

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Autodesk, Inc.

Examining Attorney: David Dubin (107)


Trademark:

 **AUTODESK**

Ser. Number: 90/858,708

Filing Date: July 30, 2021

RESPONSE TO OFFICE ACTION

The Applicant filed a trademark application Serial Number 90858708 on July 30, 2021 (“Application”) for the mark  **AUTODESK** (“Applicant's Mark”). The Examining Attorney has refused registration of the Application for Class 42 stating “the specimen does not show a direct association between the mark and the services and fails to show the applied-for mark as actually used in commerce with the identified services in International Class 42.”

The day after the Office Action was issued a Notice of Acceptance of the Amendment to Allege Use was issued. Based on the timing of the Notice of Acceptance being issued after the Office Action (instead of before as required by TMEP 1104.09), it appeared that the Class 42 specimen was subsequently accepted thus resolving the sole issue in the Office Action. When the Application was not approved for publication thereafter, the Applicant contacted the Examining Attorney to inquiry whether there was a system glitch that prevented the Application from moving forward. However, the Examining Attorney replied that there was not a system glitch and that the Class 42 specimen refusal was not withdrawn by the Notice of Acceptance. After some informal discussions about why the Applicant believed the Class 42 specimen is clearly acceptable, the Examining Attorney replied that “the specimen of record does not clearly show use of the mark in connection with any of the identified services in Class 42” and suggested filing a substitute specimen.

Applicant respectfully requests that the Examining Attorney withdraw the refusal for the following reasons. The Class 42 specimen is acceptable because it shows use of the mark for

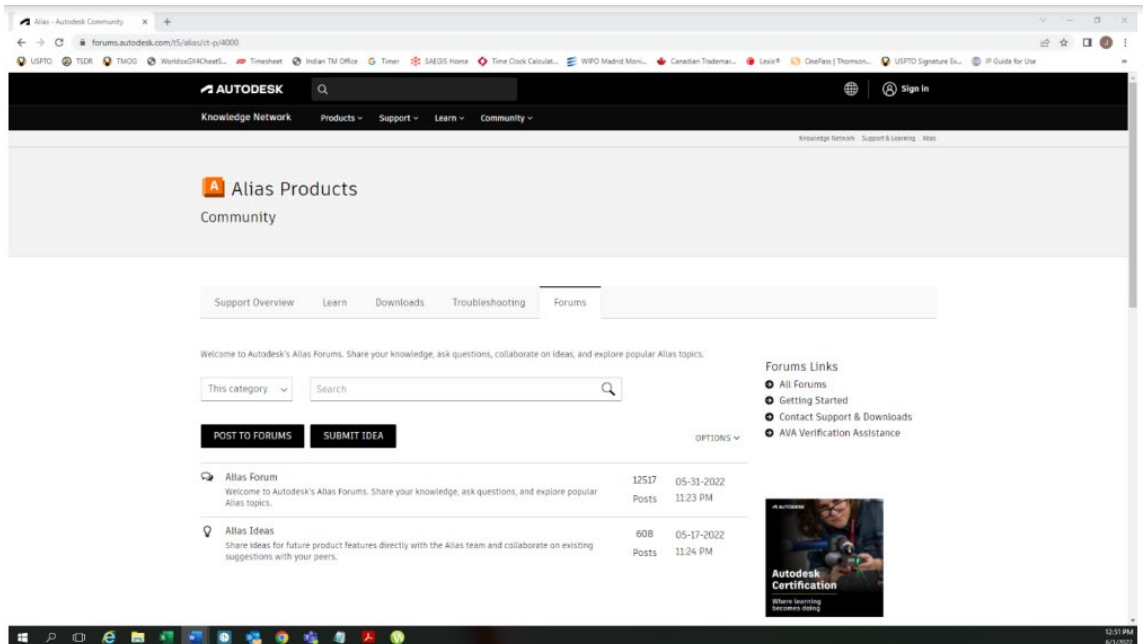
a “community” and for “troubleshooting” which are both included in the Class 42 service identification. Further, the Examining Attorney accepted the *identical* specimen for the *identical* Class 42 service identification in a companion application of the same Applicant which demonstrates that the specimen is acceptable here as well. Thus, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the entire Application for publication.

