

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78792578
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>I. <u>RECITATION OF SERVICES</u></p> <p>Applicant wishes to amend its services to drop the services in class 42 and is requesting in and through this electronic response that the class 42 services be deleted.</p>	
<p>II. <u>LIKELIHOOD OF CONFUSION</u></p> <p>A. <u>Applicant's Mark Is Not Confusingly Similar To Cited Registration No. 3108337.</u></p> <p>The Examining Attorney has refused registration of Applicant's mark in classes 35 and 42 on the basis of existing Registration No. 3108337 in class 35 in the name of Thomas Spitters (the "Cited Registration"). Applicant asserts there is no likelihood of confusion between the respective marks, particularly in light of the services limitation made herein, and requests that Applicant's application be allowed to proceed to publication.</p> <p>1. <u>Applicant's Mark Is Used In Connection With Services Which Are Not The Same As The Services Covered By The Cited Registration.</u></p> <p>The services covered in Applicant's application, as amended, are:</p> <p>Class 35: Operating on-line marketplaces for buying, selling and exchanging computer software and on-demand applications;</p> <p>When evaluating the issue of a likelihood of confusion in PTO proceedings, the Examining Attorney is constrained to compare the goods and/or services as recited in the application with the goods and/or services as recited in the registration. Applicant's application, as <i>amended</i>, covers operating an online marketplace for third parties to offer and purchase software.</p> <p>By contrast, the Cited Registration covers business, tax, and legal advice and consulting, and covers no services related in any way to operating online marketplaces for any third party goods or services, or even any information technology related services or advice. Furthermore, the respective services are not competitive or complementary in any direct way.</p> <p>Based on the differences between Applicant's and Registrant's respective services, as amended by</p>	

Applicant herein, it is highly unlikely that consumers would believe the respective services emanated from the same source. For this reason, Applicant requests that the Examining Attorney discontinue the 2(d) refusal to register its mark based on Registrant's mark

2. The Customers are Sophisticated.

The type of customers who would contract Applicant for its services and the type of customers that would contact the owner of the Cited Registration for its services would both be sophisticated and careful purchasers. The Examining Attorney indicated in the Final Office Action that "where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class." Here, we have, on the one hand, purchasers of legal, business, and tax advice and consulting services. The least sophisticated of this class would be a very careful and thoughtful individual seeking advice in these areas. Such consumer would not make an un-considered agreement for services due to the critical nature of these areas of activity and their associated high costs. On the other hand, we have users of an online marketplace on which they can enter into transactions with others for computer applications – so offering their own technologies or purchasing technologies from others. The least sophisticated of this class would also be a careful and knowledgeable individual.

3. Applicant's Services and Those in the Cited Registration Do Not Generally Travel in the Same Channels of Trade to the Same Potential Consumers.

The Examining Attorney indicated that "the services would be found in the same channels of trade and would be available to the same potential consumers." We disagree, particularly in light of the amendment to Applicant's services made herein. Applicant's services relate to operating an online marketplace for third party products, whereas the services covered by the Cited Registration relate to business, tax, and legal advice. These would be utilized by different people in completely different contexts. The Examining Attorney provided print-outs from the USPTO X-Search database purportedly showing that the respective parties' services are offered by the same entities to the same potential consumers. However, Applicant notes that not all noted registrations covered online marketplaces for computer applications along with business, tax, and/or legal consulting and advice, and only seven examples were provided, which seems to indicate that a company offering both the services covered in Applicant's application and those covered by the Cited Registration would be rare.

4. The Cited Mark is Not a Strong Mark.

The Cited Mark is merely descriptive of the services listed in the cited registration. This is evidenced by the fact that the Cited Mark is registered on the Supplemental Register. Thus, the Cited Mark is entitled to a more limited scope of protection than if it were a strong mark. The Sixth Circuit Court of Appeals stated that "the stronger the mark, the more likely it is that encroachment on it will produce confusion." *Champions Golf Club v. Champions Golf Club*, 78 F.3d 1111, 38 U.S.P.Q.2d 1161 (6th Cir. 1996). Conversely, relatively weak marks are given a relatively narrow range of protection both as to products/services and format variations. See *McCarthy on Trademarks and Unfair Competition*, §11:73 (Third Edition). Thus, the scope of protection for the Cited Mark should be construed as narrow and found confusingly similar against only identical or highly similar services. In the case at hand, and considering the amendment to Applicant's services made herein, it is clear that the respective purposes of Applicant's services and those covered by the Cited Registration are completely different. Therefore, Applicant submits that the marks are not confusingly similar.

