

ESTTA Tracking number: **ESTTA152499**

Filing date: **07/23/2007**

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

Proceeding	76127133
Applicant	DIGITAL OILFIELD INC
Applied for Mark	DIGITAL OILFIELD
Correspondence Address	THOMAS J. MOORE BACON & THOMAS PLLC 625 SLATERS LN FL 4 ALEXANDRIA, VA 22314-1176 UNITED STATES
Submission	Reply Brief
Attachments	2007.07.23.Reply Brief.pdf (8 pages)(73093 bytes)
Filer's Name	Thomas J. Moore
Filer's e-mail	tjmoore@baconthomas.com, pmiles@baconthomas.com
Signature	/Thomas J. Moore/
Date	07/23/2007

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

Application Serial No.:	76127133
Application Filing Date:	September 14, 2000
Mark:	DIGITAL OILFIELD
Owner/Applicant:	Digital Oilfield Inc.
Attorney's Reference:	DIGI6002/TJM

REPLY BRIEF

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

Thomas J. Moore
Applicant's Attorney

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: 703-683-0500
Fax: 703-683-1080
E-mail: mail@baconthomas.com

TABLE OF CONTENTS

<u>Item</u>	<u>Page(s)</u>
TABLE OF AUTHORITY	ii
INDEX OF CASES AND AUTHORITIES	iii
ARGUMENT	1
I. THE LEGAL STANDARD IS CLEAR.	1
II. THE OFFICE HAS NOT MET ITS BURDEN TO PROVE THE GENUS.	2
III. THE OFFICE HAS NOT MET ITS BURDEN TO PROVE THE UNDERSTANDING OF THE GENERAL PUBLIC.	3
CONCLUSION	5

REPLY BRIEF
U.S. Application No. 76127133

TABLE OF AUTHORITY

<u>Cases</u>	<u>Page(s)</u>
<i>American Fertility Society, In re the,</i> 188 F.3d 1341 (Fed. Cir. 1999).	1
<i>H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.,</i> 782 F.2d 987 (Fed. Cir. 1986).	1
<i>Merrill Lynch, Pierce, Fenner & Smith Inc., In re,</i> 828 F.2d 1567 (Fed. Cir. 1987).	2
<u>Statutes</u>	<u>Page(s)</u>
15 U.S.C. §1064(3) (1999).	1
<u>Other</u>	<u>Page(s)</u>
Trademark Manual of Examining Procedure (TMEP) §1209.01(c)(i) (April, 2005).	1

ARGUMENT

I. THE LEGAL STANDARD IS CLEAR.

The U.S. Court of Appeals for the Federal Circuit has stated that “the correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of the genus of goods or services at issue and the understanding by the general public that the mark refers primarily to that genus of goods or services.” *In re the American Fertility Society*, 188 F.3d 1341, 1347 (Fed. Cir. 1999), citing in *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir. 1986). None of the cases cited in the Examining Attorney’s Appeal Brief overturn this test. This test is consistent with the statute, for example, “The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” 15 U.S.C. §1064(3) (1999).

The Examining Attorney's Appeal Brief do not deny that “The examining attorney has the burden of proving that a term is generic by clear evidence.” Trademark Manual of Examining

REPLY BRIEF
U.S. Application No. 76127133

Procedure (TMEP) § 1209.01(c)(i) (April, 2005), citing *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567 (Fed. Cir. 1987).

II. THE OFFICE HAS NOT MET ITS BURDEN TO PROVE THE GENUS.

The present record does not meet the heavy burden on the U.S. Patent and Trademark Office to prove the genus. The Examining Attorney's Appeal Brief states at pages 1-2, that the genus is the goods and services of the present application. However, on page 3 of the Examining Attorney's Appeal Brief, the genus is alleged to be "an industry-wide implementation of technology and services" Moving on to page 4 of the Examining Attorney's Appeal Brief, the genus is alleged to be "oil industry technology, business initiatives, business projects, business programs and business communications."

Applicant maintains that "oil industry technology" is oil industry technology, not "digital oilfield." Applicant maintains that "business initiatives" are business initiatives, not "digital oilfield." Applicant maintains that "business projects" are business projects, not "digital oilfield." Applicant maintains that "business programs" are business programs, not "digital oilfield." Applicant maintains that "business communications" are business communications, not "digital oilfield."

REPLY BRIEF
U.S. Application No. 76127133

III. THE OFFICE HAS NOT MET ITS BURDEN TO PROVE THE UNDERSTANDING OF THE GENERAL PUBLIC.

The present record does not meet the heavy burden on the U.S. Patent and Trademark Office to prove the understanding of the general public. The Examining Attorney's Appeal Brief points to a number of the attachments to the Office Action dated March 31, 2005 (which was date stamped "April 1, 2005," as received by the undersigned on April 4, 2005). Unfortunately, these attachments are not page numbered.

The Examining Attorney's Appeal Brief at page 3, refers to an article titled "Business Program Management for the Digital Oilfield" as appearing on page 2 of the Office Action. This is not on the second page of the attachment to the Office Action as received by the undersigned. However, there is an article that appears to be a reproduction of a web page, with the first paper page including "JPT online" and "December 2004." The authors are stated to be Dutch Holland who is the founder of "a management services firm serving the energy industry," and Mike Campbell "whose speciality is performance consulting and implementation of project management in technical environments in the energy business." Thus, both of the authors are consultants. They are not customers or potential customers of the goods and services of the present application.

This article uses "digital oilfield" to describe initiatives ("strategic changes are digital oilfield initiatives" and "to make better sense out of digital oilfield and other initiatives" appear in the final

REPLY BRIEF
U.S. Application No. 76127133

two paragraphs on the first paper page of this article). On the second paper page of the article, in the second paragraph after the heading “The Three Horsemen of Effective Change,” the term “digital oilfield” is used to describe an “era” (“program management is about making a company’s vision for the digital oilfield era more than a fascination with technology”). Thus, this article uses “digital oilfield” as an adjective to describe types of initiatives and eras, and does not use it to describe the goods and services of the present application, much less use it as a generic term for the goods and services of the present application.

The Examining Attorney’s Appeal Brief discusses some of the other attachments to the Office Action dated March 31, 2005. It is not immediately clear to the undersigned which of the attachments are discussed, because of the lack of page numbering. However, none of the attachments show the understanding of the general public.

For example, “Attachment #7” comprises a single page which appears to be a printout of a web page with a heading “GSW GeoScienceWorld.” The title of the article is “Managing the journey to the digital oil field.” The author is “Dutch Holland” who appears to be the same Dutch Holland as discussed above. The article includes the statement that “the digital oil field (DOF) is not about showy technology but is a long-term process of discovery, trial, adoption, and exploitation, driven by often intense pressure for growth and profits.” Thus, this article uses “digital oil field (DOF)” to describe a process not any particular goods or services, much less to identify a genus of

REPLY BRIEF
U.S. Application No. 76127133

goods and services. The author does not appear to be a customer or potential customer of the goods and services of the present application, but is a consultant.

The mark is not generic.

CONCLUSION

Applicant respectfully submits that the application should be approved for registration because the mark is capable of distinguishing the goods and services.

Respectfully submitted,



Thomas J. Moore
Applicant's Attorney

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: 703-683-0500
Fax: 703-683-1080
E-mail: mail@baconthomas.com
Date: July 23, 2007

S:\Producer\tjm\ep\DIGI6002\2007.07.23.Reply Brief.wpd