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October 19, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ScanSource, Inc.

Serial No. 77731385

Neil M. Batavia of Dority & Manning, P.A. for ScanSource, Inc.

Barney L. Charlon, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Bucher, Zervas and Shaw, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

ScanSource, Inc. is the owner of an application¹ to register on the Supplemental Register the term PARTNER SERVICES (in standard character form) for "business development consulting services" in International Class 35.²

The examining attorney issued a final refusal to register applicant's proposed mark for the International

¹ Application Serial No. 77731385, reciting first use and first use in commerce on February 28, 2000.

² The application also includes International Class 41 services which have not been refused registration.

Class 35 services under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c), on the ground that the proposed mark is generic and thus incapable of registration on the Supplemental Register. Both applicant and the examining attorney have filed briefs.

The examining attorney maintains that the proposed mark "refer[s] to business development consulting services involving the provision of services by partner companies" and is therefore generic.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See *In re Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of services in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). This determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to

be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

The type of evidence that may satisfy the examining attorney's burden may vary depending on the circumstances presented. *Gould*, 5 USPQ2d at 1111-12 (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens based on dictionary definitions of the constituent parts and corroborated by applicant's specimens of use). See also Trademark Manual of Examining Procedure (TMEP) § 1209.01(c)(i) (8th ed. 2011). Where marks are more in the nature of a phrase, the examining attorney must provide evidence of the meaning of the composite mark as a whole. *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine based on lack of evidence showing

phrase used as a whole). We have considered all of the evidence in the application, including the evidence submitted in connection with the initial mere descriptiveness refusal of the proposed mark, which the examining attorney later withdrew.

As background (based on the Internet articles or press releases submitted with the May 4, 2011 Office action), the record reflects that applicant is a value-added distributor of specialized technologies providing, *inter alia*, voice, data and telephony products. "Founded in 1992, [applicant] markets products from more than 60 technology manufacturers to over 15,000 value-added technology resellers and is committed to empowering them with tools and services designed to help them grow." "ScanSource to Distribute Rugged, Reliable O'Neil Printers," accessed at <http://www.oneilprinters.com/>. Applicant offers "valuable partner services to its resellers, including system integration, marketing support professional services, education and training, and e-commerce solutions." "Microsoft Business Solutions Expands Distribution Options for Key Resellers in Retail Sector," accessed at www.microsoft.com/presspass/press/2004. Thus, as a distributor, applicant sells technical products to value-added resellers (who, for example, incorporate products

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acquired from applicant into other products). In addition to selling goods to resellers, applicant offers marketing support, training and the like to resellers. Applicant describes its services in its International Class 35 specimen of use, which is reproduced below:



The advertisement features a man in a suit holding a sign that says "Partner Services". Behind him, several other people are holding signs that say "VIRTUAL TECHNICIAN", "CUSTOM CONFIGURATION", "EDUCATION", "Marketing Services", and "E-SERVICES".

Partner Services, Helping You Make it Happen

Your job is to grow a successful business. Our job is to help you make it happen. When you place an order with ScanSource, Inc., you're not only working with a dedicated sales rep, you are working with an entire crew of professionals who are specifically trained to provide you with expert support and customized service. So whether you're looking for ideas for a marketing campaign, ways to expand your e-commerce offering, or strategies for managing large rollouts and custom configurations, we can help.

"The e-catalog is literally my mobile office. It is the reason for my success," says Van Eaton. What's more, he finds the e-catalog empowering, as it allows him to get the product in front of the customer, while also keeping him informed on the features and benefits of new technologies.

Ward Van Eaton, North American Barcode

We can help you broaden your business presence

Whether you're big or small, the **E-Catalog** is a fast, affordable way to add thousands of skus, product pictures and spec sheets to your website. That way, you're always engaging potential customers and complementing your traditional sales efforts.

Benefits of the **E-Catalog** include:

- Provides the entire online product catalog to your customers
- Zero maintenance – just add the link to your website and you're done
- The very latest product information, updated daily by our product data team
- Your customers are encouraged to contact you for pricing information
- A great sales tool of the products your company offers

Let us help you make it happen. To add an online catalog to your site, call your dedicated sales rep today at 800.944.2432. For more information on our services, please visit www.scansource.com/resellersupport.

The text states in relevant part:

Your job is to grow a successful business. Our job is to help you make it happen. When you place an order with ScanSource, Inc., you're not only working with a dedicated sales rep, you are working with an entire crew of professionals who are specifically trained to provide you with expert support and customized service. So whether you're looking for ideas for a marketing campaign, ways to expand your e-commerce offering, or strategies for managing large rollouts and custom configurations, we can help.

