From: Dawe, Bill

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Subject: U.S. TRADEMARK APPLICATION NO. 85163836 - BC CONNECT - 7204-85729-0 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 27

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Files: c3-1.jpg, c3-2.jpg, c1-1.jpg, 85163836.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85163836

MARK: BC CONNECT

CORRESPONDENT ADDRESS:

LISA M CALDWELL

KLARQUIST SPARKMAN LLP

121 SW SALMON ST STE 1600 ONE WORLD TRAD

E CENTER

PORTLAND, OR 97204-2988

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

APPLICANT: Boise Cascade Wood Products, L.L.C.

CORRESPONDENT'S REFERENCE/DOCKET NO:

7204-85729-0

CORRESPONDENT E-MAIL ADDRESS:

ptotmdocket@klarquist.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/11/2013

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated December 12, 2012 are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

In the office action of December 10, 2012, the examining attorney made final the requirement to disclaim the descriptive term CONNECT. The good and services associated with the application herein are Computer software to aid in designing, estimating, sales, preparing material processing systems, purchasing and inventory management of building materials, wood and wood products, in Class 9, Providing an Internet website portal featuring information databases in the field of estimating contracting work; providing an Internet website portal featuring information in the field of inventory management of engineered wood products, business and inventory management, in Class 35 and Providing an Internet website portal featuring information databases in the field of designing engineered wood I-joists, laminated veneer lumber, glue-laminated beams, and structural framing products; software as a service (SAAS) featuring software in the field of designing for use aiding in the design of structural framing member cross sections and placement plans for residential and commercial building construction; providing temporary use of non-downloadable software for customer support resource management, distribution of digital media, and business analytics used in the sale, design, and marketing of engineered wood products, in Class 42.

The term CONNECT is defined as "The line of communication between your computer (or any other device) and the Internet." *See* Netlingo definition set forth below; "To establish a communication with a device or serive." *See* Free Dictinary.com; "To join to or by means of a communications circuit." *See* Yahoo Education; "To join by means of communications equipment." *See* Vocabuluary.com.

As used by applicant, the term CONNECT is descriptive of services, namely website portal, non-downloadable software and SAAS services featuring software services which are delivered via the Internet. *See* attached Google articles which reflect the descriptive nature of the term CONNECT/CONNECTION in relationship to website portal services. Moreover, the examining attorney has enclosed U.S. Registrations in which the term CONNECT has been disclaimed for services which include website portal, non-downloadable software and SAAS services featuring software services, This is evidence that the Trademark Office treats the term CONNECT as a descriptive term for said services. Based upon the evidence of record, it is readily apparent that the term CONNECT, in connection with the identified services immediately conveys to consumers that applicant's technology, e.g. website portals, non-downloadable software or SAAS service featuring software services, facilitates communication via a ocm0puter network. (e.g. the Internet).

It is noted that applicant attached to the request for reconsideration numerous third party registrations which have the term Connect associated with the mark. It is noted that many, if not most of these registrations are not for services which are related to the application herein, e.g. website portal, non-downloadable software and SAAS services featuring software services; the term CONNECT is part of a unitary expression or, in the alternative, the term CONNECT is part of a compound term. Under those conditions, it would not be appropriate to disclaim the term CONNECT.

Applicant is reminded that a term is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g.*, *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)). And term 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) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). Put another way, descriptive term does not need to be merely descriptive of all the goods or services specified in an application. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1089 (TTAB 2012).

Accordingly, the requirement to disclaim the term CONNECT is maintained.

PLEASE NOTE: Applicant is encouraged to e-mail the trademark examining attorney to resolve the issue raised above at Bill.Dawe@uspto.gov. Upon receipt of the e-mail accepting the amendments set forth below, the examining attorney will prepare and examiner's amendment, enter the amendments into the databases and approve the application for publication.

/William H. Dawe, III/

Examining Attorney

Law Office 108

(571) 272-9337 voice

(571) 273-9337 fax

Bill.Dawe@USPTO.GOV (not for fomal responses)

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AdChoices

connect

(1) To attach a peripheral device. To establish a communication with a device or service.

(2) (Kinect) The Xbox controller-free interface. See Kinect.

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(library, networking) **connect** - Unix socket library routine to connect a socket that has been created on the local hosts to one at a specified socket address on the remote host.

Unix manual pages: connect(2), accept(2).

