

ESTTA Tracking number: **ESTTA203634**

Filing date: **04/09/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SEOMoz, Inc.		
Entity	C Corp	Citizenship	Delaware
Address	4314 Roosevelt Way NE Seattle, WA 98105 UNITED STATES		

Attorney information	Sarah L. Bird General Counsel for SEOMoz, Inc. 4314 Roosevelt Way NE Seattle, WA 98105 UNITED STATES sarah@seomoz.org Phone:206-632-3171		
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Applicant Information

Application No	77171330	Publication date	03/25/2008
Opposition Filing Date	04/09/2008	Opposition Period Ends	04/24/2008
Applicant	Jason Gambert 10001 Woodcreek Oaks Blvd. Suite 1627 Roseville, CA 95747 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2007/02/14 First Use In Commerce: 2007/02/14 All goods and services in the class are opposed, namely: 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
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
Dilution	Trademark Act section 43(c)
Genericness	Trademark Act section 23

Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	SEOMoz
Goods/Services	International Class 035. Goods and services for online advertising, promotions and marketing.

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SEO		
Goods/Services	International Class 035. Goods and services for online advertising, promotions and marketing.		

Attachments	Gambert NOO 04092008.pdf (11 pages)(2077943 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/SLB/
Name	Sarah L. Bird
Date	04/09/2008

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7 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
8 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
9

10 In re the Matter of:

11 **SERIAL NO. 77171330**
12 **FOR THE MARK "SEO"**
13 **PUBLISHED 3/25/2008**

OPPOSITION NO:

**NOTICE OF OPPOSITION TO
REGISTRATION**

14 SEOMOZ, INC., a Delaware Corporation

15 Opposer,

16 vs.

17 JAMES GAMBERT,

18 Applicant.
19
20

21 **Introduction**

22 Opposer SEOMoz, Inc., by and through its attorney, Sarah L. Bird, pursuant to
23 Trademark Rules 2.101, 2.104, 2.122(c)-(d); Fed. R. Civ. P. 7, 8-11; TBMP Chapter 300
24 (2d ed. rev. 2004) and other applicable authorities, files this Notice of Opposition
25 respectfully requesting that the Trademark Trial and Appeal Board sustain this
26 opposition and deny registration of the proposed mark, "SEO," with the serial number
27 77171330.
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30

NOTICE OF OPPOSITION

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1 The name "SEOMoz" and the proposed mark, "SEO," have been used in
2 commerce for marketing services since October 2003. SEOMoz has standing in this
3 matter because it has been using the term "SEO" for "marketing services in the field of
4 computers."¹ For example, SEOMoz uses the trade name "SEOMoz," distributes goods
5 with the "SEO" mark², utilizes the domain name SEOMoz.org, publishes "The Daily
6 SEO Blog," and compiles advertising campaigns, promotional services, and marketing
7 consulting for its customers. SEOMoz has used "SEO" to describe its marketing
8 services and goods since 2003. SEOMoz is one of the world's most trusted sites and
9 publishes one of the most widely read blogs relating to internet marketing. SEOMoz
10 would be harmed by the registration of "SEO" as a service mark for marketing goods
11 and services.
12
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15 **General Allegations**

16 1. James Gambert filed an application to register the mark "SEO" in May of 2007.
17 At that time he described his class of Goods and Services very broadly, spanning many
18 classes: "Search Engine Optimization, Hosting, Webdesign, Software, Hosting, Domain
19 Name, Software Development, All Computer Related Development and Marketing plus
20 what is listed; Computer Software, Computer Hardware, "SEO" Letters to be
21 trademarked in "All" Computer related areas."³ In his application, he indicates a first
22 use of February 14, 2007. He bases his application on his alleged current use in
23 commerce (1(a)) and not on intent to use (1(b)).
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28 ¹ Quoting Applicant's description of Goods and Services.

29 ² SEOMoz's "Beginners Guide to SEO" was published in December 2005 and has become a standard introduction to
30 SEO services and techniques in the industry. Since publication, it has been viewed over 200,000 times and has been
linked to by more than 7,500 websites.

³ Punctuation errors in original Application.

