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May 17, 2006

VIA HAND DELIVERY

Office of the Solicitor
Attention: Nancy Slutter
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TRADEMARK OFFICE
MAY 17 11P 3:50
U.S. PATENT &
TRADEMARK OFFICE

Re: *In re Reed Elsevier*; Appeal No. 06-1309
Working Appendix
Client-Matter No. MDCA:161/10301038

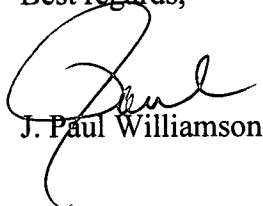
Dear Nancy:

Further to our phone conversation yesterday afternoon, we are now enclosing a working copy of the appendix.

The appendix begins with the Decision from the TTAB, and excludes both the appeal brief and reply brief we had filed with the Board. I am sure there are other documents in here that could have been excluded. We can talk about that further.

I really appreciate your courtesy and help.

Best regards,


J. Paul Williamson

JPW/as
Enclosure



05-17-2006

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Prosecution History Ser. No. 75/530,795

TAB NO.	DATE	DESCRIPTION
1.	02/16/2006	APPEAL TO CAFC
2.	01/31/2006	NOTICE OF INDIVIDUAL WITHDRAWAL AS ATTORNEY
3.	12/16/2005	EX PARTE APPEAL-REFUSAL AFFIRMED
4.	06/14/2005	APPEARANCE RECORD
5.	04/18/2005	ORAL HEARING SCHEDULED FOR 06/14/2005
6.	03/23/2005	REQUEST FOR ORAL HEARING
7.	03/23/2005	REPLY BRIEF
8.	03/03/2005	EXAMINERS STATEMENT
9.	01/18/2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY
10.	01/17/2005	APPLICANT'S APPEAL BRIEF
11.	11/18/2004	EX PARTE APPEAL-INSTITUTED
12.	11/18/2004	EX PARTE APPEAL RECEIVED AT TTAB
13.	05/18/2004	FINAL REFUSAL MAILED
14.	04/13/2004	EXAMINERS AMENDMENT MAILED
15.	01/29/2004	RESPONSE TO OFFICE ACTION
16.	08/12/2003	NON-FINAL ACTION MAIL RETURNED
17.	07/29/2003	NON-FINAL ACTION MAILED
18.	07/08/2003	NON-FINAL ACTION MAILED
19.	05/23/2003	RESPONSE TO OFFICE ACTION
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24.	08/07/2001	FINAL REFUSAL MAILED
25.	01/14/2000	LETTER OF SUSPENSION MAILED
26.	10/28/1999	RESPONSE TO OFFICE ACTION
27.	04/28/1999	NON-FINAL ACTION MAILED
28.	08/03/1998	APPLICATION FILED



Hearing:
June 14, 2005

**This Opinion is
Citable as Precedent
of the TTAB**

Mailed:
December 16, 2005

FULBRIGHT & JAWORSKI, LLP
IPT DOCKETING
Docketed Not Req'd Confirmation

UNITED STATES PATENT AND TRADEMARK OFFICE

Initials 1st _____ Initials 2nd _____ Trademark Trial and Appeal Board

DEC 22 2005

In re Reed Elsevier Properties Inc.

Attorney _____

Docket No. _____
Action Req'd _____ Date Due _____

Serial No. 75530795

Katherine M. DuBray, Tara M. Vold, and J. Paul Williamson
of Fulbright & Jaworski L.L.P. for Reed Elsevier
Properties, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Grendel, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Reed Elsevier Properties Inc. [applicant] initially
applied to register LAWYERS.COM, in standard character
form, as a mark for services identified as "providing
access to an online interactive database featuring
information exchange in the fields of law, lawyers, legal
news and legal services," in Class 42. The application
sought registration on the Principal Register and was based

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on applicant's claim of use of the designation in commerce, with July 30, 1998 asserted as the date of first use and first use in commerce.

Examination History/Evidence

The examining attorney refused registration, asserting that the designation is merely descriptive for the identified services, because it signifies only that applicant provides information about lawyers via the Internet.¹ See Lanham Act Section 2(e)(1), § 15 U.S.C. 1052(e)(1). In addition, the examining attorney provided applicant with information about a prior-filed application which, the examining attorney reported, might present a bar to registration of LAWYERS.COM if the prior-filed application resulted in issuance of a registration. In a subsequent action, however, the examining attorney stated that no such refusal would be issued.

In response to the initial refusal under Section 2(e)(1), applicant refused to concede that either LAWYERS or .COM is descriptive of its services and further argued that the combination LAWYERS.COM, "considered as a whole ... does not immediately convey an idea of the ingredients,

¹ As an alternative basis for refusal under Section 2(e)(1), the examining attorney stated that the designation might be deceptively misdescriptive. That refusal, however, was subsequently withdrawn and is not a subject of this appeal.

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qualities and characteristics of these identified services." Applicant explained that information "about lawyers is not necessarily the whole or even the primary emphasis of Applicant's service," and that the composite designation "is vague, at best, in terms of conveying any specific information."

Notwithstanding applicant's argument, the examining attorney made the refusal under Section 2(e)(1) final. Applicant then amended its application to seek registration on the Principal Register under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), but specifically stated that it was not waiving its right to argue the Section 2(e)(1) refusal on appeal. The examining attorney maintained the refusal under Section 2(e)(1) and rejected applicant's evidence of acquired distinctiveness as insufficient, but offered to consider any further evidence of distinctiveness applicant might later submit.²

Applicant then submitted a declaration from Carol Cooper, the Publisher and Senior Vice President of Martindale-Hubbell, a division of Reed Elsevier Inc., which is licensed to use LAWYERS.COM by applicant. This

² Applicant had submitted the declaration of its president and results of certain searches of the Internet by its counsel. The examining attorney suggested applicant submit information about the type of and expenditures for advertising, samples of

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declaration provides specific figures regarding advertising and sales, among other statements, and reports that "Nielsen has conducted an independent survey chronicling the consumer use of the mark." The declarant asserted that relevant portions of the survey were attached to the declaration, but they do not appear in the record.

Without mentioning the apparently missing survey evidence, the examining attorney issued another office action maintaining the refusal of registration under Section 2(e)(1). The examining attorney asserted that LAWYERS.COM is generic for the identified services and that applicant's evidence of acquired distinctiveness was therefore insufficient to overcome the refusal.

Applicant then amended the application to seek registration on the Supplemental Register. Applicant also amended the description of services to delete the word "lawyers," so that the resulting identification was "providing access to an online interactive database featuring information exchange in the fields of law, legal news, and legal services." (In a subsequent examiner's amendment, the words "access to" also were deleted from the identification.) Applicant explained that its amendment of

advertising, the level of sales of applicant's services, and consumer or other statements of recognition.

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the application to seek registration on the Supplemental Register was made "[w]ithout waiving its right to argue" on appeal against the examining attorney's refusal that LAWYERS.COM is descriptive.

The examining attorney refused registration on the Supplemental Register, referencing arguments and evidence from the previous office action. In addition, the examining attorney asserted that applicant's deletion of the word "lawyers" from its identification of services was a "transparent effort" to avoid Board precedent supporting the refusal and that it was clear from reference to applicant's specimens of use (reprints of numerous web pages accessible through the LAWYERS.COM web site) "that providing information about lawyers is one of the primary purposes of the website."

Applicant responded by arguing that while a term may be descriptive or generic for certain services, that does not preclude its registration for other goods or services. Also, applicant asserted that deletion of the term "lawyers" from its identification was not, as the examining attorney had contended, disingenuous, and applicant explained that it "never argued that its services didn't extend to providing information about lawyers, only that the services now covered by the application don't cover

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such activity." In this response, applicant referenced its earlier amendment of the application "to seek registration on the Supplemental Register," stated that the application "seeks registration of LAWYERS.COM on the Supplemental Register," and concluded its remarks by stating "this application is in condition for registration on the Supplemental Register." Nowhere in the response does applicant reference an alternative position that LAWYERS.COM is registrable on the Principal Register, with or without resort to Section 2(f).

The examining attorney then issued a final refusal to register the mark on the Supplemental Register, on the basis that applicant's mark is generic and incapable of identifying the source of applicant's services. Applicant filed a notice of appeal. The examining attorney and applicant have filed briefs, and an oral hearing was held.

In its reply brief, applicant affirmatively states that it "does not now dispute that LAWYERS.COM is descriptive" in connection with its services, and notes that it had submitted evidence under Section 2(f) and an amendment to the Supplemental Register in acknowledgment of the descriptiveness of the designation.³ While neither the

³ Pursuit of registration under Section 2(f) is a concession that the proposed mark is not inherently distinctive. See Yamaha

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applicant nor the examining attorney has specifically discussed applicant's proffer of evidence under Section 2(f), applicant concluded both its main brief and reply brief by requesting that its proposed mark be allowed to register "on the Supplemental Register or under Section 2(f)." We find that the question of registrability on a claim of acquired distinctiveness has been preserved for appeal. Accordingly, we must determine in the first instance, whether LAWYERS.COM is generic or otherwise incapable of designating source. In making such determination, we have considered the entire record, including the two declarations offered by applicant to show acquired distinctiveness. If we hold the designation not to be generic and instead capable of registration, then we may specifically discuss the arguments and the quantity of evidence of acquired distinctiveness.

International Corp. v. Hoshino Gakki Co., 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). A proposed amendment to seek registration on the Supplemental Register, however, is not an admission that the proposed mark has not acquired distinctiveness. See 15 U.S.C. §1095. Thus, an applicant may argue in the alternative that a non-distinctive designation has acquired distinctiveness and is registrable on the Principal Register or at least is capable of acquiring distinctiveness and is registrable on the Supplemental Register. See Trademark Manual of Examining Procedure §816.04 and Trademark Trial and Appeal Board Manual of Procedure §1215.

The Record

The record on which we must decide the question of whether the proposed mark is generic includes a dictionary definition submitted by the examining attorney of "lawyer" as "one whose profession is to conduct lawsuits for clients or to advise as to legal rights and obligations in other matters."⁴ The examining attorney also has included a definition of "domain name," which explains that a "domain name" is an Internet address "in alphabetic form," "must have at least two parts," and "the part on the right ... identifies the highest subdomain, such as the country (fr for France, uk for United Kingdom) or the type of organization (com for commercial, edu for educational, etc.)."⁵ In addition, the examining attorney submitted a reprint of a web page showing the result of a search for "com" on searchWebServices.com, which reads "On the Internet, 'com' is one of the top-level domain names that can be used when choosing a domain name. It generally

⁴ The definition appears on a reprint of a web page titled Merriam-Webster Online Dictionary. The examining attorney, in the office action that introduced this definition into the record, referenced it as having been retrieved from www.yourdictionary.com. Applicant did not object to the source of the definition and, in its brief, stated that it "does not dispute that this is one definition of the word lawyer."

⁵ From www.computeruser.com/resources/dictionary/definition.

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describes the entity owning the domain name as a commercial organization." Finally, we take judicial notice of the following definition of "TLD": "(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the *generic* top-level domains, such as .com, .org, and .net..." McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001) (emphasis added).

To gauge the likely significance of LAWYERS.COM to prospective consumers or users of applicant's services, the examining attorney relies on the numerous pages from applicant's web site that applicant submitted as specimens. The examining attorney also relies on reprints of various web pages from other entities that the examining attorney views as "evidence demonstrating that web sites devoted to law, legal news, and legal services also provide information about and/or databases of lawyers." (May 18, 2004 office action, the last action prior to this appeal)

Also in the record are reprints of web pages submitted by the examining attorney to show use, by entities other than applicant, of the following domain names:

www.massachusetts-lawyers.com ("Massachusetts-Lawyers.com is a Service of the Law Offices of K. William Kyros, PC in Boston, Massachusetts. The law firm helping [sic] lawyers and their clients use the internet to find qualified legal

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counsel."); www.truckerlawyers.com ("Trucker Lawyers Legal Services for Truckers Nation Wide"); www.new-jersey-lawyers.com ("Our database covers the entire state of New Jersey. Search to find a lawyer in your local area and to suit your specific legal needs."); www.connecticut-lawyers.com ("Connecticut-Lawyers.com is a service that locates Connecticut Attorneys specific to your needs."); www.lep-lawyers.com ("Welcome to the Web site of Levy, Ehrlich & Petriello. This site is designed to provide information about our firm and the services we offer. ... The information you obtain at this site is not, nor is it intended to be, legal advice. You should consult an attorney for individual advice regarding your own situation."); collectionlawyers.com ("We have been collection attorneys for over 20 years. Find out why our clients return again and again."); www.medialawyer.com ("International Entertainment, Multimedia & Intellectual Property Law and Business Network Sponsored by Harris Tulchin & Associates"); and www.wrongfuldeath-lawyers.com ("Wrongful Death Lawyers is intended to provide up to date references and resources for Wrongful Death Lawyers. The links and resources are provided as a public service for attorneys and consumers.").⁶

⁶ The examining attorney also submitted a reprint of a web site

In essence, the examining attorney contends that these domain names establish the need of competitors of applicant to use a generic term, LAWYERS.COM, in their domain names for their respective web sites.

As for the evidence applicant has submitted, there are various submissions intended to establish acquired distinctiveness of LAWYERS.COM, specifically, the two previously-referenced declarations and certain results of an internet search by counsel. In addition, applicant has proffered information about various registered marks "composed of terms that can be considered generic in some contexts, but have still been allowed to register in connection with a narrower description of goods." Brief, p. 15. This evidence was obtained from the USPTO TARR database⁷, which includes information about pending and registered trademarks.

Analysis

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving

from www.personalinjurylawyers.com.au but, because the site appears to aid those searching for personal injury lawyers located in Australia, it is of little, if any, relevance to the question of how United States Internet users would perceive the designation LAWYERS.COM.

⁷ TARR stands for Trademark Applications and Registrations Retrieval.

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genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). The critical issue to determine is whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "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?" Ginn, supra, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See Merrill Lynch, supra, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

1. The Genus of Services

As for the genus of services involved in this appeal, the examining attorney focuses on applicant's identification of services but argues that "providing information about law, legal news and legal services includes providing information about lawyers. Accordingly, the genus of services at issue includes providing information about lawyers." Brief, p. 6. Applicant, on the other hand, focuses less on the identification and asserts, "the genus for its services may be more accurately described as 'interactive database services focusing on a variety of types of law-related information.'" Brief, p. 6. Neither is quite right, for neither acknowledges the "online" nature of the identified services⁸, and applicant's focus on only "law-related information" does not adequately account for the identified information services related to legal services.

In the Magic Wand case, the Federal Circuit stated, "a proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of

⁸ We take judicial notice of the following definition of "online": "... (2) Said of a person who is actively communicating over a network. 'Online' in this sense means your computer is connected to a network host or service and you can participate in Internet activities such as discussion groups or interactive talk sessions." net.speak the internet dictionary p. 138 (1994).

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registration." Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). Applicant also reminds us of the Allen Electric case, in which the Court of Customs and Patent Appeals stated that "trademark cases must be decided on the basis of the identification of goods as set forth in the application." In re Allen Electric and Equipment Co., 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972). Finally, applicant also reminds us of two Board cases that focus on the significance of written identifications: In re Vehicle Information Network Inc., 32 USPQ2d 1542, 1544 (TTAB 1994) ("the question of registrability must be determined ... on the basis of the goods or services as set forth in the application") and In re Datatime Corporation, 203 USPQ 878, 879 (TTAB 1979) ("it is the goods as set forth in the application papers that are determinative of the issue").

The Magic Wand case involved a petition to cancel the mark TOUCHLESS, on the ground that it was generic for services identified as "automobile washing services." The petitioner in that case attempted to focus on a "relevant public" unwarranted by the description of services, specifically, "operators and manufacturers of car wash equipment," rather than purchasers of automobile washing services. Thus, the Federal Circuit's statement that "a

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proper genericness inquiry focuses on the description of services set forth in the certificate of registration" must be read in that context, i.e., as an explanation of the error in petitioner's attempt to have the Board and, later, the Federal Circuit focus on a relevant public not warranted by the description of services. Further, the quoted reference from the Magic Wand case is preceded by the Federal Circuit's observation that "[t]he description in the registration certificate identifies the services in connection with which the registrant uses the mark." Magic Wand, 19 USPQ2d at 1552. The Federal Circuit also observed, "According to the registration, the mark TOUCHLESS is used in connection with automobile washing services." Id. (emphasis added). Thus, it is clear that the analytical focus on the description of services is based on the premise that the description reflects actual conditions of use of a mark. See also, In re American Fertility Society, 188 F3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999) ("The PTO must prove: (1) what the genus of the services the Society provides is..."), and In re Web Communications, 49 USPQ2d 1478, 1479 (TTAB 1998) ("We agree with applicant that its services in the broadest sense would be considered 'consulting services.' But there are many varieties of consulting services and each would

necessarily be further identified as to the particular subject or focus of the services being offered. Here applicant has described a major focus of its services in *the specimens of record* as 'publication and communication via the World Wide Web...' Applicant's services enable its customers to achieve this communication by assisting them in setting up their own Web sites." (emphasis added).

We do not view any of the other three decisions on which applicant relies as stating precepts that run counter to the premise that an identification is rooted in the reality of use. Again, those decisions must be read in context.

In both Allen Electric and Datatime, each applicant was arguing that its goods were of a more specific type than would be apparent from the identification. As the Board explained in Datatime, because Section 7(b) of the Lanham Act bestows upon the owner of a registration the presumption of use of a mark for all goods or services identified in a registration, the question of registrability must be determined by considering any goods or services falling within the literal scope of an identification, and not merely the particular goods or services an applicant may be marketing at the time when registrability is determined. These decisions do not run

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counter to the presumption that an identification of goods or services is rooted in the reality of use but, rather, explain that the presumption extends to all goods or services encompassed by an identification.

In the Vehicle Information case, the applicant was essentially arguing that the relevant public would perceive its services as somewhat different from what they actually were, given the likely connotation of its mark for that public. The Board then focused on the identification in its discussion of possible meanings consumers might find in the mark. This is nothing more than an example of the well-settled rule that likely perception of a mark is not evaluated as an abstract matter but in connection with the identified goods or services.

In accordance with this analytical framework, while we consider applicant's identification as largely defining the genus of services involved in this case, we do so on the premise that the identification is a required element of an application precisely because it is expected to identify the goods or services in connection with which an applicant uses its mark and for which it therefore seeks registration of the mark. We also note that in the recent Steelbuilding.com decision, which involved a genericness refusal, the Federal Circuit began its analysis of the

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genus by focusing on applicant's amended recitation of services ["computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems"], but interpreted the meaning of "computerized on-line retail services" in light of the actual use being made by the applicant on its web site. See In re

Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420, 1422

(Fed. Cir. 2005):

The applicant defined its goods and services, in its amended application, as "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems." Although the definitions of the applicant and of the Board appear nearly identical, the parties understand the phrase "computerized on-line retail services" differently. Applicant sells steel buildings on line, but the record indicates it provides services beyond mere sales.

Id. at 1422.

In the case at hand, we have interpreted the nature of applicant's "online interactive database featuring information exchange in the fields of law, legal news and legal services" in light of what the record shows the database to include and, therefore, what type of information about "law, legal news and legal services" is exchanged between applicant and consumers or users of its website.

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As noted earlier, the specimens of use which applicant submitted are copies of web pages from its web site.⁹ The first such page appears to be applicant's "home" page [www.lawyers.com/site/default] and bears at the top the exhortation "Locate a Lawyer with lawyers.com!" The headline for the page portrays, in large print, "lawyers.com" and adjacent thereto, in smaller print, "Your connection to legal information & resources." Lower on the page are links to other web pages, titled, respectively, "About The Law," "Ask A Lawyer," "Hiring A Lawyer" and "Law Today."

The "About The Law" page presents a list of areas of law that the viewer can click on to view "informative articles about the most common consumer areas of law, as well as background on the judicial system, important laws and cases, and the U.S. Constitution." The page also explains to the viewer "After a quick review of the [selected] article, you'll be better prepared to choose a lawyer by searching our database."