III. DESCRIPTIVENESS OBJECTION

The Examining Attorney also refused registration of Applicant's mark on the ground that it

"merely describes characteristics of Applicant's services, as business-related services provided on a business web site." Applicant respectfully disagrees, particularly in light of Applicant's deletion of the class 42 services, and requests reconsideration of the refusal to register the mark.

The Examining Attorney stated the following:

"Business web sites are a particular type of sites. ... Consumers, when viewing applicant's mark, will immediately comprehend that the term WEB refers to a web location. The fact that the term has other meanings is not relevant to the instant descriptiveness determination. It does not require any imagination or leap in logic to immediately comprehend that the applicant's services feature a business web site."

A. The Term WEB is Not the Equivalent of the Term WEB SITE

Applicant's mark is not BUSINESS WEB SITE or BUSINESS WEB SITES – it is THE BUSINESS WEB. The services, as amended, are limited to operating on-line marketplaces for buying, selling and exchanging computer software and on-demand applications. None of the examples of services recitations including the words "business web" in the trademark registrations provided by the Examining Attorney in the January 30, 2007 Office Action, to which the Examining Attorney refers in the Final Office Action at hand, appear to refer to or overlap with the services covered in Applicant's application, as amended. Namely, none use "business web" to refer to providing online marketplaces. Furthermore, none of the references refer to "business web" alone without some further modifier, e.g., "business web sites, business web hosting, etc."

BUSINESS WEB as a stand alone phrase is not the equivalent to BUSINESS WEB SITE. The Examining Attorney has provided no evidence that indicates BUSINESS WEB or even WEB has the same meaning as WEB SITE. In fact, online dictionaries define these terms in the computer field quite differently from each other, as follows:

WEB - WORLD WIDE WEB (WORLD WIDE WEB –noun a system of extensively interlinked hypertext documents: a branch of the Internet. Abbreviation: WWW)

WEB SITE - a connected group of pages on the World Wide Web regarded as a single entity, usually maintained by one person or organization and devoted to a single topic or several closely related topics.

Dictionary.com Unabridged (v 1.1) Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006., see print-outs featuring definitions attached hereto. Therefore, even if Applicant's services were or were closely related to "web sites" the mark THE BUSINESS WEB would not be merely descriptive.

B. THE BUSINESS WEB is a Double Entendre in the Case at Hand.

As amended, Applicant's recitation of services does not include any services that could be referred to as "THE BUSINESS WEB." Also, while it is well-taken that the fact that a term has other meanings is not relevant in all descriptiveness determinations, in the case at hand, THE BUSINESS WEB, in particular the term WEB would be perceived by consumers to have at least two meanings: (1) "an intricate set or pattern of circumstances, facts, etc.: The thief was convicted by a web of evidence. Who can understand the web of life?"; and (2) "(usually initial capital letter) Computers. World Wide Web." See *Dictionary.com Unabridged* (v 1.1). Random House, Inc. 08 Jan. 2007. <[Dictionary.com http://dictionary.reference.com/browse/web](http://dictionary.reference.com/browse/web)>, a print-out is attached hereto.

A consumer may perceive the term WEB to refer to the World Wide Web, in which case the mark would not be merely descriptive because Applicant's application covers an online marketplace for

buying, selling, and exchanging third party computer software (none of which are commonly referred to as WEBS or a WEB); or a consumer may perceive the term WEB to refer to a type of "tangled web" or "complex web" of business data or business matters. Because WEB can have at least two different meanings in the present context, and consumers would perceive these two meanings when encountering the mark in connection with the services covered in Applicant's application, especially when used with the additional terms THE BUSINESS, THE BUSINESS WEB cannot be immediately and merely descriptive. In this particular context, THE BUSINESS WEB is a "double entendre" capable of more than one interpretation with two meanings that are not merely descriptive in relation to Applicant's Services, as described above. Therefore, the mark is not merely descriptive.

