

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77366584
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>RESPONSE</u></p> <p>We respectfully respond to the Office Action dated September 29, 2008 on behalf of our client, Pearson Education, Inc.</p> <p style="text-align: center;"><u>AMENDMENT</u></p> <p><u>Date of First Use</u></p> <p>Upon further investigation Applicant discovered that the date of first use listed in the application was incorrect. Applicant hereby submits that the date of first use anywhere and the date of first use in commerce is December 2006. A declaration by Applicant is submitted certifying this new date of first use.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>The Examining Attorney has refused registration on the Principal Register for the above-referenced application on the ground that the mark BIOFLIX is merely descriptive as used in connection with Applicant's services. Specifically, the Examining Attorney objects to BIOFLIX as being merely descriptive of Applicant's educational services in the field of biology since "bio is a prefix that refers to biology and the word "FLICK" is a slang term for movie."</p> <p>Applicant continues to maintain that the mark is inherently distinctive for the reasons stated in our previous submissions. However, in lieu of repeating those arguments again and without in any way conceding that the mark is not inherently distinctive, Applicant provides the evidence of acquired distinctiveness under Section 2(f) of the Trademark Act. Applicant specifically reserves its right to appeal the issue of acquired distinctiveness, and has therefore filed a Notice of Appeal.</p> <p>Applicant respectfully requests the Examining Attorney reconsider the refusal in light of the independent arguments made</p>	

below.

RESPONSE

I. In the Alternative, Applicant's Mark Has Acquired Distinctiveness

In the event that the Examining Attorney maintains the refusal to register based on inherent distinctiveness, Applicant submits that its BIOFLIX mark has acquired distinctiveness in the market place. Applicant is attaching the Declaration of Stephanie M. Foster as Exhibit A in further support of its claim of acquired distinctiveness.

It is well established that a mark can be merely descriptive of "the services for purposes of Section 2(e)(1), but not so highly descriptive as to be incapable of functioning as a service mark to identify applicant's services and distinguish them from like services of others." *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). Clearly, the term BIOFLIX is not such a common term that it is incapable of serving as a trademark. Indeed, by virtue of the fact that the Examining Attorney has offered Applicant the opportunity to register the mark on the Supplemental Register reflects his determination that the mark is capable of acting as a trademark. The only question therefore is whether the mark has in fact acquired distinctiveness such that consumers perceive it as a source designation.

II. The Evidence of Acquired Distinctiveness

As described in the Declaration of Stephanie Foster, Applicant is the global leader in educational publishing. Applicant offers what is considered by many to be the most comprehensive range of educational programs, in all subjects, for every age and level of student, from pre-K-12 through higher education and beyond. In fact, Applicant has provided services to more than 100 million students around the globe with the largest number being located in the United States. Indeed, Applicant's educational materials are so widely used that virtually every high school and/or college graduate in this country has used one of Applicant's products at sometime in their educational career.

The BIOFLIX brand refers to an educational supplement offered to the purchasers of certain college level textbooks in the field of biology. Specifically, BIOFLIX allows students to view educational videos on their computer via the Internet that highlight and expand on certain subjects covered in the textbook and classrooms. For instance, a particular BIOFLIX feature may show how neutrons work or provide a virtual tour of an animal cell.

Notwithstanding that the mark has only been in existence for less than three years, more than 200,000 students have registered to have access to the BIOFLIX service. Of course, the number of students and others within the educational community that are aware of the BIOFLIX brand is far larger. Students and other potential users of this mark are exposed to Applicant's BIOFLIX branded service in five different ways: (1) as a supplement to the textbook; (2) as an in class teaching tool; and (3) as a link from other websites; (4) as part of the Pearson on-line catalog, and (5) in connection with Pearson's efforts to differentiate the textbooks linked to this product as part of its sales efforts to persuade instructors to select these textbooks over the textbooks of its competitors.

Students first receive information about this online supplement with the purchase of one of the many textbooks that are linked to this brand. This information provided at the time that the textbook is purchased. An interested student can then register on-line for this service. As a result of this registration requirement, Pearson knows that since December of 2006 more than 300,000 students

have used its BIOFLIX product. This program is experiencing exponential growth. For instance, the number of registered students doubled between 2007 and 2008 (from approximately 83,000 to just over 182,000) and is on track so far to more than double again by the end of this year. Thus by the end of 2009 we expect that more than 500,000 students will have accessed and used the BIOFLIX service.

