

TRADEMARK APPLICATION
SERIAL NO. 78/240,385
ATTY. DOCKET NO. 2966-030684

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

International Class No. 9 :
In re application of :
CONVERSIVE, INC. : **ASSISTED RESPONSE**
Serial No. 78/240,385 :
April 22, 2003 :
Trademark Attorney: Linda Estrada :
Law Office 105 :
Pittsburgh, Pennsylvania
January 17, 2006

APPELLANT'S BRIEF ON APPEAL

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Void Date: 01/23/2006 HPHAM1
01/23/2006 HPHAM1 00000145 230650 78240385
01 FC:6403 100.00 CR

Dear Sir:

Appellant has appealed from the final decision of the United States Patent and Trademark Office Examining Attorney's refusal to register the above-identified mark under Section 2(e)(1) of the Trademark Act and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

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01 FC:6403 100.00 DA

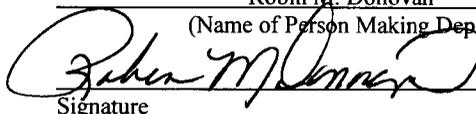
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on January 17, 2006.

Robin M. Donovan

(Name of Person Making Deposit)



Signature

01/17/2006
Date

APPELLANT'S APPLICATION

The Appellant filed its application on April 22, 2003, to register the mark ASSISTED RESPONSE. The present goods description for this application reads as follows: "computer programs, namely an interactive 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."¹

The Examining Attorney has refused registration contending that the Appellant's mark is merely descriptive under Section 2(e)(1) of the Trademark Act (15 U.S.C. §1052(e)(1)).

As set forth in the following sections of this Appeal Brief, it is respectfully submitted that the refusal to register Appellant's mark is erroneous.

ISSUE TO BE DETERMINED

The only issue to be decided by the Board is:

Whether the Appellant's mark ASSISTED RESPONSE is merely descriptive under Section 2(e)(1) of the Trademark Act when applied to an "computer programs, namely an interactive 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."

ARGUMENT

The Examining Attorney has refused to register the mark ASSISTED RESPONSE under Section 2(e)(1) on the ground that Appellant's mark is merely descriptive as applied to the Appellant's goods. The Appellant's mark should be registrable since it is only suggestive of the

¹ A conditional amendment was filed on September 30, 2005 which was dependant upon allowance by the Examining Attorney. The rejection was maintained.

goods at issue and not merely descriptive of the recited software product.

A term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. In re Gyulay, 820 F.2d 1216, 1217 (Fed. Cir. 1987). On the other hand, a mark is suggestive, and therefore registrable, if imagination, thought, or perception is required to reach a conclusion on the nature of the goods. Id. It has been recognized that there is “but a thin line of distinction between a suggestive and a merely descriptive term.” In re Recovery, Inc., 196 USPQ 830, 835 (TTAB 1977)).

Additionally, the court has held that it is a well-established practice that, where reasonable people may differ, doubt must be “resolved in the applicant’s favor.” In re The Gracious Lady Service, Inc., 175 USPQ 380, 383 (TTAB 1972)).

In this case, the mark is suggestive side because it does not immediately convey the function or purpose of the Appellant’s goods. First, the Appellant’s mark ASSISTED RESPONSE is not found in the dictionary. Although the Examining Attorney states that the fact a term is not found in the dictionary is not controlling on the question of registrability, the Board may still take judicial notice of dictionary definitions or the lack thereof. In re Gould Paper Corp., 834 F.2d 1017, 1019 (Fed.Cir. 1987); University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 231 USPQ 594, 598 (TTAB 1982). In the present case, the phrase ASSISTED RESPONSE is not found in the dictionary and as such, it is obviously a coined term. It is made up and arbitrary. This would immediately alert the purchasing public to the intended use of the mark as a designation of a product from a particular source and not a description thereof. Thus, the mark would not be read as an interactive language processing knowledge base that enables the user to build and customize interactive conversational mechanisms. These mechanisms are virtual “persons” or other animated

characters that interact with visitors to web sites. They take the place of human customer service workers, but still interact with visitors in a conversational manner.

In the Examining Attorney's opinion, since the Appellant's mark consists of a composite of the words "ASSISTED" and "RESPONSE" the term would be perceived by consumers as nothing more than a description of a product that provides "assisted responses." Furthermore, the Examining Attorney asserts that the combination of the words "assisted response" is in common usage to describe "software and computer applications, which assists user responses and answers to questions." For those reasons, the Examining Attorney found that the term ASSISTED RESPONSE describes a characteristic feature and purpose of Appellant's goods, namely, that these words have been generally used in articles about third party software products, and that the Appellant's mark must be deemed to be merely descriptive of the goods at issue. In addition, to allegedly demonstrate that the mark is merely descriptive of the Appellant's goods, the Examining Attorney enclosed representative samples of articles from the Internet and the LexisNexis database discussing "assisted responses."

