

Cooley Godward LLP

ATTORNEYS AT LAW

Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA
94306-2155
Main 650 843-5000
Fax 650 857-0663

www.cooley.com

Britt L. Anderson
(650) 843-5535
banderson@cooley.com

Broomfield, CO
720 566-4000

Reston, VA
703 456-8000

San Diego, CA
858 550-6000

San Francisco, CA
415 693-2000

Washington, DC
202 842-7800

TTAB

November 10, 2005

VIA FIRST CLASS MAIL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Re: Notice of Appeal ; Request for Reconsideration; and Declaration

Trademark: ADAPTIVE PLANNING

Serial Nos.: 78/324,672 and 78/324,676

Classes: 9 and 42

Applicant: Adaptive Planning, Inc.

**Our File: Adaptive Planning, Inc./ADAPTIVE PLANNING/US, Class 9
Adaptive Planning, Inc./ADAPTIVE PLANNING/US, Class 42**

Dear Assistant Commissioner:

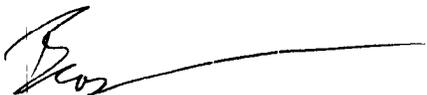
Enclosed please find the following documents for filing in each of the above-identified trademark applications.

1. Notice of Appeal;
2. Request for Reconsideration; and
2. Declaration of Britt L. Anderson in Support of Request for Reconsideration Under 37 C.F.R. § 2.64(b).

Please charge any fee associated with this filing to Deposit Account No. 03-3118. A duplicate copy of this letter as authorization is attached hereto for your convenience.

Very truly yours,

COOLEY GODWARD LLP



Britt L. Anderson

Enclosures

cc: Nonie J. McMahan, Sr. Trademark Paralegal
714836 v1/PA



11-15-2005

U.S. Patent & TMOc/TM Mail Rcpt Dt. #64

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Arlington, VA 22313-1451:

Cheryll Dung
(Typed or Printed Name)


(Signature)

November 10, 2005
(Date)

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

In Re the Application of:

Applicant:	Adaptive Planning, Inc.)
)
Serial No.:	78/324,676)
)
Filed:	November 7, 2003)
)
Mark:	ADAPTIVE PLANNING)
)
Mailing Date of)
Final Refusal:	May 10, 2005)
)

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF APPEAL

Adaptive Planning, Inc. ("Applicant") hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration

NOTICE OF APPEAL
SERIAL NO. 78/324,676

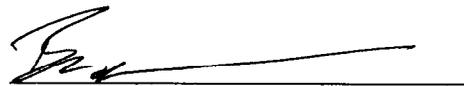
of the ADAPTIVE PLANNING mark noted above. An appeal fee in the amount of \$100.00 is filed concurrently herewith. 37 C.F.R. §2.6(a)(18). If for any reason there is no check attached or the amount is insufficient, please charge any fee or insufficiency to the deposit account of Cooley Godward LLP, Deposit Account No. 03-3118.

Respectfully submitted,

COOLEY GODWARD LLP

Date: November 10, 2005

By:



Britt L. Anderson
Attorneys for Applicant
Five Palo Alto Square
3000 El Camino Real
Palo Alto, California 94306-2155
(650) 843-5535

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Arlington, VA 22313-1451:

Cheryll Dung

(Typed or Printed Name)



(Signature)

November 10, 2005

(Date)

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Application of:

Applicant: Adaptive Planning, Inc.

Mark: ADAPTIVE PLANNING

Serial No.: 78/324,676

Filed: November 7, 2003

Mailing Date: May 10, 2005

Trademark Law Office: 102

Examining Attorney: Maria-Victoria Suarez

Commissioner for Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 2.64(b)

Pursuant to 37 C.F.R. 2.64(b), and TMEP §715.03, Adaptive Planning, Inc. (the "Applicant"), by and through its counsel, respectfully requests that the Examining Attorney reconsider her refusal to register ADAPTIVE PLANNING ("Applicant's Mark") based on the following arguments and accompanying evidence.

I. APPLICANT'S MARK ADAPTIVE PLANNING IS SUGGESTIVE AND IS THEREFORE SUFFICIENTLY DISTINCTIVE FOR REGISTRATION

A. Background

On May 10, 2005, the Examining Attorney issued a Final Refusal ("Final Action") of registration for the ADAPTIVE PLANNING trademark on the grounds that the mark "describes a function or purpose of the software featured by the applicant."¹ Applicant seeks registration of the mark ADAPTIVE PLANNING for use with its application service used for financial analysis.

Consistent with this use, Applicant seeks registration in connection with *computer services, namely, acting as an application service provider in the field of business and financial analysis* in International Class 042.²

B. Summary of Argument

Applicant respectfully asserts that the ADAPTIVE PLANNING mark is suggestive and entitled to registration on the Principal Register and requests the Examining Attorney to reconsider her refusal for the following reasons:

- The multi-step reasoning process used by the Examining Attorney to determine the attributes of the services ADAPTIVE PLANNING is alleged to describe establishes suggestiveness;
- The Examiner's third-party references do not support a finding of descriptiveness because they are drawn from fields not related to Applicant's relevant consumers or services;
- The Examiner fails to show that the commercial impression of Applicant's mark describes a *significant* feature or function of Applicant's goods and/or services;

¹ See Final Action at 2.

- Any doubt as to whether ADAPTIVE PLANNING is descriptive or suggestive must be resolved in favor of Applicant.

C. The Examining Attorney's Analysis and Evidence Strongly Supports a Finding of Suggestiveness Rather than Descriptiveness.

The Examining Attorney reaches a purported descriptive definition of Applicant's Mark after a multi-stage analysis that relies upon third party materials drawn from sources outside of Applicant's relevant market.³ Thereafter, the Examining Attorney attempts to equate the definitions she has derived from these third-party sources to language with significantly different terms found on Applicant's website. On this basis, the Examiner concludes that Applicant's Mark is merely descriptive. The elaborately reasoned nature of the Examiner's derivation of the meaning of Applicant's Mark and the sources on which she relies both militate strongly in favor of a finding of suggestiveness in this case.

1. The Examiner's Multi-Stage Reasoning Process Confirms that Applicant's Mark is Suggestive.

If one may exercise "mature thought or follow an multi-stage reasoning process" to determine attributes of a product or service, the term is suggestive, not descriptive. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978). Based upon two dictionary definitions⁴ and several third-party sources,⁵ the Examining Attorney argues that "in relation to business and financial planning software, the term 'ADAPTIVE' refers to software that provides flexible modeling and to reflect the user's current business needs."⁶ The Examining Attorney's

² See Section II *infra* (amendment of description of goods).

³ See Final Action at 2.

⁴ The Examining Attorney's dictionary references are to the definitions for "adaptive" and "adaptation" found on Bartleby.com. See Final Action at 2.

⁵ See *id.*, Exhibits 1 - 5

⁶ Final Action at 2 (third paragraph).

path for deriving this meaning consists of at least three stages of analysis as each source of meaning is incorporated into the final definition.

The first of the Examining Attorney's sources are dictionary definitions for the terms "adaptive" and "adaptation" attached to the May 10, 2005 Final Action. These dictionary definitions do not refer to financial analysis software in any way and the Examining Attorney does not suggest that the language of these definitions allows direct derivation of a descriptive meaning for Applicant's Mark. "[T]he absence of any particular reference to [Applicant's field of business] in the dictionary probably favors [Applicant's] position that the ADAPTIVE PLANNING mark should be published rather than refused *ex parte*." See *In re Men's Int'l Professional Tennis Council*, 1986 WL 83346, *1 (T.T.A.B. 1986); *In re Sundown Technology Inc.*, 1986 WL 83350, *2 (T.T.A.B. 1986) (finding GOVERNOR for amplifier controls not merely descriptive based in part on an absence of reference by dictionary definition made of record to the germ "governor" being a term of art in the electronics field or with amplifiers in particular). Further, the language of these definitions is entirely dissimilar to language that the Examining Attorney later excerpts from (or that is found anywhere on) Applicant's website or Applicant's services description.

Nonetheless, rather than tying these dictionary definitions to Applicant's services directly, the Examining Attorney then progresses in her analysis to a second purported meaning for the "adaptive" term by citing to two third-party references in the field of software development and programming,⁷ which she asserts establish that "the term 'ADAPTIVE' refers to software that can readily adjust despite changing user needs, desires and environment."⁸ This

⁷ See Final Action, Exh's 1 & 2.

⁸ Final Action at 2.

specific language is drawn from the first⁹ of these third-party references, an article apparently authored by Peter Norvig and David Cohn (the “Norvig article”). The language of the Norvig article has been taken out of context. In fact, the full quotation containing the Examining Attorney’s selected language actually reads: “Adaptive *Programming* is aimed at the problem of producing applications that can readily adapt in the face of changing user needs, desires, and environment.”¹⁰ This full language makes it clear that the author of the article is proposing a definition specifically for “Adaptive Programming,” not for the adjective “Adaptive” in connection with Applicant’s financial analysis software.

Moreover, the Norvig article is unrelated to Applicant’s financial analysis software and the financial executives who use such software and/or services. Instead, it is abundantly clear that the article relates to the computer programming field. The first section of the article summarizes the history of “[v]arious software design methodologies,” by listing “Structured programming,” “Object-oriented programming,” and finally “Adaptive programming.”¹¹ This terminology clearly indicates that the authors of the Norvig article targeted their work at computer programmers and other specialists in computer software development.¹² As Applicant pointed out in its original response to the Examining Attorney’s office action, Applicant’s application services is used by financial executives for business and financial analysis, not computer programmers or software application developers who would read the Norvig article.

⁹ The first reference, found at Exhibit 1 of the Final Action, is an article found at the website www.norvig.com. As discussed in the Declaration of Britt L. Anderson (“Anderson Declaration”) filed herewith, a visit to this website on November 7, 2005 revealed that this website offers links to other websites, training material and articles related to various technical topics in the computer programming field. See Anderson Decl. ¶ 2, Exh. A.

¹⁰ See Final Action, Exh. 1 (pg. 1) (emphasis added).

¹¹ Final Action at 2, Exhibit 1, pg. 1.

¹² See *supra* note 9.

Like Exhibit 1, the Examining Attorney's second citation found at the Final Action's Exhibit 2 – a description of a workshop apparently hosted by the Institute of Software Integrated Systems (“ISIS”) at Vanderbilt University (the “ISIS workshop”)¹³ – is clearly aimed at attendees with a high level of sophistication in computer engineering, programming and languages, and not Applicant's financial executive consumers. In addition, the ISIS workshop material discusses a topic, called “self-adaptive software,” that differs substantially from the Norvig article. Further, it does not provide direct support for the purported definition of “Adaptive” derived by the Examining Attorney in relation to Exhibits 1 and 2. By relying on the ISIS workshop material to support this assertion, the Examiner could only have arrived on this definition through a multi-stage reasoning process. Thus, the ISIS workshop materials appear both out of place in the context of the Examining Attorney's argument and irrelevant to any descriptive meaning in regard to Applicant's business.

After this examination of the use of the “Adaptive” term in the specialized software programming field, the Examining Attorney asserts that, “[i]n any context, the term ‘ADAPTIVE’ refers to planning systems that are dynamic.”¹⁴ This third definition differs from both the dictionary meaning as well as the definition purportedly derived from the Norvig article and the ISIS workshop materials. The materials¹⁵ cited in support of this additional definition include an article from *Air University Review* entitled “Adaptive Mission Planning,” which discusses an “Adaptive Mission-Planning System” used for military planning (the “AMPS article”), a training service called “Adaptive Planning leadership development program” offered

¹³ A visit to this website on November 7, 2005 revealed that the www.isis.vanderbilt.edu website, which hosts the ISIS workshop description, provides information on computer software engineering and modeling. See Anderson Decl. ¶ 3, Exh. B.

