

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field   | Entered        |
|---|----------------|
| <b>SERIAL NUMBER</b>  | 77234926       |
| <b>LAW OFFICE ASSIGNED</b>  | LAW OFFICE 116 |
| <b>MARK SECTION (no change)</b>   |                |
| <b>ARGUMENT(S)</b>  |                |
| <p>In response to the official action dated May 12, 2008, Applicant submits the following amendment, remarks and request for reconsideration.</p> <p style="padding-left: 40px;">Please amend the recitation of services to read as follows:</p> <p style="padding-left: 80px;">“On-line unified communications aptitude test for providing on-line advertising and marketing information on a selection of unified communications products and services” in International Class 35.</p> <p style="text-align: center;"><b><u>REMARKS</u></b></p> <p>Registration for Applicant’s mark UCAN for use with its services has been refused under Section 2(d) of the Trademark Act based on Registration No. 2,871,363. Applicant respectfully traverses this refusal and requests reconsideration.</p> <p>Applicant has amended the description of services to clarify and make more specific the testing that is being offered under the UCAN mark. The description now specifically identifies that the on-line test is a unified communications aptitude test for providing on-line advertising of unified communications products and services based on the unified communications needs assessed from the test. This is to clarify that Applicant is not offering “testing services” or educational services as indicated by the Examining Attorney, but a specific unified communications test to provide advertising and marketing information.</p> |                |

The cited registration is for the mark UCAN for “educational services in the nature of test preparation courses; tutoring services for high school students; educational services, namely conducting workshops in the areas of leadership and of training others for student counseling, and to provide tutoring and testing services” in class 41. In contrast, Applicant’s mark is for a unified communications test to assess the unified communications needs of the test taker and provide advertising and marketing information on a selection of unified communications products and services to meet those needs. Applicant is not using the mark to indicate any testing services, educational services, or tutoring services.

Applicant’s service is offered as a test to help sophisticated enterprise purchasers determine their level of use of unified communications, and to target specific advertising of unified communications products and services to help the enterprise purchaser improve their unified communications capabilities. Applicant’s test is a free service offered on its own website and provides advertising information on unified communications products sold by Applicant. Purchasers that would use Applicant’s UCAN test would be taking the test to determine what products and services Applicant can provide to them in the unified communications space. As Applicant’s products are only sold to enterprises and Applicant’s UCAN service is offered only on Applicant’s website, the users of Applicant’s service would not and could not be confused with the cited mark that is being used for selling educational and tutoring services directed to students to help them improve educationally and get into college. Applicant’s mark is used for a free service to provide advertising literature on Applicant’s products, and Registrant’s mark is used to sell educational and tutoring services. Applicant submits that the differences in the respective services and trade channels are such as to preclude any reasonable likelihood of confusion.

Applicants’ goods and services and the services associated with the cited mark have different markets (namely, enterprises versus individuals), different channels of trade (namely, Applicant’s own website for enterprise communication products versus Registrant’s ucanprep.com website), different sophisticated consumers (namely, enterprise consumers versus students), and different uses of their respective marks on different services (namely, free testing to determine unified communications needs versus selling educational and tutoring services). Applicant submits that these differences

between the Registrant's services and the Applicant's services, preclude any reasonable likelihood of confusion between the cited registration and the present application.

In view of the above amendment and remarks, Applicant submits that the mark UCAN is suitable for registration on the Principal Register in International Class 35. Favorable action is therefore respectfully requested. The Examining Attorney is invited to telephone the undersigned attorney with any matters that would expedite prosecution of this application.

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

|                     |     |
|---------------------|-----|
| INTERNATIONAL CLASS | 035 |
|---------------------|-----|

**DESCRIPTION**

On-line testing to determine professional competency in unified communications

|              |              |
|--------------|--------------|
| FILING BASIS | Section 1(b) |
|--------------|--------------|

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

|                     |     |
|---------------------|-----|
| INTERNATIONAL CLASS | 035 |
|---------------------|-----|

**DESCRIPTION**

On-line unified communications aptitude test for providing on-line advertising and marketing information on a selection of unified communications products and services

|              |              |
|--------------|--------------|
| FILING BASIS | Section 1(b) |
|--------------|--------------|

**CORRESPONDENCE SECTION**

|      |                       |
|------|-----------------------|
| NAME | Russell W. Binns, Jr. |
|------|-----------------------|

|           |            |
|-----------|------------|
| FIRM NAME | Avaya Inc. |
|-----------|------------|

|                  |                    |
|------------------|--------------------|
| INTERNAL ADDRESS | 3C818 - Trademarks |
|------------------|--------------------|

|        |                    |
|--------|--------------------|
| STREET | 211 Mount Airy Rd. |
|--------|--------------------|

|      |               |
|------|---------------|
| CITY | Basking Ridge |
|------|---------------|

|       |            |
|-------|------------|
| STATE | New Jersey |
|-------|------------|

|                 |       |
|-----------------|-------|
| ZIP/POSTAL CODE | 07920 |
|-----------------|-------|

|         |               |
|---------|---------------|
| COUNTRY | United States |
|---------|---------------|

|       |              |
|-------|--------------|
| PHONE | 732-852-2120 |
|-------|--------------|

|     |              |
|-----|--------------|
| FAX | 908-953-5408 |
|-----|--------------|

|       |                 |
|-------|-----------------|
| EMAIL | binns@avaya.com |
|-------|-----------------|

