

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 17, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Discuss.io Inc.

Reexamination No. 2023-100526R for Registration No. 6729238

Thomas E. Zutic and Alberto Zacapa of DLA Piper LLP (US)
for Discuss.io Inc.

Renee Servance, Staff Attorney, Law Office 800,
Montia Pressey, Director for Trademark Register Protection.

Before English, Cohen, and Lavache,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Discuss.io Inc. (“Registrant”) appeals the Director of the United States Patent and Trademark Office’s (“USPTO” or “Office”) final decision,¹ on petition for reexamination, finding that Registration No. 6729238 should be cancelled under Section 16B of the Trademark Act, 15 U.S.C. § 1066b(b), because Registrant failed

¹ The Director’s authority to make determinations and issue notices and decisions related to this matter was delegated to the assigned Examiner pursuant to 35 U.S.C. § 3(a)-(b). We use the term “Examiner” because the Trademark Modernization Act contemplates “the examiner’s decision,” *see* Trademark Act Section 16B(g), 15 U.S.C. § 1066b(g).

to demonstrate use in commerce of the standard-character mark DISCUSS.IO (the “Registered Mark”) for the services listed below as of May 12, 2021, the filing date of the underlying use-based application (the “Application Date”):²

Streaming of audio, visual and audiovisual material via a global computer network; Wireless electronic transmission of data and images by video broadcasting of market research interviews, in International Class 38; and

Providing temporary use of a web-based software application for conducting and analyzing market research; Providing temporary use of a web-based software application for use in data collection and data management in the field of market research; Software as a service (SAAS) services featuring software for the collection, storage, organization, management, searching, manipulation and analysis of data in the fields of marketing, marketing research, and focus groups; Software as a service (SAAS) services featuring software for management of marketing and market research projects, in International Class 42.

Both Registrant and the Examiner filed briefs.³ We affirm the Examiner’s finding that Registrant failed to demonstrate use of the Registered Mark for each class of services.

I. Preliminary Matter

Registrant attached new evidence to its brief consisting of invoices.⁴

Registrant acknowledges that the record should be complete prior to the filing of an appeal in an Expungement or Reexamination Proceeding and

² Registration No. 6729238 issued on May 24, 2022 from a use-based application filed May 12, 2021, claiming January 5, 2012 as the date of first use and first use in commerce for the services in International Classes 38 and 42.

The registration also covered goods in Class 9, but Registrant deleted these goods during reexamination, as permitted under Trademark Rule 2.93(b)(6)(ii), 37 C.F.R. § 2.93(b)(6)(ii), rendering the reexamination moot as to this class. Trademark Rules 2.93(d)(3), 37 C.F.R. § 2.93(d)(3).

³ Registrant’s appeal brief is at 6 TTABVUE. The Examiner’s brief is at 8 TTABVUE.

⁴ Appeal Brief, 6 TTABVUE 7-22.

no additional evidence may be included once an appeal is filed. TBMP § 1305. However, Registrant is enclosing a Supplemental Communication which contains a Declaration from an officer for Registrant. Registrant respectfully requests that the Supplemental Communication be considered, arguing that there is good cause for allowing the introduction and such evidence is critical to demonstrating that services were rendered to costumers [sic] under Registrant's Mark as of the Relevant Date.

The Examiner objects to the invoices as "untimely."⁵

Trademark Rule 2.142(d)(2) provides that "[i]n an appeal from an expungement or reexamination proceeding, no additional evidence may be included once an appeal is filed, and the Board may not remand for further examination." 37 C.F.R. § 2.142(d)(2). We have no discretion to consider Registrant's untimely evidence submitted with its appeal brief. Nor may we remand the registration to allow Registrant to introduce the evidence. We therefore give no further consideration to the invoices attached to Registrant's brief.

II. Background

On July 14, 2023, a third party filed a petition for reexamination arguing that Registrant's Mark was not in bona fide use in commerce for any of the goods in Class 9 or services in Classes 38 and 42 as of the Application Date. In support of the petition, the petitioner, among other things, pointed out that during prosecution of the underlying application, Applicant did not file an acceptable specimen of use for the Class 38 services.⁶

⁵ Examiner's Brief, 8 TTABVUE 2.