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1 2. In August 2007, the reviewing attorney correctly refused the application on the
2 grounds that "SEO" is (1) generic and (2) merely descriptive of the Applicant's services.
3 The reviewing attorney cited multiple examples of "SEO" being used in relation to
4 computers and Search Engine Optimization.
5

6 3. Between September 2007 and January 2008, Gambert used select, unreliable
7 internet sources to persuade the reviewing attorney that "SEO" is commonly used to
8 describe the "process" of search engine optimization and *not* marketing services. He
9 also amended his application to remove all traces of search engine optimization
10 services. Gambert also greatly generalized the description of his goods and services as
11 "Marketing services in the field of computers in the nature of providing marketing
12 services [sic] for the benefit of others by compiling advertising campaigns, promotional
13 services, and consulting for its customers." He is currently filing under International
14 Class 35.
15
16

17 4. The reviewing attorney approved the application for publication in January
18 2008. Publication began on March 25, 2008.
19

20 5. A search for Gambert's website reveals that as of April 8, 2008 he is not using
21 "SEO" anywhere on his site (www.modernconsultingsolutions.com). See Attachment A.
22 However, he does claim to offer search engine optimization services. See Attachment B.
23 Ultimately, however, there is no proof, (other than the alleged specimen submitted by
24 Gambert), that he uses "SEO" in commerce now or in the past. In fact, a comparison of
25 the alleged specimen submitted by Gambert and the screen shot of his website in
26 Attachment A suggests that Gambert created a phony specimen to submit to the
27
28
29

30 ⁴The attorney had other serious concerns with the application, but they are not germane to this Notice of Opposition.

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1 reviewing attorney by replacing the letters "MCS" with "SEO." SEOMoz alleges the
2 submitted specimen was never used in commerce.

3
4 6. The term "SEO" is a generic term that has been in wide circulation for almost
5 two decades. Further, contrary to the Applicant's representation, it is not merely a
6 process; it is a service. The Applicant also wrongfully represented to the reviewing
7 attorney that "SEO" is merely a technical process involving only the manipulation of
8 keywords. In fact, it is broadly understood and acknowledged that SEO involves much
9 more than manipulating keywords.
10

11 7. SEO involves creating interesting content in the form of articles, blogs and
12 press releases, finding and utilizing link directories, reviewing the structure of a
13 website, and reviewing the code that allows search engines to index the website.⁵
14 Discovering useful keywords and phrases is only one aspect of a much more involved
15 service. The fact that internet marketers are paid out of their clients' marketing
16 budgets, and not the clients' technology budgets, further demonstrates that SEO is
17 widely understood to be a marketing service.
18
19

20 8. SEO is a common and essential marketing strategy. It overlaps with traditional
21 television, radio, and other print marketing campaigns. The Applicant's description of
22 "marketing services in the field of computers in the nature of providing marketing
23 services for the benefit of others by compiling advertising campaigns, promotional
24 services, and consulting for its customers" is broad enough to include SEO marketing
25
26
27

28
29 ⁵ See Google's definition of "SEO" at
30 <http://www.google.com/support/webmasters/bin/answer.py?hl=en&answer=35291>: "SEO is an abbreviation for
"search engine optimizer." Many SEOs and other agencies and consultants provide useful services for website
owners, from writing copy to giving advice on site architecture and helping to find relevant directories to which a site
can be submitted." Last visited on April 8, 2008.

1 strategies. In fact, the Applicant offers search engine optimization services on his
2 website. See Attachment B.

3
4 9. As the reviewing attorney noted in her response to the Applicant, a Google
5 search for "SEO computers" returns a results page with over 900,000 stories. Even
6 more important for purposes of the challenged application, a Google search for "SEO
7 marketing" returns a results page with over 3 million articles. A Google search for "SEO
8 Marketing Services" returns a results page with over 900,000 articles. This
9 demonstrates that "SEO" is broadly and widely understood to identify a kind of
10 marketing service, and not the *source* of a service.

11
12 10. Further, individuals and businesses have been providing marketing services
13 that include SEO since the early 1990s. Even if the mark "SEO" was not generic or
14 merely descriptive, the registration would be barred by prior use because thousands of
15 entities that have been using SEO in the context of marketing and computers well
16 before February 2007. In fact, SEOMoz, has been using its trade name since 2003 and
17 has been providing marketing services in the field of computers under the "SEO" mark
18 since that time.

19
20 11. If this mark were granted, thousands of internet marketers would have to
21 change the way they describe and talk about their services. Further, consumers would
22 be confused about the source of marketing services because of the widespread, generic
23 use of the proposed "SEO" mark.

24 25 26 Grounds for Opposition

27 **A. The Proposed Mark Is Merely Descriptive.**

28 12. Registration should be denied because the proposed mark merely describes a
29 feature or characteristic of Applicant's services. Trademark Act Section 2(e)(1), 15 USC
30

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1 §1052(e)(1); TMEP §§1209 *et seq.* A mark is merely descriptive under Trademark Act
2 Section 2(e)(1), 15 USC §§1052(e)(1), if it describes an ingredient, quality,
3 characteristic, function, feature, purpose or use of the relevant goods and/or services.
4
5 *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast*
6 *Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re Met Path Inc.*, 223 USPQ
7 88 (TTAB 1984); TMEP §1209.1(b). For purposes of Section (2)(e)(1) analysis, a term
8 need not describe all of the purposes, functions, characteristics or features of the goods
9 and/or services to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d
10 1341, 1346, 57 USPQ2d 1807 (Fed. Cir. 2001). It is enough if the term describes only
11 one significant function, attribute or property. *In re Oppedeahl & Larson LLP*, 373 F.3d
12 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“[A] mark may be merely
13 descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s
14 goods or services.”) (quoting *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346,
15 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

