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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TouchStar Software Corporation

Serial No. 78619121

Andrew Roppel of Holland & Hart LLP for TouchStar Software Corporation.

A. D. Saunders, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Walters, Bucher and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

TouchStar Software Corporation (applicant) has filed an application to register DIAL-ON-DEMAND (in standard character form) on the Principal Register for "providing temporary use of non-downloadable software for use in predictive dialing, automatic call distribution, and IVR (Interactive Voice Response) that enables a user to deliver

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voice and/or data communications via telephone and data transmission" in International Class 42.¹

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its services. After the examining attorney made the descriptiveness refusal final, applicant appealed and filed a request for reconsideration. Upon the examining attorney's denial of the request for reconsideration, the Board resumed the appeal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant

¹ Application Serial No. 78619121, filed April 28, 2005, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a

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quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Initially, the examining attorney based her descriptiveness refusal on her discovery of a term of art used in the IT industry in which "dial on demand" refers to routing technology that allows for connecting to the

bona fide intention to use the mark in commerce.

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Internet only when needed. Applicant explained that this is not what they sell or offer and described its services as follows:

Applicant's services provide companies the ability to temporarily utilize a dialer (see attached definition), anytime and from anywhere. This "hosted dialer solution" thus eliminates the need for organizations involved in collections, telemarketing, and political campaigns and the like to invest in the equipment and software necessary to make a lot of phone calls. Moreover, it further allows such organizations the ability to scale up or down depending on their ever-changing business needs.

Request for Reconsideration p. 3 (January 19, 2007).

A "dialer" is described in the excerpted third-party website set forth below from insidesales.com attached to applicant's Request for Reconsideration:

[A] dialer allows a single operator to quickly make a large number of outbound calls. It's ideal for small to medium sized call centers, businesses selling a product or service, or telemarketers. You load the dialer with a phone list and it will automatically place a call to each number at the click of a mouse. Once dialed, you take the call as the number is ringing. If the call is busy or not answered, you can use our system to send fax, voicemail, email, etc while tracking them and your actions.

www.insidesales.com.

Applicant further states that "[b]y purchasing Applicant's services, consumers obtain the result of being able to dial phone numbers as needed (i.e., on-demand)."

Request for Reconsideration p. 3 (January 19, 2007).

Thus, the question of descriptiveness revolves around the more mundane understandings of the word "dial" and the phrase "on demand."²

In the context of applicant's services the following dictionary definitions submitted by the examining attorney are most relevant:

Dial: *verb* 4. To call (a party) on a telephone.

Demand: *idiom* on demand 2. When needed or asked for: *fed the baby on demand.*

The American Heritage Dictionary of the English Language
(3d ed. 1992).

In addition, the examining attorney submitted an excerpt from a website of a company that provides phone systems to call centers where the phrase "dial on demand" is used to describe the attributes of one of the dialer systems offered by the company:

Developed with industry standard components (Dialogic, Intel, and Windows), our phone system has features and functions that can only be found in large scale PBX's, but at a fraction of the cost...Outbound CTI Phone Dialer - Our DSC phone system is also capable of performing outbound calling functions including voice broadcasting, dial on demand, predictive dialing, progressive dialing, and preview dialing - all at the same time.

² While it may be that other companies that offer predictive dialing services may use dial on demand routing technology when connecting with the Internet(see supra pp. 3-4), the record is not clear as to this possibility, nor would it change the result herein.

www.call-center-tech.com.

Both applicant and the examining attorney have submitted third-party registrations in support of their competing positions. Applicant argues that the United States Patent and Trademark Office (USPTO) has registered several marks on the Principal Register that contain the phrase "on demand" without disclaimer or resort to Section 2(f) of the Trademark Act. Approximately twelve of these third party registrations support applicant's position.³ See, e.g., 2995220 for the mark CATALOG-ON-DEMAND on the Principal Register for computer service, namely, acting as an application service provider in the field of computer software and electronic databases used to create custom print or web publications; Reg. No. 2704264 for the mark DESIGN ON DEMAND on the Principal Register for providing temporary use of on-line non-downloadable software for use in creation and revision of brochures, advertising and promotional materials; Reg. No. 2770824 for the mark DEPOSITIONS ON DEMAND on the Principal Register

³ Some of the third-party registrations, e.g., Reg. No. 2974966, are on the Supplemental Register, which undercuts applicant's argument, or the wording is intertwined with a design and could be considered unitary for disclaimer purposes and thus provides no clear statement regarding the phrase "on demand." The third party applications have no probative value other than that they were filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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("DEPOSITIONS" disclaimed) for electronic storage and retrieval of video witness depositions and transcripts via the internet; and Reg. No. 2895295 for the mark CLASS ON DEMAND on the Principal Register ("CLASS" disclaimed) for professional and consumer education classes provided via personal instruction, classroom instruction, computer-based training (CBT) and the Internet.

