

**U.S. Serial No. 88/001,867 for ACE; TC Docket No. 51017/176442**

Section 2(d) Refusal<sup>1</sup>

U.S. Reg. Nos. 4327692 for ACE METRIX and 4531632 for ACE METRIX LIVE & Design

According to the office action, this citation is directed to the following goods and services in Enterprise's ACE application: *downloadable software for retailers of automobiles, minivans, light trucks, sport utility vehicles, heavy trucks, construction equipment, agricultural equipment, motorcycles, boats, marine vehicles, powersports vehicles and recreational vehicles to manage and track advertising and marketing campaigns in IC 9 and software as a service (SAAS) services, namely, software for retailers of automobiles, minivans, light trucks, sport utility vehicles, heavy trucks, construction equipment, agricultural equipment, motorcycles, boats, marine vehicles, powersports vehicles and recreational vehicles to manage and track advertising and marketing campaigns in IC 42.* Enterprise has deleted these goods and services from its application, thus mooted the citation.

U.S. Reg. No. 2006801 for ACE\*COMM

Enterprise notes that the cited registration is invalid because the registrant failed to make its required maintenance filing. This citation should therefore be withdrawn.

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<sup>1</sup> Enterprise addresses the citations in the order that they appear in the "Relatedness of the Goods and Services" section of the office action, with the exception of U.S. Reg. No. 4849355 for ACE DOCS, which is addressed last.

U.S. Reg. No. 4198282 for ORDERACE

According to the office action, this citation is directed to the following goods and services in Enterprise's ACE application: *downloadable software for use in customer relationship management (CRM) in IC 9 and software as a service (SAAS) services, namely, software for use in customer relationship management (CRM)*. Enterprise has deleted these goods and services from its application, thus mooting the citation.

U.S. Reg. Nos. 4673789 for ACE DATA GROUP and 4677245 for ACE DATA RECOVERY

According to the office action, this citation is directed to the following services in Enterprise's ACE application: *providing technical support, namely, troubleshooting of computer hardware and software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software in IC 42*. Enterprise has deleted these services from its application, thus mooting the citation.

U.S. Reg. No. 4433375 for ACE FACTORY

According to the office action, this citation is directed to the following services in Enterprise's ACE application: *computer software design, development and programming services for others in IC 42*. Enterprise has deleted these services from its application, thus mooting the citation.

U.S. Reg. No. 4348491 for ACE

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management, networking equipment, servers,*

*computer peripherals* in IC 9. Enterprise has deleted these goods from its application, thus mooting the citation.

U.S. Reg. No. 4613381 for ACEGUARDER

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management, networking equipment, servers, computer peripherals, and printers* in IC 9. Enterprise has deleted these goods from its application, thus mooting the citation.

U.S. Reg. No. 4925288 for OUTACE

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management, networking equipment, servers, computer peripherals, and printers* in IC 9. Enterprise has deleted these goods from its application, thus mooting the citation.

U.S. Reg. No. 5083038 for PRIVACY ACE (Stylized)

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management, networking equipment, servers, computer peripherals, and printers* in IC 9. Enterprise has deleted these goods from its application, thus mooting the citation.

U.S. Reg. No. 1459047 for SPELLING ACE

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management* in IC 9. Enterprise has deleted these goods from its application, thus mooted the citation.

U.S. Reg. No. 5033068 for ACE TEAH

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management* in IC 9. Enterprise has deleted these goods from its application, thus mooted the citation.

U.S. Reg. No. 4206296 for ACE MOBILE and Design

According to the office action, this citation is directed to the following goods in Enterprise's ACE application: *telephones* in IC 9. Enterprise has deleted these goods from its application, thus mooted the citation.

U.S. Reg. No. 5035222 for ACEELITE (Stylized)

This mark is identified as a bar to registration in the introductory paragraph of the office action, but the office action does not provide any analysis regarding the alleged relatedness of the goods. Enterprise believes the citation is directed to the following goods in Enterprise's ACE application: *computer hardware, namely, computers, personal computers, computer terminals, computers for network management, networking equipment, servers, computer peripherals, and*

*printers* in IC 9. Enterprise has deleted these goods from its application, thus mooted the citation.

