To:	Capitol Indemnity Corporation (jbyrne@boardmanlawfirm.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 77615599 - SURETY ONLINE. ANYTIME. - 27617-20
Sent:	10/12/2010 7:47:28 PM
Sent As:	ECOM111@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77615599

MARK: SURETY ONLINE. ANYTIME.

77615599

CORRESPONDENT ADDRESS:
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CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/teas/eTEASpageD.htm

APPLICANT: Capitol Indemnity Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:
27617-20
CORRESPONDENT E-MAIL ADDRESS:
jbyrne@boardmanlawfirm.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 10/12/2010

This letter is in response to the office action received from applicant on October 5, 2010. Applicant has argued against the refusal to register under Section 2(e)(1) and in the alternative has asserted its claim of acquired distinctiveness under Section 2(f). Applicant contends that the Examining Attorney denied its request for reconsideration on the issue of descriptiveness without considering its extra evidence. The

additional evidence submitted with the request for reconsideration was considered and found unpersuasive because it was more of the same type of evidence submitted in the response to the first office action. The request for reconsideration was granted to consider applicant's claim of distinctiveness. That is the only issue that will be addressed in this office action.

SECTION 2(E)(1) FINAL REFUSAL CONTINUED - AMENDMENT UNDER SECTION 2(F) DENIED

In the prior office action, applicant was advised that an intent to use application required specific showings for acquired distinctiveness. Applicant indicates that it wishes to base its acquired distinctiveness on use of its mark in commerce without first filing an allegation of use. Whether acquired distinctiveness has been established is a question of fact. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir. 1985), and cases cited therein. The record must contain facts or evidence of acquired distinctiveness. The burden of proving that a mark has acquired distinctiveness is on the applicant. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959). Three basic types of evidence may be used to establish acquired distinctiveness under §2(f):

> (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (*see* 37 C.F.R. §2.41(b); TMEP Section 1212.04 *et seq.*);
>
> (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(b); TMEP Section 1212.05 *et seq.*); and
>
> (3) Actual evidence of acquired distinctiveness (*see* 37 C.F.R. §2.41(a); TMEP Section 1212.06 *et seq.*).

Applicant is not alleging claim of ownership of a prior registration or long use of the mark to support its allegation of acquired distinctiveness. Applicant relies on actual use of the mark. Applicant contends its mark has acquired distinctiveness because of its "substantially exclusive and continuous use in commerce of the mark." However, applicant has not filed a verified allegation of use in this application.

While applicant's use appears to be substantially exclusive, its does not appear to have been used long enough to have acquired secondary meaning. To support its "substantially exclusive use" claim, applicant refers to copies of search results retrieved from GOOGLE search engine contained in its response dated

March 15, 2010. A GOOGLE search for the phrase "surety online anytime" produced sixty-one (61) search results. According to applicant, each referred to applicant and its surety services and none of the results referenced any other party. This evidence is of little probative value because it is a list of Internet search results which does not show the context in which the term is used on the listed web pages. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (GOOGLE® search results that provided very little context of the use of ASPIRINA deemed to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (truncated Google® search results entitled to little probative weight without additional evidence of how the searched term is used); *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) (Board rejected an applicant's attempt to show weakness of a term in a mark through citation to a large number of GOOGLE® "hits" because the "hits" lacked sufficient context); *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002).

Applicant asserts "continuous use" of the mark by relying on two copies of its newsletters, dated August, 2009 and May 2010 touting the success of its services. The newsletter entitled CAPITOL SURETY NEWS, dated August 2009, Volume 1, Issue 1, announces a new bond system known as Capital Express (CapEx). The only mention of "SURETY ONLINE. ANYTIME" is in the lower right corner where the mark is buried in very small letters underneath the much larger mark, CAPITAL EXPRESS. As used in the newsletters, "SURETY ONLINE. ANYTIME." is an advertising tagline describing applicant's CAPITAL EXPRESS "automated, online underwriting bond issuance system." That is, CAPITAL EXPRESS is "SURETY ONLINE. ANYTIME" (i.e., an online insurance guarantee accessible at anytime). In other words, "SURETY ONLINE. ANYTIME" will not be recognized as a service mark because it is used descriptively rather than as a source indicator. Moreover, two newsletters nine months apart are not sufficient evidence from which the PTO can infer that there is any consumer recognition of applicant's mark. Unverified use for one year does not establish long continuous use of a mark. Moreover, the use of the mark in applicant's newsletters does not constitute a wide distribution of information to support consumer recognition. A newsletter is limited to the parties on applicant's mailing addresses. A newsletter does not reach a broad spectrum of financial consumers.

Finally, as further proof that secondary meaning has not been established, applicant has provided no verified allegation of use, no evidence of advertising expenditures, no market share studies, no evidence of geographic trading area, no survey evidence, no market research or consumer reaction studies.

Applicant has not met its burden of proof to support a claim of acquired distinctiveness. The amendment to Section 2(f) is denied.

The file will now be returned to the Trademark Trial and Appeal Board for resumption of the appeal instituted on March 16, 2010.

/Margery A. Tierney/
Margery A. Tierney
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Law Office 111
Phone: 571-272-9234

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at http://teasroa.uspto.gov/roa/. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

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IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON 10/12/2010 FOR SERIAL NO. 77615599

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this **link** **or** go to **http://portal.uspto.gov/external/portal/tow** and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable **response time period**. Your response deadline will be calculated from 10/12/2010 (or sooner if specified in the office action).

Do NOT hit "Reply"to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.

HELP: For *technical* assistance in accessing the Office action, please e-mail **TDR@uspto.gov**. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.