

ESTTA Tracking number: **ESTTA441032**

Filing date: **11/15/2011**

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

Proceeding	85026093
Applicant	NCO Holdings, Inc.
Applied for Mark	NRC NATIONAL REVENUE CORPORATION AN NCO COMPANY
Correspondence Address	JENNIFER L. STEFANSKI BLANK ROME LLP 1 LOGAN SQ FL 8 PHILADELPHIA, PA 19103-6998 UNITED STATES casey@blankrome.com
Submission	Applicants Request for Remand and Amendment
Attachments	NRC Request for Remand.pdf ( 4 pages )(46181 bytes ) Exhibit A.pdf ( 1 page )(5915 bytes ) NCO Consent Agreement for NSA.pdf ( 4 pages )(215239 bytes )
Filer's Name	Jennifer L. Stefanski
Filer's e-mail	stefanski@blankrome.com, casey@blankrome.com
Signature	/Jennifer L. Stefanski/
Date	11/15/2011

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

Applicant: NCO Holdings, Inc.

Serial No.: 85/026,093



Mark:

Classes: 35 and 36

Filed: April 29, 2010

To: Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Attn: Trademark Trial and Appeal Board

**REQUEST FOR REMAND TO TRADEMARK EXAMINING ATTORNEY**

Applicant respectfully requests that the Trademark Trial and Appeal Board (the "Board") remand jurisdiction of the application to the Examining Attorney in order that the Applicant may submit additional evidence that was not previously available. See T.B.M.P. § 1207.02(1).

**A. Consent to Register**

In her Denial of Applicant's Request for Reconsideration, dated August 1, 2011, the Examining Attorney reinstated the finality of her prior Office Action, refusing registration of Applicant's mark pursuant to Section 2(d) of the Lanham Act.

The Examining Attorney maintained and continued her likelihood of confusion refusal with regard to Registration Nos. 3,769,957 and 3,769,958 for the marks NSA NORTH SHORE AGENCY AN NCO COMPANY and Design and NSAC NORTH SHORE AGENCY CANADA AN NCO COMPANY and Design, respectively, as owned by Transworld Systems Inc. In correspondence dated August 25, 2011, the Trademark Trial and Appeal Board initiated the ex parte appeal proceedings. On October 25, 2011, the Board granted Applicant's request for an extension of time in order to allow Applicant time to seek a consent agreement, providing Applicant until November 23, 2011 to file its brief.

Pursuant to T.B.M.P. § 1207.02(1), providing that additional evidence is appropriate where, "[t]he evidence was not previously available," Applicant hereby respectfully requests that the Board suspend the Appeal and remand the application to the Examining Attorney in light of new evidence.

The Trademark Rules provide that an applicant may request the Board to suspend an ex parte appeal and remand the case to the Examining Attorney upon a showing of good cause.

37 C.F.R. § 2.117; T.B.M.P. § 1213. Applicant's mark has been refused registration for an alleged likelihood of confusion with the marks NSA NORTH SHORE AGENCY AN NCO COMPANY and Design (Reg. No. 3,769,957) and NSAC NORTH SHORE AGENCY CANADA AN NCO COMPANY and Design (Reg. No. 3,769,958). As Applicant's arguments

against such refusal have, to this point, been denied, Applicant respectfully requests that this appeal be remanded to allow Applicant to submit to the Examining Attorney evidence of the attached executed consent agreement, which Applicant has executed with Transworld Systems Inc. (See Exhibit A.)

Applicant has not previously submitted the consent agreement in this matter, because Applicant has a complex and diverse worldwide structure, and the parties were deciding the terms of the agreement. Thus, the agreement was not previously available for the Examining Attorney to review as evidence. See T.B.M.P. § 1207.02(1).

Applicant submits that, where no final decision has been rendered, and where the attached consent agreement establishes, among other factors, that Registrant consents to Applicant's registration of the mark, the parties agree to cooperate with one another to eliminate or minimize any confusion that may arise from the coexistence of their respective marks, to notify each other of any incidents of actual confusion of which they become aware and to take reasonable action to try to preclude any such incidents of confusion from reoccurring, the refusal to register should be withdrawn by the Examining Attorney.

#### **CONCLUSION**

As all of the concerns of the Trademark Trial and Appeal Board have been satisfied, Applicant respectfully requests the

Board to suspend the instant ex parte appeal proceedings, and remand the application to the Examining Attorney to review the issues presented in light of the new evidence of registrability, and to approve Applicant's mark for publication.

Respectfully submitted,

NCO HOLDINGS, INC.

Dated: November 15, 2011      By:       /Jennifer L. Stefanski/        
Lisa Casey Spaniel  
Jennifer L. Stefanski  
Its Attorneys

BLANK ROME LLP  
One Logan Square  
Philadelphia, PA 19103  
(215) 569-5337

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on November 15, 2011.

