
To: Conversive, Inc. (webblaw@webblaw.com)
Subject: TRADEMARK APPLICATION NO. 78240383 - ASSISTED RESPONSE AGENT - 2966-030685
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/240383 AND 78/240385

APPLICANT: Conversive, Inc.

CORRESPONDENT ADDRESS:

Kent E. Baldauf, Jr., Registration No. 3
Webb Ziesenheim Logsdon Orkin & Hanson,
700 Koppers Building 436 Seventh Avenue
Pittsburgh, PA 15219-1818



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: ASSISTED RESPONSE AGENT AND ASSISTED RESPONSE

CORRESPONDENT'S REFERENCE/DOCKET NO: 2966-030685

CORRESPONDENT EMAIL ADDRESS:
webblaw@webblaw.com

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.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the trademarks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE on the ground that it is merely descriptive within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

FACTS

On April 22, 2003, applicant Conversive, Inc., filed intent to use applications to register

ASSISTED RESPONSE AGENT under U.S. Application No. 78240383 and ASSISTED RESPONSE under U.S. Application No. 78240385 as typed marks for “computer programs, namely an interactive natural language processing knowledge base, for use in internet relay communications platforms.” In office actions dated November 7, 2003, the examining attorney refused registration of the proposed marks pursuant to Section 2(e)(1) of the Trademark Act on the grounds that they are merely descriptive of functions and characteristics of the goods. In addition, the examining attorney required amendment to the identification of goods in both applications.

In responses dated May 6, 2004, the applicant argued against the refusal to register the marks and amended the identification of goods for both applications to “computer programs, namely an interactive natural language processing knowledge base used to build and customize interactive conversational mechanisms which assist, answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms in International Class 9.”

On June 12, 2004, the examining attorney refused the marks in final pursuant to Section 2(e)(1) and accepted the amendment to the identification of goods in both applications. On October 21, 2005, following abandonment and revival of both applications, applicant filed Motions for Reconsideration of the refusal and further amended the identification of goods to “computer programs, namely an interactive natural language processing knowledge base used to build and customize interactive conversational mechanisms in the form of an animated or virtual character which assists, answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms” in International Class 9.

The examining attorney denied the Motions for Reconsideration with respect to the refusal pursuant to Section 2(e)(1) in both applications and accepted applicant’s amendment to the identification of goods. The applicant has filed this appeal. On March 11, 2006, the examining attorney filed a Motion to Consolidate the appeals in U.S. Application No. 78240383 and 78240385. The Board granted the Motion on March 16, 2006.

ISSUE

The issue presented by applicant's appeal is whether the proposed marks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE are merely descriptive of the goods pursuant to Section 2(e)(1) of the Trademark Act.

ARGUMENT

The proposed marks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE are merely descriptive of applicant's goods.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). A term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term describe only one attribute of the goods and/or services to be found merely descriptive. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982).

A mark is suggestive if some imagination, thought or perception is required to determine the nature of the goods and/or services from the term. A suggestive term differs from a descriptive term, which immediately and directly conveys some information about the goods and/or services. *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984).

Applicant is seeking registration of the proposed marks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE for "computer programs, namely an interactive natural language processing knowledge base used to build and customize interactive conversational mechanisms in the form of an animated or virtual character which assists, answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms" in International Class 9.

The examining attorney has considered the proposed marks in relation to applicant's goods and determined that the marks merely describe functions and characteristics of the goods. Specifically, the mark ASSISTED RESPONSE AGENT conveys to consumers that goods are used for providing assisted responses through an agent. The mark ASSISTED RESPONSE conveys to consumers that a function of the goods is the provision of assisted responses. The refusal of both applications is supported by evidence consisting of dictionary definitions as well as Internet evidence showing use of the wording in

the marks by third parties in connection with similar goods.

Applicant argues that the proposed marks are suggestive, composite marks functioning as source indicators for applicant's goods. In addition, applicant argues that the evidence does not support the refusal of the marks. For the reasons more fully set forth below, the examining attorney respectfully submits that the refusal under Section 2(e)(1) should be affirmed for both applications.

A. The Evidence of Record Supports the Finding that the Proposed Marks Are Merely Descriptive of the Goods.

In the office actions issued in both applications on November 7, 2003, the examining attorney provided dictionary evidence for the wording composing the marks from the *American Heritage Dictionary of the English Language*, (Fourth Edition, © 2000). For the convenience of the Board, the relevant portions of the dictionary definitions upon which the refusal was based are set forth below.

