

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 74/716462

APPLICANT: USF&G CORP.

MAY 24 2004

CORRESPONDENT ADDRESS:

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MARK: VISIONPAK

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Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Examining Attorney's name and Law Office number.
3. Your telephone number and e-mail address.

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	USF&G CORP.	:	BEFORE THE
Trademark:	VISIONPAK	:	TRADEMARK TRIAL
Serial No:	74/716462	:	AND
Attorney:	Robin Ramswick Fuller	:	APPEAL BOARD
Address:	The St. Paul Companies, Inc. MC515A 385 Washington Street St. Paul MN 55102	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

This concerns appeal of a refusal under Section 2(d) made Final in 1996. As the applicant filed many actions, including a number of requests for reconsideration and suspension of action on this

appeal and a petition to cancel the cited registration, the examining attorney provides the following description of the proceedings.

STATEMENT OF PROCEEDINGS

The application was filed August 16, 1995 for the proposed mark VISION-PAK for services identified as “insurance underwriting services.” The application was based on Section 1(b) and no allegation of use has been filed.

In the first Office action mailed February 6, 1996, the examining attorney refused registration of VISION-PAK under Section 2(d) on the basis of likelihood of confusion with Reg. Nos. 1335908 VISION for use with “underwriting insurance services” and 1726230 VISION 2000 for “life insurance underwriting services,” both owned by the same entity; required amendment to the recitation of services; and required applicant to provide information and materials. In its response filed September 4, 1996, the applicant argued against likelihood of confusion based primarily on a list of 8 registrations that included VISION as a component as arguably showing VISION is a weak component, amended the recitation of services to “insurance underwriting services in the fields of property and casualty,” responded to the examining attorney’s questions, and submitted promotional materials about applicant’s services.

In the Final Office action mailed November 5, 1996, the examining attorney accepted the applicant’s amendment to the recitation of services, information and materials about the services, withdrew refusal on the basis of Reg. No. 1726230, and made Final the refusal under Section 2(d) for the proposed mark VISION-PAK on the basis of Reg. 1335908. Evidence attached to the Final action included Webster’s II New Riverside University Dictionary for the “package;” copies from X-search of 13 applications and registrations owned by this applicant that show applicant itself obtained registrations for use with the broadly identified “insurance underwriting services” (the same services identified in the cited registration), life, and property and/or casualty insurance

services under the same and/or similar marks; copies from X-search of 28 third parties' registrations for marks that include PAK and its functional variants, demonstrating that PAK and its functional variants would be regarded as weak and in frequent use in the insurance industry; copies from the specimen brochure for registrant's companion Reg. 1726230 for VISION 2000; copies from X-search of approximately 40 third party registrations showing registration for the same and/or similar mark for services identified in this application and in the cited registration.

On May 5, 1997, the applicant filed a Notice of Appeal and Request for Reconsideration, argued against the refusal, arguing on the one hand that VISION is a weak component as shown by submission of 14 registrations for goods and services in Classes 16, 36, 41, and 42, and 7 applications for goods and services in Classes 9, 35, 36, 41 and 42, that include VISION as a component, but arguing on the other hand that PAK is not a weak component, stating incorrectly that the examining attorney relied "on a mere three registrations," when in fact the examining attorney had attached 28 third parties' registrations that include PAK and its variants showing PAK to be a frequent and weak component in the insurance field. In an order from the Board mailed May 29, 1997, Judge Cissel instituted the appeal and suspended action thereon, granted the reconsideration request, and remanded the file. The examining attorney denied the request for reconsideration, and continued the Final action refusing registration of VISION-PAK for "insurance underwriting services in the field of property and casualty. In this action, the examining attorney distinguished the VISION registrations submitted by applicant (4 were for use with vision and eye care insurance services, 2 were for use with limited, highly specialized services - funeral and burial insurance and insurance and administration for auto repair (by then cancelled)), and one (Reg. 1924071 now cancelled) for use with a list of financial services, insurance underwriting services being the last) and noted that opposition proceedings had commenced against all but 2 of the pending VISION applications identified by applicant. The examining attorney attached

additional evidence supporting the refusal, including, a search strategy showing the dearth of registrations (a mere 6, see line 17) that included VISION as a component for use in connection with Class 36 insurance underwriting and administration services not for eye care or vision insurance services, contrasted with 1106 hits for registrations for PAK and its variants for Class 36 services (see line 7); copies from X-search of 23 registrations for PAK and its variants limited to Class 36 insurance underwriting and administration services; and definitions for “package insurance” and “package policy” from Dictionary of Insurance Terms.

In an order from the Board mailed January 12, 1998, Judge Simms resumed the appeal and allowed applicant 60 days to file its brief.

On March 13, 1998, the applicant requested suspension of the appeal, two amendments, and a second request for reconsideration. The applicant requested amendment of the recitation of services to “insurance underwriting services for emerging technology companies in the field of property and casualty,” requested amendment of the mark from VISION-PAK to VISIONPAK, and argued against the refusal under Section 2(d), contending again that VISION is weak – notwithstanding the above-noted evidence of only 6 registrations for non-eye care insurance services that include VISION, but that PAK is not weak – notwithstanding the above-noted 1106 hits of registrations in Class 36 in the search strategy and 28 ‘PAK’ registrations, because PAK had not been disclaimed.

In an order from the Board mailed April 28, 1998, Judge Seeherman granted remand, suspended action on the appeal, and remanded the file to the examining attorney. The examining attorney accepted the amendments of the recitation of services and mark, denied the request for reconsideration, continued the Final action, attached evidence supporting the refusal -including copies from X-search of 3 newly issued registrations for PLATINUM PAK (PAK disclaimed), GLOBAL SECURITY PACKAGE (SECURITY PACKAGE disclaimed), and POLLUSTION

PROTECTION PACKAGE (permitted on the Supplemental Register) for Class 36 insurance and underwriting services; copies from TRAM showing abandonment of the previously-noted applications having VISION as a component against which oppositions had been filed (VISION, ALEXIS-VISION, VISON HEALTHCARE RESOURCES, and INVISION).

In an order from the Board mailed August 14, 1998, Judge Seeherman resumed action on the appeal and allowed applicant 60 days to file its brief. On October 7, 1998, applicant filed a Notice of Appeal and stated that applicant was in negotiations with the owner of the cited registration and if the parties concurred in a consent, the appeal would be moot. Applicant did not file its brief by October 14, 1998.

On November 6, 1998, applicant filed a Request for Leave to File Appeal Brief Out Of Time based on a docketing error, the mistaken duplicative Notice of Appeal and statement therein that applicant was in negotiations with owner of the cited registration, that delay would not prejudice any third party's interests, and that a negotiated consent would moot the appeal. The applicant's brief was filed November 6, 1998.

On November 13, 1998, the applicant filed its third request for suspension of the appeal, indicating therein that applicant filed on November 8, 1998, a Petition for Cancellation of the cited registration, seeking partial cancellation of the registration or in the alternative, modification of the services in the cited registration, to eliminate the basis for refusal.

In an order from the Board mailed January 21, 1999, Judge Seeherman granted applicant's request to file its brief out of time, granted the request for suspension of action on the appeal in view of the Petition to Cancel, and stated "Applicant should advise the Board when there has been a final disposition of Cancellation No. 28,265."

Office TTABVUE records, a copy of which is attached hereto for convenience of the Board and applicant, indicate that applicant's Petition to Cancel cited Reg. 1335908 was dismissed with

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