For the reasons stated above, Applicant respectfully requests that the Examining Attorney withdraw the descriptiveness objection and allow the application, as amended, to proceed to publication.

IV. CONCLUSION

The points raised in the Office Action having been addressed herein, Applicant requests that the application be allowed to proceed to publication.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2007/12/11/2007121121213415345358-78792578-001_001/evi_6654170187-212642022_._THE_BUSINESS_WEB_req_for_recons_-_specimen.pdf
CONVERTED PDF FILE(S) (8 pages)	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR002.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR003.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR004.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR005.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR006.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR007.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR008.JPG
	\\TICRS2\EXPORT14\787925\78792578\xml1\RFR009.JPG
DESCRIPTION OF EVIDENCE FILE	specimen: scanned web dictionary pages

GOODS AND/OR SERVICES SECTION (035)(no change)	
GOODS AND/OR SERVICES SECTION (042)(class deleted)	
INTERNATIONAL CLASS	042
DESCRIPTION	
Application service provider (ASP) featuring computer software for: customer relationship management, business transaction and data tracking and analysis; collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data; customizing computer application interfaces; computer application development; web site development; application and database integration; and featuring computer software of others, all in the fields of business project management, business knowledge, information and asset management, customer relationship management, sales, marketing, e-commerce, electronic messaging, and web site development	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/Heather Dunn/
SIGNATORY'S NAME	Heather A. Dunn
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	12/11/2007
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Dec 11 21:34:15 EST 2007
TEAS STAMP	USPTO/RFR-66.54.170.187-2 0071211213415345358-78792 578-4102ad912968b1b3f2605 7a923d67a1dc4-N/A-N/A-200 71211212642022389

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **78792578** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

I. RECITATION OF SERVICES

Applicant wishes to amend its services to drop the services in class 42 and is requesting in and through this electronic response that the class 42 services be deleted.

II. LIKELIHOOD OF CONFUSION**A. Applicant's Mark Is Not Confusingly Similar To Cited Registration No. 3108337.**

The Examining Attorney has refused registration of Applicant's mark in classes 35 and 42 on the basis of existing Registration No. 3108337 in class 35 in the name of Thomas Spitters (the "Cited Registration"). Applicant asserts there is no likelihood of confusion between the respective marks, particularly in light of the services limitation made herein, and requests that Applicant's application be allowed to proceed to publication.

1. Applicant's Mark Is Used In Connection With Services Which Are Not The Same As The Services Covered By The Cited Registration.

The services covered in Applicant's application, as amended, are:

Class 35: Operating on-line marketplaces for buying, selling and exchanging computer software and on-demand applications;

When evaluating the issue of a likelihood of confusion in PTO proceedings, the Examining Attorney is constrained to compare the goods and/or services as recited in the application with the goods and/or services as recited in the registration. Applicant's application, as *amended*, covers operating an online marketplace for third parties to offer and purchase software.

By contrast, the Cited Registration covers business, tax, and legal advice and consulting, and covers no services related in any way to operating online marketplaces for any third party goods or services, or even any information technology related services or advice. Furthermore, the respective services are not competitive or complementary in any direct way.

Based on the differences between Applicant's and Registrant's respective services, as amended by Applicant herein, it is highly unlikely that consumers would believe the respective services emanated from the same source. For this reason, Applicant requests that the Examining Attorney discontinue the 2(d) refusal to register its mark based on Registrant's mark

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The type of customers who would contract Applicant for its services and the type of customers that would contact the owner of the Cited Registration for its services would both be sophisticated and careful purchasers. The Examining Attorney indicated in the Final Office Action that "where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class." Here, we have, on the one hand, purchasers of legal, business, and tax advice and consulting services. The least sophisticated of this class would be a very careful and thoughtful individual seeking advice in these areas. Such consumer would not make an un-considered agreement for services due to the critical nature of these areas of activity and their associated high costs. On the other hand, we have

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WEB SITE - a connected group of pages on the World Wide Web regarded as a single entity, usually maintained by one person or organization and devoted to a single topic or several closely related topics.