The "Ask A Lawyer" page explains "This area of lawyers.com is designed to provide you with a unique forum in which to ask general questions of our hosting

⁹ We note, too, that the Cooper declaration, in paragraph 3, attests to use of "LAWYERS.COM in commerce in connection with an

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attorneys." The page also explains that the hosting attorneys are practicing lawyers that maintain listings in the Martindale-Hubbell Law Directory, that the information provided through the page is for educational purposes, and that the viewer in need of specific legal advice "should obtain the services of a qualified attorney such as those listed in the Law Directory."

The "Hiring A Lawyer" page contains information on such topics as "Do I Really Need an Attorney?" "Thinking Things Through," "Starting the Process," "Evaluating Your Candidates," "What Will it Cost?" "Your Attorney's Responsibilities to You, the Client," "When Things Don't Go As You Expected," and "Legal Resources."

Finally, the "Law Today" page contains links to specific articles defining areas of the law, to cases in the news or famous cases, and to legal headlines.

We agree with the examining attorney's conclusion that the specimen web pages applicant submitted demonstrate "that applicant's information about the law includes providing information about lawyers and, in fact, is offered for the express purpose of assisting the individual in selecting a lawyer." Brief, p. 4; emphasis added. The

'online interactive database featuring information exchange in the fields of law, lawyers, legal news, and legal services.'

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examining attorney argues, too, that providing information about *legal news* or *legal services*, particularly as demonstrated by applicant's web site, involves providing information about lawyers.

Applicant argues, however, that its deletion of the word "lawyers" from its identification of services "limited its covered services" by excising "online services relating to information exchange in the field of 'lawyers.'" Brief, p. 3. In addition, applicant argues that it "is not seeking federal registration of its mark in connection with all of the different types of content or services available on Applicant's web site" and its mark "is capable of distinguishing its narrower description of services."

Under the circumstances we find the genus of services to be providing a web site¹⁰ with a database of information covering the identified topics of law, legal news and legal services and that a central and inextricably intertwined element of that genus is information about lawyers and information from lawyers.

2. What Will the Relevant Public Understand?

The next question is: who are the members of the relevant public for such services, and what will they

¹⁰ The phrase "online interactive database" in the identification is an apt synonym for "web site."

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understand when confronted with LAWYERS.COM? We conclude that members of the relevant public include lawyers who may be seeking legal information or who may be seeking other lawyers to whom they may refer clients. The relevant public also includes laypersons that may be seeking legal information, legal representation, or referrals.

As noted earlier, the examining attorney has made of record a dictionary definition of "lawyer" that applicant concedes is accurate as one definition of the word. In addition, the examining attorney has put into the record reprints of numerous web pages from web sites that include information on the law, the nature of legal services and information about obtaining a lawyer. These include many of the previously-referenced web sites that utilize "lawyers.com" in their web site domain names, and the web site thelaw.com.

The relevant public, including both lawyers and non-lawyers, when they consider LAWYERS.COM in conjunction with the class of involved services, would readily understand the term to identify a commercial web site providing access to and information about lawyers. Some members of the relevant public would think of a web site that would provide information about lawyers, including their specialties, contact information, and the like, which is

part of what applicant's web site does. It is also likely that some members of the relevant public would think of a web site that allows site visitors to actually contact other lawyers, as exemplified by applicant's "Ask a Lawyer" web page.

A lawyer member of the relevant public might understand, better than a non-lawyer, that the web site would have limitations, for example, that it would include disclaimers and would not present information from lawyers accessible via the site as "legal advice." This, however, does not alter the likelihood that either type of member of the relevant public would think of the web site in the ways we have discussed.

In addition, the likelihood that some members of the relevant public would think of a web site providing online access to lawyers while others might think of a web site providing online information about lawyers does not render LAWYERS.COM non-generic. Either understanding of the term would be generic and the fact that a term may have two generic meanings when considered in connection with a particular class of services does not mean it is not generic. Compare Steelbuilding.com, supra, 75 USPQ2d at 1422-23 (the Federal Circuit found neither of two possible meanings for the mark STEELBUILDING.COM to be generic) with

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Abercrombie & Fitch Company v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 766 (2d Cir. 1976) (stating "a word may have more than one generic use," the Second Circuit found "safari" to be generic in multiple contexts, although not in all contexts). See also Northland Aluminum, *supra* (the Federal Circuit found BUNDT generic for cakes and cake mixes); and Gear Inc. v. L.A. Gear California Inc., 670 F.Supp. 508, 4 USPQ2d 1192, 1197 (S.D.N.Y. 1987) ("A word may have more than one generic use, and it is protected in each of its generic uses from appropriation by any one merchant."), vacated in part, dismissed, 13 USPQ2d 1655 (S.D.N.Y. 1989) (disposition of some claims by summary judgment vacated by a settlement agreement of the parties and all claims dismissed).

Applicant has argued that a term that "may be considered descriptive or generic for some goods or services may still function as a mark in connection with other goods or services or to other markets" and that it "is not seeking to register its mark LAWYERS.COM for selling lawyers or offering the services of lawyers, but for the more limited services now covered by its application." Brief, pp. 8 and 15, respectively. Reference to the decision of In re Seats, Inc., 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985), is helpful in assessing

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this argument. That case involved an application to register SEATS as a mark for "ticket reservation and issuing services for various events by means of a computer," and the Federal Circuit stated: "The term 'seats' may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservation services. Contrary to the Board's statements, Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service..." Id. at 367-68. Just as Seats, Inc. was not selling seats, applicant here is not selling lawyers,¹¹ but it is there that the similarity ends. Though the Federal Circuit noted the Board's concern with "a need of others to use SEATS in describing the present services," there is no indication in the Seats decision that the Board actually had before it evidence of use of the term by other purveyors of ticket reservation and issuance services. In contrast, the record in this case evidences use of "lawyers.com" as part of the domain names of numerous hosts of web sites; and those web sites provide information to lawyers and laypersons that is the same as or very similar to that provided by applicant's

¹¹ The record does not reveal whether applicant is actually "selling" anything, i.e., charging visitors to its web site. Thus, the revenue figures reported in the Cooper declaration are without context and the declarant does tie the figures to particular services or activities of applicant.

Ser No. 75530795

web site. In short, this case does not involve a perceived need for others to use a term, but involves a demonstrated use of the term by others. The relevant public will, therefore, perceive use of "lawyers.com" as indicating a web site (an "online interactive database featuring information exchange") focused on lawyers, legal services, and the areas of the law in which lawyers practice or render their services.

Applicant argues that its web site is different from the sites of others that also employ the term "lawyers.com" in their domain names. Specifically, applicant argues that the other names and web sites are different, because the other names add more specific terms to "lawyers.com" and thus more immediately reveal the nature of the sites, as well as because the lawyer "search or directory feature" of applicant's site is not the site's "primary function, or even the most prominent feature." Brief, p. 7.

Insofar as the first of these two arguments implies that LAWYERS.COM cannot be generic for applicant's site because it is more general and vague compared to such names as truckerlawyers.com and massachusetts-lawyers.com, we do not find the argument persuasive. The name for applicant's site is simply broad in scope, and the content of its web site appears to match that breadth. As for applicant's

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argument that its lawyer search or directory feature is not a primary or prominent feature of its web site, we note the exhortation "Locate a Lawyer with lawyers.com!" on applicant's main web page; and even linked pages, such as its "About the Law" page, explains "After a quick review of the [selected] article, you'll be better prepared to choose a lawyer by searching our database." In short, we agree with the examining attorney that applicant's web site is all about the law, obtaining information on the law from lawyers, and finding lawyers that can help one with a legal problem.

Another argument advanced by applicant is that its LAWYERS.COM name is no less distinctive than many "arguably generic terms" that the USPTO has approved for registration on the Principal or Supplemental Registers. In support of this argument, applicant relies on TARR printouts of information on various registrations, many of which are ".com" marks. There can be no doubt, however, that "the Board ... must assess each mark on the record of public perception submitted with the application." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Accordingly, there is "little persuasive value in the registrations" applicant has submitted. Id. See also, In re First Draft, Inc., 76 USPQ2d 1183 (TTAB 2005)

Ser No. 75530795

(even when the applicant submitted copies of entire files from other registrations, the Board did not find the evidence persuasive).

The final argument applicant advances in its main brief is that under the Federal Circuit's Oppedahl decision, In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004), the ".COM" portion of LAWYERS.COM can only be considered descriptive, not generic. By implication, then, applicant is arguing that LAWYERS.COM cannot be generic if any portion of it is not.

As the Board noted in its decision in the Eddie Z's case, In re Eddie Z's Blinds and Drapery Inc., 74 USPQ2d 1037 (TTAB 2005), we are cognizant of the Federal Circuit's ruling in Oppedahl, which cautions that while the "addition of a TLD such as '.com' or '.org' to an otherwise unregistrable mark will typically not add any source-identifying significance," this "is not a bright-line, per se rule" and that "exceptional circumstances" might yield a different result. Oppedahl, 71 USPQ2d 1374. As the Board also noted in Eddie Z's, it does not view Oppedahl as creating a per se rule that addition of a TLD to an unregistrable term always results in at least a potential mark, i.e., a non-generic compound and, instead, views the Oppedahl decision as leaving the door open for registration

Ser No. 75530795

of combinations of unregistrable terms and TLDs in the exceptional circumstances whereby the combination results in a whole greater than the sum of its parts. Eddie Z's, 74 USPQ2d at 1042. While the Federal Circuit determined in the Steelbuilding.com case that STEELBUILDING.COM had a non-generic meaning and was therefore registrable, we do not find the designation now before us to present such exceptional circumstances.

Because we find LAWYERS.COM generic, we do not address applicant's arguments that the designation is merely descriptive and that there is sufficient acquired distinctiveness to allow registration under Section 2(f).

Decision: The refusal of registration on the ground of genericness is affirmed.

U.S. PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
ORAL HEARING APPEARANCE RECORD

EX PARTE APPEAL

APPLICATION SERIAL NO. 75-530,795
HEARING DATE: June 14, 2005
TIME: 11:00am

HEARD BY ADMINISTRATIVE TRADEMARK JUDGES:

Grendel Rogers Drost

APPLICANT'S NAME: REED ELSEVIER PROPERTIES, INC
APPLICANT'S COUNSEL: J. Paul Williamson

TRADEMARK EXAMINING ATTORNEY: Kathleen M. Vanston



United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

In re Reed Elsevier Properties Inc.
Serial No. 75530795

Mailed: April 18, 2005

Hearing Date: June 14, 2005

Time: 11:00am

Madison Building (East Wing)
600 Dulany Street
Alexandria, VA 22313-1450

The Board has scheduled an oral hearing in the above identified proceeding on the date and at the time indicated above.

If any party, or its attorney, does not appear when the case is called, that party's right to an oral hearing will be considered to have been waived.

In the case of an oral hearing on an ex parte appeal, oral arguments will be limited to twenty minutes for the applicant and ten minutes for the Examining Attorney, unless a longer period is requested and permitted in advance of the date set. The applicant may reserve part of its time for rebuttal.

In the case of an oral hearing on an inter partes proceeding, oral arguments will be limited to thirty minutes for the plaintiff and thirty minutes for the defendant. The plaintiff may reserve part of its time for rebuttal.

Any party who intends not to be present for the oral hearing should notify the Board in advance of the hearing date.

Any party who intends not to be present for the oral hearing should notify the Board in advance of the hearing date.

The Board will reschedule an oral hearing, at the request of a party, if there is a reasonable basis for the request. But, absent compelling circumstances or the consent of the opposing party, the Board will not change a hearing date if the request to reschedule is made within two weeks of the scheduled hearing date. A party who wants to reschedule an oral hearing should first notify the Board by telephone [(571) 272-8500] and then submit to the Board, by fax [(571) 273-8500], a written request to reschedule, stating the reasons for the request and whether the opposing party has consented to the rescheduling.

Bernadine Abdi
Secretary
Trademark Trial and Appeal Board
(571) 272-6232

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United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: March 23, 2005

In re Reed Elsevier
Properties Inc.

Serial No. 75530795

Filed: 08/03/1998

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2623

Rochelle Ricks, Paralegal Specialist:

Applicant's request for oral hearing filed March 23,
2005 is noted and applicant will be contacted and a date for
the oral hearing will be scheduled in due course.

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FULBRIGHT & JAWORSKI

ESTTA Tracking number: **ESTTA28910**

Filing date: **03/23/2005**

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

Proceeding	75530795
Applicant	Reed Elsevier Properties Inc.
Correspondence Address	J. PAUL WILLIAMSON FULBRIGHT & JAWORSKI L.L.P. 801 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2623 UNITED STATES wotrademark@fulbright.com
Submission	Request For Oral Hearing
Attachments	Hearing Request.pdf (1 page)
Filer's Name	Katherine M. DuBray
Filer's e-mail	kdubray@fulbright.com, wotrademark@fulbright.com
Signature	/Katherine M. DuBray/
Date	03/23/2005

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

Applicant:	§	
Reed Elsevier Properties Inc.	§	
Mark:	§	Law Office: 103
LAWYERS.COM	§	
Serial No.:	§	Examining Attorney:
75/530,795	§	Kathleen M. Vanston, Esq.
Filed:	§	
August 3, 1998	§	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

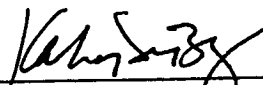
REQUEST FOR ORAL HEARING

Applicant, pursuant to Trademark Rule 2.142(e)(1), hereby requests that an oral hearing be granted in connection with the appeal filed in the above-identified application.

Respectfully submitted on behalf of

REED ELSEVIER PROPERTIES INC.

Dated: March 23, 2005



Katherine M. DuBray, Esq.
Tara M. Vold, Esq.
J. Paul Williamson, Esq.
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2623
Telephone: (202) 662-0200

Attorneys for Applicant

DuBray, Katherine M.

From: estta-server@uspto.gov
Sent: Wednesday, March 23, 2005 12:39 PM
To: DuBray, Katherine M.; Washington Office Trademark
Subject: ESTTA. Request For Oral Hearing confirmation receipt ID: ESTTA28910

Ex Parte Appeal No.: 75530795

Tracking No: ESTTA28910

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

Proceeding: 75530795
Applicant: Reed Elsevier Properties Inc.
Correspondence Address: J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.

801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2623
UNITED STATES
wotrademark@fulbright.com Phone:

Submission: Request For Oral Hearing

Attachments: Hearing Request.pdf (1 page)

Filer's Name: Katherine M. DuBray
Filer's e-mail: kdubray@fulbright.com, wotrademark@fulbright.com
Signature: /Katherine M. DuBray/
Date: 03/23/2005



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

Proceeding	75530795
Applicant	Reed Elsevier Properties Inc.
Correspondence Address	J. PAUL WILLIAMSON FULBRIGHT & JAWORSKI L.L.P. 801 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2623 UNITED STATES wotrademark@fulbright.com
Submission	Request For Oral Hearing
Attachments	Hearing Request.pdf (1 page)
Filer's Name	Katherine M. DuBray
Filer's e-mail	kdubray@fulbright.com, wotrademark@fulbright.com
Signature	/Katherine M. DuBray/
Date	03/23/2005

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

Applicant:	§	
Reed Elsevier Properties Inc.	§	
	§	Law Office: 103
Mark: LAWYERS.COM	§	
	§	Examining Attorney:
Serial No.: 75/530,795	§	Kathleen M. Vanston, Esq.
	§	
Filed: August 3, 1998	§	

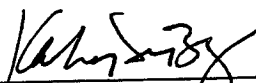
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR ORAL HEARING

Applicant, pursuant to Trademark Rule 2.142(e)(1), hereby requests that an oral hearing be granted in connection with the appeal filed in the above-identified application.

Respectfully submitted on behalf of
REED ELSEVIER PROPERTIES INC.

Dated: March 23, 2005



Katherine M. DuBray, Esq.
Tara M. Vold, Esq.
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Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
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Telephone: (202) 662-0200

Attorneys for Applicant



Please place on Upper Right Corner
of Response to Office Action On...

Examining Attorney: VANSTON, KATHLEEN M.

Serial Number: 75/530795

MAR - 3 2005

UNITED STATES

SERIAL NO: 75/530795

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: LAWYERS.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

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FULBRIGHT & JAWORSKI

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal under Trademark Act Section 23(c), 15 U.S.C. Section 1091(c), because the proposed mark is incapable of identifying the applicant's services and distinguishing them from those of others.

FACTS

Applicant filed an application seeking to register LAWYERS.COM for "providing access to an online interactive database featuring information exchange in the fields of law, lawyers, legal news and legal services," in Class 42. The examining attorney issued a refusal under Section 2(e)(1) of the Trademark Act because the mark was descriptive and, in the alternative, misdescriptive of the

services. The examining attorney also cited a prior pending application which could possibly create a bar to registration under Section 2(d) of the Trademark Act.

The applicant responded, arguing against the refusal. The examining attorney suspended the application pending the disposition of the prior pending application.

When the prosecution was resumed, the examining attorney indicated that she would not cite the prior pending application against the applicant. The examining attorney withdrew the refusal under Trademark Act Section 2(e)(1) because the mark was misdescriptive in relation to the identified services. The examining attorney issued a final refusal under Section 2(e)(1) of the Trademark Act because the mark described the services.

Applicant responded by claiming that the mark had acquired distinctiveness under Section 2(f) of the Trademark Act. The examining attorney responded by noting the highly descriptive nature of the mark and requesting more evidence of distinctiveness.

Applicant responded by submitting additional evidence of acquired distinctiveness. However, the examining attorney determined that the mark was generic and incapable of distinguishing applicant's services from the services of others.

Applicant responded by amending the application to seek registration on the Supplemental Register. Applicant also amended its services to "providing access to an online interactive database featuring information exchange in the fields of law, legal news and legal services," in Class 42.

The examining attorney refused registration under Section 23 of the Trademark Act because the mark was incapable of distinguishing applicant's services from the services of others. Applicant argued against this refusal.

The recitation of services was amended to "providing an online interactive database featuring information exchange in the fields of law, legal news, and legal services" in Class 42. The examining attorney issued a final refusal under Section 23 of the Trademark Act. The applicant has appealed this final refusal.

ARGUMENT

A proposed mark is unregistrable on the Supplemental Register if it consists of a generic term combined with a top-level domain (TLD), such as .COM. TMEP §§1209.03(m) and 1215.05. The TLD will be perceived by prospective customers as part of an Internet address, and, therefore, have no source identifying significance. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.").

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832

(Fed. Cir. 1999). Generic terms are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

A two-part test is used to determine whether a designation is generic: (1) What is the class or genus of goods or services at issue? (2) Does the relevant public understand the term primarily to refer to the class or genus of goods or services at issue? *See H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); TMEP §1209.01(c)(i).

**THE GENUS OF SERVICES IS INFORMATION, IN PART,
ABOUT LAWYERS.**

With respect to the first portion of the genericness inquiry, applicant has identified its services as information services pertaining to law, legal news, and legal services.¹ Since it has already been established that “.com” has no source indicating significance, the issue is whether information about lawyers is the class of services at issue, or more particularly, whether information services about law, legal news and legal services include information about lawyers.

¹ Applicant's services originally included information services pertaining to lawyers. The term “lawyers” was deleted during the prosecution of the application.

In *In re Cyberfinancial.Net, Inc.*, the applicant sought to register BONDS.COM for “providing information regarding financial products and services...” The applicant also stated in an affidavit that the applicant did not buy or sell bonds. The Trademark Trial and Appeal Board (TTAB) found, however, that “financial products” in the recitation of services included bonds. In the same way, providing information about law, legal news and legal services includes providing information about lawyers. These topics are inextricably linked. Nowhere is this more clear than on applicant’s web site.

The material that applicant has submitted for the record demonstrates that applicant’s information about the law includes providing information about lawyers and, in fact, is offered for the express purpose of assisting the individual in selecting a lawyer. For example the following is taken from applicant’s specimen of record, consisting of material found on applicant’s website at www.lawyers.com.