ARGUMENT

The Office Action states that “the specimen does not show a direct association between the mark and services in that it illustrates the proposed mark used in connection with, what appears to be, online forums” and not services in the Application. Applicant disagrees with the Examining Attorney and asserts that the specimen is acceptable because it shows use with services in the Application. While the exact wording “online forums” are not specifically listed in the Class 42 services, the following services are listed in Class 42 and the specimen shows use of the Applicant’s Mark in connection with such:

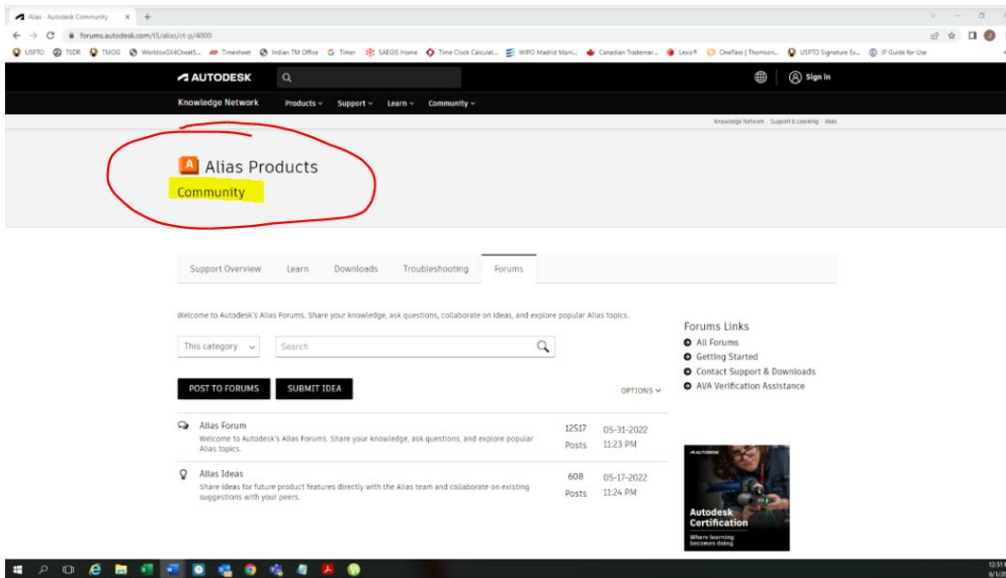
- *“Computer services, namely, **creating an on-line community for registered users to publish and share their own content and images online**”*
- *“technical support services in the field of software development, namely, **troubleshooting of computer software problems**” (emphasis added).*

The specimen submitted on June 15, 2022 for Class 42 is shown below (“Specimen”).

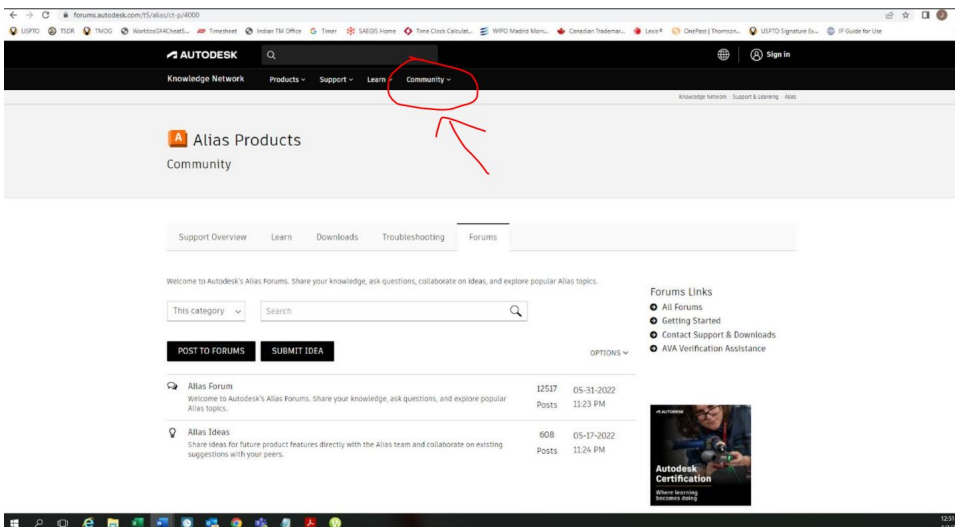


1. The Specimen shows use of the mark in connection with the Class 42 services of creating an on-line community for registered users to share content.

