

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86512490
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 106
<b>MARK SECTION</b>	
<b>MARK FILE NAME</b>	http://tmng-al.uspto.gov/resting2/api/img/86512490/large
<b>LITERAL ELEMENT</b>	ISOLUTIONS PLATFORM · ANALYTICS · RESULTS
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>COLOR(S) CLAIMED (If applicable)</b>	Color is not claimed as a feature of the mark.
<b>DESCRIPTION OF THE MARK (and Color Location, if applicable)</b>	The mark consists of the word ISOLUTIONS with the letter I stylized; a horizontal line below ISOLUTIONS; the words PLATFORM ANALYTICS RESULTS below the horizontal line and dots between each word.
<b>ARGUMENT(S)</b>	
<p>Applicant requests reconsideration and withdrawal of the refusal to register based on prior registration No. 4,658,689. Applicant has obtained the written consent to register this mark from the owner of that registration, Impact Management Services, Inc. as evidenced by the attached fully executed consent agreement. That agreement contains numerous reasons why the two marks can co-exist on the Register and in the marketplace. These are set forth in the agreement and include the fact that 1) the marks are different in appearance, 2) the parties offer different different products to different industries having different customers, namely Applicant offers its customer retention services to banks, credit unions and financial institutions, while Registrant offers manufacturing efficiency solutions to pharmaceutical and life sciences industries, 3) the customers for both parties' services are sophisticated and experienced professional buyers, 4) Applicant offers marketing services while Registrant offers management services under their respective marks, and, 5) the parties are not competitors in the marketplace. The attached agreement is an arms' length agreement reached between commercial parties operating in the marketplace. Their agreement that there is no likelihood of confusion, and that the two marks can co-exist in the marketplace and on the Principal Register should be accepted in order to withdraw the refusal to register and advance the application on to publication. The outstanding Office action also contains a request for a disclaimer of "Platform, Analytics and Results" apart from the mark. A suitable disclaimer has been entered by the Applicant, and that objection should now be withdrawn. Applicant submits that the application is now in condition for allowance as the confusing similar refusal and disclaimer issues are the only issue remaining. Both have been addressed herein. Advancement to publication is respectfully requested.</p>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_680174235-20160523180156365371_i-Solutions_consent_to_use.pdf</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\865\124\86512490\xml8\RFR0002.JPG</a> <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\865\124\86512490\xml8\RFR0003.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Executed Consent to Registration signed by the CEO of Owner of Reg. No. 4,658,689
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>DISCLAIMER</b>	No claim is made to the exclusive right to use "PLATFORM, ANALYTICS, and RESULTS" apart from the mark as shown.
<b>SIGNATURE SECTION</b>	

RESPONSE SIGNATURE	/John A. Clifford/
SIGNATORY'S NAME	John A. Clifford
SIGNATORY'S POSITION	Attorney for Applicant
SIGNATORY'S PHONE NUMBER	612.336.4616
DATE SIGNED	05/23/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Mon May 23 18:14:04 EDT 2016
TEAS STAMP	USPTO/RFR-XX.X.XXX.XXX-20 160523181404824213-865124 90-5503419479a1eb1e6cd40a 0f5448f10abc0175ed61c0aaa 9c754dff4c933e39b22-N/A-N /A-20160523180156365371

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.  
PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86512490** ISOLUTIONS PLATFORM · ANALYTICS · RESULTS (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86512490/large>) has been amended as follows:

#### ARGUMENT(S)

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

Applicant requests reconsideration and withdrawal of the refusal to register based on prior registration No. 4,658,689. Applicant has obtained the written consent to register this mark from the owner of that registration, Impact Management Services, Inc. as evidenced by the attached fully executed consent agreement. That agreement contains numerous reasons why the two marks can co-exist on the Register and in the marketplace. These are set forth in the agreement and include the fact that 1) the marks are different in appearance, 2) the parties offer different products to different industries having different customers, namely Applicant offers its customer retention services to banks, credit unions and financial institutions, while Registrant offers manufacturing efficiency solutions to pharmaceutical and life sciences industries, 3) the customers for both parties' services are sophisticated and experienced professional buyers, 4) Applicant offers marketing services while Registrant offers management services under their respective marks, and, 5) the parties are not competitors in the marketplace. The attached agreement is an arms' length agreement reached between commercial parties operating in the marketplace. Their agreement that there is no likelihood of confusion, and that the two marks can co-exist in the marketplace and on the Principal Register should be accepted in order to withdraw the refusal to register and advance the application on to publication. The outstanding Office action also contains a request for a disclaimer of "Platform, Analytics and Results" apart from the mark. A suitable disclaimer has been entered by the Applicant, and that objection should now be withdrawn. Applicant submits that the application is now in condition for allowance as the confusing similar refusal and disclaimer issues are the only issue remaining. Both have been addressed herein. Advancement to publication is respectfully requested.

#### EVIDENCE

Evidence in the nature of Executed Consent to Registration signed by the CEO of Owner of Reg. No. 4,658,689 has been attached.