The more you know about the legal system and specific areas of law, the easier it will be to select a competent attorney for your particular situation...It’s advantageous if you have a basic understanding of your legal issue, the legal system and how it can best serve you....After choosing a topic below, you’ll see a brief description of that section. After a review of the article, you’ll be better prepared to choose a lawyer by searching our database.

Further on, the web site contains the following material.

This area of lawyers.com is designed to provide you with a unique forum in which to ask questions of our hosting attorneys... All information provided in this area is for educational purposes only and should not be construed as legal advice. For specific legal advice...you should obtain the services of a qualified attorney such as those listed in the Law Directory.

The material of record demonstrates that applicant provides information about the law as a way of educating individuals so that they can better assess the information about lawyers that the applicant provides. Providing information about law includes providing information about lawyers.

Applicant's web site also provides legal news about particular areas of law as a way of assisting individuals in determining if legal issues exist and whether they need assistance from a lawyer.

For example, the following is of record.

Elder law is a fast growing area of the law. Many of us need some assistance or have someone close to us who needs advice with the issues and problems associated with aging.

Of course, one of the areas of law about which applicant provides more information is "Elder Law." Next to the heading "Areas of Law," of which "Elder Law" is one, the web site states that "[A]fter a quick review of the article, you'll be better prepared to choose a lawyer by searching our database." It is apparent that providing legal news can include providing information about lawyers.

Finally, applicant's recitation of services indicates that it provides information about legal services. A "lawyer" is one whose professions is to conduct law suits for clients or to advise as to legal rights and obligations in other matters. (See <http://www.yourdictionary.com> attached to the office action of May 17, 2004). "Legal services, " therefore, are provided by lawyers. It would be impossible to provide information about legal services without providing information about lawyers. Applicant's information about legal services includes and references information about lawyers.

Applicant's web site contains a section titled "Hiring a Lawyer." In that section, applicant references "legal services" and provides some information to assist an individual in determining whether he needs legal services. If he does need legal services, applicant notes the following.

You can search at lawyers.com for attorneys in your geographical area who have experience in the legal field with which you are concerned. If you have compiled a list of attorney candidates, lawyers.com can help add to your list, provide you with important information concerning the credentials of your candidates....

This particular section of applicant's web site demonstrates beyond doubt that applicant's information about legal services includes information about lawyers. Therefore, providing information about law, legal news and legal services includes providing information about lawyers. Accordingly, the genus of services at issue includes providing information about lawyers.

**THE PURCHASING PUBLIC UNDERSTANDS LAWYERS.COM
TO REFER TO THE CATEGORY OF SERVICES AT ISSUE.**

The second issue is whether the relevant public understands the term LAWYERS.COM to refer to the category of services at issue, namely, information services in the field of law, legal news and legal services, including information about lawyers. The evidence of record demonstrates that the public understands LAWYERS.COM to refer to these services.

A "lawyer" is one whose professions is to conduct law suits for clients or to advise as to legal rights and obligations in other matters. (See <http://www.yourdictionary.com> attached to the office action of May 17, 2004). In other words, lawyers provide legal services and information about the law. As was demonstrated above, applicant's information services pertain to the law, legal news and legal services and include information about lawyers. Because lawyers constitute at least a

portion of the subject matter of the information services provided by applicant, the term is a generic name for the information services, themselves. Other entities wishing to provide information about legal services, legal news and the law, including information about lawyers, would need to use the generic term in connection with their services. Just as the TTAB found in *In re Cyberfinancial* that BONDS.COM should be freely available for others to adopt so that designations such as ACMEBONDS.COM or UNITEDBONDS.COM could be used by competitors, so LAWYERS.COM should be freely available for use by others as well.

To see how the purchasing public views term encompassing LAWYERS.COM, attention is directed to how the term is already in use on the web. For example, the following are of record. MASSACHUSETTS-LAWYERS.COM provides information about legal issues and assistance in locating an attorney. (See <http://www.massachusetts-lawyers.com> attached to the office action of December 3, 2002). TRUCKERLAWYERS.COM provide information about work-related legal issues and assistance in locating an attorney. (See <http://www.truckerlawyers.com> attached to the office action of December 3, 2002). CONNECTICUT-LAWYERS.COM provides legal information and assistance in locating an attorney in Connecticut. (See <http://www.connecticut-lawyers.com> attached to the office action of December 3, 2002). LEP-LAWYERS.COM. provides information about lawyers and specific practice areas. (See <http://www.lep-lawyers.com> attached to the office action of December 3, 2002).

All of this evidence demonstrates that the purchasing public has come to see LAWYERS.COM as a reference to the category of services at issue, namely, information services in the field of law, legal news and legal services, including information about lawyers.

**THE COMBINATION OF THESE TWO GENERIC TERMS
RESULTS IN A GENERIC TERM.**

A combination of generic terms may result in a unitary designation that is registrable if the juxtaposition of terms is incongruous or evokes a unique commercial impression. However, if the combination of two or more generic terms is such that each term retains its generic significance, then the combined expression is generic and thus incapable of denoting source. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). *See also Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, 559 F. Supp. 1270, 218 USPQ 71 (S.D.N.Y. 1983) (AIR SHUTTLE); *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 196 USPQ 121 (D. Oregon 1976), *aff'd* 202 USPQ 401 (9th Cir. 1979) (SURGICENTER).

Applicant seeks to register a generic term, "lawyer" which cannot function as a source indicator in connection with the recited services in combination with a top level domain indicator ".com" which also has no source identifying significance. The combination of these two terms does not result in a term with source indicating capability.

THIRD PARTY REGISTRATIONS ARE IRRELEVANT.

Applicant has made reference to a number of third party registrations in an attempt to argue that they are somehow relevant to the registrability of the mark in this application. Third-party registrations are not conclusive on the question of descriptiveness or genericness. Each case must be considered on its own merits. A proposed mark that is merely descriptive or generic does not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

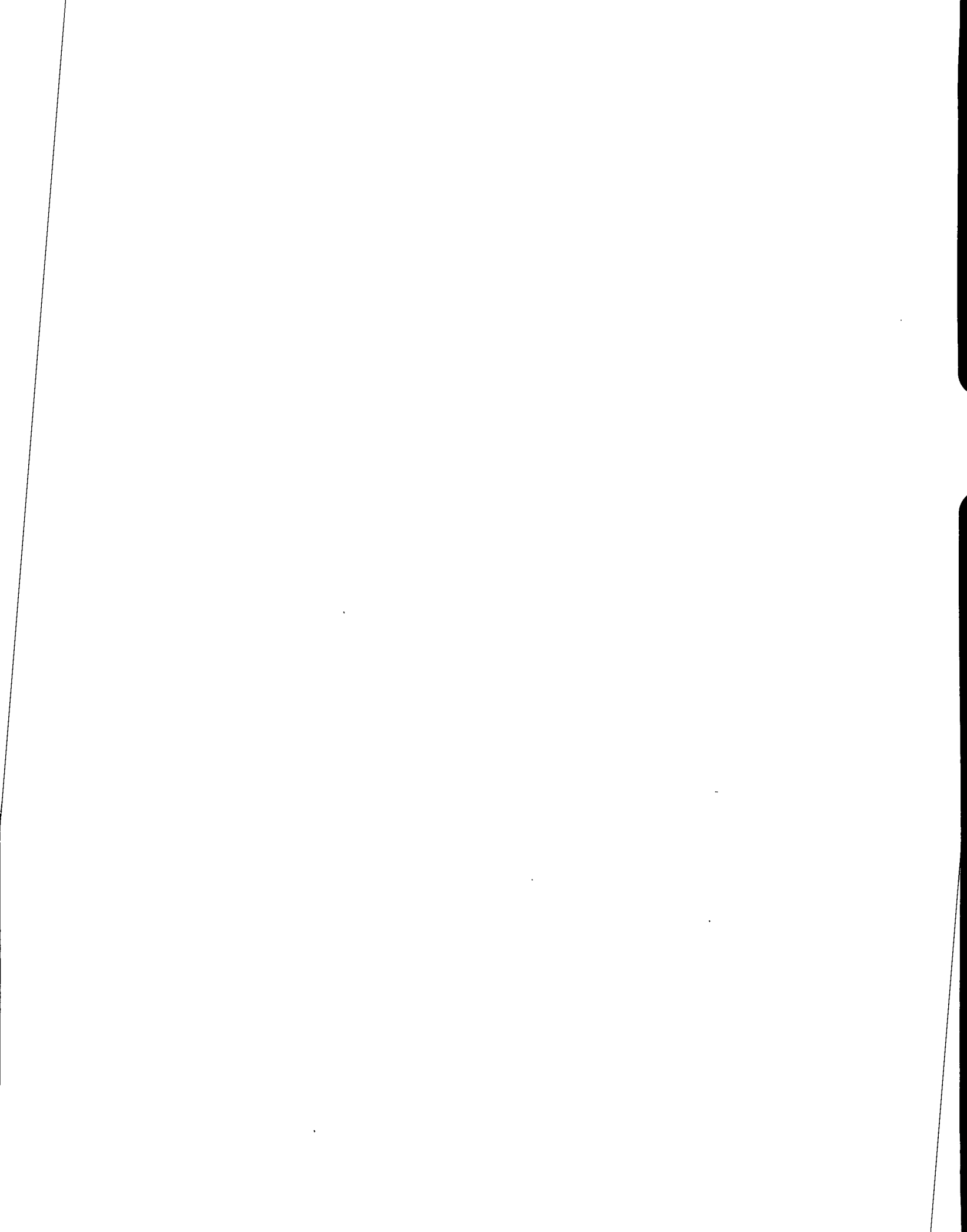
CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 23(c) of the Trademark Act, 15 U.S.C. Section 1091(c), for the reason that the mark is incapable of identifying applicant's services from the services of others, should be affirmed.

Respectfully submitted,

/Kathleen M. Vanston/
Examining Attorney
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(571) 272-9235

Michael Hamilton
Managing Attorney
Law Office - 103



United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 18, 2005

In re Reed
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Serial No. 75530795

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J. PAUL WILLIAMSON
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801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2623

Rochelle Ricks, Paralegal Specialist:

Applicant's brief filed January 17, 2005 is noted and the application file is forwarded herewith to the Trademark Examining Attorney for her brief in accordance with Trademark Rule 2.142(b).

A request for an oral hearing, if desired, is due not later than ten days after the due date for applicant's reply brief.

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A51

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAILED: November 18, 2004

IN RE:
Reed Elsevier Properties Inc.

SERIAL NO. 75530795

APPEAL RECEIVED: 11/18/2004

BRIEF DUE: 1/17/2005

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

ESTA19498

The appeal and appeal fee in the above-entitled application were received on the date indicated above.

The Trademark Rules of Practice provide that the brief of the applicant must be filed within sixty days after the date of the appeal. Applicant must also indicate, not later than ten days after the due date for applicant's reply brief, if an oral hearing is desired.

New Developments at the Trademark Trial and Appeal Board

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at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

DuBray, Katherine M.

From: ESTTA@USPTO.GOV
Sent: Thursday, November 18, 2004 10:59 AM
To: Washington Office Trademark
Subject: Exparte Appeal

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAILED: November 18, 2004 _____
IN RE: _____
Reed Elsevier Properties Inc. _____
SERIAL NO. 75530795 _____
APPEAL RECEIVED: 11/18/2004 _____
BRIEF DUE: 1/17/2005 _____

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

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Himes-Escamilla, Traci

From: estta-server@uspto.gov
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Notice of Appeal.

Tracking No: ESTTA19498

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Printable version of your request is attached to this e-mail

—
ESTTA server at <http://estta.uspto.gov>

ESTTA Tracking number: ESTTA19498
Filing date: 11/18/2004

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

Application Serial No.:75530795
Applicant: Reed Elsevier Properties Inc.

Notice of Appeal

Notice is hereby given that appeal to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 75530795.

The refusal to register has been appealed as to the following class of goods/services:
IC 042

Respectfully submitted,
J. PAUL WILLIAMSON

/jpw/

11/18/2004

J. PAUL WILLIAMSON

FULBRIGHT & JAWORSKI L.L.P.

801 PENNSYLVANIA AVENUE, N.W.

WASHINGTON, DC 20004-2623

UNITED STATES

wotrademark@fulbright.com Phone:(202) 662-0200



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

Application Serial No.	75530795
Applicant	Reed Elsevier Properties Inc.

Notice of Appeal

Notice is hereby given that Reed Elsevier Properties Inc. appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 75530795.

The refusal to register has been appealed as to the following class of goods/services:

- IC 042

Respectfully submitted,

/jpw/

11/18/2004

J. PAUL WILLIAMSON
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/530795

MAY 18 2004

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: LAWYERS.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/530795

This letter responds to the applicant's communication filed on January 29, 2004.

The refusal under Section 23 of the Trademark Act is CONTINUED and made FINAL.

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

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

- (1) What is the class or genus of goods or services at issue?

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MAY 18 2004

A60

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(2) Does the relevant public understand the term primarily to refer to the class or genus of goods or services at issue?

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

The proposed mark is generic because it consists of the generic term or terms LAWYERS combined with the top-level domain (TLD) .COM, and is therefore generic for applicant's services. Thus the proposed mark is unregistrable on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). TMEP §§1209.03(m) and 1215.05. The TLD will be perceived by prospective customers as part of an Internet address, and, therefore, has no source identifying significance. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, 'CONTAINER.COM' would immediately indicate a commercial web site on the Internet which provides containers.").

With respect to the first part of the genericness inquiry, the class or category of services at issue here is that of information services regarding law, legal news and legal services. Since legal services are provided by lawyers, any information relative to legal services includes information about lawyers. Applicant's web site confirms this. It has options pertaining to "hiring a lawyer." It also states that [A]fter choosing a topic below, you'll be better prepared to choose a lawyer by searching our database." Applicant's home page describes it as [Y]our connection to legal information and resources," with very obvious references to choosing lawyers. In addition, attached is evidence demonstrating that web sites devoted to law, legal news, and legal services also provide information about and/or databases of lawyers. In short, applicant's argument that its recitation of services demonstrates that its web site is not about lawyers is not persuasive. In the first place, the web site itself contradicts that argument. Second, web sites containing information about legal news and legal services almost always provide information about lawyers.

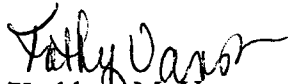
The second step of the Gin inquiry is whether the relevant public understands the term LAWYERS.COM to refer to the category of services at issue, namely, information services regarding law, legal news and legal services, including information about providers of legal services, namely, lawyers. The term "lawyer" is defined as "one whose profession is to conduct lawsuits for clients or to advise as to legal rights and obligations in other matters." See <http://www.yourdictionary.com>. "Providing information about the law and legal services almost by definition includes information about lawyers. "Lawyer" identifies the provider of legal services. Applicant's information services relate to legal news, legal services, and clearly from its website, lawyers. Therefore, the term is a generic term for the information services. Those wishing to provide Internet information services involving law and legal services would need to use the term lawyers, and are entitled to use the generic term in connection with these services.

"Lawyers" has no source-identifying significance in connection with applicant's services. .Com has no source-identifying significance either. The public would not understand LAWYERS.COM to have any meaning apart from the meaning of the individual terms combined. In addition, LAWYERS.COM should be freely available for others to adopt so that designations such as

PERSONALINJURYLAWYERS.COM or WRONGFULDEATHLAWYERS.COM. can be used by others. (See attachments to the office action of (December 3, 2002). See *In re Cyber Financial*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM should be freely available for others to adopt so that designations such as ACMEBONDS.COM or UNITEDBONDS.COM could be used by competitors...).

LAWYERS.COM is not capable of distinguishing applicant's information services from the information services of others. Therefore, registration is finally refused under Section 23 of the Trademark Act.

Applicant may respond to this final action by either: (1) submitting a timely response that fully satisfies any outstanding requirements, if feasible; (2) timely filing an appeal of this final action to the Trademark Trial and Appeal Board; or (3) timely filing a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, See 37 C.F.R. §2.146 and TMEP Chapter 1700.


/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

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Thesaurus

7 entries found for lawyer.
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- Philadelphia lawyer
- sea lawyer

Main Entry: **lawyer**

Pronunciation: 'lo-yər, 'loi-ər

Function: *noun*

: one whose profession is to conduct lawsuits for clients or to advise as to legal rights and obligations in other matters

- lawyerlike /-''lɪk/ *adjective*

- lawyerly /-lɪlɪ/ *adjective*

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If you are the plaintiff (source) in a lawsuit with a questionable outcome

If you have a weak case (as determined by your lawyer) - you will also have to think in terms of "\$1,000's" laid out in advance in hopes of a recovery of money. Using our competitive bidding system, you will probably be able to reduce that hourly fee or else turn the hourly fee into a single flat fee and maybe have the lawyer waive the indirect costs as well!

If you're the plaintiff in a strong case (e.g.: personal injury, malpractice, etc.)

Even though your lawyer is your partner, you may be able to save \$1,000's because lawyers compete to handle your case for a much lower % than you ever thought possible. Using our competitive bidding system, you will probably be able to significantly reduce the % you will give to your lawyer and reduce % relative to the time invested or even use a different type of contingency contract that is stronger for you - weaker for your lawyer!

If you require a legal service (no opponent) (e.g. wills, trusts, mergers, contracts etc.)

Very often the total legal fees will cost many \$100's or if the case is involved - many \$1,000's. Using our competitive bidding system, you will probably be able to reduce that hourly fee or else turn the hourly fee into a single flat fee and maybe have the lawyer waive the indirect costs as well!

At the very least, because of the quotation process, you will be more comfortable with the lawyer you do select!

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/530795

APR

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

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Examining Attorney: VANSTON, KATHLEEN M.
Serial Number: 75/530795



MARK: LAWYERS.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

RE: Serial Number 75/530795

EXAMINER'S AMENDMENT

In accordance with the authorization granted by Paul Williamson on April 5, 2004, the application has been AMENDED as indicated below. Please note that if the identification of goods or services has been amended below, any future amendments must be in accordance with 37 C.F.R. 2.71(a); TMEP section 1402.07(e). No response is necessary unless there is an objection to the amendment. If there is an objection to the amendment, the applicant should notify the examining attorney immediately.

The identification of goods is amended to read as follows: "Providing an online interactive database featuring information exchange in the fields of law, legal news and legal services," in Class 42.

A final refusal will follow the amendment.

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The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.



/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In re Application of:
Reed Elsevier Properties Inc.

Serial No. 75/530,795

Filed: June 22, 1998

Mark: LAWYERS.COM

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Law Office 103

Trademark Attorney:
Kathleen Vanston, Esq.

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

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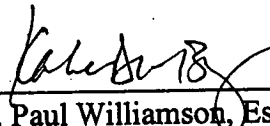
Dear Sir:

We enclose the following documents for filing in connection with the above-referenced service mark application.

-- Response to Office Action of July 29, 2003.

The Commissioner is hereby authorized to charge any fee assessed in connection with this filing to Deposit Account No. 06/2375, Order No. MDCA:161/10301038. A duplicate copy of this transmittal letter is attached for accounting purposes.

Respectfully submitted,



J. Paul Williamson, Esq.
Katherine M. DuBray, Esq.
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2623
(202) 662-0200

Attorneys for Applicant

Dated: January 29, 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In re Application of:
Reed Elsevier Properties Inc.

Serial No. 75/530,795

Filed: June 22, 1998

Mark: LAWYERS.COM

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Law Office 103

Trademark Attorney:
Kathleen Vanston, Esq.

RESPONSE TO OFFICE ACTION OF JULY 29, 2003

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Dear Sir:

This paper is submitted in response to the Office Action dated July 29, 2003.

REMARKS

In its Response to Office Action of December 3, 2002, Applicant amended its application to seek registration on the Supplemental Register and amended the description of services to exclude those services for which the Trademark Attorney had argued that the mark was merely descriptive of or incapable of functioning as a mark when used in connection with those specific services. Applicant respectfully requests that the outstanding refusal be reconsidered in view of the remarks that follow.

