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MARK: ON-DEMAND LOCATION



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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Targus Information Corporation

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112171-27

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the proposed mark ON-DEMAND LOCATION on the grounds that it is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act., 15 U.S.C. § 1052(e)(1).

I. FACTS

This matter is before the Board following applicant's trademark application filed on June 12, 2007 to register the proposed mark ON-DEMAND LOCATION in standard characters for services identified as "information services, namely providing client organizations with information about callers and visitors to their web sites; and providing call-routing services and store-locator services for web site visitors."

Through the first office action dated September 17, 2007, the proposed mark was refused under Section 2(e)(1) of the Trademark Act. The examining attorney determined that the proposed mark is descriptive because it conveys to consumers that the services feature the provision of location information on demand. In addition, the examining attorney required amendments to the recitation of services.

Applicant responded on March 17, 2008, submitting arguments in response to the Section 2(e)(1) refusal and voluntarily disclaiming the wording LOCATION in the mark. In addition, applicant amended the recitation of services to “business information services, namely, providing client organizations with statistical and demographic information about callers and visitors to their web sites.”

On April 7, 2008, the examining attorney issued a final refusal of the mark under Section 2(e)(1) of the Trademark Act. Applicant’s amendment to the recitation of services was accepted. Applicant filed a Request for Reconsideration and Notice of Appeal on October 7, 2008. The examining attorney denied applicant’s Request for Reconsideration on November 5, 2008.

II. ISSUE

WHETHER THE PROPOSED MARK ON-DEMAND LOCATION IS MERELY DESCRIPTIVE OF APPLICANT’S SERVICES PURSUANT TO SECTION 2(e)(1) OF THE TRADEMARK ACT.

ARGUMENT

THE PROPOSED MARK CONSISTS OF A COMPOSITE MARK, WHICH IS MERELY DESCRIPTIVE OF APPLICANT’S SERVICES.

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified services. *See In re Steelbuilding.com*, 415

F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005). “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *Id* at 1173; TMEP §1209.01(b).

Applicant seeks to register ON-DEMAND LOCATION for services identified as “business information services, namely, providing client organizations with statistical and demographic information about callers and visitors to their web sites.” Applicant argues that the wording ON DEMAND alone and in combination with the wording LOCATION is not merely descriptive of applicant’s services because the mark does not convey that applicant’s services provide information about the location of consumers or that such information is provided “on demand.” Applicant’s Brief at 1.

The examining attorney respectfully submits that the proposed mark is merely descriptive because it conveys to consumers that the services include the provision of location information. In addition, the mark conveys that the information is provided on demand. The examining attorney also respectfully submits that the evidence of record supports the refusal under Section 2(e)(1) of the Trademark Act.

A. The Wording ON-DEMAND Is Merely Descriptive of the Identified Services

A mark is suggestive if some imagination, thought or perception is needed to understand the nature of the services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a). In determining the descriptiveness of a term or mark comprising

more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Oppedahl at 1174-75.*

Attached to the office action dated September 15, 2007, the examining attorney provided dictionary evidence from www.netlingo.com indicating that the wording ON-DEMAND is defined as “when asked for” and “refers to stored content that users can access whenever they want, as opposed to live or one-time-only broadcast events.” In addition, through the November 5, 2008 denial of applicant’s Request for Reconsideration, the examining attorney provided additional dictionary evidence from whatis.com indicating that “on-demand computing” is defined as:

On-demand (OD) computing is an increasingly popular enterprise model in which computing resources are made available to the user as needed. The resources may be maintained within the user's enterprise, or made available by a service provider. The on-demand model was developed to overcome the common challenge to an enterprise of being able to meet fluctuating demands efficiently. Because an enterprise's demand on computing resources can vary drastically from one time to another, maintaining sufficient resources to meet peak requirements can be costly. Conversely, if the enterprise cuts costs by only maintaining minimal computing resources, there will not be sufficient resources to meet peak requirements. On-demand computing products are rapidly becoming prevalent in the marketplace. Computer Associates, HP, IBM, Microsoft, and Sun Microsystems are among the more prominent on-demand vendors. These companies refer to their on-demand products and services by a variety of names. IBM calls theirs "On Demand Computing" (without the hyphen). Concepts such as grid computing, utility computing, autonomic computing, and adaptive management seem very similar to the concept of on-demand computing. Jason Bloomberg, Senior Analyst with ZapThink, says that on-demand computing is a broad category that includes all the other terms, each of which means something slightly different. Utility computing, for example, is an on-demand approach that combines outsourced computing resources and infrastructure management with a usage-based payment structure (this approach is sometimes known as metered services).