#### Original PDF file:

[evi\\_680174235-20160523180156365371\\_i-Solutions\\_consent\\_to\\_use.pdf](#)

Converted PDF file(s) ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

## **ADDITIONAL STATEMENTS**

### **Disclaimer**

No claim is made to the exclusive right to use "PLATFORM, ANALYTICS, and RESULTS" apart from the mark as shown.

### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /John A. Clifford/ Date: 05/23/2016

Signatory's Name: John A. Clifford

Signatory's Position: Attorney for Applicant

Signatory's Phone Number: 612.336.4616

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86512490

Internet Transmission Date: Mon May 23 18:14:04 EDT 2016

TEAS Stamp: USPTO/RFR-XX.X.XXX.XXX-20160523181404824

213-86512490-5503419479a1eb1e6cd40a0f544

8f10abc0175ed61c0aaa9c754dff4c933e39b22-

N/A-N/A-20160523180156365371

# Merchant & Gould

An Intellectual Property Law Firm

5635 N. Scottsdale  
Road  
Suite 170  
Scottsdale, AZ 85250  
Telephone: 612.332.5300  
Fax: 612.332.9081  
www.merchantgould.com  
A Professional Corporation

Direct | 480.725.8806  
Contact | jclifford@merchantgould.com

May 17, 2016

VIA EMAIL  
dbennett@coatsandbennett.com

David E. Bennett  
COATS & BENNETT, P.L.L.C.  
1400 Crescent Grn Ste 300  
Cary, NC 27518-8118

Re: U.S. Trademark Applications for **ISOLUTIONS** (Serial No. 86/509325) and  
*i* S O L U T I O N S  
Platform • Analytics • Results (Serial No. 86/512490) in the name of Allied Solutions, LLC  
Our Ref: 04987.0005US01

Dear Mr. Bennett:

I represent Allied Solutions, LLC, (Allied) a leading producer of products for the financial services industry. Allied is using the trademarks ISOLUTIONS, and ISOLUTIONS PLATFORM · ANALYTICS · RESULTS & DESIGN for business marketing services in the field of banking and credit union customer retention and customer relationship expansion. Allied has used these marks since April 17, 2012 and January 2013, respectively. Allied has sought to register these trademarks with the U.S. Patent and Trademark Office. We have been advised of the existence of U.S. Registration No. 4,658,689 for the mark I-SOLUTIONS issued to Impact Management Services, Inc. (Impact) based on first use of that mark on January 1, 2014. We note that the services covered by the registration are business management, and that you are the attorney of record.

We believe that the services offered by Allied under its trademarks travel in distinct and separate channels of trade from those occupied by Impact under the I-SOLUTIONS mark. Namely, Allied services banks and credit unions seeking to improve their customer retention of existing customers, and increase loan business with those customers, while Impact provides product manufacturing efficiency solutions to the pharmaceutical and life science industries. We also believe that the typical purchasers for Impact's services and Allied's services are relatively sophisticated and experienced professional buyers. We also note that the respective marks of the parties are different in appearance, and Allied's design mark includes the words, "platform," "analytics," and "results" which do not appear in the Impact mark. We also note that Allied provides marketing services, while Impact provides management services. Allied and Impact are not competitors.

Atlanta | Denver | Knoxville | Madison | Minneapolis | New York | Seattle | Washington  
DC

May 17, 2016  
Page 2

We therefore believe that there is no likelihood of confusion presented by simultaneous use by Allied Solutions of the marks ISOLUTIONS and ISOLUTIONS PLATFORM · ANALYTICS · RESULTS & DESIGN and by Impact Management Services of the mark I-SOLUTIONS. We trust you will agree.

We therefore ask that Impact consent to the use and registration by Allied of the marks ISOLUTIONS and ISOLUTIONS PLATFORM · ANALYTICS · RESULTS & DESIGN, as shown in U.S. Application Serial Numbers 86/509325 and 86/512490 respectively, for business marketing services in the field of banking and credit union customer retention and customer relationship expansion.

The parties also agree that should instances of actual confusion become known to either party, the parties will work in good faith to reduce or eliminate any such confusion from the marketplace.

We expect that you will find the explanation contained in this letter sufficient to allow you to agree with this request. If you are agreeable, please have Impact sign below indicating their consent to this request and return a copy of the same to me. Please feel free to contact me should you have any questions about this matter.

Sincerely,

John A. Clifford

JAC/aja

CONSENT TO USE AND REGISTRATION

ON BEHALF OF IMPACT MANAGEMENT SERVICES, INC., IT IS AGREED THAT ALLIED SOLUTIONS, LLC MAY USE AND REGISTER THE "ISOLUTIONS" AND "ISOLUTIONS PLATFORM · ANALYTICS · RESULTS & DESIGN" MARKS FOR BUSINESS MARKETING SERVICES IN THE FIELD OF BANKING AND CREDIT UNION CUSTOMER RETENTION AND CUSTOMER RELATIONSHIP EXPANSION

Date: 23 May 16

By:   
Title: CEO