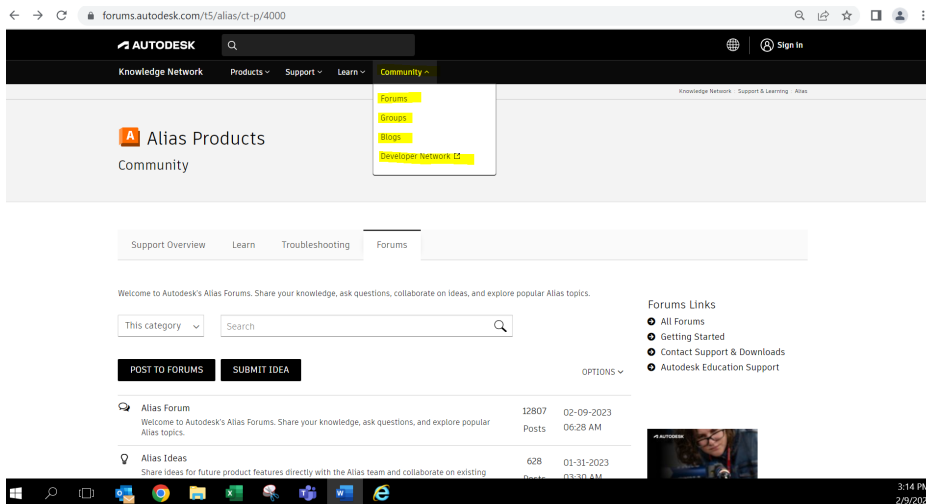
The Application includes a claim in Class 42 to use of the Applicant’s Mark in connection with “*Computer services, namely, creating an on-line community for registered users to publish and share their own content and images online.*” The Specimen (shown below highlighted and in a red circle for emphasis), clearly shows the word “Community” in the page heading indicating that the rest of the page, including the sections labeled “forums,” is part of the broader “online community.”



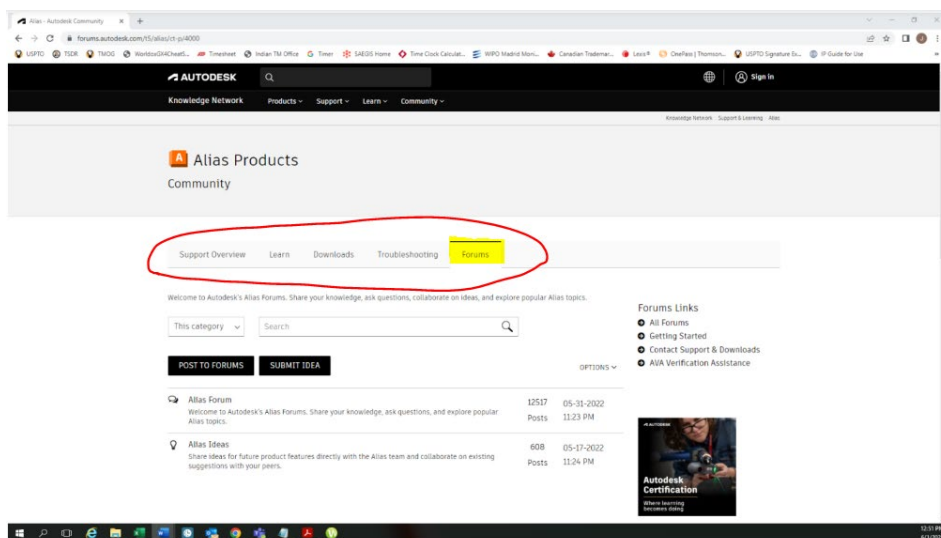
The Specimen displays the term “community” not only in the page heading but also in the website heading with a drop-down menu arrow. The Specimen is shown below with this use of “Community” circled in red and a red arrow for emphasis:



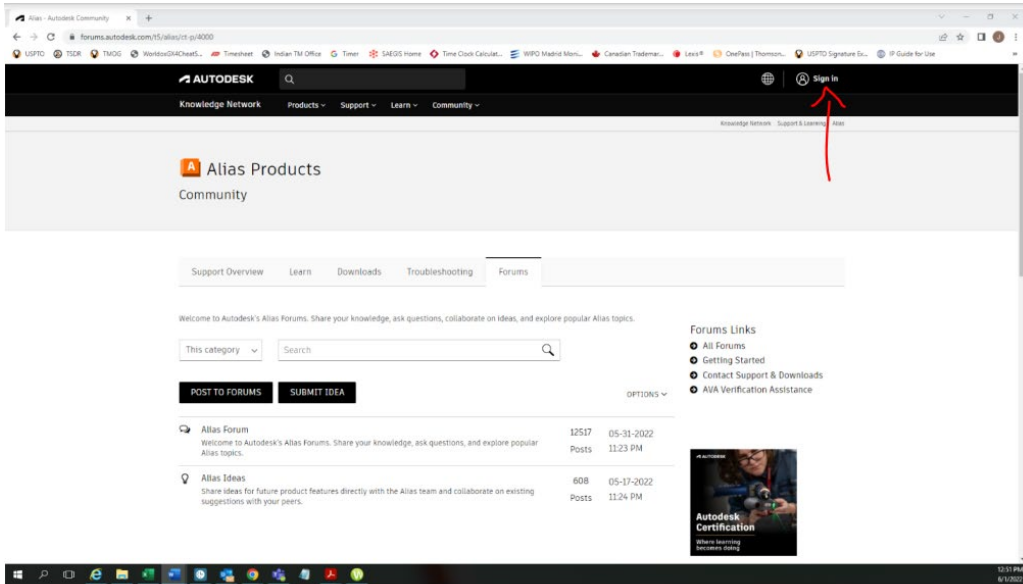
When the word “Community” in the website heading is clicked, a drop-down menu appears as shown below. The drop-down menu shows the various other sections of the online community that are available to users, which are Forums, Groups, Blogs, and Developer Network- all types of online communities. A screenshot of the drop-down menu showing links to the other sections of the online community is shown in highlights below:



