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Subject: U.S. TRADEMARK APPLICATION NO. 76710584 - DEFINITY COMMUNITY - 122159-3517 -
Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 76710584

MARK: DEFINITY COMMUNITY



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Essilor of America, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

122159-3517

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

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. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated January 5, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

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

Applicant amended its identification of services. However, the amendments to the identification of services remain unacceptable for the reasons discussed below.

Identification of Services

At the outset, applicant should note that an applicant should not use its own registered or unregistered mark in an identification of goods and/or services. See TMEP §1402.09. Applicant should amend its identification of services to remove references to the applied-for mark.

In addition, applicant amended its Class 41 as follows: Providing business training for eyecare professionals who offer DEFINITY brand lenses to their patients in the fields of business management, business operations, advertising, promotion and marketing. However, the proposed amendment to the identification cannot be accepted because wording refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. See 37 C.F.R. §2.71(a). This wording is beyond the scope of the original wording because applicant's Class 41 identification of services was previously identified as "team employment training services in the field of eye care." The field of use is separate, as well as the nature of the services, namely team employment training versus business training. Accordingly, the amendment to the identification of services is unacceptable.

While an applicant may clarify or limit the identification of goods and/or services, adding to or broadening the scope is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07(a). Therefore, this wording should be deleted from the identification. See 37 C.F.R. §2.71(a); TMEP §1402.07(d).

Section 2(d) Refusal

Applicant asserts that it does not provide the services offered by the registrations owned by United Health Group as registrant provides health care coverage and health benefit services, as well as technology-enabled health services. However, as discussed in the January 5, 2013 Office action, the parties' health care plan and benefit services, benefit administration, wellness programs and incentive reward programs travel through the same commercial channels as demonstrated by the web pages from <http://www.ceridian.com>; <http://www.qualityincentivecompany.com>; <http://www.loyaltyworks.com>; <http://www.towerswatson.com>; <http://www.edenredusa.com>; <http://www.strategichr.com>; <http://www.trinet.com/>; <http://www.checkpointhr.com> and <http://www.insourceservices.com>.

Applicant also argues that its services are provided to an existing defined community of eye care professionals and thus the parties' channels of trade are separate. However, applicant should note that with respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services 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)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the registration(s) has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. Accordingly, registrant's identification of services is broadly identified to travel in all normal channels of trade, including the channels of trade indicated by applicant.

Lastly, applicant asserts that the purchasers are sophisticated. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

/Ameen Imam/

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