A Mark May Be Descriptive For Some Services And Not For Others

As the Trademark Attorney states in the Office Action dated July 29, 2003, it is true that a "registration should be refused if the term is descriptive of any of the goods for which registration is sought." *McCarthy on Trademarks, 4th Edition*, §11:51. It is also true, however,

that a mark's registrability is determined by those goods and services actually listed in the application and not other goods or services on which the mark is used or intended to be used. *Id.*

In the case of *In re Datatime Corp.*, 203 U.S.P.Q. 878 (T.T.A.B. 1979), the Trademark Trial and Appeal Board sustained the trademark attorney's finding that the mark MONTE CARLO was geographically deceptively misdescriptive of electronic digital watches. The applicant had submitted specimens displaying the mark in connection with digital watches with electronic gaming capabilities. The Board found that, while the mark would have been suggestive of the goods depicted in the specimens, the mark was geographically deceptively misdescriptive of the goods as they were more broadly identified in the application. The objection to registration was withdrawn after the applicant limited its description of goods to cover only those watches with gaming capabilities. *Id.* at 880.

Applicant has taken the same step here in limiting its covered services to exclude those services relating to information exchange regarding lawyers — to which the Trademark Attorney had objected to in the previous Office Action. Applicant is now not seeking registration of its mark in connection with services relating to obtaining a lawyer, searching for a lawyer, employing a lawyer or other "lawyer information services." Applicant is, however, seeking to register its mark in connection with those services specifically described in the application, namely, "providing access to an online interactive database featuring information exchange in the fields of law, legal news and legal services." The Applicant, contrary to the Office Action of July 29, 2003, never argued that its services didn't extend to providing information about lawyers, only that the services now covered by the application don't cover such activity. There is nothing disingenuous about this position.

Applicant has restricted its description of services to moot the Trademark Attorney's assertions that its mark is incapable of functioning as a mark in connection with certain of its services as identified in the original application. In narrowing its description of services, Applicant has abided by the well-known tenet that the fact that a term may be considered descriptive or generic of some goods and services, does not prohibit that term from functioning as a mark in connection with other goods and services or to other markets. *Soweco, Inc. v. Shell Oil Company, etc.*, 617 F.2d 1178, 1183, 207 U.S.P.Q. 278 (5th Cir. 1980).

In *Burger King Corporation v. Pilgrim's Pride Corporation*, 705 F. Supp. 1522, 12 U.S.P.Q. 2d 1526 (S.D. Fla. 1988), the court affirmed that the plaintiff's mark "CHICKEN TENDERS" could be the generic name for a part of a chicken within the chicken processing industry and at the same time could be a protectable trademark to the retail purchasing public. Applicant recognized that arguments existed that its mark might be considered descriptive or, from the Trademark Attorney's viewpoint, generic of certain types of services concerning lawyers. Accordingly, Applicant amended its recitation of services so that it is not seeking federal registration for any services for which its mark might be argued to be generic or incapable of functioning as a mark.

Applicant's Mark Must Be Examined In Connection With Those Services Presently Identified In The Application

In light of Applicant's limitation to its recitation of services, the Trademark Attorney's statements in the July 29, 2003, Office Action miss the mark. Applicant has narrowed the coverage of its application to withdraw all reference to "lawyers." The Trademark Attorney's comments reflected that she has based her objections to Applicant's mark on the originally broader — and different — recitation of services. Applicant respectfully requests that the

Trademark Attorney focus on registrability in connection with only those services now listed in the application.

The application seeks registration of LAWYERS.COM on the Supplemental Register for providing access to an online interactive database featuring information exchange in the fields of law, legal news and legal services. At most, "lawyers" describes one of the intended audiences for the recited services.

"LAWYERS.COM" does not refer to a genus of products or services. The registrability of LAWYERS.COM must be determined on the basis of the recited services. See, *In re Allen Electric and Equipment Company*, 173 U.S.P.Q. 689, 690 (C.C.P.A. 1972), where the mark SCANNER for antennas was refused registration as being descriptive of scanning antennas. The applicant had argued that examination of its mark should have been based on the actual use of its mark as shown by the specimens submitted with its application and not on the identification of goods contained in the application. This argument was rejected by the court (and the Patent and Trademark Office) even though it was clear that the applicant's goods were not the type of antennas known as "scanning antennas." The court affirmed that "trademark cases must be decided on the basis of the identification of the goods as set forth in the application." *Id.*; see also, *In re Datatime*, 203 U.S.P.Q. at 880; *Genesee Brewing Company, Inc. v. Stroh Brewing Company*, 124 F. 3d 137, 147, 42 U.S.P.Q. 2d 1734 (2nd Cir. 1997).

Applicant's Mark Is Capable Of Distinguishing Its Narrower Description Of Services

As explained in the Response to Office Action of December 3, 2002, Applicant's mark is, at most, descriptive of its services. Applicant's services exist in an online interactive database that provides information on a variety of topics of interest to both lay people and professionals in the legal field. If Applicant's recited services were merely the providing of a directory of


lawyers or primarily a search tool for consumers to find a lawyer, then Applicant's mark might well be questioned in terms of its ability to distinguish the services. In reality, however, the services for which Applicant seeks registration are the providing of database services focusing on a variety of types of information for which the mark LAWYERS.COM is, at most, merely descriptive. The database services offer detailed information on legal topics, updates on case law, sources of legal research, information for legal support staff and on numerous other areas geared toward both lay members of the public and legal professionals. In fact, the true merely descriptive names for Applicant's services might be Legalresources.com, Legalnews.com, Lawresources.com or Legalcyclopedia.com — not LAWYERS.COM.

Applicant seeks to register its mark in connection with services for which this mark is capable of functioning as a service mark, specifically, "providing access to an online interactive database featuring information exchange in the fields of law, legal news and legal services."

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that this application is in condition for registration on the Supplemental Register.

Respectfully submitted,



J. Paul Williamson, Esq.
Katherine M. DuBray, Esq.
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2623
(202) 662-0200

Attorneys for Applicant

Dated: January 29, 2004

The stamp of the TRADEMARK OFFICE, placed hereon, acknowledges receipt of:

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Application No. 75/530,795 Atty Docket MDCA:161
Deposit/Mail Date January 29, 2004 Matter # 10301038

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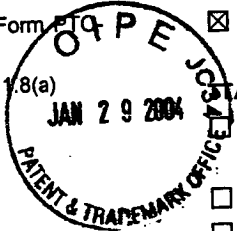
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Applicant Reed Elsevier Properties Inc. By Katherine M. DuBray
Application No. 75/530,795 Atty Docket MDCA:161
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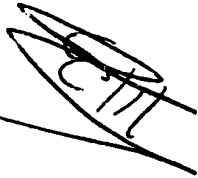
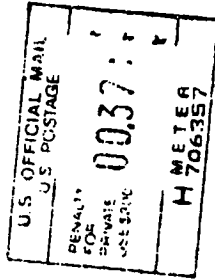
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UNITED STATES PATENT AND TRADEMARK OFFICE

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SERIAL NO: 75/530795

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
ARNOLD WHITE & DURKEE
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

RETURN ADDRESS:

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2900 Crystal Drive
Arlington, VA 22202-3514
ecom103@uspto.gov

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OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/530795

This letter responds to the applicant's communication filed on May 23, 2003.

The amendment to the recitation of services is acceptable and made of record.

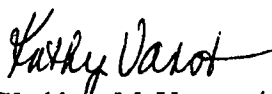
The examining attorney refuses registration on the Supplemental Register because the proposed mark is incapable of identifying the applicant's services and distinguishing them from those of others. Trademark Act Section 23, 15 U.S.C. §1091; *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998); *In re Comus Communications Co.*, 23 USPQ2d 1717 (TTAB 1992); *In re Crown Zellerbach Corp.*, 229 USPQ 318 (TTAB 1985); *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (TTAB 1984); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984); TMEP §1209.01(c).

The examiner reiterates the arguments contained in the final office action. Applicant seeks to register the generic term "lawyers" which has no source identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com." Combining these

two generic terms does not create a term capable of identifying and distinguishing applicant's services. See *In re Martin Container, Inc.*, ___ USPQ2d ___ (TTAB June 11, 2002); *In re CyberFinancial.Net*, ___ USPQ2d ___ (TTAB August 28, 2002).

Applicant's amendment to its recitation of services is a transparent effort to bypass the applicability of these two recent TTAB decisions. Applicant has deleted the term "lawyers" from its information services despite the fact that the specimens of record indicate that providing information about lawyers is one of the primary purposes of the website. For example, the specimen indicates that "[T]he Martindale-Hubbell Law Directory is the most complete, trusted source for identifying qualified legal counsel." It also states that "[A]fter a review of the article, you'll be better prepared to choose a lawyer by searching our database." There is also a section called "Hiring a Lawyer" which provides information about choosing a good lawyer. To now argue that applicant's services do not pertain to providing information about lawyers is disingenuous at best.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.



/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

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JUL 29 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/530795

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

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FULBRIGHT & JAWORSKI L.L.P.
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

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JUL 31 2003

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ecom103@uspto.gov

FULBRIGHT & JAWORSKI

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2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/530795

This letter responds to the applicant's communication filed on May 23, 2003.

The amendment to the recitation of services is acceptable and made of record.


The examining attorney refuses registration on the Supplemental Register because the proposed mark is incapable of identifying the applicant's services and distinguishing them from those of others. Trademark Act Section 23, 15 U.S.C. §1091; *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001); *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998); *In re Comus Communications Co.*, 23 USPQ2d 1717 (TTAB 1992); *In re Crown Zellerbach Corp.*, 229 USPQ 318 (TTAB 1985); *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (TTAB 1984); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984); TMEP §1209.01(c).

The examiner reiterates the arguments contained in the final office action. Applicant seeks to register the generic term "lawyers" which has no source identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com." Combining these

two generic terms does not create a term capable of identifying and distinguishing applicant's services. See *In re Martin Container, Inc.*, ___ USPQ2d ___ (TTAB June 11, 2002); *In re CyberFinancial.Net*, ___ USPQ2d ___ (TTAB August 28, 2002).

Applicant's amendment to its recitation of services is a transparent effort to bypass the applicability of these two recent TTAB decisions. Applicant has deleted the term "lawyers" from its information services despite the fact that the specimens of record indicate that providing information about lawyers is one of the primary purposes of the website. For example, the specimen indicates that "[T]he Martindale-Hubbell Law Directory is the most complete, trusted source for identifying qualified legal counsel." It also states that "[A]fter a review of the article, you'll be better prepared to choose a lawyer by searching our database." There is also a section called "Hiring a Lawyer" which provides information about choosing a good lawyer. To now argue that applicant's services do not pertain to providing information about lawyers is disingenuous at best.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.


/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

****Please place on Upper Right Corner****
****of Response to Office Action ONLY.****

Examining Attorney: VANSTON, KATHLEEN M.
Serial Number: 75/530795

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/530795

APPLICANT: Reed Elsevier Properties Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
ARNOLD WHITE & DURKEE
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20004-2623

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom103@uspto.gov

MARK: LAWYERS.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/530795

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Applicant's amendment to its recitation of services is a transparent effort to bypass the applicability of these two recent TTAB decisions. Applicant has deleted the term "lawyers" from its information services despite the fact that the specimens of record indicate that providing information about lawyers is one of the primary purposes of the website. For example, the specimen indicates that "[T]he Martindale-Hubbell Law Directory is the most complete, trusted source for identifying qualified legal counsel." It also states that "[A]fter a review of the article, you'll be better prepared to choose a lawyer by searching our database." There is also a section called "Hiring a Lawyer" which provides information about choosing a good lawyer. To now argue that applicant's services do not pertain to providing information about lawyers is disingenuous at best.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.



/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of: §
Reed Elsevier Properties Inc. §
Serial No. 75/530,795 § Law Office 103
Filed: June 22, 1998 § Trademark Attorney:
Mark: LAWYERS.COM § Kathleen Vanston, Esq.
§
§

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

TRANSMITTAL LETTER

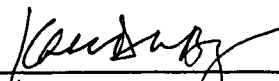
Dear Madam:

We enclose the following documents for filing in connection with the above-referenced service mark application.

- Response to Office Action;
- Revocation and Substitution Power of Attorney; and
- Exhibit A.

The Commissioner is hereby authorized to charge any fee assessed in connection with this filing to Deposit Account No. 06/2375, Order No. MDCA:161/10301038. A duplicate copy of this transmittal letter is attached for accounting purposes.

Respectfully submitted,



J. Paul Williamson Esq.
Katherine M. DuBray, Esq.
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2623
(202) 662-0200

Dated: May 23, 2003

Attorneys for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:
Reed Elsevier Properties Inc.

Serial No. 75/530,795

Filed: June 22, 1998

Mark: LAWYERS.COM

§
§
§
§
§
§
§

Law Office 103

Trademark Attorney:

Kathleen Vanston, Esq.

RESPONSE TO OFFICE ACTION OF DECEMBER 3, 2002

Box Responses/NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Madam:

This paper is submitted in response to the Office Action dated December 3, 2002.

AMENDMENTS

Pursuant to 37 C.F.R. § 2.71, Applicant requests that the following amendments be entered into the application.

Amendment Under 37 C.F.R. § 2.75

Kindly amend the application to seek registration on the Supplemental Register.

Description of Services

Applicant respectfully requests that the description of services contained in the application be amended to read as follows:

Providing access to an online interactive database featuring information exchange in the fields of law, legal news and legal services, in International Class 42.

Correction of Clerical Error in Applicant's Name

Pursuant to TMEP § 1201.02(c), Applicant respectfully requests that the spelling of its name be corrected to remove the comma from before the word "Inc." so that it appears as follows:

Reed Elsevier Properties Inc.

It is believed that a verification or declaration is not necessary to correct an obvious mistake of this nature (the original application correctly displayed Applicant's name). The Trademark Attorney is invited to contact the undersigned attorney at the telephone number and address listed below if she desires a separate declaration or verification.

REMARKS

Descriptiveness Refusal

The Trademark Attorney has refused to register the application on the grounds that LAWYERS.COM is merely descriptive under Trademark Act Section 2(e)(1). Without waiving its right to argue this issue on appeal, if necessary, Applicant has now amended the application to seek registration on the Supplemental Register pursuant to Section 37 C.F.R. § 2.75 (since the application was filed as a use-based application, no change in the "filing date" is necessary). Accordingly, Applicant believes the rejection on the grounds that the mark is merely descriptive is now moot. The Amendment is a proper response to the "Final" refusal to register and it is respectfully submitted that the application is now ready to be passed to registration.

Applicant's Mark is Capable of Distinguishing Applicant's Services

The Trademark Attorney has indicated in the Office Action that she believes the Applicant's mark is incapable of distinguishing Applicant's services. Applicant respectfully disagrees.

"[T]he critical question 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 involved." *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 U.S.P.Q. 2d 1996, 1998 (TTAB 1986). The Supreme Court has clarified the rule as follows, "[a] generic term is one that refers to the genus of which the particular product is a species." *Park 'N Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194, 224 U.S.P.Q. 327, 329 (1985). Applicant respectfully submits that under this rule, any conclusion that Applicant's mark is generic would be incorrect.

In *Hunter Publishing*, the TTAB found that while the title of the applicant's magazine, "SYSTEMS USER," might be used to describe *individuals* in the computer industry or data processing field, there was "no evidence that the relevant public would refer to a *publication* about the computer and/or the data processing industry as SYSTEMS USER." 1 U.S.P.Q. 2d at 1998 (emphasis added). Likewise, neither "LAWYERS.COM" nor "LAWYERS" is the genus of Applicant's services. Applicant's services do not include selling or promoting lawyers. Rather, Applicant's services focus on offering information about how to find and select a lawyer, the mechanics of employing a lawyer, tips and advice for legal professionals, and current topics of interest in the legal field. No one in the legal field or general public is likely to refer to an on-line database as a "LAWYER" or "LAWYERS," much less as a "LAWYERS.COM."

As in *Hunter Publishing*, at most, the term "LAWYERS" describes a feature of the Applicant's services, specifically, an element of the intended audience for Applicant's database.

The evidence provided by the Trademark Attorney, in the form of Internet pages from various web sites incorporating the name "LAWYERS" in their domain names and reflecting pages limited to directories to be used by the general public for obtaining legal counsel in specific geographic or subject matter areas, supports this conclusion. Unlike these Internet pages, the services Applicant provides in connection with the LAWYERS.COM mark are distinguishable from a mere directory of lawyers. In fact, a truly generic identifier for Applicant's services would be "directory of legal topics" or perhaps "legal encyclopedia" services, not LAWYERS.COM.

Applicant's Mark is, At Most, Descriptive

As distinguished from a generic term, a descriptive term "describes the qualities or characteristics of the goods or service." *Park 'N Fly*, 224 U.S.P.Q. at 329. For example, in *In re Carlson Dolls Co.*, 31 U.S.P.Q. 2d 1319, 1320 (TTAB 1994), MARTHA WASHINGTON was held to be merely descriptive of the Applicant's dolls because "a key feature, quality or characteristic of the dolls is that they portray Martha Washington." Like the mark in *In re Carlson Dolls*, LAWYERS.COM communicates a feature of Applicant's database, namely, that the content is broadly related to lawyers. Thus, the mark is not generic. At the very worst, the mark is descriptive of Applicant's services in the same way that the marks of the registrations identified below are also descriptive.

CRUISE.COM, Reg. No. 2,684,818, for travel agency services, namely, making reservations and bookings for transportation;

OPINIONJOURNAL.COM, Reg. No. 2,684,851, for computer services, namely, providing an on-line newspaper column featuring general news and news relating to current events, technology, business, finance and the economy;

SALESFORCE.COM, Reg. No. 2,684,824, for providing temporary use of on-line non-downloadable software for storing, managing, tracking and analyzing data in the field of marketing, promotion, sales, customer information management, customer support services and employee efficiency; providing temporary use of on-line non-downloadable software to create statistical and management reports on marketing, promotion, sales, customer information management, customer support services and employee efficiency; providing temporary use of on-line non-downloadable multimedia computer program for communicating with peer professionals; computer services, namely, designing, implementing, and maintaining computer software for others; providing internal company computer networks; providing search engines for obtaining a wide variety of data on a global computer network;

CRIMINALSUPERSEARCH.COM, Reg. No. 2,710,256, for performing investigations on individuals, namely, performing criminal background checks;

LOSTANDFOUND.COM, Reg. No. 2,696,872, for electronic transmission of data and documents concerning misplaced and located personal property via a global network of computer terminals;

MORTGAGE-INVESTMENTS.COM, Reg. No. 2,647,595, for providing an on-line computer database featuring information in the field of the procurement and brokerage of home and commercial mortgages;

HOMES.COM, Reg. No. 2,562,661, for providing home improvement information via a global communications network;

DOG.COM, Reg. No. 2,568,605, for toys and games, namely, dog robot toys;

NETHOSTING.COM, Reg. No. 2,497,383, for hosting the web site on [sic] others on a computer server for a global computer network;

WEATHEREXPERTS.COM, Reg. No. 2,489,705, for retail store services and online retail store services in the fields of meteorological equipment, instruments, maps, and images;

CULINARYPRO.COM, Reg. No. 2,542,013, for kitchen cutlery, namely knives;

COURTREPORTERS.COM, Reg. No. 2,545,478, for providing a website on global computer networks featuring information in the field of court reporters, namely, court reporters listings, listing of court reporting equipment and supplies, employment listings, classified ads, schools, books, and other court reporting resources;

DISCOUNTCOUPONS.COM, Reg. No. 2,486,399, for computer services, namely providing coupons for the goods and services of others; providing information regarding discounts, coupons and special offers for the goods and services of others;

POKER.COM, Reg. No. 2,470,729, for providing computer gaming services accessed via a global computer network.

Copies of the TARR Reports for these Registrations are attached as Exhibit A.

These Registrations demonstrate that the Patent and Trademark Office routinely finds that marks of a similar nature to LAWYERS.COM are not generic. MORTGAGE-INVESTMENTS.COM has been registered for information services about procurement and brokerage of mortgages. COURTREPORTERS.COM has been registered for information services about and directed to court reporters. HOMES.COM has been registered for information services relating to homes. Likewise, LAWYERS.COM should be allowed to register for information services about the law, legal news and legal services.

