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Oral Hearing:
February 7, 2008

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Digital Oilfield Inc.

Serial No. 76127133

Thomas J. Moore of Bacon & Thomas, PLLC for Digital Oilfield Inc.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hairston, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Digital Oilfield Inc. seeks to register on the Supplemental Register the mark DIGITAL OILFIELD in standard character form for the following goods and services:

computer software for business to business e-commerce services in the international oil and gas industry, namely, software used to facilitate the receipt, coding and authorization of invoices; computer software for business to business e-commerce services in the international oil and gas industry; namely; software for workflow coordination and automation, including planning,

scheduling, procuring and coordination of tasks;
computer software for business to business
e-commerce services in the international oil and
gas industry, namely, software that automates
financial, operational and business workflow
processes in Class 9;

licensing of computer software for use in business
to business electronic commerce in the field of oil
and gas exploration in Class 35;

provision of a site on the global computer network
offering business to business e-commerce services
to the international oil and gas industry; namely,
inter-business communication, namely, electronic
transmission of data and documents among users of
computers; electronic data transmission for
business to business communication services,
business to business collaboration services and
business to business e-commerce services by way of
a global computer information network and internet
site in Class 38;

computer services, namely, creating indexes of
information on networks for automated financial,
operational and business workflow services in
business to business electronic commerce in the oil
and gas industry in Class 42; and

provision of a site on the global computer network
offering business to business e-commerce services
to the international oil and gas industry, namely,
providing user authentication services in
e-commerce transactions in Class 45.¹

Registration has been finally refused pursuant to
Section 23 of the Trademark Act, 15 U.S.C. §1091(c), on the

¹ Application Serial No. 76127133, filed September 14, 2000, asserting a bona fide intent to use the mark in commerce, and a claim of priority of March 24, 2000 under Section 44(d) of the Trademark Act, based on Canadian Application No. 1052163. The Canadian application subsequently issued on March 27, 2003, and applicant has claimed Section 44(e) of the Act as the basis for registration. Office records show that the Section 44(e) basis has been accepted.

ground that the term is generic for applicant's identified goods and services, and therefore incapable of distinguishing such goods and services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, and an oral hearing was held.²

Examining Attorney's Argument and Evidence

The examining attorney's argument that DIGITAL OILFIELD is generic in connection with applicant's identified goods and services is set forth below:

The evidence of record as a whole directly supports the refusal to register on the Supplemental Register on the grounds [sic] that the proposed mark DIGITAL OILFIELD is generic for Applicant's computer software and services because it shows that there is an entire industry that refers to its business as the digital oilfield industry. This evidence shows that the wording "digital oilfield" is used by this industry to identify and refer to an entire panoply of goods and services, particularly those offered on a business-to-business basis. Further, the evidence shows that the oil industry uses the wording "digital oilfield" as an umbrella term for all of the electronic or "digital" goods and services that constitute the business of digital oilfields throughout the world today. Accordingly, the present record supports that there is a need to preserve the wording "digital oilfield" for use by a particular industry, its purchasing public, its customers and its consumers.
(Brief at 2-3).

² The application was assigned to examining attorney Dominic J. Ferraiuolo to prepare the appeal brief and represent the Office at the oral hearing. A different examining attorney handled the case during prosecution.

The examining attorney submitted approximately twenty excerpted articles from the Nexis database to show generic use of the term "digital oilfield/oil field." Several representative examples are set forth below:

Headline: Joining Forces To Address Needs of Oil and Gas Companies

IVN members will collaborate to deliver solutions and integration scenarios to address industry-specific pain points including the need to maintain assets and secure or grow reserves to meet the world's increasing demand for energy. Oil and gas companies are faced with addressing these fundamental challenges as their business environment becomes increasingly complex and changes rapidly due to growing geopolitical uncertainty, limited access to new resources, globalization and the changing influence of national oil companies. To help accelerate development of software innovations necessary for this industry to address such challenges, members of the IVN for oil and gas are initially collaborating on the focus topics of the **digital oil field** and the hydrocarbon supply chain. For these focus topics, the IVN members are working together to deliver solutions for integrated exploration and production, land lease management, real-time gas allocation management, asset life-cycle management, secondary distribution and terminal management, commodity trading, and price optimization and margin management.

