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

Proceeding	91177828
Party	Plaintiff SNOCAP, INC.
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/Martin R Greenstein/
Martin R. Greenstein

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

SNOCAP, INC.,

Opposer,

v.

TODD MEAGHER,

Applicant.

Opposition No.: 91-177,827
Trademark: MYSTORE (stylized)
Serial No. 78/853,849

Opposition No.: 91-177,828
Trademark: MYSTORE.COM
Serial No. 78/853,866

Unopposed Motion to
Consolidate Pending

OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO
OPPOSER'S CROSS MOTION FOR SUMMARY JUDGMENT

A. PREFATORY NOTE ON CONSOLIDATION:

As indicated earlier, Applicant filed a well-taken Motion to Consolidate the two captioned oppositions on July 23, 2007, and Opposer did not and does not object to or oppose consolidation. While no Order has yet issued, the Motion to Consolidate should be granted as conceded and on the merits. Until consolidation is actually ordered however, this document carries a double caption and should apply to each opposition.

B. APPLICANT'S ALTERNATIVE MOTION TO COMPEL DISCOVERY:

Applicant notes that if the Board denies the Alternative Motion to Compel as untimely, as Opposer has requested, Applicant can and will refile its Motion to Compel Discovery upon resumption of the discovery period. Opposer agrees that this is permissible and proper, assuming there are still issues remaining in the oppositions after decision on the pending motion and cross-motion for summary judgment.

C. WHETHER APPLICANT'S MOTION FOR SUMMARY JUDGMENT IS PREMATURE:

Opposer assumes that the Board will either take up Opposer's motion to strike as part of its consideration of the motion and cross-motion for summary judgment, or rule on the motion and ask the parties to reframe their motions for summary judgment taking into consideration that ruling, if and to the extent necessary. Clearly this issue will apply to both the motion and cross-motion for summary judgment - Opposer did not and would not take the position that one is proper and the other improper during the pendency of the motion to strike. Applicant's suggestion that the motion to strike is somehow intended to slow down or drag out the summary judgment proceedings is ludicrous - the motion to strike was filed on August 15, 2007, months before Applicant filed its motion for summary judgment.

D. APPLICANT'S CLAIM THAT OPPOSER'S EVIDENCE HAS MINIMAL RELEVANCE AND PROBATIVE VALUE:

Applicant argues that evidence presented by Opposer is "of little value in this proceeding as it does not refer to any use of Applicant's compound marks in a descriptive manner by a third party in connection with Applicant's service." However, Applicant's argument provides no support for this naked conclusion. Applicant does not argue in any way that Opposer's evidence fails to prove descriptive use, but instead argues that such evidence of use in commerce, as provided by Opposer, has little or no value because it is not trademark/service mark use. Opposer agrees that it is not trademark/service mark use - that is the very point. The phrases in question are used extensively, throughout the industry for their ordinary, descriptive and common dictionary meaning, and the voluminous evidence submitted by Opposer clearly establishes exactly that. It does not - and was not intended to - show that others use the phrases and terms as trademarks or service marks. They are highly descriptive and/or generic, and there is no genuine issue of material fact remaining on that point.

With respect to each category of evidence supplied by Opposer, Applicant simply states, “Opposer’s Exhibits shows no use in commerce of a service mark or of a mark related to the issues presented in this proceeding.” Such a general refutation of Opposer’s evidence suggests that perhaps Applicant did not carefully review the hundreds of pages of Opposer’s exhibits and instead perhaps merely scanned the summary indexes which were provided for convenience by Opposer as a “map” showing the general categories of common, descriptive use.

With respect to Applicant’s characterization of exhibits in “Category E,” Applicant states, “A large number of exhibits themselves appear to have part of the content blocked or removed and may not be an accurate representation of the materials.” This argument is disingenuous - Opposer clearly explained in follow-up communications to the TTAB, on which Applicant was copied, that Opposer highlighted the relevant portions of the web pages for ease of reference, but when the documents were uploaded to the TTAB online system, this highlighting showed up as a blanking out of the underlying text, so that the highlighted words and phrases appear blacked or shaded out. However, the service copies of all of the exhibits, including Exhibit E, which were provided to Applicant, did not have this same problem. Applicant received the exhibits in whole, with no information removed, and copies without highlighting are being provided to the TTAB for proper uploading.

