

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
March 31, 2008  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ultimus, Inc.

Serial No. 78688816

Howard A. MacCord, Jr. of MacCord Mason PLLC for Ultimus,  
Inc.

David Collier, Trademark Examining Attorney, Law Office 104  
(Chris Doninger, Managing Attorney).

Before Bucher, Zervas, and Ritchie de Larena,  
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Ultimus, Inc. seeks registration on the Principal  
Register of the mark **UNRULY EVENTS** (*in standard character  
format*) for services recited in the application as  
"providing on-line communications links which transfer the  
website user to other local and global web pages featuring  
software for workflow automation" in International Class  
38.<sup>1</sup>

<sup>1</sup> Application Serial No. 78688816 was filed on August 9, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. A Statement of Use was filed on January 11, 2007 claiming first use anywhere and first use in commerce at least as early as January 8, 2007.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that applicant's specimen of record (reproduced below) does not show the applied-for mark in use in commerce as a service mark for the services recited in the application and the Statement of Use (SOU). 15 U.S.C. §§ 1051 and 1127, and 37 C.F.R. §§ 2.56 and 2.88.

## Adaptive Discovery®

### Adaptive Discovery Drives BPM Return on Investment



*"Adaptive Discovery sets Ultimus apart."*

Connie Moore, Forrester  
Wave 2006

Adaptive Discovery helps drive strong ROI because it 1) accelerates the launch of BPM projects, and 2) makes it much faster to change and adapt processes after they have been deployed.

### Accelerating Deployment and Driving Savings

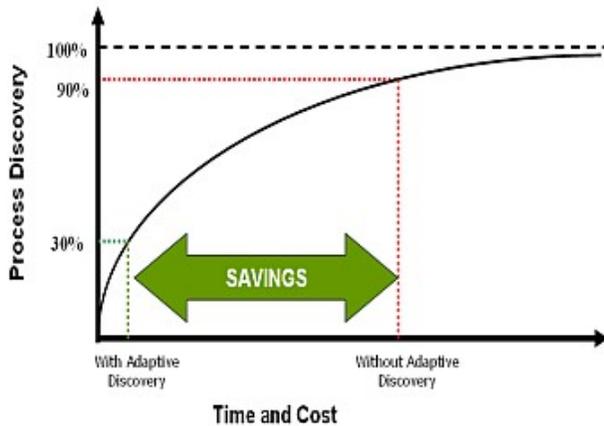


*"Sure there is embedded BPM in my ERP system. However, I may wish to change my ERP system. By using Ultimus, I can get the immediate benefits of BPM without having to change every process that touches my ERP system."*

Marcelo Ramirez Rexam do  
Brazil, World's Largest  
Beverage Can Manufacturer

Process Discovery, the first step in BPM, can often cause project delays. In fact, research shows that defining business processes and rules takes up to 71% of the time for a BPM project while developing, installing and testing the system take far less time.

With Ultimus, organizations can deploy processes faster by shortening process discovery. This reduces the time and cost of deployment and generates savings as shown below. With Adaptive Discovery technology, an organization can quickly agree on the key business rules and deploy the process. They do not need to identify every possible rule, step or exception because the Adaptive Discovery [Unruly Events™](#) technology enables new rules to be added dynamically as they are discovered in the natural course of doing business.



Learn more about Adaptive Discovery... → [Learn more](#)

“Our customer rebate process is very complex. It deals with hundreds of customers, products and program definitions - while requiring approval from many people across sales, marketing, finance, and product management. In addition, we must handle exceptions as they occur – which is sometimes on a daily basis. Ultimus BPM gives us great process control and visibility while Adaptive Discovery has enabled us to handle exceptions and change in minutes or hours instead of days or weeks.”

Minty Meade  
National Gypsum

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Applicant and the Trademark Examining Attorney have briefed the issues before us. We affirm the refusal to register.

**Prosecution history since the filing of the SOU**

In his initial examination of the SOU of January 11, 2007, the Trademark Examining Attorney refused registration, stating the following:

In the present case, the specimen does not describe the services, but rather describes the underlying technology within the software.