¹⁴ Final Action at 2.

on the website www.forum.com (the “Forum service description”),¹⁶ and article entitled “Navigation Strategy – Adaptive Planning Approaches” from the website Espial HPC, an information technology consulting firm (“Espial webpage”) (collectively, “Exhibits 3-5”).

Exhibits 3-5 are inappropriate references for a finding of descriptiveness in this case. All of these references suffer from the same weakness i.e., none actually contain language stating that “the term ‘ADAPTIVE’ refers to planning systems that are dynamic,” as the Examining Attorney’s assertion may be read to suggest that they do.¹⁷ Instead, the Examiner has apparently conducted a review of Exhibits 3-5 and through a multi-stage reasoning process has synthesized a definition of what she believes “Adaptive” to mean “in any context.”

Once the Examiner has derived these differing third-party definitions – one from the programming world and one synthesized from the examiner’s reading of disparate sources unrelated to Applicant’s application service for financial executives, the Examiner then takes a third step in both logic and language to reach her conclusion. This step begins with the Examiner proposing a fourth definition for ADAPTIVE:

Specifically, in relation to business and financial planning software, the term ADAPTIVE refers to software that provides flexible modeling and to reflect the user’s current business needs. As those business needs change, the software allows the user to modify the model.

Final Action at 2.

¹⁵ These materials are found at Exhibit 3-5 attached to the PTO’s May 10, 2005 Office Action.

¹⁶ The Forum service description appears to be an instance where a third party is treating the “Adaptive Planning” phrase as a mark in regard to a set of services unrelated to Applicant’s goods. A review of the Forum website at www.forum.com indicates that Forum follows the phrase “Adaptive Planning” with the service descriptor “leadership development program,” as it consistently does with a number of other Advanced Leadership course names. Applicant submits that “Adaptive Planning” is a name used to identify Forum’s course rather than a term used to describe the topic of the course. *See* Anderson Decl. ¶ 4, Exh. C.

This fourth definition, which contains entirely new terms not found in language of any of the third-party references, is in fact drawn directly from Applicant's website, which the Examining Attorney excerpts in the following paragraph. *Id.* Apparently dissatisfied with third party references found at Exhibit 1-5, the Examining Attorney has *reasoned backwards* to create a new definition for ADAPTIVE out of whole cloth. This new definition is then equated to Applicant's own product language to conclude that "the mark immediately tells consumers a function or purpose of software featured by applicant – namely, to provide flexible business and financial modeling."

Applicant respectfully submits that the Examining Attorney's multi-stage reasoning process itself validates Applicant's arguments that the ADAPTIVE PLANNING mark is suggestive in regard to Applicant's financial analysis software. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods or services. *See In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 58 (T.T.A.B. 1978) (quoting *Stix Products Inv. v. United Merchants & Manufacturers, Inc.* 160 U.S.P.Q. 777 (S.D.N.Y. 1968)). Moreover, it is well settled that a valid trademark may be highly suggestive. *See, e.g., Minn. Mining and Mfg. Co. v. Johnson & Johnson*, 59 C.C.P.A. 971, 973 (C.C.P.A. 1972) (finding SKINVISIBLE registrable in connection with adhesive tape for medical and surgical purposes, although the mark "undoubtedly suggest[ed] that the skin is visible through or in spite of the goods"). That is, the fact that a mark is capable of being analyzed does not render it merely descriptive. *See In re C.J. Webb, Inc.*, 182 U.S.P.Q. 63, 64 (T.T.A.B. 1974). Certainly, if a

¹⁷ In addition, none of these relate to software goods are used by financial executives "for business and financial analysis," which are Applicant's goods. *See* Section I.C.2 *infra*.

mark necessitates “mature thought,” then the mark must be deemed suggestive rather than merely descriptive. *Id.* (citing *In re One Minute Washer Co.*, 37 U.S.P.Q. 203 (C.C.P.A. 1938)).

Here, it is clear that the Examining Attorney has applied “imagination, thought and perception” in an elaborate process of deductive reasoning to reach her conclusion. This process involves the derivation of multiple meanings for the ADAPTIVE term followed by wholesale creation of a new definition – a definition which contains entirely new terms derived from Applicant’s website for the purpose of establishing a meaning for Applicant’s mark. The Examining Attorney provides no basis on which any of these three definitions may be equated to one another or the cited language on Applicant’s website. Finally, for Section 2(e)(1) purposes, Applicant’s relevant consumers cannot be expected to engage in such an elaborate reasoning process. Accordingly, the Examiner’s final assertion that “the mark *immediately* tells consumers a function or purpose of software featured by the applicant”¹⁸ is totally unsupported and the ADAPTIVE PLANNING mark must be found suggestive in regard to Applicant’s services.

2. The Cited Third Party References Do Not Support Descriptiveness Because They Do Not Relate to Applicant’s Relevant Consumers or Services.

In developing a definition for the ADAPTIVE PLANNING term, the Examining Attorney relied on five third party sources.¹⁹ These sources cannot be considered as relevant to the determination of whether Applicant’s ADAPTIVE PLANNING mark is merely descriptive, because each source is drawn from a field not related to Applicant’s financial analysis application service or the financial executives who would purchase such services.

¹⁸ See Final Action at 2.

¹⁹ See Final Action, Exh’s 1-5.

As with the American Marketing Association reference cited by the Examining Attorney under Office Action No. 1,²⁰ the lack of relation to Applicant's business area causes the Examiner's sources to be inappropriate for a determination of descriptiveness. The determination of whether a mark is merely descriptive cannot be made in the abstract. *See In re Medical Disposables Co.*, 25 U.S.P.Q.2d 1801, 1804 (T.T.A.B. 1993). Rather, such determination must be made in relation to the goods or services for which registration is sought, in the context in which the mark is used, and the possible significance that the mark would have, because of that context, to the average purchaser in the marketplace. *See In re Omaha Nat'l Corp.*, 2 U.S.P.Q.2d 1859, 1861 (Fed. Cir. 1987); *In re Abcor Dev't Corp.*, 200 U.S.P.Q. at 218; *In re Venture Lending Assocs.*, 226 U.S.P.Q. 285, 286 (T.T.A.B. 1985); *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591, 593 (T.T.A.B. 1979).

Here, Applicant is marketing computer software and application services for business and financial analysis to financial executives and managers. The references cited by the Examining Attorney are simply not relevant to these products or their relevant consumers. As discussed at Section I.C.1 *supra*, the Norvig article and ISIS references are related to highly technical issues in the computer programming field, not financial analysis. Applicant's relevant consumers are not computer programmers and Applicant's software product for financial executive is not designed for computer programming or design of software applications. Exhibits 3-5 are similarly far afield. The AMPS article at Exhibit 3 of the Final Action is a 1987 reference relates to military planning having nothing to do with financial budgeting software. The "Adaptive Planning leadership development program" at Exhibit 4 is a training service clearly unrelated to

²⁰ *See* Applicant's November 30, 2004 Response to Office Action at Section C.3.

financial analysis software.²¹ Further, Forum, the apparent provider of the training course, appears to use the “Adaptive Planning” phrase as the name for its course rather than as descriptively.²² The Espial webpage from Espial at Exhibit 5 uses the “Adaptive Planning” in the context of a service related to strategic planning for technology. The Espial services do not include offerings of software used for financial analysis and are not targeted at Applicant’s financial executives, with their budgetary and forecasting concerns.²³

Applicant respectfully submits that there is a significant distance between its relevant area of business and the fields from which the Examining Attorney has drawn her references. While it is possible that the term ADAPTIVE may have a well-understood meaning with respect to goods and/or services in these other fields, the Examiner has failed to show that the ADAPTIVE PLANNING term has a descriptive meaning when applied to Applicant’s goods. *See Sundown*, 1986 WL 83350, *2 (evidence of well understood meaning in regard to electric motors insufficient to show meaning with respect to Applicant’s electric amplifiers); *In re Stroh Brewery*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1995) (finding the term VIRGIN not descriptive of non-alcoholic malt beverages despite evidence of use of the term “virgin” in connection with non-alcoholic mixed drinks). Here, Applicant’s relevant area of business is certainly at least as distant from the fields of use relevant to Exhibits 1-5 as the respective applicants in the *Sundown* and *Stroh* cases.

²¹ See Anderson Decl., ¶ 4, Exh. C.

²² *Id.*

²³ See Anderson Decl., ¶ 5, Exh. D.

D. To Support Descriptiveness, a Term Must Describe a Significant Attribute of the Relevant Goods and/or Services.

The Examining Attorney reaches her conclusion regarding refusal under Section 2(e)(1) based upon the statement, “it is sufficient that the term describe only *one* attribute of the goods and/or services to be merely descriptive.”²⁴ This is an incorrect statement regarding the law. In fact, the *H.U.D.D.L.E.* and *MBAAssociates* cases cited by the examining attorney immediately following this assertion do not support this language. Instead, these cases provide that a term must describe “a *significant* function or attribute or property” of the goods and/or services to be considered descriptive. See *In Re Huddle*, 216 U.S.P.Q. 358, 359 (T.T.A.B. 1982) (citing *In Re MBAAssociates*, 180 U.S.P.Q. 338 (T.T.A.B. 1973)). The Examining Attorney’s reasoning fails to meet this standard.

The Board’s inclusion of the word “significant” in the language of these cases is important to the Examiner’s basis for refusal in this case. The Examining Attorney states: “the mark immediately tells consumers a function or purpose of the software featured by the Applicant – namely, to provide flexible business or financial modeling.”²⁵ Yet at no point does the Examiner point to anything in the record supporting an assertion that “flexible business or financial modeling” is “a *significant* function or attribute or property” of Applicant’s goods. In fact, any suggestion that “flexible business or financial modeling” is a significant feature of Applicant’s goods or services flies in the face of the record for this application. In its November 10, 2004 Response to Office Action No. 1, Applicant presented evidence of at least thirteen different functions for its ADAPTIVE PLANNING product. None of these thirteen different functions contained the terms found in the Examiner’s “flexible business or financial modeling.”

²⁴ Final Action at 2.

feature purportedly described by Applicant's Mark. On this basis alone, the Examining Attorney has failed to meet the standard for Section 2(e)(1) refusal.

Moreover, attached to the Anderson Declaration is an additional exemplar of Applicant's ADAPTIVE PLANNING product materials as presented to its Product Advisory Panel ("Panel") as Applicant was planning its product in 2003. The Panel was comprised of several financial executives who have subsequently become customers for Applicant's financial analysis software.²⁶

As Applicant describes to its Panel, the key problems faced by managers responsible for budgeting, forecasting and reporting – *and accordingly the key features and functions that Applicant's product provides* – are found at page 3 of this presentation. At no point in this listing does the Examiner's "flexible business or financial modeling" feature on which the descriptiveness refusal is based appear.²⁷ In fact, "flexible modeling" does not appear at any point in the entire presentation.²⁸ The Examining Attorney's arbitrary decision to excerpt the "flexible modeling" language from Applicant's website cannot overcome the requirement that the PTO has the burden to show that the mark describes "a *significant* function or attribute or property" of the goods and/or services to be considered descriptive

This conclusion that the ADAPTIVE PLANNING mark does not describe any significant function or feature of Applicant's goods is reinforced by the fact that the Examining Attorney was only able to derive a purported meaning for ADAPTIVE as an outcome of a multi-stage reasoning process. Where marks are only suggestive or reminiscent of a single feature of the

²⁵ *Id.*

²⁶ Anderson Decl., ¶ 6, Exh. E.

