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Request for Reconsideration after Final Action

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ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

Attention: Box Response - No Fee

Commissioner for Trademarks

P.O. Box 1451

Alexandria, Virginia 22313-1451

Dear Trademark Commissioner:

This responds to the Final Office Action issued September 15, 2011. ***Applicant respectfully realleges and incorporates its arguments from August 24, 2011.***

I. 2(d) Refusal

The Office has continued its refusal to register Applicant's PROTECTIVE RE mark on the grounds of a likelihood of confusion with prior U.S. Registration Nos. 3217560, 3270260, 3042849, 2979731, 2974318, 3759199, 3755646, 3313300, 2776227, 2279368, 2522963, 2011673, 0694701, and 2922248.

Protective Life Corporation ("PLC Registrant") is the owner of the following registrations, cited

against Applicant's mark:

1. **Registration No. 3217560**, PROTECTIVE, "Providing and administering discount consumer membership programs to enable participants to obtain discounts, savings and rebates on healthcare services and products," in Class 35, and "Insurance and financial services, namely, life insurance underwriting and administration services, annuities, guaranteed investment contracts, and mortgage securitization; providing limited warranties and extended service contracts for vehicles; providing information in the field of insurance over a global communications network," in Class 36;

2. **Registration No. 3270260**, PROTECTIVE MULTITERM, for "Financial services, namely, underwriting life insurance," in Class 36;

3. **Registration No. 3042849**, PROTECTIVEACCESS, **Registration No. 2979731**, PROTECTIVEREWARDS, and **Registration No. 2974318**, PROTECTIVEVALUES for "life insurance underwriting, namely, variable annuities," in Class 36;

4. **Registration No. 3313300**, PROTECTIVE HERITAGEGUARD SPWL, for "life insurance underwriting services, namely, single premium whole life policies," in Class 36;

5. **Registration No. 2776227**, PROTECTIVE PREMIERE PROVIDER, for " Life insurance services, namely the underwriting of variable life insurance products," in Class 36;

6. **Registration No. 2279368**, YOU CAN DEPEND ON PROTECTIVE, for "life insurance underwriting services," in Class 36;

7. **Registration No. 2522963**, FIRST PROTECTIVE & design, for "Life, health, dental, cancer, credit and disability insurance underwriting services; underwriting annuity and guaranteed investment contracts," in Class 36, and;

8. **Registration No. 0694701**, PROTECTIVE LIFE, for "underwriting life, health, and accident insurance and annuities," in Class 36.

The Medical Protective Company ("MPC Registrant") is the owner of the following registrations, cited against Applicant's mark:

1. **Registration No. 3759199**, ATTORNEY PROTECTIVE AAA PROTECTION FOR THE NATION'S ADVOCATES, for "Insurance services, namely, underwriting, issuing and administration of professional liability insurance," in Class 36;

2. **Registration No. 3755646**, ATTORNEY PROTECTIVE, for "Insurance services, namely, underwriting, issuing and administration of professional liability insurance," in Class 36, and;

3. **Registration No. 2011673**, THE MEDICAL PROTECTIVE COMPANY, for "underwriting insurance in the fields of general liability and professional liability, including medical malpractice; and insurance claims processing and claims administration services."

Finally, Protection Reinsurance Intermediaries AG ("PRI Registrant") is the owner of Registration No. 2922248, PROTECTION RE & design, for "reinsurance and insurance consulting services; reinsurance administration," in Class 36.

Applicant respectfully requests reconsideration of this objection in light of the submissions and reasons set forth in this Response. As discussed in detail below, and in Applicant's response of August 24, 2011, Applicant respectfully disagrees that any confusion is likely between the respective marks because: 1) the highly educated and sophisticated nature of the relevant purchasers weighs against a finding of a likelihood of confusion; 2) there is no evidence of actual confusion over a significant period of concurrent use, and; 3) the Office has not met its burden of proof.

As such, Applicant respectfully requests that the Office's objection to registration be withdrawn and the application be allowed to publish.

A. **The Highly Educated and Sophisticated Nature of the Relevant Purchasers Weighs Against a Finding of a Likelihood of Confusion.**

If the consumer of a particular good or service tends to be sophisticated, or if the consumer is inclined to think carefully before purchasing a product or service, this may be sufficient to dispel any confusion, even between similar marks. *See, e.g., In re Software Design, Inc.*, 220 U.S.P.Q. 662 (T.T.A.B. 1983). In the case at hand, the nature of Applicant's respective services almost assures that their customers would put a great deal of thought into a purchase, and would therefore be sophisticated purchasers.