16
17
18 13. The Applicant claims to be providing “marketing services in the field of
19 computers” under International Class 35. He also offers search engine optimization
20 services on his website. See Attachment B. SEO or search engine optimization is a
21 “marketing service.” It is a generic and highly descriptive term. The Applicant is using
22 the generic term SEO in its commonly understood sense to describe marketing
23 services.
24
25

26 14. Even if the Applicant’s services extended beyond the broad range of services
27 encompassed by the term “SEO,” the mark is still merely descriptive because it
28 describes a significant aspect of his services. See, e.g., *In re Dial-a-Mattress Operating*
29 *Corp.*, 240 F.3d at 1346, 57 USPQ2d 1807.
30

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1 15. If the Applicant were permitted to register the mark "SEO," Applicant would
2 obtain at least a *prima facie* right to exclusive use of the term, and the Opposer, its
3 affiliates, and licensees could be deprived of their lawful rights to continue to use the
4 term. Therefore, the granting of a certificate of registration to Applicant would injure
5 the Opposer.
6

7 **B. The Applicant Is Not Using the Mark In Commerce.**
8

9 16. Upon information and belief, the Applicant is not using "SEO" to identify his
10 marketing services. The alleged specimen does not indicate a date or use in commerce.
11 Further, the Applicant's website (www.modernconsultingsolutions.com) does not
12 contain the mark "SEO" anywhere.⁶ See for example, Attachment A.
13

14 17. Because the Applicant based his application on current use in commerce (1(a))
15 and not on intent-to-use (1(b)), his application must be should be denied.
16

17 **C. The Proposed Mark is Deceptively Descriptive**
18

19 18. The reviewing attorney informed the Applicant that his application was refused
20 because "SEO" is a generic term for search engine optimization and the Applicant listed
21 "search engine optimization" in his initial description of "goods and services." The
22 Applicant then attempted to obfuscate the United States Patent & Trademark Office
23 and circumvent the letter and spirit of trademark law by claiming that "SEO" stands for
24 "Systems Efficient Optimization" and that he was providing "marketing services in the
25 field of computers." He goes out of his way to distance himself from search engine
26 optimization by presenting a nonsensical argument that SEO is a process and never a
27 service.
28

29 _____
30 ⁶ Although the site doesn't include "SEO," it creates a likelihood of confusion by offering search
engine optimization services. See Attachment B.

1 19. Representing to the United States Patent & Trademark Office and to potential
2 consumers that "SEO" means something other than search engine optimization for
3 provision of "marketing services in the field of computers" is deceptive. He deceives the
4 USPTO and potential consumers that his services are somehow different from those
5 marketing services provided by marketers who provide SEO services. *If* the Applicant is
6 not providing SEO services, then he is deceiving consumers. Consumers have the right
7 to expect that an entity identifying itself as an "SEO" and claiming to provide
8 "marketing services in the field of computers" provides search engine optimization
9 services. Thus, if he is not performing SEO services, his use of the proposed mark is
10 deceptively descriptive by mislabeling his marketing services.
11
12

13 **D. Alternatively, If the Mark is Appropriate for Registration, then SEOMoz**
14 **Has Priority and there is a Likelihood of Confusion.**
15

16 20. First, it is SEOMoz's position that the term "SEO" when applied to marketing
17 services is generic and merely descriptive. However, in the event that the Trademark
18 Trial and Appeal Board finds that the mark is sufficiently distinctive, then SEOMoz
19 maintains that prior use, likelihood of confusion, and dilution should bar registration.
20

21 21. SEOMoz, for example, has been using the mark "SEO" and the trade name
22 SEOMoz (where the "s" "e" and "o" are capitalized) since 2003 to provide marketing
23 services in the field of computers. SEOMoz also uses the proposed mark, "SEO" to
24 describe its vast marketing services, blogs, tools, guides and other goods. SEOMoz
25 therefore has common law rights to "SEOMoz" and "SEO." Further, SEOMoz's use is
26 well before the "first use" stated in the Applicant's registration, February 2007. Thus,
27 there is a likelihood of confusion under Trademark Act (sometimes referred to as "The
28 Lanham Act") Section 2(d) between applicant's mark and SEOMoz's marks.
29
30

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1 22. Allowing a marketer "in the field of computers" to register the service mark for
2 SEO would harm SEOMoz's common law mark because it also provides marketing
3 services. The similarity in the names would result in customer confusion and dilution.
4

5
6 WHEREFORE, Opposer believes that it will be damaged by Applicant's registration
7 of the mark "SEO" and requests that the opposition be sustained and said registration
8 be denied.
9

10 Please recognize as attorney for Opposer in this proceeding Sarah L. Bird, a
11 member of the Washington State bar. Please address all communications to Sarah L.
12 Bird at the address listed below.

