

# **THE SEARCH FOR EVIDENCE TO SUPPORT A FINAL REFUSAL**

## **2(d) and 2(e)(1)**

### **I. When is a final action appropriate**

TMEP Section 1105.04(c) -- When Final Action is Appropriate

Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant. That is, all issues have been raised previously by the examining attorney. The examining attorney should examine an application completely on the initial examination and should phrase any resulting Office action in a way which will make all issues and requirements clear and will indicate the courses available to the applicant in response, so that all issues can be addressed when the application is taken up for second action.

The attached supplemental charts and memos should assist you in making this determination.

### **II. What kind of evidence, how much, and where to find**

Once you have determined that final action is appropriate, the next hurdle is the evidence. This memo will break down the task for the 2 most common statutory sections, 2(d) and 2(e)(1).

#### **A. The 2(d) evidence package**

Consider the test for likelihood of confusion as set forth by Dupont:

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney **must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely.** *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

It's the "relatedness of the goods/services" and the "channel of trade" prongs which require evidence. As such, the evidence package must be tailored to the type of goods/services which are involved. However, there is a way which one can generally approach this task.

**Step 1:** When possible, use Pinckney’s Products Comparison Manual for Trademark Users to find case law to support your position. In the same light, use the USPTO’s search tool to find a case [I find the “words and phrases” option the easiest to use—you might try:  
 2(d) and [applicant’s goods/services] and [registrant’s goods/services]  
 or confusion and applicant’s goods/services] and [registrant’s goods/services]

**Step 2:** look for the prima facie case in X-search 1.1.<sup>1</sup> The [gs] field should be employed; and both the “exact match” and “adjacent” search tags should be used.

EXAMPLE: The applicant’s mark is mark **CAPELLA** for "**educational and training** services, namely conducting courses, certificate and degree programs, seminars and workshops in the **fields** of business, **technology**, education, liberal arts, and health and human services." The cited mark is identical for various services "**installation, maintenance, and repair of computer networks, computer programs, and installation of computer networks.**"

The search should begin with x-search 1.1. Enter the following:

```

1 52819 (repair$ or install$ or maintain$)[gs]
2 329834 T (computer$ or software)[gs]
3 329901 (computer$ or software)[gs]
4 109831 (educat$ or train$)[gs]
5 16173 technolog$[gs]
6 16068 1 and (2 3)
7 3942 4 and 5
8 385 6 and 7
9 71 8 and registrant[ow]
10 71 9 not sect44[s4]
```

Print 10 or 15 of the best registrations for attachment.