The term "assisted" is defined as:

To give help or support to, especially as a subordinate or supplement; aid: *The clerk assisted the judge by looking up related precedents. Her breathing was assisted by a respirator.*

1. To give aid or support. See synonyms at help.

1. An act of giving aid; help.

The term "response" is defined as:

1. The act of responding.

2. A reply or an answer.

3. A reaction, as that of an organism or a mechanism, to a specific stimulus.

The term "agent" is defined as:

1. One that acts or has the power or authority to act.

On the basis of these definitions and in light of the identified goods, the examining attorney determined that the proposed marks are merely descriptive of a function of the goods because the goods are used for providing assisted responses through an agent, namely, a character or instrument through which such responses are provided.

In addition to the dictionary definitions, the first office action in the ASSISTED RESPONSE AGENT application also included LEXIS-NEXIS® evidence in the nature of an article entitled *Banter Releases Version 4.5 of E-Mail and Web Response Solution; New Workflow, Integration and Language Capabilities Yield Faster ROI for Enterprise Customers*, PR Newswire, June 5, 2001. The article states:

"Banter, a leading provider of intelligent communication technologies, today announced the release of Banter Reply version 4.5. The latest version of Banter's e-mail and web form response solution features multiple language support, increased

productivity through advanced routing capabilities, and powerful integration with an enterprise's existing CRM solution -- all designed to help enterprise customers more rapidly improve service levels and control agent costs. Reply v4.5 builds on the previous version's success in meeting the demands of organizations with high volumes of e-mail and web form communication from their customers. Powered by Banter's Relationship Modeling Engine (RME), the leading natural language engine for CRM applications, Reply v4.5 provides unmatched accuracy and ease of use for intelligent response, *assisted response*, and rules-based routing." (emphasis added).

This article supports the refusal because it is evidence that communication technology featuring natural language is commonly used for assisted response purposes to help organizations manage e-mail and web communications from their customers.

The final actions issued on June 12, 2004 in both applications included a dictionary definition for the term "agent" from www.techweb.com, known also as the *Techencyclopedia*. This evidence indicates that with respect to computer programs, the term "agent" is defined as "a software routine that waits in the background and performs an action when a specified event occurs. For example, agents could transmit a summary file on the first day of the month or monitor incoming data and alert the user when a certain transaction has arrived. Agents are also called "intelligent agents," "personal agents" and "bots." See [mobile agent](#), [bot](#) and [workflow](#)."

This dictionary evidence also supports the refusal because an aspect of applicant's goods is a computerized agent, which assists, answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms.

The Denial of Applicant's Motions for Reconsideration issued in both applications on November 17, 2005 included pages from applicant's website at www.conversive.com featuring information about the ASSISTED RESPONSE AGENT product. This evidence states, in pertinent part:

"Conversive's AnswerAgent and AssistedResponseAgent are designed to provide true relief for today's customer service problems. Our solutions provide a highly flexible customer interface that guides your customers through their problems with the same type of conversational process that a CSR would use. We provide your customers with web pages, forms, graphics, and data as appropriate. We can solicit information from your customers and write that information to the appropriate databases or CRM systems, so that it will be available in the appropriate form for further action. Conversive solutions leverage the value of your existing web investment by dramatically enhancing navigation and useability. At the same time, we enable you for the first time to make your back-office resources truly available on the Internet, leveraging your investment dollars to achieve new levels of customer service quality and scalability.

AssistedResponseAgent has all of the features and capabilities of AnswerAgent. But it provides more as well. For those companies that want to provide that level of customer service that only human beings are capable of, the AssistedResponseAgent uses Conversive's patent pending escalation process to seamlessly refer any question not immediately answerable by the Agent's NLP engine to a CSR. The CSR receives the question through Conversive's advanced message controller. Every aspect of the transaction is logged, and time records are kept. Routing can be based on skills, location, availability or other factors. CSR's are provided with a highly advanced interface that includes short cuts, editing capabilities and suggestions from our NLP engine. Once the reply is sent, the engine takes over the conversation again, and continues to answer every question that it can.

Useful graphics are provided. Forms are presented. Problem tickets are generated and entered into the CRM system. The burden on the CSR is dramatically less than a comparable web chat conversation, because most of the burden is carried by the engine, with only occasional questions being escalated to the CSR. In addition to high-touch customer service, it is easy to see that the AnswerAgent solution is ideal for cost-effective service at help desks, travel booking services or other applications where complex information is being provided over the Internet. AssistedResponseAgent is the last mile of railroad track tying together the Internet and the Call Center. It leverages every human, process and data resource that you have invested in and makes them available online, in real time, with no phone calls or emails. Find out how it can impact your customer service strategy."