      /Jennifer L. Stefanski/        
Jennifer L. Stefanski

# EXHIBIT A

## CONSENT AGREEMENT

THIS AGREEMENT is entered into as of this \_\_\_ day of October, 2011 by and between Transworld Systems, Inc. d/b/a North Shore Agency (“Transworld”), a California corporation having a place of business at 5880 Commerce Boulevard, Rohnert Park, California 94928, and NCO Holdings, Inc. (“NCO”), a Delaware corporation having a place of business at 507 Prudential Road, Horsham, Pennsylvania 19044 (each party to this Agreement is also individually referred to as “Party” or collectively as “Parties”);

WHEREAS, Transworld is the owner of the following registrations:

MARK	REG./APP. NO.	ISSUE/FILING DATE	IDENTIFICATION
 <b>NORTH SHORE</b> <b>AGENCY</b> <small>AN NCO COMPANY</small>	3,769,957	4/6/2010	35: accounts receivable management services 36: debt recovery and collection services
 <b>NORTH SHORE</b> <b>AGENCY CANADA</b> <small>AN NCO COMPANY</small>	3,769,958	4/6/2010	35: accounts receivable management services 36: debt recovery and collection services

(hereinafter collectively referred to as the “Transworld Marks”);

WHEREAS, NCO is the owner of following pending applications:

MARK	REG./APP. NO.	ISSUE/FILING DATE	IDENTIFICATION
 <b>NCO</b>	77/961,095	3/17/2010	35: accounts receivable management services 36: debt recovery and collection services

MARK	REG./APP. No.	ISSUE/FILING DATE	IDENTIFICATION
	85/024,964	4/28/2010	35: accounts receivable management services 36: debt recovery and collection services
	85/026,093	4/29/2010	35: accounts receivable management services 36: debt recovery and collection services
	85/026,094	4/29/2010	35: accounts receivable management services 36: debt recovery and collection services

(hereinafter referred to as the “NCO Mark”);

**WHEREAS**, Transworld has registered and is using the NSA NORTH SHORE AGENCY AN NCO COMPANY and Design and the NSAC NORTH SHORE AGENCY CANADA AN NCO COMPANY and Design marks, as reflected in Registration Nos. 3,769,957 and 3,769,958, respectively;

**WHEREAS**, NCO desires to register and is using the NCO and Design, NCO HEALTHCARE SERVICES and Design, NRC NATIONAL REVENUE CORPORATION AN NCO COMPANY and Design, and STATEWIDE MERCANTILE SERVICES PTY LTD AN NCO COMPANY and Design marks, as reflected in Application Nos. 77/961,095, 85/024,964, 85/026,093, and 85/026,094, respectively; and

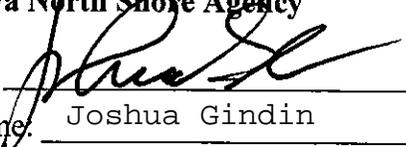
**WHEREAS**, the Parties have concluded that no likelihood of confusion exists because Transworld and NCO are related companies and flow from a common corporate parent (through one or more wholly-owned subsidiaries). As Transworld and NCO all flow from a common corporate parent that exerts uniform control over the brands of these entities, use of the Transworld Marks and the NCO Marks is not likely to cause any public confusion, mistake or deception as to source. Further, consumer confusion is not likely to arise because Transworld has indicated the origin of its services in its Transworld Marks.

**NOW, THEREFORE**, in consideration of the mutual promises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, and intending to be legally bound, the Parties agree as follows:

1. Transworld agrees and consents to NCO's use and registration of its NCO marks, as depicted in Application Nos. 77/961,095, 85/024,964, 85/026,093, and 85/026,094;
2. NCO agrees and consents to Transworld's use and registration of its Transworld Marks, as depicted in Registration Nos. 3,769,957 and 3,769,958; and
3. The Parties agree to take all reasonable action necessary to prevent any confusion that may arise from the coexistence of their respective marks, to notify each other of any incidents of actual confusion of which they become aware and to take reasonable action to try to preclude any such incidents of confusion from reoccurring.

[SIGNATURE PAGE FOLLOWS]

IN WITNESS WHEREOF, to be executed by Transworld and NCO effective as of the date of last signature, in duplicate copies, each of which shall be deemed an original.

<b>TRANSWORLD SYSTEMS, INC.</b> d/b/a North Shore Agency	<b>NCO HOLDINGS, INC.</b>
By: 	By: 
Name: <u>Joshua Gindin</u>	Name: <u>Joshua Gindin</u>
Title: <u>Secretary</u>	Title: <u>Executive Vice President &amp; General Counsel</u>
Date: <u>October 25, 2011</u>	Date: <u>October 25, 2011</u>