However, in a case similar to that at hand, the Board has held that "whether consumers could guess what the product or service is from consideration of the mark alone is not the test." In re Harry v. Lehmann, 2002 TTAB LEXIS 370, 377 (citing In re American Greeting Corp., 226 USPQ, 365, 366 (TTAB 1985)). In Lehmann, the Applicant appealed the final refusal of the Trademark Examining Attorney to register the mark "PHASESCAN" for computer online retail ordering services "in the field of books, publications, excerpted text, and non-textual images," since the mark is merely descriptive of his services. Id. at 371. The Examining Attorney argued that the combination of the merely descriptive words "PHASE" and "SCAN" did not create a new and different term "which has an incongruous meaning in connection with applicant's services." Id. at

372-373. Additionally, the Examining Attorney submitted a number of excerpted stories from the Internet and from the LexisNexis database to demonstrate that a scanning function is a common function of computer search systems. Id. Subsequently, the Board held that the Examining Attorney failed to carry his burden of demonstrating that the Applicant's mark is merely descriptive of his services and that the mark merely described the nature or function of Applicant's computer ordering service. Id. at 378.

In the current case, similar to Lehmann, just because the Appellant's mark consists of the words "ASSISTED" and "RESPONSE" and that third parties may use versions of the phrase to describe various computer applications, does not mean that the mark is unregistrable. Together, these two words convey a response that is assisted in some way. It does not describe a software product that enables the development of an animated or virtual character for interacting with users of a web site in a conversational manner. Because the mark in no way describes the software product, it thus immediately tells the public that the intended use of the mark is a designation of a product from a particular source and not a description thereof. While the mark ASSISTED RESPONSE may be suggestive a use of the goods in the broadest, most general sense, it hardly describes the physical structure, characteristics, and features of goods. Imagination, thought and/or perception is required to reach the conclusion on the nature of the goods if, indeed, such can be done. Thus, just like the Appellant in Lehmann, the asserted mark does not merely describe the nature or function of the Appellant's goods and is only suggestive of the goods at issue.

Applicant's software enables the purchaser to create a virtual "person" or other animated character for interacting with users of a web site. This virtual person or character interacts in a conversational manner to answer questions, and to provide help in information to users of the web site. The mark ASSISTED RESPONSE does not describe the Applicant's software that enables

the purchaser to create such a virtual “person” or character. An individual hearing or reading this mark would not conclude that such goods would be provided under this mark. The goods are not described in any way.

Moreover, when one applies any of the imagination test, the competitors’ need test or the competitors’ use test, it is readily apparent that the mark ASSISTED RESPONSE is suggestive. The imagination test provides that a mark is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it conveys an immediate idea of the ingredients, qualities or characteristics of the goods. See Hasbro, Inc. v. Lanard Toys, Ltd., 858 F.2d 70 (2d Cir. 1988). The mark ASSISTED RESPONSE does not immediately convey any idea that this is a software product for creating a virtual person or character to assist users of a web site. Correspondingly, because imagination is required to associate ASSISTED RESPONSE with this software product, it will not be needed by competitive sellers to describe their product. Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366 (7th Cir. 1976). The materials submitted by the Examiner do not provide evidence that this term is used by competitors for a software product that permits the development of such virtual characters. This further supports the conclusion that the mark is not descriptive. Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 U.S.P.Q 557 (T.T.A.B. 1975), aff’d, 189 U.S.P.Q. 348 (CCPA 1976).

In the June 12, 2004 Office Action, the Examining Attorney attached various articles in which the words “assisted response” are used in connection with various software products. Specifically, in the article “Concerto Software Launches EnsemblePro 5.0”, the words “assisted response” are used in connection with coordinated voice and data transfers and screen pops. In the article “Firepond’s eService Performer Helps Saga Manage Interactions with ‘Silver Surfers’; Top UK Web Site for Over-50s Has Complete View of its Customers”, the words “assisted response” are

used in a discussion of the processing of incoming e-mails in an e-mail management product. In the article "E-Mail Management Technologies: A Purchaser's Primer; Technology Information", the words "assisted response" are used in a discussion of automating e-mail message systems. The article "NetworkDirect's Eagle Email Introduces Eagle Response; E-mail Assisted Response System Designed for Businesses of Any Size" describes a system for reducing time for e-mail replies by using pre-developed messages to customer questions. The article "Maximize SAN and NAS ROI with SRM: matching application requirements with appropriate storage resources enables administrators to fully realize the value of networked storage; storage resource management", the words "assisted response" are used in connection with notification of instances where data storage capacity is surpassed. In the article "Firepond Delivers Intelligent Multi-Channel Contact Center with New e ServicePerformer 2002; Combines fast deployment with advanced intelligence and easy integration," the words "assisted response" are used in the discussion of a customer assistance product for e-mail responses. The article "E-Mail Management Technologies: A Purchaser's Primer; Technology Information" uses the words "agent-assisted response" to describe a method of sending e-mail responses to e-mail inquiries with human involvement. The article "Chordiant knowledge management system; Management News and Products; Brief Article; Product Announcement" refers to words "assisted response" in a product name. This likewise appears to be product for responding to e-mails in a written form. The article "Marks Debut in DP; Savin Comes Out With Two OA Systems", the words "computer-assisted response" are used in connection with a hotline for remote repair and maintenance problems.