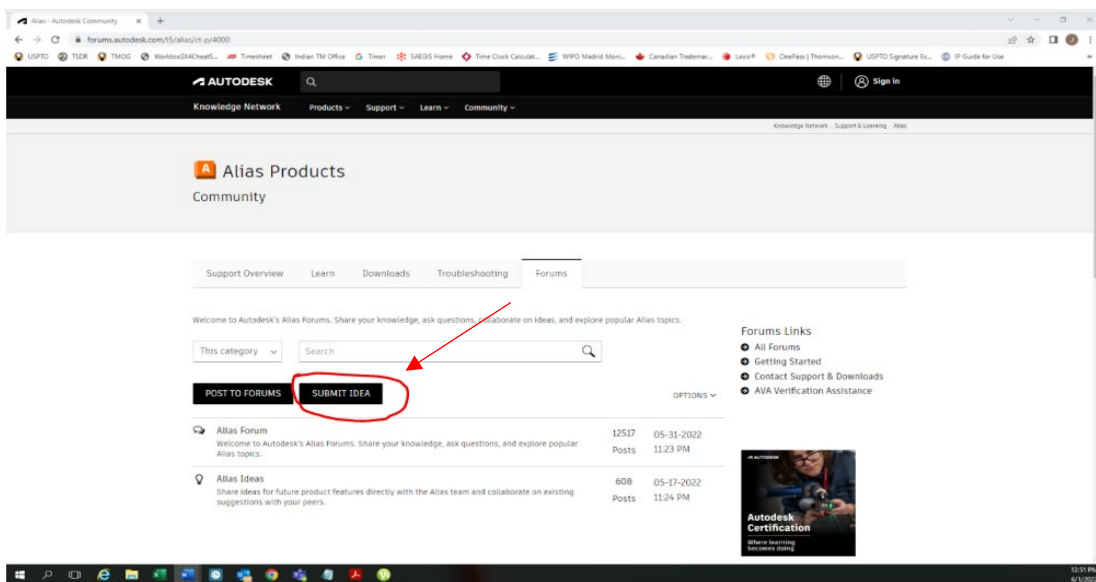
The Examining Attorney refused the Specimen because it shows use of the Applicant’s Mark in connection with a “forum” rather than an “online community.” However, the Specimen shows the “forum” content of the broader online community page because the “Forums” tab, rather than one of the other four tabs on the community page, is selected. The other tabs indicate that there are additional sections. The combination of the “forums” section with the additional sections make up the online community. See the Specimen below with the available tabs circled in red and the selected “Forums” tab highlighted for emphasis:



