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

Proceeding	86455558
Applicant	Iris Data Services, Inc.
Applied for Mark	ARC
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Submission	Reply Brief
Attachments	Applicant ARC reply brief.pdf(95992 bytes) Exhibit A to Applicant ARC Reply Brief.pdf(84985 bytes)
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Date	02/14/2017

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

In re Application: SN: 86-455558	)	
	)	Examining Attorney: Andrea Hack, Esq.
	)	Law Office: 108
Applicant: Iris Data Services Inc.	)	

REPLY TO EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant wishes to make a brief statement in response to a few points raised by the newly appointed Examining Attorney in her Appeal Brief. Applicant respectfully submits that the Examiner's Statement misstates the evidence, the applicable facts, the procedural history, and the legal standards on which this Appeal is based. Accordingly, Applicant respectfully requests that the Board consider and reverse the refusal to register.

PROCEDURAL BACKGROUND

In light of the unusual nature of the prosecution history, Applicant wishes to clarify the events leading to the amendment of goods between the filing of Applicant's brief and the current Examiner's Statement.

Applicant did not sua sponte amend the identification of services. Instead, the undersigned added the bolded language upon a proposal by the former Examiner to resolve the ex parte appeal. Specifically, in September 2016, after he read Applicant's Appeal Brief, the first examiner in this case called the undersigned attorney. He proposed the amendment to the Applicant, as a means of resolving the appeal and allowing Applicant's mark to proceed to publication. After consideration, as it narrowed the identification, Applicant agreed to amend its

description of services as proposed by the Examiner, if, and only if, as he proposed, he would withdraw the refusal to register. To that end, on September 22, 2016, Applicant amended its originally filed identification to add the language **provided exclusively to law firms,** so that it reads as follows: "Litigation support services **provided exclusively to law firms**, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit".

An Examiner's Amendment was duly issued on September 23, 2016. However, on September 28, 2016, the undersigned was advised that a PTO supervisor rejected the agreement and refused to pass the mark to publication.

On that same date, in light of the fact that the amendment had been entered into upon reliance in the Examiner's and Applicant's agreement and after the prosecution of the application had been closed, the Board issued an order noting that no new evidence could be filed. Despite this, Examiner Hack has relied on dictionary definitions in support of her Argument.

To the extent that this is a violation of the Board's order, Applicant objects. However, even with this new evidence, Applicant respectfully submits that the refusal to register is improper.

ARGUMENT

Applicant wishes to clarify and stress that the present identification is "Litigation support services **provided exclusively to law firms**, namely, conducting **electronic** legal discovery in the nature of reviewing e-mails **and other electronically stored information** that could be relevant evidence in a lawsuit".

By virtue of this identification, the law presumes **conclusively** that (1) Applicant provides **electronic** legal discovery services, as that term is commonly understood and (2) these electronic discovery services are offered and provided **exclusively to law firms**.

The Examiner's Statement rests on the mistaken conclusion that "legal services" comprises "electronic legal discovery." No evidence supports the Examiner's conclusion.

Numerous dictionaries define the phrase "legal services" as the services provided by a "lawyer to his or her client." See, e.g. Exhibit B to Applicant's Appeal Brief and attached hereto as Exhibit A.[1]

Given these definitions of the phrase "legal services" one need not engage in the Examiner's multi-staged tortured ontological analysis derived from the meaning of the term "law" to derive at a meaning of the phrase. The Cambridge Dictionary and others reflect that "Legal Services" is a defined phrase. This meaning differs materially from that proposed by the Examiner.

Moreover, Applicant respectfully invites the Board's attention to the fact that even in the Examiner's definition, Number 6, which Applicant recommends as the most relevant, defines "legal" as "applicable to attorneys." Further when carried to its logical and Applicant respectfully submits, improper conclusion, the Examiner's proposed ontological definition of legal services would encompass such materially differing services as a process server, a judge in a courtroom, a mail room clerk in a law firm. This definition conflicts with the precise clear definition of the phrase "legal services" offered by *two* standard dictionaries as what consumers understand by the phrase.

[1] While Applicant maintains its objection to the Examiner's evidence, nonetheless, only to the extent that the Board permits the Examiner to submit the dictionary definitions attached to her brief, in fairness, Applicant requests that the Board take judicial notice of the additional definition attached hereto as Exhibit A.

Most importantly, no evidence in the record exists that lawyers typically offer ***electronic*** legal discovery services. In fact, the record shows the exact opposite. As the Committee Notes Committee Notes and Applicant's specimens cited in Applicant's Main Brief has shown, discovery and electronic discovery are defined as entirely different concepts. Lawyers conduct discovery. Computerized technology companies, like Applicant's, conduct electronic discovery. As stated in Applicant's opening brief, this is because both the knowledge and the technology to conduct each differ.

Electronic legal discovery requires the use of computers to locate, analyze documents for metadata and other electronically stored information (ESI) that humans cannot even perceive.

As Judge Faciolla held, in one of the most famous cases first defining the rules on electronic discovery, appropriate searching of electronic data is too complicated for lawyers, but instead required the use of computerized solutions experts. *U.S. v O'Keefe, 537 F. Supp. 2d 14* (D. D.C.2008). As that court stated, ediscovery involves "the interplay at least of the sciences of computer technology, statistics and linguistics… Given this complexity, for lawyers and judges to opine is truly to go where angels dare to tread." *Id.* Subsequent cases therefore have affirmatively sanctioned counsel for failing to retain such companies to perform ediscovery. See e.g., *Mosley v. Conte, 110623/2008 (8-17-2010)*, 2010 NY Slip Op 32424(U), 14 (N.Y. Misc. 2010), explaining the problems of attempting to analyze ESI without a computer forensic expert and ordering party to retain and search and analyze documents through a computer forensic expert. ["The affidavit of a computer expert following his or her examination of and search through Conte's computers, email databases, and the like, also might have alleviated these problems. In their absence, the Court does not find the Conte affidavit sufficiently comprehensive or persuasive about the existence of ESI.]

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