We now turn to the question of defining the genus of services at issue in this case, and find that the genus of services is adequately defined by the International Class 35 recitation of services, namely, "business development consulting services." See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration."). This genus would also encompass business development consulting services involving the provision of services to partner companies,³ which was suggested by the examining attorney.

Next, we must determine whether the designation "Partner Services" is understood by the relevant purchasing public primarily to refer to that genus of services. See *Ginn*, 228 USPQ at 530. In this case, the relevant public

consists of entrepreneurs requiring assistance in business development, including those businessmen and businesswomen who are value-added resellers of specialized technologies including voice, data and telephony products.

The evidence introduced by the examining attorney includes the following:

PARTNER SERVICES in connection with third-party reselling

- from www.nuance.com
"Nuance, Dragon NaturallySpeaking Connections Partner Program," - the program consists of "organizations that provide expert services, such as sales support, customization, training, consulting and technical support, to help customers leverage their Dragon solution for special results"; "**Partner services** empower customers to realize the full potential of Dragon - often in conjunction with other software and/or hardware products - for meeting business goals and maximizing return on investment."
- from www.edgetechcorp.com
Discussing, under the heading "**Partner Services**," "EDGE's sales programs deliver win-win results to its reseller and distribution partners. These programs are designed to grow business with our partners through unique reward and recognition programs for sales representatives and customers for their support of EDGE[] products."
- from www.linkedin.com
"Services Marketing Manager - Channel Partners at EMC," Job Description: "Leads the marketing effort to develop and promote EMC Global Service offerings for resale by EMC channel partners" and

³ A "partner company" is considered a company with which an entity has a business relationship. A formal legal arrangement is not necessary.

"Leads the development of demand generation activities and programs to support **partner services** sales." Also requires an "[u]nderstanding of channel structure and go-to-market processes for distributor and value-added-reseller partners."

- from www.ontility.com

Partner Services & Solutions

ONTILITY understands the challenges that eco projects present. Success in this new and exciting industry requires a skilled green workforce and efficient eco project planning, execution, management and support.

ONTILITY's leadership team and subject matter experts have spent countless hours researching the needs of our partners to build what we believe to be the best end-to-end service, solution and technology platform available in the eco industry, the **Powered by ONTILITY™** Platform.

Through our **Powered by ONTILITY™** Platform, both commercial and utility scale partners and dealer/installer partners have access to a comprehensive portfolio comprised of eco products, solutions, services, training, support and technologies.

Stating in relevant part: "Through our Powered by ONTILITY[] Platform, both commercial and utility scale partners and dealer/installer partners have access to a comprehensive portfolio comprised of eco products, solutions, services, training, support and technologies"; and "Click one of the three circles below for more detailed information on Commercial & Utility Scale and Dealer/Installer partner services and solutions."

PARTNER SERVICES in connection with other businesses

- from www.faqs.com

"USPS adds **partner services** to direct mail Web site" states that "The US Postal Service (USPS) has chosen several new vendors that will offer services on its direct mail Web site. The vendors selected are DirectMailQuotes.com, which will provide free competitive quotes on direct-mail services; ListBazaar.com and ThinkDirectMarketing.com, for mailing list services; and Zairmail and ZIPM, for creative, print and production services."

- from www.sap.com

SAP Software Solution Partners, Rewards and Benefits, in the Technical Enablement section states that "In order to help you address the

challenges of technical ramp-up in software development, SAP PartnerEdge offers a variety of benefits, services, and resources to help you to develop solutions that seamlessly integrate with SAP solutions. These benefits include: SAP **partner services** benefits package."

- from <http://press.nokia.com>

"The Nokia Local Marketing Solution delivers localized and timed services to consumers' smartphones," indicates that "With the Nokia Local Marketing Solution, operators and service providers can easily advertise their own and **partner services** in relevant places, at relevant times, thereby providing added-value service to their customers."

- from www.ogmentum.com

OgMentum, High-Tech Sales and Marketing, states that "OgMentum is the source for fiber optic products, sales, and **partner services**."

- from www.wisegeek.com

"The success of multichannel marketing often relies heavily on **partner services**. For example, a manufacturer of pharmaceuticals may have a repackaging and rebranding specialist to take their products from old or bulk packaging and repackage and relabel them."

