

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79145528
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/79145528/large
LITERAL ELEMENT	INGAGE
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
<u>REQUEST FOR RECONSIDERATION</u>	
<p>This responds to the Final Office Action issued on February 19, 2015 wherein the Examining Attorney refused registration of the Applied-for Mark pursuant to 15 U.S.C. § 1052(d). Specifically, the Examining Attorney determined and maintains that the mark sought-to-be-registered is likely to be confused with: INGAGE NETWORKS, Registration No. 4,425,819, with regard to Class 9 and 42; and INGAGE CONSULTING, Registration No. 4,533,055, with regard to Class 35.</p> <p><i>Class 35</i></p> <p>While Applicant maintains that there is no likelihood of confusion with respect to its Applied-for Mark and the registered INGAGE CONSULTING mark, Applicant has reconsidered the services it provides under its Applied-for Mark and has determined that it is appropriate to deleted those services in Class 35 as incidental to its main services—namely, the provision of services specific to investor relations in the financial sector. Accordingly, Applicant respectfully believes that the 2(d) refusal with respect to INGAGE CONSULTING should be removed as moot.</p> <p><i>Classes 9 and 42</i></p> <p>While Applicant maintains that there is no likelihood of confusion with respect to its Applied-for</p>	

Mark and the registered INGAGE NETWORKS mark, Applicant hereby adds prominent limitations to the descriptions stated in Classes 9 and 42. In particular, Applicant adds the phrasing “*all aforesaid goods/services being provided in relation to investor relations.*” This limitation makes it apparent on the face of the application that the Applied-for Mark is used in connection with distinctly different goods and services when compared to the goods and services associated with the Registered Mark.

The aforementioned limitation is particularly relevant in light of the goods and services at issue. The United States Patent and Trademark Office has stated that software is to be evaluated using a subject-matter-based mode of analysis. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). Under such logic, any similarity as to the goods and services may not be presumed merely because the goods are delivered in the same media format. As held by the Trademark Trial and Appeal Board (the “Board”):

[T]he fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks.

Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992).

As previously noted, INGAGE NETWORKS is registered for use in connection with computer software that is used to create social networks to manage public comment and customer relations. In contrast, Applicant’s mark INGAGE is applied for use in connection with computer software that facilitates meetings between investors and shareholders. Further, with Applicant’s recent limitation, it could not be clearer that these goods and services are provided in relation to investor relations. Accordingly, the fact that both Applicant and Registrant offer software-related goods and services does not create a relationship between those goods and services such that consumers would believe all software originates from the same source simply because they are offered under marks with a common term.

Further, the services associated with Applicant and Registrant are directed to sophisticated consumers who are searching for services in connection with specific business and or investment capabilities.

These are not services that would be purchased on impulse. These sophisticated consumers, in addition to the differences between the subject matter of the software, obviate the risk of confusion.

Applicant respectfully asks the Examining Attorney to reevaluate the risk of confusion in light of the new goods/services limitations, the subject matter based mode of analysis for software related goods, and other relevant *Dupont* factors. Simply, the average consumer would not think that these computer

software programs emanate from the same source simply because they are sold under marks that have a common term.

GOODS AND/OR SERVICES SECTION (009)(current)

INTERNATIONAL CLASS 009

DESCRIPTION

Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS 009

TRACKED TEXT DESCRIPTION

~~Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders;~~ [Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid goods being provided in relation to investor relations](#)

FINAL DESCRIPTION

Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid goods being provided in relation to investor relations

GOODS AND/OR SERVICES SECTION (035)(class deleted)

GOODS AND/OR SERVICES SECTION (036)(no change)

GOODS AND/OR SERVICES SECTION (042)(current)

INTERNATIONAL CLASS 042

DESCRIPTION

Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders

GOODS AND/OR SERVICES SECTION (042)(proposed)

INTERNATIONAL CLASS 042

TRACKED TEXT DESCRIPTION

~~Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders;~~ [Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid services being provided in relation to investor relations](#)

FINAL DESCRIPTION

Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or

viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid services being provided in relation to investor relations