- In some cases, you should use both the exact match and the adjacent operators on 1.1.

```

1 0 "electric heater$"[gs]
2 68 "electric heater"[gs]
3 622 "electric heaters"[gs]
4 791 T electric$[gs] adj heater$[gs]
5 791 electric$[gs] adj heater$[gs]
6 632 5 not sect44[s4]
7 403 6 and registrant[ow]
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<sup>1</sup> Note the type of registrations which should/should not be included in the memo entitled “Evidence Gathering.”

- In some cases, you might also need to think of equivalent goods/services. For example, if the services are “retail stores featuring radios,” you might want to search for “retail stores” and “consumer electronics” or “recording devices” or things of that nature.

**Step 3:** The search on Nexis. Please refer to the Nexis search strategy memo. Here, you must determine “why” the goods/services are related.

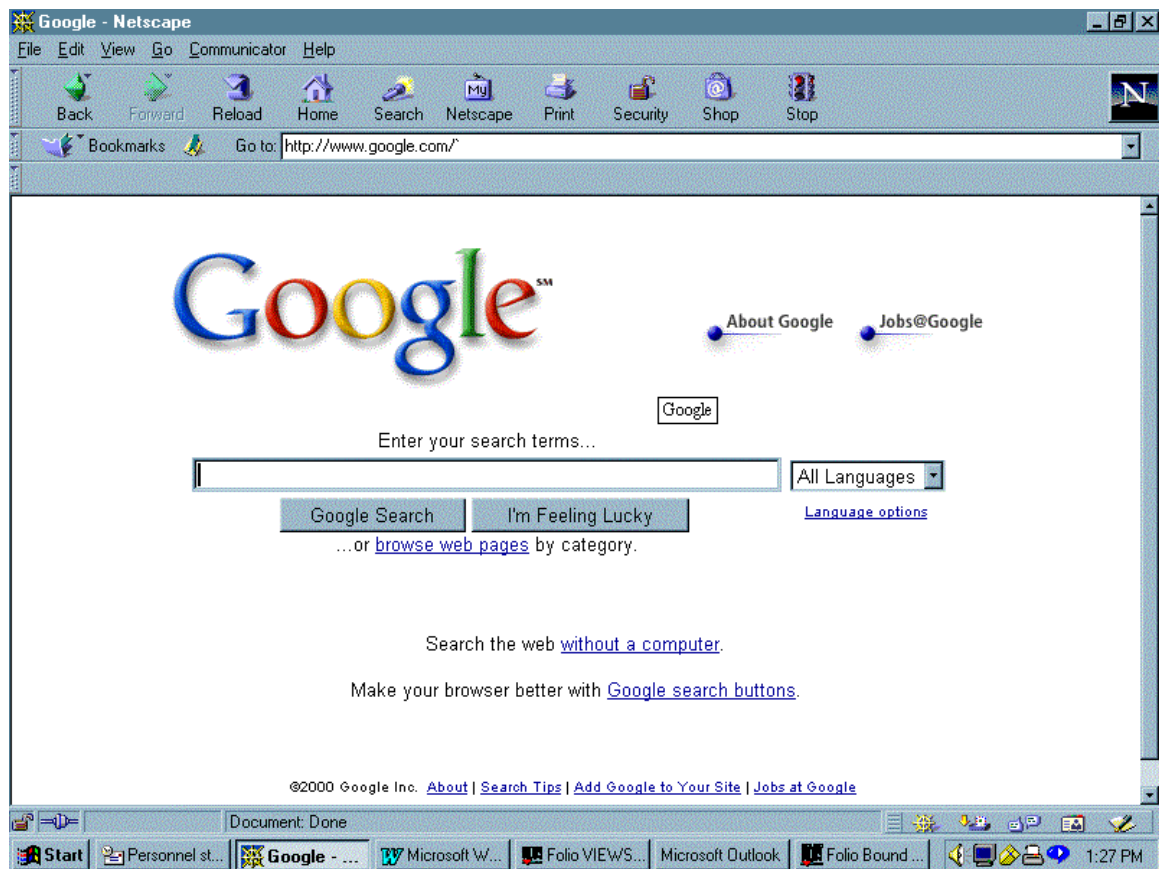
- Consider entering the g/s in without any qualifiers first, e.g. if the services are as the example above, try:
  1. ((repair! or maintain! or install!) w/5 (train! or educat! or seminar or class)) w/5 ((field or area or subject) w/2 (computer or software or technology))
  2. Note the double parentheses. Grouping the search terms is important for relevant hits.
- Look through some of the stories and see what the relationship is between/among the goods/services. Then if necessary, re-fashion the search to get more pointed hits.
  1. If you believe that the goods, in this case cars and tires, are made by the same makers, then execute this search:
    - (mak! or manufactur! or produc! or fabricat!) w/5 ((car or automobile or suv or truck or van) w/3 (tire))
  2. If you believe that the goods, in this case tv and radios, are sold in the same channel of trade, then try this one:
    - (retail! or sold or sell! or sale or distribut! or display!) w/5 ((television or tv) w/2 (radio))
    - In this case, you might also want to go for: (retail! or sold or sell! or sale or distribut! or display!) w/5 (consumer electronic or electronic products or electronic goods)
  3. If you believe that the goods, in this case programming tools and servers, which end up being used by the same users, then identify the group and search for that.
    - ((programmers or network managers or administrator) w/3 (use or employ! or utiliz!)) w5 ((programming w/1 (tool or software)) w/5 server))

Print out the stories most relevant. Remember it is not the number of stories but the substance of the stories which would be persuasive to the Board. See the Evidence Searching memo for the type of stories to be included/excluded.

**Step 4:** Use the web. The website which is most helpful is [www.google.com](http://www.google.com) which searches fast and intelligently. You need only to put the applicant's and registrant's goods and services in and look through the website hits to see if they are related.

Another good search engine is [www.altavista.com](http://www.altavista.com). This one has an advanced search button which resembles Nexis and can be helpful, too.