Financial Wire, January 30, 2007;

"The development of the Verari Systems E&P 7500 server and our latest relationship with Landmark create a powerful and cost-effective solution for oil and gas companies that are managing and operating **digital oil fields**," said David B. Wright, CEO, Verari Systems. We are excited to bring to market the worlds [sic] most scalable, industry-standards-based visualization solutions specifically designed to support the compute-intensive [sic] oil and gas industry and to meet

its operating needs. Landmark, a brand of Halliburton Drilling, Evaluation and Digital Solutions, is the leading supplier of software, optimized computing solutions and services for the upstream oil and gas industry. The companys [sic] software solutions span exploration, production, drilling, business-decision analysis and data management.

Newswire US, January 30, 2007;

Halliburton (NYSE:HAL) today introduced its eRedBook(TM) software, a complete digital toolkit that offers quick and reliable calculators for computations used in daily operations; an interactive wellbore tool that enables users to share well schematics faster than ever before; product information from all Energy Services Group product service lines; as well as the American Petroleum Institute's (API) most up-to-date pipe data, among other resources. The eRedBook software evolved from the trusted RedBook(TM) cementing tables referencing guide, which Halliburton pioneered and first published in 1929.

"Halliburton is committed to making life easier for our customers," said David King, senior vice-president of global operations for Halliburton's Energy Services Group. "eRedBook software is the most user-friendly, most complete **digital oilfield** toolkit available today, and it's simply a smarter way for industry professionals to work.

The eRedBook software contains all the data from the original, hardcopy RedBook reference guide. It features significantly expanded content that makes it a complete and easily accessible resource, and it enables users to transfer data onto other mediums such as e-mail or word processing applications. With an internet connection eRedBook's self-update function will automatically download new content, including calculators, revised API pipe data, and additional features as they become available, providing users a single toolkit for the pertinent, timely information they need for their jobs.

Business Wire, May 1, 2006;

As energy companies are forced into deeper and deeper waters to find more oil and gas, the

challenges are ratcheting up significantly, said Jonathan Lewis, Houston-based Halliburton's vice-president of innovation.

Lewis' focus has been finding new ways to use 3-D visualization and digital technology to ferret out fossil fuels without energy companies needing to hire more field technicians.

"There's no need to have as many people in the field today," he said. "Especially with the labor shortage issues we're all concerned about, we need to leverage professionals in the very best way we know how."

Lewis is hoping energy companies will buy into Halliburton's Real Time Decision Center, which pairs gadgetry from the likes of Intel, Sony and Silicon Graphics with the skilled people who make decisions about how to drill wells. Halliburton's contention is that putting all those people and all of that technology in one room speeds up the entire process.

Traditionally, the geologists, geophysicists, reservoir engineers and production specialists who develop these energy projects have worked in a segregated way, within their own silo of expertise, Lewis said.

Despite the fact that today workers in a downtown office tower can use remote-controlled, joystick-operated digital setups to help drill wells in the deep waters of the Gulf of Mexico or sandy dunes of Saudi Arabia, some of them just don't want to.

"Technology is the easy part - a walk in the park, frankly - compared to changing the behavior of reservoir engineers and production specialists who are used to doing things in a certain way. We have to make sure people aren't the roadblocks to getting a better rate of return on investments and producing more oil and gas," Lewis said.

Shell and Saudi Aramco have been big adopters of Halliburton's **digital oil-field** technology, and Lewis hopes others will be convinced to follow suit by customer claims of shaving down drilling costs significantly.

The Houston Chronicle, April 30, 2006; and

Today, a major technological revolution is unfolding, known as "DOFF" - the **digital oil field** of the future." This brings together a panoply of information and control technologies, remote sensing mechanisms, "intelligent drilling" and highly accurate measurement tools to make exploration and production far more exact and targeted. The consequence will be to substantially lower costs. As a result, physical supplies that were previously too expensive or too difficult to produce will now become economically feasible. Milwaukee Journal Sentinel, April 6, 2003.

In addition, the examining attorney submitted printouts of pages from various websites that show use of the term "digital oilfield/oil field." Several representative examples are set forth below:

Business Success Solutions for The **Digital Oilfield** (DOF)

...

What's the Opportunity?

