

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/418266

MARK: THE LEADER IN USER G

77418266

CORRESPONDENT ADDRESS:

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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: CafePress.com, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

23626-033

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

Search Results:

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Section 2(e)(1) Refusal to Register:

Registration is refused because the applied-for mark merely describes a feature or characteristic of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Laudatory words or terms that attribute quality or excellence to goods and/or services are considered merely descriptive. TMEP §1209.03(k). Thus, laudatory terms, phrases and slogans are nondistinctive and unregistrable on the Principal Register without proof of acquired distinctiveness. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK a laudatory, descriptive phrase that touts the superiority of applicant's bicycle racks); *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA a laudatory, descriptive phrase for applicant's beer and ale); *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2006) (holding THE GREATEST BAR a laudatory, descriptive term for applicant's restaurant and bar since term

“greatest” immediately informs prospective purchaser that applicant’s establishment is superior in character or quality when compared to other restaurants and bars); *In re Dos Padres, Inc.*, 49 USPQ2d 1860 (TTAB 1998) (holding QUESO QUESADILLA SUPREME a laudatory, descriptive term for applicant’s cheese).

The applicant’s mark is THE LEADER IN USER GENERATED COMMERCE for, “Specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized materials, namely, clothing, headwear, footwear, beverageware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD-Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers, and posters; computerized online retail stores featuring clothing, headwear, footwear, beverageware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD-Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers and posters; management services, namely, online business development services; business consultation, namely retail and storefront development services; business management services; supplying and order fulfillment services and customer service in the field of specialty merchandising; and the dissemination of advertising for others via the internet” and “Manufacturing to the order and specification of others, namely, clothing, headwear, footwear, beverageware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers, and posters.”

LEADER is defined as, “a person or thing that is the most successful or advanced in a particular area” and is a laudatory term. USER is defined as, “One that uses: a user of public transportation.” GENERATE is defined as, “To bring into being; give rise to: generate a discussion.” COMMERCE is defined as, “The buying and selling of goods, especially on a large scale, as between cities or nations.” THE LEADER IN USER GENERATED COMMERCE is a laudatory slogan that merely describes the applicant’s services, specifically the applicant is the leader in providing services featuring user generated commerce. Please see the attached dictionary definitions. Further, please see a page attached from the applicant’s web site which further supports the examining attorney’s position that the wording THE LEADER IN USER GENERATED COMMERCE merely describes the applicant’s services.

Accordingly, because the applicant’s mark merely describes a feature or characteristic of the applicant’s services, registration is refused under Trademark Act Section 2(e)(1).

Supplemental Register:

Although an amendment to the Supplemental Register would normally be an appropriate response to this refusal, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76(b), (c) has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(e) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03.

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

Recitation of Services:

The identification of goods or services should set forth common names, using terminology that is generally understood. The identification of goods or services must be specific, definite, clear, accurate and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The wording “management services, namely, online business development services” in the identification of services is indefinite. See TMEP §1402.01. Specifically, please state, “Management services, namely, on-line business development services, namely, providing start-up support for businesses of others” if accurate.

The wording “supplying services” in the identification of services is indefinite. See TMEP §1402.01. Specifically, the wording is overly broad and includes services classified in various International Classes. For example, this wording includes, “Retail gasoline supply services” in International Class 035, “Gas supplying” in International Class 039” and “Supplying meals to the homeless or underprivileged” in International Class 043. Please identify the services by common commercial or generic name and classify appropriately.

Please see below for additional suggestions. Applicant may adopt the following identification, if accurate:

International Class 035:

Specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized materials, namely, clothing, headwear, footwear, beverage ware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD-Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers, and posters; computerized online retail stores featuring clothing, headwear, footwear, beverage ware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD-Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers and posters; management services, namely, online business development services, **namely providing start-up support for businesses of others**; business consultation, namely retail and storefront development services; business management services; supplying **services, namely, {please identify the service by common commercial or generic name, e.g., retail gasoline supply services}**; order fulfillment services and customer service in the field of specialty merchandising; and the dissemination of advertising for others via the internet.

International Class 040:

Manufacturing to the order and specification of others, namely, **manufacture of** clothing, headwear, footwear, beverage ware, aprons, petwear, magnets, buttons, messenger bags, computer peripherals, canvas bags, ornaments, calendars, toys, pillows, clocks, books, CD Roms, blank DVDs and compact discs, framed prints, greeting cards, journals, license plate frames, tile boxes, tile coasters, oval and round keepsakes, calendar prints, poster prints, postcards, stickers, and posters **to the order and specification of others**.

Although identifications of services may be amended to clarify or limit the services, adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

Please also note that parentheticals are not acceptable in the identification. Where indicated “**{please identify. . .}**,” the examining attorney has merely suggested ways to cure the indefiniteness of the identification. The applicant must list the goods/services without parentheses. In instances where the goods/services may be classified in several different classes, the applicant must list those goods/services separately according to class.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netah/html/tidm.html>. See TMEP §1402.04.

Request for Information:

To permit proper examination of the application, applicant must submit additional information about the services. See 37 C.F.R. §2.61(b); *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004); TMEP §814. The requested information should include fact sheets, brochures, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for services of the same type, explaining how its own services will differ. If the services feature new technology and no information regarding competing services is available, applicant must provide a detailed factual description of the services.

The submitted factual information must make clear what the services are and how they are rendered, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the services will not satisfy this requirement for information.

Failure to respond to a request for information is an additional ground for refusing registration. See *In re DTI P’ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003). Merely stating that information about the services is available on applicant’s website is an inappropriate response to a request for additional information and is insufficient to make the relevant information of record. See *In re Planalytics*, 70 USPQ2d at 1457-58.

Significance of Wording:

Applicant must specify whether the wording “USER GENERATED COMMERCE” has any significance in the applicant’s trade or industry or as applied to the goods/services described in the application. See 37 C.F.R. §2.61(b); TMEP §§808.01(c), 814.

Response Guidelines:

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title “Response to Office Action” and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant’s name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response should address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant can argue against the refusal; i.e., applicant can submit arguments and evidence as to why the refusal should be withdrawn and the mark should register. To respond to

requirements, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

The response must be personally signed or the electronic signature manually entered by applicant or someone with legal authority to bind applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Colleen Dombrow/
Trademark Attorney
Law Office 101
Direct Dial: (571) 272-8262
Facsimile: (571) 273-9101

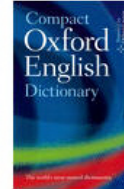
RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



Compact Oxford English Dictionary



leader

• **noun** **1** a person or thing that leads. **2** a person or thing that is the most successful or advanced in a particular area. **3** the principal player in a music group. **4** Brit. a leading article in a newspaper. **5** (also **Leader of the House**) Brit. a member of the government officially responsible for initiating business in Parliament. **6** a short strip of non-functioning material at each end of a reel of film or recording tape for connection to the spool.

— DERIVATIVES **leaderless** adjective **leadership** noun.

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