- Hint on getting stories from the sites which do not allow you to print: You can scroll to the portion you like on the site, hit "screen print" [top, right hand corner of your keyboard]; then toggle to the word document, then hit "paste" or Ctrl V to past the document onto your page. See below.



**Step 5:** This step may or may not be necessary, depending on the type of goods/services.

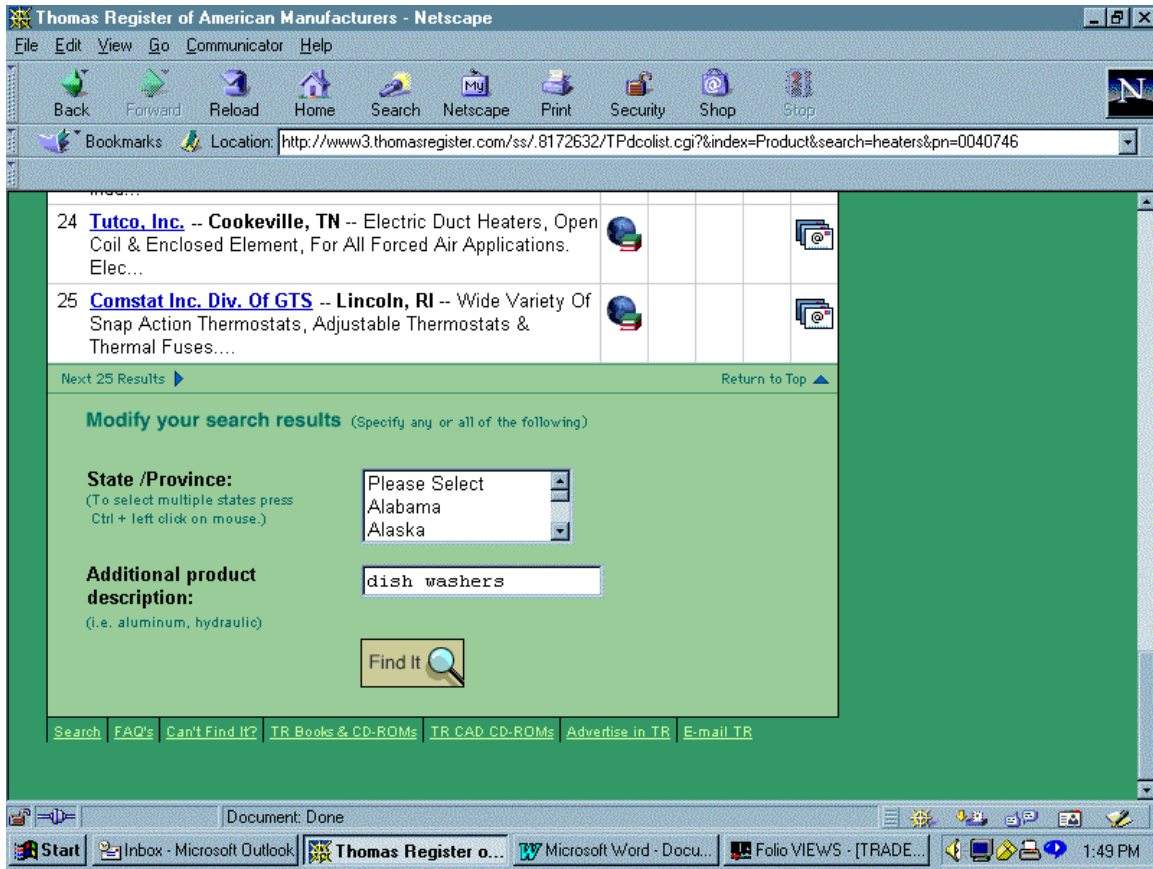
- Thomas register—on line at [www.thomasregister.com](http://www.thomasregister.com). The site is good for getting descriptions of goods; and sometimes helpful for 2(d) purposes if the goods are technical.

Example: looking for heaters and dishwashers

The screenshot shows a Netscape browser window with the address bar containing the URL: <http://www3.thomasregister.com/ss/8172632/TRpsrch.cgi?&index=Product&search=heaters>. The page content includes the Thomas Register logo, a search path of 'heaters', and a total of 696 product headings found. A table lists the top 13 results with columns for product name and counts for various categories.

|  | Companies | Catalogs & Websites | Order Online | CAD Drawings | PDF or Fax Literature | Send E-mail |
|--|-----------|---------------------|--------------|--------------|-----------------------|-------------|
| 1 <a href="#">Heaters</a>  | 281       | 83                  | 11           | 6            | 9                     | 130         |
| 2 <a href="#">Heaters: Acid</a>                                  | 49        | 23                  | 1            |              | 1                     | 32          |
| 3 <a href="#">Heaters: Aerospace</a>                             | 9         | 4                   | 1            |              |                       | 8           |
| 4 <a href="#">Heaters: Air</a>                                   | 264       | 91                  | 4            | 1            | 9                     | 125         |
| 5 <a href="#">Heaters: Air, High Temperature</a>                 | 15        | 5                   | 1            |              |                       | 11          |
| 6 <a href="#">Heaters: Aircraft</a>                              | 55        | 22                  | 1            |              | 3                     | 35          |
| 7 <a href="#">Heaters: Appliance</a>                             | 8         | 5                   |              |              |                       | 8           |
| 8 <a href="#">Heaters: Asphalt</a>                               | 78        | 25                  |              |              | 2                     | 43          |
| 9 <a href="#">Heaters: Automotive</a>                            | 56        | 11                  | 1            |              | 1                     | 22          |