²⁷ *Id.*

²⁸ *Id.*

underlying goods, they are not held descriptive. *See Application of Reynolds Metals Co.*, 480 F.2d 902, 903-04 (C.C.P.A. 1973) (finding mark BROWN-IN-BAG suggestive when used in connection with transparent film bags used to brown meat in an oven); *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978) (finding THE MONEY SERVICE registrable for financial services wherein funds transferred to and from locations remote from associated financial institution). The Examining Attorney has only shown evidence that the ADAPTIVE PLANNING mark is, at most, reminiscent of one feature of many of Applicant's goods, a showing entirely insufficient for a refusal under Section 2(e)(1).

E. The PTO Bears the Burden in Demonstrating Descriptiveness.

The Examining Attorney bears the burden of proof in demonstrating descriptiveness.²⁹ As noted above, the Examining Attorney has used a multi-stage reasoning process to derive the meaning of Applicant's Mark, which on its own confirms that Applicant's Mark is suggestive because it does not immediately convey a feature, purpose or function of Applicant's goods. In addition, the Examiner's third-party references are not related to Applicant's relevant consumers or its relevant goods, making them inappropriate bases for derivation of a descriptive meaning. Finally, the Examiner's arguments fail to show that the ADAPTIVE PLANNING mark describes a *significant* feature of Applicant's goods. If a doubt exists regarding whether a mark is registrable under section 2(e)(1), that doubt is to be resolved in the Applicant's favor. *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992). If any doubt remains after submission of Applicant's arguments and evidence, Applicant's application should be approved for publication.

²⁹ TMEP § 1209.02. ("If the examining attorney refuses registration [on descriptiveness grounds], he or she should support the refusal with appropriate evidence.")

II. APPLICANT'S AMENDMENT OF GOODS DESCRIPTION

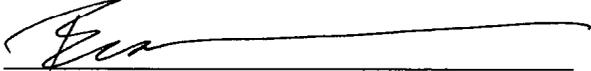
On November 7, 2003, Applicant filed the instant application in connection with: "Computer software for business and financial planning and analysis" in International Class 009. With this Motion for Reconsideration, Applicant hereby amends its description of goods to: "Computer software for business and financial analysis" in International Class 009.

III. CONCLUSION

In view of the foregoing arguments, it is believed that this application is now in condition for prompt publication, and favorable action is therefore requested.

Respectfully submitted,
Cooley Godward LLP

Date: November 10, 2005

By: 
Britt L. Anderson, Esq.
Cooley Godward LLP
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Telephone: (650) 843-5000

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Arlington, VA 22313-1451:

Cheryll Dung

(Typed or Printed Name)



(Signature)

November 10, 2005

(Date)

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Application of:

Applicant: Adaptive Planning, Inc.

Mark: ADAPTIVE PLANNING

Serial No.: 78/324,676

Filed: November 7, 2003

Mailing Date: May 10, 2005

Trademark Law Office: 102

Examining Attorney: Maria-Victoria Suarez

Commissioner for Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

**DECLARATION OF BRITT L. ANDERSON
IN SUPPORT OF RESPONSE TO OFFICE ACTION**

I, Britt L. Anderson, declare as follows:

1. I am an associate with Cooley Godward LLP, attorneys of record for Applicant Adaptive Planning, Inc. ("Applicant"). I either have personal knowledge of the matters stated

**ANDERSON DECLARATION IN SUPPORT OF
REQUEST FOR RECONSIDERATION**

herein or have knowledge based upon my review of materials maintained in the ordinary course of business. If called to testify as a witness, I would state the following:

2. On November 7, 2005, I visited the website at www.norvig.com. I found that this website offered links to other websites, training materials and articles related to various topics in the computer programming field. Attached hereto as Exhibit A is a true and correct copy of the homepage of the website at www.norvig.com.

3. On November 7, 2005, I visited the website at www.isis.vanderbilt.edu. I found that this website, which hosts the ISIS workshop description discussed in the Request for Reconsideration filed herewith, provides information on computer software engineering and modeling. Attached hereto as Exhibit B is a true and correct copy of the homepage of the website at www.isis.vanderbilt.edu.

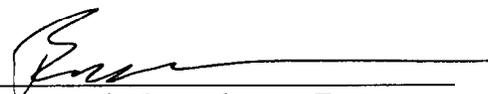
4. On November 7, 2005, I visited the website at www.forum.com ("Forum website"). I found that this website follows the phrase "Adaptive Planning" with the service descriptor "leadership development program," as it consistently with a number of its Advanced Leadership course titles. Attached hereto as Exhibit C are true and correct copies of webpages from the Forum website that display exemplars where the course names "Dilemma Management" and "Establishing Credibility" are used as course titles followed by similar service descriptors.

5. On November 7, 2005, I visited the website at www.espial-hpc.com ("Espial website"). I found that this company operating the website at this domain address was offering a service related to strategic planning for technology. Attached hereto as Exhibit D is a true and correct copy of a print out of the home page of the Espial website.

ANDERSON DECLARATION IN SUPPORT OF
REQUEST FOR RECONSIDERATION

6. Attached hereto as Exhibit E is a true and correct copy of a marketing and product planning presentation presented on November 20, 2003 to Applicant's Product Advisory Panel ("Panel"). Applicant's Panel was comprised of several financial executives who have subsequently become customers for Applicant's financial analysis software and/or application service.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 10th day of November 2005 in Palo Alto, California.



Britt L. Anderson, Esq.



Peter@Norvig.com

This site contains technical papers, essays, reports, software, and other materials by Peter Norvig. 

Top Dozen Links on Norvig.com

- #1 [Gettysburg Powerpoint Presentation](#) and its making (slides)
- #2 [AI: A Modern Approach](#) (book) and [AI on the Web](#) (links)
- #3 [World's Longest Palindrome](#) (for 20:02 02/20 2002)
- #4 [Teach Yourself Programming in 10 Years](#) (essay)
- #5 [Design Patterns in Dynamic Languages](#) (slides)
- #6 [Paradigms of AI Programming](#) (book) with [code](#)
- #7 [Java IAQ and Python IAQ](#) (FAQs)
- #8 [Lisp compared to Python, Java, and itself in 1991](#)
- #9 [Code for Intro AI programming in Python and Lisp](#)
- #10 [norvig.com rss feed](#)
- #11 [Einstein '05 Performance Review](#)
- #12 [JScheme: Scheme in Java](#) (software)

Artificial Intelligence Books

#2 [AI: A Modern Approach](#), *Outstanding ... will deservedly dominate the field for some time* - Nils Nilsson

[Amazon](#)

#6 [Paradigms of AI Programming](#) *Possibly the best hardcore programming book ever.* - Gareth McCaughan

[Amazon](#)

[Verbmobil: Translation for Face-to-Face Dialog](#) - [Amazon](#)

[Intelligent Help Systems for Unix](#) - [Amazon](#)

Free Open Source Software

- #6 [Lisp for Paradigms of AI Programming](#)
- #9 [Code in Python and Lisp for AI: A Modern Approach](#)
- #12 [JScheme: Scheme in Java](#)

[Beal's Conjecture](#)

[Pugdom](#), and [Nutdom](#), games by Juliet Norvig

[LTD: Converting Lisp to Dylan](#)

[py2html \(.py\)](#) (python pretty-printer)

[docex \(.py\)](#) (unit test / example module; similar to doctest)

[yaptu.py](#) (my version of Martelli's template code)

Etc.

#2 [AI on the Web](#) (my list of about 800 links)

[Norvig's Law](#)

[A Y2K Saga](#) (fiction)

[Familiar and Unfamiliar Quotations](#) (my favorites)

[Data gathering around forms](#) (patent)

[Norvig.com logs: 1997-99, 2000-01, 02, 03, 04, all-time.](#)

Contact Information

Peter Norvig

Director of Search Quality Google™

Tel: (650) 623-4248

Fax: (650) 618-1499

[Vita / resume](#) including [online papers](#); short bio with [photo](#)

What's New

NEW [RSS Feed for norvig.com](#)

NEW ['05 Performance Review for Albert Einstein](#)

NEW [Doing the Martin Shuffle \(with your iPod\)](#)

Java, Lisp and Python Essays

#6 [Paradigms of AI Programming with Lisp code](#)

#7 [Java IAQ \(Infrequently Answered Questions\)](#)

#7 [Python IAQ \(Infrequently Answered Questions\)](#)

#8 [Python for Lisp Programmers](#) (essay)

#12 [JScheme: Scheme implemented in Java](#) (free software)

[Lisp: Where Do We Come From? What Are We? Where Are We Going?](#)

[Silk: A Playful Blend of Scheme and Java](#) (ps)

[Lisp as an Alternative to Java](#) (comparison)

[Lisp Retrospective](#) (essay)

[Tutorial on Good Lisp Programming Style](#) (ps)

[Python Accumulation Displays](#) (proposal)

Other Programming Papers and Presentations

#4 [Teach Yourself Programming in 10 Years](#) (essay)

#5 [Design Patterns in Dynamic Languages](#) (slides)

#11 [Beal's Conjecture](#) (software, math)

[Decision Theory: Language of Adaptive Software](#) (slides)

[Finding and Reusing Programmer's Work](#) (ps)

[How to Make Agents Do the Right Thing](#) (demo)

[Adaptive Software](#) (article)

NASA

[Mars Program Reports](#) (with Tom Young Commission)

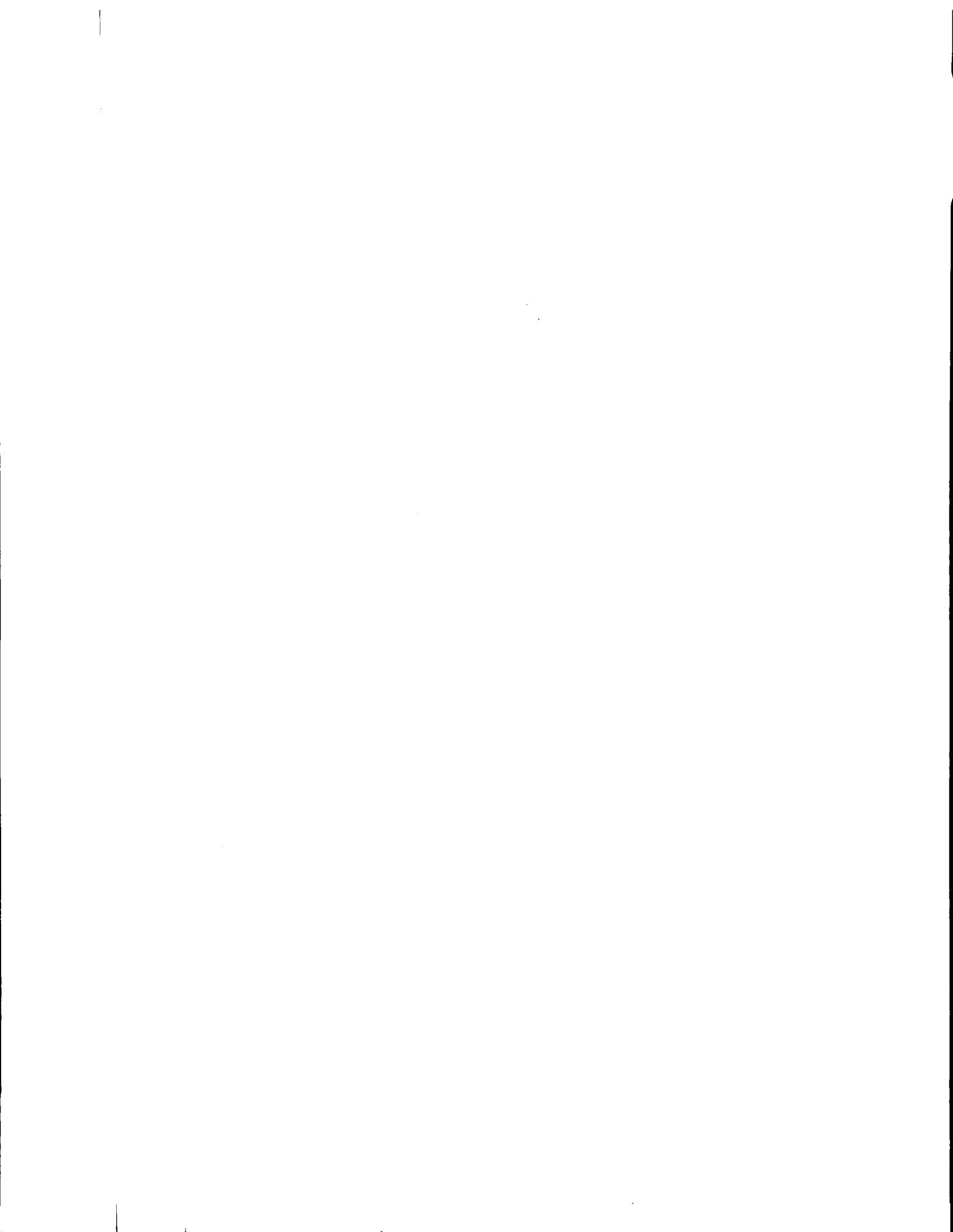
[NASA Project Management Report](#) (pdf, with Stephenson)

