

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Adobe Systems Incorporated

SERIAL NUMBER: 86/014,310

MARK: ADOBE

FILED: July 18, 2013

CLASS: 35

LAW OFFICE 109

EXAMINING ATTORNEY: James A. Rauen

RESPONSE TO OFFICE ACTION NO. 1

This document responds to the Office Action issued on November 1, 2013 for ADOBE (the “**Mark**”) filed by Adobe Systems Incorporated (the “**Applicant**”) to cover “Business consultation services in the fields of marketing, advertising and online business optimization; advertising and marketing consulting services, namely, providing advertising and marketing services for managing, distributing and serving advertising, improving ad targeting, facilitating buying or selling advertising, providing real-time reporting, and forecasting, managing, monitoring, executing and optimizing the performance of advertising and marketing campaigns; collecting, reporting, analyzing and integrating data related to the use of websites and applications of others, the use of other data from various sources, and the effectiveness of advertising and marketing campaigns; computerized database management; providing online searchable databases in the field of advertising and marketing campaign analytics; market research and business analyses; conducting business and market research surveys; preparing business reports electronically relating to customer and employee satisfaction and attitude, organizational climate or effectiveness, and the use of web sites; advertising and marketing consultancy; providing business intelligence services; providing business intelligence services in the field of advertising and marketing campaign analytics; providing advertising and marketing consulting in the field of social media; advertising, marketing and commercial information services via the Internet, computer networks, other telecommunications networks, and mobile communications devices; business data analysis; statistical analysis and reporting services for business purposes; product merchandising services and business merchandising display services” in Class 35 (the “**Application**”).

Applicant also refers to the telephone conversation on or about January 22, 2014 between James Rauen, the Examiner, and Lynne Graybeal, Attorney for Applicant, in which the issues raised in the Office Action were previously discussed.

### **AMENDMENTS**

Applicant amends the description of services in the Application to the following:

Class 35: Business consultation services in the field of online business optimization; collecting, reporting, analyzing and integrating data related to the use of websites and applications of others, and the use of other data from various sources; computerized database management; providing business intelligence services; business data analysis; statistical analysis and reporting services for business purposes; product merchandising services and business merchandising display services.

### **IDENTIFICATION OF SERVICES**

In the telephone call on or about January 22, 2014, the Examiner indicated that limitation of the services covered by the application to those listed in the above-amendment would be sufficient to remove the citation of U.S. Registration No. 2,076,967 as a barrier to registration of the Application. In that call, the Examiner raised concerns regarding the term “online business optimization” and suggested that such term may need to be further clarified or specified. Applicant submits that the item “Business consultation services in the field of online business optimization” in the amended specification above is not vague, is sufficiently specific and well understood in the relevant industry, and does not require further clarification or specification. This item is commonly used to describe online analytics services for businesses and should be accepted in the amended description. To support this, Applicant refers to the below marks which cover similar and identical items in Class 35 and were recently accepted for registration.

- Reg. No. 4488279 for A Logo by Adobe Systems Incorporated, filed by the Applicant contemporaneously with the Application, covering “Business consultation services in the fields of marketing, advertising and **online business optimization**; advertising and marketing consulting services, namely, providing advertising and marketing services for managing, distributing and serving advertising, improving ad targeting,

facilitating buying or selling advertising, providing real-time reporting, and forecasting, managing, monitoring, executing and optimizing the performance of advertising and marketing campaigns; collecting, reporting, analyzing and integrating data related to the use of websites and applications of others, the use of other data from various sources, and the effectiveness of advertising and marketing campaigns; computerized database management; providing online searchable databases in the field of advertising and marketing campaign analytics; market research and business analyses; conducting business and market research surveys; preparing business reports electronically relating to customer and employee satisfaction and attitude, organizational climate or effectiveness, and the use of web sites; advertising and marketing consultancy; providing business intelligence services; providing business intelligence services in the field of advertising and marketing campaign analytics; providing advertising and marketing consulting in the field of social media; advertising, marketing and commercial information services via the Internet, computer networks, other telecommunications networks, and mobile communications devices; business data analysis; statistical analysis and reporting services for business purposes; product merchandising services and business merchandising display services” in Class 35. Registered February 25, 2014. *See*, Exhibit A.

- Reg. No. 4346572 for THE BLAMEBUSTERS by Treaty Consulting covering “**Business optimization consulting**” in Class 35. Registered June 4, 2013. *See*, Exhibit B.
- Reg. No. 4424734 for POSITIVELY CHARGED GUIDANCE by Michael Guethlein covering “Business consulting services in the field of business strategy consulting, business management consulting, **business optimization**, business merger and acquisition as well as professional services, namely, personnel placement” in Class 35. Registered October 29, 2013. *See*, Exhibit C.
- Reg. No. 4276877 for DAILYFIT by DailyFit, Inc. covering “Consulting services, namely, marketing and **business optimization services**; Promoting the goods and services of others by providing coupons, discounts and bundled packages” in Class 35. Registered January 15, 2013. *See*, Exhibit D.

