

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/907865

APPLICANT: salesforce.com, inc.

78907865

CORRESPONDENT ADDRESS:

HEATHER A. DUNN
DLA PIPER RUDNICK GRAY CARY US LLP
153 TOWNSEND ST STE 800
SAN FRANCISCO, CA 94107-1957

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: APPSTORE

CORRESPONDENT'S REFERENCE/DOCKET NO: 349615-159

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/907865

MARK: APPSTORE

THIS IS A FINAL ACTION

This letter responds to the applicant's communication filed on May 21, 2007.

- In the applicant's response, the applicant responded to the refusal issued under section 2(e)(1) of the Trademark Act. After careful consideration of the applicant's response with respect to the refusal, the undersigned examiner continues and make final the 2(e)(1) refusal.

- **FINAL REFUSAL UNDER SECTION 2 (e) (1) OF THE TRADEMARK ACT**

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified services.

The applicant has applied to register the mark “APPSTORE” to be used with “operating on-line marketplaces for buying, selling and exchanging computer software and on-demand applications; Application service provider (ASP) featuring computer software in the field of business project management, business knowledge, information and asset management, customer relationship management, sales, marketing, e-commerce, electronic messaging, and web site development.”

The applicant has argued that the mark “APPSTORE” is not merely descriptive of the services and has submitted a number of registration where the wording “store” has not been disclaimed. The wording “APP” is the abbreviated format for the wording ‘applications.’ The term “Store” is defined as “A place where merchandise is offered for sale.” The applicant’s mark immediately describes a retail opportunity to obtain application, which is shortened to “apps.” This term is commonly used in the applicant’s industry as the Internet evidence indicates. This is demonstrated by the applicant’s description of the services: “[f]rom the moment we started talking about our vision of **a marketplace of on-demand applications**, the market has been asking, 'What is Salesforce.com's strategy to monetize the AppExchange?' AppStore is the answer," Marc Benioff, Salesforce.com chief executive, said in a statement.” (Highlighting added). These two terms merged together does not create a mark that is unitary and requires any imagination. It is evident that the purpose of the mark is to provide application software in a retail environment.” While it is true, a mark which combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, this is not the case in the applicant’s mark. *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). It is also, true however, that the mere combination of the descriptive word does not automatically create a non-descriptive new term. The combination of descriptive words may also result is nothing more than the combination of descriptive words. *In re IBP, Inc.* 228 USPQ 303 (TTAB 1985); *In re Wink Corp.*, 218 USPQ 739 (TTAB 1983), *In re Quik-Print Copy Shop, Inc.*, 205 USPQ 505 (CCPA 1980).

The applicant further argues that the wording “STORE” is not descriptive when used in connection with the specified services and that the examining attorney has improperly dissected the mark into its component words to arrive at the conclusion that the mark is merely descriptive. This argument is without merit, however, the examining attorney’s discussion of each word in the mark separately in order to show that the designation in its entirety is descriptive is not the same thing as dissecting the mark. *See In re Medical Plastics, Inc.*, 192 USPQ 239. The applicant’s recitation clearly states that the applicant’s services involve “selling and exchanging computer software” which indicates that the applicant’s services are retail-based. Accordingly, the wording “STORE” in the mark is immediately descriptive of a feature of some of the applicant’s services.

The marriage of the words “APP” and “STORE” result in a clear meaning of the combination of these terms and does not create an unusual or unexpected result when the mark is used in connection with applicant’s services. A term is suggestive if some imagination, thought or perception is required to determine the nature of the services from the term. A suggestive term differs from a descriptive term, which immediately tells something about the services. *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984). A suggestive mark is registrable on the Principal Register. TMEP section 1209.01(a).

As a whole, the applicant’s mark constitutes a merely descriptive designation of applicant’s goods and services. This argument is without merit and the applicant is referred to the third-part registration in

which the term has consistently held to be descriptive by the office when used in marks created by two terms merged together. Prior decisions and actions of other examiners in registering different marks are without evidentiary value and are not binding upon the Patent and Trademark Office. Each case is decided on its own facts, and each mark stands on its own merits.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive, unique or has an incongruous meaning. However, in the present case the proposed mark is merely descriptive in its entirety when applied to the applicant's goods and services. Thus, the refusal to register the mark under Section 2(e) (1) is continued and made FINAL.

For the forgoing reasons, the refusal issued under section 2(e)(1) is continued and made FINAL.

APPLICANT'S OPTIONS

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

Georgia Ann Carty Ellis
/GeorgiaAnnCartyEllis/
Trademark Attorney
Law Office 117
(571)-272-9377

NOTICE OF NEW PROCEDURE FOR E-MAILED OFFICE ACTIONS: In late spring 2007, for any applicant who authorizes e-mail communication with the USPTO, the USPTO will no longer directly e-mail the actual Office action to the applicant. Instead, upon issuance of an Office action, the USPTO will e-mail the applicant a notice with a link/web address to access the Office action using Trademark Document Retrieval (TDR), which is located on the USPTO website at <http://portal.uspto.gov/external/portal/tow>. The Office action will not be attached to the e-mail notice. Upon receipt of the notice, the applicant can then view and print the actual Office action and any evidentiary attachments using the provided link/web address. TDR is available 24 hours a day, seven days

a week, including holidays and weekends. This new process is intended to eliminate problems associated with e-mailed Office actions that contain numerous attachments.

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.** To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.