

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

U.S. APPLICATION SERIAL NO. 88276343

MARK: AMBITO

88276343

CORRESPONDENT ADDRESS:

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APPLICANT: Tabak, Jonathan

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

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OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 4/22/2019

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Section 2(d) Refusal – Likelihood of Confusion

IC 042. US 100 101. G & S: Software as a service (SAAS) services featuring software for sales enablement solution TO BE CORRECTED TO, AND READ: "Software as a service (SAAS) services featuring

software for {process driven inside sales teams}, for sales enablement purposes.”

- Advisory: Prior-Filed Applications **SEE SECTION
- Identification of Services – Amendment Required **SEE SECTION

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4392440. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); *see In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The applied-for mark is **AMBITO** for “*Software as a service (SAAS) services featuring software for sales enablement solution*” in International Class 42. The registered mark is **AMBIT** for “*Computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction*”

processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance” in International Class 9 and for “*Computer services, namely, application service provider featuring computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance; computer software consulting services related to computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance*” in International Class 42.

** Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” ” Ambito is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”.

Similarity of the Marks

**Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

** Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” ” Ambito is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”.

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047,

1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

** In the present case, the compared marks are identical in part because they share a distinctive wording **AMBIT**. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Thus, the compared marks are identical in part.

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Because the compared marks are identical in part, consumers are likely to confuse the marks when encountering them in the marketplace.

Relatedness of the Goods and Services

The goods and services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and the services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

A. Relatedness of the Services in Class 42

**The applicant's services are identified as *"Software as a service (SAAS) services featuring software for sales enablement solution"* in International Class 42. The registrant's services are identified as *"Computer services, namely, application service provider featuring computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance; computer software consulting services related to computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance"* in International Class 42.

**Ambito has no link to "Financial Services Software" or "Banking". Definition change to "Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes." Ambito is pronounced: "AM-BEE-TOH". Website domain registration under ".io".

**Determining likelihood of confusion is based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

**Ambito has no link to "Financial Services Software" or "Banking". Definition change to "Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes." Ambito is pronounced: "AM-BEE-TOH". Website domain registration under ".io".

**In this case, the application uses broad wording to describe *"Software as a service (SAAS) services featuring software for sales enablement solution"*, which presumably encompasses all services of the type described, including registrant's more narrow services, namely, *"Computer services, namely, application service provider featuring computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance"*. See, e.g., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). The attached Internet evidence

from <https://www.highspot.com/sales-enablement/best-sales-enablement-tools-and-software/> (“Using the right *sales enablement software, sales and marketing teams* work together seamlessly to deliver timely, relevant, and on-brand content to prospective buyers. . . . The tools offer solutions that tend to fit into one or more of the following categories: *sales readiness, sales asset management, and sales engagement.*.”); “Notable among the vendors in this market, Enhatch offers *native CPQ (configure, price, quote) and order management functions*, which is relevant to buyers in the consumer goods and *banking sectors.*”), <https://www.capterra.com/sales-enablement-software/> (“Eltropy, SaaS platform improves share of wallet, *client acquisition and productivity of client-facing teams in financial institutions.* . . . Lynx Trading Platform helps you to *manage and control all sales processes of banking, financial and insurance products.* . . . [Paperfin is a] *sales enablement and digital client engagement platform for the financial services industry.*”) shows that sales enablement software is used for managing sales processes and customer relationships, including in banking and financial fields. Thus, applicant’s and registrant’s services are legally identical. See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

**** Ambito has no link to “Financial Services Software” or “Banking”. Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” Ambito is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”.**

**** Further, the attached Internet evidence, consisting of <https://seismic.com/solution/sales-enablement/> (offers sales enablement software and consulting services), <http://www.mindmatrix.net/sales-enablement-platform-for-finance-industry/> (same), and <https://www.predictiveanalyticstoday.com/services/> (<https://www.predictiveanalyticstoday.com/category/reviews/sales-enablement-platform/>; same), establishes that the same entity commonly provides the relevant services and markets the services under the same mark, the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant’s and registrant’s services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).**

**** ** Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” Ambito is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”. “Sales enablement” is**

simply a generic known category that many software companies contribute software to. These tools aid inside sales professionals.