In the June 12, 2004 Office Action, the Examining Attorney also attached information concerning the companies Chordiant and Banter. Chordiant apparently delivers responses to consumer questions (presumably by e-mail) by an "Assisted Response" application. Banter sells an

e-mail response product. The words “assisted response” are used in the discussion of the e-mail response and routing capabilities.

The Examining Attorney also attached a number of additional articles to the November 9, 2005 Office Action. The first article is directed to Island Data in a publication called CRMAdvocate. The article notes that the product at issue “Insight RT” is a knowledge management module used for workflow and task management. The product is represented to be “significantly less expensive than an agent-assisted response.” The use of these words is in no way directed to Applicant’s product but instead refers to human interaction.

The second article is titled “*Concerto Software Management Solution.*” As with the other article directed to Concerto addressed above, the phrase “assisted response” is used to describe automated voice and data transfers for the EnsemblePro product sold to multimedia contact centers.

The materials directed to Centrac Inc. use the term “assisted response” in the discussion of its product OSCAR (On Site Computer Assisted Response). This is a system for displaying scripts and reference information to be read by human representatives fielding telephone calls. The Phoenix CTI site includes a description of a product called “Edify E-Mail.” It is noted that this e-mail product “offers assisted response capability” due to its ability to suggest responses to humans responding to an e-mail.

The next web page is for Conversive’s AssistedResponseAgent. This is Applicant’s site. the material of course describes Applicant’s product. Importantly, the words “assisted response” are not used to describe the product. It is readily evident that this is a trademark, not a description term.

The final item is a the “Pliner.net Assisted Response System.” It appears that this is a product used to assist a human operator in responding to e-mail and bulk mailings.

The review of these materials evidences the use of the mark to describe the function of assisting a human operator to respond to something. These materials do not demonstrate an interactive language processing knowledge base used to build interactive conversational mechanisms which interact with users of the web site. The materials establish that the phrase is not descriptive. the phrase is not used to describe Applicant's product.

The Examining Attorney argues that the materials establish that the phrase is in common usage to describe software and computer applications which assists user responses and answers to questions. In general, they may be directed to assisting responses and /or e-mail related products but do not describe Applicant's specific product. The fact that they relate to the very broad field of software in general does not change this fact. In a case similar to that at hand, the Board held that a mark was suggestive, when the goods or services were encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, were required in order to determine what attributes of the goods or services the mark indicates. In re Automotive Technologies, Inc., 2001 TTAB LEXIS 37. In the case at hand, the term "assisted response" is not descriptive of the goods since the term may refer to any manner of assisting a response to something. There are evidently numerous ways of assisting a response to something, but none of these uses describe Applicant's product. Hence, the mark is certainly not descriptive of Applicant's very specific software product. Therefore, similar to Automotive, a refusal on the ground of mere descriptiveness cannot be properly based on some theoretical or otherwise speculative possibility. Reasonable people may differ on their idea of an assisted response, and, therefore, the Board should find that the mark is merely suggestive of the Appellant's goods.

CONCLUSION

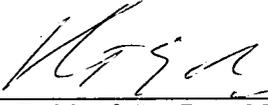
In view of the foregoing, Appellant submits that the mark is not merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act. Accordingly, Appellant's mark is entitled to registration. The Board is therefore respectfully requested to reverse the decision of the Examining Attorney's decision refusing registration.

The Commissioner for Trademarks is hereby authorized to charge any fees which may be required to Deposit Account No. 23-0650. The original and two copies of this Brief on Appeal are enclosed.

Respectfully submitted,

THE WEBB LAW FIRM, P.C.

By



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**TRADEMARK TRIAL AND
APPEAL BOARD**

The dating stamp on this card will be taken as an indication that the accompanying paper was filed.

Applicants: Conversive, Inc.

Appl. No.: 78/240,385

Paper dated: January 17, 2006

Atty's File No.: 2966-030684

Amount of Check: \$100.00

Initials KEBjr:rmd

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In re Appellant's Brief on Appeal

Enclosed:

Transmittal Form (1 p.); Appellant's Brief on Appeal (10pp.); and check for fee.



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