

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Application: "CONNECTED OFFICE UC"	Owner: Windstream Services, LLC
Application No. 88339732	Examiner: Robert Guliano
Filed: March 14, 2019	

RESPONSE TO OFFICE ACTION

Applicant, Windstream Services, LLC, hereby responds to the Office Action of April 9, 2019. The Examiner has refused registration under Section 2(d) of the Trademark Act on the basis that Applicant's mark, "CONNECTED OFFICE UC," when used on or in connection with the services identified in the application, is likely to cause confusion with the mark "OFFICE CONNECT," U.S. Registration No. 4515591. "OFFICE" is the only word that appears in both marks, and it is situated between of "CONNECTED" and "UC" in Applicant's mark, while it is front and center in Registrant's mark. And according to the Examiner, this term is allegedly descriptive, which means that it should receive limited trademark protection. "CONNECTED" is the first word in Applicant's mark and does not appear in Registrant's mark.

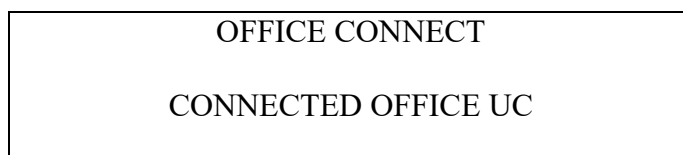
In view of these differences in the marks, no likelihood of confusion exists between Applicant's and Registrant's marks. Additionally, there should be limited trademark protection for "OFFICE CONNECT" because it is so widely used in the marketplace.

A. INTRODUCTION

Trademark rights extend only as far as necessary to avoid consumer confusion. When determining whether likelihood of confusion exists between two marks, the courts have identified a number of factors to consider, including (1) purchasing conditions and buyers to whom sales are

made (impulse vs. careful, sophisticated purchasing), (2) comparison of the services/trade channels, (3) comparison of the goods or services, (4) comparison of the marks, and other factors. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The Examiner’s analysis fails to evaluate one of these significant factors (i.e., purchasing conditions and buyers to whom sales are made). Applicant submits that a proper balancing of the relevant factors listed above leads to a finding of no likelihood of confusion.

B. THE TWO MARKS CREATE A DRASTICALLY DIFFERENT IMPRESSION



The marks must be compared in their entireties. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); TMEP §1207.01(b). “OFFICE” is the only common word between these marks, and therefore, this word appears to be the anchor of the examiner’s rejection. However, the Examiner also argues that “OFFICE” is descriptive of the identified services, which means that this is a weak anchor.

Applicant’s mark starts with the word “CONNECTED,” while Registrant’s mark starts with the allegedly descriptive term, “OFFICE.” The term “CONNECT” is used as a verb in Registrant’s mark, while the term “CONNECTED” is used as an adjective in Applicant’s mark. The distinct use of “CONNECTED” conveys a completely different meaning to consumers.

The term “UC” is absent from Registrant’s mark. Aside from the Examiner’s suggestion that this term is descriptive, the Office Action fails to discuss this term, but this term cannot be ignored, even if it is allegedly descriptive. “Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different

commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004) (ruling that “THE RITZ KIDS” creates a different commercial impression than “RITZ”).

These differences establish that there is no likelihood of confusion. Applicant’s mark begins with the term “CONNECTED,” and its use in the first word position creates a greater significance for this word by acting to capture the consumer’s focus. Consumers are more inclined to focus on the first word, prefix, or syllable in any trademark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). In contrast, Registrant’s mark starts off with the allegedly descriptive term “OFFICE.” These two marks clearly convey a distinct initial impression on consumers.

Further, the term “CONNECTED” is an adjective that modifies “OFFICE” and seeks to convey the impression that traditional office services are already connected. This is consistent with Applicant’s services that focus on the connection of VoIP, web conferencing services, online meeting services, e-mail services, voicemail services, and fax services. Accordingly, all the traditional office services can be integrated by Applicant. The second term “CONNECT” in Registrant’s mark is used as a verb to describe what could be possible. The mobile communications services and fixed-line telecommunications identified by Registrant are not traditionally integrated in an office setting, so Registrant’s mark conveys the impression that these services may be combined in an unanticipated integration. Applicant’s use of “CONNECTED” creates a distinct overall commercial impression when compared to Registrant’s use of “CONNECT.”

The cases cited by the Examiner are distinguishable because they stand for the proposition that phrases cannot be added within the same word to avoid likelihood of confusion (COMMCASH vs. COMMUNICASH, CONFIRM vs. CONFIRMCELLS, MILTRON vs. MILLTRONICS). Not a single case found likelihood of confusion when two separate and distinct words were transposed. However, the Federal Circuit has ruled that the transposition of words can help to avoid a likelihood of confusion determination. *See Outdoor Kids, Inc. v Parris Mfg. Co.*, 2010 U.S. App. LEXIS 14092, at **4-9 (Fed. Cir. 2010) (finding no likelihood of confusion between the “OUTDOOR KIDS” and “KID’S OUTDOOR” marks). The word combinations here are not only transposed, but the “CONNECTED” term is missing from Registrant’s mark.

The missing term “UC” cannot be ignored, as the marks should be compared in their entireties in appearance, sound, connotation, and commercial impression. *See Stone Lion Capital Partners, LP v Lion Capital LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014). Aside from a disclaimer demand, the Examiner fails to acknowledge or analyze the “UC” term, while relying upon the allegedly descriptive term “OFFICE” as the crux of the rejection. The addition of “UC” in Applicant’s mark and its absence in Registrant’s mark creates a different commercial impression to consumers. Thus, the addition of “UC” further distinguishes Applicant’s mark.

