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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field           | Entered   |
|-----------------------|---|
| SERIAL NUMBER         | 86431514  |
| LAW OFFICE ASSIGNED   | LAW OFFICE 103  |
| MARK SECTION          |   |
| MARK                  | <a href="http://tmng-al.uspto.gov/resting2/api/img/86431514/large">http://tmng-al.uspto.gov/resting2/api/img/86431514/large</a> |
| LITERAL ELEMENT       | PETROTECHNICAL CLOUD  |
| STANDARD CHARACTERS   | YES   |
| USPTO-GENERATED IMAGE | YES   |
| MARK STATEMENT        | The mark consists of standard characters, without claim to any particular font style, size or color.                            |

### ARGUMENT(S)

#### **REQUEST FOR RECONSIDERATION AFTER FINAL OFFICE ACTION**

This communication is in response to the *Final Office Action* dated July 9, 2015 regarding the above-referenced trademark application. The period set for response is 6 months from the *Final Office Action* date, ending on January 9, 2016. Applicant respectfully requests favorable consideration based on the following amendments and new arguments to the issues raised in the *Final Office Action*. A *Notice of Appeal* is being filed concurrently herewith.

#### **REMARKS**

#### **Section 2(e)(1) Refusal of Class 42 Services – Merely Descriptive**

In the *Final Office Action*, the Trademark Office maintained the refusal to register the PETROTECHNICAL CLOUD mark for Applicant's Class 42 services under Trademark Act Section 2(e)(1) on the basis that the mark allegedly merely describes a characteristic of Applicant's Class 42 services. For that reason, the Trademark Office denied registration on the Principal Register and suggested amending the application to seek registration on the Supplemental Register. Applicant respectfully disagrees and requests reconsideration and withdrawal of the rejection in view of the following new arguments.

In explaining how to identify merely descriptive marks, the Trademark Trial and Appeal Board

("TTAB") stated in *In re Simmons Company*, 189 U.S.P.Q. 352 (TTAB 1976):

Broadly speaking, a mark is considered to be descriptive under the provisions of Section 2(e)(1) if it merely describes a characteristic of the goods. *See In re Crowley's Milk Company, Inc.*, 185 U.S.P.Q. 240 (TTAB 1974) and cases cited therein. However, if the words sought to be registered are suggestive of certain characteristics of the goods with which they are used but are not **directly descriptive** thereof, they may be good trademarks and therefore proper subject matter for registration on the Principal Register. (emphasis added)

In maintaining the refusal, the Trademark Office referred only to the Applicant's Class 42 "computer services", taking the position that PETROTECHNICAL CLOUD merely describes these services because Applicant provides cloud computing in the petrotechnical field. However, the Trademark Office did not address Applicant's Class 42 "consulting services", and its reasons for maintaining the descriptiveness refusal do not apply to such services.

In particular, the mark PETROTECHNICAL CLOUD is not **directly descriptive** of "consulting services for others in the field of subsurface, reservoir, drilling and production data analysis." Since PETROTECHNICAL CLOUD is used not only in connection with computer-related services, but also in connection with consulting services, Applicant's mark PETROTECHNICAL CLOUD is at least suggestive of the services in connection with which it is used. Further, it is well settled that an Applicant's mark need not be devoid of all meaning in relation to the services before it can be registered on the Principal Register without a showing of acquired distinctiveness. *In re Shutts*, 217 U.S.P.Q. 363 (TTAB 1983).

The relevant inquiry is whether the mark PETROTECHNICAL CLOUD, when viewed as a whole, is merely descriptive of the many different Class 42 services to which the application is directed. The PETROTECHNICAL CLOUD mark does not immediately convey to consumers any of Applicant's services, and certainly not Applicant's "consulting services", as detailed in the description of services. When considered in this context, it is abundantly clear that the mark is at most suggestive of Applicant's services, or at least a portion thereof. Any doubt whether the mark is merely descriptive must be resolved in favor of the Applicant. *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ 2d 1141, 1144 (Fed. Cir. 1987); *In re Bel Paese Sales Co.*, 1 USPQ 2d 1233, 1236 (TTAB 1986); *In re Aid Laboratories, Inc.*, 221 USPQ 1215 (TTAB 1983); *In re Conductive Systems, Inc.*, 220 USPQ 84 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

In view of the foregoing, Applicant respectfully requests withdrawal of the rejection under Trademark Action Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP Section 1209 *et seq.* for all of Applicant's Class 42 services, or alternatively, at least for Applicant's Class 42 "consulting services".

**Identification of Services – International Class 35**

Applicant respectfully submits the following amendment to the identification of goods in International Class 35, adopting the Trademark Office's suggestion:

**Online On-line demonstrations demonstration of goods, namely,** sub-surface, reservoir, drilling and production software.

### CONCLUSION

The present Response is intended to fully address each of the issues raised in the *Final Office Action* dated July 9, 2015. Applicant invites the Examining Attorney to contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving any remaining issues pending in this matter.