Revocation of Previous Powers of Attorney and Appointment of New Attorneys

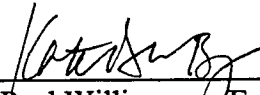
Applicant advises the Trademark Attorney that it has authorized new counsel to prosecute this application on its behalf. Enclosed herewith is a document entitled "Revocation and Substitution Power of Attorney" indicating that J. Paul Williamson, Esq., Tara M. Vold, Esq., Cynthia C. Henderson, Esq. and Katherine M. DuBray, Esq. and all other attorneys of the law firm of Fulbright & Jaworski L.L.P., are now authorized by Applicant to correspond with the office regarding this application, with full powers of substitution and revocation. Accordingly,

Applicant respectfully requests the Trademark Attorney update office Records to reflect the contact information for Applicant's new counsel.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is now in condition for registration on the Supplemental Register.

Respectfully submitted,



J. Paul Williamson, Esq.
Katherine M. DuBray, Esq.
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2623
(202) 662-0200

Dated: May 23, 2003

Attorneys for Applicant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In Re Application of: §
Reed Elsevier Properties Inc. §
§
Serial No. 75/530,795 §
§
Filed: June 22, 1998 §
§
Mark: LAWYERS.COM §

Law Office 103

Trademark Attorney:
Kathleen Vanston, Esq.

Commissioner for Trademarks
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202-3513

REVOCATION AND SUBSTITUTION POWER OF ATTORNEY

Applicant hereby revokes all previous powers of attorney and appoints Fulbright & Jaworski L.L.P., having an address at 801 Pennsylvania Avenue, N.W., Washington, DC 20004-2623, and J. Paul Williamson, Tara M. Vold, Cynthia C. Henderson and Katherine M. DuBray, all members of the District of Columbia bar, as its attorneys with full power of substitution or revocation, to prosecute this application, to make alterations and amendments therein, to handle all matters in the Patent and Trademark Office in connection therewith and to receive the registration certificate.

Please address all correspondence to:

J. Paul Williamson
FULBRIGHT & JAWORSKI L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, DC, 20004-2623
Phone: (202) 662-0200
Fax: (202) 662-4643

REED ELSEVIER PROPERTIES INC.

Date: May 15, 2003

By: Renee Simonton
Renee Simonton
President

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:32:37 ET

Serial Number: 75731748

Registration Number: 2684818

Mark (words only): CRUISE.COM

Current Status: Registered.

Date of Status: 2003-02-04

Filing Date: 1999-06-18

Registration Date: 2003-02-04

Law Office Assigned: TMEG Law Office 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-03-18

CURRENT APPLICANT(S)/OWNER(S)

1. OMEGA WORLD TRAVEL, INC.

Address:

OMEGA WORLD TRAVEL, INC.
3102 Omega Office Park
Fairfax, VA 22031
United States

State or Country of Incorporation: Virginia

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

travel agency services, namely, making reservations and bookings for transportation

International Class: 039

First Use Date: 1996-12-09

First Use in Commerce Date: 1996-12-09

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

A103

PROSECUTION HISTORY

2003-02-04 - Registered - Supplemental Register
2002-07-15 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER
2002-06-25 - Previous allowance count withdrawn
2002-06-17 - Approved for Pub - Principal Register (Initial exam)
2002-06-03 - Report petition to revive - granted
2001-10-24 - Petition to revive - Received
2001-09-04 - Abandonment - Failure to respond
2001-01-22 - Final refusal mailed
2000-06-19 - Letter of suspension mailed
2000-04-27 - Communication received from applicant
1999-10-29 - Non-final action mailed
1999-10-19 - Case file assigned to examining attorney
1999-09-23 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

LISA K. DACOSTA (Attorney of record)

LISA K. DACOSTA
ROBERTS & HUNDERTMARK LLP
35 WISCONSIN CIRCLE
SUITE 350
CHEVEY CHASE, MD 20815
United States

A104

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:32:56 ET

Serial Number: 76081074

Registration Number: 2684851

Mark (words only): OPINIONJOURNAL.COM

Current Status: Registered.

Date of Status: 2003-02-04

Filing Date: 2000-06-30

Registration Date: 2003-02-04

Law Office Assigned: TMEG Law Office,109

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-03-19

CURRENT APPLICANT(S)/OWNER(S)

1. Dow Jones & Company. Inc.

Address:

Dow Jones & Company. Inc.
200 Liberty Street
New York, NY 10281
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

COMPUTER SERVICES, NAMELY, PROVIDING AN ON-LINE NEWSPAPER COLUMN FEATURING GENERAL NEWS AND NEWS RELATING TO CURRENT EVENTS, TECHNOLOGY, BUSINESS, FINANCE AND THE ECONOMY

International Class: 042

First Use Date: 2000-07-27

First Use in Commerce Date: 2000-07-27

A105

Basis: 1(a)

ADDITIONAL INFORMATION

PROSECUTION HISTORY

2003-02-04 - Registered - Supplemental Register
2002-11-23 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER
2002-11-23 - Amendment to Use approved
2002-09-29 - Report petition to revive - granted
2002-05-22 - Petition to revive - Received
2002-05-22 - PAPER RECEIVED
2002-03-16 - Abandonment - Failure to respond
2001-07-05 - Non-final action mailed
2001-01-17 - Case file assigned to examining attorney
2000-12-28 - Case file assigned to examining attorney
2000-10-24 - Communication received from applicant
2000-12-14 - Amendment to use processing complete
2000-10-24 - Amendment to Use filed

CONTACT INFORMATION

Correspondent (Owner)

DANA R. KAPLAN (Attorney of record)

DANA R. KAPLAN
KENYON & KENYON
ONE BROADWAY
NEW YORK, NEW YORK 10004
United States

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:36:00 ET

Serial Number: 75836332

Registration Number: 2684824

Mark (words only): SALESFORCE.COM

Current Status: Registered.

Date of Status: 2003-02-04

Filing Date: 1999-10-29

Registration Date: 2003-02-04

Law Office Assigned: TMEG Law Office 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 - Warehouse (Newington)

Date In Location: 2003-04-14

CURRENT APPLICANT(S)/OWNER(S)

1. salesforce.com, inc.

Address:

salesforce.com, inc.
101 Spear Street, Suite 203
San Francisco, CA 94105
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Providing temporary use of on-line non-downloadable software for storing, managing, tracking and analyzing data in the field of marketing, promotion, sales, customer information management, customer support services and employee efficiency; providing temporary use of on-line non-downloadable software to create statistical and management reports on marketing, promotion, sales, customer information management, customer support services and employee efficiency; providing temporary use of on-line non-downloadable multimedia computer program for communicating with peer professionals; computer services, namely, designing, implementing, and maintaining computer software for others; providing internal company computer networks; providing search engines for obtaining a wide variety of data on a global computer network

International Class: 042

First Use Date: 1999-09-27

First Use in Commerce Date: 1999-09-27

A107

Latest Status Info

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-03-10 - Ex parte appeal terminated

2003-02-04 - Registered - Supplemental Register

2002-11-25 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2002-10-30 - Jurisdiction restored to examiner

2002-10-30 - Ex parte appeal - Instituted

2002-08-09 - Non-final action mailed

2002-06-17 - Letter of suspension mailed

2001-11-13 - Communication received from applicant

2001-09-10 - Final refusal mailed

2001-08-24 - Report petition to revive - granted

2000-12-18 - Petition to revive - Received

2001-09-07 - Previous action count withdrawn

2000-04-07 - Non-final action mailed

2000-03-29 - Case file assigned to examining attorney

2000-03-24 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

BRUCE J. GOLDNER, ESQ. (Attorney of record)

BRUCE J. GOLDNER, ESQ.
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036-6522
United States

A108

05/11/2003

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:39:24 ET

Serial Number: 78138176

Registration Number: 2710256

Mark (words only): CRIMINALSUPERSEARCH.COM

Current Status: Registered.

Date of Status: 2003-04-22

Filing Date: 2002-06-24

Registration Date: 2003-04-22

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-04-28

CURRENT APPLICANT(S)/OWNER(S)

1. RentGrow, Inc.

Address:

RentGrow, Inc.
275 Wyman Street, Suite 14
Waltham, MA 02451
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Performing investigations on individuals, namely, performing criminal background checks

International Class: 045

First Use Date: 1999-12-31

First Use in Commerce Date: 1999-12-31

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

A109

PROSECUTION HISTORY

- 2003-04-22 - Registered - Supplemental Register
- 2003-03-02 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER
- 2003-01-09 - Communication received from applicant
- 2003-01-09 - PAPER RECEIVED
- 2002-11-19 - Non-final action e-mailed
- 2002-11-04 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Charles E. Weinstein, Esq. (Attorney of record)

CHARLES E. WEINSTEIN, ESQ.
FOLEY HOAG LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON MA 02210-2600
United States

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:42:04 ET

Serial Number: 78027029

Registration Number: 2696872

Mark (words only): LOSTANDFOUND.COM

Current Status: Registered.

Date of Status: 2003-03-11

Filing Date: 2000-09-21

Registration Date: 2003-03-11

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-04-02

CURRENT APPLICANT(S)/OWNER(S)

1. Consumer Product Recovery and Finance Company, Inc.

Address:

Consumer Product Recovery and Finance Company, Inc.

50 Trinity Place Ste 300

New York, NY 10006

United States

State or Country of Incorporation: Delaware**Legal Entity Type:** Corporation

GOODS AND/OR SERVICES

" ELECTRONIC TRANSMISSION OF DATA AND DOCUMENTS CONCERNING MISPLACED AND LOCATED PERSONAL PROPERTY VIA A GLOBAL NETWORK OF COMPUTER TERMINALS

International Class: 038**First Use Date:** 1998-12-01**First Use in Commerce Date:** 1998-12-01**Basis:** 1(a)

A111

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-03-11 - Registered - Supplemental Register

2003-01-13 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2002-12-04 - Communication received from applicant

2002-10-02 - Case file assigned to examining attorney

2002-06-07 - Non-final action mailed

2002-05-17 - Communication received from applicant

2001-12-06 - Non-final action mailed

2001-12-06 - Case file assigned to examining attorney

2001-10-09 - Communication received from applicant

2001-10-09 - Communication received from applicant

2001-04-09 - Non-final action mailed

2001-03-12 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
CONSUMER PRODUCT RECOVERY AND FINANCE CO
50 TRINITY PL STE 300
NEW YORK NY 10006-2508
United States

A112

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 10:45:43 ET

Serial Number: 78106233

Registration Number: 2647595

Mark (words only): MORTGAGE-INVESTMENTS.COM

Current Status: Registered.

Date of Status: 2002-11-05

Filing Date: 2002-02-01

Registration Date: 2002-11-05

Law Office Assigned: TMO LAW OFFICE 116

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-01-06

CURRENT APPLICANT(S)/OWNER(S)

1. Mortgage-Investments.com, Inc.

Address:

Mortgage-Investments.com, Inc.
4905 34th Street S #5600
Saint Petersburg, FL 337114511
United States

State or Country of Incorporation: Florida

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Providing an on-line computer database featuring information in the field of the procurement and brokerage of home and commercial mortgages

International Class: 036

First Use Date: 1997-12-01

First Use in Commerce Date: 1997-12-01

Basis: 1(a)

A113

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-11-05 - Registered - Supplemental Register

2002-08-12 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2002-07-25 - Communication received from applicant

2002-06-03 - Non-final action mailed

2002-05-15 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

MORTGAGE-INVESTMENTS.COM, INC.

4905 34TH STREET S

#5600

SAINT PETERSBURG FL 33711-4511

United States

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:46:37 ET

Serial Number: 76135604

Registration Number: 2562661

Mark (words only): HOMES.COM

Current Status: Registered.

Date of Status: 2002-04-16

Filing Date: 2000-09-26

Registration Date: 2002-04-16

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-04-24

CURRENT APPLICANT(S)/OWNER(S)

1. Homes.com, Inc.

Address:

Homes.com, Inc.
2470 Camino Real, Suite 210
Palo Alto, CA 94306
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

providing home improvement information via a global communications network

International Class: 037

First Use Date: 1999-10-00

First Use in Commerce Date: 1999-10-00

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

2226864

A115

PROSECUTION HISTORY

2003-02-03 - PAPER RECEIVED

2002-04-16 - Registered - Supplemental Register

2001-10-22 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2001-08-20 - Communication received from applicant

2001-03-15 - Non-final action mailed

2001-02-26 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

RANDALL C BROWN (Attorney of record)

RANDALL C BROWN
AKIN GUMP STRAUSS HAUER & FELD LLP
PO BOX 688
DALLAS TX 75313-0688
United States

A116

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:46:57 ET

Serial Number: 76076745

Registration Number: 2568605

Mark (words only): DOG.COM

Current Status: Registered.

Date of Status: 2002-05-07

Filing Date: 2000-06-26

Registration Date: 2002-05-07

Law Office Assigned: TMEG Law Office 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-05-21

CURRENT APPLICANT(S)/OWNER(S)

1. TOMY COMPANY, LTD.

Address:

TOMY COMPANY, LTD.
No. 9-10, Tateishi 7-chome
Katsushika-ku, Tokyo,
Japan

State or Country of Incorporation: Japan

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

TOYS AND GAMES, NAMELY, DOG ROBOT TOYS

International Class: 028

First Use Date: 2000-07-12

First Use in Commerce Date: 2001-05-15

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

A117

PROSECUTION HISTORY

2002-05-07 - Registered - Supplemental Register
2001-10-30 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER
2001-10-30 - Amendment to Use approved
2001-10-30 - Case file assigned to examining attorney
2001-10-23 - Amendment to use processing complete
2001-08-15 - Amendment to Use filed
2001-08-15 - Communication received from applicant
2001-06-29 - Communication received from applicant
2001-01-02 - Non-final action mailed
2000-12-18 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
JAMES D HALSEY JR (Attorney of record)

JAMES D HALSEY JR
STAAS & HALSEY
700 11TH ST NW
WASHINGTON DC 20001
United States

Domestic Representative
JAMES D. HALSEY, JR.

A118

05/13/2003

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:47:09 ET

Serial Number: 78011468

Registration Number: 2497383

Mark (words only): NETHOSTING.COM

Current Status: Registered.

Date of Status: 2001-10-09

Filing Date: 2000-06-06

Registration Date: 2001-10-09

Law Office Assigned: TMEG Law Office 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-11-09

CURRENT APPLICANT(S)/OWNER(S)

1. Fibernet Corp.

Address:

Fibernet Corp.
1455 South State Street Suite G
Orem, UT 84097
United States

State or Country of Incorporation: Utah

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

hosting the web site on others on a computer server for a global computer network

International Class: 042

First Use Date: 1996-07-01

First Use in Commerce Date: 1996-07-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

A119

PROSECUTION HISTORY

2001-10-09 - Registered - Supplemental Register
2001-08-02 - Approved for Pub - Principal Register (Initial exam)
2001-02-05 - Communication received from applicant
2000-11-21 - Non-final action mailed
2000-10-20 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
Christopher J. Day (Attorney of record)

CHRISTOPHER J. DAY
LAW OFFICE OF CHRISTOPHER DAY
340 EAST PALM LANE, STE 282
PHOENIX, AZ 85004
United States

A120

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:47:20 ET

Serial Number: 78018642

Registration Number: 2489705

Mark (words only): WEATHEREXPERTS.COM

Current Status: Registered.

Date of Status: 2001-09-11

Filing Date: 2000-07-27

Registration Date: 2001-09-11

Law Office Assigned: TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-10-09

CURRENT APPLICANT(S)/OWNER(S)

1. MORCOM INTERNATIONAL, INC.

Address:

MORCOM INTERNATIONAL, INC.

14018-G SULLYFIELD CIRCLE

CHANTILLY, VA 20151

United States

State or Country of Incorporation: Virginia

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

RETAIL STORE SERVICES AND ONLINE RETAIL STORE SERVICES IN THE FIELDS OF METEOROLOGICAL EQUIPMENT, INSTRUMENTS, MAPS, AND IMAGES

International Class: 035

First Use Date: 2000-05-01

First Use in Commerce Date: 2000-05-01

Basis: 1(a)

A121

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-09-11 - Registered - Supplemental Register

2001-07-12 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2001-06-04 - Communication received from applicant

2001-01-02 - Non-final action mailed

2000-12-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

RALPH M. TENER (Attorney of record)

RALPH M. TENER
MCCANDLISH & LILLARD
11350 RANDOM HILLS ROAD,
SUITE 500
FAIRFAX, VA 22030-7429
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-14 17:24:11 ET

Serial Number: 78047146

Registration Number: 2542013

Mark (words only): CULINARYPRO.COM

Current Status: Registered.

Date of Status: 2002-02-19

Filing Date: 2001-02-07

Registration Date: 2002-02-19

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-03-08

CURRENT APPLICANT(S)/OWNER(S)

1. National Housewares Corporation

Address:

National Housewares Corporation
13 Grove Street
Darien, CT 06820
United States

State or Country of Incorporation: Connecticut

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

kitchen cutlery, namely knives

International Class: 008

First Use Date: 2000-01-01

First Use in Commerce Date: 2000-01-01

Basis: 1(a)

A123

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-02-19 - Registered - Supplemental Register

2001-11-14 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2001-10-15 - Communication received from applicant

2001-10-15 - Communication received from applicant

2001-07-10 - Non-final action mailed

2001-06-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

JAMIE J. FITZGERALD (Attorney of record)

JAMIE J. FITZGERALD
CUMMINGS & LOCKWOOD
PO BOX 1960
NEW HAVEN CT 06509-1960
United States

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:48:06 ET

Serial Number: 78034626

Registration Number: 2545478

Mark (words only): COURTREPORTERS.COM

Current Status: Registered.

Date of Status: 2002-03-05

Filing Date: 2000-11-09

Registration Date: 2002-03-05

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-03-15

CURRENT APPLICANT(S)/OWNER(S)

1. MIRANDA, BERTHA

Address:

MIRANDA, BERTHA
P.O. BOX 365
NEWBURY PARK, CA 91319
United States

Country of Citizenship: United States

Legal Entity Type: Individual

GOODS AND/OR SERVICES

Providing a website on global computer networks featuring information in the field of court reporters, namely, court reporters listings, listing of court reporting equipment and supplies, employment listings, classified ads, schools, books, and other court reporting resources

International Class: 009

First Use Date: 2001-01-10

First Use in Commerce Date: 2001-01-10

Basis: 1(a)

A125

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-03-05 - Registered - Supplemental Register

2001-12-16 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2001-12-11 - Amendment to Use approved

2001-11-14 - Amendment to use processing complete

2001-09-20 - Amendment to Use filed

2001-09-20 - Communication received from applicant

2001-04-23 - Non-final action mailed

2001-04-18 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

BERTHA MIRANDA

PO BOX 365

NEWBURY PARK CA 91319-0365

United States

A126

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:48:17 ET

Serial Number: 78015760

Registration Number: 2486399

Mark (words only): DISCOUNTCOUPONS.COM

Current Status: Registered.

Date of Status: 2001-09-04

Filing Date: 2000-07-07

Registration Date: 2001-09-04

Law Office Assigned: TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-09-28

CURRENT APPLICANT(S)/OWNER(S)

1. Zitsman, Charles B.

Address:

Zitsman, Charles B.
3575 US 1 South
St. Augustine, FL 32086
United States

State or Country of Incorporation: Florida

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Computer services, namely providing coupons for the goods and services of others; providing information regarding discounts, coupons and special offers for the goods and services of others

International Class: 042

First Use Date: 1997-10-15

First Use in Commerce Date: 1997-10-15

A127

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-04-11 - TEAS Change of Correspondence Received

2001-09-04 - Registered - Supplemental Register

2001-07-02 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2001-05-23 - Communication received from applicant

2001-05-23 - Communication received from applicant

2000-12-01 - Non-final action mailed

2000-11-01 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

BRIAN R. GIBBONS (Attorney of record)

BRIAN GIBBONS

3936 S. SEMORAN BLVD., SUITE 330

ORLANDO FL 32822-4015

United States

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-13 19:48:25 ET

Serial Number: 75849777

Registration Number: 2470729

Mark (words only): POKER.COM

Current Status: Registered.