⁶ January 26, 2022 Office Action, TSDR 2-4; January 27, 2022 Trademark Snap Shot Publication Style Sheet.

On November 30, 2023, the Examiner issued a Combined Notice of Institution and Non-Final Office Action (“Non-Final Office Action”) finding that “the petition and accompanying evidence set forth a prima facie case that the mark was not in use in commerce as of the relevant date with any of the goods and/or services listed in the registration.”⁷ As noted, Registrant responded by deleting the Class 9 goods from the registration⁸ and introducing evidence of purported use in commerce of the Registered Mark for the Class 38 and 42 services.

III. Analysis

A. Applicable Law

Reexamination is an ex parte proceeding created by the Trademark Modernization Act of 2020. *In re Everwise Credit Union*, No. 2023-10053R for Reg. No. 7068783, 2026 WL 1920599, at *2 (TTAB 2026) (citing Trademark Act Section 16B, 15 U.S.C. § 1066b, and Trademark Rules 2.91-2.94, 37 C.F.R. §§ 2.91-2.94). The issue in this reexamination proceeding is whether Registrant was using the Registered Mark in commerce for the identified services in Classes 38 and 42 as of the Application Date. Section 16B(g) of the Trademark Act, 15 U.S.C § 1066b(g); Trademark Rule 2.91(a)(2), 37 C.F.R. § 2.91(a)(2).

A mark is in use in commerce for services when it:

is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

⁷ November 30, 2023 Non-Final Office Action, TSDR 1-2.

⁸ See n.2 above.

15 U.S.C. § 1127.

B. Registrant's Argument that the Law on Reexamination is Unclear

Before turning to the evidence, we address Registrant's argument that it was "unclear" that it needed to prove that it was rendering the registered services in connection with the Registered Mark as of the Application Date.⁹ Specifically, Registrant contends:

It was only after the [Examiner] denied Registrant's Request for Reconsideration that Registrant's counsel was advised by the [Examiner] in a telephone conversation that invoices and other documentary evidence that showed that the 'services were actually rendered' would be needed to avoid cancellation of Registrant's Mark. ... This type ... of evidence is not required anywhere in the [Trademark Manual of Examining Procedure (TMEP)], in any of the notices served on Registrant, and is not an ordinary requirement. In fact, invoices usually are not acceptable evidence of use in commerce unless they create "a direct association between the mark and the services."¹⁰

The record contradicts Registrant's assertions. In the November 30, 2023 Non-Final Office Action, under the heading "Acceptable Evidence of Use of the Mark in Commerce," the Examiner expressly advised Registrant that

[E]vidence consisting of advertising for the goods will not rebut the prima facie case. Use in commerce requires both use of the mark on or in connection with the goods and/or services, and, in the case of goods, transporting or selling the goods in commerce, or in the case of services, rendering, i.e., performing, the services in commerce. Therefore, the documentary evidence must show both use of the mark on or in connection with the goods and/or services and that the goods were sold or transported and/or that the services were rendered as of the relevant date. See 15 U.S.C. §1127; 37 C.F.R. §2.93(b)(7).¹¹

⁹ Appeal Brief, 6 TTABVue 5.

¹⁰ *Id.*

¹¹ November 30, 2023 Non-Final Office Action, TSDR 3.

In the March 5, 2025 Final Office Action, the Examiner reemphasized the requirement that Registrant prove it rendered the registered services as of the Application Date.¹² The fact that the Examiner didn't specifically suggest that Registrant introduce invoices is immaterial; the Examiner put Registrant on clear notice of what it was required to prove.

The applicable legal authority also clearly sets out what a registrant must establish in a reexamination proceeding to overcome a prima facie case of nonuse. Section 16B of the Trademark Act expressly provides:

A registrant's documentary evidence of use shall be consistent with when a mark shall be deemed to be in use in commerce under the definition of "use in commerce" in section 1127 of this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.

