

To: EPS Settlements Group, Inc. (kkalan@bw-legal.com)
Subject: TRADEMARK APPLICATION NO. 77609719 - THE STRUCTURED
SETTL - N/A
Sent: 2/9/2009 1:16:28 PM
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Attachments: [Attachment - 1](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/609719

MARK: THE STRUCTURED SETTL

77609719

CORRESPONDENT ADDRESS:

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RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: EPS Settlements Group,
Inc.

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

N/A

CORRESPONDENT E-MAIL ADDRESS:

kkalan@bw-legal.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 2/9/2009

Serial Number: 77/609719 – THE STRUCTURED SETTLEMENTS COMPANY

The assigned examining attorney has reviewed the referenced application and determined the following.

SEARCH OF OFFICE RECORDS

The Office records have been searched and there are no similar registered or pending marks that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

DESCRIPTIVENESS REFUSAL

Registration is refused because the applied-for mark merely immediately describes the nature of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

In addition to being merely descriptive, the applied-for mark appears to be generic in connection with the identified services and, therefore, incapable of functioning as a source-identifier for applicant's services. *In re The Am. Acad. of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001); *see* TMEP §§1209.01(c) *et seq.*, 1209.02. Under these circumstances, neither an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register can be recommended. *See* TMEP §1209.01(c).

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"A mark 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). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

Applicant has applied to register the mark THE STRUCTURED SETTLEMENT COMPANY in standard character form for use in connection with "structured settlement services, namely, designing

and brokering settlements of legal claims; providing financial management and consulting to insurance companies and self-insured entities regarding the settlement of tort actions.”

A mark that combines descriptive words may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968) (holding SUGAR & SPICE not merely descriptive of bakery products because of the mark’s immediate association with the nursery rhyme “sugar and spice and everything nice”). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *See, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive for theater ticket sales services).

The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark created imparts an incongruous meaning as used in connection with the goods and/or services. TMEP §1209.03(d); *e.g., In re Copytele, Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *In re Associated Theatre Clubs*, 9 USPQ2d at 1662. Where, as in this case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the mark is merely descriptive.

The identification of services itself indicates that applicant provides structured settlement services. Attached to this Office action is an excerpt retrieved from applicant’s website which indicates that applicant is “a company that symbolizes innovation, longevity, service, and premier leadership in the structured settlement industry.” The term COMPANY merely identified applicant’s entity type and has no source identifying significance.

Based upon this evidence and the legal standards as set forth above, the examining attorney concludes that the proposed mark THE STRUCTURED SETTLEMENTS COMPANY is merely descriptive of the applicant’s services. It appears that applicant is a structured settlement company. Accordingly, the mark is refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act.

If applicant is *not* a structured settlement company and the idea conveyed by the mark is false but plausible, then the mark is deceptively misdescriptive and also unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informality.

INFORMALITY

Informational - Claimed Prior Registration

Applicant’s claim of ownership of U.S. Registration No. 1519185 will not be printed on any registration that may issue from this application because the marks are different. Only prior registrations for the same or similar marks are considered related registrations for purposes of an ownership claim. 37 C.F.R. §2.36; TMEP §812.

TELEPHONE FOR ASSISTANCE

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Alicia P. Collins/
Trademark Examining Attorney
U.S. Patent and Trademark Office
Law Office 115
(571) 272-9147
(571) 273-9147 (fax)

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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EPS Settlements Group, Inc. is Nationwide

EPS Settlements Group is a company that symbolizes innovation, longevity, service, and premier leadership in the structured settlement industry. As early pioneers in the industry, we are proud to have helped thousands of individuals to receive a structured settlement – providing a future stream of periodic payments to address their essential needs.

Our 160 professionals located nationwide are highly trained and creative with expertise in many practice areas, access to all available annuity providers and the support of the best systems and technology in the industry. EPS Settlement Consultants are the...People You Need For Results You Want.™

EPS Opens Office in Kennebunkport, Maine

EPS Settlements Group, Inc. is proud to announce the hire of Frederick "Doug" Friedman as a new Structured Settlement Consultant effective January 22, 2009.

IFS Obtains Favorable Ruling on Resolving Taxable Claims with Periodic Payments

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Subject: TRADEMARK APPLICATION NO. 77609719 - THE STRUCTURED
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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 2/9/2009 FOR
APPLICATION SERIAL NO. 77609719

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
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the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **2/9/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in**

the ABANDONMENT of your application.