Date of Status: 2001-07-17

Filing Date: 1999-11-15

Registration Date: 2001-07-17

Law Office Assigned: TMO Law Office 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 - Warehouse (Newington)

Date In Location: 2001-08-17

CURRENT APPLICANT(S)/OWNER(S)

1. Poker.com, Inc.

Address:

Poker.com, Inc.
#1502 - 1166 Alberni Street
Vancouver, V6E 3Z3
Canada

State or Country of Incorporation: Florida

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

PROVIDING COMPUTER GAMING SERVICES ACCESSED VIA A GLOBAL COMPUTER NETWORK

International Class: 041

First Use Date: 1999-06-15

First Use in Commerce Date: 1999-08-09

A129

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-07-17 - Registered - Supplemental Register

2001-02-26 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2000-10-26 - Communication received from applicant

2000-04-26 - Non-final action mailed

2000-04-06 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Richard L. Morris, Jr. (Attorney of record)

RICHARD L. MORRIS, JR.
TRADEMARK SERVICES
1000 WEST AVE STE 512
MIAMI BEACH FL 33139
United States

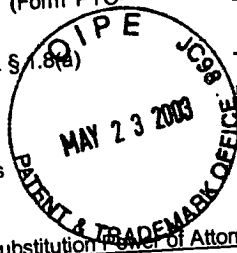
Domestic Representative (NOT AVAILABLE)

The stamp of the TRADEMARK OFFICE, placed hereon, acknowledges receipt of:
Applicant Reed Elsevier Properties Inc. By Katherine M. DuBray
Application No. 75/530.795 Atty Docket MDCA:161
Deposit/Mail Date May 23, 2003 Matter # 10301038

- | | |
|--|---|
| <input checked="" type="checkbox"/> Amendment/Response - with Exhibit A | <input type="checkbox"/> Declaration under Sections <input type="checkbox"/> 8 & <input type="checkbox"/> |
| <input type="checkbox"/> Amendment to Allege Use | <input type="checkbox"/> Extension of Time to File Statement |
| <input type="checkbox"/> Application for TM/SM | <input type="checkbox"/> Check for \$ |
| <input type="checkbox"/> Use-Based <input type="checkbox"/> ITU | <input checked="" type="checkbox"/> Postcard |
| <input type="checkbox"/> ___ Specimens | <input type="checkbox"/> ___ Specimens |
| <input type="checkbox"/> Application for Renewal | <input type="checkbox"/> Statement of Use, Check for \$ |
| <input type="checkbox"/> Assignment, Check for \$ _____ | <input type="checkbox"/> ___ Specimens |
| <input type="checkbox"/> Assignment Cover Sheet (Form PTO-1594) | <input checked="" type="checkbox"/> Transmittal Letter (in duplicate) |
| <input type="checkbox"/> Cert. Of Mailing under 37 CFR § 1.8(a) | |
| Express Mail No. _____ | TTAB: |
| <input type="checkbox"/> Check for \$ | <input type="checkbox"/> Ext. of Time to File Not. Of Opposition |
| <input type="checkbox"/> Declaration <input type="checkbox"/> Specimens | Check for \$ _____ |
| | <input type="checkbox"/> Not. Of Opposition (in duplicate) |
| | <input type="checkbox"/> Check for \$600.00 |
| <input checked="" type="checkbox"/> Other <u>Revocation and Substitution Power of Attorney</u> | |

The stamp of the TRADEMARK OFFICE, placed hereon, acknowledges receipt of:
Applicant Reed Elsevier Properties Inc. By Katherine M. DuBray
Application No. 75/530.795 Atty Docket MDCA:161
Deposit/Mail Date May 23, 2003 Matter # 10301038

- | | |
|--|--|
| <input checked="" type="checkbox"/> Amendment/Response - with Exhibit A | <input type="checkbox"/> Declaration under Sections <input type="checkbox"/> 8 & <input type="checkbox"/> 15 |
| <input type="checkbox"/> Amendment to Allege Use | <input type="checkbox"/> Extension of Time to File Statement of Use, |
| <input type="checkbox"/> Application for TM/SM | <input type="checkbox"/> Check for \$ |
| <input type="checkbox"/> Use-Based <input type="checkbox"/> ITU | <input checked="" type="checkbox"/> Postcard |
| <input type="checkbox"/> ___ Specimens | <input type="checkbox"/> ___ Specimens |
| <input type="checkbox"/> Application for Renewal | <input type="checkbox"/> Statement of Use, Check for \$ |
| <input type="checkbox"/> Assignment, Check for \$ _____ | <input type="checkbox"/> ___ Specimens |
| <input type="checkbox"/> Assignment Cover Sheet (Form PTO-1594) | <input checked="" type="checkbox"/> Transmittal Letter (in duplicate) |
| <input type="checkbox"/> Cert. Of Mailing under 37 CFR § 1.8(a) | |
| Express Mail No. _____ | TTAB: |
| <input type="checkbox"/> Check for \$ | <input type="checkbox"/> Ext. of Time to File Not. Of Opposition, |
| <input type="checkbox"/> Declaration <input type="checkbox"/> Specimens | Check for \$ _____ |
| | <input type="checkbox"/> Not. Of Opposition (in duplicate) |
| | <input type="checkbox"/> Check for \$600.00 |
| <input checked="" type="checkbox"/> Other <u>Revocation and Substitution Power of Attorney</u> | |



CAC

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/530795

DEC - 8 2002

APPLICANT: Reed Elsevier Properties, Inc.

CORRESPONDENT ADDRESS:

J. PAUL WILLIAMSON
ARNOLD WHITE & DURKEE
750 BERING DR
HOUSTON TX 77057-2149

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

ecom103@uspto.gov
REC'D HOWREY SIMON ARNOLD & WHITE

DEC 6 2002

MARK: LAWYERS.COM

HOUSTON DOCKETING DEPT.

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A 11774.CALI. TRUSCO

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

N/A

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 75/530795

This letter responds to the applicant's communication filed on November 7, 2002.

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL. The applicant's evidence of acquired distinctiveness is insufficient to overcome the stated refusal because the mark is incapable of distinguishing applicant's lawyer information services from the lawyer information services of others.

If matter is generic, the matter is unregistrable. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) ("If a mark is generic, incapable of serving as a means 'by which the goods of the applicant may be distinguished from the goods of others' ... it is not a trademark and can not be registered under the Lanham Act."); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), and cases cited therein ("A

generic term ... can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of §2(e)(1) and is incapable of acquiring *de jure* distinctiveness under §2(f.)

The determination of whether a term is generic involves a two-part inquiry. The first part relates to the category of the goods or services at issue. The second part relates to whether the term sought to be registered is understood by the relevant public primarily to refer to that category of goods or services. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986).


In this instance, the class or category of services at issue here is that of information services, pertaining to lawyers, provided via the Internet. With respect to the second part, "lawyers" identifies the subject matter of the Internet information services. See

<http://www.lawyers.com>. Because "lawyers" identifies, in part, the subject matter of applicant's information services, the term is likewise generic name for the information services. See *In re A L Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001). Those wishing to provide Internet information services pertaining to lawyers would need to use the generic term in connection with such services. (See <http://www.massachusetts-lawyers.com>; www.truckerlawyers.com; www.personalinjurylawyers.com; www.newjersey-lawyers.com; www.connecticut-lawyers.com; www.lep-lawyers.com; www.collectionlawyers.com; www.medialawyer.com; www.wrongfuldeath-lawyers.com.)

Applicant seeks to register the generic term "lawyers" which has no source identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com," which also has no source-identifying significance. See www.whatis.com. Combining the two terms does not create a term capable of identifying and distinguishing applicant's services.

This issue has been recently addressed by the Trademark Trial and Appeal Board. See *In re Martin Container, Inc.*, ___ USPQ2d ___ (TTAB June 11, 2002) [CONTAINER.COM found generic for "retail store services and retail services offered via telephone featuring metal shipping containers"]; *In re CyberFinanical.Net*, ___ USPQ2d ___ (TTAB August 28, 2002) [BONDS.COM found generic for "providing information regarding financial products and services via global computer network..."]. Applicant's situation fits squarely within the parameters of these two decisions. Accordingly, registration is refused under Section 2(e)(1) of the Trademark Act. The evidence applicant has submitted in support of its amendment to Section 2(f) of the Trademark Act is not sufficient to overcome the refusal.

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. §2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).


Kathleen M. Vanston
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

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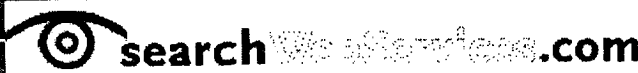
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The Internet Corporation for Assigned Names and Numbers ([ICANN](http://www.icann.org)) has overall responsibility for domain names (as well as for [Internet Protocol](http://www.icann.org) addresses and many other Internet parameters). Day-to-day responsibility

is delegated to specific registrars, such as Network Solutions and a number of competing companies for .com, .org, .net, and .edu top-level domains.

Specific criteria are set forth for the use of the top-level domain name in RFC 1591 - Domain Name System Structure and Delegation.

The top-level domain names administered by ICANN and its delegate agencies are: [com](#), [edu](#), [gov](#), [int](#), [mil](#), [net](#), and [org](#). In addition to these, domain name applicants within the United States may also be able to register a name under a U.S. top-level domain name based on geography. See RFC 1480 - The US Domain and visit the U.S. Domain Registry for registration procedures.

Top-level domain names for countries other than the United States are administered by each country and are based on the ISO-3166 list of country codes.

Read more about it:

- >> [RFC 1480 - The US Domain specifies the use of U.S. geographic top-level domain names.](#)
- >> [RFC 1591 - Domain Name System Structure and Delegation sets forth specific criteria for use of top-level domain names.](#)


Last updated on: May 31, 2001

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Electrical Accident Lawsuits

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Workers' Compensation & Workplace Injuries

Issues involving people injured at work including third party actions that allow more than Workers' Comp.

Slip and Fall Accident Cases

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Injuries at childbirth including Erb's palsy.

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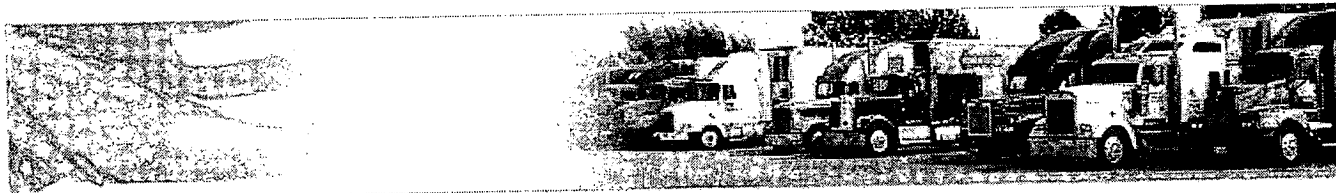
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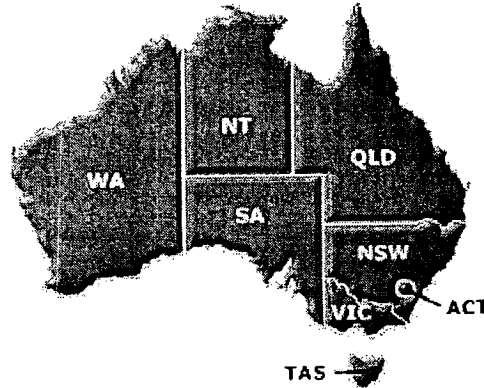
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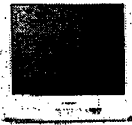
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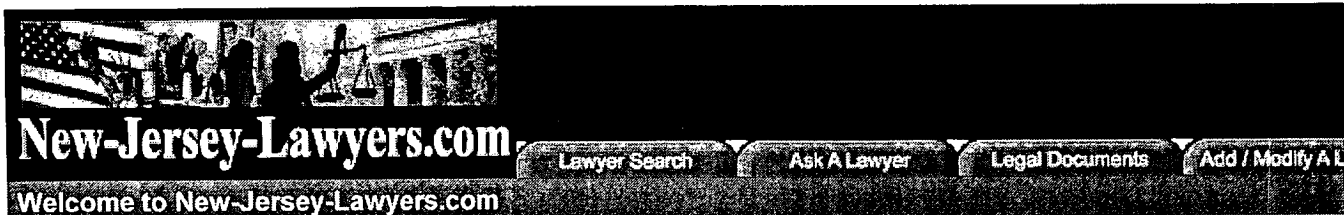
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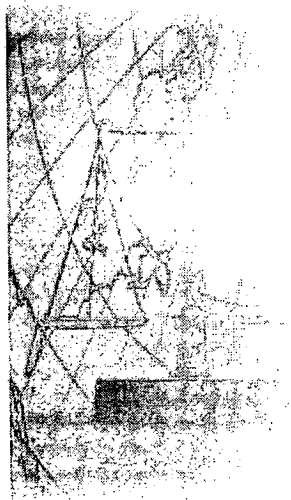


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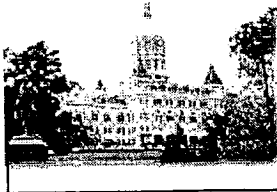
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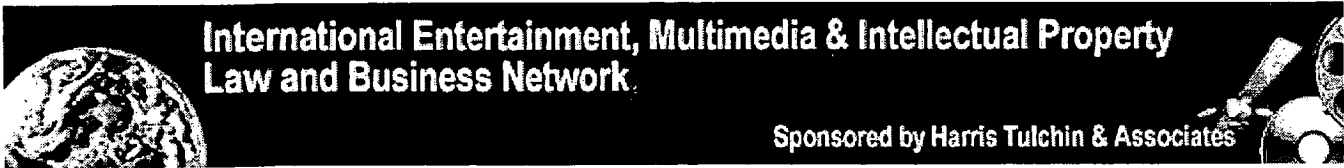
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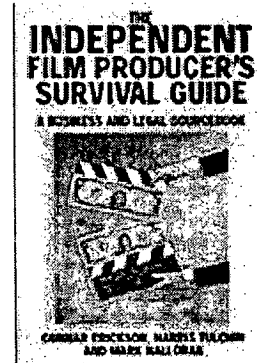
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In the loss of a loved one, these damages may be sued for by the deceased's estate or heirs. Medical bills - physician bills, hospital bills, therapy and ambulance bills - can be overwhelming, causing untold mental anguish for the family as well as the victim. Loss of income and loss of future income can be devastating for a dependant who is already suffering the emotional loss of a parent or guardian. Sometimes the financial hardship is such that they must abandon plans for education or give up the home they know.

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VIA HAND DELIVERY

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: Response to Office Action for Lawyers.com, Serial No. 75/530,795

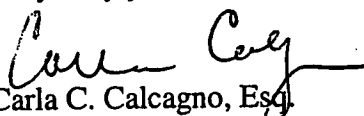
Dear Sir/Madam:

We enclose for appropriate action by the U.S. Patent and Trademark Office (PTO) the following documents regarding Serial No. 75/530,795:

1. Transmittal Letter (in duplicate);
2. Response to Office Action of May 5, 2002;
3. A postcard verifying receipt by the PTO

It is our understanding that no fee is required. If a fee is required, however, the Commissioner for Trademarks is hereby authorized to draw on the deposit account of Howrey Simon Arnold & White, Account No. 08-3038, Order No. 11774.0161.TMUS00. A duplicate copy of this letter is enclosed for billing purposes.

Very truly yours,


Carla C. Calcagno, Esq.

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:

Reed Elsevier Properties Inc.

Serial No.: 75/530,795

Filed: June 22, 1998

Mark: LAWYERS.COM

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Law Office 103

Trademark Attorney:
Kathleen Vanston, Esq.

RESPONSE TO OFFICE ACTION OF MAY 7, 2002

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

This paper is filed in response to the Office Action dated May 7, 2002.

The Office Action raises only one issue with respect to the application. The Trademark Attorney continues to conclude that the mark is merely descriptive under § 2(e)(1) of the Statute and has requested additional evidence.

As requested by the Examining Attorney, Applicant hereby submits the Declaration of Carol Cooper attesting to the acquired distinctiveness, if necessary of the mark. As requested by the Examining Attorney, in addition to the evidence previously submitted, Applicant's evidence reflects that the mark has been used for four and one half years, enjoying revenues ranging from

50 million to 200 million dollars. 2 million unique customers visit the site each year. This means that one out of ten persons in the United States has visited Applicant's site. These customers perform 500,000 searches per month. Thus, Applicant's service is the number one site of its kind in America, enjoying twice as many searches as any of Applicant's competitors.

Applicant has spent tens of millions of dollars advertising and promoting the mark, through every conceivable form of media. These include television commercials, radio commercials, printed brochures, bus shelters, subway signs and web sites, distributed nationally.

As a result of Applicant's extensive promotion, and the effort it has expended in creating a quality service, Applicant's site has received numerous awards and numerous third party references. In the past two years alone, Applicant has enjoyed hundreds of third party references, not only in newspapers and the like but also on radio and television shows. These third party references have reached a combined circulation of 100,000,000, (one hundred million) persons, i.e. approximately one-half of the population of the United States.

The quality and character of evidence sufficient to prove distinctiveness depends on the circumstances surrounding the use of the term. The Board has expressly held that some terms may acquire distinctiveness in less than five years. See e.g. *Hunter Publishing Co, v. Caulfield Publishing Ltd.* 1 USPQ2d 1996, 1999 (TTAB 1986) [holding that SYSTEMS USER was not generic and had acquired distinctiveness for a magazine title]. See also, McCarthy, J. Thomas McCarthy on Trademarks and Unfair Competition, at 15:56.

In *In re Callaway Golf Company*, 2001 TTAB LEXIS 599 (TTAB 2001), the Board found that the mark STEELHEAD for steel headed golf clubs had acquired distinctiveness, despite having been used for only three years. In that case the Applicant's sales exceeded 134

million dollars and had appeared prominently in advertisements. Further the mark had appeared in tens of millions of catalogs and numerous unsolicited articles.

Under the Hunter and Callaway standards, the LAWYERS.COM mark has acquired distinctiveness. The Applicant's revenue figures exceed those in Callaway, as have the advertising figures. Under such circumstances, Applicant respectfully submits that, to the extent distinctiveness is required, Applicant's mark has acquired distinctiveness to the relevant consuming public and publication of Applicant's mark is respectfully requested.

Wherefore Applicant respectfully requests that the Examiner withdraw the refusal to register and permit Applicant's mark to proceed to publication.

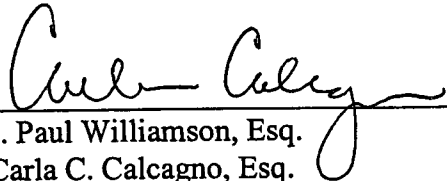
Respectfully submitted,

Reed Elsevier Properties Inc.

Dated: _____

11-07-02

By: _____


J. Paul Williamson, Esq.
Carla C. Calcagno, Esq.
Howrey Simon Arnold & White
1299 Pennsylvania Avenue, NW
Washington, DC 20004
(202) 383-6830
Attorneys for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant: Reed Elsevier Properties Inc.
Serial No.: 75/530,795
Filed: June 22, 1998
Mark: LAWYERS.COM

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Trademark Attorney:
Kathleen Vanston, Esq.

DECLARATION OF DISTINCTIVENESS UNDER SECTION 2(f)

Carol Cooper, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, and declaring that all the facts set forth in this application and declaration are true and all statements made upon information and belief are believed to be true, declares as follows:

- (1) I am Publisher and Senior Vice President of Martindale-Hubbell, a division of Reed Elsevier Inc. and I have been authorized to execute this instrument on behalf of Martindale-Hubbell and Applicant, Reed Elsevier Properties Inc. Reed Elsevier Properties Inc. owns the LAWYERS.COM mark and licenses that mark to Reed Elsevier Inc, whose division, Martindale-Hubbell, uses the mark on behalf of, and under the control of, Reed Elsevier Properties Inc.
- (2) I have been employed by Reed Elsevier Inc. since 1987 and by Martindale-Hubbell since 1995. As a result of these positions, I am intimately familiar with

Applicant's promotion and use of the LAWYERS.COM mark, through its licensee, Martindale-Hubbell.