The **Digital Oilfield** Formula for Success is known and can be applied to every DOF application. Leveraging rapidly-advancing digital technology promises to revolutionize parts of the work in the oil patch if, and only if, it is successfully implemented! More and better data, real-time decision-making capability, remote manipulation and "smart assets" portend gains in performance, productivity and profits. **Digital Oilfield** initiatives are gearing up, but there may be a problem.

...

What tools and products do we offer?

Thanks to a lot of research, experimentation, and generosity of our clients, we have accumulated a full range of tools and templates for the Business Practice Solutions needed DOF business success. Our tools are simple and practical but battle proven. We can customize a tools set for you and even training you to use them.

www.hdinc.com/Digital-Oilfield

Continuing Education Needs for the **Digital Oil Fields** of the Future

The industry-wide push to develop the framework for the **digital oilfields** of the future (footnote omitted) (called by different names in the industry: "smart fields," "I-field," "efield," **digital oil field** of the future," or DOFF... etc). Over the past few decades, the world has seen tremendous leaps in the development of hardware and software tools that measure, analyze and organize process systems.

<http://www.spe.org/atce>

Digital oil field of the future

One of the world's great future sources of oil does not require new exploration. Rather, what is needed is improved technology to get at it. The resource is the oil that has been left behind.

....

Our estimate is that about 125 billion barrels of additional oil can be made available from existing fields around the world utilising a basket of proven technologies collectively known as "the **digital oil field** of the future."

Successfully deploying these technologies would be like finding another major oil-exporting country, for that 125 billion barrels is roughly the equivalent to the current estimates for the entire producible reserves of Iraq.

...

The **digital oil field** of the future is a suite of technologies that allows producers to extract a larger percentage of the oil from a field at a lower cost.

www.npd.no/English

The Gravitas System - Unlock the potential of the digital oilfield

Drilling for oil has never been routine. Today, wells are becoming more and more complex and the E & P industry depends increasingly on technology to meet the rigorous demands of recovery and production.

The right technology can unlock the potential of the **digital oilfield**, ensuring long term

competitiveness and securing maximum leverage from your data.

Now, our pioneering Gravitas software suite not only connects geologists to the **digital oilfield** for the first time, it integrates all your well data and links assets and office to take you to new levels of data optimisation. Gravitas is the corporate electronic wellfile.

Gravitas is comprised of a powerful central database with a choice of integrated modules and options.

With Gravitas, you can collect data real time, store current and historical well information securely, eliminate data transfer errors and produce reliable logistical charts and reports - all from one secure accurate data set.

....

Connecting geology with the **digital oilfield**, Gravitas solves the traditional problems associated with data collection, integration and transfer, giving geologists the freedom to get with valuable interpretation/analysis.

www.hrh.ltd.uk

The **Digital Oil Field**

The oil industry is increasingly relying on digital technology and Internet or web-based concepts in every aspect, from back-office accounting and e-procurement to making decisions based on modeling software, to actually drilling, completing and monitoring wells. It's called the e-field, the i-field, the smart field, and the **digital oil field**. And it is a very good thing.

www.oilandgasinvestor.com

Unearthing the potential of **digital oilfield** technology

Digging Deep

The **Digital Oilfield** is much talked about, but often not clearly articulated. The truth is that many existing and new technologies contribute to the overall concept, and there is no clear-cut definition as to what is, and what is not, part of the **Digital Oilfield**.

The **Digital Oilfield** potentially extends from the use of 4-D seismic imaging through to "data-to-desktop" initiatives that take production data

through to marketers and traders. This means that it can, potentially, impact the entire oil and gas value chain, with all the technical, process and human impacts that go with it.
www.deloitte.com

Applicant's Arguments and Evidence

Applicant argues that the examining attorney has not established by clear evidence that the mark DIGITAL OILFIELD is generic in connection with applicant's identified goods and services. Applicant contends that none of the Nexis and Internet excerpted materials relied on by the examining attorney evidence use of the term "digital oilfield" in connection with applicant's particular goods and services. In addition, applicant challenges several of the excerpts from Internet websites as having little relevance because the sites are from sources outside the United States. Applicant submitted over twenty articles that have appeared in various oil and gas industry magazines that discuss applicant's computer software and computer services. Applicant maintains that these articles show that its particular computer software and computer services are not the same as the "digital oilfield" technologies that are mentioned or discussed in the materials made of record by the examining attorney. Specifically, applicant contends that the "digital oilfield" technologies mentioned in these materials relate

to exploring oil and gas fields, whereas applicant's computer software and computer services are business to business in nature and are used in connection with oil and gas company supplier invoicing and contract management.