E. APPLICANT’S CLAIM OPPOSER PRESENTS NO EVIDENCE THAT THE MARKS ARE DESCRIPTIVE FOR APPLICANT’S SERVICES:

Applicant correctly states the test for determining whether a mark is merely descriptive, “whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used.” *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Applicant attempts to discredit Opposer’s voluminous evidence of descriptive use by arguing that such evidence is largely irrelevant

because Applicant's marks, "MYSTORE" and "MYSTORE.COM," are composite marks.

Applicant's argument is simply wrong - the evidence establishes beyond any reasonable doubt that the phrase "MYSTORE", its equivalent "MY STORE" and variations such as "MY XXX STORE" merely describe a feature or function of Applicant's services, or alternatively that the term and phrase(s) are generic.

Applicant further argues that third party usage of the "MYSTORE" or variants are demonstrative of third party use as a trade or service mark, and thereby, entitle Applicant to registration as a service mark. Applicant states, "This evidence [of third party uses] demonstrates the capability of MYSTORE and MYSTORE.COM to function as non-descriptive service marks." First, this argument is misplaced because the rules state:

"Each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board." *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

In other words, examining attorneys are not bound by evidence of prior similar registrations, and such an argument is completely without merit. Further, there is nothing in the record that shows or establishes that these many common law descriptive use - hundreds upon hundred of pages and examples - are registered service marks. It is logical to assume that, by extension, if even a registered mark is not binding, then clearly use of phrases which one might claim are common law or unregistered marks is certainly not binding. Furthermore, Opposer does not argue that Applicant's mark is not being by Applicant used as a service mark, but instead is arguing that Applicant should not be entitled to exclusive use of a descriptive and/or generic term.

Second, Applicant fails to address the actual argument made by Opposer, namely, that the pervasiveness of the use of "MYSTORE" and variants for services similar or identical to Applicant's, demonstrates that "MYSTORE" is generic or at the very highly descriptive of

Applicant's services. Furthermore, an admission that there are many businesses using such similar marks in trade would seem to preclude the purpose for which one obtains a trademark registration--a mark has little value if it cannot possibly function as a source identifier. Thus, Applicant's argument prompts a possible argument for likelihood of confusion should the evidence demonstrate other registered marks for "MYSTORE" or MYSTORE.COM." See Applicant's procedurally flawed attempt to introduce evidence (in its reply brief) of Reg #3,319,834 for "MI TIENDA," which translates as "my store."

As stated in Opposer's brief, "The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of (1) the context in which the mark is used or intended to be used in connection with those goods/services, and (2) the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace." *TMEP* § 1209.01(b).

Applicant's claim that "Opposer's Cross-Motion and evidence attached thereto is devoid of analysis of Applicant's mark in relation to Applicant's services," disregards completely Opposer's argument and is simply an incorrect statement of fact. Applicant argues that the marks are suggestive with reference to the following services: "Advertising and information distribution services, namely, providing classified advertising space via a global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases featuring classified listings and want ads." However, the rules make clear that a mark need not be descriptive of all of the goods and/or services to be determinative of descriptiveness. See::

"The mark need not describe all the goods and services identified, as long as it merely describes one of them." *TMEP* § 1209.01(b). See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) ("[T]he Trademark Office may require a disclaimer as a condition of registration if the mark is merely descriptive for at least one of the products or services involved.")

Opposer maintains that with regard to Applicant's services, namely, "providing classified advertising space via a global computer network" and "promoting the goods and services of others over the Internet," the marks merely describe the function of Applicant's Internet based service. Applicant provides advertising space via the Internet for the sale of goods/service of others, which is basically the equivalent of providing a "my store." As stated in Opposer's Cross-Motion for Summary Judgment, it is not significant that such space is provided over the Internet and is not a physical retail space because a "store" is simply "a place where merchandise is offered for sale." The Internet has become a common tool to facilitate the sale of goods and services, and thus, does not change the nature of the services provided by Applicant.

The second part of the inquiry, requires us to determine how the relevant public understands the designation. Evidence of the pervasiveness of "my store" in connection with online platforms and computer software that enable individuals to launch a "my store" (see Opposer's hundreds of pages of exhibits showing this descriptive use, all attested to by the declaration of Nicole Pannoni as to how, when and where they were collected) provide clear evidence of the descriptive significance of these words to the average purchaser in the marketplace. This is especially true when one considers that numerous users, as evidenced by the sheer number of stores launched by individuals through eBay, for example, have come to create a store called "MY STORE XYZ" or "MY XYZ STORE."

In addition, Applicant seems to rely on the fact that he is attempting to register a composite mark. Opposer acknowledges that the inquiry requires an examination of the mark as a whole. Where the mark is a composite of descriptive elements, the mark as a whole is likewise descriptive. As stated by Applicant, "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920).