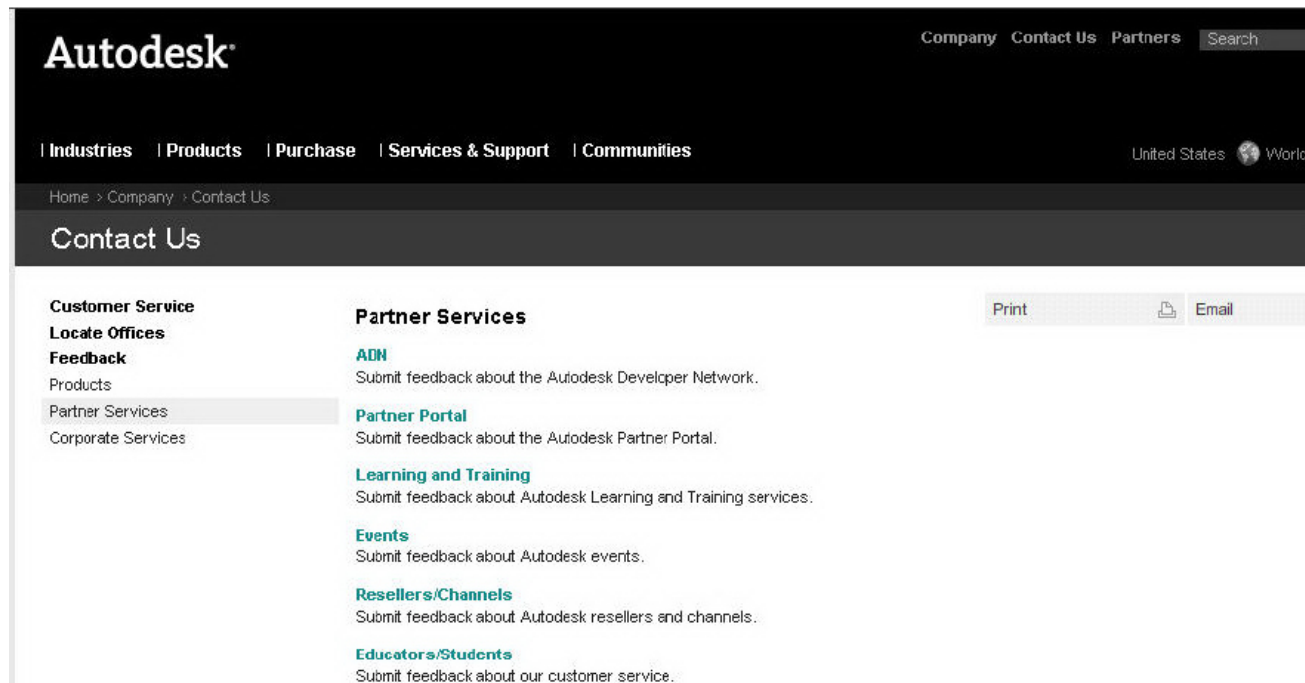
- from www.productrealizationgroup.com

Product Realization Group, **Partner Services**, indicates that "By leveraging our outsourced resources, you can increase flexibility, lower costs, and gain higher return on investment, while avoiding the typical pitfalls associated with managing outside services. By delivering the highest level of expertise and services in a straightforward approachable style, we strive to build long term trusted relationships."

- from www.hoovers.com
"4imprint Group can design it, print it, pack it and ship it. The company sources and sells promotional merchandise through four distribution channels; direct marketing, corporate programs, premium promotions, and **partner services**."

PARTNER SERVICES as webpage heading

- from http://usa.autodesk.com



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from www.centerforclimateaction.org:

PARTNER SERVICES



- [Home](#)
- [About](#)
- [Mission](#)
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Interactive calendar

A comprehensive listing of public and private climate policy events in the West

Policy updates

A trusted resource on current research and new programs on our focus areas: AB 32 and WCI, federal climate initiatives, the road to Copenhagen (COP 15), and mitigation and adaptation

Delegation to UNFCCC Climate Change Conference

Opportunity to participate in the UNFCCC international treaty negotiations as part of the Center for Climate Action's delegation; includes briefings on the negotiations before and after the trip, as well as briefings on-site

Discounted registration to Navigating the American Carbon World conference

The annual conference will become an event of the Center for Climate Action; Partners of the Center will receive discounted registration


Climate Action Champion awards

Recognition of individuals and organizations who demonstrate exceptional leadership on climate issues

Policy conference call series

Bi-monthly conference calls featuring the foremost experts on climate issues

from www.leica-geosystems.com:

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- ↓ Educational Program Region EMEA
- ↓ Technical Service
- ↓ Downloads
- ↓ Software License Agreement
- ↓ International Warranty
- ↓ CE Conformity Declaration
- ↓ Recycling Passport
- ↓ Reach Compliance
- ↓ ISO9001/14001 Certificates
- **Partner Services**
- ↓ Training Programs
- ↓ Registration

Leica Geosystems → Support - Service → Partner Services

Partner Services

Web Services for our Partners

Warranty Claims
Create your warranty request online. For registered dealers only.

eRepair
Online form for repair process DISTO. For registered dealers only.