[Mars Climate Orbiter Failure Report](#) (pdf, with Stephenson)

[NASA Computational Sciences](#) (my former division)

Politics

[Hiring a President](#)



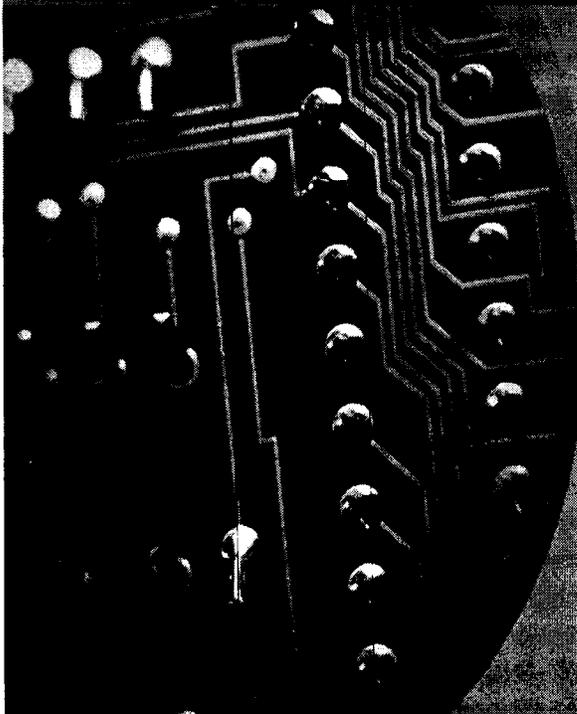


INSTITUTE FOR SOFTWARE INTEGRATED SYSTEMS

SEARCH

RESEARCH EDUCATION PUBLICATIONS CONTACT CALENDAR OF EVENTS

IN THE NEWS

A close-up, black and white photograph of a complex printed circuit board (PCB). The board is densely packed with various electronic components, including numerous integrated circuits (chips) and surface-mount components. The intricate patterns of copper traces and the arrangement of components are clearly visible, creating a complex, geometric layout.

Model-Integrated Computing

Model-Integrated Computing (MIC) addresses the problems of developing software integrated systems by providing rich, domain-specific modeling environments including model analysis and model-based program synthesis tools. This technology is used to create and evolve integrated, multiple-aspect models using concepts, relations, and model composition principles routinely used in the specific field, to facilitate systems/software engineering analysis of the models, and to automatically synthesize applications from the models. MIC has been used to develop many different technologies and solutions for industry and government. Please browse our updated web presense for more details of our technology, research, and projects. More information on MIC is available [here](#).

September 21, 2005

We've just released GME 5, a new version of the Generic Modeling Environment. New features include advanced scripting support in the console window, enhanced smart copy between projects and many other improvements to decorators and interpreter interfaces. GME is now compiled with Visual Studio .NET. Download GME 5 from [Escher](#).

JOIN US ABOUT ISIS SITE INDEX SCHOOL OF ENGINEERING VANDERBILT UNIVERSITY



FORUM

Where Learning Means Business

[Home](#) [About Forum](#)[Sales Force Effectiveness](#)[Customer Loyalty](#)[Library](#)[News](#)[Events](#)[Contact us](#)

Home : Leadership Development : Advanced Leadership : Dilemma Management

- [Capabilities Overview](#)
- [Leadership Fundamentals](#)
- [Teams and Collaboration](#)
- [Advanced Leadership](#)
 - [Coaching: Strategic Advantage Through Learning](#)
 - [Establishing Credibility](#)
 - [Dilemma Management](#)
 - [The First 90 Days™](#)
 - [Ownership: Delivering Value Through People](#)
 - [Making Strategy Work](#)
 - [Adaptive Planning](#)
 - [Encouraging Innovative Ideas](#)
- [Leadership Simulations](#)
- [Newsletter Sign-up](#)
- [Site Map](#)
- [Contact Us](#)
- [Privacy Policy](#)

Search Our Site

Dilemma Management

Business Challenge

A critical skill for today's business leaders is the ability to resolve complex issues quickly and effectively. However, not every issue has a right answer or a best solution. For example, how should a leader decide between short-term profitability and long-term growth? Between quality versus cost? Or global alignment versus local fit? Each of these examples represents a dilemma - a situation or decision with two opposing forces, each with distinct advantages and disadvantages. The emerging leaders role is to develop strategies that consistently tap the maximum value of both forces over time while minimizing the disadvantages of both.

Dilemma Management

The Dilemma Management leadership development program helps participants learn how to identify, analyze, and skillfully manage the critical dilemmas they face on the job. It breaks managers out of either-or thinking. It also frees them from the waste and poor decisions that come from trying to define every issue as a problem to be solved as opposed to a dilemma that must be assessed and managed over time.

Key Content

Dilemma Management consists of three key content areas: identifying, analyzing, and managing leadership dilemmas:

- **Identify:** As a first step, leaders must be able to

distinguish between a problem, which can be solved with a single, discrete solution, and a dilemma, which has no one best solution and must be managed over time. A clear definition and set of criteria that help participants identify their own leadership dilemmas are provided and discussed.

- **Analyze:** Once a dilemma has been identified, it is important for the leader to clarify its opposing forces or polarities, and to pinpoint the upside potential and downside risks of each. Participants learn how to use a simple but effective tool to uncover and capture this information as they analyze their dilemmas.
- **Manage:** After a dilemma has been thoroughly assessed, the leaders task is to develop specific strategies that will achieve the best of both sides of the dilemma over time. Participants follow a set of guidelines to help them craft these strategies and plan how they will execute them back in their businesses.

Target Audience

Dilemma Management is suited for managers at all levels who need to develop systems thinking, seasoned judgment, or complexity-management leadership skills. Any manager who must wrestle with critical trade-offs in leading his or her division or team in complex, ever-changing business settings will benefit from this leadership development session.

Outcomes

By the end of the Dilemma Management session, participants will be able to:

- Rapidly identify critical dilemmas throughout their business context
- Craft and apply strategies to maximize the greatest potential of both sides over time
- Display agility, clear judgment, and incisive action in the face of important business challenges

Dilemma Management typically includes 3 hours of classroom learning and is usually integrated into a larger, customized leadership development system.

For More Information on Leadership Development

please call one of [Forum's global offices](#) or submit your information request [here](#).



©Copyright 2004 The Forum Corporation All Rights Reserved
Home | About Forum | Leadership Development | Customer Loyalty | Sales Force Effectiveness |
Library | News | Events | Site Map | Contact Us



FORUM Where Learning Means Business

Home About Forum Sales Force Effectiveness Customer Loyalty Library News Events Contact us



Home : Leadership Development : Advanced Leadership : Establishing Credibility

- ▶ Capabilities Overview
- ▶ Leadership Fundamentals
- ▶ Teams and Collaboration
- ▶ Advanced Leadership
 - ▶ Coaching: Strategic Advantage Through Learning
 - ▶ Establishing Credibility
 - ▶ Dilemma Management
 - ▶ The First 90 Days™
 - ▶ Ownership: Delivering Value Through People
 - ▶ Making Strategy Work
 - ▶ Adaptive Planning
 - ▶ Encouraging Innovative Ideas
- ▶ Leadership Simulations
 - ▶ Newsletter Sign-up
 - ▶ Site Map
 - ▶ Contact Us
 - ▶ Privacy Policy

Search Our Site

Establishing Credibility

Business Challenge

Credibility is essential for managers in an environment in which success requires quick action, rapid changes, and fast results. But business volatility over the past 20 years - reorganizations, mergers, acquisitions, and right-sizing has diminished employee trust and confidence in managers, resulting in a workplace characterized by increasing cynicism. While credibility is more important than ever, it is no longer considered an entitlement. It does not automatically come with a title, degree, or seniority; instead, it must be earned. So, for managers both new and experienced, the time to start building or rebuilding credibility is now.

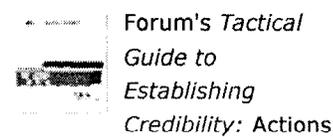
Establishing Credibility

The Establishing Credibility leadership development program teaches managers and leaders how to establish or rebuild credibility in order to dramatically increase their effectiveness. Built on a researched set of practices, the module provides managers with confidential feedback as well as a blueprint for enhancing their personal credibility in the workplace.

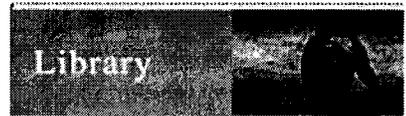
Key Content

Establishing Credibility addresses the following key content areas:

- The Credibility Model and Practices: The research-based model incorporates four essential components that



your leaders can take to achieve, re-establish, or enhance credibility within your organization



A compilation of Forum's ongoing research and thought-leadership in the areas of leadership development, sales, service and customer loyalty.

- ▶ Research Papers
- ▶ Case Studies
- ▶ Tools & Assessments
- ▶ White Papers

managers must demonstrate to achieve credibility in today's workplace: consistency, competence, concern, and commitment. The model presents 20 leadership development practices that capture the critical behaviors and actions necessary for success.

- **Confidential Feedback:** Managers receive confidential feedback from employees and colleagues on the importance of and the extent to which they demonstrate the 20 credibility practices. The feedback report provides specific, valuable information that guides managers action planning for enhancing their credibility.
- **Methods for Demonstrating Concern:** Tools that focus on enhancing credibility being attentive, listening, questioning, and following up are discussed.
- **Action Planning Tools:** Approaches for securing credibility in three different contexts: getting started (in the first 90 days), restarting (at times when credibility has been lost), and maintaining credibility (over time). Opportunities for practical application of these approaches are provided.

Target Audience

The Establishing Credibility leadership development session is ideal for both new and experienced managers and professionals whose credibility is essential to their effectiveness in the workplace.

