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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85979129 MARK: DMX MOBILE	
CORRESPONDENT ADDRESS: CARLA CALCAGNO CALCAGNO LAW PLLC 1250 24TH ST NW WASHINGTON, DC 20037	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Epiq Systems, Inc.	
CORRESPONDENT'S REFERENCE/DOCKET NO: DMX Mobile CORRESPONDENT E-MAIL ADDRESS: cccalcagno@gmail.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Please note: this is merely a duplicate of the brief submitted regarding Application Serial No.

85/978,692, as the appeals for these applications have been consolidated.

These proceedings concern appeals regarding Application Serial Nos. 85/978,692 and 85/979,129, consolidation granted by the Board on October 20, 2014.

Facts and Background

The applicant, Epiq Systems, Inc., seeks to register the marks “DOCUMATRIX MOBILE” and “DMX MOBILE” for the following identifications of services in Classes 42 and 45 [the wording in brackets appears in 85/979,129 only]:

- Class 42: Consulting in the field of technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; Leasing of computer software that stores and manages documents, digital media, text, sound, and images, [“all”] in the fields of electronic discovery, internal corporate matters, compliance, second requests, litigation, investigations, and document management [“for purposes of responding to discovery”].
- Class 45: Litigation support services, namely, conducting electronic discovery and document review services of electronically stored information that could be relevant in legal proceedings; Legal consultation services.¹

¹ The examining attorney notes that the present applications are divided from initial applications. They are the children of Application Serial Nos. 85/229,600 and 85/229,605, and the parent applications retain goods identified in Class 9.

The applicant appeals decisions of the examining attorney that the specimens submitted in Statements of Use for each application do not show the respective marks in actual use in commerce for the services identified in each of the consolidated cases. While the services identified in each case and the respective sets of specimens of record differ slightly, the examining attorney has found them insufficient based on the same factual and legal principles.

Issue and Examining Attorney's Analysis

THE SPECIMENS PROVIDED IN THE STATEMENTS OF USE DO NOT SHOW USE OF THE MARKS IN COMMERCE IN THE PROMOTION OR RENDERING OF THE SERVICES IDENTIFIED IN CLASSES 42 AND 45 IN THE STATEMENTS OF USE. TRADEMARK ACT SECTIONS 1 AND 45, U.S.C. SECTIONS 1051, 1127, TMEP §§904 *ET SEQ.*, 1301 *ET SEQ.*

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301 *et seq.*

In this case, the examining attorney has explained that examples of acceptable specimens for services typically include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §§1301.04 *et seq.* Specimens consisting of advertising or

promotional materials generally must show a direct association between the mark and the services for which registration is sought. *Id.* While the exact nature of the services does not need to be specified in the specimen, there must be something that creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)).

In the March 1, 2013, Statement of Use for 85/978,692, the applicant described the specimen images as “the cover and material pages from a brochure distributed by Applicant relating to its DOCUMATRIX MOBILE services.” In the March 19, 2013, Office action, the examining attorney rejected these specimens, which consist of four distinct pages repeated twice apiece. The first page references the applicant Epiq Systems generally, but does not feature the mark “DOCUMATRIX MOBILE” at all. 03/01/2013 Statement of Use for 85/978,692 at 2. At best, this page shows that the applicant generally provides technology products and services under the Epiq Systems mark, but not the applied-for mark: “Epiq Systems is a global leader in providing fully integrated technology products and services for eDiscovery and document review.” *Id.* The second page is a title page for the brochure, also fails to show the applied-for mark, and again only stands to suggest that eDiscovery and document review activities are provided under the Epiq Systems umbrella. *Id.* at 3. The third page is the first to feature the mark; however, while the brochure material generally touts the applicant’s “infrastructure” and “on-site capabilities”, the specimen only states that “DOCUMATRIX MOBILE”, coupled with Epiq’s document review solutions, enables lawyer review wherever an investigation occurs.” *Id.* at 4. Finally, the fourth page refers to the applicant’s “document review platforms” as well as a similar prior registration “DOCUMATRIX” as “Epiq’s hosted proprietary review software”. *Id.* at 5. This page goes on to make specific reference to the mark “DOCUMATRIX MOBILE”, but only to briefly describe the features under

the mark as “go on-site anywhere in the world to filter, process and conduct document review behind and in conjunction with your IT infrastructure.” *Id.* There is no use of the mark to reference the services applied for; the only use of it is as the name of the applicant’s actual software.