Dictionary.com Unabridged (v 1.1) Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006., see print-outs featuring definitions attached hereto. Therefore, even if Applicant's services were or were closely related to "web sites" the mark THE BUSINESS WEB would not be merely descriptive.

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As amended, Applicant's recitation of services does not include any services that could be referred to as "THE BUSINESS WEB." Also, while it is well-taken that the fact that a term has other meanings is not relevant in all descriptiveness determinations, in the case at hand, THE BUSINESS WEB, in particular the term WEB would be perceived by consumers to have at least two meanings: (1) "an intricate set or pattern of circumstances, facts, etc.: The thief was convicted by a web of evidence. Who can understand the web of life?"; and (2) "(usually initial capital letter) Computers. World Wide Web." See *Dictionary.com Unabridged* (v 1.1). Random House, Inc. 08 Jan. 2007. <[Dictionary.com http://dictionary.reference.com/browse/web](http://dictionary.reference.com/browse/web)>, a print-out is attached hereto.

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For the reasons stated above, Applicant respectfully requests that the Examining Attorney withdraw the descriptiveness objection and allow the application, as amended, to proceed to publication.

IV. CONCLUSION

The points raised in the Office Action having been addressed herein, Applicant requests that the application be allowed to proceed to publication.

EVIDENCE

Evidence in the nature of specimen: scanned web dictionary pages has been attached.

Original PDF file:

http://tgate/PDF/RFR/2007/12/11/20071211213415345358-78792578-001_001/evi_6654170187-212642022_._THE_BUSINESS_WEB_req_for_recons_-_specimen.pdf

Converted PDF file(s) (8 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 042 for Application service provider (ASP) featuring computer software for: customer relationship management, business transaction and data tracking and analysis; collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data; customizing computer application interfaces; computer application development; web site development; application and database integration; and featuring computer software of others, all in the fields of business project management, business knowledge, information and asset management, customer relationship management, sales, marketing, e-commerce, electronic messaging, and web site development

SIGNATURE(S)**Declaration Signature**

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Request for Reconsideration Signature

Signature: /Heather Dunn/ Date: 12/11/2007

Signatory's Name: Heather A. Dunn

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 78792578

Internet Transmission Date: Tue Dec 11 21:34:15 EST 2007

TEAS Stamp: USPTO/RFR-66.54.170.187-2007121121341534

5358-78792578-4102ad912968b1b3f26057a923

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World Wide Web

-noun

a system of extensively interlinked hypertext documents: a branch of the Internet.

Abbreviation: WWW

[Origin: 1990-95]

[Dictionary.com Unabridged \(v 1.1\)](#)

Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006.

[American Heritage Dictionary - Cite This Source - Share This](#)

World Wide Web

n. *Abbr.* WWW

The complete set of documents residing on all Internet servers that use the HTTP protocol, accessible to users via a simple point-and-click system.

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WordNet – Cite This Source – Share This
world wide web

noun

computer network consisting of a collection of internet sites that offer text and graphics and sound and animation resources through the hypertext transfer protocol

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Kernerman English Multilingual Dictionary (Beta Version) – Cite This Source – Share This
World Wide Web *noun*
see WWW

See also: web-footed, web-toed, webbing, web, Web site, webbed

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The American Heritage Science Dictionary – Cite This Source – Share This

World Wide Web  (wûrld) Pronunciation Key

The complete set of electronic documents stored on computers that are connected over the Internet and are made available by the protocol known as HTTP. The World Wide Web makes up a large part of the Internet. See more at Internet.

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World Wide Web

See Internet.