| 10 <a href="#">Heaters: Automotive (Transportation Services)</a> | 4         | 2                   |              |              |                       | 4           |
| 11 <a href="#">Heaters: Band</a>                                 | 83        | 27                  | 3            |              | 3                     | 45          |
| 12 <a href="#">Heaters: Baseboard</a>                            | 29        | 7                   |              |              | 1                     | 11          |
| 13 <a href="#">Heaters: Baseboard</a>                            | 16        | 10                  |              |              | 1                     | 13          |

Double Click on the entry with the correct goods—here no. 1; then scroll down to the bottom of the next screen and enter the next set of goods.



Hit find it and you should find out if the goods are related or not.

**Step 6:** Again, this may or may not be necessary, depending on the goods.

- Look in the yellow pages—do the same stores sell these goods? Do the providers of the applicant’s services also provide the registrant’s services.
- Look in the circulars in news papers: keep a few of goods you find all the time—automotive stores and computer stores, for example.

### **B. The 2(e)(1) package.**

Here, again, keep in mind what you are trying to prove: essentially, the term(s) tell you something about the goods/services.

**Step 1:** The case law search should be the same as shown above. Substitute the 2(d) with 2(e)(1) and “confusion” with “describe” or “descriptive.”

Here is a list of some good 2(e)(1) cases which might be helpful on general principles. The list is posted on 114’s S-drive under case law.

## *SERVICES*

In re Disc Jockey Inc., 23 USPQ2d 1715 (TTAB 1992): DJDJ is descriptive of disc jockeying services despite the repetition of the initials.

In re Vehicle Information Network Inc., 32 USPQ2d 1542 (TTAB 1994): THE NATION'S LOCAL ELECTRONIC CLASSIFIEDS is descriptive of computer services in the nature of storage and retrieval relating to vehicles available for sale by dealers and private parties.

SiLite Inc. v. Creative Bath Products, Inc., DC NIII. 33 USPQ2d. 1308(1994) OPEN MRI is descriptive of magnetic resonance imaging services.

## *GOODS*

In re Women's Publishing Co. 23 USPQ2d 1876 (TTAB 1992) : DECORATING DIGEST is only descriptive and not generic of decorating magazines.

In re Waverly Inc. , 27 USPQ2d 1620 (TTAB 1993): MEDICINE is not generic but merely descriptive and may be registered on the Principal Register with the showing of 2(f)

In re Copytele, 31 USPQ2d 1540 (TTAB 1993): SCREEN FAX PHONE is descriptive of phone with fax capability. Used only dictionary definition.

In re Cryomedical Sciences Inc. 32 USPQ 1377 (TTAB 1994): SMARTPROBE is descriptive cryosurgical probes because consumers would know that the probes are equipped with microprocessors

