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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Selling Source, LLC

Serial No. 77149255

Bradford R. Norton for Selling Source, LLC.

Zachary R. Bello, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Zervas and Cataldo, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Selling Source, LLC filed an application to register
the mark OPTIMIZED CONTACT SOLUTIONS for "direct mail
marketing and consulting services."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act, 15 U.S.C.
§1052(e)(1), on the ground that applicant's mark, when used
in connection with applicant's services, is merely

¹ Application Serial No. 77149255, filed April 5, 2007, alleging
a bona fide intention to use the mark in commerce.

descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Before considering the merits of the appeal, we turn our attention to an evidentiary matter. The examining attorney impermissibly submitted new evidence with his appeal brief. Firstly, the examining attorney submitted a TARR printout of applicant's co-pending application (serial no. 77149222) that has matured into Registration No. 3550878 (issued on December 23, 2008) for the mark OCS OPTIMIZED CONTACT SOLUTIONS TARGETED DIRECT MAIL MARKETING and design for "direct mail marketing and consulting services." The words "OPTIMIZED CONTACT SOLUTIONS, TARGETED DIRECT MAIL MARKETING" are disclaimed. Secondly, the examining attorney submitted excerpts of third-party websites showing uses of the term "optimized contact" in connection with marketing services.

Trademark Rule 2.142(d) provides that the application record should be complete prior to the filing of an appeal. The Board ordinarily will not consider additional evidence submitted after the appeal is filed. TBMP §1207.01 (2d ed. rev. 2004). Although applicant did not file a reply brief and, therefore, did not object to the untimely submission, we decline to consider the additional evidence attached to

the examining attorney's appeal brief due to its untimely submission.

The examining attorney maintains that the proposed mark immediately conveys the purpose of applicant's direct mail marketing and consulting services, namely "efficient [customer] contact problem solving." In support of the refusal, the examining attorney submitted dictionary definitions of each of the terms comprising applicant's mark, and excerpts of third-party websites showing uses of the term "contact solutions."

Applicant argues that its mark is arbitrary or, at worst, only suggestive of the services recited in the application. Applicant states that the examining attorney improperly dissected applicant's mark to arrive at the conclusion that it is merely descriptive. There are no similar marks on the register, indicating, according to applicant, that the proposed mark is not merely descriptive. Applicant dismisses the examining attorney's Internet evidence on the basis that the websites have nothing to do with the type of services rendered by applicant. Lastly, applicant asserts that any doubt on the issue of mere descriptiveness must be resolved in its favor.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (TTAB 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question

is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). The "average" or "ordinary" consumer is the class or classes of actual or prospective customers of applicant's goods or services. *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, e.g., *In re Tower Tech Inc.*, supra [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; and *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs].

The term "optimized" is defined as "to make as perfect or effective as possible." The term "contact" means "connection or interaction; communication." The term "solution" is defined as "the method or process of solving

a problem; the answer to or disposition of a problem." The American Heritage Dictionary of the English Language (3d ed. 1992).

The record also includes several examples of third-party descriptive uses of the term "contact solutions" in connection with the methods of businesses in solving a specific problem, which is staying in contact with its customers.

Based on the meanings of the individual components comprising applicant's mark as they are understood in the marketing field, we find that the combination of the words is merely descriptive of applicant's services. The individual merely descriptive components retain their descriptive character when combined to form the composite OPTIMIZED CONTACT SOLUTIONS. The proposed mark OPTIMIZED CONTACT SOLUTIONS merely describes a significant character or feature of applicant's direct mail marketing and consulting services, namely that they provide a business with the most effective methods of solving the problem of staying in communication with its customers. No imagination is required to discern this feature or purpose of the services. The fact that applicant may be the first or only user of the merely descriptive designation is outweighed by the weight of the evidence of mere

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descriptiveness. *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985).

While applicant argues that any doubt on the issue of mere descriptiveness should be resolved in its favor, we have no such doubts.

Decision: The refusal to register is affirmed.