[Chapter:] *Technology*

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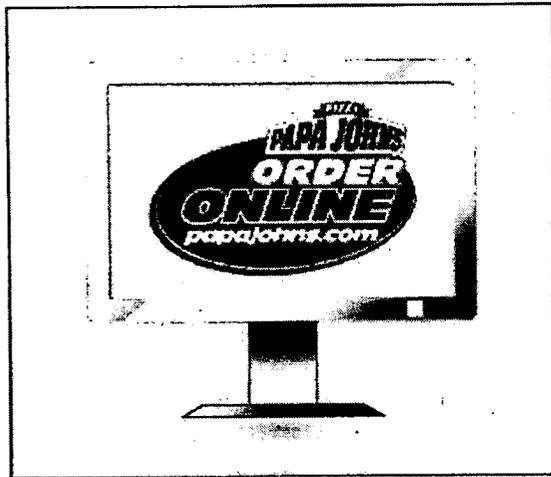
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[www.BizSitePro.com](#)

Dictionary.com Unabridged (v 1.1) - Cite This Source - Share This

Web site

-noun

Computers. a connected group of pages on the World Wide Web regarded as a single entity, usually maintained by one person or organization and devoted to a single topic or several closely related topics.

Also, **web site**, **web · site** [**web-sahyt**] [Pronunciation Key](#) - [Show IPA Pronunciation](#)

[Origin: 1990-95]

Dictionary.com Unabridged (v 1.1)

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web · site or **Web site** (wĕb'sīt') [Pronunciation Key](#)

Reli
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Free
these
Expl

Save
Dict

the same server, and prepared and maintained as a collection of information by a person, group, or organization.

Usage Note: The transition from *World Wide Web site* to *Web site* to *website* as a single uncapitalized word mirrors the development of other technological expressions which have tended to take unhyphenated forms as they become more familiar. Thus *email* is gaining ground over the forms *E-mail* and *e-mail*, especially in texts that are more technologically oriented. Similarly, there is an increasing preference for closed forms like *homepage*, *online*, and *printout*.

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web site

noun

a computer connected to the internet that maintains a series of web pages on the World Wide Web; "the Israeli web site was damaged by hostile hackers"

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Web site *noun*

see site

- | | |
|---------------------------------------|--|
| <i>Arabic:</i> موقع على شبكة الإنترنت | <i>Hungarian:</i> webhely, honlap |
| <i>Chinese (Simplified):</i> 网页 | <i>Lithuanian:</i> tinklapis |
| <i>Chinese (Traditional):</i> 網頁 | <i>Norwegian:</i> nettsted |
| <i>Czech:</i> internetová stránka | <i>Russian:</i> веб-сайт |
| <i>Danish:</i> website; websted | <i>Slovak:</i> webová stránka, Web stránka |
| <i>French:</i> site | <i>Slovenian:</i> spletna stran |
| <i>Greek:</i> δικτυακός τόπος | <i>Turkish:</i> internet sitesi |

See also: web-footed, web-toed, webbing, web, webbed, World Wide Web

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website or Web site  (wěb'sīt') Pronunciation Key

A set of interconnected webpages, usually including a homepage, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization.

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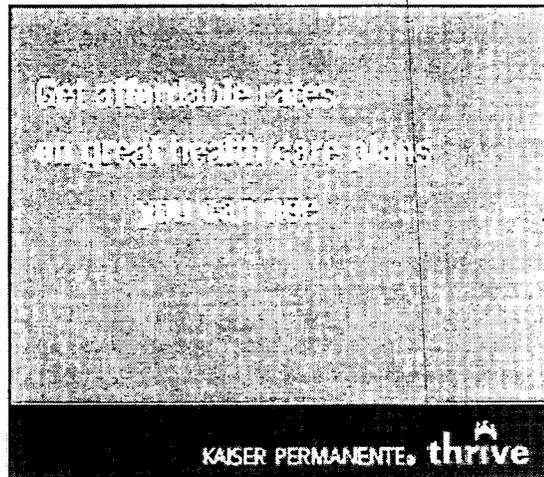
See Web page.

[Chapter:] *Technology*

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