Outcomes

Participants in Establishing Credibility will be able to:

- Build and execute plans that deal with specific, personal credibility issues identified by associate feedback
- Establish and maintain credibility by taking personal accountability in the face of workplace realities that can erode credibility

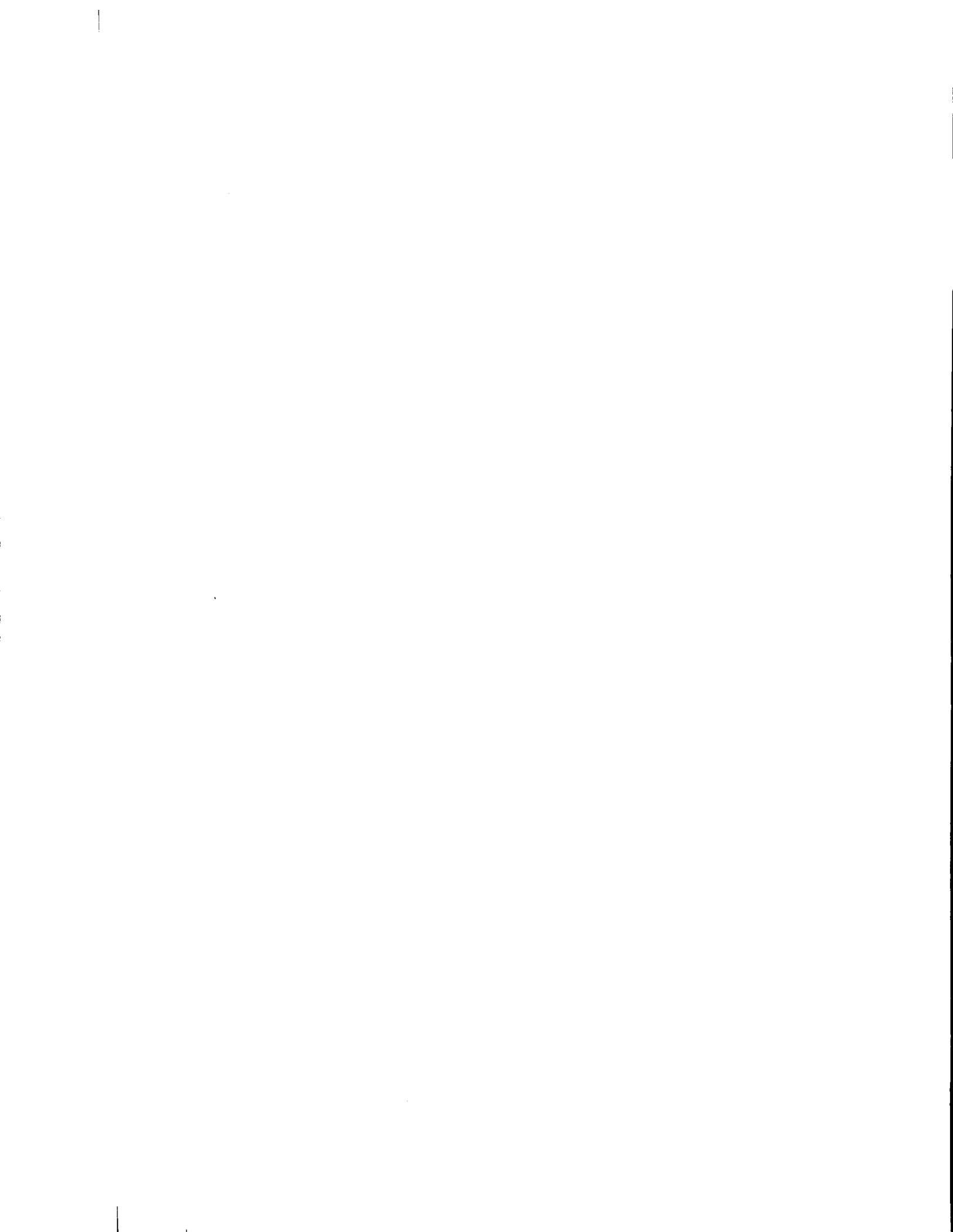
Establishing Credibility typically includes 7 hours of classroom learning, as well as tools for on-the-job reinforcement. It may be customized to drive specific business issues.

For More Information on Leadership Development

please call one of [Forum's global offices](#) or submit your information request [here](#).



©Copyright 2004 The Forum Corporation All Rights Reserved
Home | [About Forum](#) | [Leadership Development](#) | [Customer Loyalty](#) | [Sales Force Effectiveness](#) |
[Library](#) | [News](#) | [Events](#) | [Site Map](#) | [Contact Us](#)





Strategy and services for knowledge intensive business.

High Performance Consulting – High Performance Computing

Strategic Technology Planning
 Business Intelligence Systems
 Research Support Services

[Home](#)

[Strategy](#)

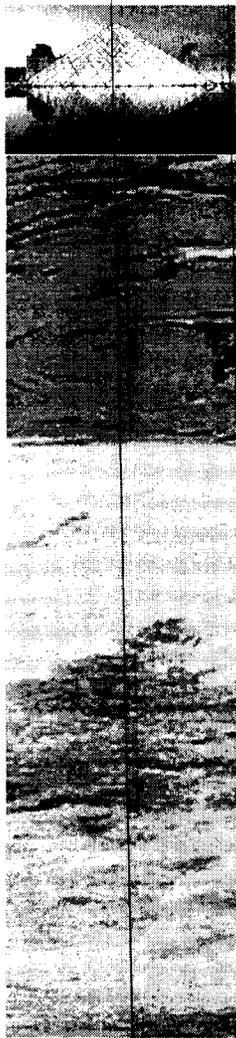
[Systems](#)

[Support](#)

[Resources](#)

[Careers](#)

[About](#)



Navigate
 the information ocean.

Chart unlimited information channels

Correlate internal and external
 knowledge

Anticipate and adapt to subtle change

Outpace
 the competition.

Delivering *intelligence* and *action* on complex customer, competitive and operational problems.

HPC – High Performance Consulting. Leverage creativity, improve service, and build new competencies that exceed the boundaries of your organizations knowledge skills, and experience.

HPC – High Performance Computing. Optimize analysis capability – model, visualize and forecast the flows, patterns, and trends that impact business strategy and real-time operations.

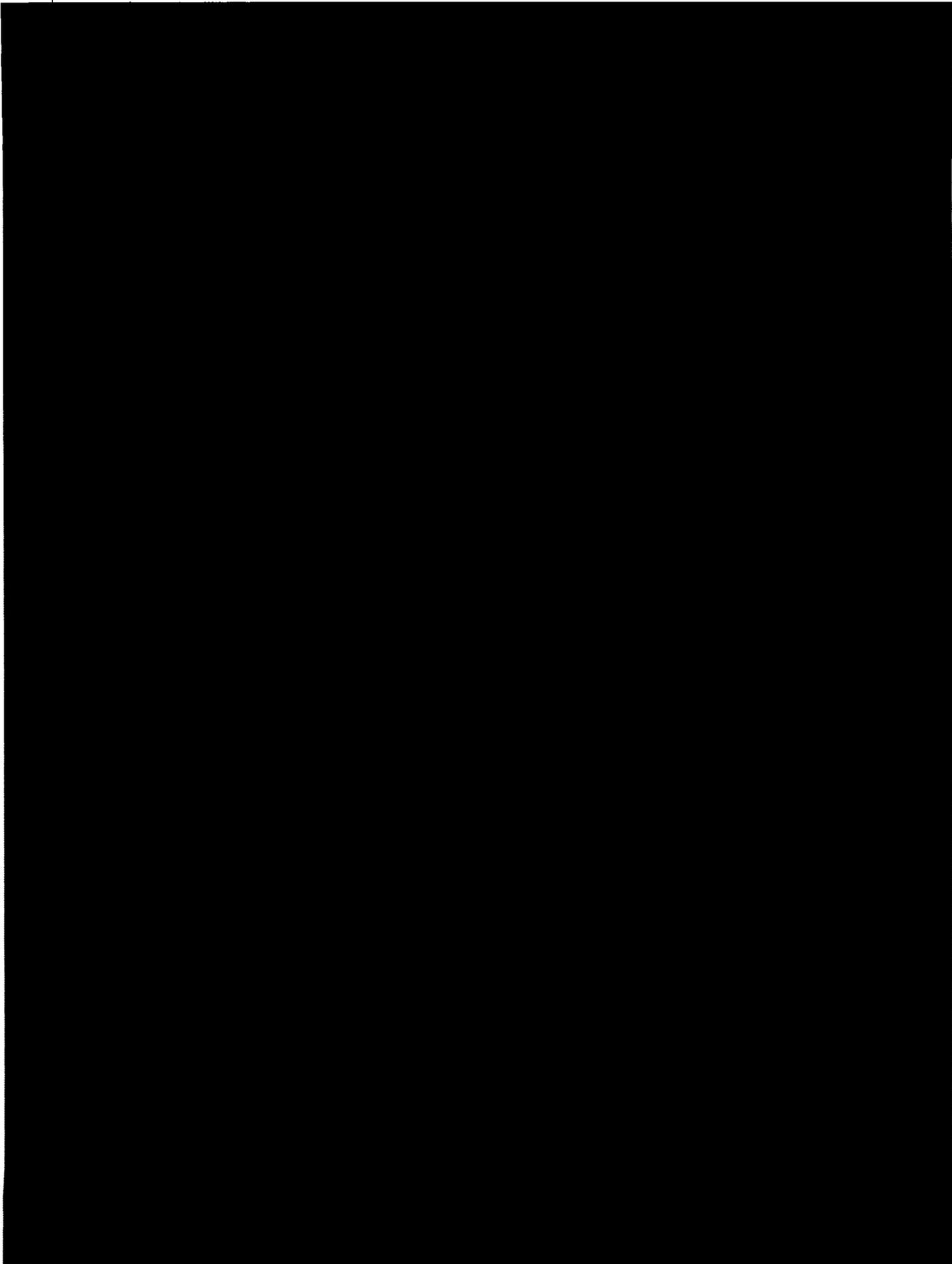
Espial HPC. Incorporated
hpcstrategy@espial-hpc.com