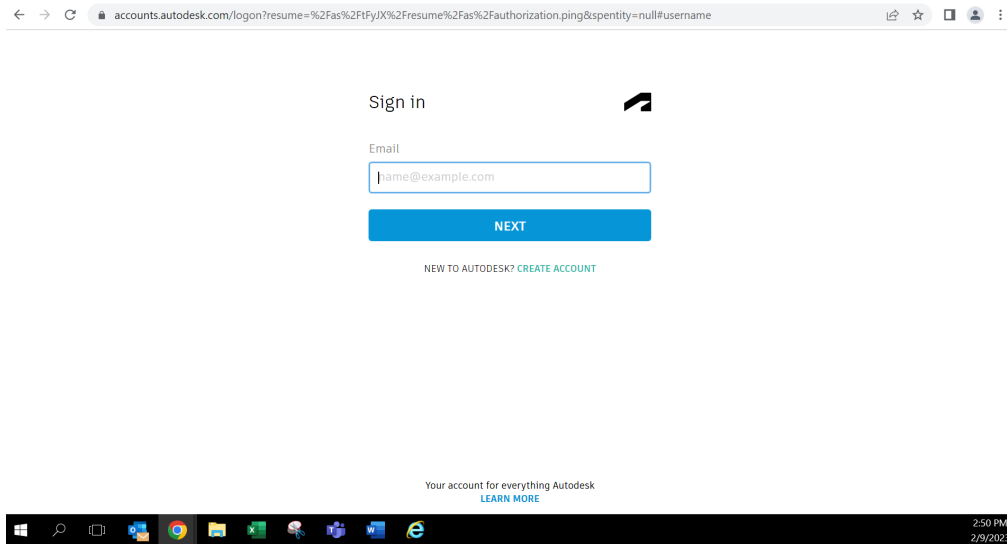
Further, the Specimen shows that the online community requires users be registered (as stated in the Class 42 service identification) because there is a “Sign In” button at the top right of the page. See the Specimen below with the “Sign In” button indicated with a red arrow for emphasis:



Additionally, the Forum tab of the online community shown in the Specimen allows users to “Submit Ideas.” This button fulfills the stated purpose of the on-line community for registered users in the Class 42 service identification of to “*share their own content and images online.*” See the Specimen below with the “Submit Idea” button circled in red with a red arrow for emphasis:



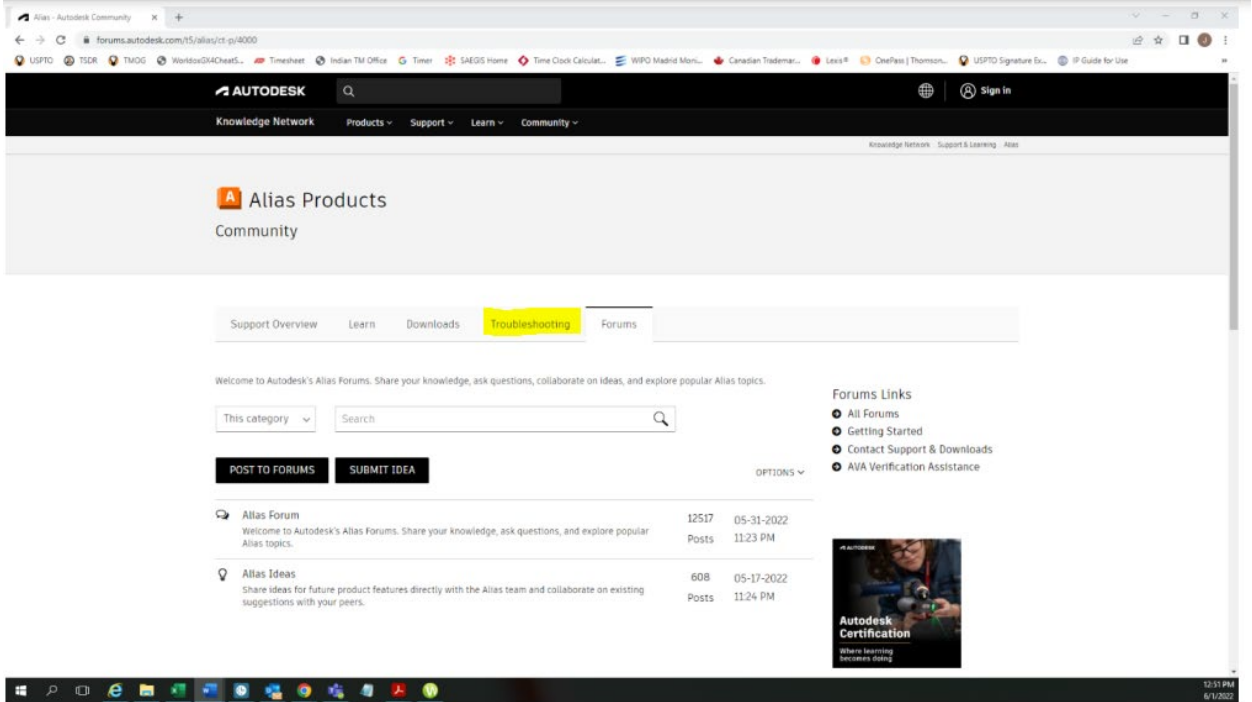
If a user not signed in as a registered user, clicking “Submit Idea” to share content with the online community will bring the user to the below log in screen to either log in or create an account.



