

From: Saunders, Andrea

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Subject: U.S. Trademark Application Serial No. 86882884 - ELASTIC - 49142-TM1012 - SU - Request for Reconsideration Denied - Return to TTAB

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United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 86882884

Mark: ELASTIC

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Applicant: Elasticsearch BV

Reference/Docket No. 49142-TM1012

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **April 06, 2020**

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling

evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

SECTION 2(F) CLAIM – DATES DO NOT SUPPORT 5 YEARS' USE

Applicant's Trademark Act Section 2(f) claim based on five years' use is insufficient to show acquired distinctiveness because applicant's dates of use of the mark indicate that applicant has not actually used the mark in commerce for the requisite time period. See 15 U.S.C. §1052(f). For this claim to be accepted, applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate must have been for at least five years before the date on which the claim is made. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2); TMEP §1212.05. And such use must have been in a type of commerce that may be regulated by the U.S. Congress. See 15 U.S.C. §§1052(f), 1127.

In the present case, applicant asserted a claim of acquired distinctiveness on March 25, 2020. Five years prior to this date would be approximately February 16, 2021. However, the date of first use in commerce specified in the March 30, 2018 Statement of Use is February 16, 2016, which is less than five years prior to the date the distinctiveness claim was made.

As an alternative to claiming acquired distinctiveness under Section 2(f), applicant may request to amend the application to seek registration on the Supplemental Register. See 15 U.S.C. §1091(a); 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. To amend to the Supplemental Register, the mark must be in lawful use in commerce; however, no specific length of use is required. See 15 U.S.C. §1091(a); 37 C.F.R. §2.47(a); TMEP §815.02.

Additionally, applicant provided affidavits and declarations from applicant's employees, officers, and/or attorney to support applicant's claim that the applied-for mark acquired distinctiveness under Trademark Act Section 2(f). See 15 U.S.C. §1052(f). Although consumer affidavits and declarations that assert recognition of a mark as an indicator of source are relevant in establishing acquired distinctiveness, affidavits and declarations of an applicant's employees, officers, and attorneys are usually self-serving and entitled to little weight. See *In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated October 16, 2019 are **maintained and continued**:

- Disclaimer requirement

See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B). Filing a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §715.03(c).

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