SIGNATURE SECTION

RESPONSE SIGNATURE	/samantha m quimby/
SIGNATORY'S NAME	Samantha M. Quimby
SIGNATORY'S POSITION	Attorney of record, Ohio bar member
SIGNATORY'S PHONE NUMBER	614.559.7282
DATE SIGNED	08/19/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Wed Aug 19 16:17:50 EDT 2015
TEAS STAMP	USPTO/RFR-69.61.131.58-20 150819161750300182-791455 28-540ec9ca6d6c7f74ad878d 23d2f52f2b1dca3c60d31ae8a 271d9a7e9faf14140dc-N/A-N /A-20150819160954595875

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **79145528** INGAGE (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/79145528/large>) has been amended as follows:

ARGUMENT(S)

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

REQUEST FOR RECONSIDERATION

This responds to the Final Office Action issued on February 19, 2015 wherein the Examining Attorney refused registration of the Applied-for Mark pursuant to 15 U.S.C. § 1052(d). Specifically, the Examining Attorney determined and maintains that the mark sought-to-be-registered is likely to be confused with: INGAGE NETWORKS, Registration No. 4,425,819, with regard to Class 9 and 42; and

INGAGE CONSULTING, Registration No. 4,533,055, with regard to Class 35.

Class 35

While Applicant maintains that there is no likelihood of confusion with respect to its Applied-for Mark and the registered INGAGE CONSULTING mark, Applicant has reconsidered the services it provides under its Applied-for Mark and has determined that it is appropriate to delete those services in Class 35 as incidental to its main services—namely, the provision of services specific to investor relations in the financial sector. Accordingly, Applicant respectfully believes that the 2(d) refusal with respect to INGAGE CONSULTING should be removed as moot.

Classes 9 and 42

While Applicant maintains that there is no likelihood of confusion with respect to its Applied-for Mark and the registered INGAGE NETWORKS mark, Applicant hereby adds prominent limitations to the descriptions stated in Classes 9 and 42. In particular, Applicant adds the phrasing “*all aforesaid goods/services being provided in relation to investor relations.*” This limitation makes it apparent on the face of the application that the Applied-for Mark is used in connection with distinctly different goods and services when compared to the goods and services associated with the Registered Mark.

The aforementioned limitation is particularly relevant in light of the goods and services at issue. The United States Patent and Trademark Office has stated that software is to be evaluated using a subject-matter-based mode of analysis. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). Under such logic, any similarity as to the goods and services may not be presumed merely because the goods are delivered in the same media format. As held by the Trademark Trial and Appeal Board (the “Board”):

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clearer that these goods and services are provided in relation to investor relations. Accordingly, the fact that both Applicant and Registrant offer software-related goods and services does not create a relationship between those goods and services such that consumers would believe all software originates from the same source simply because they are offered under marks with a common term.

Further, the services associated with Applicant and Registrant are directed to sophisticated consumers who are searching for services in connection with specific business and or investment capabilities. These are not services that would be purchased on impulse. These sophisticated consumers, in addition to the differences between the subject matter of the software, obviate the risk of confusion.

Applicant respectfully asks the Examining Attorney to reevaluate the risk of confusion in light of the new goods/services limitations, the subject matter based mode of analysis for software related goods, and other relevant *Dupont* factors. Simply, the average consumer would not think that these computer software programs emanate from the same source simply because they are sold under marks that have a common term.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Class 035 for Arranging business introductions, namely, providing referrals in the field of investor relations; arranging of presentations for business purposes in the field of investor relations; assistance in management of business activities

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders;~~ Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid goods being provided in relation to investor relations

Class 009 for Computer software for scheduling, publicising, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid goods being provided in relation to investor relations

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 042 for Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders
Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders;~~
Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid services being provided in relation to investor relations

Class 042 for Providing online non-downloadable software for scheduling, publicizing, hosting, conducting and/or viewing of meetings between quoted companies and investors and shareholders, all of the aforesaid services being provided in relation to investor relations

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /samantha m quimby/ Date: 08/19/2015

Signatory's Name: Samantha M. Quimby

Signatory's Position: Attorney of record, Ohio bar member

Signatory's Phone Number: 614.559.7282

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 79145528

Internet Transmission Date: Wed Aug 19 16:17:50 EDT 2015

TEAS Stamp: USPTO/RFR-69.61.131.58-20150819161750300

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