
To: PrintCo., Inc. (mtrudell@sheridanross.com)
Subject: TRADEMARK APPLICATION NO. 78155673 - ENKLAVVOICE - 4081-131
Sent: 9/21/2005 11:42:48 AM
Sent As: ECOM101@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 78/155673**APPLICANT:** PrintCo., Inc.**CORRESPONDENT ADDRESS:**

Miriam D. Trudell
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1560 Broadway, Suite 1200
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RETURN ADDRESS:

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

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: ENKLAVVOICE**CORRESPONDENT'S REFERENCE/DOCKET NO:** 4081-131

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

mtrudell@sheridanross.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/155673

DENIAL OF REQUEST FOR RECONSIDERATION

Applicant is requesting reconsideration of a final refusal dated April 25, 2005.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

SPECIMEN OF USE UNACCEPTABLE

The applicant was previously required to submit an acceptable specimen of use showing the mark used in connection with the recited services as a service mark. The applicant continues to rely on its original specimen submitted with the Statement of Use of July 7, 2004. The applicant's request for reconsideration sets forth the following arguments in support of registration.

The Applicant submits "that a specimen showing advertising for a service mark is acceptable. TMEP

1301.04. The fact that Applicant's Specimen is an advertisement, therefore, does not preclude the Specimen from being acceptable to prove use for Applicant's services, provided the Specimen meets all other criteria." Applicant's Request for Reconsideration, p. 2.

The examining attorney agrees that an advertisement is an acceptable form of a specimen of use of a mark in connection with services. However, the mere fact that the mark appears on the advertisement does not automatically render such an advertisement an acceptable specimen of use of the mark *as a service mark*. To show service mark usage, the specimens must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the services were advertised in the same brochure in which the name of the process was used); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART perceived as informational matter rather than as service mark for art dealership services, where the term is displayed inconspicuously in specimen brochure amid other informational matter, in the same size and font as the rest of the brochure text); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimens, found to identify the applicant's ratings instead of its rating services); TMEP Section 1301.04(a).

The present issue is not whether the advertisement shows the mark but rather whether the mark is used as a service mark in connection with the recited services. Would potential purchasers, upon viewing the mark in its present context, understand that the mark indicates the source of particular services. i

The applicant also submits that "[i]n determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant's explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used." TMEP Section 1301.04(b). The applicant requests that the examining attorney consider the following:

Applicant's ENCLAVTDW [sic] family of marks including ENKLAVVOICE [sic], provide services for "content management and dynamic publishing systems]" via "browser based collaboration tools." Specimen, page 1. ENCLAVTDW [sic] and family of marks, including ENCLAYVOICE [sic], allows users to "aggregate, organize, authorize and publish content on demand. Images and text can be re-expressed through customized templates for a variety of media." Specimen, page 2. Accordingly, users use the service to ensure consistency of use of "pricing, product images and descriptions, legal boilerplates, and logos" in "sales kits, catalogs, direct mail, brochures and webpages" between various vendors or departments such as "brand designers, designers, brand channels, and vendors." Specimen, page 2. The ENKLAVVOICE [sic] services specifically allows users to "create, populate, approve and manage a digital warehouse of sales and marketing information. EnclavVoice aggregates all forms of text, data, and images and administers content approvals." Specimen, page 2. In other words, Applicant's customers can subscribe to Applicant's service to create advertisements for their own businesses.

Applicant's Request for Reconsideration, pp 2-3.

Just as the applicant submits, the specimens do not specifically indicate that services are provided. The applicant clarifies this lack of specificity by indicating the services are implied "[i]n other words." The specimen on its face does not offer services of any kind. If a potential purchaser has to undertake further research or investigation to determine the nature of the applicant's activities, or read the text with an understanding of the applicant's business acquired elsewhere, the specimen is not evidence of proper service mark use as the mark is not serving as a source indicator of particular services. Reading solely within the four corners of the document as presented, potential purchasers would not have more than a vague understanding of the benefits of the applicant's offerings, with no clear understanding of how to obtain or use them.

Finally, the applicant submits that the specimen of record clearly indicates that services are provided via a website and that there is no indication that such activities could be provided by a CD-ROM. "Applicant submits that in fact, it very clear from the text of the Specimen that Applicant provides services which are only accessible through the World Wide Web." Applicant's Request for Reconsideration, pp. 3-4.

The Applicant states in the Specimen that the services are provided via a website that allows users to perform the functions outlined in the recitation of services. Applicant provides the following statements from the Specimen in support of Applicant's assertion. Specifically, the Specimen states that ENCLAVVOICE [sic] IS one of "EnklavTDW's browser-based collaboration tools." Specimen, page 1. Further, the Specimen provides that the services are provided ". . . all through a hosted, secure web portal." In other words, to use the services, after purchasing said services from Applicant, the user accesses the Applicant's website, and then interacts with the Applicant's website to both upload information and to receive Applicant's services through a web portal. Specifically, as described by Applicant in the Specimen, Applicant provides a browser-based collaboration tool called ENCLAVVOICE [sic], through a hosted, secure web portal, which provides Applicant's service consisting of "aggregat[ing] all forms of text, data, and images and administering] content approvals." Specimen, page 2.

Applicant's Request for Reconsideration, p. 4.

The term "website" does not appear at all on the specimen. Notwithstanding that fact that the specimen is itself a page from a website, the only reference to the World Wide Web is the reference to EnklavTDW enabling users to "manage quality and consistency and eliminate redundant tasks in publishing to multiple media . . . all through a hosted, secure web portal designed to match your brand. Again, as the applicant must interpret "in other words," the specimen does not specifically state that potential purchasers are to use the applicant's services via a website. There is no indication that users must log in to a webpage, there is no indication that nothing is to be installed on the users' computer, there is no specifically identified means of obtaining the "browser-based collaboration tools" or being permitted access to the "secure web portal." None of the abilities of the users are made clear by the specimen. Applicant's EnklavTDW is referred to as a "system." The specimen does not explain the components of this system or whether it is purchased by users or accessed remotely. As it is unclear from its face whether services are being offered or goods are being advertised, the specimen does not clearly use the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source.

Furthermore, the mark "ENKLAVVOICE" is used thusly: "ENKLAVVOICE aggregates all forms of text, data and images and administers content approvals." The mark "ENKLAVVOICE" is used as the subject of the sentence, i.e. as a noun, indicating a person, place or most likely in this case, a thing. When the mark refers to a "thing," it gives the impression of a good being offered, not an activity or service being provided. Each of the other components of the EnklavTDW system are also described in this manner, with no clear indication that such functionality is available via non-downloadable software accessed solely via a website.

As the present specimen and applicant's submitted explanation do not establish use of the mark ENKLAVVOICE in connection with the recited services, the specimen of use remains unacceptable and the final requirement for an acceptable specimen of use is maintained and continued.

Accordingly, applicant's request for reconsideration is *denied*. As the applicant has filed a notice of appeal with the Trademark Trial and Appeal Board, the application will be returned to the Board for resumption of the appeal.

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