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<sup>2</sup> <http://www.ultimus.com/products/Adaptive+Discovery.htm>

In its response of May 11, 2007, applicant argues that its specimen shows use of its mark in the actual rendering of its services, similar to what the Office has accepted from hundreds of other registrants:

The specimen submitted with the Statement of Use is a print from an on-line webpage that includes "UNRULY EVENTS" as an active link to other web pages featuring software for workflow automation. The page that is live has Unruly Events as hyperlink to <http://www.ultimus.com/products/Adaptive+Discovery.htm>. As such, the usage on the submitted specimen constitutes an on-line communications link which transfers the website user to other local and global web pages featuring software for workflow automation, which are exactly the services recited in the application. While "unruly events" also refers to a feature of the software, that does not negate the fact that it also meets the services description.

The Trademark Examining Attorney's Final refusal to register explained why the specimen fails to show an association of the mark with the identified services:

... The applicant argues that the mark, as shown on the specimen is a link to other web pages featuring their services. As noted before, this specimen is unacceptable. An adequate specimen would consist of the mark shown in direct connection with the applicant's services.

The Trademark Examining Attorney also explained his concern regarding applicant's specimen and the contents of TMEP § 1301.04, which is entitled "Specimens of Use for Services

Marks." According to the Trademark Examining Attorney, any specimen must show use as a service mark and that there must be an association between the alleged mark and the recited services. The Trademark Examining Attorney explores this in more detail in his brief, citing verbatim to significant portions of TMEP §§ 1301.04, 1301.04(a), 1301.04(b) and 1301.04(c). Immediately following this discussion, the Trademark Examining Attorney also addresses the differences between the provision of the technical telecommunication link by which persons can communicate, in International Class 38, and the varied services of content providers.

In its appeal brief, applicant responds directly to the Trademark Examining Attorney's citation to TMEP § 1301.04 in his Final refusal, arguing that its specimen shows use of the mark in connection with the recited services, and that the law does not require that the specimen recite the services. Then, in its reply brief, applicant argues that "the Examining Attorney has made a new refusal in his brief." Applicant argues that the Trademark Examining Attorney's brief, in referring to classification notes related to International Class 38, suggests that the basis for the refusal is that applicant's

services were misclassified. Applicant contends that in the event that its services have been misidentified or misclassified, in fairness to applicant, it would be appropriate to remand this file so that the Trademark Examining Attorney can more clearly elucidate the nature of the refusal, and provide applicant an opportunity to amend its recitation of services, as appropriate.

### **Analysis**

Upon consideration of the specimen and the arguments of both the Trademark Examining Attorney and applicant, we find that the specimen fails to show the mark in use in commerce as a service mark for the services identified in the application.

A service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services."

Trademark Act Section 45, 15 U.S.C. § 1127. "[B]ecause by its very nature a service mark can be used in a wide variety of ways, the types of specimens which may be

submitted as evidence of use are varied." *In re Metriplex Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992).

As noted by the Trademark Examining Attorney, when used in advertising of services, the service mark must not merely appear in the advertising material that also discusses or offers the services, but must be associated with the services in such a manner as would be sufficient to indicate to potential purchasers or users of the services that the mark identifies the services and their source. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) ["The minimum requirement is some direct association between the offer of *services* and the mark sought to be registered therefor."] (italics in original), and *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989) [requirement is for "a direct association between the mark sought to be registered and the services specified in the application, i.e., that [the mark] be used in such a manner that it would be readily perceived as identifying such services"]. When used in the actual sale of services, as opposed to their advertising, it is not *per se* necessary that the services be referenced, but in such cases it may be necessary to explain how the mark appears during the

rendering of the service and, therefore, why the purchaser or user of the service would recognize and associate the mark with the service. *See Metriplex*, 23 USPQ2d at 1316 ["As applicant explained in its declaration, the specimens show the mark as it appears on a computer terminal in the course of applicant's rendering of the services."].

In connection with applicant's argument that the specimen shows use of the mark in connection with the services, we find that the fact a consumer may be able to follow applicant's hyperlink by clicking on the words Unruly Events in the specimen in no way means that applicant has shown use of the mark in the service of transferring the website user to *other* local and global web pages featuring software for workflow automation. In fact, we agree with the Trademark Examining Attorney that this specimen is unacceptable to show an association of the mark with the identified services. Applicant does not identify exactly how this specimen makes an association between the mark and the services recited in the application and SOU. The specimen identifies "Unruly Events" as "technology [that] enables new rules to be added dynamically as they are discovered in the natural course of doing business." This original web page *qua* specimen associates the mark with a component of its Adaptive Discovery<sup>®</sup> software.