This evidence supports the finding that the applicant's goods are used to assist companies with customer relationship management and providing information via the Internet through a computerized instrument or agent providing assisted responses.

B. The Terms in the Proposed Marks are Merely Descriptive in the Applicant's Industry

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. However, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002). In this case, the composite marks immediately convey a great deal of information to consumers about the applicant's goods. The information conveyed by ASSISTED RESPONSE AGENT is that the goods are used to deliver assisted responses through an agent. The information conveyed by ASSISTED RESPONSE is that applicant's programs are used for providing assisted responses.

Moreover, the wording ASSISTED RESPONSE is commonly used by third parties in connection with products and services for managing communications and providing information over the Internet. The two major reasons for not protecting descriptive marks are: (1) to prevent the owner of a mark from

inhibiting competition in the sale of particular goods or services; and (2) to avoid the possibility of costly infringement suits brought by the registrant. This thus enables businesses and competitors to have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978).

The examining attorney respectfully directs the Board's attention to the final actions issued in both applications on June 12, 2004, which featured Internet evidence in the nature of Internet articles and advertisements in which the wording ASSISTED RESPONSE is used to describe the products and services of others in the customer relationship management field.

For the convenience of the Board, the examining attorney outlines the following examples of use of the wording in the proposed mark by others:

1. Advertisement from www.chordiant.com concerning Chordiant Software, Inc. and stating "ChordiantKnowledgeBase uses a sophisticated knowledge engine to deliver the most relevant answers to consumer questions and delivers these responses via Automated Response, Assisted Response or Live Response Applications."
2. Advertising article from www.networkdirect.net dated November 7, 2000 and entitled "Eagle Email Introduces Eagle Response" and stating "E-mail Assisted Response System Designed for Businesses of Any Size."
3. Dave Sims, *You Asked For it! Solving the Customer Support Dilemma*, New Architect, November 1999, stating "The customer service solutions emerging to fill this niche have their roots in several disciplines in computer science. They're enjoying a resurgence in applications including knowledge management, user-interface design, case-based reasoning, and good old-fashioned FAQ lists. Most of these solutions involve one or more of three types of technologies: a knowledge base with access to experts and a system to present the collected questions online; an email management system that can include some level of automated or *assisted response*; live chat." (emphasis added).

The Denials of the Motions for Reconsideration dated November 17, 2005 also included evidence of common usage of the wording ASSISTED RESPONSE for customer relationship management purposes. The examining attorney highlights the following example for the convenience of the Board:

Article from www.TCMnet.com dated November 19, 2002 and entitled "Concerto Software Launches New Version of Its Customer Interaction Management Solution" and stating "Numerous applications within EnsemblePro - including predictive dialing, email auto and *assisted response*, coordinated voice and data transfers and screen pops - help automate the work process for agents, reducing dollars and time spent on activities that would otherwise require individual, human attention. In addition, EnsemblePro dramatically reduces the high costs and intense labor associated with installing, integrating and maintaining multiple point solutions found in most contact centers, thereby reducing initial investment requirements as well as the total cost of ownership over time." (emphasis added).

Applicant argues that because the proposed marks do not convey to consumers that the goods are used for creating a virtual character, there is no competitive need of third parties for use of the wording in the marks. The examining attorney respectfully submits, however, that since the wording ASSISTED RESPONSE and AGENT has been clearly shown to be widely used within the computer, communications and customer relationship management industries, there is a clear competitive need for this wording.

Finally, applicant argues any doubts with respect to whether a mark is merely descriptive or suggestive must be resolved in applicant's favor and relies on *In re The Gracious Lady Service, Inc.*, 175 USPQ 380, 383 (TTAB 1972). The examining attorney respectfully submits that there is *no* doubt that the proposed marks are merely descriptive of the goods as identified in both applications. In addition, the evidence weighs in favor of affirming the refusal of both applications.

CONCLUSION

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15

U.S.C. §1052(e)(1), a mark must be merely descriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. The examining attorney respectfully submits that the proposed marks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE are merely descriptive of applicant's goods. In addition, the evidence of record in both applications supports the refusal pursuant to Section 2(e) (1). Therefore, the refusal to registration under Section 2(e)(1) of the Trademark Act should be affirmed in both applications.

Respectfully submitted,

/Linda M. Estrada/
Trademark Attorney, Law Office 104
U.S. Patent & Trademark Office
(571) 272-9298
(571) 273-9104 Fax

CHRIS DONINGER
Managing Attorney
Law Office - 104