Additionally, the services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant’s and registrant’s services are related.

Based on the analysis above, applicant’s and registrant’s services are commercially related and travel in the same trade channels.

B. Relatedness of the Goods and Services in Classes 9 and 42

The applicant’s services are identified as “***Software as a service (SAAS) services featuring software for sales enablement solution***” in International Class 42. The registrant’s goods are identified as “***Computer software for use by banks and banking institutions for retail and commercial core banking, private banking, transaction processing, customer relationship management, risk management, reporting, regulatory compliance, treasury management and finance***” in International Class 9.

**The attached Internet evidence, consisting of website screenshots from <https://www.lynxbroker.com/software-tools/> (provides software platform and tools, as well as access to a web version of its software), <https://www.eltropy.com/sales/> (same; “Ready to adopt a smarter messaging *platform* to increase client engagement? . . . Our *AI-based software* sends you data on client engagement.”), and <http://www.mindmatrix.net/sales-enablement-platform-for-finance-industry/> (“Our *Sales Enablement Software* helps you provide them with the content to make them independent of your marketing team; while at the same time *promoting a seamless marketing-sales alignment for improving sales effectiveness.*”), establishes that the same entity commonly produces the relevant goods and provides the relevant services and markets the goods and services under the same mark, the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant’s and registrant’s goods and services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

“Sales enablement” is simply a generic known category that many software companies contribute software to. These tools aid inside sales professionals.

Additionally, the goods and services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant’s and registrant’s goods and services are related.

Based on the analysis above, applicant’s and registrant’s goods and services are commercially related and travel in the same trade channels.

Therefore, because the applied-for mark is confusingly similar to the cited registered marks and the goods and services are related and travel within the same channels of trade, the applicant’s mark is refused under Section 2(d) of the Lanham Act on grounds of likelihood of confusion.

Although applicant’s mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

ADVISORY: PRIOR-FILED APPLICATIONS

The filing dates of pending U.S. Application Serial Nos. 88061411 and 88092953 precede applicant’s filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant’s response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant’s mark and the marks in the referenced applications. Applicant’s election not to submit arguments at this time in no way limits applicant’s right to address this issue later if a refusal under Section 2(d) issues.

** Am I competing with my other filing “A-Ambito”? ** ** Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” “Ambito” is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”. “Sales enablement” is simply a generic known category that many software companies contribute software to. These tools aid inside sales professionals. “Ambito,” “Ambito.io” is not in any direct or similar competition under specified name.

IDENTIFICATION OF SERVICES – AMENDMENT REQUIRED

** The wording “*software for sales enablement solution sales enablement solution*” in the identification of services is indefinite and must be clarified because it does not make clear what the function of the software is. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The USPTO has the discretion to determine the degree of particularity needed to clearly identify services covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, 109 USPQ2d 1593, 1597 (TTAB 2014) (citing *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of services in a U.S. application to be specific, definite, clear, accurate, and concise. TMEP §1402.01; *see In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A.*, 109 USPQ2d at 1597-98; *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm’r Pats. 1954).

Applicant may substitute the following wording, if accurate (the examining attorney’s suggestions appear in **bold** font):

Class 42: Software as a service (SAAS) services featuring software **for {specify the function of the software, e.g., a repository of marketing content to be used by sales representatives for sales performance management, email tracking, outbound call tracking, etc.}** for sale enablement purposes

Applicant’s services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different services or add services not found or encompassed by those in the original application or as acceptably

amended. *See* TMEP §1402.06(a)-(b). The scope of the services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the services will further limit scope, and once services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

** Definition change to “Software as a service (SAAS) services featuring software for {process driven inside sales teams}, for sales enablement purposes.” “Ambito” is pronounced: “AM-BEE-TOH”. Website domain registration under “.io”. “Sales enablement” is simply a generic known category that many software companies contribute software to. These tools aid inside sales professionals. “Ambito,” “Ambito.io” is not in any direct or similar competition under specified name.

For assistance with identifying and classifying services in trademark applications, please see the USPTO’s online searchable [*U.S. Acceptable Identification of Goods and Services Manual*](#). *See* TMEP §1402.04.