- (3) Applicant, through its licensee, first promoted the mark LAWYERS.COM in April 1998. The LAWYERS.COM website became active on July 30, 1998. Continuously since that date, Applicant, through its licensee, has used the mark LAWYERS.COM in commerce in connection with an "online interactive database featuring information exchange in the fields of law, lawyers, legal news, and legal services" (hereafter "Applicant's services").
- (4) I have no knowledge of any person using the phrase LAWYERS.COM as a source designator for online information services, other than to refer to those services provided by Martindale-Hubbell under license from Applicant.
- (5) Since the LAWYERS.COM website was launched, Applicant, through Martindale-Hubbell, has extensively, substantially, and continuously promoted the mark. From 1998 to the present, Martindale-Hubbell has spent tens of millions of dollars, at the very least, in advertising and promoting the LAWYERS.COM mark. Martindale-Hubbell has advertised and promoted the mark through such varied, nationally distributed, media as television and radio broadcasts, printed brochures, flyers, newspapers and magazines, including USA Today, Women's Day, The National Law Journal, and American Lawyer, billboards, bus shelters and subway signs, throughout the United States and through promotion and advertisement on the web sites of others. For example, in addition to television commercials and other promotional efforts, in 2002 alone, Martindale-Hubbell ran

279,000 radio spots over 2,100 stations, generating over 371 million listener impressions.

- (6) Applicant's mark also has been the subject of extensive third-party media coverage. Since 2000, Applicant's mark has enjoyed well over 350 third party media mentions in television broadcasts, magazines, newspapers, and online publications reaching a combined circulation of over 100,000,000 (one hundred million) persons.
- (7) As a result of the extensive use, advertising, and promotion of the mark LAWYERS.COM, the LAWYERS.COM site has achieved tremendous consumer recognition. Since 1998, the LAWYERS.COM website has generated direct revenues to Martindale-Hubbell of approximately 50 million dollars, at the very least. Additional indirect revenues are generated that have not yet been quantified. However, I approximate these revenues to be at least 200 million dollars. Presently, the site enjoys approximately 500,000 searches per month, a figure two times greater than any competitor's site. Over 2 million unique customers visit the site per year.
- (8) Further, the site has received substantial recognition in the industry. Specifically, among other awards, the LAWYERS.COM site has been voted "Favorite Legal Site" by Forbes magazine, "One of the 100 Best Websites" by Entrepreneur Magazine, "One of the 50 Most Incredibly Useful Sites" by Yahoo! Internet Life, for two consecutive years, and "Best Online Directory" by Simba Report on Directory Publishing.

- (9) Additionally, Nielsen has conducted an independent survey chronicling the consumer use of the mark. A copy of relevant portions of this survey is attached.
- (10) By reason of the substantially exclusive and continuous use thereof as a mark by or on behalf of Applicant in commerce, the extensive advertising and promotional efforts made by or on behalf of Applicant for the services carrying this mark, and by reason of the extensive sales which have been generated under the mark over that time, I believe that the LAWYERS.COM mark has become distinctive as applied to Applicant's services. By distinctive, I mean that when consumers hear or see or use the term LAWYERS.COM, they understand and expect that term to refer exclusively to Applicant's services, as provided by its licensee, Martindale-Hubbell.

Respectfully submitted,

Dated: 11/7/02

By: Carol Cooper

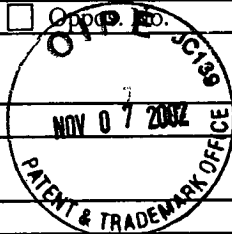
Name: Carol Cooper
Company: Martindale-Hubbell, a division of
Reed Elsevier Inc.
Title: Publisher and Senior Vice President

Please indicate receipt of the below-identified paper:

<input type="checkbox"/> New TM/SM Appl. As Follows:	<input type="checkbox"/> ITU	<input checked="" type="checkbox"/> Use-Based	<input type="checkbox"/> 44	<input type="checkbox"/> Priority
<input type="checkbox"/> Specimens	<input type="checkbox"/> Drawing	Class(es): 09	<input type="checkbox"/> Check for \$	
<input type="checkbox"/> AAU	<input type="checkbox"/> EOT #	<input type="checkbox"/> Stmt of Use	<input type="checkbox"/> Sec. 8 Decl.	<input type="checkbox"/> Sec. 8 & 15 Decl.
<input type="checkbox"/> Assignment FROM:		TO:		
<input checked="" type="checkbox"/> Response to Office Action Dated:		May 5, 2002		
<input type="checkbox"/> Other:				
<input checked="" type="checkbox"/> Hand Delivery		<input type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.	

IDENTIFICATION OF MATTER

<input checked="" type="checkbox"/> Serial No. 75/530,795	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: LAWYERS.COM			
Applicant or Registrant: Reed Elsevier Properties, Inc.		Attorney: Carla C. Calcagno	
Client: Reed Elsevier Properties, Inc.		Firm File No.: 11774.0161.TMUS00	
Mailed:	Filed:	Due Date:	

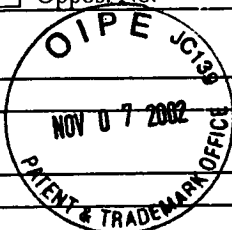


Please indicate receipt of the below-identified paper:

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<input checked="" type="checkbox"/> Response to Office Action Dated:		May 5, 2002		
<input type="checkbox"/> Other:				
<input checked="" type="checkbox"/> Hand Delivery		<input type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.	

IDENTIFICATION OF MATTER

<input checked="" type="checkbox"/> Serial No. 75/530,795	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: LAWYERS.COM			
Applicant or Registrant: Reed Elsevier Properties, Inc.		Attorney: Carla C. Calcagno	
Client: Reed Elsevier Properties, Inc.		Firm File No.: 11774.0161.TMUS00	
Mailed:	Filed:	Due Date:	



Please indicate receipt of the below-identified paper:

<input type="checkbox"/> New TM/SM Appl. As Follows:	<input type="checkbox"/> ITU	<input checked="" type="checkbox"/> Use-Based	<input type="checkbox"/> 44	<input type="checkbox"/> Priority
<input type="checkbox"/> Specimens	<input type="checkbox"/> Drawing	Class(es): 09	<input type="checkbox"/> Check for \$	
<input type="checkbox"/> AAU	<input type="checkbox"/> EOT #	<input type="checkbox"/> Stmt of Use	<input type="checkbox"/> Sec. 8 Decl.	<input type="checkbox"/> Sec. 8 & 15 Decl.
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<input checked="" type="checkbox"/> Hand Delivery		<input type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.	

IDENTIFICATION OF MATTER

<input checked="" type="checkbox"/> Serial No. 75/530,795	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: LAWYERS.COM			
Applicant or Registrant: Reed Elsevier Properties, Inc.		Attorney: Carla C. Calcagno	
Client: Reed Elsevier Properties, Inc.		Firm File No.: 11774.0161.TMUS00	
Mailed:	Filed:	Due Date:	



UNITED STATES PATENT AND TRADEMARK OFFICE

DOCKET DEPT.
HOWREY SIMON ARNOLD & WHITE

11774161-TMUS

PAPER NO. 00

MAR 18 2002

SERIAL NO. 76/530795 APPLICANT Reed Elsevier Properties, Inc. WASHINGTON, D.C.

MARK LAWYERS, PC

ADDRESS
PENNY F SIMONTON
REED ELSEVIER PROPERTIES INC
1100 N MARKET ST
WILMINGTON DE 19801

ACTION NO.
03

MAILING DATE
05/07/02

REF. NO.

ADDRESS:
Commissioner for Trademarks
2500 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

- Please provide in all correspondence:
1. Filing Date, serial number, mark and Applicant's name.
 2. Mailing date of this Office action.
 3. Examining Attorney's name and Law Office number.
 4. Your telephone number and ZIP code.

FORM PTO-1525 (5-80)

U.S. DEPT. OF COMM. & TM OFFICE

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/530795

This letter responds to the applicant's communication filed on February 7, 2002.

The refusal under Section 2(e)(1) is CONTINUED for the reasons stated in the first and second office actions.

The applicant's mark is highly descriptive as applied to the services. The applicant's three and one half years of use alone is insufficient evidence of distinctiveness. The applicant may submit actual evidence to prove the distinctiveness of the mark in commerce. The Office will decide each case on its own merits. The examining attorney will consider the following principal factors in this decision: (1) how long the applicant has used the mark; (2) the type and amount of advertising of the mark; and (3) the applicant's efforts to associate the mark with the goods/services. See *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 173 USPQ 820 (S.D.N.Y. 1972); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984); 37 C.F.R. §2.41; TMEP §§1212, 1212.01 and 1212.06 et seq. This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark and any other evidence that establishes the distinctiveness of the mark as an indicator of source.

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of the response, the applicant should insert the declaration signed by a person authorized to sign under 37 C.F.R. §2.33(a).

DOCKETED LS 6-19-02

530795

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

Kathleen M. Vanston
Kathleen M. Vanston
Examining Attorney
Law Office 103
(703) 308-9103 ext. 188

NOTICE FOR APPLICANTS FILING IN INTERNATIONAL CLASS 42

Effective January 1, 2002, the 8th edition of the Nice Agreement governing the classification of goods and services divided prior International Class 42 into four service mark classes. Information about revised International Class 42 and new International Classes 43, 44, and 45 is available at www.uspto.gov/web/offices/tac/notices/notices.htm.

All applications filed on or after January 1, 2002, must comply with the new classification schedule. For applications filed before January 1, 2002, the new classification schedule is optional. Applicants opting to amend to the new schedule must advise the assigned Examining Attorney.



1299 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20004-2402
PHONE 202.783.0800
FAX 202.383.6610
A LIMITED LIABILITY PARTNERSHIP

CARLA CALCAGNO
PARTNER
202.383.6830
calcagnoc@howrey.com

FILE: MDCA:161

February 7, 2002

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: *Response to Office Action of August 7, 2001, for Serial No. 75/530,795 -*
LAWYERS.COM

Dear Sir:


Enclosed is a Response to Office Action of August 7, 2001 for Serial No. 75/530,795.

The Assistant Commissioner for Trademarks is hereby authorized to draw on the deposit account of Howrey Simon Arnold & White, LLP, Account No. 01-2508, Order No. MDCA:161/CAC, should a fee be necessary. A duplicate copy of this transmittal letter is enclosed for billing purposes, if necessary.

Please call if there are any questions.

Very truly yours,

Howrey Simon Arnold & White, LLP


Carla C. Calcagno
1299 Pennsylvania Avenue, NW
Washington, DC 20004-2402
(202) 383-6830

CCC:crr

Enclosures

cc: J. Paul Williamson, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:	§	
	§	
Reed Elsevier Properties Inc.	§	
	§	Law Office 103
Serial No.: 75/530,795	§	
	§	Trademark Attorney:
Filed: June 22, 1998	§	Kathleen Vanston, Esq.
	§	
Mark: LAWYERS.COM	§	
	§	

RESPONSE TO OFFICE ACTION OF AUGUST 7, 2001

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

This paper is filed in response to the Office Action dated August 7, 2001. Applicant is pleased to note that the Examining Attorney has withdrawn the reference to Serial Number 75/505902 and the refusal on the ground that the mark is deceptively misdescriptive of Applicant's services.

The Office Action raises only one issue with respect to the application. The Trademark Attorney continues to conclude that the mark is merely descriptive under § 2(e)(1) of the Statute. Without waiving Applicant's right to argue this issue on Appeal, and without conceding the Examiner is correct, Applicant hereby amends this Application to claim the benefits of Section 2(f) of the Lanham Act. In support of this Amendment, Applicant submits the Affidavit of

Renee P. Simonton attesting to the acquired distinctiveness, if necessary of the mark. Applicant also points out that a Google Search for the mark LAWYERS.COM revealed only a response to Applicant's web page. See, Google search page attached as Exhibit A. Applicant also points out that a link search shows that allegedly, there are 3,640 links to Applicant's site. See, Google search for linking sites attached as Exhibit B. These facts appear to show that Applicant's use is substantially exclusive and that given the years of use and number of links, consumers are fully aware that LAWYERS.COM indicates source. Under such circumstances, Applicant respectfully submits that, to the extent distinctiveness is required, Applicant's mark has acquired distinctiveness to the relevant consuming public and publication of Applicant's mark is respectfully requested.

Respectfully submitted,

Reed Elsevier Properties Inc.

Dated: 2-07-02

By: Carla Cagno
J. Paul Williamson, Esq.
Carla C. Calcagno, Esq.
Arnold White & Durkee
750 Bering Drive
Houston, Texas 77057
(202) 383-6830
Attorneys for Applicant



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lawyers.com

Google Search

I'm Feeling Lucky

Showing web page information for lawyers.com

Attorneys - Lawyers - Law Firms - Find Hire an Attorney - ...

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Description: A simplified interface to the Martindale-Hubbell legal directory for consumers, also providing legal...

Category: [Society](#) > [Law](#) > [Services](#) > [Lawyers and Law Firms](#) > [Directories](#)

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- Find web pages that are similar to lawyers.com
- Find web pages that link to lawyers.com
- Find web pages that contain the term "lawyers.com"

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link:h_oHmdsGSIEC:www.lawyers.cc

Google Search

Searched for pages linking to h_oHmdsGSIEC:www.lawyers.com/ Results 1 - 30 of about 3,640. Search tool

Will/Probate Personal Injury Divorce Malpractice Attorneys - ...

... Here are links to resources on the web that might be useful in your search for a lawyer and other legal services. ...

www.lawyers.com/lawyers-com/content/legalresources/legalresources.html - 20k - [Cached](#) - [Similar pages](#)

Lawyers.com Firm Overview Page for Jeralyn E. Merritt

Jeralyn E. Merritt. Jeralyn ... Click here to view our Martindale-Hubbell listing. This web site is ...

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Lawyers.com News Clips Page for Jeralyn E. Merritt

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Lisa L. Schneider & Associates, ... www.ryans-edsi-arbitration-agreement-invalidated.com/3.html.

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Martindale-Hubbell's Lawyers.Com: About the Law: Criminal Law

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Enter Practice Area, City, State. AL, ... Services Provided: N/A Eligibility: N/A. Top of Page. ...

www.lawyers.com/lawyers-com/content/legalresources/georgia.html - 21k - [Cached](#) - [Similar pages](#)

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... Marin County: Legal Aid of Marin City: San Rafael Telephone: (415) 492-0230 Area Served: Marin county Services Provided: N/A Eligibility: N/A ...

www.lawyers.com/lawyers-com/content/legalresources/california.html - 50k - [Cached](#) - [Similar pages](#)

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A163

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Bankruptcy Criminal Personal Injury Will/Probate Attorneys - ...

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Martindale-Hubbell Law Directory is ...

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FedLaw - How-to Legal-related Sites

... How-to Legal-related Sites. Certiorari (cert.) (Cornell Legal Information Institute).
Court personnel (US Courts). ... Evidence (Kentucky Dept. of Public Advocacy). ...
Description: Links to 'how-to' legal-related sites from the US General Services Administration.
Category: Society > Law > Legal Information > Resources > Directories

www.legal.gsa.gov/legal92.htm - 4k - Cached - Similar pages

Spam Laws: Links

Spam Laws: Links. Legal Information. FindLaw; Law.com;
LawOffice ... Information on the Internet. Spam. ...

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martindale.com

... Martindale-Hubbell Home Feedback, Visit our affiliates... lawyers.com. LexisNexis
TM. LawCommerce.com SM. Index of Areas of Practice for the United States. ...

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martindale.com

... Banner Sponsorships Alliances and Affiliations. The
Lawyer Locator expands its reach. Through an ...

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martindale.com

... The effective way to promote your business to the
legal market. Whether you ... Expert Witness. top ...

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pages

martindale.com

... John A. Lawler. President and CEO of Reed Elsevier New Providence
(RENP), which includes Martindale-Hubbell. ...

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... Add a free listing for a US law firm. Martindale-Hubbell
endeavors to ... discuss expanding my listing. ... top ...

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... Tips for the Corporate search form. Use the Corporate
search ... the Lawyer Search form. ... Field Descriptions. ...

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... See the impact of a Professional Biography. A basic listing provides you with a presence in the Martindale-Hubbell Legal Network. ...
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Scout Report Annotations Listed by Category: Law

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Office Bearers

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SAARCLAW Patrons

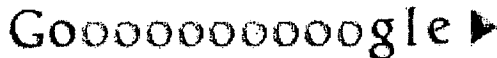
www.saarclaw.org, Welcome to SAARCLAW Homepage ! ... Home > Patrons. SAARCLAW Patrons. ...
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Untitled

... New Search. . Paul D. Supnik. Member. Paul D. Supnik. 9595 Wilshire Boulevard, Suite 201. Beverly Hills, California 90212-2512. ... New Search.

top ...

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:

Reed Elsevier Properties Inc.

Serial No.: 75/530,795

Filed: June 22, 1998

Mark: LAWYERS.COM

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§

Law Office 103

Trademark Attorney:
Kathleen Vanston, Esq.

DECLARATION OF RENEE SIMONTON

Renee Simonton, being warned that statements made with the knowledge that willful false statements and the like are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any registration resulting therefrom declares as follows; that she is president of Applicant and is authorized to make this declaration on its behalf; that she believes that the mark LAWYERS.COM has become distinctive as applied to Applicant's services by reason of substantially exclusive and continuous use thereof as a mark by the Applicant in commerce for the three and one-half years preceding the execution of this Declaration; she further declares that all statements made herein of her own knowledge are true and all statements made herein on information and belief are believed to be true

REED ELSEVIER PROPERTIES INC.

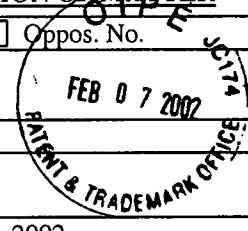
By: Renee P. Simonton
Renee P. Simonton, President

Date: 2/7/02

<input type="checkbox"/> New TM/SM Appl. As Follows:	<input type="checkbox"/> ITU	<input type="checkbox"/> Use-Based	<input type="checkbox"/> 44	<input type="checkbox"/> Priority
<input type="checkbox"/> Specimens	<input type="checkbox"/> Drawing	Class(es):	<input type="checkbox"/> Check for \$	
<input type="checkbox"/> AAU	<input type="checkbox"/> EOT #	<input type="checkbox"/> Stmt of Use	<input type="checkbox"/> Sec. 8 Decl.	<input type="checkbox"/> Sec. 8 & 15 Decl.
<input type="checkbox"/> Assignment	FROM:		TO:	
<input checked="" type="checkbox"/> Response to Office Action Dated:	August 7, 2001 and Declaration of Renee Simonton			
<input type="checkbox"/> Other:				
<input checked="" type="checkbox"/> Hand Delivery	<input type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.		

IDENTIFICATION OF MATTER

<input checked="" type="checkbox"/> Serial No. 75/530,795	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: LAWYERS.COM			
Applicant or Registrant: Reed Elsevier Properties Inc.		Attorney: Calcagno	
Client: Reed Elsevier Properties Inc.		Firm File No.: 11774.0161.TMUS00	
Mailed:	Filed: February 7, 2002	Due Date: February 7, 2002	

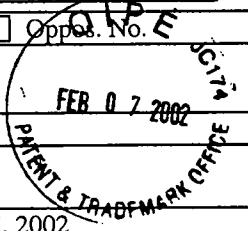


Please indicate receipt of the below-identified paper:

<input type="checkbox"/> New TM/SM Appl. As Follows:	<input type="checkbox"/> ITU	<input type="checkbox"/> Use-Based	<input type="checkbox"/> 44	<input type="checkbox"/> Priority
<input type="checkbox"/> Specimens	<input type="checkbox"/> Drawing	Class(es):	<input type="checkbox"/> Check for \$	
<input type="checkbox"/> AAU	<input type="checkbox"/> EOT #	<input type="checkbox"/> Stmt of Use	<input type="checkbox"/> Sec. 8 Decl.	<input type="checkbox"/> Sec. 8 & 15 Decl.
<input type="checkbox"/> Assignment	FROM:		TO:	
<input checked="" type="checkbox"/> Response to Office Action Dated:	August 7, 2001 and Declaration of Renee Simonton			
<input type="checkbox"/> Other:				
<input checked="" type="checkbox"/> Hand Delivery	<input type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.		

