

Filing Basis

Applicant does not wish to rely on Section 44(e) as a filing basis for this application, but would like to retain the priority date of its foreign application under Section 44(d).

Likelihood of Confusion

The examining attorney has cited six different registrations as obstacles to Applicant's registration under Section 2(d) of the Trademark Act:

- Redwood Software, Inc.'s REDWOOD CRONACLE (Stylized) (RN 2,617,178);
- Aderant Redwood, LLC's REDWOOD ANALYTICS (RN 2,846,602);
- Redwood E-Learning Systems Inc.'s REDWOOD E-LEARNING SYSTEMS (RN 2,993,232);
- Redwood Systems, Inc.'s REDWOOD SYSTEMS (RN 3,861,946);
- Redwood Technologies Limited's REDWOOD TECHNOLOGIES (RN 4,065,044); and
- Mediasation's REDWOOD (RN 4,086,762).

The examining attorney cited these registrations on the grounds that Applicant's identification includes "computer software" generally, and is therefore broad enough to encompass the goods covered by these registrations. Applicant has now amended its identification of goods to clarify the nature of its software, and its identification of goods no longer overlaps with the goods listed in the cited registrations.

Each of the cited registrations is limited to a specific type of software for a particular purpose or use in a particular industry – e.g., "scheduling computer applications and processes", "multi-variable financial, statistical and operational performance analyses", "lighting, security, safety and other home and office monitoring and control applications", "hosting, operation and management of telecommunications", etc. Given the coexistence on the register of multiple REDWOOD marks, each with a limited scope of use, it's clear that each prior registrant is entitled to only a limited scope of protection for its REDWOOD mark. Applicant is entitled to registration for its REDWOOD mark for its own specific use, with no risk of confusion with any of the cited marks.

In light of the foregoing, Applicant respectfully requests that the examining attorney withdraw the Section 2(d) refusal.

Request for Additional Information

Applicant's goods do not provide information pertaining to Redwood National and State Parks in northern California.

Descriptiveness

The examining attorney has refused registration on Section 2(e)(1) of the Trademark Act, on the grounds that the term REDWOOD merely identifies that Applicant's goods provide information regarding Redwood National and State Parks in northern California. Applicant respectfully disagrees with this conclusion.

In order for a mark to be merely descriptive, it must clearly and immediately identify a feature or characteristic of the applicant's goods or services. In re Southern National Bank of North Carolina, 219 USPQ 1231 (TTAB 1983). The determination of whether or not a mark is merely descriptive depends on the perspective of the average purchaser of the goods. See, e.g., In re Omaha Nat'l Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). The Trademark Office has the burden of proving that a term is descriptive, and any doubt as to the suggestiveness of a term should be resolved in an applicant's favor. See, e.g., In re Box Solutions Corp., 79 USPQ2d 1953, 1955 (TTAB 2006).

The term "Redwood" refers to a type of tree indigenous to northern California and Oregon – indeed, the examining attorney's own evidence lists the primary definition of "Redwood" as a type of tree, not the proper name of a national park. It follows that the average consumer will view the term REDWOOD to be an arbitrary mark for Applicant's computer software, not as descriptive for a feature of Applicant's software. There is no basis for assuming that a consumer would understand REDWOOD to signify the name of a park when the word PARK is not present in the mark or in the identification of goods.

The evidence in the office action does not establish that the average American purchaser will clearly and immediately view Applicant's mark as descriptive for its goods, and the Office has not met its burden for a refusal to register. Applicant therefore respectfully requests that the examining attorney withdraw the descriptiveness refusal.