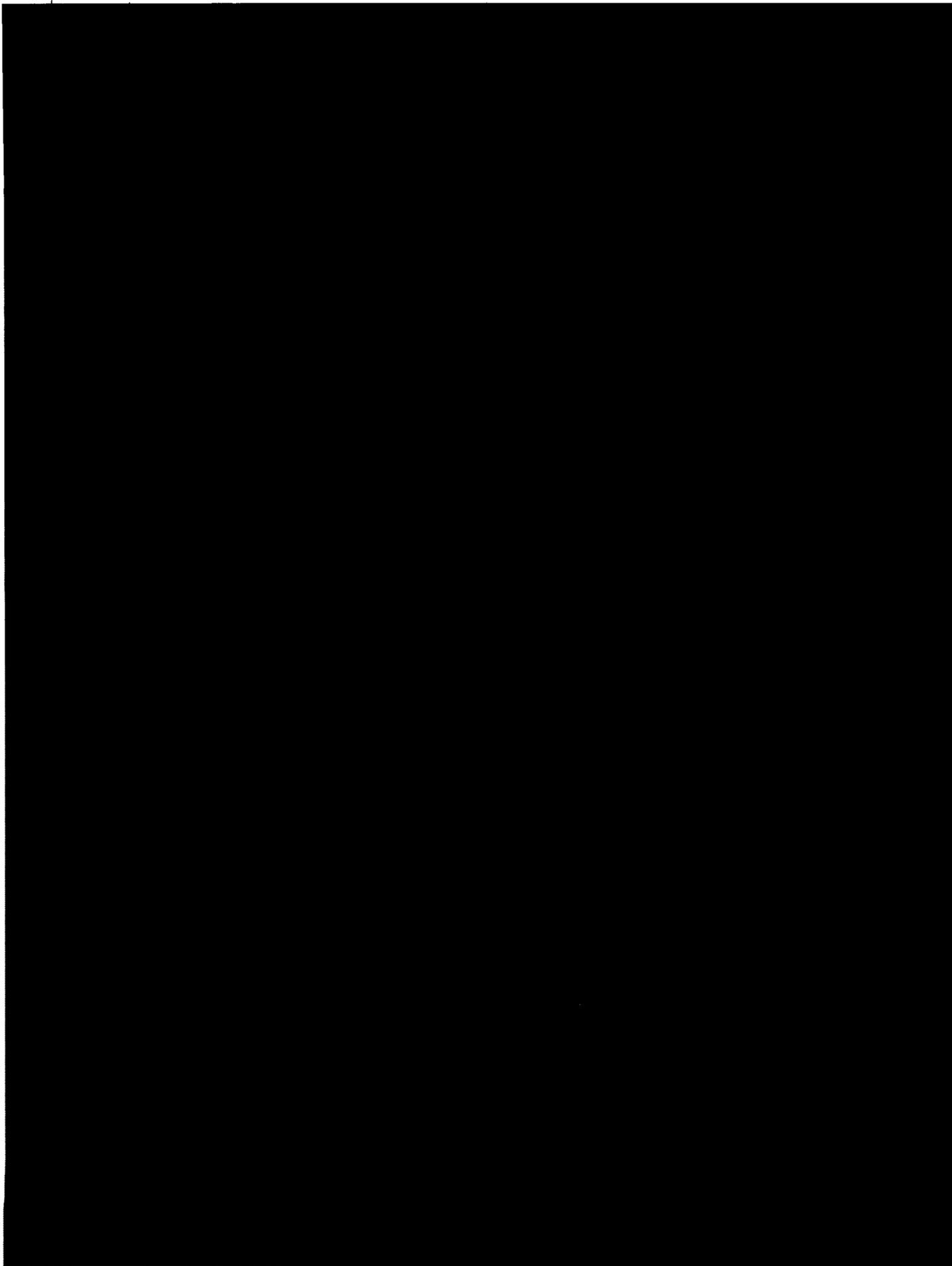
Espial – Noun: The Act of Noting, Observing, or Taking Into Account.

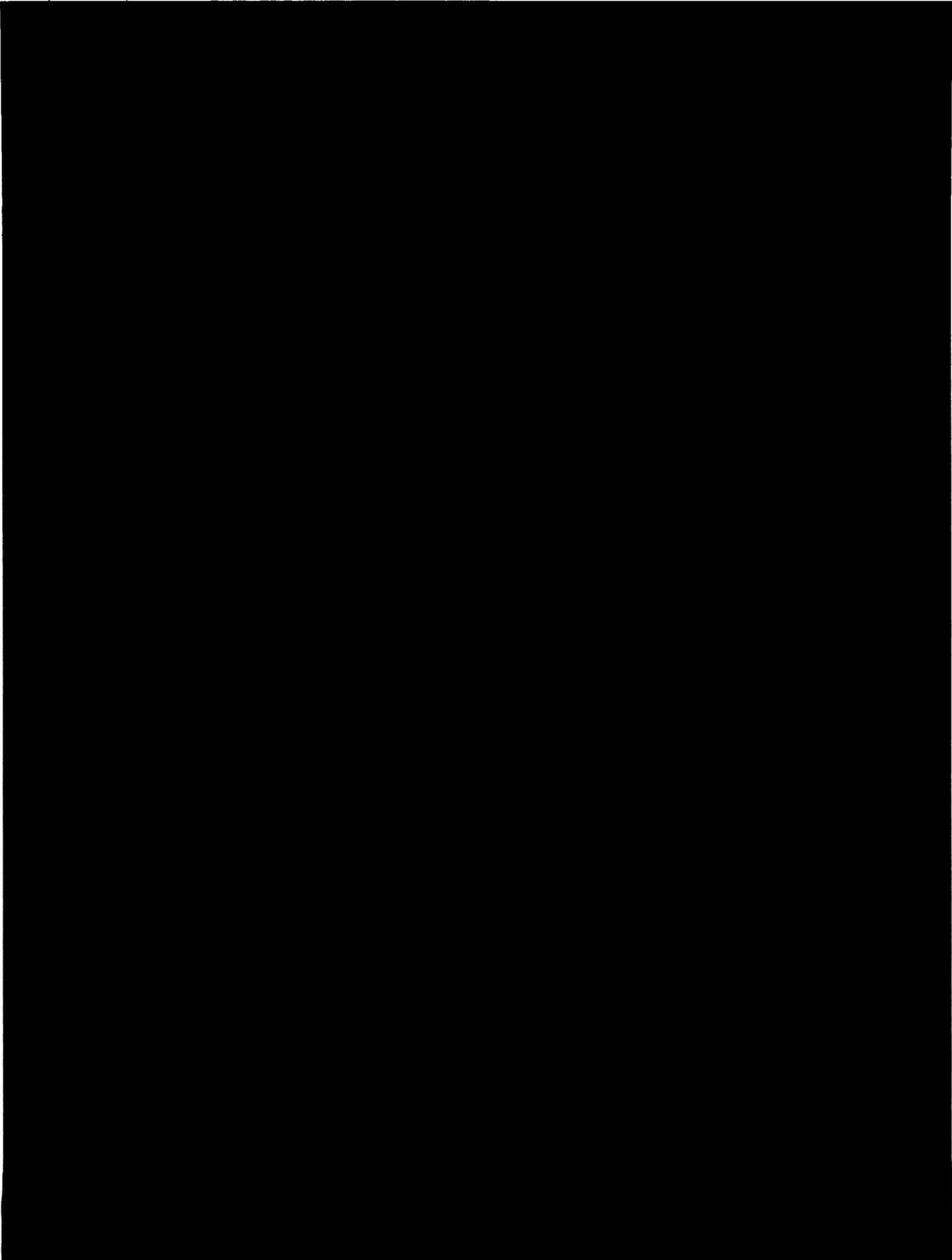
All trademarks are the property of their respective owners.

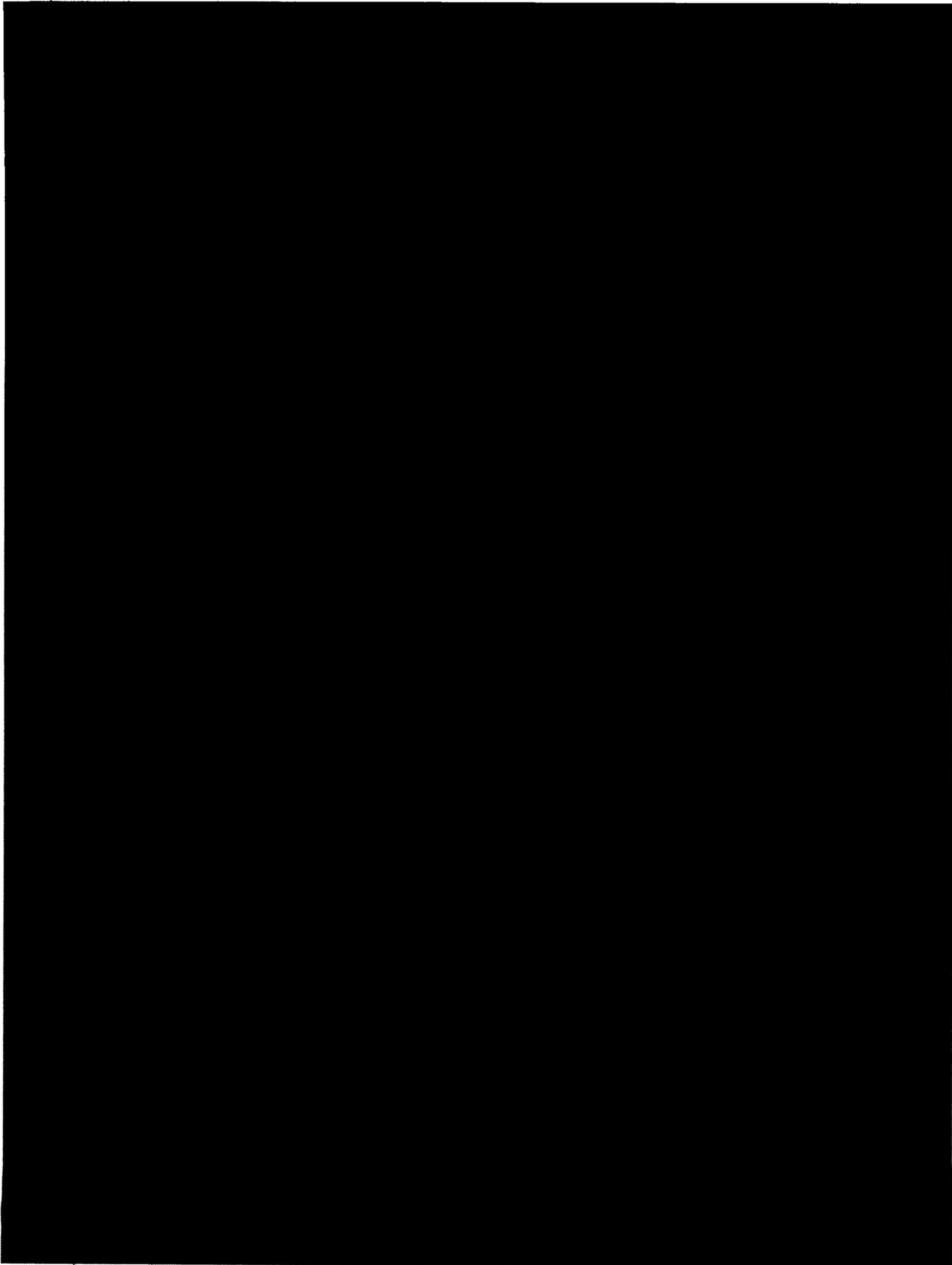
Copyright © 2002 - 2004 Espial HPC. Inc.