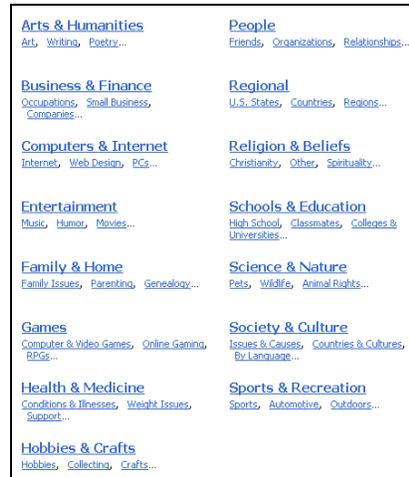
While the words Unruly Events themselves serve as a hyperlink, as one views this page, there is no association between the alleged mark and "providing on-line communications links which transfer the website user to other local and global web pages featuring software for workflow automation." While this term, as used on the specimen of record, identifies a proprietary piece of applicant's software, the web page neither promises nor provides a single connection to the websites of *others* featuring software for workflow automation.

Perhaps we can best clarify our determination (i.e., that applicant's specimen of record does not show the applied-for mark in use in commerce as a service mark for the services recited in the Statement of Use) by contrasting applicant's case with the third-party situations that applicant put forward as being analogous to the instant case.

**Contrasts with applicant's two chosen examples**

Applicant points to two examples from the XANGA BLOGRINGS and XYREM websites that it claims are analogous to this case. For the reasons set forth below, we find that they are distinguishable from applicant's services/specimens.

First, applicant points to a firm involved in website linking and providing blogging sites at Xanga.COM. Xanga is involved in interactive hosting services which allow the user to publish and share their own content and images online. In the website



excerpt made of record by applicant, on a page where the **XANGA BLOGRINGS** marks appear prominently on the header, XANGA provides an entire page of hyperlinks, as seen above.<sup>3</sup>

The language of "providing on-line communications links which transfer the website user to other local and global web pages" is the entirety of a recitation of services that would be used by an information technology (IT) company providing technical linking services. Like each of the other three-hundred-plus listings in the ID and classification manual for International Class 38 services, this recitation fits into the category of services characterized by information technologies and/or the

<sup>3</sup> <http://groups.xanga.com/groups/>; Registration No. 3156276 for the mark BLOGRINGS for "providing on-line communications links which transfer the website user to other local and global web pages featuring the ability for users to affiliate websites of a common focus or theme that use a dated log format" in International Class 38.

electronic transmission of data, etc. Consistent with this understanding, Xanga is an IT company involved in interactive online hosting and linking services for others - services correctly classified in International Class 38.

By contrast with Xanga, applicant's underlying business is providing sophisticated tools to its clients involved in Business Process Management (BPM) or Business Process Reengineering (BPR). Applicant is clearly not a telecommunication services provider, so the way in which Xanga uses its service mark in the process of offering interactive hosting services is not *apropos* to our case.

As noted by the Trademark Examining Attorney, more *apropos* to applicant would be the recitations of services of other content providers who are, according to the ID manual, "providing links to websites of others featuring {*indicate field or subject matter of linked sites ...*}." Consistent with the Nice International Classification System, a classification scheme used administratively for purposes of registering marks with the United States Patent and Trademark Office, such services are then correctly classified in the class of that field or subject matter. So, for example, an online website that promotes or advertises the goods or services of another on another

linked site would be classified in International Class 35.<sup>4</sup> Similarly, links to other websites featuring travel would be in International Class 39,<sup>5</sup> Internet search engines would be in International Class 42,<sup>6</sup> links to medical information would be in International Class 44,<sup>7</sup> etc. In fact, applicant's second example fits this general category of linking services.

The second website/third-party registration combination that applicant points out involves the trademark owner for **XYREM** pharmaceutical preparation for

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<sup>4</sup> For example, the ID manual has entries such as "promoting the goods and services of others by providing hypertext links to the web sites of others"; "promoting the goods and services of others by providing a web site at which users can link to {indicate subject matter of links}"; "promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others"; "promoting the goods and services of others by providing a web site featuring coupons, rebates, price-comparison information, product reviews, links to the retail web sites of others, and discount information"; or "promoting the goods and services of others by providing a community-driven web site featuring user-submitted content in the nature of coupons, rebates, price-comparison information, product reviews, links to the retail web sites of others, and discount information."

<sup>5</sup> "Providing a web site and web site links to geographic information, map images, and trip routing" or "providing links to web sites of others featuring travel."