1. Registrant’s Mark is Weak and Should Receive Limited Protection.

The term “OFFICE” is allegedly descriptive, which indicates that the initial term of Registrant’s mark merely describes the services offered. Since consumers are more inclined to focus on the first word, prefix, or syllable in any trademark, the descriptiveness of the first term of highlights the weakness of Registrant’s mark. *See Outdoor Kids, Inc.*, 2010 U.S. App. LEXIS 14092, at **9 (finding no likelihood of confusion in part due to the descriptive nature and weakness of Registrant’s mark).

An Internet search suggests that numerous companies are currently using the “OFFICE CONNECT” mark to market, advertise, and sell similar products and services. *See* Ex. 1, Google Search of “Office Connect.” This evidence further weakens Registrant’s mark.

Company	Use of the Mark
Adaptive Insights	<p>OfficeConnect Datasheet Adaptive Insights https://www.adaptiveinsights.com/node/35941 ▼ Learn more about Adaptive OfficeConnect: software that makes it easy to create high-quality reports, board books, and presentations with Microsoft Word, Excel, ...</p> <p>Videos</p> <p>Adaptive OfficeConnect Overview Adaptive OfficeConnect Using OfficeConnect (25:35) ></p>
AvePoint	<p>✔ Use the Office Connect Add-in https://avepointcdn.azureedge.net/...office-connect/.../Use_the_Office_Connect_Add-i... ▼ After you enable the Office Connect add-in for your Microsoft Office account, you can upload e-mails and attachments to any Office 365 Groups or SharePoint ...</p> <p>✔ Install Office Connect https://avepointcdn.azureedge.net/...office-connect.../Install_Office_Connect.htm ▼ The Office Connect Installation Wizard will guide you through the installation process. In order to complete the installation successfully, a local administrator must ...</p>
3Com	<p>✔ 3Com 3C16700A OfficeConnect 8-Port Ethernet Hub ... - Amazon.com https://www.amazon.com/3Com-3C16700A-OfficeConnect-8-Port-.../B0000304Z0 ▼ ★★★★★ Rating: 4.5 - 4 reviews Product Features Plug and Play installation Requires no configuration Easy-to-read front-panel display includes diagnostic LEDs and network monitoring 10MB ...</p>
Hewlett Packard Enterprise	<p>[PDF] ✔ HPE OfficeConnect 1850 Switch Series - Data sheet - CNET Content ... https://cc.cnetcontent.com/.../E96314E41460B0003BCBF071F95998706AFCA30F_s... ▼ HPE OfficeConnect 1850 Switch Series devices are basic smart managed, fixed configuration Gigabit plus 10 Gigabit. Ethernet Layer 2 switches designed for ...</p>

Far from arbitrary and unique, the “OFFICE CONNECT” mark is used by numerous companies across related industries. The descriptive nature of “OFFICE” and the widespread use of this mark further proves its weakness. *See Outdoor Kids, Inc.*, 2010 U.S. App. LEXIS 14092 at **9. And the limited protection available for this weak mark cannot be used to reject a distinct mark with only an allegedly descriptive word in common (“OFFICE”).

C. TWO ADDITIONAL FACTORS WEIGH IN FAVOR OF APPLICANT

1. Applicant’s and Registrant’s Services are Not the Same.

Registrant’s identification of services focuses on “mobile unified communications services” for integration with “fixed-line telecommunications services.” This offering from T-Mobile is designed to incorporate mobile services with enterprise telecommunications services. Mobile communications are not always generally integrated in an enterprise setting, so this is an unanticipated integration. In contrast, Applicant’s services focus on connecting VoIP, web conferencing, video conferencing, online meeting, e-mail, voicemail, and fax services for enterprise customers. Mobile services are missing from Applicant’s application, and numerous services, including e-mail, conferencing, and fax services are missing from Registrant’s identification of services. These are clearly different services for enterprise customers that are searching for a specific telecommunications solution.

2. Consumers Exercise a High Degree of Care When Selecting These Services.

The high degree of care that Applicant’s and Registrant’s enterprise customers exercise when selecting a telecommunications provider weighs in favor of allowance. These are highly specialized services being offered, where sophisticated purchasing departments generally collect bids and vet numerous companies before selecting the proper provider. Contracts for these types

of telecommunications services can be very expensive. Confusion is unlikely when the contracts are this large and the operation of the business is at stake. Two distinct marks with a common, descriptive word (“OFFICE”) fail to create confusion in this type of environment.

D. CONCLUSION

Applicant submits that the significant differences in the marks establish that there is no likelihood of confusion. The two marks create a different commercial impression to the highly sophisticated consumers that purchase Applicant’s and Registrant’s services. Further, Registrant’s descriptive and weak mark fails to support the expanded trademark protection argued by the Examiner. Thus, Applicant respectfully requests that the refusal to register be withdrawn and that the present application be approved for allowance.

E. DISCLAIMER

Applicant disputes the descriptiveness of “OFFICE” in view of the pending Office Action. The Examiner rejected Applicant’s application in view of the “OFFICE CONNECT” mark that registered without any disclaimers. The Examiner admits that Applicant’s and Registrant’s services “are considered related,” so Applicant shouldn’t have to disclaim the term “OFFICE” for the same reasons that Registrant did not disclaim “OFFICE.” However, if the Examiner determines that there is no likelihood of confusion between Applicant’s and Registrant’s marks, then Applicant may be willing to disclaim the term “OFFICE.”

Applicant agrees to disclaim the term “UC.”

No claim is made to the exclusive right to use “UC” apart from the mark as shown.

Based upon the above amendments and remarks, applicant respectfully contends that the

pending application is now in a condition for allowance. Thus, a Notice of Allowance is requested.

Date: July 24, 2019

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