Finally, as additional support for its position that the mark DIGITAL OILFIELD is not generic, applicant points to the absence of such term in the Merriam-Webster Online Dictionary.

Analysis and Decision

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

With respect to the first question, in this case, we find the identification of goods and services to be an appropriate specification of the class of goods and services.

The next question then is whether the term DIGITAL OILFIELD is generic in connection with applicant's goods and services. The test for making this determination turns upon how the term is perceived by the relevant public, that is, the primary significance of the mark to the relevant public. Magic Wand, Inc., supra; and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra.

Applicant's goods and services are identified as "business to business e-commerce/electronic commerce" computer software and computer services. We judicially notice the following definitions:

business-to-business (b2b) n. The exchange of products, services, and information between businesses. B2B web services can be sorted into company web sites, e-procurement sites, specialized or vertical industry portals, auction sites, and information sites. The term is fairly broad and additional models are still evolving.
The E-Business Dictionary (First Edition 2003).

B2B abbr. *E-com* business-to-business: relating to an advertising or marketing program aimed at businesses doing business with other businesses as opposed to consumers. The term is most commonly used in reference to commerce or business that is conducted over the Internet between commercial enterprises.
The Ultimate Business Dictionary (First Edition 2003).

e-commerce *E-com* the exchange of goods, information products, or services via an electronic medium such as the Internet. Originally limited to buying and selling, it has evolved to include such functions as customer service, marketing, and advertising.

The Ultimate Business Dictionary (First Edition 2003).

In view of these definitions, we consider the relevant public for applicant's business to business e-commerce/electronic commerce computer software and computer services to be oil and gas company managers, and procurement and supply chain specialists. The Office has the burden of proving genericness by "clear evidence" of the relevant public's understanding thereof. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

With respect to applicant's contention that certain of the excerpts from Internet websites have little probative value because the sites are from sources outside the United States, the Board has held that, in appropriate situations, web pages posted abroad may be considered probative evidence on how a term will be perceived. See In re Remacle, 66 USPQ2d 1222 (TTAB 2002) [Board found that professionals in certain fields, such as medicine,

engineering, computers and telecommunications would be likely to monitor developments in their fields without regard to national boundaries, and that the internet facilitates such distribution of knowledge, so evidence from an English website in Great Britain held admissible). In this case, involving computer software and computer services for use in the oil and gas industry, it is reasonable to consider articles from Internet websites, in English, about developments in the oil and gas industry in other countries, such as Norway and Canada, because those developments are likely to be of interest worldwide regardless of their country of origin. Further, the absence of the term "digital oilfield" from a dictionary is not determinative of whether the term is generic.

Nonetheless, considering all the evidence, and keeping in mind the heavy burden the USPTO faces in establishing that a mark is generic, we find that the examining attorney has not met that burden.³

It simply is not clear from the evidence relied on by the examining attorney that "digital oilfield" designates applicant's particular category of business to business

³ It should be noted that our decision herein would not preclude a different result, on a different record, in a cancellation proceeding which might arise as a result of the registration of applicant's mark.

e-commerce computer software and computer services. Rather, the overwhelming majority of the excerpted materials refer to a "digital oilfield" as various technologies for use in the oil and gas exploration and production process, itself (e.g., data collection and analysis computer software). The remaining excerpted materials refer ambiguously to a "digital oilfield" without defining the nature or category of such goods and/or services.

While we recognize that applicant's business to business e-commerce computer software and computer services use digital technology and enable oil and gas companies to increase efficiency in their overall oilfield business operations, such computer software and computer services do not appear to be of a type that would be used in the oil and gas exploration and production process, itself.

There is simply insufficient evidence that, to the relevant public, the primary significance of DIGITAL OILFIELD, used in connection with applicant's business to business e-commerce computer software and computer software and computer services, would be the common name of such goods and services.

In view of the foregoing, and since any doubt on the matter of genericness should be resolved in applicant's

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favor, we find that the Office has not met its burden of showing that DIGITAL OILFIELD is generic for applicant's goods and services.

Decision: The refusal to register applicant's mark on the ground that it is generic is reversed.