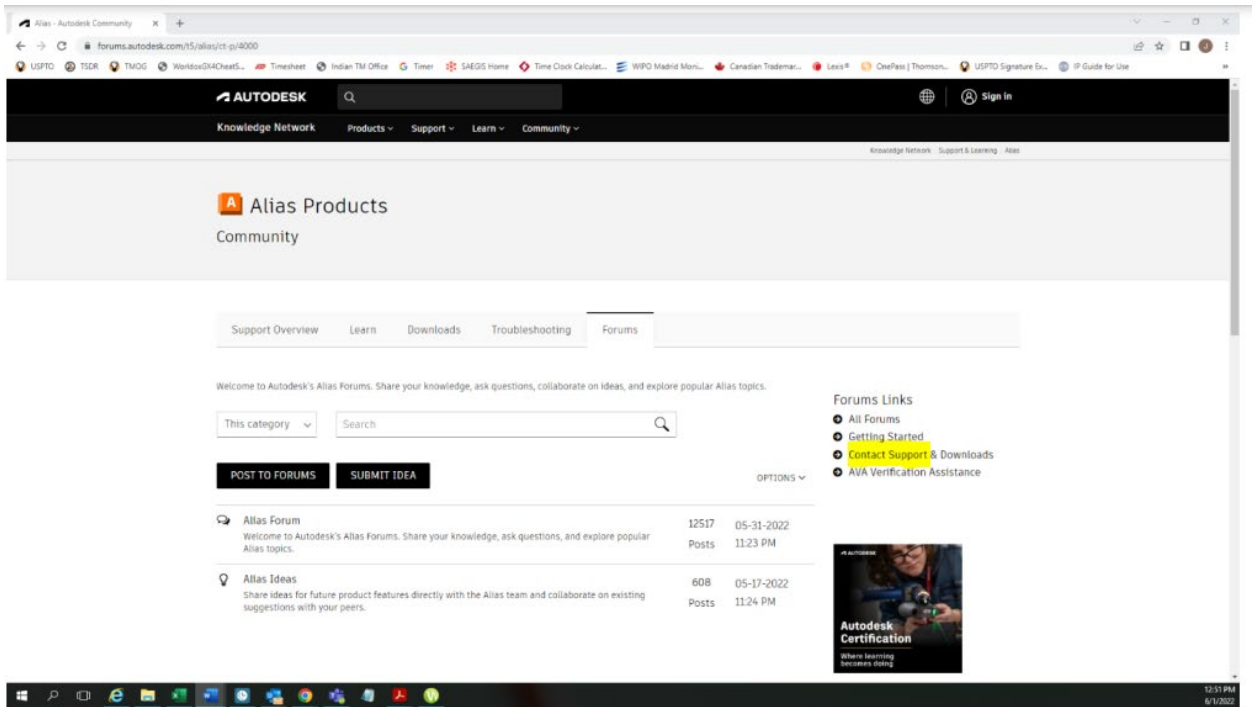
Because the Specimen clearly identifies the services of “*an on-line community for registered users to ... share their own content and images online*” by the webpage displaying an online community page that is even labeled “Community” and is for registered users to share ideas, the Specimen is acceptable.

2. The Specimen shows use of the mark in connection with the Class 42 services of troubleshooting of computer software problems.

The Application includes a claim in Class 42 to use of the Applicant’s Mark in connection with “*technical support services in the field of software development, namely, troubleshooting of computer software problems.*” The Specimen clearly shows use of the Applicant’s Mark in connection with these services as the Specimen shows a “Troubleshooting” tab on a page relating to the ALIAS branded software. See the Specimen below with the “Troubleshooting” tab highlighted for emphasis:






The Specimen also shows a link to “Contact Support,” which is also demonstrates offering technical support services for software as listed in the Class 42 service identification. See the Specimen below with the “Contact Support” link highlighted for emphasis:





Because the Specimen clearly identifies the services of “*technical support services in the field of software development, namely, troubleshooting of computer software problems*” by displaying a “troubleshooting” tab on an online community webpage about software as well as a link to contact the software support team, the Specimen is acceptable.