The problems with the first set of specimens are thus a microcosm of the failures of the applicant’s specimens in both applications to show use of the respective marks as sources for the identified services. As detailed below, these deficiencies are consistent across both applications and their associated specimens, and the cause may be summarized as follows: Whereas the applications identify services of technical support, legal consulting, and conducting discovery and document review – activities implicitly performed by people – the applied-for marks are used solely as the names of specific software products. In other words, while the “DOCUMATRIX MOBILE” and “DMX MOBILE” software may be used by people to facilitate activities of the kind identified, these software products are only tools per se and distinct from the activities identified, at least according to the specimens of record. The evidence clearly indicates that “DOCUMATRIX” is a software platform, and the marks “DOCUMATRIX MOBILE” and “DMX MOBILE” refer to versions of this software provided on-site to consumers anywhere in the world. *Id.* at 4. Thus, the marks are used for the actual software only; they are not used in association with the services as actually identified to the extent that the services imply human actors.

As stated in TMEP §1301.04(e) concerning whether a mark functions as a source-indicating service mark, “registration must be refused if, for example, the specimen shows the mark...only as the name of a computer software program or application”. This same section of the TMEP features several case cites and explanations expanding on this principle. The Court in *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973), explained the standard as follows:

The requirement that a mark must be 'used in the sale or advertising of services' to be registered as a service mark is clear and specific. We think it is not met by evidence which only shows use of the mark as the name of a process and that the company is in the business of rendering services generally, even though the advertising of the services appears in the same brochure in which the name of the process is used. The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.

Similarly, TMEP §1301.04(e) indicates that the Board in *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1625-26 (TTAB 2008), found the submitted specimen unacceptable evidence of use of the mark in connection with custom manufacturing services because it did not show an association between the mark and the services, but instead the mark was used only to refer to computer software. Expanding on *In re DSM*, the TMEP explains that while "the software or process may actually be used in providing the identified services neither transforms that software or process into the identified services, nor associates the name of that software or process as the name of the identified services." Finally, the TMEP explains that the Board in *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986), found the submitted specimen unacceptable since the mark "referred only to the computer software used in performing the services and not to identify and distinguish the services themselves." These cases directly address the issues in these cases. Furthermore, TMEP §1301.02(f) is similarly illustrative for service specimen issues specifically concerning computer software: "A term that only identifies a computer program does not become a service mark, unless it is also used to identify and distinguish the service." Citing *In re Walker* and *In re DSM, supra*.

In the response for 85/978,692 dated September 4, 2013, the applicant provided a substitute specimen featuring additional images from the applicant's brochure originally submitted with the Statement of Use. On similar grounds, the examining attorney rejected the specimens. The first image is the same as Page 7 of the original brochure, and at best indicates that "Documatrix" is the applicant's "hosted proprietary review software". 09/04/2013 Response for 85/978,692 at 7. Pages 8 and 9 of the brochure discuss document review services of the kind identified in the Statement of Use. *Id.* at 8-9. However, the overall brochure and the references to the services therein are for the applicant's overall business under the Epiq Systems umbrella mark, not the applied-for mark: "Epiq's document review solutions", "Epiq's review facilities", "Epiq's review experts". *Id.* Page 10 of the brochure discusses production and security of Epiq services under the umbrella mark, but does not feature the applied-for mark. *Id.* at 10. Page 11, also featured among the initial specimens, implicitly indicates this distinction between the applicant's overall services and the software actually provided under the mark: "Documatrix Mobile, coupled with Epiq's document review solutions, enables lawyer review wherever an investigation occurs." *Id.* at 11. The next three unnumbered pages of the brochure are cover and introductory pages for the brochure and do not feature the applied-for mark; rather, the wording "Document Review" and references to other services appear but only under the Epiq Systems umbrella mark. *Id.* at 12-14. Similarly, pages 3 and 4 of the brochure also reference services of the kind identified, but again only under the Epiq umbrella. *Id.* at 15-16. Page 5 of the brochure discusses other technological tools provided by the applicant under the mark "eDataMatrix". *Id.* at 17. Page 6 of the brochure references "technology-assisted review" services, but again only within the context that the brochure is for Epiq Systems as an umbrella mark. *Id.* at 18. The next two unnumbered pages feature the applied-for mark "DOCUMATRIX MOBILE" but feature no information associating the mark with any particular services. *Id.* at 19-20. The first page merely shows the marks "DOCUMATRIX MOBILE" and

“DMX MOBILE”, the vague tagline “Anytime. Anywhere. Global.”, and the overarching Epiq umbrella mark. *Id.* at 19. The second page demonstrates an affinity between the “DOCUMATRIX MOBILE” and “DMX MOBILE” marks, and contains language indicating that the marks are used as the name of a software product (“hardware and software solution”), not for the services identified in the Statement of Use: “Documatrix Mobile (DMX Mobile) provides law firms and corporations the ability to perform on-site document review”. *Id.* A consumer reading this would believe that while Epiq may provide the services that it identifies in these applications, “DOCUMATRIX MOBILE” and “DMX MOBILE” are the names only for the Epiq software product and not a source for the actual services. The remaining pages are merely duplicates of the other pages in a different order.