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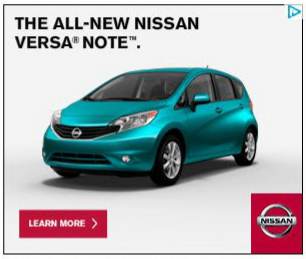

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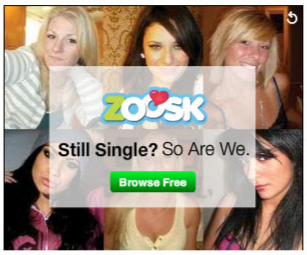

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References in classic literature

Mature as he was, she might yet be able to help him to the building of the rainbow bridge that should **connect** the prose in us with the passion.
Howards End by *Forster, E. M.* **View in context**

One is apt, I believe, to **connect** assurance of manner with coquetry, and to expect that an impudent address will naturally attend an impudent mind; at least I was myself prepared for an improper degree of confidence in Lady Susan; but her countenance is absolutely sweet, and her voice and manner winningly mild.
Lady Susan by *Austen, Jane* **View in context**

By no stretch of fancy can the human mind **connect** together snuff and diamonds and wax and loose clockwork.
The Innocence Of Father Brown by *Chesterton, Gilbert K.* **View in context**

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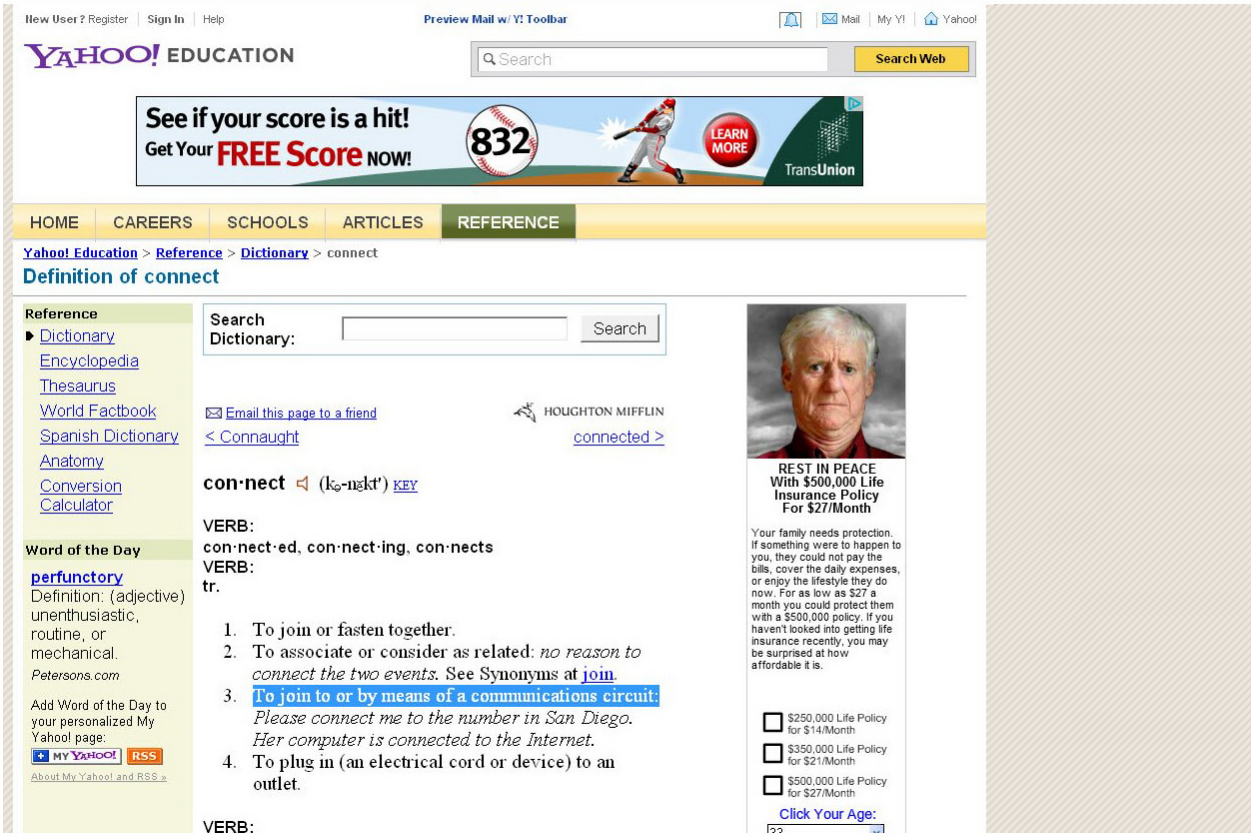

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con·nect (kə-nĕkt') KEY

VERB:
con·nect·ed, con·nect·ing, con·nects
VERB:
tr.

1. To join or fasten together.
2. To associate or consider as related: *no reason to connect the two events.* See Synonyms at join.
3. To join to or by means of a communications circuit: *Please connect me to the number in San Diego. Her computer is connected to the Internet.*
4. To plug in (an electrical cord or device) to an outlet.

VERB:

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