In re Time Solutions, 33 USPQ2d 1156 (TTAB 1995) YOUR HEALTH INSURANCE MANAGER for software is descriptive.

Lewis Management Co. V. Corel Corp. 36 USPQ2d 1534 (DC SCalif 1995) CD CREATOR for computer program which collects information in a computer and put it on a CD.

**Step 2:** Use X-search 1.1 to find the disclaimers of the relevant terms in relation to the services. This type of evidence is generally weak, but can be used.

- The search tag is [ds] for disclaimer
- Don't forget to use Supplemental[rg] to show descriptiveness as well.
- Again, don't use anything but US registrations.

**Step 3:** Using Nexis to show the descriptive nature of the goods/services.

- Don't make the mistake of looking for all terms together. If you found the applicant's mark used as a unit, you might be looking at generic use. **Sometimes you need only to search "each element" of the mark in relation to the goods/services to show descriptiveness.**
- Begin with the descriptive term and the goods/services to see how it is descriptive, if necessary.
- Remember that descriptiveness requires a showing that the mark or the combination of the terms in the mark inform you about a feature, ingredient, or function of the goods. We are, essentially, looking for a sentence in Nexis that says XYZ goods features or function or has a specific ingredient.

Example: Screen wipes for a towel for cleaning the computers.

You should be thinking that the mark is descriptive because the goods "wipes the computer screen." The goods is used for that purpose.

Therefore, the search should not be "screen wipe" or "screenwipes." Rather it should be: ((towel! or paper or sheet) w/2 (wip!)) w/5 (screen or monitor or computer hardware or computer top)

- The general approach should be to determine how the term is descriptive and then add that element to the search. So if you are looking for a color, then add the word "color" to the search—[(blue w/5 (color or hue)) w/10 (applicant's goods)]; if you looking for a field that the applicant is teaching, then look for that element—e.g. ((IT or information technology) w/5 (field or discipline or course or seminar or symposium)). Add (teach! or instruct! or educat!) later if you have too many hits.

**Step 4:** Use the online resources for dictionary and related definitions. Here are a few good sites to book mark.

[www.tidalwave.net/~rsuss](http://www.tidalwave.net/~rsuss)

[www.onelook.com](http://www.onelook.com)

[www.mtds.com](http://www.mtds.com)

[www.acronymFinder.com](http://www.acronymFinder.com)

[www.techweb.com/encyclopedia/defineterm.cgi](http://www.techweb.com/encyclopedia/defineterm.cgi)

[www.microsoft.com/Windows/server/Overview/features/glossary.asp](http://www.microsoft.com/Windows/server/Overview/features/glossary.asp)

### **III. Additional Resources**

If you are stumped and need help, Conrad or I would be more than happy to assist. You'll find us on e-mail or in our respective offices.