- Reg. No. 4171380 for CORFORMANCE by Corformance, Inc. covering “Providing business auditing activities in the nature of recovery auditing; business consultation in the field of recovery auditing; business advisory, consultancy and information services in the field of **business optimization** and performance management; advisory services, namely, providing advice and assistance to commercial business and governmental agencies and departments relating to identifying and recovering erroneous payments; business management consulting featuring specialization in the use of data extraction, transformation and analysis capabilities, namely, data processing, for the reduction of costs and improvement of procurement and disbursement processes; providing business consulting, business information services in the field of analytics, data mining, business operational and business process improvement and outsourcing services for the finance, accounting and procurement functions of commercial and governmental entities; accounting services” in Class 35. Registered July 10, 2012. *See*, Exhibit E.
- Reg. No. 2508613 for GOMEZ by Compuware Corporation covering “Commercial electronic commerce information and directory agency relating to vendors listed on the global computer network and to goods and services offered via the global computer network, such information including quality rankings of such vendors, goods and services; providing business electronic commerce marketing research and advice relating to customer experience and [acquisition, vendor selection, and] **online business optimization**” in Class 35. Registered November 20, 2001. *See*, Exhibit F.

Pursuant to the U.S. Trademark Office’s Consistency Initiative, Applicant requests consistent examination with its contemporaneously filed U.S. Registration No. 4488279 as well as consistent treatment with the above-listed third party registrations. These registrations clearly indicated that the U.S. Trademark Office has concluded on multiple recent occasions that the terms “business optimization” and “online business optimization” are sufficiently specific and well understood in the relevant industry, and do not require further clarification or specification.

## LIKELIHOOD OF CONFUSION

In the Office Action, the Examiner has refused the Application on the grounds that the Mark is confusingly similar with Registration No. 2076967 for THE ADOBE GROUP by The Adobe Group, LLC covering “business consultation in the field of business communications” in Class 35 (the “**Cited Mark**”). *See*, Exhibit G. Applicant submits that there is no likelihood of confusion between the Cited Mark and the Mark, particularly as filed and used in relation to the amended specification of services. Applicant refers to the phone call of January 2014, in which the Examiner indicated that these amendments to the specification would be sufficient to remove any likelihood of confusion and prevent possible conflict on the register and in the marketplace.

Applicant believes that it has amended the description of services in the Application in accordance with the discussions between the Examiner and Lynne Graybeal on or about January 22, 2014 and requests that the Cited Mark be removed as a barrier to registration of the Application. In the event the Examiner continues to have concerns regarding any portion of the amended description, Applicant provides the following information and arguments.

Applicant submits that the marks cover sufficiently different services. The Cited Mark covers “business consultation in the field of business communications”. The relevant business consultation services are limited to a specific field - business communications - and do not cover business consultation broadly. The amended description of services in the Application covers business consultation services in the separate field of online business optimization as well as data gathering, management and analysis for business purposes. The Mark does not encompass services in the field of “business communications” or any related services.

The Mark and the Cited Mark will not be used in similar trade channels. As both the Cited Mark and the Mark cover services which are restricted to specific fields, there can be no presumption that they will travel in the same channels of trade or to the same classes of purchasers (*In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). Whereas the applied-for Mark is to be used for data gathering, management and analysis for the purpose

of evaluating business decisions and strategies, the Cited Mark is used in connection with consultation regarding internal and external corporate communications. The website for the registrant of the Cited Mark at [www.adobegroup.com](http://www.adobegroup.com) states: “What we do — plain and simple — is develop great communication for your organization. Great communication helps you build stronger relationships with your workforce, your stakeholders and your customers.” On the other hand, the Applicant does not provide communications services but assists with internal data gathering, management and analysis.

Consumers will recognize the Mark in connection with Applicant’s services and be able to distinguish it from the Cited Mark. The ADOBE brand has been used in connection with computer programs since at least as early as January 1986 (see U.S. Registration No. 1475793). *See*, Exhibit H. The brand is famous in relation to computer software and online goods and services. Applicant’s software products are integral to many business operations, and Applicant provides a number of business-oriented services in connection with such goods, including those in the applied-for description of services.

The Cited Mark and the Mark have been able to coexist for at least nineteen years without any actual conflict or confusion. The Cited Mark has been used in U.S. commerce since July 1995, and, as noted above, the Applicant’s ADOBE brand has been used in U.S. commerce since January 1986. The Applicant has also claimed trademark protection of its ADOBE mark specifically in connection with Class 35 services since at least as early as 2010 (see U.S. Registration No. 4091791) without confusion or conflict. *See*, Exhibit I.

### **Conclusion**

The Applicant believes it has addressed all outstanding issues raised by the Examiner in the Office Action, and respectfully requests that the Application be allowed to register for the amended description of services. Should any questions remain with respect to issues raised in the Office Action, please contact Lynne Graybeal at 206-359-6485 or [LGraybeal@perkinscoie.com](mailto:LGraybeal@perkinscoie.com).

DATED: May 1, 2014.

## **EXHIBITS**

- A. Reg. No. 4488279 for A Logo by Adobe Systems Incorporated
- B. Reg. No. 4346572 for THE BLAMEBUSTERS by Treaty Consulting
- C. Reg. No. 4424734 for POSITIVELY CHARGED GUIDANCE by Michael Guethlein
- D. Reg. No. 4276877 for DAILYFIT by DailyFit, Inc.
- E. Reg. No. 4171380 for CORFORMANCE by Corformance, Inc.
- F. Reg. No. 2508613 for GOMEZ by Compuware Corporation
- G. Reg. No. 2076967 for THE ADOBE GROUP by The Adobe Group, LLC
- H. Reg. No. 1475793 for ADOBE by Adobe Systems Incorporated
- I. Reg. No. 4091791 for ADOBE by Adobe Systems Incorporated