U.S. Reg. No. 4849355 for ACE DOCS

The registered mark ACE DOCS (U.S. Reg. No. 4849355), for *cloud computing featuring enterprise-scale computer software for managing, tracking, and sharing documents and files as part of a quality management system*, has been cited as a bar to registration.

According to the office action, the citation is directed to the following services in Enterprise's ACE application: *software as a service (SAAS) services, namely, software for managing documents, forms and contracts in the automotive retail sales and financing process, namely, software for creating, archiving and organizing documents and forms.*

There is no "per se" rule requiring a finding of likelihood of confusion where the subject goods involve different types of software. See TMEP § 1207.01(a)(iv); *In re Quadram Corp.*, 228 U.S.P.Q. 863, 865 (TTAB 1985); *Information Resources v. X-Press Information Services*, 6 U.S.P.Q. 1034, 1038 (TTAB 1988); *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 U.S.P.Q.2d 1944, 1947–48 (Fed. Cir. 2006). In the software context, a subject-matter-based mode of analysis is appropriate for assessing relatedness. *Id.*

Enterprise's software is used to create, archive and organize documents and forms for the automotive retail sales and financing process. The Registrant's software, in contrast, is used for managing, tracking and sharing documents and files as part of a *quality management system*. As shown in the attached Internet evidence, a "quality management system" is "defined as a formalized system that documents processes, procedures, and responsibilities for achieving quality policies and objectives. A QMS helps coordinate and direct an organization's activities to meet customer and regulatory requirements and improve its effectiveness and efficiency on a

continuous basis.” The software provided by Enterprise and the Registrant are thus provided to distinct customers for very different purposes. Whereas Enterprise’s software is used by those who sell and finance automobiles, to create, store and organize documents used in the automotive sales and finance processes, the Registrant’s software facilitates an organization’s *internal* protocols and processes for managing its own documents and files. It is an organizational quality control system and has nothing to do with selling and financing automobiles. The USPTO offers no evidence to the contrary. Given such differences in the use and purposes of the parties’ respective software, consumers are not likely to be confused.

The consumers of the parties’ respective software are also sophisticated and exercise a great deal of care in purchasing decisions. Where the relevant purchaser is rather sophisticated, it is appropriate to apply an elevated standard when determining whether a likelihood of confusion exists. *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 14 U.S.P.Q.2d. 1840 (Fed. Cir. 1990). This is particularly true when the relevant goods and services are of great importance to the purchaser, as is the case with software that is critical to business operations. As the Third Circuit stated in *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285–86 (3d Cir. 2001):

The consumers of Checkpoint Systems' and Check Point Software's products place great importance on, and take great care in, purchasing these products. ... Similarly, purchasers of Check Point Software's firewall technology are highly technical computer and information specialists that must ensure the software is compatible with other programs. Because the security provided is integral to loss prevention in the one case, and confidentiality of communications in the other, the products here are essential to the customers' business needs. Because of the respective products' importance to their buyers' security needs and their high cost, consumers take care in making purchasing decisions and are not likely to be confused by the parties' similar marks.

Similarly, as the court stated in *Lambda Elecs. Corp. v. Lambda Tech., Inc.*, 515 F. Supp. 915, 928 (S.D.N.Y. 1981), “computer software packages are not the sort of products that are

bought on impulse.” As a result of the associated expense and technical nature of such software, the purchaser is highly sophisticated, and this cuts against a finding of likelihood of confusion.

*Id.* Under such circumstances, where goods and/or services are purchased after careful consideration by persons who are highly knowledgeable, even minor differences between the goods/services are enough to avoid a likelihood of confusion

In this case, Enterprise’s customers are sophisticated businesses seeking reliable software for documenting automobile sales and financing. Potential purchasers of such software will take great care when selecting this type of software, given the importance of such documentation. Similarly, companies seeking software such as that offered by the Registrant—for organizational quality control—will take great care to research and understand the nature and provider of the software they are purchasing. Ensuring quality is business critical; decisions of this sort are not made lightly. For such knowledgeable purchasers of business-critical software, even subtle differences between the software are enough to prevent confusion as to source.

For these reasons, the Section 2(d) refusal should be withdrawn.