Significantly, the web pages using the BIOFLIX mark do so in an “attention getting” style such as a head line or in set apart type that signals that this designation is not being used merely a generic descriptor but as a brand. It is also equally significant that the BIOFLIX mark typically appears with a “tm” symbol thereby reinforcing the consumers’ perception that this term functions as a source designation.

Of course, even students who do not register for the BIOFLIX service come into contact with the mark. Obviously, any student who buys one of the ten or so textbooks currently linked to this product service are all provided information about the BIOFLIX supplemental Internet educational material. These students encounter the BIOFLIX trademark through websites introducing students to their relevant text, see www.firstdayofclass.com, through the mybiology website which presents all the student supplements and by reference in the print or eBook version of the main textbook. A particular BIOFLIX educational video may also be used by a professor or teaching instructor as part of a class room presentation on a particular topic. In this fashion, every student in the class room is exposed to the brand.

In addition, other websites link to the BIOFLIX website and in doing so, prominently display the BIOFLIX trademark. According to Applicant’s own tracking of this information there are at the present time at least 12 other web sites that link to the BIOFLIX web page. Thus, all of the visitors to these other web pages have also been exposed to this mark.

We also note that the Pearson on-line catalog also features this mark. Thus, users of the catalog will see the details of this service. The mark BIOFLIX is set apart from the remainder of the text by use of the “tm” symbol. *See*

<http://vig.pearsoned.co.uk/catalog/academic/product/0,1144,0321512618,00.html>.

Finally, the BIOFLIX supplemental offering is an integral part of the sales pitch given to college

professors and other influencers of such decisions as to why a Applicant's product should be selected over its competitors.

In considering the probative value of this information we note that the Lanham Act creates a presumption that a mark which has been in use for five (5) years has acquired distinctiveness. While this mark has not yet been in use for five (5) years, the clear evidence establishes that it functions as a trademark along the relevant consumers and has become associated as a designation or origin.

III. Applicant's 2(f) argument Does Not Negate the Need for the Examining Attorney to Reconsider the Determination of Whether the Mark is Inherently Distinctive.

However, while Applicant submits this evidence of acquired distinctness, it specifically requests that the Examining Attorney not approve this mark for publication until he has advised Applicant that it may either elect to appeal the denial of inherent distinctiveness or accept a 2(f) registration. This is no more than the TMEP requires.

IV. In the Last Alternative, Applicant Accepts the Examining Attorney's Invitation to Register the mark on The Supplemental Register.

The Examining Attorney has already invited Applicant to accept registration on the Supplemental Register. Applicant requests that in the event that it elects to appeal the denial of the inherent distinctiveness and/or the denial of the 2(f) evidence that the Examining Attorney then accept Applications' acceptance of this offer. However, Applicant again emphasizes that its acceptance of the Supplemental Registration is only in the event that both its inherent distinctness and 2(f) arguments do not persuade the examining attorney. See TBMP §§ 1201, 1204; and TMEP § 715.03(b). In order to preserve its rights in this application, Application submits that if it has no other choice, it will agree to amend the mark to the Supplemental Register.

V. Conclusion

For all of the reasons stated above, Applicant respectfully requests that the Examining Attorney withdraw the refusals to register Applicant's BIOFLIX trademark on the Principal Register and pass the application to publication without a claim of acquired distinctiveness. In the alternative, the Applicant requests that the Examining Attorney indicate his acceptance of the mark under 2(f) but issue a final office action on inherent distinctiveness so that the Applicant can pursue an appeal.

EVIDENCE SECTION	
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DESCRIPTION OF EVIDENCE FILE	Declaration of Stephanie M. Foster in Support of Claim of Acquired Distinctiveness
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	041
DESCRIPTION	
Educational services, namely, online tutorials for students and instructors in the field of biology; online tutorials for students and instructors in the field of biology featuring 3D animations	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 08/06/2007
FIRST USE IN COMMERCE DATE	At least as early as 08/29/2007
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	041
DESCRIPTION	
Educational services, namely, online tutorials for students and instructors in the field of biology; online tutorials for students and instructors in the field of biology featuring 3D animations	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 12/00/2006
FIRST USE IN COMMERCE DATE	At least as early as 12/00/2006

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