The Statement of Use for 85/979,129 (“DMX MOBILE”), submitted April 15, 2013, features two images, each repeated twice. 04/15/2013 Statement of Use for 85/979,129. These are the same as the just discussed images from pages 19 and 20 of the 09/04/2013 response in the “DOCUMATRIX MOBILE” application. 09/04/2013 Response for 85/978,692 at 19-20. As noted above, these pages merely show an affinity between the “DOCUMATRIX MOBILE” and “DMX MOBILE” marks and generally only describe the product under the marks as software. 04/15/2013 Statement of Use for 85/979,129 at 2-3. The examining attorney refused these specimens on similar grounds as those raised for 85/978,692, namely, that the specimens only show use of the mark for a software product, but not for the services as identified in the Statement of Use. The applicant did not submit substitute specimens for 85/979,129 in response to the refusal.

For these reasons, the examining attorney maintains that while the applicant’s specimens show marketing materials promoting products and services under the Epiq Systems umbrella mark,

consumers would clearly understand that the brochures use the marks “DOCUMATRIX MOBILE” and “DMX MOBILE” solely to promote a specific portion of Epiq’s business activities, namely, providing software. The other activities advertised more generally under the Epiq Systems umbrella, those for which the applicant has applied, namely, technical support consulting, conducting discovery and document review, and legal consulting, are offered under the Epiq mark and not under either “DOCUMATRIX MOBILE” or “DMX MOBILE”. The specimens also fail to refer to services of software leasing. There is no “sign up for a subscription”, “log in and begin using the software today”, or any of the other common invitations used by companies to make it clear that their software is available to lease. Thus, the specimens use the applied-for marks solely to reference the applicant’s software products and not in any way for the services as identified in the applications.

Analysis of Applicant’s Arguments Against the Refusal

In its brief, the applicant first calls attention to the two-page brochure submitted as the initial specimens for “DMX MOBILE” and as substitute specimens for “DOCUMATRIX MOBILE”. Applicant’s Brief at 2-4 (referencing images submitted in the 04/15/2013 Statement of Use for 85/979,129 at 2-3, and in the 09/04/2013 Response for 85/978,692 at 19-20). In a footnote in the brief, the applicant also calls attention to the multi-page brochure submitted as specimens for 85/979,129 only entitled “Global eDiscovery & Document Review”. Applicant’s Brief at 4.

The applicant summarizes its arguments relative to these specimen images in the following six points. Applicant’s Brief at 4-6. (1) The two-page brochure is “used by Epiq to advertise and promote the solutions under the...marks.” (2) “[The brochures] individually and collectively both create a direct

association between the...marks and the services listed in those brochures.” (3) The marks are prominently used in the two-page brochure and create a direct association between the marks and the services described therein. (4) The specimens clearly use the mark to refer to the fact that the applicant offers a “solution”. (5) The brochure features a bulleted list describing features of the “DMX Mobile solution”. (6) Page 11 of the Global eDiscovery brochure describes a case study concerning the “on-site solution” next to the mark “DOCUMATRIX MOBILE”.

The examining attorney finds that the applicant is no doubt correct that the two-page brochure shows use of both marks and that the Global eDiscovery brochure shows use of the “DOCUMATRIX MOBILE” mark. However, the examining attorney maintains that these brochures would not be viewed by consumers as showing the mark in sufficient association with the services identified in the Statements of Use. As explained above, the specimens only make a clear association between the marks and descriptions of the product being a “hardware and software solution”. 04/15/2013 Statement of Use for 85/979,129 at 3. Thus, the specimens expressly – and only – show use of the marks for a limited type of product, a computer tool that performs functions. This is not the same as the broader range of services identified in the Statements of Use, such as technical support services, legal consulting, and document review. While the software platform may be used in association with other kinds of services, including those in the application, the law requires that the specimen clearly show an association between the mark and such services. None of the specimens submitted make this association such that consumers would view “DOCUMATRIX MOBILE” and “DMX MOBILE” as a source for any of the services.