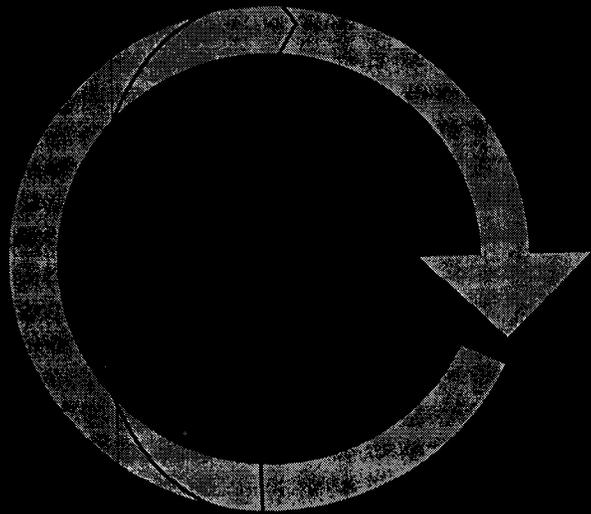


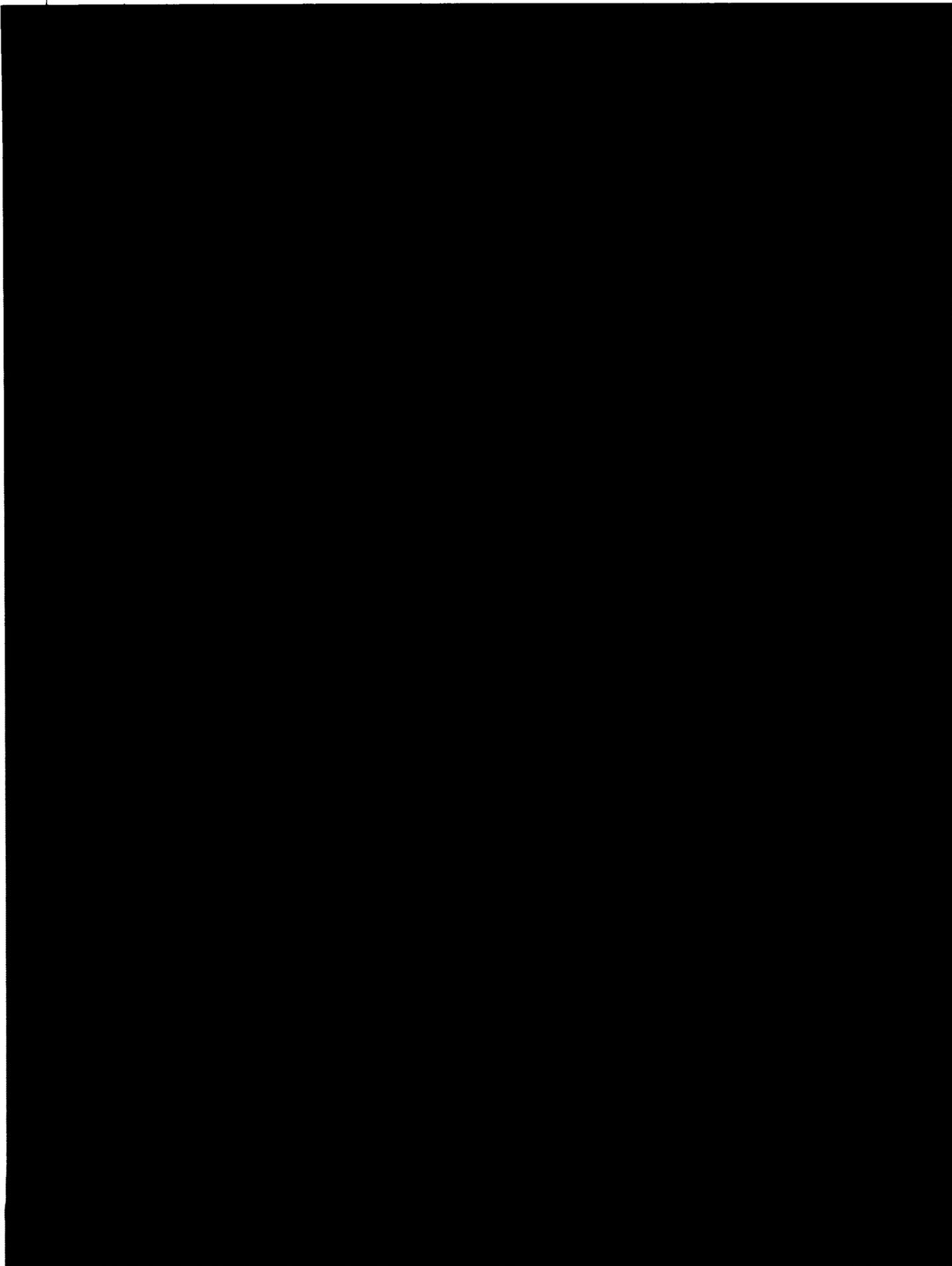












Company X

Operations

F&A

Sales

Marketing

Product Dev

UK

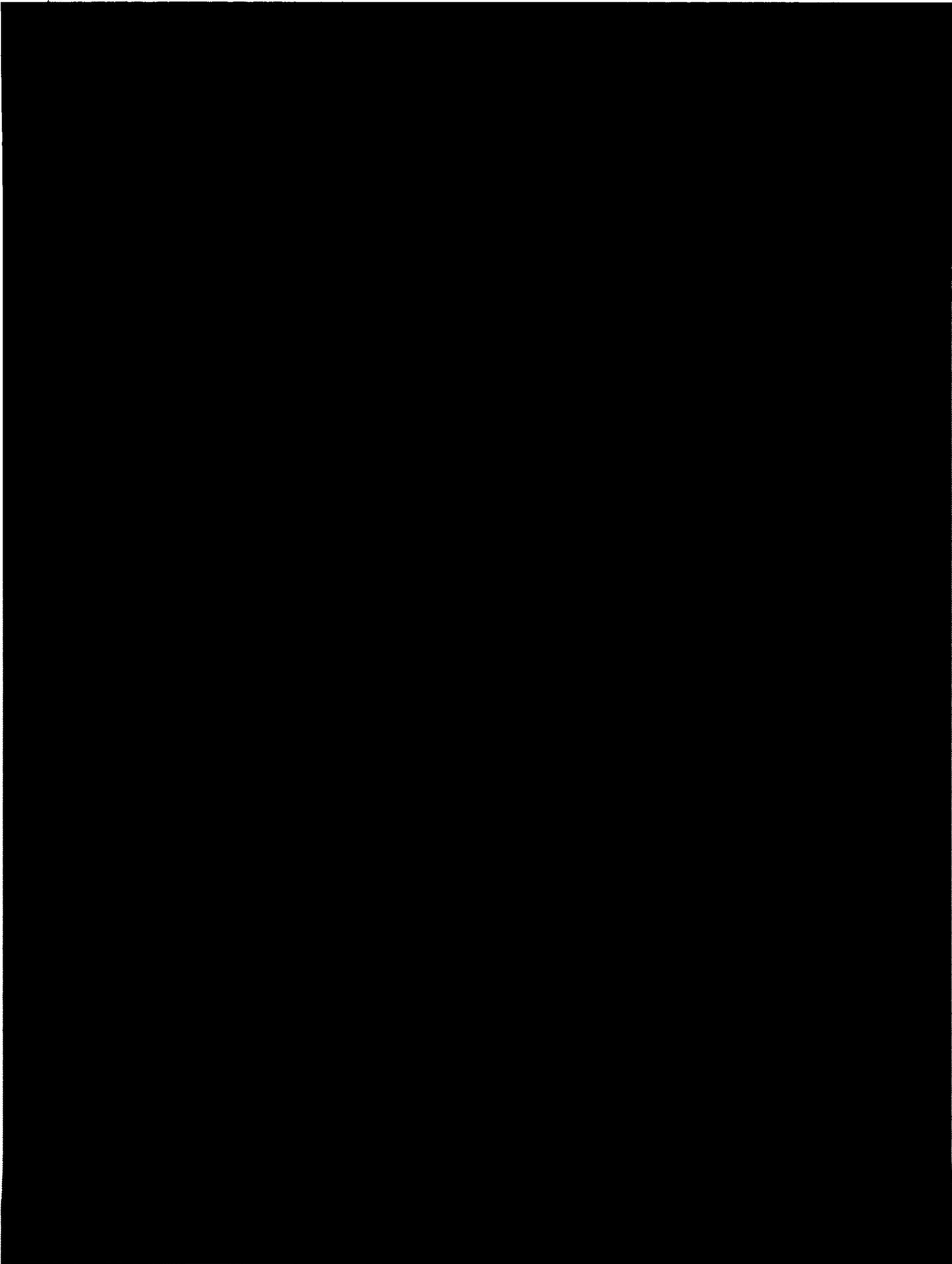
West

East

UK Dev

QA

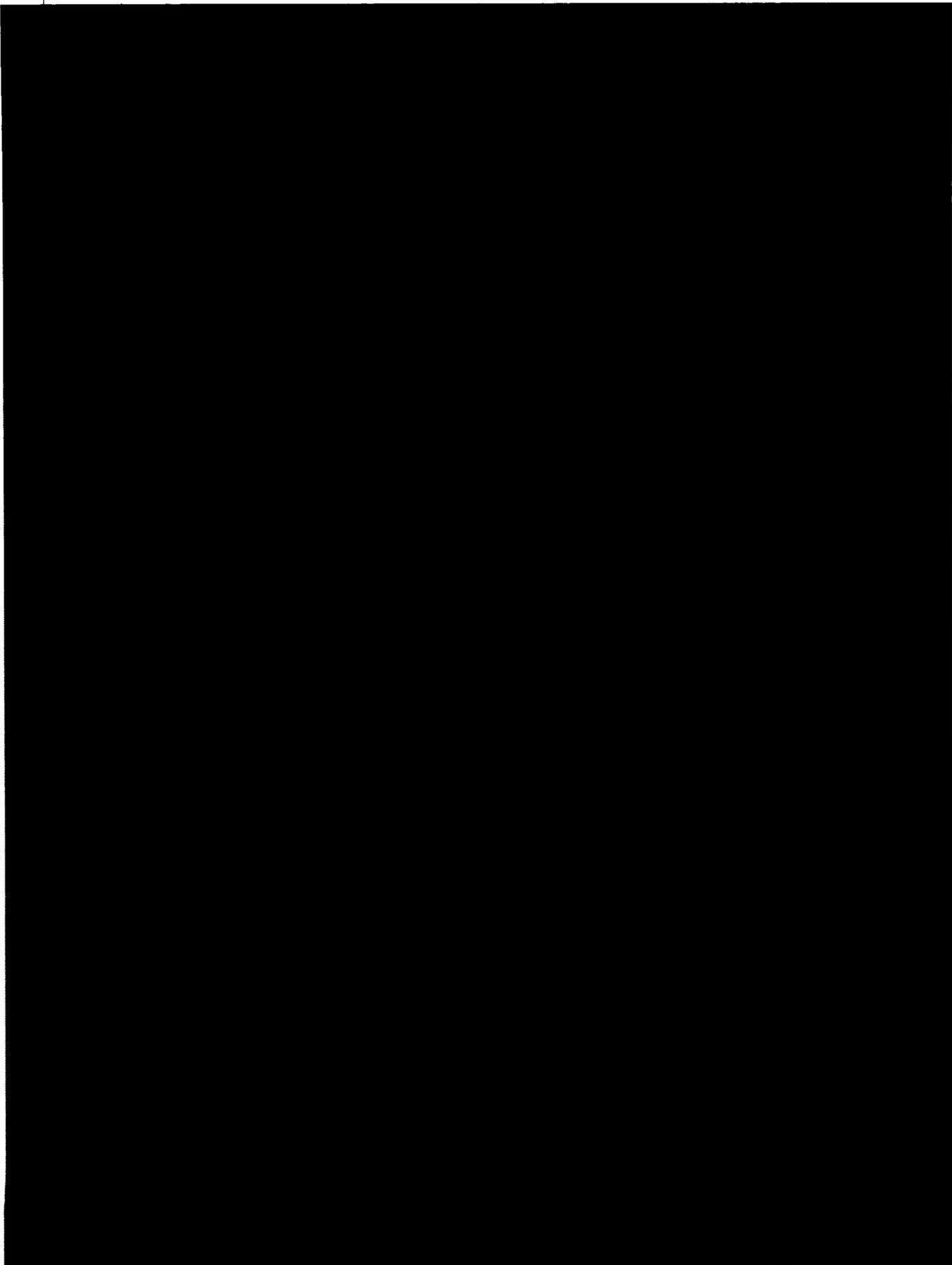
Development

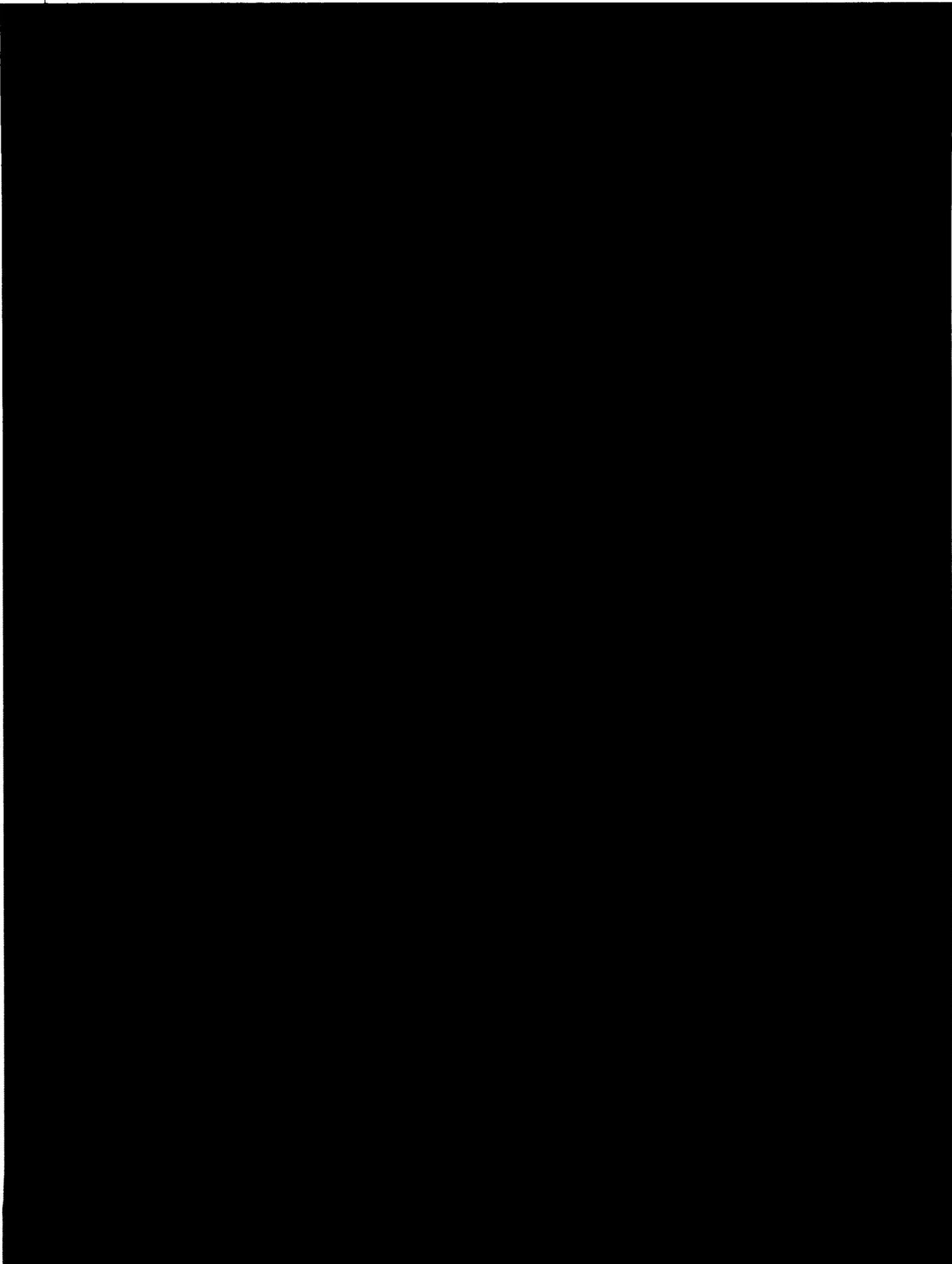


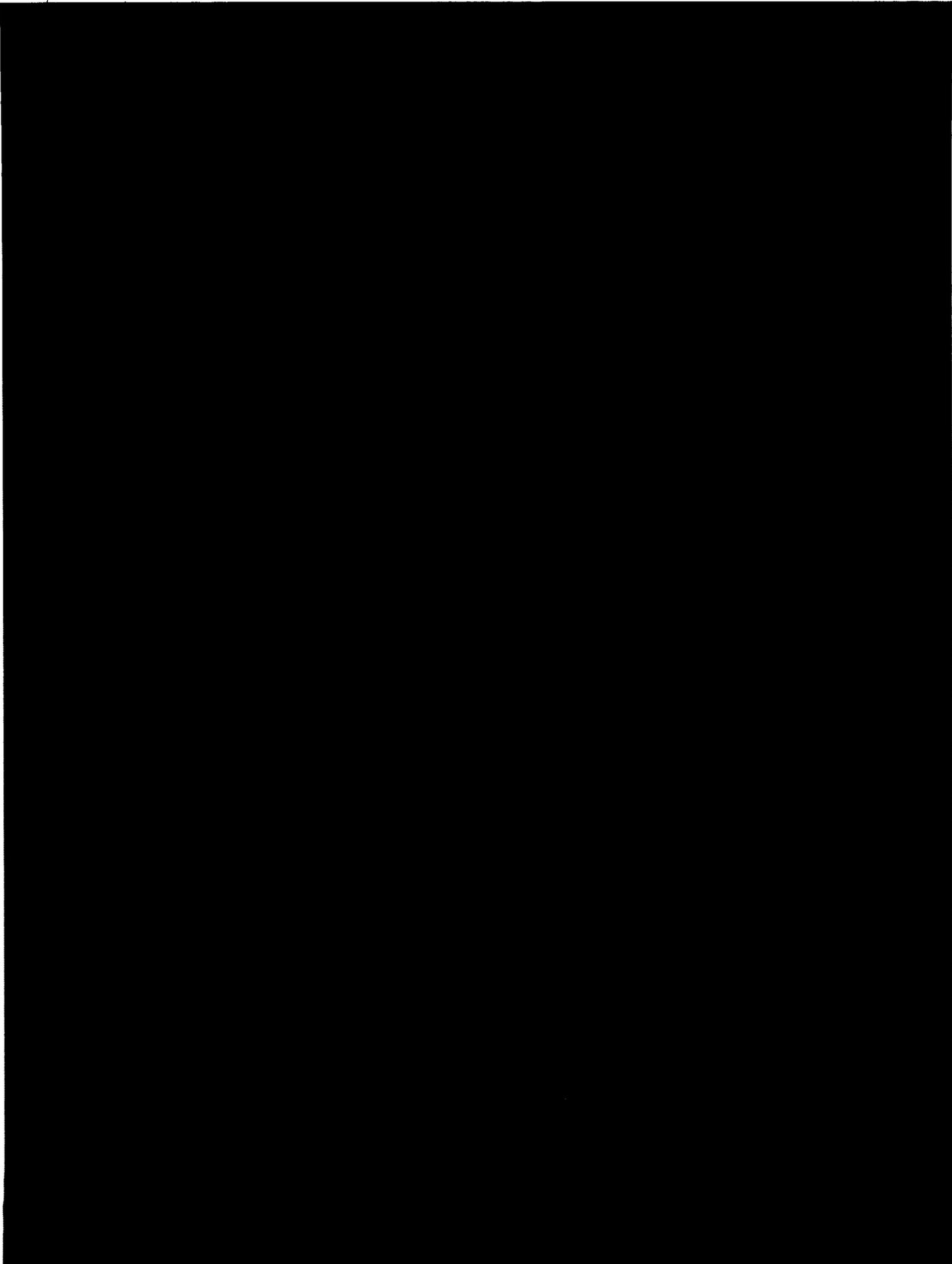
- Compensation
- Salaries
- Benefits Expense
- Bonuses
- Recruiting Fees
- Hardware Expense
- Software Expense
- Marketing
- Advertising
- Public Relations
- Travel & Entertainment
- Air
- Hotel
- Meals
- Ground Transportation
- Office Supplies
- Facilities Expense
- Rent
- Janitorial Services
- Utilities
- Telecommunications
- and so on...

- Compensation
- Consultants
- Hardware Expense
- Software Expense
- Travel & Entertainment
- Telecommunications

- Compensation
- Advertising
- Public Relations
- Travel & Entertainment
- Telecommunications







Bookings (Calculated)							
<u>Customer</u> List	<u>Product/Service</u> List	<u>Sales Rep/Territory</u> List	<u>Region</u> List	<u>Channel</u> List	<u>Jan</u> Price[Jan]* Units[Jan]* Discount[Jan]	<u>Feb</u> Price[Feb]* Units[Feb]* Discount[Feb]	<u>Mar</u> Price[Mar]* Units[Mar]* Discount[Mar]

Revenue (Calculated)								
<u>Customer</u> One line for each combination of Customer, Product, Sales Rep, Region, Channel, and Booking Month.	<u>Product/Service</u>	<u>Sales Rep/Territory</u>	<u>Region</u>	<u>Channel</u>	<u>Booking Month</u>	<u>Jan</u> apply Rev Rec Pattern selected in Qty/unit to the Combination selected with a Booking Month of Jan	<u>Feb</u> continue to apply Rev Rec Pattern selected to Bookings[Jan] if applicable	<u>Mar...</u>
					Jan	0	continue to apply Rev Rec Pattern selected to Bookings[Jan] if applicable	
