From: Chery, Jeffrey

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To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 86954782 - MUTUAL SOLUTIONS - N/A - Request for Reconsideration Denied - Return to TTAB - Message 1 of 4

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Attachment Information:

Count: 14

Files: AHMUTUAL-1.jpg, AHMUTUAL-2.jpg, AHMUTUAL-3.jpg, MW MUTUAL.jpg, Lammico.jpg, Nationwide Mutual Insurance.jpg, Brotherhood Mutual Insurance 2.jpg, Brotherhood Mutual Insurance 1.jpg, Mutual Benefits Inc..jpg, Keystone Mutual.jpg, Medical Mutual.jpg, LWCC.jpg, Illinois Mutual.jpg, 86954782.doc

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

U.S. APPLICATION SERIAL NO. 86954782

MARK: MUTUAL SOLUTIONS

CORRESPONDENT ADDRESS:

MARTHA ZAJICEK

MUTUAL OF OMAHA INSURANCE COMPANY

MUTUAL OF OMAHA PLAZALAW OPERATION - FLO

OR 3

OMAHA, NE 68175-1008

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

VIEW YOUR APPLICATION FILE

APPLICANT: Mutual of Omaha Insurance Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

martha.zajicek@mutualofomaha.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/8/2017

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated November 9, 2016 are maintained and continue to be final: Section 2(e)(1) Merely Descriptive Refusal. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

It should be noted that the examining attorney has attached three registrations containing the word "MUTUAL" owned by the applicant and registered with claims of acquired distinctiveness pursuant to Trademark Act Section 2(f) for insurance services. This is an admission that the word "MUTUAL" is inherently descriptive in relation to the services. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."). Additionally, the applicant filed the instant application with a disclaimer of the word "SOLUTIONS" and attached canceled Registration No. 3583968, which also contained a disclaimer of the word "SOLUTIONS". Thus, the arguments put forth by the applicant that the words "MUTUAL" and "SOLUTIONS" are not descriptive are undermined by registrations and applications once or currently owned by the applicant.

The applicant argues that the words "MUTUAL" and "SOLUTIONS" have multiple meanings and provides dictionary evidence to support this argument. However, descriptiveness is considered in relation to the relevant services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). It is universally understood that words may have multiple meanings, and thus, the applicant's argument is not dispositive. Notably, the applicant does not deny that the word "MUTUAL" refers to insurance companies and services and "SOLUTIONS" refers to services designed to meet a particular need, but avers that the examining attorney should consider the alternative meanings.

Importantly, in the Request for Reconsideration, the applicant puts forth alternative meanings of the applied-for mark, which are also descriptive. Specifically, the applicant states:

> The "Mutual" portion of the Applicant's mark, however, refers to the benefits shared in common by policy owners. Additionally, the 'Solutions' portion of the mark's services does not refer to a solution to a problem or a solution to insurance needs, but rather, the Applicant's 'Solution' portion of the mark's services refers to the value-added benefits available to policy owners, based on their status as a policy owner.

Keeping in line with the applicant's argument that the words in the applied-for mark have multiple meanings, the examining attorney has attached the following dictionary definitions:

MUTUAL

- "Of, relating to, or in the form of mutual insurance."
- "of or relating to a plan whereby the members of an organization share in the profits and expenses; specifically : of, relating to, or taking the form of an insurance method in which the policyholders constitute the members of the insuring company"

The applicant's argument above combined with the various definitions of the words "MUTUAL" and "SOLUTIONS" only strengthens the Section 2(e)(1) refusal because the applicant provides an additional descriptive explanation of the applied-for mark in relation to the services being offered. The applicant offers "Insurance procurement services, namely, providing and arranging for value-added benefits available for life and health insurance." It is practically impossible to ignore the most pertinent meaning of the word "SOLUTIONS," namely, "services designed to meet a particular need." The word "need" means something essential or a thing that is wanted. See attached evidence. Thus, accepting the applicant's argument quoted above means that the applicant offers services designed to provide something essential or wanted by policy owners or policyholders, namely, insurance value-added benefits.

Indeed, the applicant states that the "SOLUTIONS" portion of the mark refers to value-added benefits available to policy owners. Thus, the value-added benefits are designed to meet a particular need (something essential or wanted) of consumers, policy owners, and/or policyholders, namely, those who are looking for or want essential or enhanced insurance benefits. The attached evidence from the Insurance Journal specifically states that "value added services can be anything that insurance costumers might ***want or need***" (Emphasis added). Utilizing the most basic interpretation of the applied-for mark in conjunction with the attached evidence leads to the conclusion that the applicant offers insurance services meant to address a particular insurance need of policyholders. Therefore, the applicant's argument as to an alternative meaning of the applied-for mark is itself descriptive pursuant to Section 2(e)(1).

The applicant further argues that the mark is a double entendre, and thus contains a non-descriptive alternative meaning that must be considered. However, once again, the alternative meaning is also descriptive. Interestingly, the applicant states "[i]n fact, value-added benefits are not a solution solving any issue. They are merely an added enhancement associated with Applicant's life and health insurance services." Thus, the value-added benefits are part of the applicant's insurance services. The applicant essentially concedes the applied-for mark, "MUTUAL SOLUTION", refers to the insurance services offered by the applicant for consumers who need or are looking for enhanced insurance services. Every

interpretation of the applied-for mark proffered by the applicant is descriptive. “If all meanings of a "double entendre" are merely descriptive in relation to the goods [or services], then the mark comprising the "double entendre" must be refused registration as merely descriptive. TMEP 1213.059(c).

Additionally, the multiple interpretations that make an expression a "double entendre" must be associations that the public would make fairly readily, and must be readily apparent from the mark itself. See In re RiseSmart Inc., 104 USPQ2d 1931, 1934 (TTAB 2012) (finding that TALENT ASSURANCE does not present a double entendre such that "the merely descriptive significance of the term [TALENT] is lost in the mark as a whole"); In re The Place, Inc., 76 USPQ2d 1467, 1470 (TTAB 2005) (holding THE GREATEST BAR laudatory and merely descriptive of restaurant and bar services; the Board stating that "[i]f the alleged second meaning of the mark is apparent to purchasers only after they view the mark in the context of the applicant’s trade dress, advertising materials or other matter separate from the mark itself, then the mark is not a double entendre"); In re Wells Fargo & Co., 231 USPQ 95, 99 (TTAB 1986) (holding EXPRESSERVICE merely descriptive for banking services, despite applicant’s argument that the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association). See also In re Ethnic Home Lifestyles Corp., 70 USPQ2d 1156, 1158 (TTAB 2003) (holding ETHNIC ACCENTS merely descriptive of "entertainment in the nature of television programs in the field of home décor," because the meaning in the context of the services is home furnishings or decorations which reflect or evoke particular ethnic traditions or themes, which identifies a significant feature of applicant’s programs; viewers of applicant’s programs deemed unlikely to discern a double entendre referring to a person who speaks with a foreign accent). TMEP 1213.05(c). Here, the other interpretations of the applied-for mark are not readily apparent and do not qualify as a double entendre as the interpretations asserted by the applicant are also descriptive. The merely descriptive significance of the wording MUTUAL SOLUTIONS is not lost when the mark is considered in relation to the services.

The applicant further states a “consumer seeing MUTUAL SOLUTIONS would have no idea what services are associated with the mark” and “[t]here is no product or service immediately described or suggested by the mark MUTUAL SOLUTIONS.” This is not the standard for determining whether a mark is descriptive pursuant to Section 2(e)(1). The determination of whether a mark is merely descriptive is made in relation to an applicant’s services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g.*, *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

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