IDENTIFICATION OF MATTER


<input checked="" type="checkbox"/> Serial No. 75/530,795	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: LAWYERS.COM			
Applicant or Registrant: Reed Elsevier Properties Inc.		Attorney: Calcagno	
Client: Reed Elsevier Properties Inc.		Firm File No.: 11774.0161.TMUS00	
Mailed:	Filed: February 7, 2002	Due Date: February 7, 2002	



C. CALCAÑO
MDOCA
11774.0161, TMUSOO

MDOCA:461

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 75/530795 Reed & Sevier Properties, Inc.		APPLICANT 		PAPER NO.	
MARK LAWYERS.COM		ACTION NO. 03		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov	
ADDRESS RENEE T. STONER REED & SEVIER PROPERTIES INC 1105 N MARKET ST WILMINGTON DE 19801		MAILING DATE 08/07/01		If no fees are enclosed, the address should include the words "Free Response - No Fee."	
REF. NO.		Please provide in all correspondence:		<ol style="list-style-type: none"> 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code. 	
FORM PTO-1525 (5-00)		U.S. DEPT. OF COMM. & TM OFFICE			

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/530795

The examiner will not cite Application Serial No. 75/505902 against the applicant.

The refusal to register because the mark is misdescriptive of the identified services is **WITHDRAWN**.

Registration was refused under Trademark Act Section 2(c)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(c)(1) is maintained and made **FINAL**.

It is clear from specimens of record that the primary focus of the services is to provide information about lawyers. As such, the term "LAWYERS" is immediately descriptive of the subject matter of the services.

Furthermore, as noted in the first Office action, the suffix term ".COM" as used in the proposed mark is merely one of the standard Internet "domains" which constitute a descriptive part of Internet computer addresses or domain names. Domain names must have at least 2 parts: the part on the left which names the organization, and the part on the right which identifies the highest subdomain, such as the country (fr for France, uk for United Kingdom) or the type of organization (com for commercial; edu for educational, etc.). See the attached definition of "domain" from <http://www.computeruser.com>. Here, the ".COM" domain signifies a commercial entity accessible on the Internet.

Therefore, the combination of the descriptive term "LAWYERS" with the descriptive term "com" in the form of a domain name "LAWYERS.COM" remains descriptive in its entirety of a commercial entity which provides information about lawyers via a multi-user global computer information network.

Accordingly, the refusal to register is hereby made FINAL.

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. Section 2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).

K. Vanston
 Kathleen M. Vanston
 Examining Attorney
 Law Office 103
 (703) 308-9103 ex 188

REC'D HOWREY SIMON ARNOLD & WHITE

NOV 07 2001

HOUSTON DOCKETING DEPT.

DOCKETED UPDATED
 Previously ___ Not Required ___
 Appl. Info _____
 Reg/Grant Info _____
 Action Required: *Response to Final Refusal*
 Date Due/Done: *2-7-02*
 By: *RB* Checked *JM*

DOCKETED UPDATED
 Previously ___ Not Required ___
 Appl. Info _____
 Reg/Grant Info _____
 Action Required: *Notice of Appeal to TTABU*
 Date Due/Done: *2-7-02*
 By: *RB* Checked *JM*

A170

Definition for: domain name

An Internet address in alphabetic form. Domain names must have at least 2 parts: the part on the left which names the organization, and the part on the right which identifies the highest subdomain, such as the country (fr for France, uk for United Kingdom) or the type of organization (com for commercial; edu for educational, etc.). Directory levels can be indicated in other parts. The IP address is translated into the domain name by the domain name server.

SEARCH

Look Up

Put this on my site
Tell a Friend | Help!
No Frames!

A171

8/7/01 11:37 AM

Aug-10-01 12:57P

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

SERIAL NO.

APPLICANT

PAPER NO.

75/530795 Reed Elsevier Properties, Inc.

MARK

LAWYERS.COM

ADDRESS

RENEE P SIMONTON
 REED ELSEVIER PROPERTIES INC
 1105 N MARKET ST
 WILMINGTON DE 19801

ACTION NO.

02

MAILING DATE

01/14/00

REF. NO.

Assistant Commissioner
 for Trademarks
 2900 Crystal Drive
 Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

RE: Serial Number: 75/530795

The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

1. Action on this application is suspended pending the disposition of:

Cancellation No(s). _____

Opposition No(s). _____

Civil Action No(s). _____

Concurrent Use No(s). _____

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

Application Serial No(s). 75/505902

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) is attached was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of foreign of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

4. Action on this application is suspended for months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R 2.67.

5. The following refusals/requirements are continued:

(1) Section 2(e)(1) refusal

Kathleen Vanston

EXAMINING ATTORNEY NAME

Kathleen Vanston

EXAMINING ATTORNEY SIGNATURE

LAW OFFICE

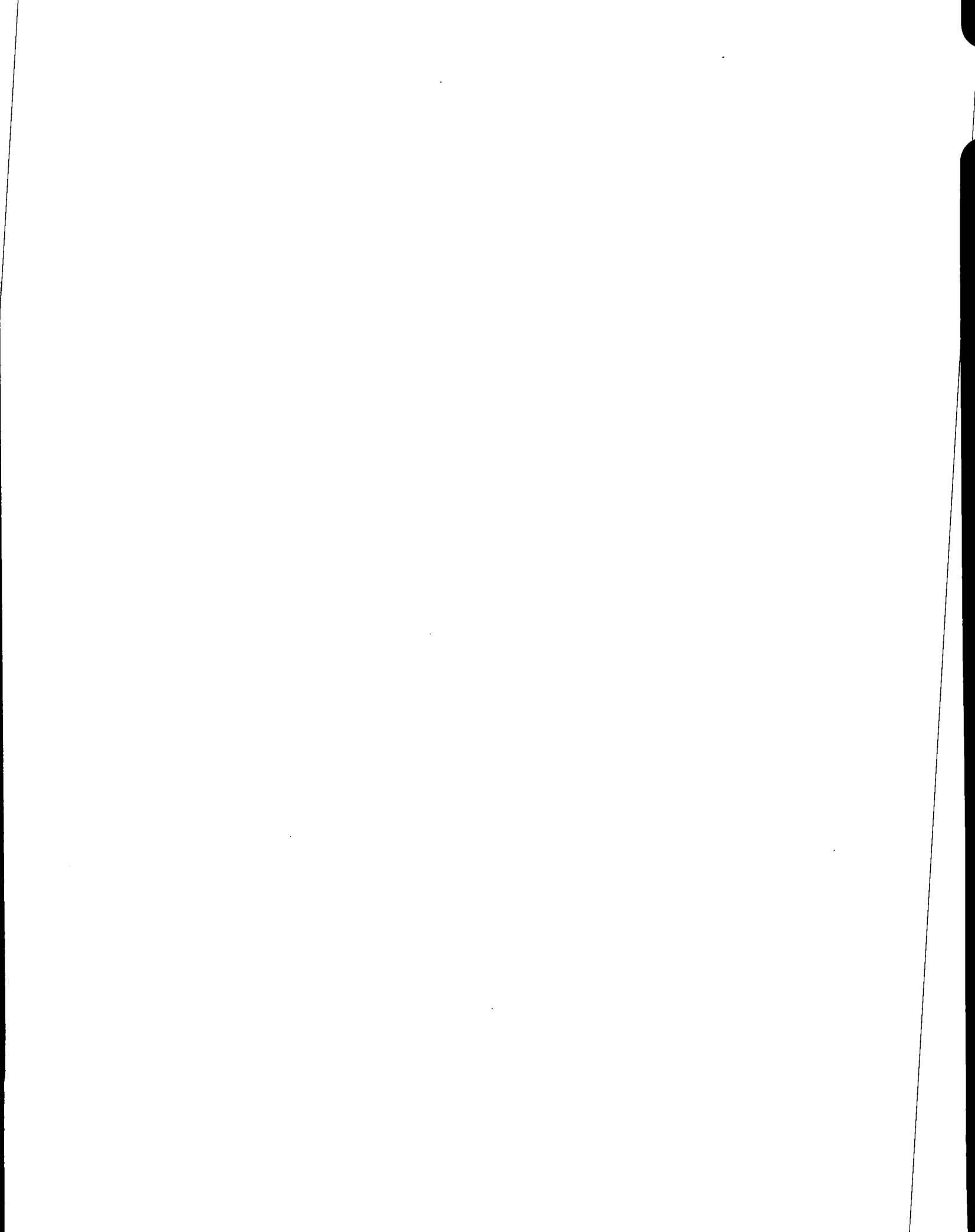
(703)

PHONE

rec'd 1/21/00
 128

Form PTOL-373 (Rev. 8-94)

A172



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:	§	
	§	
Reed Elsevier Properties Inc.	§	
	§	Law Office 103
Serial No.: 75/530,795	§	
	§	Trademark Attorney:
Filed: June 22, 1998	§	Kathleen Vanston, Esq.
	§	
Mark: LAWYERS.COM	§	
	§	

RESPONSE TO OFFICE ACTION OF APRIL 28, 1999

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

This paper is filed in response to the office action dated April 28, 1999. Applicant is pleased to note that the Examining Attorney has found no registered mark that would bar registration of Applicant's mark under Section 2(d) of the Lanham Act.

The office action raises only two issues with respect to the application. First, the Trademark Attorney concludes that the mark is merely descriptive under § 2(e)(1) of the Statute. Specifically, the Trademark Attorney indicates that the mark merely describes the subject matter of the Applicant's services, i.e., that Applicant provides information about lawyers.

For the reasons noted below, the Trademark Attorney is urged to reconsider the refusal.

As has been stated frequently, for a mark to be “merely descriptive” it must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. If imagination, thought or perception is required to reach a conclusion as to the nature of the goods or services, then the mark is suggestive. As noted in McCarthy on Trademarks, § 11:19, at page 11-26, if information about the product or service given by the term sought to be registered is indirect or vague, then this indicates that the term is suggestive and not descriptive.

To begin with, Applicant is seeking to register a unitary mark, LAWYERS.COM, and it is the mark as a whole that must be analyzed, not its individual components, or combinations within the whole, as it is the unitary whole that consumers will view.

When considered as a whole, the unitary mark LAWYERS.COM does not immediately convey an idea of the ingredients, qualities or characteristics of these identified services. The services in question are designed to offer information about the law, and to provide a forum for discussing law, among other topics. Information about lawyers is not necessarily the whole or even the primary emphasis of Applicant’s service. The unitary mark is vague, at best, in terms of conveying any specific information about the total service package.

The Trademark Attorney has focused separately on the “LAWYERS” element of the unitary mark to support the idea that the mark as a whole is somehow descriptive. Even assuming, without conceding, that “lawyers” is somehow descriptive of Applicant’s services, the Examining Attorney has not shown that “LAWYERS.COM” is merely descriptive. Apart from current office policy, the Examiner has not offered a single case holding “.COM” to be merely

descriptive of Applicant's services. The cases cited by the Examiner do not speak to the registration of marks including the form ".com," let alone hold that all uses of ".com" are merely descriptive. By way of example, if Applicant sought to register ".COM" alone as a mark for Applicant's services, would the Examiner really consider that mark merely descriptive of the quality or characteristics of Applicant's services?

For this reason, the Patent and Trademark Office has registered marks comprised of the ".COM" formulation. These include: SOFTWARE.COM for computer software, and PARENTS.COM for online magazines in the fields of child development and parenting.

Moreover, even assuming, without conceding, that "lawyers" and ".com" were separately descriptive of Applicant's services, this does not render the two-word combination merely descriptive as a whole. See, e.g., In re Colgate Palmolive Co., 149 U.S.P.Q. 793 (TTAB 1966) (HANDI-WIPES not merely descriptive of disposable wipes); In re Polytop Corp., 167 U.S.P.Q. 383 (TTAB 1970) (LOCK-TOP not merely descriptive of bottle closures).

A mark does not have to be devoid of all meaning relevant to the goods or services in connection with which it is used in order to be protectable. It can have the capacity to draw attention to what the service is or to what are features of the service and still be suggestive, rather than descriptive, when it requires an effort of the imagination of the consumer in order for the mark to be understood as descriptive of a particular feature or aspect of the service. The Vision Center v. Opticks, Inc., 202 U.S.P.Q. 333 (5th Cir. 1979), cert. denied, 444 U.S. 1016.

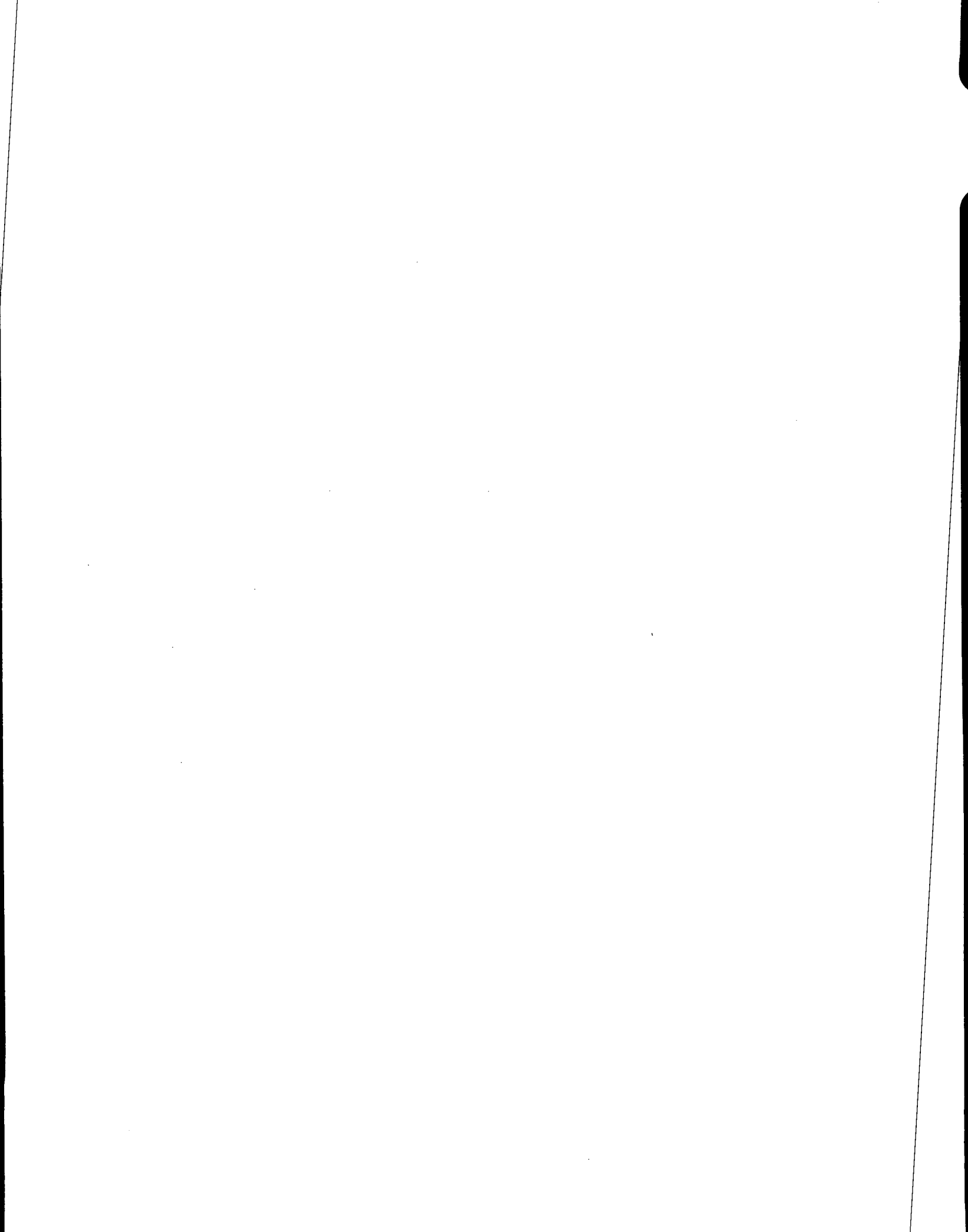
Applicant notes that the Examining Attorney advises Applicant of the current pendency of a previously-filed application. Until the Examiner decides whether or not to initiate a refusal, Applicant will defer response to that issue.

Respectfully submitted,

Reed Elsevier Properties Inc.

Dated: 10-28-97

By: Carla Calcagno
J. Paul Williamson, Esq.
Carla C. Calcagno, Esq.
Arnold White & Durkee
750 Bering Drive
Houston, Texas 77057
(202) 289-0229
Attorneys for Applicant



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

<p>SERIAL NO. 75/530795 APPLICANT Reed Elsevier Properties Inc. SD</p> <hr/> <p>MARK LAWYERS.COM</p> <hr/> <p>ADDRESS JENEE P SIMONTON REED ELSEVIER PROPERTIES INC .105 N MARKET ST WILMINGTON DE 19801</p>	<p>PAPER NO.</p> <hr/> <p>ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513</p> <p><small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small></p> <hr/> <p>Please provide in all correspondence:</p> <ol style="list-style-type: none"> 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.
<p>FORM PTO-1525 (5-90)</p>	<p>U.S. DEPT. OF COMM. PAT. & TM OFFICE</p>
<p>ACTION NO. 71</p> <hr/> <p>MAILING DATE 04/29/91</p> <hr/> <p>REF. NO.</p>	

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.
For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/530795

The assigned examining attorney has reviewed the referenced application and determined the following.

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 et seq.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

Here, the applicant seeks to register LAWYERS.COM. In effect, the proposed mark merely combines the descriptive term LAWYERS with standard Internet top level domain COM. The prefix term LAWYERS is descriptive in that it appears to describe the subject matter of the information provided by the applicant namely, information about lawyers.

Furthermore, as noted above, the suffix term ".COM" as used in the proposed mark appears to be merely a standard top level domain name commonly used for on-line computer network addresses. Therefore, prospective customers will be immediately led to believe by the suffix ".COM" that the services are or would be provided through a multi-user global computer information network. As such, the addition of the top level domain is not considered sufficient to overcome the inherently descriptive significance of the remainder of the proposed mark.

Alternatively, to the extent that the proposed mark does not describe any aspect of the goods and/or services, then the idea it conveys would be false because, given the nature of the goods and/or services, it is plausible that the proposed mark would immediately be understood as describing some aspect of the goods and/or services or the manner in which the goods and/or services are provided.

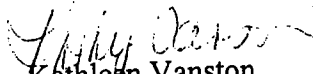
If the idea conveyed by the mark is false, and also plausible, then the term is deceptively misdescriptive and is unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983).

Therefore, to the extent that the proposed mark does not describe any aspect of the goods and/or services or the manner in which they are provided, as indicated above, the examining attorney concludes that the proposed mark would be deceptively misdescriptive and, therefore, in the alternative, registration is refused on that basis as well.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

Although the examining attorney has searched the Office records and has found no similar *registered* mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), the examining attorney encloses information regarding pending Application Serial No. 75505902. 37 C.F.R. Section 2.83.

There may be a likelihood of confusion between the applicant's mark and the mark in the above noted application under Section 2(d) of the Act. The filing date of the referenced application precedes the applicant's filing date. If the earlier-filed application matures into a registration, the examining attorney may refuse registration under Section 2(d).


Kathleen Vanston
Examining Attorney
Law Office 103
(703) 308-9103 ex 188

[Typed Drawing]

Mark

LAW.COM

Goods and Services

IC 042. US 100 101. G & S: providing information relating to legal services, legal products and law

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75505902

Filing Date

19980622

Filed ITU

FILED AS ITU

Owner Name and Address

(APPLICANT) Law.Com, L.L.C. COMPANY ARIZONA 1201 South Alma School Road
Suite 400 Mesa ARIZONA 85210

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

75530795

TRADEMARK APPLICATION SERIAL NO. _____

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

08/14/1998 VJONES 00000156 75530795
01 FC:361 245.00 OP