As noted above, Section 45 of the Trademark Act in turn provides two requirements for establishing that a mark is in use in commerce for services: (1) the mark must be used or displayed in the sale or advertising of services; and (2) the services must be rendered in commerce. 15 U.S.C. § 1127. It is therefore clear from the relevant statutory provisions that a Registrant involved in a reexamination proceeding must demonstrate **both** use of its mark in the sale or advertising of the identified services **and** that the services were rendered in commerce as of the relevant date. *Couture v.*

¹² March 5, 2025 Final Office Action, TSDR 3 (see heading "No Evidence of Actual Sales of Goods or Rendering of the Services"); *see also* August 4, 2025 Denial of Request for Reconsideration, TSDR 2 ("None of the evidence in the Request for Reconsideration establishes actual sales or rendering of the services as of the relevant date. Additionally, some recited services are not shown in any of the evidence of record. As such, the evidence fails to rebut the prima facie case of nonuse.").

Playdom, Inc., 779 F.3d 1379, 1381 (Fed. Cir. 2015) (“On its face, the statute is clear that a mark for services is used in commerce only when both [1] ‘it is used or displayed in the sale or advertising of services and [2] the services are rendered....’”).

Trademark Rule 2.93, 37 C.F.R. § 2.93, and Section 1716.04(c) of the TMEP reiterate that “evidence of use” in a reexamination proceeding “must be consistent with the definition of ‘use in commerce’ set forth in section 45 of the Act.” Providing further guidance, Section 1716.04 of the TMEP refers registrants to Sections 901-903 of the TMEP “regarding use in commerce” as well as “relevant case law” pertaining to “use in commerce.”

Sections 901 and 903 of the TMEP yet again repeat the requirement that services must be “rendered” in commerce to satisfy the “use in commerce” requirement. Relevant case law also makes clear that the rendering of services is required to establish “use in commerce.” *See, e.g., Couture v. Playdom*, 779 F.3d at 1381 (holding that offering of a service, without the actual provision of a service, is insufficient to constitute use in commerce).

In sum, the guidance provided during reexamination, the relevant statutory provisions, the applicable Trademark Rules, the TMEP and the relevant case law, are unambiguous. Registrant was on notice that it needed to introduce evidence to support not only that it promoted the identified in services in connection with the Registered Mark but that it also rendered the registered services as of the

Application Date. Registrant's argument to the contrary is without merit.¹³

C. Registrant's Evidence of Use

The Examiner does not dispute that Registrant was advertising its Class 38 and 42 services in connection with the Registered Mark as of the Application Date.¹⁴ The issue in this appeal is whether Registrant was rendering the services – not just promoting them – as of the use-based Application Date.

For ease of reference, we set forth below the registered services:

Class 38 Services: Streaming of audio, visual and audiovisual material via a global computer network; Wireless electronic transmission of data and images by video broadcasting of market research interviews.

Class 42: Providing temporary use of a web-based software application for conducting and analyzing market research; Providing temporary use of a web-based software application for use in data collection and data management in the field of market research; Software as a service (SAAS) services featuring software for the collection, storage, organization, management, searching, manipulation and analysis of data in the fields of marketing, marketing research, and focus groups; Software as a service (SAAS) services featuring software for management of marketing and market research projects.

To support that it was using the Registered Mark in commerce for the identified services, Registrant introduced:

¹³ Registrant's argument also is belied by its Request for Reconsideration in which it states that it is introducing additional evidence to show that the services in Classes 38 and 42 "were rendered on or before" the Application Date. June 5, 2025 Request for Reconsideration, TSDR 10-11.

¹⁴ Examiner's Brief, 8 TTABVue 5 ("Registrant's evidence shows promotion of the services but there is no documentary evidence that supports that sales of the services were ever made.").