<sup>6</sup> "Providing customized on-line web pages featuring user-defined information, which includes search engines and on-line web links to other web sites."

<sup>7</sup> "Providing links to the web sites of others featuring information about the diagnosis and treatment of cancer."

the treatment of narcolepsy. The Xyrem website contains a web page for prospective patients that has links to the websites of a number of other organizations dealing with sleep disorders, such as the American Academy of Sleep Medicine.<sup>8</sup>

Accordingly, to the extent that applicant would be providing content in the field of business process management or business process reengineering, its underlying services would be classified in International Class 35. To the extent that any of applicant's secondary, value-added services allegedly involved herein are provided by means of a telecommunication link, they would still remain in class 35.

However, the Trademark Examining Attorney's final refusals is not over any potential problems with

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<sup>8</sup> <http://xyrem.com/html/main.isx>; Registration No. 3162634 for the mark XYREM for "providing on-line communications links which transfer the website user to other local and global web pages; and on-line document delivery via a global computer network" in International Class 38.

The screen-print from the XYREM.COM site shows that this registrant is indeed providing a linking service on a page having the service mark shown prominently at the top of the page. However, as noted above, a more accurate ID and classification might well have been "providing on-line communications links which transfer the website user to other local and global web pages *about the diagnosis and treatment of narcolepsy and related sleep disorders* and on-line document delivery via a global computer network of the same" in International Class 44.

misclassification of the services. Rather, as suggested by the Trademark Examining Attorney in the Office's brief, it appears that this is a case in which applicant chose an appropriately-worded recitation of services that is on its face acceptable to the Trademark Office, but one where applicant may well not be providing the service recited.

With this background, we contrast the nature of applicant's link as well as the details of its alleged services with the value-added services of XYREM.COM.

Turning again to applicant, with the involved application, applicant is claiming a service in a hyperlink contained in a page of its website, "[ULTIMUS® Empowering People. Driving Process, An Innovative Leader in Adaptive Technologies.](#)" Clicking on the hyperlink entitled [Unruly Events](#) takes one to a second page on applicant's own website. Neither the Trademark Examining Attorney nor applicant have supplied copies of this forward link.

While applicant chides the Trademark Examining Attorney for allegedly failing to check out this forward link, applicant has not provided an explanation or declaration supporting registrability by explaining the way in which the specimen shows use of the mark in the rendering or selling of applicant's services. *Cf. In re Metriplex Inc.*, 23 USPQ2d at 1316-17.

In short then, applicant's claimed service ["providing on-line communications links which transfer the website user to *other* local and global web pages featuring software for workflow automation"] [*emphasis* supplied] is actually encapsulated in ones clicking on the hyperlink, leading one to another "Adaptive Discovery™"/[Unruly Events™](#) page located within applicant own website.

However, the key concept in all of the linking services provided by content providers is that the service provider's web page is linking the user to "others," "other sites," "the goods or services of another," "promoting the goods or services of others," etc. As seen in the jumping-off page of the XYREM.COM website, there is a brief description about what the user will find upon following the link forward: "For more information about narcolepsy ... ."

By contrast, there is no text on applicant's specimen page - other than the markings characterizing any embedded hyperlink - indicating that additional information is being provided through this link. A hypothetical in the instant case, analogous to the situation shown in the XYREM.COM site, would be a web page using the UNRULY EVENTS mark prominently on a page header, where a primary focus of the page would be one or more links, for example, to scholarly

resources from universities/think-tanks discussing the cutting edge advances in Artificial Intelligence as applied to the field of BPM: "For more information about the latest software developments in BPM, ..." In this hypothetical, the actual hyperlink may be in the image of a button, without the alleged trademark even showing on the button.

As noted above, applicant's failure to be more explicit about the link itself - particularly when that feature comprises the entirety of the claimed service - actually points to a related but equally serious problem fatal to applicant's registrability herein: simply linking back into one's own website is of benefit only to the website owner. While such a feature may well make applicant's site more usable, functional or profitable, that feature would be considered, at most, self-promotion for the content provider, and is not considered a service for the benefit of *others*, under the Lanham Act.

*Decision:* We affirm the refusal to register this designation based upon the ground that applicant's specimen of record does not show the applied-for mark in use in commerce as a service mark for the services recited in the Statement of Use. Inasmuch as the refusal herein is not

predicated upon any potential misclassification of applicant's services, and given the posture of this case otherwise, there is no reason to remand this application to the Trademark Examining Attorney for further examination.