From: Bello, Zack

Sent: 10/31/2008 9:42:42 AM

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Subject: TRADEMARK APPLICATION NO. 77149255 - OPTIMIZED CONTACT SO - N/A - Message 1 of 5

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Attachment Information:
Count: 11
Files: 77149222P001OF003.JPG, 77149222P002OF003.JPG, 77149222P003OF003.JPG, optimize-1.jpg, optimize-2.jpg, contact-1.jpg, contact-2.jpg, solution-1.jpg, solution-2.jpg, optimCont1-1.jpg, 77149255.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/149255

MARK: OPTIMIZED CONTACT SO

CORRESPONDENT ADDRESS:
Bradford R. Norton
325 E. Warm Springs Road, Suite 200
Las Vegas NV 89119

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: SELLING SOURCE, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:
brad.norton@sellingsource.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark OPTIMIZED CONTACT SOLUTIONS for "direct mail marketing and consulting services." Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) because the mark is merely descriptive of the applicant's services.

ISSUE

The applicant's mark, OPTIMIZED CONTACT SOLUTIONS, is merely descriptive of the identified services and should be refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

FACTS

On April 5, 2007, applicant applied to register the mark OPTIMIZED CONTACT SOLUTIONS on the Principal Register for "direct mail marketing and consulting services." The application in issue is a companion application to application serial No. 77149222, OPTIMIZED CONTACT SOLUTIONS, TARGETED DIRECT MAIL MARKETING for "direct mail marketing and consulting services." The applicant disclaimed the wordings OPTIMIZED CONTACT SOLUTIONS, TARGETED DIRECT MAIL MARKETING in the companion application and it is now published for opposition. See attachments.

On July 21, 2007, the examining attorney refused registration of the mark under Section 2(e)(1) because OPTIMIZED CONTACT SOLUTIONS, when used in conjunction with the identified services, describes the characteristic, feature, function and purpose of the identified services. The examining attorney attached dictionary evidence as to the descriptive nature of the words and asserted that the mark is unregistrable because the applicant's combination of descriptive terms failed to create an incongruent meaning. The examining attorney suggested registration on the Supplemental Register.

The applicant filed a response on 01/21/08 arguing the mark is arbitrary or at most suggestive. The examining attorney found the applicant's argument unpersuasive. Also, the applicant's assertion was inconsistent with the position it took during the prosecution of the companion application Serial No. 77149222 where it disclaimed OPTIMIZED CONTACT SOLUTIONS, TARGETED DIRECT MAIL MARKETING without any objections.

On February 11, 2008, the examining attorney issues a final refusal with more evidence as to the descriptive nature of the mark. The evidence includes online articles and advertisement showing that the major component of the mark is a term of art in the marketing services. The examining attorney once again suggested registration on the Supplemental Register.

On April 16, 2008, the applicant appointed a new attorney. On July 7, 2008, the applicant filed an appeal and submitted its brief arguing against the Section 2(e)(1) final refusal.

ARGUMENT

THE MARK IS MERELY DESCRIPTIVE BECAUSE IT CONVEYS AN IMMEDIATE IDEA OF A CHARACTERISTIC OF THE SERVICES

The law applicable to this refusal is well settled. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

In the instant case, the applicant's mark, OPTIMIZED CONTACT SOLUTIONS, merely describes a feature, quality, characteristic, function, or purpose of the identified services. Firstly, the examining attorney asserts that applicant's mark is descriptive based on dictionary definition of the terms. The term OPTIMIZED means efficient. Additionally, CONTACT refers to establishment of communication. Further, SOLUTIONS means problem solving. See attachments. In essence, the applicant's mark represents *efficient contact problem solving* and nothing else. Thus, the applicant merely combined terms that describe the function or purpose of the identified services. A mark that combines descriptive words may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark's immediate association with the nursery rhyme "sugar and spice and everything nice"). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *See, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive for theater ticket sales services).

The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark created imparts an incongruous meaning as used in connection with the goods and/or services. TMEP §1209.03(d); *e.g., In re Copytele, Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *In re Associated Theatre Clubs*, 9 USPQ2d at 1662. Where, as in this case, the combination

of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive.

Furthermore, the examining attorney asserts that OPTIMIZED CONTACT is a term of art in the marketing field. The wording "optimized contact" represents targeting or directing business contacts, sales or sales pitch toward people who are most likely to purchase. It is obviously a marketing tool. The following online websites support examiner's assertion as to the descriptive use of the term in the marketing industry:

a)

http://www.targetbase.com/services/cp_3.html

The plan to reach the customer

The final step in communications planning is to create an **optimized contact** plan and touchpoint strategy, defining how many target consumers we should reach, using which media. This plan describes how you should engage the consumer and deliver motivational messaging. It also details the timing, frequency and recommended interaction between contact points.

b)

http://www.professionalagent.com/premium.html

Professional Agent websites are the ideal solution for real estate agents who want the best in online marketing.

