1975); In re Idiag, 2001 TTAB LEXIS 475, at \*9 (TTAB June 19, 2001) (Ex. L).

---

<sup>8</sup> Applicant also argued that is no evidence in the record to indicate that consumers would interpret VIDEOPINION as “[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services.” None of the Examining Attorney’s examples of use of the phrase “video opinions” purport to describe Applicant’s class 41 entertainment service.

<sup>9</sup> In that case, the applicant sought DATALERTS for “computer software that monitors changes and additions to information in databases and provides automatic notification to users of changes and additions to information in databases,” in International Class 9. In that case, the applicant’s software product was primarily designed to provide data alerts. Unlike that case, Applicant here does not provide video (i.e., movie) reviews or even reviews in video format. Applicant provides a service, namely, “[e]ntertainment services in the nature of on-going television programs in the field of information about consumer products and services.”

**III. APPLICANT ARGUES THAT VIDEOPINIONS  
COULD AT MOST BE SUGGESTIVE**

The Examining Attorney does not contest Applicant's argument that its mark is at most suggestive and does not contest the fact that third party competitors do not need Applicant's mark to identify their own services. As marks go, VIDEOPINIONS is certainly less descriptive than numerous marks which have been deemed to be suggestive by the Board. See, e.g., Grand Forest Holdings, 78 USPQ2d 1152 (TTAB 2006) (FREEDOM FRIES not descriptive of frozen french fries); In re Intelligent Medical Sys., 5 USPQ2d 1674 (INTELLIGENT MEDICAL SYSTEMS not descriptive of "electronic thermometers for measuring human body temperature."); In re Sundown Technology Inc., 1 USPQ2d 1927, 1928 (TTAB 1986) (GOVERNOR not descriptive for controls used to limit sound from musical amplifier); In re WSI Corp., 1 USPQ2d 1570 (TTAB 1986) (SUPERSAT not descriptive of collecting meteorological information via satellite); In re Southern Nat'l Bank, 219 USPQ 1231 (TTAB 1983) (MONEY 24 not descriptive of automatic teller machines); Harrington, 219 USPQ 854 (COLLEGE ACADEMY not descriptive for education services for gifted children).

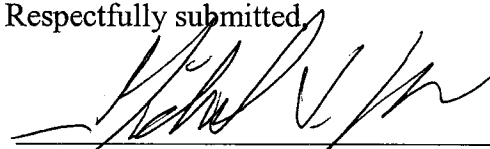
**CONCLUSION**

For the foregoing reasons, the Applicant respectfully requests the Board reverse the refusal to register its mark. In this case, the Applicant respectfully contends that (at the very least) it has raised doubts as to whether the Applicant's mark is "merely descriptive." Moreover, if the Board agrees, Applicant requests that such doubts be resolved in favor of the applicant. In re The Stroh Brewery, 34 USPQ2d 1796, at \*4-5 (TTAB 1995); In re Gourmet Bakers, Inc., 173 USPQ 565, at \*1 (TTAB 1972), accord, On Technology, 41 USPQ2d 1475, at \*8; Telechat Networks, Inc., 2006 TTAB LEXIS 178, at \*8 (Ex. M).

Respectfully submitted,

Dated: September 24, 2007

By:

A handwritten signature in black ink, appearing to read 'Joseph F. Nicholson', written over a horizontal line.

Joseph F. Nicholson  
Michael J. Freno  
KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
*Attorneys for Applicant*