The examining attorney submitted twelve registrations with marks that include the phrase "on demand" either on the Supplemental Register or with "on demand" disclaimed or registered under Section 2(f) of the Trademark Act. See, e.g., Reg. No. 3074822 for the mark CURRICULUM-ON-DEMAND on the Supplemental Register for educational services, namely, conducting electronic and interactive tutorials, lectures and classes in the fields of history, etc.; Reg. No. 2986583 for the mark CONFERENCE ON DEMAND on the Supplemental Register for domestic and international telecommunications services; Reg. No. 2874022 for the mark PRINT ON DEMAND registered under Section 2(f) of the Principal Register for magazines in the field of printing and publishing; Reg. No. 3000587 for the mark  on the Principal Register (with all wording disclaimed) for computer programs for installing other programs across local and wide area networks; and Reg. No. 2926822 for the

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mark FOOD NETWORK ON DEMAND registered on the Principal Register (with NETWORK ON DEMAND disclaimed) for entertainment services, namely, the production of live and on-demand television programming.

Third-party registrations may be helpful in showing that a term has a descriptive meaning in a particular field. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269, 70 (CCPA 1973). This is typically useful in the context of a likelihood of confusion analysis. With regard to a descriptiveness refusal, third-party registrations are not conclusive as to the question of descriptiveness and each case must be analyzed based on the facts pertinent to that case. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). We first note, that the third-party registrations are not for services similar to applicant's hosted predictive dialing services. The closest services may be the online computer services which are registered both with ON DEMAND on the Principal Register not disclaimed (Reg. No. 2707264) and with ON DEMAND on the Principal Register disclaimed (3000587). In view of the apparently conflicting nature of the treatment of the phrase ON DEMAND and the minimal probative value third-party registrations carry in these circumstances, we do not

accord them significant weight. However, we do note that it appears that the more recent registrations treat ON DEMAND as descriptive.

Applicant initially argued that:

Applicant's use of DIAL-ON-DEMAND does not describe, with any degree of specificity, what the service is (ASP software), how it works (via online access over the Internet), what it is used for (predictive dialing and automated call distribution), or its characteristics or features (broadcast voice messaging, graphical reports w/real-time statistics, quick-and-simple access to software upgrades, level 1 security w/privilege-based assignments, and 24/7 technical support)... Because ... DIAL is commonly understood to refer to a myriad of instruments or tools ... and "ON DEMAND" refers to "when needed or asked for," even if a consumer were to intuit that Applicant's DIAL-ON-DEMAND services related to a subject related to "dialing," consumers would be required to make a "mental leap" to make the connection to ASP software with application as a hosted dialer solution for automated call distribution. The DIAL-ON-DEMAND mark could just as easily suggest a television remote control, or a radio remote control...

Applicant's Response pp. 6-7 (May 30, 2006).

However, as noted above, we determine the descriptiveness of a term in the context of the goods or services at issue, not in the abstract. In re Chopper Industries, 222 USPQ 258 (TTAB 1984); In re Bright-Crest, Ltd., supra.

In its brief, applicant states that "on demand" means "as needed" and argues that:

...the wording 'DIAL-ON-DEMAND' suggests the desired end result of Applicant's services. Applicant's software allows consumers to have access to the capabilities of a traditional call center anytime and from anywhere. This hosted solution gives companies in the call center industry the ability to ramp their operations up or down, depending on workload, and it allows for easier entry into the marketplace because it omits the need for an initial investment into the telephone lines and related equipment that have been traditionally required in operating a call center.

Br. pp. 2-3.

Thus, a key feature of applicant's services is that they are provided "on demand." Further, "Dial" is descriptive of applicant's services inasmuch as it indicates a significant feature of the services, i.e., dialing. Clearly, these terms separately have a descriptive significance in relation to applicant's services. The question remains whether combined they present a unique or incongruous combination. We find that when combined these terms do not lose their descriptive significance and, in fact, make clear that applicant intends to provide dialing services as needed or "on demand." Thus, we are persuaded by the evidence of record that the words DIAL and ON DEMAND are merely descriptive of applicant's recited services and that when combined do not present a unique or incongruous meaning. In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002).

The fact that a term may have meanings other than the one relevant to the services in issue here is not controlling; it is enough that a purpose or feature of applicant's services is included within the meaning of the term. See *In re Bright-Crest, Ltd*, supra at 593.

We are not persuaded by applicant's argument that this phrase suggests the desired end result. In the cases cited by applicant the terms at issue clearly referred to the desired end results. For example, in *In re Pennwalt Corporation*, 173 USPQ2d 317 (TTAB 1972) the anti-perspirant deodorant for feet gave the user a DRI-FOOT and in *In re The Realistic Company*, 169 USPQ 610 (CCPA 1971) the permanent wave curling solution left the user with CURV in her hair. Here, the proposed mark describes the services that dial phone numbers as needed or on demand by the user.

Viewing DIAL-ON-DEMAND as a whole, we find the evidence of record sets forth a prima facie case that it is descriptive. Thus, we are persuaded that when applied to applicant's services, DIAL-ON-DEMAND immediately describes, without need for conjecture or speculation, a significant feature or function of applicant's services, namely the dialing of phone numbers on demand. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective

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consumers of applicant's services to perceive readily the merely descriptive significance of DIAL-ON-DEMAND as it pertains to applicant's services.

Decision: The refusal to register is affirmed under Section 2(e)(1).