Internet articles referring to applicant

- from findarticles.com

BNET, "ScanSource Rolls out New Service Through Its Partner Services Group," indicates that "The mission of the **Partner Services** Group is to act as an extension of its partners' businesses by providing innovative programs and support services that allow solution providers to spend less time on behind-the-scenes activities and more time identifying and closing sales opportunities. [Applicant] offers system integration, marketing support, professional services, education and training, and E-commerce solutions." It also "provides both value-added distribution sales and **partner services** to technology resellers."

- from www.microsoft.com

Microsoft News Center, "Microsoft Business Solutions Expands Distribution Options For Key Resellers in Retail Sector" indicates that "ScanSource has been serving North America as a value-added distributor of specialized technologies for more than 10 years. The company provides POS products and voice, data and telephony products through its Catalyst Telecom and Paracon sales units. ScanSource offers valuable **partner services** to its resellers, including system integration, marketing support, professional services, education and training, and ecommerce solutions."

- from www.bsminfo.com

BusinessSolutions, "ScanSource Partner Services Adds Human Resources Offering" quotes and identifies Peter O'Brien as "vice president of **partner services** for ScanSource, Inc."

- from <http://www.oneilprinters.com/>

"ScanSource to Distribute Rugged, Reliable O'Neill Printers," indicates that ScanSource provides both value-added distribution sales and **partner services** to technology resellers."

The evidence in the record demonstrates that in the business context, "partner services" is a term broadly used to identify those services offered to another with whom the offering party has a business relationship. Several of the webpages identify "partner services" as a topic heading, indicating "partner services" refers to a general category of services that businesses provide to their customer-partners to promote and facilitate the business relationship. In the context of applicant's business, where applicant is a distributor and sells to value-added resellers, applicant provides support or consulting services to the reseller, i.e., its partner, on aspects such as system integration, marketing support, professional services, education and training, and E-commerce solutions, all of which broadly relate to "business development." See particularly the evidence from nuance.com and linkedin.com referring to "partner services" in the reseller context. In addition, applicant's specimen demonstrates that applicant, as part of its consulting services, actively promotes "partner services," that is, applicant offers

consulting services to those firms which add value to the products opposer sells to them. The articles specifically discussing applicant refer to applicant's services as "partner services." Thus, we find that the examining attorney has established *prima facie* that the relevant public would understand that the designation refers to the genus of services, namely, business development consulting services offered to applicant's customers or partners, in the context of reselling goods.

In seeking to rebut the examining attorney's *prima facie* case, applicant argues that "the so-called evidence cited by the Examining Attorney merely demonstrates that services offered under Appellant's PARTNER SERVICES trademark can be of great benefit to Appellant's third party reseller customers." Brief at 7. We disagree. The evidence demonstrates that the term "partner services" identifies particular services provided to customers who have a relationship with the seller, including those who are resellers. This includes the material from the website concerning a business manager job position (linkedin.com), which applicant challenges in its brief as referring to third-party partners. The position requires an "[u]nderstanding of channel structure and go-to-market processes for distributor and value-added-reseller

partners"; this is directly related to applicant's business.

In addition, applicant submitted what applicant identified as "numerous" (there are only three) third-party registrations with its April 13, 2011 response, and represents that they all are registered on the Principal Register (only one is). One registration indicates it is cancelled. Another registration, which is on the Principal Register, contains the terms PARTNERS and SERVICES, but they are separated by the term INVESTMENT. Because the terms PARTNERS and SERVICES are not together as one term, as they are in applicant's designation, this registration has limited probative value. That leaves the remaining registration for the mark SERVICE PARTNER PLATFORM, which registered on the Supplemental Register. This single registration is not persuasive; it is only one in number, PARTNER and SERVICE(S) are in a different word order, the term PLATFORM is also in the designation, and the listed services are different from applicant's services. Further, it is well-settled that neither the Board nor our primary reviewing court is bound by prior determinations by the USPTO and each case must be decided on its own merits. See *In Re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed Cir. 2011).

In sum, we find that applicant has not refuted the *prima facie* case of genericness of the proposed mark established by the examining attorney. We therefore find that the examining attorney has established *prima facie* by clear evidence that the designation "PARTNER SERVICES" is generic for those business development consulting services to business involving the use of partners in rendering those services, which falls within applicant's recitation of services. See *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers used in attics; "The broad general category of goods involved here is sprinklers for fire protection. However, a product may be in more than one category, and here applicant's goods also fall within the narrower category of sprinklers for fire protection of attics."); *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (LAWYERS.COM generic for online information exchange in the fields of law, legal news, and legal services; "a central and inextricably intertwined element of [the claimed] genus is information about lawyers and information from lawyers.").

DECISION: The refusal to register the proposed mark on the Supplemental Register for the International Class 35 services is affirmed and registration of applicant's

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proposed mark for such International Class 35 services is refused.

The proposed mark will be registered on the Supplemental Register in due course, but only for the International Class 41 services.