The Examining Attorney, in the Final Office Action issued September 15, 2011, stated that " When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser." *See Alfacell Corp. v. Anticancer, Inc.*, 71 U.S.P.Q.2d 1301, 1306 (T.T.A.B. 2004). However, TMEP Section 1207.01(d)(vii) *also states* that "circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion." *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (concluding

that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). Furthermore, courts have found that "there is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *See Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. (BNA) 786, 790 (1st Cir. 1983).

The general public seeking insurance coverage is not the purchaser of Applicant's insurance, and purchasers will be exercising great care when purchasing reinsurance services. Reinsurance is a contract under which a company, the reinsurer, agrees to indemnify an insurance company, the ceding company, against all or part of the primary insurance risks underwritten by the ceding company under one or more insurance contracts. "Reinsurance is a very specific sector in the sphere of insurance. ***A complex business,*** it allows insurers to cover their risks by ceding them to a reinsurer. In this context, the reinsurer is obliged to indemnify the 'ceding company' in the event of a claim." (*See* Exhibit A: Printout of Scor.com webpage explaining reinsurance services) (emphasis added). Therefore, Applicant's services are marketed to insurers seeking the risk sharing benefits of insurance pooling, and both the reinsurer and insured parties must be extremely knowledgeable about their respective fields.

Moreover, "[t]he intent of reinsurance is for an insurance company to reduce the risks associated with underwritten policies by spreading risks across alternative institutions." (*See* Exhibit B: Printout of Investopedia webpage discussion the definition of reinsurance). As such, Insurance companies work with an agent to determine the terms, conditions, and costs of a reinsurance contract. (*See* Exhibit C: Printout of Reinsurance.org, discussing the fundamentals of reinsurance). Because a reinsurance contract can potentially be for large sums of money, reinsurance contracts help limit liability to the insurer, and because the purchaser is likely working with a reinsurance agent, this dispels any chance that there will be confusion as to who is providing the reinsurance services.

As a general matter, the decision to purchase insurance is an important one that is not made on impulse, but rather involves careful consideration given its risk management purpose and high cost. *See generally Carefirst of Maryland v. Firsthealth of the Carolinas*, 77 U.S.P.Q. 1492, 1504 (T.T.A.B. 2005) (purchasing healthcare insurance is a very important decision and involve substantial financial

commitment). The consumers of Applicant's services are insurance companies looking to create a legally binding contract with another insurance company to protect itself against losses. An assuming reinsurer is paid a reinsurance *premium* by the ceding insurer. In most cases, a primary insurer will not put an insurance service on the market to the public without first having adequate reinsurance in place. Thus, an insurance company's decision to purchase reinsurance to protect itself against liability under the insurance policies it issues clearly requires that the transaction is made with care and deliberation. Therefore, the purchase of Applicant's services is not made spontaneously or without concerted thought; the insurer must carefully research the products and services and confirm that the reinsurance treaty is negotiated so that it will adequately protect the company from extraordinary loss results. Accordingly, the research and negotiation involved helps assure that any purchaser of Applicant's services is going to be highly sophisticated.

In sum, since reinsurance services are rendered sophisticated purchasers, and the purchaser will likely work with an agent to determine the terms and conditions of the reinsurance contract, confusion is not likely.

B. <u>There is No Evidence of Actual Confusion over a Significant Period of Concurrent Use</u>

Although it is unnecessary to show actual confusion to establish a likelihood of confusion, the lack of any actual confusion may also be considered in determining whether a likelihood of confusion exists. *See* TMEP 1207.01(c)(iii), *citing Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990).

Courts have held that where the parties have engaged in a significant period of competition during which the defendant has used the allegedly-infringing mark, the absence of evidence of "actual" consumer confusion, *i.e.*, evidence that specific, individual consumers have been confused, is a factor weighing against a finding of a likelihood of confusion. *See, e.g., Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1005 (2d Cir. 1983) ("[N]o evidence of confusion for over a three-year period, during which substantial sales occurred, is a strong indicator that the likelihood of confusion is minimal."); *M&G Elecs. Sales Corp. v.Sonly Kabushiki Kaisha*, 250 F.Supp.2d 91, 104 (E.D.N.Y. 2003) ("A plaintiff need not show actual confusion; however, the complete absence of confusion after a lengthy

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