

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/020816

APPLICANT: DASSAULT SYSTEMES

79020816

CORRESPONDENT ADDRESS:
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F-75847 PARIS CEDEX 17 FRANCE

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

MARK: 3D VIA

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

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 79/020816

INTERNATIONAL REGISTRATION NO. 0876355

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. 15 U.S.C. §1141h(c).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the United States Patent and Trademark Office (USPTO)** in trademark matters are:

- (1) **Attorneys in good standing with the bar of any U.S. federal court or the highest court of any U.S. state, and**
- (2) **Canadian attorneys who have applied for and received reciprocal recognition** by the USPTO under 37 C.F.R. §10.14(c).

37 C.F.R. §10.14; TMEP §602.

Foreign attorneys are *not* permitted to practice before the USPTO, other than properly authorized Canadian attorneys. Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. *A response signed by an unauthorized foreign attorney will be considered an incomplete response.* TMEP §§602, 602.03, 603.05.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

The assigned examining attorney has reviewed the referenced application and determined the following.

No Conflicting Marks Noted

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 704.02.

Identification of Goods and Services Indefinite

Applicant must clarify the identification of goods to specify the common commercial or generic name for the goods. If there is no common commercial or generic name, then applicant must describe the product and intended consumer as well as its main purpose and intended uses.

Applicant must remove any parentheses from the identification of goods and/or services and incorporate the parenthetical information into the description. Generally, parentheses and brackets should not be used in identifications. Parenthetical information is only permitted in identifications if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

The applicant may adopt the following identification, if accurate:

Software for 3D graphic display, especially for creating, animating, simulating and experimenting with objects, characters IN THE NATURE OF PEOPLE, information or ideas, for navigation, research, exploration, collaboration; software for marketing and maintenance of goods; software for presenting knowledge in connection with goods intended for industries or end consumers, their production, use, maintenance, documentation, perception and consumption; software for designing games; gaming software; software for MULTI-media content management, preproduction and postproduction; data exchange software, NAMELY [MORE SPECIFICALLY DESCRIBE SOFTWARE]; educational software FEATURING INSTRUCTION IN [SPECIFY SUBJECT MATTER]; training software FEATURING INSTRUCTION IN [SPECIFY SUBJECT MATTER]; teaching software FEATURING INSTRUCTION IN [SPECIFY SUBJECT MATTER]; 3D content management software, NAMELY, [MORE SPECIFICALLY DESCRIBE FUNCTION]; CD-ROMs, DVDs, minidisks and diskettes ALL [INDICATE BLANK AND/OR FEATURING SPECIFY SUBJECT MATTER], in international class 9;

Files, NAMELY, [SPECIFY TYPE IN CLASS 9, E.G., CARD FILES]; printed matter, NAMELY

[INDICATE SPECIFIC GOODS]; newspapers, books, NAMELY, [LIST SPECIFIC TYPE AND SUBJECT MATTER IF APPROPRIATE], PRINTED periodicals IN THE FIELD OF [INDICATE SUBJECT MATTER]; programming manuals, NAMELY, COMPUTER PROGRAM MANUALS FOR [INDICATE SUBJECT MATTER]; operating manuals for computer programs; photographs, printing blocks; PRINTED instructional and teaching material IN THE FIELD OF [SPECIFY AREA OF USE], in international class 16;

~~Supply (transmission) of information~~ ELECTRONIC DATA TRANSMISSION, on line, with regard to training relating to software and software sale, in international class 38;

Training services in the field of software, information technology and 3D content creation; training services and courses provided on line in the field of software; organization and conducting of EDUCATIONAL conferences with regard to software, program development, computer systems and 3D content creation, in international class 41;

Computer programming services; services for the design of goods and GRAHPIC characters IN THE NATURE PEOPLE (~~people~~) ~~OR~~ AND in connection with the operational sequencing of industrial processes assisted by computer; rental of computers, computer programs ~~OR~~ AND peripheral equipment for computers; engineering services and technical consultancy concerning the design of goods and production means ~~OR~~ AND the operational sequencing of industrial processes; software design, maintenance and updating services; technical assistance services for software customization for adapting said software to the specific needs resulting from the customer's activity and working methods; advisory services in the field of information technology, in international class 42.

TMEP section 1402.01.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

The applicant is strongly encouraged to consult the Acceptable Identification of Goods and Services Manual. The Manual is available on the PTO's "homepage" on the Internet, which can be accessed at <http://tess2.uspto.gov/netathtml/tidm.html>. TMEP Section 1404.04. The Acceptable Identification of Goods and Services Manual sets out acceptable language for identifying goods and services of various types. Utilizing identification language from the Manual may enable trademark owners to avoid problems relating to indefiniteness with respect to the goods or services identified in their applications for registration; however, applicants should note that they must assert actual use in commerce or a bona fide intent to use the mark in commerce for the goods or services specified. TMEP Section 1404.04.

Disclaimer Required

The applicant must disclaim the descriptive wording "3D" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.03(a). The applicant own use of the term 3D in its identification of goods and services demonstrates the descriptive nature of the term. The

wording is merely descriptive because it describes the type of goods and services, namely goods and services for 3D applications.

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.08(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use 3D apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm'r Pats. 1983).

Explanation of Effect of Disclaimer

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

Proper Response to Office Action

A response to this Office action requires no set form. The applicant, however, must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them.

Any response must be signed. If the applicant is using an attorney for this application, the attorney must sign the response. 37 C.F.R. §10.18(a). If an attorney does not represent the applicant, the response must be signed by someone with legal authority to bind the applicant (e.g., an appropriate corporate officer or general partner of a partnership). A non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (*See* TMEP §804.04) is *not* entitled to sign responses to office actions, or to authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant. TMEP section 712.01.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Rudy Singleton/

Examining Attorney, Law Office 102
(571) 272-9262

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.