The applicant highlights the bulleted descriptions under the heading “Key Features of DMX Mobile”. Applicant’s Brief at 7. However, these features all tie the marks to a computer hardware and software product, but not to any services. The bullet beginning “complete hardware and software solution” is self-explanatory. The wording “on-site access” again indicates that access is to software: a “review platform”. The wording “multi-level security providing safeguards for various investigations on identical data sets” merely indicates that the product has security features to protect data, which is appropriate for software products, not services provided by human actors like legal consulting or document review. Finally, the wording “consultants and experts available on-site, and via our processing centers” makes reference to the availability of consulting, but is vague as to the nature of this consulting. Furthermore, the reference to “Epiq’s on-site support team”, in the context of the other wording in the brochures, ties any technical support and consulting services more clearly to the umbrella mark Epiq Systems. 04/15/2013 Statement of Use for 85/979,129 at 3. As noted above, for example, the Global eDiscovery brochure indicates the distinction between Epiq’s overall services and the software actually provided under the mark: “Documatrix Mobile, coupled with Epiq’s document review solutions, enables lawyer review wherever an investigation occurs.” 09/04/2013 Response for 85/978,692 at 11. The applicant’s brochures consistently consign “DOCUMATRIX” to being a software product distinct from the other activities: “Document Review Platforms: With Documatrix(R), Epiq’s hosted proprietary review software, clients are equipped with essential discovery management tools for an efficient intelligent assessment and review.” *Id.* at 7-8. On the next page, document review services of the kind actually identified in Class 45 are under the Epiq umbrella: “Epiq’s document review solutions are flexible and customizable. Whether you need simple staffing, fully managed review, or anything in between, you can mix and match our service offerings to meet the needs of any matter.” *Id.* at 8.

For these reasons, the applicant's arguments are unpersuasive that the portion of the brochure listing the features of "DMX MOBILE" shows use of the mark in association with the identified services. Rather, the descriptions serve to reinforce that the product provided under the marks is merely a software tool that may be used by others in support of other activities.

The applicant's brief next discusses its leasing of computer software. Applicant's Brief at 11-13. The applicant has submitted evidence in the form of a declaration from its vice president and general counsel Jayne Rothman. The applicant's discussion and evidence counter the examining attorney's characterization of the product provided under the marks as being software provided as a service. The examining attorney apologizes for earlier confusion on this point. The applicant's brief clarifies that it does not deliver the software via the Internet, but is rather making access of the software available to consumers on their own sites where it may reside within their own firewalls. *Id.* This explanation fully demonstrates that the applicant does not provide the software as a service. However, it also suggests – without the materials making express reference to leasing arrangements – that the applicant's software product should be treated as if it were a good appropriate for Class 9, such as those identified in the parent applications for these marks. The applicant argues that the wording "on-site access" "signifies that it is currently allowing its clients access to its software for a fee" as a lease arrangement. *Id.* at 11. The examining attorney disagrees. No leasing arrangement is implicitly contemplated by these terms. Rather, "on-site access" merely indicates that consumers may house or at least use the product from their own domains. Similarly, the applicant suggests that the description of the software as "proprietary" indicates a leasing arrangement. *Id.* at 13. The examining attorney disagrees, finding that this adjective simply indicates that the applicant produced or developed the software, but not

necessarily that it retains ownership rights as a lessor.² Therefore, the examining attorney maintains that the brochures do not sufficiently denote software leasing activities in association with the marks, but rather that the materials advertise software products of the kind identified in Class 9 in the parent applications for these cases.

The applicant's brief finally argues that the specimens show use of the mark for legal consulting and litigation support services. Applicant's Brief at 13. Previously, the applicant's argument summary made a brief note that the Global eDiscovery brochure includes reference "a detailed case study" referencing these consulting and document review services "next to the mark". *Id.* at 6. The applicant's emphasis on this page is misplaced. The "Case Study" is contained in a separate box across the page from the only use of "DOCUMATRIX MOBILE", and uses only the applicant's umbrella mark to refer to "Epiq's analysis" and other Epiq review services. 09/04/2013 Response for 85/978,692 at 11. Thus, this case study is not shown in sufficient association with the applied-for mark so fails to show the mark in use for the activities it describes. As the examining attorney has explained previously, while the brochure unquestionably describes services of the kind identified in the Statements of Use for the marks, the marks themselves are not used in association with these references such that they would be viewed as a source for the services. Rather, the marks are used to indicate a software product, and the other service activities are used in association only with the applicant's Epiq mark.

Conclusion

² The examining attorney requests that the Board take notice of the definitions of "proprietary" found in the *Merriam-Webster* online dictionary, available at <http://www.merriam-webster.com/dictionary/proprietary>: "something that is used, produced, or marketed under exclusive legal right of the inventor or maker; specifically [one] that is protected...as to name."

For these reasons, the examining attorney maintains that the specimens of record do not show use of the marks in sufficient association with the services identified in the Statements of Use. Technical support services, legal consulting services, and discovery and document review services are referenced in the marketing materials, but only under the general mark for Epiq Systems; never as services provided under the applied-for marks. Furthermore, the marketing materials make no reference to leasing services or related arrangements that would suggest that the applicant's software is provided in such a fashion, rather than as goods. Therefore, the examining attorney respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Sections 1 and 45.

Respectfully submitted,

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