The problem with Applicant's argument is that the commercial impression of "my store" is, in fact, the very clear descriptive meaning that Applicant wants to avoid. The creation of a "my store" by a party indicates ownership of that store by the individual merchant(s) - it is his/her store that the owner identifies to the public as "my store". Applicant concedes, and there is no possible argument, that the word "store" is not and cannot be anything other than a clearly descriptive or generic term. In effect, the mark is composed of these two descriptive elements - the obviously descriptive possessive article "my" and the equally and admittedly descriptive or generic term "store", and it is for an outlet - albeit an online outlet - that functions as a store. Thus, the average person would understand "my store" as somebody's store, and "my xyz store" as a specific type of store.

F. APPLICANT'S ODD ARGUMENT THAT "MY" IS NOT DESCRIPTIVE OF HIS STORE:

Applicant argues that the word "MY" is not descriptive when used to describe his online, e-commerce "store". While one could probably postulate some circumstance where the word "my", standing alone or perhaps in combination with some other word, might not be descriptive, it is hard to credibly argue that a possessive article used in front of the descriptive word "store" is not descriptive. My store, his store, your store, their store etc. all immediately convey information concerning a quality, characteristic, function, ingredient, attribute or feature of the store - namely, that it is the store of the person identified in the article. Not all descriptive terms require a disclaimer - articles such as "the", "a", "an" etc. and such as "my", in this case, don't require a disclaimer to establish their descriptiveness.

When a term is a compound word, the examining attorney may establish that a term is generic by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." *TMEP* § 1209.01(c)(i).

As discussed above, the fact that other marks have been registered by the PTO is not dispositive of the issue before us. According to *TMEP* 1209.03(a):

“Third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register.” *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977) (SCHOLASTIC held merely descriptive of devising, scoring and validating tests for others). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS held merely descriptive of computer software for use in development and deployment of application programs on a global computer network).

Thus, Applicant’s exhibits AA and BB (aside from being procedurally flawed attempts to introduce evidence in reply brief) do not support a conclusion that “MY” is not descriptive because registrations containing the word “MY” without a finding of descriptiveness are not relevant.

Second, Applicant is “promoting the goods and services of others over the Internet,” and is doing so in its store. Thus, the relevant consumer would understand that “MY” refers to vehicle, i.e., the store, through which Applicant is promoting the goods and services of others. They are not “my” goods and services - they do not necessarily belong to Applicant (they may, but then it wouldn’t be service mark use - it is not service mark use to advertise your own goods and services. In this way, “MY” does indeed describe an “ingredient, quality, characteristic, function, feature, purpose or use” of Applicant’s services - the ownership of the vehicle - the online e-commerce website or “store” which is used to offer and render the service.

G. APPLICANT’S COMMENTS ON OPPOSER’S CROSS-MOTION FOR SUMMARY JUDGMENT

In its initial filing Opposer containing a response to Applicant’s Motion for Summary Judgment and Opposer’s Cross-Motion for Summary Judgment, Opposer explained that the issues in each were inextricably intertwined, and that to avoid needless duplication and repetition of arguments, Opposer requested the Board consider Opposer’s Cross-Motion for Summary Judgment as part

and parcel of Opposer's Opposition to Applicant's Motion for Summary Judgment. Applicant has done the same, making essentially the same request in the last section of its reply papers.

Applicant claims that "Opposer's evidence relates to services which are different from those of Applicant." However, Applicant fails to identify any meaningful differences between Applicant's services and the single chosen example, eBay. The hundreds of pages of exhibits put into evidence by Opposer are self explanatory as unmistakably clear evidence of uses of "my store" in a descriptive and/or generic sense in connection with "promoting the goods and services of others over the Internet," thereby shifting the burden to Applicant.

Furthermore, with regard to any reference to Applicant's services, Opposer's clerical error in omitting or failing to include the term "classified" in the description of services provided in Opposer's brief on pages 14 and 15, was obviously not done intentionally, and does not in any way alter or change the analysis.

V. CONCLUSION

For the foregoing reasons, Applicant's Motion for Summary Judgment in each opposition should be denied; Opposer's Cross-Motion for Summary Judgment in each opposition should be granted, both oppositions should be sustained and registration of the marks MYSTORE and MYSTORE.COM should be denied.

January 10, 2008

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S CROSS MOTION FOR SUMMARY JUDGMENT is being served on January 10, 2008, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to:

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