In addition to the dictionary evidence, the examining attorney submitted advertising material taken from applicant’s website and attached to the November 5,

2008 denial of applicant's Request for Reconsideration. This evidence indicates that applicant provides products and services, which feature the dynamic "delivery of relevant and actionable information." The advertising indicates to consumers that solutions include "a wealth of knowledge at the moment you need it." Consumers are also advised that "in a split second, you can access our rich data and analytics to identify, verify, qualify and locate the people who are interacting with your organization."

The subject advertising also refers to a suite of services provided by applicant. These include ON-DEMAND LOCATION; ON-DEMAND IDENTIFICATION; ON-DEMAND VERIFICATION and CALLER NAME SERVICES.

In advertising evidence made of record as part of the April 7, 2008 final office action, Applicant's ON-DEMAND LOCATION services are described as follows:

"With TARGUSinfo On-Demand LocationSM solutions, you can pinpoint a customer's location within a radius of 105 feet, whether you're routing callers or providing your locations. With On-Demand Location, you can use our proprietary mapping tools to define geographic service areas down to the street level, freeing you from ZIP code or area code constraints. It even takes into account geographical obstacles, such as lakes and wooded areas." So, regardless of whether you want to identify the closest store, the most appropriate service center or prioritize where calls are directed, we'll deliver your customers where you want them — your bottom line."

Applicant argues that its services are not provided "ON-DEMAND," which applicant indicates is commonly understood to mean "instantly provided." Applicant's Brief at 3. However, the evidence indicates that the wording ON-DEMAND standing alone and in combination with LOCATION is merely descriptive of the identified services because applicant's business information services features the provision of statistical and demographic information including location information. The wording ON-DEMAND is descriptive because the services feature access to the information as

described by the advertising at a time of the customer's choice. As applicant's website indicates, the services allow consumers to obtain the information "when asked for" and in a split second.

A mark that combines descriptive words may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark's immediate association with the nursery rhyme "sugar and spice and everything nice"). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *See, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive for theater ticket sales services).

The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark created imparts an incongruous meaning as used in connection with the services. TMEP §1209.03(d); *e.g., In re Copytele, Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994). Where, as in this case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the services, the mark is merely descriptive.

B. The Evidence Supports The Refusal under Section 2(e)(1) of the Trademark Act

The determination of whether a mark is merely descriptive is considered in relation to the identified services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b). The services at

issue in this case are “business information services, namely, providing client organizations with statistical and demographic information about callers and visitors to their web sites.”

Applicant argues that its mark “does not convey that applicant’s services provide information about location of consumers or that such information is provided ‘on-demand.’ Applicant’s Brief at 2. It should be noted, however, that applicant has disclaimed the wording LOCATION apart from the mark as shown. Applicant also argues that “applicant’s mark at most implies that customers, upon request, can obtain the sought after information after signing up for the services of the applicant.” *Id* at 3.

However, the evidence of record contradicts applicant’s position. As previously noted, applicant specifically markets its services as allowing consumers to access a “wealth of knowledge at the moment you need it.” The advertising evidence provided with the November 5, 2008 denial of applicant’s Request for Reconsideration also describes applicant’s services as being “delivered on-demand so you can VERIFY.” Moreover, the advertising for the ON-DEMAND LOCATION services clearly indicate that provision of location information is a feature of the services.

When viewing the proposed mark in relation to the identified services, consumers are likely to conclude that the services feature the provision of on demand location information. Based upon the evidence of record, the proposed mark is merely descriptive as defined under Section 2(e)(1) of the Trademark Act.

III. CONCLUSION

For the foregoing reasons, the refusal of the proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1) should be affirmed.

Respectfully submitted,

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