3. The identical specimen was accepted by the Examining Attorney for the identical services in a companion application.



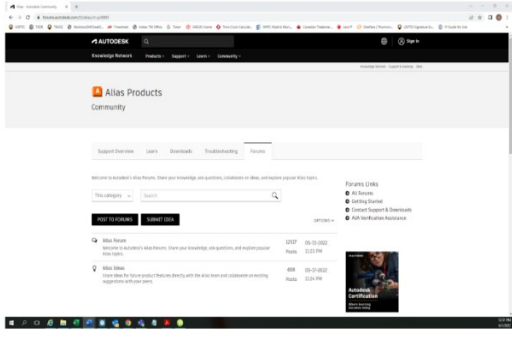
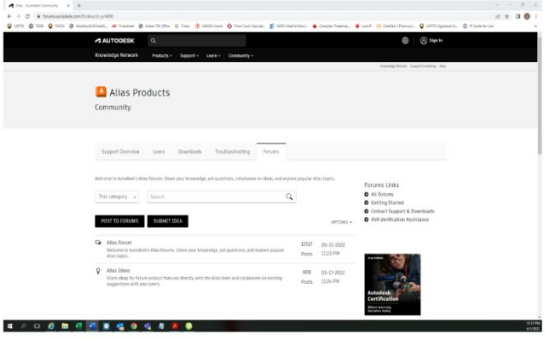
On the same day the Application was filed, Applicant filed a trademark application for the mark , Serial Number 90/858,678 (“Design Application”). Exhibit A. The Design Application contained the identical goods and service identifications as the Application, including the services, “*Computer services, namely, creating an on-line community for registered users to publish and share their own content and images online*” and “*technical support services in the field of software development*” in Class 42. Below is a chart showing the *identical* Class 42 services in the Application and Design Application with the services relevant to the Specimen in **bold**.

Mark	 AUTODESK Serial No. 90858708	 Reg. No. 6883068
Class 42 Services (as filed)	Cloud computing featuring software for computer aided design, graphics design, multimedia production, project management, image manipulation and home design for use by architects, interior designers, civil engineers, construction managers, computer aided designers, multimedia manipulators, prototype creators, and graphics professionals; Computer aided graphic design; Computer project management services; Computer services, namely, creating an on-line community for registered users to publish and share their own content and images online; Providing a secure electronic online system featuring technology which allows users to create, publish, modify, share and produce personalized things from digital content, models and designs; Providing a web site featuring technology that enables users to design their own home layouts, three dimensional objects and construction projects; Providing a web site featuring temporary use of non-downloadable software for tools for image editing, simulation, visualization, rendering of digital objects and images, data management, construction projects, home design, object design	Cloud computing featuring software for computer aided design, graphics design, multimedia production, project management, image manipulation and home design for use by architects, interior designers, civil engineers, construction managers, computer aided designers, multimedia manipulators, prototype creators, and graphics professionals; Computer aided graphic design; Computer project management services; Computer services, namely, creating an on-line community for registered users to publish and share their own content and images online; Providing a secure electronic online system featuring technology which allows users to create, publish, modify, share and produce personalized things from digital content, models and designs; Providing a web site featuring technology that enables users to design their own home layouts, three dimensional objects and construction projects; Providing a web site featuring temporary use of non-downloadable software for tools for image editing, simulation, visualization, rendering of digital objects and images, data management, construction projects, home design, object design