With such great features as built-in, **optimized contact** forms, expert optimization for search engine placement, and the ability to instantly modify your website yourself with no technical skills, your Professional Agent website will easily provide a handsome return on your investment.

100% satisfaction guaranteed.

Cancel at anytime.

c)

http://www.relativityllc.com/contact-center-consulting.html

The bottom line is that call center consulting solutions from Relativity LLC, implemented in conjunction with our partners, are complete solutions that incorporate **optimized contact** center technology, proper contact center software, excellent scripting, workflow, contact center physical environment, and people and process management.

Relativity can also assist you in marketing your call center services with a turnkey marketing solution that leverages Nurture Marketing**.**

d)

http://findarticles.com/p/articles/mi_m0EIN/is_/ai_61786475. It

The partnership will offer multimedia contact centers a unique combination of technologies that improve customer **sales**/service representatives' (CSRs) service delivery through multiple channels, such as the telephone, e-mail and Web chat. In addition, the joint solutions will help ensure **optimized contact** center performance through robust recording and analysis, as well as forecasting and scheduling functionality. Common customers will benefit from their ability to import agent information from Blue Pumpkin PrimeTime(TM) solutions directly into Witness Systems' eQuality Analysis(TM) solution to compare performance goals against expectations.

e)

http://newsroom.cisco.com/dlls/2006/prod_022106c.html

"After seeing the benefits that IP telephony can bring, companies are increasingly adopting IP-based contact centers for mission-critical service and support," said Laurent Philonenko, vice president and general manager of Cisco's customer contact business unit. "Cisco IPCC is the ideal solution to help Cox realize their vision for **optimized contact** center management."

Also, CONTACT SOLUTION, which is another significant component of the mark, is being used as a term of art in the marketing field as indicated below:

f)

http://www.datasquirt.co.nz/ContactSolutions/CaseStudies/Default.aspx?id=192.

The **CONTACT solution** has given the Cerebos Gregg's marketing team the ability to quickly create and implement its own promotional campaigns and competitions using the CONTACT Competition & Campaign Manager™ module (CCM)."

g)

http://mac.softpedia.com/get/Business/Contact-vX.shtml.

Marketing and **contact solution**

INtex Contact vX is a powerful solution to all your **marketing** and contacting needs.

i)

http://findarticles.com/p/articles/mi_m0EIN/is_/ai_78328618.

WESTFORD, Mass.--(BUSINESS WIRE)--Sept. 17, 2001

Davox Corporation (NASDAQ: DAVX), a proven provider of customer interaction management (CIM) solutions, today announced that Zenta Technologies, a contact center outsourcing service in India, has selected Davox's Ensemble(TM) customer **contact solution** for its contact center. A member of the holding company Hiranandani Group, Zenta will deploy 200 Ensemble seats for its multi-media contact center in Mumbai, India.

The enumerated websites belong to the applicant's competitors. They are using a significant component of the mark as a marketing tool to provide and promote efficient customer contact or communication. They carry out customer contact in several ways, namely, email, direct mail, telephone call, etc. The general descriptive use of the wording by competitors supports examiner's assertion that the entire mark is unregistrable on the Principal Register. Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

The applicant argues that the examining attorney improperly dissected the mark. This argument is misplaced because the entire mark is descriptive. In determining the

descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that "the PTO may [separately] consider the meaning of 'patents' and the meaning of '.com' with respect to the goods identified in the application."); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that "[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole."); *In re Med. Plastics, Inc.*, 192 USPQ 239, 240 (TTAB 1976) (holding a mark generic when noting that "[t]he Examiner did discuss each word in the mark separately in order to show that the term in its entirety was the apt name of the applicant's goods. This is not the same thing as dissecting a mark."). Thus the examining attorney's use of the dictionary definitions to support the issue of descriptiveness is appropriate in this case.

The applicant further argues that absence of no "similar registered or pending marks" that would bar registration gives credence to the fact that the mark is not descriptive. This argument is irrelevant because the issue in the instant case, is not likelihood of confusion. Because there is no statutory bar to the registration as to issue pertaining to the Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq*, is not an indication that other issues such as Trademark Act Section 2(e)(1), 15 U.S.C.

§1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq*, is not relevant or will not be raised.

Moreover, applicant argues the evidence provided in one of the office actions is wrong because entities indicated in the evidence are not its competitors. This argument is unpersuasive because some of the entities are potential competitors that specialized in the marketing field. Also, the entities do not have to be directly competitive before the issue of descriptiveness could be raised. Additionally, two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

Finally, the applicant had admitted that the mark is unregistrable on the Principal Register. The identical wording was disclaimed in the prosecution of companion application Serial No. 77149222 without any objections when the issue was raised. Accordingly, the examining attorney maintains that the mark is descriptive under Section 2(e)(1).

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Sections 1052(e)(1), be affirmed.

Respectfully submitted,

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