					Feb		continue to apply Rev Rec Pattern selected to Bookings[Jan] if applicable	

Standard Cost

Product	Jan	Feb	Mar
list	formula	formula	formula

Inventory Units Produced/Acquired

Product	Jan	Feb	Mar
list	formula	formula	formula

Name	Salary	Start Date	End Date	Date
Joe	\$60,000	Jan 03	none	r 03
Admin	\$30,000	Mar 03	none	

Name	Salary	Jan	Feb	Mar	Apr
Joe	\$60,000	\$5,000	\$5,000	\$5,000	\$5,000
Admin	\$30,000		\$2,500	\$2,500	\$2,500
Total Salary		\$5,000	\$5,000	\$7,500	\$7,500
Taxes and Benefits		\$1,000	\$1,000	\$1,500	\$1,500
Total Compensation		\$6,000	\$6,000	\$9,000	\$9,000

	Jan	Feb	Mar	Total
Compensation				
Consultants				
HW				
SW				
T&E				
trips per month				
cost per trip	\$1,500			
Telecommunications				
Total				

= StaffCount[Dev,Jan]
 *TelecomCost[Dev,Jan]



Company Plan

[Redacted]

[Redacted]

Marketing

[Redacted]

Marcom
m
m

Marcom

[Redacted]

[Redacted]

Trade Shows

PR

Advertising

Company X

Development
Product Dev
Marketing
Sales
UK Dev
QA
West
UK
East

Company X

Product Dev
Development
Product Dev
Marketing
Sales
UK
West
UK
East
Dev
Sales

Company X

Operations

R&A

Sales

Marketing

Product Dev

UK

West

East

UK Dev

QA

Development

Company X

Product Dev

Marketing

Sales

R&D

Operations

Development

QA

UK Dev

East

West

UK

Product 1

Product 2

Company X

Product Dev

Marketing

Sales

IT & A

Operations

Development

QA

ITK Dev

East

West

UK

Product 1

Project 1

Close Books for Period
(Mo., Qtr., Year) in GL

GL Data Uploaded
to Adaptive Planning

Dept. Managers Notified that
Variance Reports Available for Review

Dept. Managers Review Variances

- Drill Down to Transactions Detail as Desired
- Input Comments
- Modify Plan Data as Appropriate

Consolidated Forecast of Financial Statements
and Departmental Budgets Reviewed