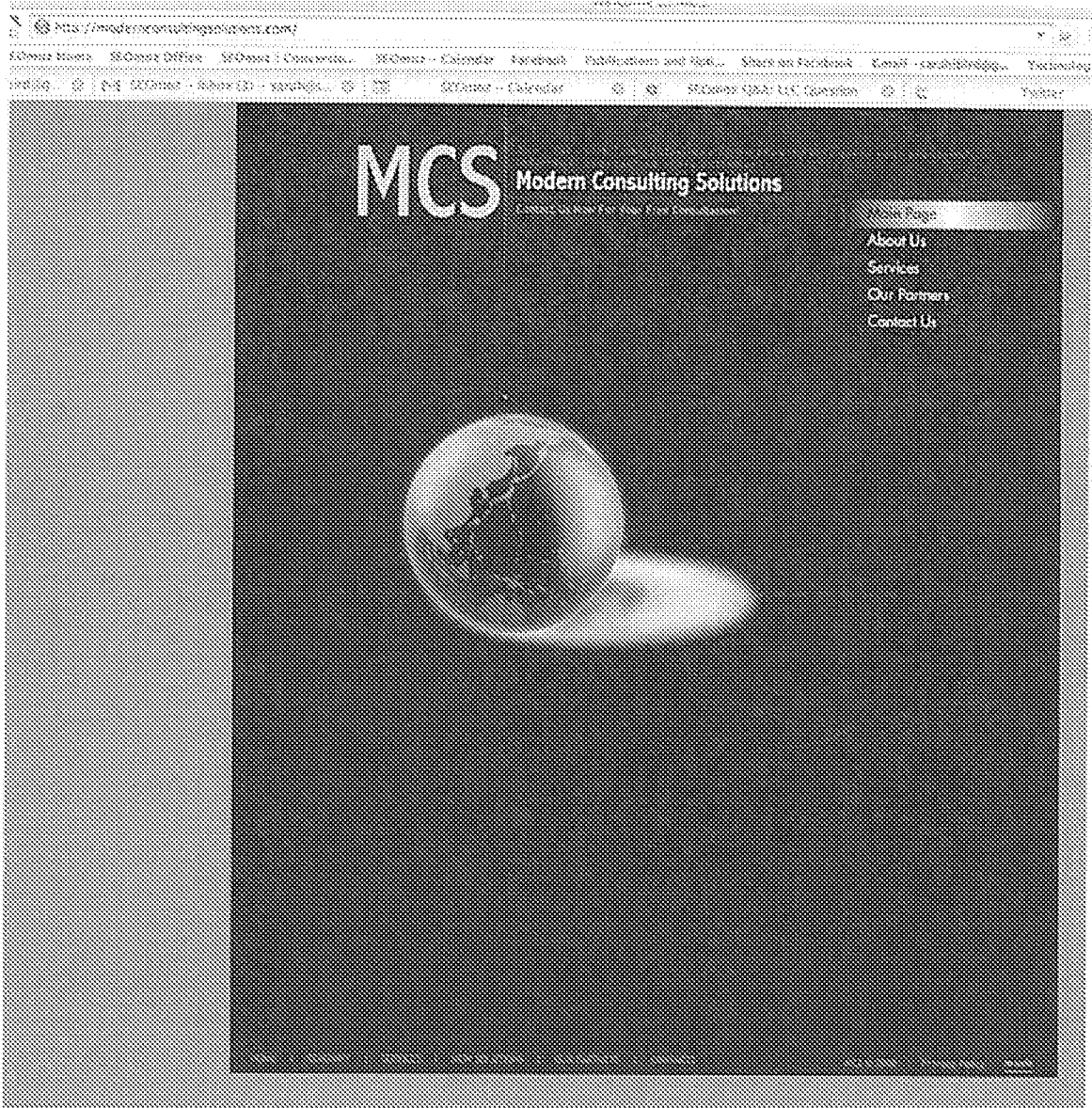
13 Respectfully submitted this 8th day of April, 2008 in Seattle, Washington.
14

15
16
17 BY: 

18 Sarah L. Bird, WSBA #36883
19 Attorney for Opposer SEOMoz, Inc.
20 4314 Roosevelt Way, NE
21 Seattle, WA 98105
22 206-632-3171
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27
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Attachment A To SEOMoz's Notice of Opposition

Screen Shot of www.modernconsultingsolutions.com Taken April 8, 2008



Attachment B SEOMoz's Notice of Opposition

Screen Shot of www.modernconsultingsolutions.com
Taken April 8, 2008

