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

Proceeding	91170256
Party	Defendant GOOGLE INC. GOOGLE INC. 1600 Amphitheatre Parkway Building 41 Mountain View, CA 94043
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Attachments	Response to Motion for Judicial Notice.pdf (6 pages)(162093 bytes)

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

In the Matter of:

Application Serial No. 76314811
For the Mark: GOOGLE
Publication Date: November 1, 2005

Opposition No. 91170256

CENTRAL MFG. CO. (INC.),

Opposer,

v.

GOOGLE INC.,

Applicant.

**APPLICANT'S RESPONSE TO
OPPOSER'S "MOTION FOR
JUDICIAL NOTICE" DATED MAY
24, 2006 IN CONNECTION WITH
OPPOSER'S MOTION TO STRIKE
RE: APPLICANT'S REPLY PAPERS**

Commissioner of Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

Applicant Google Inc. ("Applicant") respectfully submits this response to Opposer's "Motion for Judicial Notice" dated May 24, 2006. Opposer's "Motion for Judicial Notice" was allegedly filed in support of Opposer's Motion to Strike (the "Opposer's Motion to Strike") the reply papers of Applicant on Applicant's Combined (1) Motion for Protective Order re: Opposer's Service and (2) Preliminary Response to Opposer's Motion to Consolidate (hereinafter, the "Applicant's Motion for Protective Order").¹ In support thereof, Applicant states as follows.

Not content with creating satellite motion practice through its serial motions to strike in disregard of TMBP § 516, Opposer piecemeals further by filing, as an after-thought, a purported "Motion for Judicial Notice" in alleged support of Opposer's Motion to Strike. The "Motion for Judicial Notice" merely repeats *verbatim* groundless arguments Opposer previously had made in the Motion to Strike and discusses and attaches a copy of a published TTAB decision, *In re Zanova, Inc.*, 59 U.S.P.Q.2d 1300 (T.T.A.B. 2001).

Opposer purports to seek "judicial notice" of a *published* TTAB disposition, which is not remotely necessary. Indeed, this point, along with the fact that the *Zanova* decision was readily available to Opposer at the time it filed its Motion to Strike, simply confirms that Opposer's belated "motion" is nothing more than an effort to harass through piecemeal motion practice and to circumvent the normal rules on briefing by filing what essentially is yet another improper sur-reply on Applicant's Motion for Protective Order. Opposer goes on to claim, without cogent explanation, that it "is also submitting the case *In Re Zanova, Inc.* for the proposition that the

¹ Applicant's Motion for Protective Order seeks an order from the Board requiring Opposer to file papers via ESTTA and to serve all further papers in this proceeding either by (a) obtaining a postmark from the U.S. Postal Service, or (b) using U.S. Postal Service Express Mail.

GOOGLE mark is generic and/or has become merely descriptive and hence unregistrable on the Principle Register. Under Section 2(e)(1)." Motion, at 2 (typographical errors in original). What this purported proposition has to do with the Motion to Strike Opposer does not explain, undoubtedly because Opposer knows that it is not relevant to any issue on that motion. More importantly, however, there is no merit to Opposer's blithe assumption that an issue such as the ultimate question of fact regarding the supposed *acquired* genericism of a mark -- which is the subject of a factually intensive analysis that largely focuses on the public's primary understanding of the term and an issue on which Opposer bears the burden of persuasion² -- is the proper subject of judicial notice on the terms set forth in the Motion for Judicial Notice. Fed. R. Evid. 201(b) ("A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."). Indeed, *Zanova* says nothing about the GOOGLE mark and certainly contains no "adjudicative facts" bearing on Applicant's GOOGLE mark involved in this proceeding. Fed. R. Evid. 201(a).

Opposer also misstates the legal analysis contained in *Zanova*. As the Board will recall, Opposer's Motion to Strike rested solely on Trademark Rule 2.142(d), which Opposer claimed somehow precludes the introduction of evidence in this inter partes proceeding on all reply briefs

² E.g., *Zimmerman v. National Association of Realtors*, 70 U.S.P.Q.2d 1425, 1429 (T.T.A.B. 2004) ("The critical issue (both before and after the 1984 Trademark Clarification Act) in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods in question."); see also *In re Recovery, Inc.*, 196 U.S.P.Q. 830, 831 (T.T.A.B. 1977) ("whether a word or notation is merely descriptive must be determined not in the abstract or on a guesswork basis but in relation to the goods or services for which registration is sought, the context in which it is used, and the impact that it is likely to make on the average purchaser of such goods or services.").

under all circumstances. As Applicant pointed out, and Opposer evidently concedes, that Rule -- entitled "Time and manner of *ex parte* appeals" -- has no application to this proceeding because the Rule applies by its term only to *ex parte* appeals from the "Examiner of Trademarks."³ *Zanova*, too, involved an *ex parte* appeal from an Examining Attorney's refusal to register, not the record on an *inter partes* proceeding. As that case and the face of Trademark Rule 2.142(d) reflect, the procedures for the introduction of evidence for the first time on an *ex parte* appeal are to define the proper scope of the evidentiary record for purposes of appeals and presumably to ensure that the Examining Attorney has had an opportunity to fully consider the evidence before the intervention of the Board. *Zanova*, 59 U.S.P.Q. 2d at 1302 ("Moreover, creation of the record to be considered *in an ex parte appeal* must, at some point, be concluded." (emphasis added));⁴ *see also* TBMP § 1207.01 (noting in discussing import of § 2.142(d) that "[a]dditional evidence filed after appeal normally will be given no consideration by the Board."). That rationale with respect to appellate records has no application to the consideration of evidence on Applicant's Motion for Protective Order in this *inter partes* proceeding. Opposer's belated

³ Trademark Rule 2.142(d) provides: "The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination."

⁴ The other reasons provided by *Zanova* in declining to remand to the Examining Attorney to consider the new evidence raised on appeal also make clear that the case does not assist Opposer here. In particular, the Board did not consider the evidence to be "probative" or justified in light of the fact that the applicant had had an opportunity to present it during examination. Neither does that reasoning apply to Applicant's Motion for Protective Order nor was the declaration submitted with Applicant's reply anything other than properly responsive to Opposer's arguments in opposing the motion. *See, e.g.*, Applicant's Opposition To Motion to Strike, filed May 20, 2006, at pages 2-3 (citing authorities).

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