

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant Name: Bitrix, Inc.	:	Law Office: 112
	:	
Serial No.: 85881491	:	Examiner: Warren Olandria
	:	
Filed: December 30, 2013	::	
	:	
MARK: Bitrix24	:	

RESPONSE

To: U.S. Patent and Trademark Office
Warren Olandria
Trademark Attorney
Law Office 112
571-272-9718

Dear Mr. Olandria,

This is a response to an Office Action (“*Office Action*”) issued by the U.S. Patent and Trademark Office (“*USPTO*”) on June 28, 2013 to Bitrix, Inc. (the “*Applicant*”), by and through its counsel.

On March 20, 2013 the Applicant filed an application for the registration of the mark “Bitrix24” (“*Bitrix24 Mark*”) in connection with the goods and/or services in the following classes: Class 009: Downloadable computer software, namely, software for use as a social network management system in the fields of project management, workplace intranet, social networking, on-line workplace communication and collaboration, on-line photo sharing, content evaluation, event and meeting management, workflow and task management, file sharing, and mobile access; downloadable computer software, namely software for document management, calendaring and scheduling, contact management, task management and conferencing; downloadable computer software for use on laptops, desktops, and mobile phones for workplace management, communication, socialization, and collaboration; computer software platform for social networking that may be accessed via the internet or intranet; computer software to enable

uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information in the fields of virtual communities; web services software to manage, analyze, retrieve, monitor, report, forecast and display data and information from computer databases; computer software, namely, software for creating web services, server applications, business intelligence, internet and intranet portals, content management, and wireless communications; computer software application in the field of social intranet communications, management of workplace and social communications, business project management, and strategic business, simulation, enterprise and resource planning; Class 035: Business management and administration services, namely, document management and administration regarding an on-line intranet work platform which facilitates communication and collaboration between users via the global computer network; business administration service, namely creation, development, and management of websites and web content on an on-line work platform which facilitates communication and collaboration between users via the global computer network; Class 038: Telecommunications services, namely, providing a computer network for delivery of computer programs, graphics, text, and other data and information; telecommunications services, namely, transmission of electronic data and information, including on-line communication, internal messaging and message receiving, using an on-line and intranet workplace social platform; telecommunications services, namely, providing access to on-line work platform via the global computer network and intranet; electronic mail messaging in support of social and workplace project management, workplace social networking, collaboration, product development, and workflow management; transmission and distribution of communication and data via global computer network for users of workplace intranet platform; providing on-line forums for on-line communications used in the field of on-line project management, content evaluation, workflow management, social communications, workplace collaboration, and product development; and Class 042: Software as a service (SAAS), featuring software for on-line project management and workplace social intranet communications, workplace social networking, collaboration, and product development; SAAS, featuring software for use as an on-line, electronic, virtual platform for workplace communication and

collaboration; application service provider (ASP), featuring software for use in development, implementation, and management of social intranet software; technical support services, namely, implementation, maintenance, troubleshooting and technical support of computer software; technical assistance related to the operation and management of cloud-based social intranet software, namely in the form of troubleshooting, updates, upgrades, patches, fixes and technical documentation.

The Examining Attorney (“*Examiner*”) refused to register the Applicant’s Bitrix24 Mark because of the likelihood of confusion of the Bitrix24 Mark with the “Bitrix” mark, Registration No. 3271860 (the “*Bitrix Mark*”). *See Office Action* at page 2 (citing Lanham Act § 2(d); 15 USC § 1052(d)). Bitrix Mark is owned by Bitrix OOO, a limited liability company organized under the laws of the Russian Federation. The Applicant (Bitrix, Inc.) is the exclusive licensee of Bitrix OOO in the United States. As such the Applicant distributes and markets the goods and services under the Bitrix24 Mark at the direction and control of Bitrix OOO, as evidenced by the Declaration of Sergey Ryzhikov (hereinafter “*Ryzhikov Decl.*”) attached hereto as Exhibit A. *See Ryzhikov Decl.* at ¶¶ 4-5.

As previously communicated to the Examiner via telephone, both the Bitrix24 Mark and the Bitrix Mark emanate from a single source, one that exercises control over all the decisions regarding the selection, use, adoption and quality control of both marks. *See* TMEP § 1201.07(a)-(b). Based on the supporting materials submitted hereunder in support of Applicant’s response to this Office Action, the Applicant asserts that while the Applicant and Bitrix OOO are separate legal entities, they constitute a single source regarding the use of Bitrix24 Mark and Bitrix Mark. Thus, no likelihood of confusion exists regarding these marks. *See In re Wella A.G.*, *infra*. In light of the argument provided below, the Applicant requests that the Examiner withdraw his refusal to register the Bitrix24 Mark, and allow the Bitrix24 Mark to proceed to registration on the Principal Register.

I.) There Is No Likelihood of Confusion Between the Bitrix Mark and the Bitrix24 Mark Because Both Marks Emanate From a Single Source With Unity of Control Over the Use, Selection, and Adoption of Both Bitrix Marks.