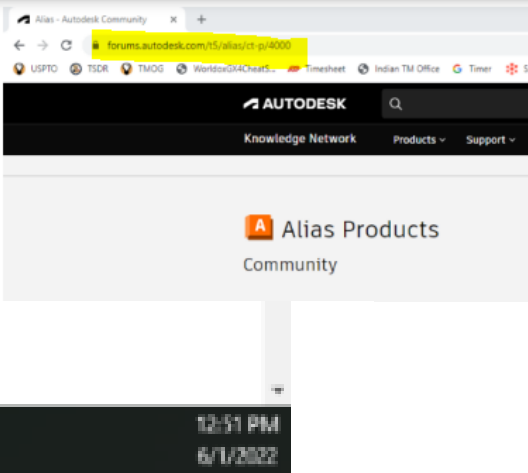
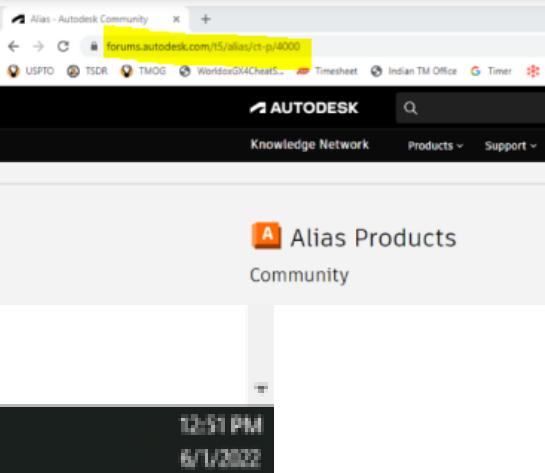
Mark	 Serial No. 90858708	 Reg. No. 6883068
	and computer graphics; Providing an Internet website portal offering information in the field of computer aided design; Cloud computing featuring software for aiding, operating, and controlling devices for printing of three-dimensional (3D) objects ; Software as a service (SAAS) services featuring software for use in designing, creating, visualizing, editing, optimizing, and analyzing 3D meshes, 3D models, 3D point clouds, and orthographic projections and views; Providing temporary use of on-line non-downloadable software for use in designing, creating, visualizing, editing, optimizing, and analyzing 3D meshes, 3D models, 3D point clouds, and orthographic projections and views; Platform as a service (PAAS) featuring computer software platforms providing services, application programming interfaces, and software development kits to enable software developers and businesses, to develop software applications, products, and services; Computer software development tools; providing an internet website portal offering information on software development; software development consulting; technical support services in the field of software development Software as a service (SAAS) services featuring software for use in manufacturing and 3D printing; Providing temporary use of on-line non-downloadable software for use in manufacturing and 3D printing; Software as a service (SAAS) services featuring software for use in electronic design automation and for designing and manufacturing printed circuit boards; Providing temporary use of on-line non-downloadable software for use in electronic design automation and for designing and manufacturing printed circuit boards	and computer graphics; Providing an Internet website portal offering information in the field of computer aided design; Cloud computing featuring software for aiding, operating, and controlling devices for printing of three-dimensional (3D) objects ; Software as a service (SAAS) services featuring software for use in designing, creating, visualizing, editing, optimizing, and analyzing 3D meshes, 3D models, 3D point clouds, and orthographic projections and views; Providing temporary use of on-line non-downloadable software for use in designing, creating, visualizing, editing, optimizing, and analyzing 3D meshes, 3D models, 3D point clouds, and orthographic projections and views; Platform as a service (PAAS) featuring computer software platforms providing services, application programming interfaces, and software development kits to enable software developers and businesses, to develop software applications, products, and services; Computer software development tools; providing an internet website portal offering information on software development; software development consulting; technical support services in the field of software development Software as a service (SAAS) services featuring software for use in manufacturing and 3D printing; Providing temporary use of on-line non-downloadable software for use in manufacturing and 3D printing; Software as a service (SAAS) services featuring software for use in electronic design automation and for designing and manufacturing printed circuit boards; Providing temporary use of on-line non-downloadable software for use in electronic design automation and for designing and manufacturing printed circuit boards

On June 15, 2022, Applicant responded to Office Actions issued in both the Application and the Design Application, among other things, amending the service identification of “*technical support services in the field of software development*” in Class 42 to “*technical support services in the field of software development, namely, troubleshooting of computer software problems.*”

Simultaneously with the Office Action Responses, Applicant filed Amendments to Allege Use for the Application and the Design Application. Both Amendments to Allege Use contained the same specimen for Class 42 shown below.

<p>Mark</p>	 Serial No. 90858708 Application	 Ser. No. 90858678 Design Application
<p>Specimen</p>		

The specimen submitted for both the Application and the Design Application is *identical* and contains the same url in the address bar- forums.autodesk.com/t5/alias/ct-p/4000 and the same date/time stamp in the footer of 12:51pm on June 1, 2022. Below are closeups of the URL and date/time stamp footer from the specimens (highlight added for emphasis).

<p>Mark</p>	 Serial No. 90858708 Application	 Ser. No. 90858678 Design Application
<p>Closeup of URL and Footer</p>		

On June 30, 2022, a Notice of Acceptance of AAU was issued for the Design Application. The Examining Attorney thus accepted the Class 42 specimen for the Design Application because a Notification of Notice of Publication issued on July 20, 2022 for the Design Application. The Design Application registered on October 25, 2022. Exhibit B. Then in August, the same Examining Attorney that accepted the *identical* Class 42 specimen for the *identical* services in the Design Application in June, refused the *identical* Class 42 specimen for the *identical* services in the Application. The Examining Attorney's acceptance of the Specimen in the Design Application supports Applicant's position that the Specimen is acceptable in the Application.

CONCLUSION

The Class 42 Specimen is acceptable because it shows use of the Applicant's Mark for the Class 42 service identifications of an "*Computer services, namely, creating an on-line community for registered users to publish and share their own content and images online*" and "*troubleshooting of computer software problems.*" The Examining Attorney also accepted the *identical* specimen for the *identical* Class 42 service identification in a Design Application which further supports that the Specimen is acceptable in this case. For the foregoing reasons, Applicant respectfully requests that the refusal of registration be withdrawn, and the Application be approved for publication.