Respectfully submitted,  
GRIFFITH BATES CHAMPION & HARPER LLP  
Shannon W. Bates  
Attorney for Applicant

#### **GOODS AND/OR SERVICES SECTION (035)(current)**

INTERNATIONAL CLASS

035

#### **DESCRIPTION**

Online demonstrations of sub-surface, reservoir, drilling and production software

FILING BASIS

Section 1(b)

#### **GOODS AND/OR SERVICES SECTION (035)(proposed)**

INTERNATIONAL CLASS

035

#### **TRACKED TEXT DESCRIPTION**

~~Online demonstrations of sub-surface, reservoir, drilling and production software;~~ [On-line demonstration of goods, namely, sub-surface, reservoir, drilling and production software](#)

#### **FINAL DESCRIPTION**

On-line demonstration of goods, namely, sub-surface, reservoir, drilling and production software

FILING BASIS

Section 1(b)

#### **GOODS AND/OR SERVICES SECTION (041)(no change)**

#### **GOODS AND/OR SERVICES SECTION (042)(no change)**

#### **SIGNATURE SECTION**

RESPONSE SIGNATURE

/shannon w. bates/

SIGNATORY'S NAME

Shannon W. Bates

|                                       |   |
|---------------------------------------|---|
| <b>SIGNATORY'S POSITION</b>           | Attorney of Record, Texas bar member  |
| <b>SIGNATORY'S PHONE NUMBER</b>       | 214-238-8400  |
| <b>DATE SIGNED</b>                    | 01/08/2016  |
| <b>AUTHORIZED SIGNATORY</b>           | YES   |
| <b>CONCURRENT APPEAL NOTICE FILED</b> | NO  |
| <b>FILING INFORMATION SECTION</b>     |   |
| <b>SUBMIT DATE</b>                    | Fri Jan 08 17:59:28 EST 2016  |
| <b>TEAS STAMP</b>                     | USPTO/RFR-XXX.XXX.XXX.XXX<br>-20160108175928148352-864<br>31514-5504a5748fdddd3219e<br>38a3283eb323b3f2d8584cca7<br>8919b8b685cd6050fc736a-N/<br>A-N/A-2016010817535110223<br>6 |

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

## **Request for Reconsideration after Final Action**

### **To the Commissioner for Trademarks:**

Application serial no. **86431514** PETROTECHNICAL CLOUD(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86431514/large>) has been amended as follows:

#### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

#### **REQUEST FOR RECONSIDERATION AFTER FINAL OFFICE ACTION**

This communication is in response to the *Final Office Action* dated July 9, 2015 regarding the above-referenced trademark application. The period set for response is 6 months from the *Final Office Action* date, ending on January 9, 2016. Applicant respectfully requests favorable consideration based on the following amendments and new arguments to the issues raised in the *Final Office Action*. A *Notice of Appeal* is being filed concurrently herewith.

#### **REMARKS**

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PETROTECHNICAL CLOUD mark for Applicant's Class 42 services under Trademark Act Section 2(e)(1) on the basis that the mark allegedly merely describes a characteristic of Applicant's Class 42 services. For that reason, the Trademark Office denied registration on the Principal Register and suggested amending the application to seek registration on the Supplemental Register. Applicant respectfully disagrees and requests reconsideration and withdrawal of the rejection in view of the following new arguments.

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In particular, the mark PETROTECHNICAL CLOUD is not **directly descriptive** of "consulting services for others in the field of subsurface, reservoir, drilling and production data analysis." Since PETROTECHNICAL CLOUD is used not only in connection with computer-related services, but also in connection with consulting services, Applicant's mark PETROTECHNICAL CLOUD is at least suggestive of the services in connection with which it is used. Further, it is well settled that an Applicant's mark need not be devoid of all meaning in relation to the services before it can be registered on the Principal Register without a showing of acquired distinctiveness. *In re Shutts*, 217 U.S.P.Q. 363 (TTAB 1983).

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*Systems, Inc.*, 220 USPQ 84 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

In view of the foregoing, Applicant respectfully requests withdrawal of the rejection under Trademark Action Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP Section 1209 *et seq.* for all of Applicant's Class 42 services, or alternatively, at least for Applicant's Class 42 "consulting services".

### **Identification of Services – International Class 35**

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### **CONCLUSION**

The present Response is intended to fully address each of the issues raised in the *Final Office Action* dated July 9, 2015. Applicant invites the Examining Attorney to contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving any remaining issues pending in this matter.

Respectfully submitted,  
GRIFFITH BATES CHAMPION & HARPER LLP  
Shannon W. Bates  
Attorney for Applicant

### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 035 for Online demonstrations of sub-surface, reservoir, drilling and production software  
Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~Online demonstrations of sub-surface, reservoir, drilling and production software~~; On-line demonstration of goods, namely, sub-surface, reservoir, drilling and production software

Class 035 for On-line demonstration of goods, namely, sub-surface, reservoir, drilling and production software

**Filing Basis: Section 1(b), Intent to Use:** *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /shannon w. bates/ Date: 01/08/2016

Signatory's Name: Shannon W. Bates

Signatory's Position: Attorney of Record, Texas bar member

Signatory's Phone Number: 214-238-8400

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86431514

Internet Transmission Date: Fri Jan 08 17:59:28 EST 2016

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XXX-20160108175928

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