(1) promotional materials consisting of a sales deck and other advertisements.¹⁵

(2) consumer reference guides.¹⁶

(3) articles:

- Undated article titled *Discuss.io Wins 'Best Video Hosting Solution' in 2020 MarTech Breakthrough Awards*;¹⁷
- a June 15, 2020 article published by diginomica, titled *Discuss.io CEO Simon Glass on How Covid-19 has Expanded the Demand for 'Smart' Video Conferencing Platforms*;¹⁸ and
- a January 14, 2020 article titled *Discuss.io Launches Respondent Management Hub to Take Friction (and Spreadsheets) out of Online Qualitative Research*.¹⁹

(4) “[a]rchived internet screenshots from the Internet Archive Wayback Machine dated March 18, 2016.”²⁰

Registrant does not argue, and we do not find, that the promotional materials or reference guides prove that it was rendering the Class 38 and 42 services as of the

¹⁵ February 23, 2024 Office Action Response, TSDR 23-54, 65-108 (Exhibits C, D, E, H, I, J, and K). Registrant identified Exhibits C, D and E as showing use of the registered mark for the Class 38 services and Exhibits H, I and J as evidence of use for the Class 42 services.

¹⁶ February 23, 2024 Office Action Response, TSDR 13-22, 58-64 (Exhibits A, B, and G). Registrant identified Exhibits A and B as evidence of use for the since-deleted Class 9 goods and identified Exhibit G as evidence of use for the Class 42 services.

¹⁷ February 23, 2024 Office Action Response, TSDR 55-57 (Exhibit F); June 5, 2025 Request for Reconsideration, TSDR 125-27 (Index B). Registrant introduced this article to demonstrate use of its mark for the Class 38 services. Registrant also introduced a screenshot listing 2020 Award Winners, Martechbreakthrough.com/2020-winners. June 5, 2025 Request for Reconsideration, TSDR 133-36 (Index E).

¹⁸ June 5, 2025 Request for Reconsideration, 128-32 (Indexes C and D). Registrant introduced this article to demonstrate use of its mark for the Class 38 services.

¹⁹ February 23, 2024 Office Action Response, TSDR 109-11 (Exhibit L). Registrant identified Exhibit L as evidence of use for the Class 42 services.

²⁰ Appeal Brief, 6 TTABVUE 4 (citing Index F, June 5, 2025 Request for Reconsideration, TSDR 140-44).

Application Date, as opposed to merely promoting the services or preparing to offer them.

Turning to the articles, even if we were to treat the contents as true, this evidence is, at best, indirect evidence requiring us to infer that Registrant was rendering its services as of the Application Date. The purpose of a reexamination proceeding is to ascertain whether a mark was actually in “use in commerce” as of the relevant date, and thus, whether the registration was properly granted. We find that the type of indirect evidence Registrant has offered is insufficient to overcome the Director’s finding of a *prima facie* case of nonuse.²¹ It is notable that Registrant did not introduce any direct evidence consisting of a declaration from someone with firsthand knowledge attesting to when Registrant began rendering its services and other pertinent information such as its number of customers or user agreements. As the Examiner points out, such evidence is important to demonstrate that any use in commerce was “bona fide” and not made merely to reserve a right in the mark. 15 U.S.C. § 1127 (“‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”); *In re Everwise Credit Union*, 2026 WL 1920599, at *11-12 (addressing requirement that use must be bona fide).

As to the last piece of evidence, even if we were to accept that the Wayback

²¹ To the extent the articles include a screenshot showing a computer screen bearing the Registered Mark, we note that this screenshot is used repeatedly in Registrant’s marketing materials. It appears to reflect a stock promotional image. There is no basis for us to find that the screenshot shows the mark as displayed in rendering any services to actual customers.

printout accurately reflects how Registrant's website appeared on March 18, 2016, that is more than five years before the Application Date. Because the evidence is not reasonably contemporaneous with the filing date of the application, we find that it does not overcome the prima facie case of nonuse for the registered services as of the Application Date.²²

IV. Conclusion

Registrant's evidence fails to demonstrate use in commerce of the Registered Mark for the Class 38 and 42 services as of the Application Date.

Decision: We affirm the Director's decision on petition for reexamination finding that Registrant failed to demonstrate use of the Registered Mark for each class of services. Registrant's Registration No. 6729238 for the Registered Mark DISCUSS.IO will be cancelled in its entirety in due course under Section 16B(g) of the Trademark Act, 15 U.S.C. § 1066b(g).

²² We further note that we cannot confirm from the screenshot whether consumers were able to and did login to the website.