

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

In the matter of trademark application Serial No. 77/171330
For the mark SEO
Published in the Official Gazette March 25, 2008

JE Hochman & Associates LLC,)	
Opposer)	
)	
v.)	Opposition No. _____
)	
Jason Gambert,)	
Applicant)	

NOTICE OF OPPOSITION

JE Hochman & Associates LLC,
a Connecticut limited liability company
171 Still Road,
West Hartford, CT 06117

The above-identified Opposer believes that it will be damaged by registration of the mark shown in the above-identified application (the "Application"), and hereby opposes the same.

The Application seeks registration of the mark SEO for use with:
"marketing services in the field of computers in the nature of providing marketing services for the benefit of others by compiling advertising campaigns, promotional services, and consulting for customers" in Class 035.

2. The Application alleges Applicant's first use in commerce of the mark was February, 14, 2007.

3. The term, SEO, is an acronym for the phrase "Search Engine Optimization." SEO "is the process of improving the volume and quality of traffic to a web site from search engines via "natural" ("organic" or "algorithmic") search results for targeted keywords. . . . The initialism "SEO" can also refer to "search engine optimizers",

terms adopted by an industry of consultants who carry out optimization projects on behalf of clients.” Wikipedia, *Search engine optimization*, http://en.wikipedia.org/wiki/Search_engine_optimization (as of May. 13, 2008, 20:07 GMT). SEO involves various strategies for improving search engine results positioning. Such strategies commonly include the services described in the Application, including compiling advertising campaigns, promotional services, and consulting for customers.

4. The Opposer is an Internet marketing consultant and an SEO. Among other services it provides search engine optimization. It has used the term SEO to refer to such services since at least late 2004, long before Applicant’s first cited use.

5. The term, SEO, is a generic term for the identified services and is incapable of functioning as registrable trademark denoting source. Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). The term SEO is so “descriptive as to be incapable of acquiring distinctiveness as a trademark.” *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999). SEO is commonly understood to refer to marketing services of the type described in the application. The term SEO is thought to have been first used in connection with such services in 1997. Wikipedia, *Search engine optimization*, http://en.wikipedia.org/wiki/Search_engine_optimization (as of May. 13, 2008, 20:07 GMT). It is commonly used to refer to such services today. The primary significance of the term to the relevant public is to identify a type of Internet marketing services.

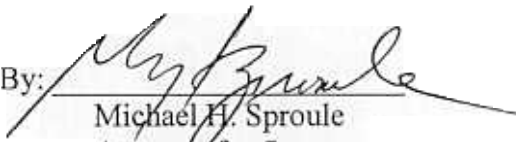
6. The term, SEO, is a merely descriptive in relation to the identified services. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818

(Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing). Further, “a mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services,” citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010; *In re Cox Enterprises Inc.*, 82 USPQ2d 1040 (TTAB 2007). The term, SEO, which stands for Search Engine Optimization, describes the services, or aspects of the services, offered by the applicant or at the least purpose and use of the services.

6. Because the Opposer is an SEO consultant who performs search engine optimization, its business and goodwill will be injured by Applicant’s registration of the term, SEO, for marketing services in the field of computing and any resulting limitations on Opposer’s ability to refer to its services by their commonly understood acronym, SEO.

WHEREFORE, Opposer prays that this Opposition be sustained and that the above-identified application be refused registration.

JE Hochman & Associates LLC

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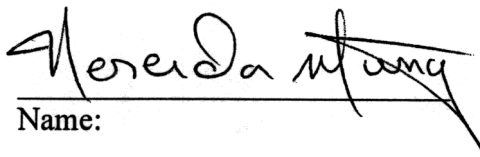
Dated: May 14, 2008

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

Jason Gambert
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on May 14, 2008.


Name: _____