A close relationship between related companies will obviate any likelihood of confusion in the public's mind because the related companies constitute a single source. *See* TMEP § 1201.07(a)-(b). The Court in *In re Wella A.G.*, where a U.S. subsidiary ("**Wella U.S.**") of the German parent company ("**Wella A.G.**") applied for registration of several trademarks, spoke precisely on this very issue. *In re Wella A.G.*, 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986). The Court succinctly phrased the issue as "whether, despite the similarity of the marks and the goods on which they are used, the public is likely to be confused about the source of the [hair care] products carrying the trademark...[i]n other words, is the public likely to believe that the source of that product is Wella U.S. rather than the German company or the Wella organization." *In re Wella A.G.*, 858 F.2d 725, 726 (Fed. Cir. 1988). In answering this question, the Court reversed the Trademark Trial and Appeal Board's ("**TTAB**") refusal to register the trademarks under § 2(d), concluding that both the U.S. and German companies were the same "source" for purposes of § 2(d), and that no likelihood of confusion existed with respect to the trademarks sought to be registered. *Id.*

The Court in *Wella* was especially persuaded by the declaration of the executive vice president of Wella U.S., which stated that Wella A.G. owns substantially all the outstanding stock of Wella U.S. and "thus controls the activities and operations of Wella U.S., including the selection, adoption, and use of the trademarks." *In re Wella A.G.* at 1550. The declaration was deemed sufficient, absent contradictory evidence in the record, to establish that control over the use of the trademarks resides in a single source. *Id.* at 1553.

Similarly, the Trademark Manual of Examining Procedure ("**TMEP**") states that if *either* the applicant or the registrant owns substantially all of the other entity and asserts control over the activities of the other entity, including its trademarks, and there is no contradictory evidence, the examining attorney should conclude that unity of control is present, that the entities

constitute a single source, and that there is no likelihood of confusion under § 2(d). TMEP § 1201.07(b)(ii)(emphasis in original).

Here, the supporting evidence provided with this response demonstrates that while the owners of both marks are separate legal entities, they are a “single source” in the public’s mind, and that no likelihood of confusion exists between the two marks. Mr. Ryzhikov, the CEO of both Bitrix, Inc. and Bitrix OOO, has submitted a declaration stating that the Applicant is the exclusive U.S. licensee and distributor of Bitrix OOO’s products and services under the Bitrix24 Mark, and that the selection, adoption, and use of the trademarks, including the Bitrix24 Mark and Bitrix Mark, is controlled by Bitrix OOO. *See* Ryzhikov Decl. at ¶ 4. As a result, the Applicant and Bitrix OOO constitute a single source for the products and services distributed under both marks, and there is no likelihood of confusion under § 2(d).

Consequently, there is no distinction in the public’s mind as to the source of products provided to consumers under the Bitrix24 Mark or the Bitrix Mark, as the products under both marks come from the single Bitrix organization, rather than two distinct U.S. and Russian companies. *See* Ryzhikov Decl. at ¶¶ 4-5. Finally, there exists no evidence on the record to contradict this assertion of unity of control. Therefore, according to the rule set forth under *Wella* and the TMEP, both Bitrix OOO and Bitrix, Inc. are a single source for purposes of § 2(d), and no likelihood of confusion regarding the two marks exists.

II.) Conclusion

Because both Bitrix24 and Bitrix Mark both emanate from a single source (i.e. Bitrix OOO) no likelihood of confusion exists regarding these marks. Hence, the Applicant requests that the Examiner withdraw his refusal to register the Bitrix24 Mark, and allow the Bitrix24 Mark to proceed to registration on the Principal Register.

Very truly yours,



Dmitri I. Dubograev, Esq.

EXHIBIT A
DECLARATION OF SERGEY RYZHIKOV

DECLARATION OF SERGEY RYZHIKOV

I, Sergey Ryzhikov, hereby state and declare as follows:

1. I make this Declaration in support of Bitrix, Inc.'s response to an Office Action issued by the U.S. Patent and Trademark Office ("*USPTO*") on June 28, 2013 regarding registration of the Bitrix24 Mark (Serial No. 85881491).
2. I am the Chief Executive Officer ("*CEO*") of Bitrix, Inc., a corporation duly organized and existing under the laws of the Commonwealth of Virginia. Bitrix, Inc. is the owner of the Bitrix24 Mark, under which the Bitrix, Inc provides software products and services as an exclusive licensee of Bitrix OOO in the United States to enable efficient workplace communication and collaboration through intranet and internet networks.
3. I am also the Chief Executive Officer ("*CEO*") of Bitrix OOO, a limited liability company duly organized under the laws of the Russian Federation. Bitrix OOO is the owner of the Bitrix Mark, which was registered with the USPTO on July 31, 2007, Registration No. 3271860. Bitrix OOO also provides a range of products and services in the software development field.
4. Bitrix, Inc. is the exclusive U.S. licensee and distributor of Bitrix OOO's products and services provided under the Bitrix24 Mark. In addition, Bitrix OOO controls the use, selection, adoption, and quality control of both the Bitrix and Bitrix24 marks.
5. The close relationship between both Bitrix OOO and Bitrix, Inc. prevents any consumer confusion as to the source of the products or services provided under either the Bitrix or Bitrix24 marks because consumers associate both marks with one "Bitrix" organization, rather than specifically Bitrix OOO or Bitrix, Inc.
6. Based on the foregoing, I respectfully request that the Bitrix24 Mark be allowed to proceed to registration. If the USPTO requires any additional information, please do not hesitate to contact me.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 USC § 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Dated: December 30, 2013


SERGEY RYZHIKOV