

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

APPLICATION SERIAL NO. 85045208

MARK: ENTERPRISE DATABASE
CORPORATION

85045208

CORRESPONDENT ADDRESS:

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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Enterprise Database
Corporation

CORRESPONDENT'S REFERENCE/DOCKET

NO:

43956.00021

CORRESPONDENT E-MAIL ADDRESS:

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:

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 1, 2012. The applicant provided additional evidence of acquired distinctiveness for the wording ENTERPRISE DATABASE CORPORATION and submitted a disclaimer of the wording CORPORATION. The applicant's additional evidence of acquired distinctiveness is insufficient. Therefore, the following requirement is now made FINAL: requirement for a disclaimer of ENTERPRISE DATABASE CORPORATION. *See* 37 C.F.R. §2.64(a).

NOTE: It appears that the applicant may have submitted a separate declaration signed by Executive Vice President of Enterprise Database Corporation as an attachment. Applicant is advised that the only declaration information is contained within the body of the response to the office action.

DISCLAIMER

In the prior office action, the requirement to disclaim the descriptive wording "ENTERPRISE DATABASE CORPORATION" apart from the mark as shown because it merely describes that the applicant's goods feature enterprise database products from a corporation entity type was maintained and continued. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). *See* 15 U.S.C. §§1052(e)(1), 1056(a); In

re *Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); In re *Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); TMEP §§1213, 1213.03(a). The examining attorney submitted that applicant's allegation of five years' use was insufficient to show acquired distinctiveness as to this portion of the mark because the wording ENTERPRISE DATABASE CORPORATION is highly descriptive of applicant's goods and/or services. In re *Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989); TMEP §1212.05(a). The examining attorney required additional evidence.

In response, the applicant has submitted the declaration of Executive Vice President of Enterprise Database Corporation who asserts that the following:

1) The wording ENTERPRISE DATABASE CORPORATION used within the mark has become distinctive of the services subject of this application through the Applicant's substantially exclusive and continuous use in commerce in association with the services for at least the eleven years and two months immediately before the date of this statement.

2) Applicant has used the mark in advertising for its goods and services and the Applicant has exclusively and continuously used ENTERPRISE DATABASE CORPORATION pursuant to substantial advertising to the relevant public on a continually recurring basis for 11 full years.

3) Applicant has made extensive efforts to educate the public that its services or goods marketed and provided with the ENTERPRISE DATABASE CORPORATION mark are services or goods that originate only with our company.

4) Over the years, a number of articles have been written and presentations have been given describing Enterprise Database Corporation and indicating that ENTERPRISE DATABASE CORPORATION is clearly used as a trademark.

The examining attorney has considered the applicant's additional evidence carefully but has found them unpersuasive. For the reasons below, the requirement for a disclaimer of the term ENTERPRISE DATABASE CORPORATION is maintained and made FINAL.

As stated previously, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

Allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark. An applicant must also provide the actual advertising material so that the examining attorney can determine how the term is used, the commercial impression created by such use, and the significance the term would have to prospective purchasers. TMEP §1212.06(b); *see In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); *see In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971).

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *see In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); TMEP §1212.05(a).

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods and/or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re*

Seaman & Assocs., Inc., 1 USPQ2d 1657 (TTAB 1986).

However, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances. See *In re Bongrain*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1212.02(i).

In the present case, applicant's claim of acquired distinctiveness based on years of use and allegations of sales and marketing is insufficient to show acquired distinctiveness as to the wording ENTERPRISE DATABASE CORPORATION because the wording "enterprise database" is a well-known term of art used in the computer industry. The applicant has already submitted a disclaimer of the generic entity designation.

The applicant's addition 2(f) evidence in the form of a declaration containing allegations of use, sales and marketing is deficient. As stated previously, the following factors are generally considered when determining acquired distinctiveness: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense, and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212 *et seq.* The Office will decide each case on its own merits.

The applicant's acquired distinctiveness evidence does not include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and other sufficient evidence that establishes the distinctiveness of the mark as an indicator of source. See 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.* Therefore, the applicant's claim of acquired distinctiveness is insufficient to obviate the requirement for a disclaimer of the highly descriptive wording ENTERPRISE DATABASE CORPORATION.

Therefore, the requirement for a disclaimer of the descriptive wording ENTERPRISE DATABASE CORPORATION is continued and made FINAL.

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use "ENTERPRISE DATABASE CORPORATION" apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

If applicant does not provide the required disclaimer, the USPTO can refuse to register the entire mark. TMEP §1213.01(b).

RESPONSE GUIDELINES

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. 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. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

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/>.

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