|                  |  |
|------------------|--|
| AUTHORIZED EMAIL |  |
|------------------|--|

|                                   |  |
|-----------------------------------|--|
| COMMUNICATION                     | Yes  |
| <b>SIGNATURE SECTION</b>          |  |
| DECLARATION SIGNATURE             | /russell binns/  |
| SIGNATORY'S NAME                  | Russell W. Binns, Jr.  |
| SIGNATORY'S POSITION              | Corporate Counsel - IP   |
| DATE SIGNED                       | 11/11/2008   |
| RESPONSE SIGNATURE                | /russell binns/  |
| SIGNATORY'S NAME                  | Russell W. Binns, Jr.  |
| SIGNATORY'S POSITION              | Corporate Counsel - IP   |
| DATE SIGNED                       | 11/11/2008   |
| AUTHORIZED SIGNATORY              | YES  |
| CONCURRENT APPEAL NOTICE FILED    | YES  |
| <b>FILING INFORMATION SECTION</b> |  |
| SUBMIT DATE                       | Tue Nov 11 15:21:50 EST 2008   |
| TEAS STAMP                        | USPTO/RFR-198.152.12.67-2<br>0081111152150024319-77234<br>926-43049577cc6ec6cab9db3<br>57b05e7755186f-N/A-N/A-20<br>081111144922334116 |

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

### Request for Reconsideration after Final Action

**To the Commissioner for Trademarks:**

Application serial no. **77234926** has been amended as follows:

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

In response to the official action dated May 12, 2008, Applicant submits the following amendment, remarks and request for reconsideration.

Please amend the recitation of services to read as follows:

“On-line unified communications aptitude test for providing on-line advertising and marketing information on a selection of unified communications products and services” in International Class 35.

### REMARKS

Registration for Applicant’s mark UCAN for use with its services has been refused under Section 2(d) of the Trademark Act based on Registration No. 2,871,363. Applicant respectfully traverses this refusal and requests reconsideration.

Applicant has amended the description of services to clarify and make more specific the testing that is being offered under the UCAN mark. The description now specifically identifies that the on-line test is a unified communications aptitude test for providing on-line advertising of unified communications products and services based on the unified communications needs assessed from the test. This is to clarify that Applicant is not offering “testing services” or educational services as indicated by the Examining Attorney, but a specific unified communications test to provide advertising and marketing information.

The cited registration is for the mark UCAN for “educational services in the nature of test preparation courses; tutoring services for high school students; educational services, namely conducting workshops in the areas of leadership and of training others for student counseling, and to provide tutoring and testing services” in class 41. In contrast, Applicant’s mark is for a unified communications test to assess the unified communications needs of the test taker and provide advertising and marketing information on a selection of unified communications products and services to meet those needs. Applicant is not using the mark to indicate any testing services, educational services, or tutoring services.

Applicant’s service is offered as a test to help sophisticated enterprise purchasers determine their level of use of unified communications, and to target specific advertising of unified communications products and services to help the enterprise purchaser improve their unified communications capabilities. Applicant’s test is a free service offered on its own website and provides advertising information on unified communications products sold by Applicant. Purchasers that would use Applicant’s UCAN test would be taking the test to determine what products and services Applicant can

provide to them in the unified communications space. As Applicant's products are only sold to enterprises and Applicant's UCAN service is offered only on Applicant's website, the users of Applicant's service would not and could not be confused with the cited mark that is being used for selling educational and tutoring services directed to students to help them improve educationally and get into college. Applicant's mark is used for a free service to provide advertising literature on Applicant's products, and Registrant's mark is used to sell educational and tutoring services. Applicant submits that the differences in the respective services and trade channels are such as to preclude any reasonable likelihood of confusion.

Applicants' goods and services and the services associated with the cited mark have different markets (namely, enterprises versus individuals), different channels of trade (namely, Applicant's own website for enterprise communication products versus Registrant's ucanprep.com website), different sophisticated consumers (namely, enterprise consumers versus students), and different uses of their respective marks on different services (namely, free testing to determine unified communications needs versus selling educational and tutoring services). Applicant submits that these differences between the Registrant's services and the Applicant's services, preclude any reasonable likelihood of confusion between the cited registration and the present application.

In view of the above amendment and remarks, Applicant submits that the mark UCAN is suitable for registration on the Principal Register in International Class 35. Favorable action is therefore respectfully requested. The Examining Attorney is invited to telephone the undersigned attorney with any matters that would expedite prosecution of this application.

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

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

**Current:** Class 035 for On-line testing to determine professional competency in unified communications

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:** Class 035 for On-line unified communications aptitude test for providing on-line advertising and marketing information on a selection of unified communications products and services

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified

goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

#### **CORRESPONDENCE ADDRESS CHANGE**

Applicant proposes to amend the following:

**Current:** KENNETH CHAN AVAYA INC. 211 MOUNT AIRY RD RM 3C531 BASKING RIDGE, NJ 07920-2311

**Proposed:** Russell W. Binns, Jr. of Avaya Inc., having an address of 3C818 - Trademarks 211 Mount Airy Rd. Basking Ridge, New Jersey United States 07920, whose e-mail address is binns@avaya.com, whose phone number is 732-852-2120 and whose fax number is 908-953-5408.

#### **SIGNATURE(S)**

##### **Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /russell binns/ Date: 11/11/2008

Signatory's Name: Russell W. Binns, Jr.

Signatory's Position: Corporate Counsel - IP

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

Signature: /russell binns/ Date: 11/11/2008

Signatory's Name: Russell W. Binns, Jr.

Signatory's Position: Corporate Counsel - IP

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.

Mailing Address: Russell W. Binns, Jr.  
Avaya Inc.  
3C818 - Trademarks  
211 Mount Airy Rd.  
Basking Ridge, New Jersey 07920

Serial Number: 77234926  
Internet Transmission Date: Tue Nov 11 15:21:50 EST 2008  
TEAS Stamp: USPTO/RFR-198.152.12.67-2008111115215002  
4319-77234926-43049577cc6ec6cab9db357b05  
e7755186f-N/A-N/A-20081111144922334116