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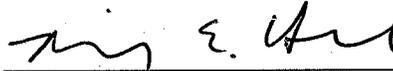
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79066317
Applicant	Christoph Geskes
Correspondence Address	MARK B. HARRISON VENABLE P.O. BOX 34385 WASHINGTON, DC 20043-9998 UNITED STATES mbharrison@venable.com, mehall@venable.com, trademarkdocket@venable.com
Submission	Applicants Request for Remand and Amendment
Attachments	THE MUNICH, Serial No. 79066317 -- Request for Remand.pdf ( 5 pages ) (278753 bytes )
Filer's Name	Michael E. Hall
Filer's e-mail	mbharrison@venable.com, mehall@venable.com, trademarkdocket@venable.com
Signature	/Michael E. Hall/
Date	03/21/2011



Accordingly, Applicant respectfully requests that the Board suspend the appeal and remand the application to the Examining Attorney to consider the Consent Agreement attached hereto.<sup>1</sup>

Respectfully submitted,



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Date: March 21, 2011

Applicant's Attorneys

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<sup>1</sup> With respect to the Section 2(e)(2) refusal, Applicant has argued that THE MUNICH is incongruous because in common usage “the word *the* is a definite article that is not used before the names of cities” (Response of August 17, 2010). Of course, “incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark.” In re Shutts, 217 U.S.P.Q. 363, 364-65 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive). The Examining Attorney noted Applicant’s argument in his subsequent Office Action but did not substantively address it, simply responding that “the term ‘the’ is not distinctive and does not add any source-identifying significance” and citing several inapposite cases in which the term *the* was added to a noun in a manner that would comport with common usage (THE GREATEST BAR, THE WEATHER CHANNEL, and THE COMPUTER STORE). The Examining Attorney refuses to analyze Applicant’s mark THE MUNICH as a whole and consider that the word *the* coupled with the name of a city is a strange usage – and possibly unheard of – as a synonym for the city itself, and there is no per se rule that the word *the* coupled with a term that is not inherently distinctive by itself results in a composite mark that is not inherently distinctive as a whole. For example, the Trademark Manual of Examining Procedure explains that “an entity designation has no source-indicating capacity” but provides for an exception “where the entity designation is used in an arbitrary manner (e.g., “**THE LTD.**” . . .).” T.M.E.P. § 1213.03(d) (bolding added). Director Kappos might say, “I work in Alexandria” but he would not say “I work in the Alexandria.” Accordingly, Applicant insists that its applied-for mark THE MUNICH is not primarily geographically descriptive within the meaning of Section 2(e)(2).

### CONSENT AGREEMENT

This Consent Agreement ("Agreement") is made as of this 10<sup>th</sup> day of March, 2011 ("Effective Date") by and between (1) Christoph Geskes ("Geskes"), located at Mathiaskirchplatz 5, 50968 Köln, Germany, and (2) Munich Reinsurance America, Inc. ("MRA"), located at 555 College Road East, Princeton, New Jersey 08543-5241 USA.

WHEREAS Geskes is the owner of U.S. Trademark Application Serial No. 79/066,317 (extension of protection from International Registration No. 996172) for the mark THE MUNICH (in standard characters) and covering the following services:

Class 35

Advertising; business management services; business administration; office functions

Class 36

Insurance and reinsurance agencies; insurance underwriting services for all types of insurance; reinsurance underwriting; insurance and reinsurance consultancy; insurance and reinsurance information; insurance and reinsurance subrogation; insurance and reinsurance brokerage; insurance and reinsurance actuarial services; insurance and reinsurance administration; insurance and reinsurance claims processing; consultation in the fields of insurance, reinsurance, insurance underwriting and reinsurance underwriting; consultation services in the fields of property insurance, casualty insurance, reinsurance, legal expenses insurance, liability insurance, life insurance, fire insurance, accident insurance, and health insurance as well as in the field of administration of insurance and reinsurance claims; financial affairs, namely financial information, management and analysis services; financial advice; financial consultation; financial forecasting; financing services; financial research; consultation in the field of financial risk management; financial services, namely consultation in finance management and planning; monetary exchange; acquisition and transfer of monetary claims; monetary strategy consultation and research; real estate consultation; real estate agencies; real estate appraisal; real estate brokerage; real estate listing; real estate financing services; real estate investment services

Class 44

Medical and veterinary services; hygienic and beauty care for human beings; agricultural advice; forest habitat restoration

WHEREAS MRA is the owner of U.S. Trademark Registration No. 3,747,881, issued February 9, 2010 for the mark MUNICH RE AMERICA and covering the following services:

Class 9

Electronic publications, namely, books, brochures, magazines, memoranda, newsletters, pamphlets, and a series of articles featuring business, financial, risk, insurance, reinsurance and related topics recorded on computer media; software, namely, computer software for financial analysis of insurance and reinsurance structures, computer software for administration and reporting of insurance and reinsurance information; downloadable electronic newsletters in the field of financial, risk, insurance, and related field information

Class 16

Informational materials, namely, books, brochures, magazines, memoranda, newsletters, pamphlets, and a series of articles featuring business, consulting, financial, management, risk, insurance, reinsurance, and related topics; printed publications, namely, books, brochures, magazines, memoranda, newsletters, pamphlets, and a series of articles in the field of business, consulting, financial, management, risk, insurance, reinsurance, and related topics

Class 35

Business services, namely, risk management assistance; consulting services, namely, business advice

Class 36

Management services, namely, property, casualty, and health insurance underwriting management assistance, insurance claims administration assistance; financial risk management assistance; insurance and reinsurance underwriting in all classes of casualty, property, fidelity, surety, and health insurance; financial services, namely, financial management and planning assistance; insurance and reinsurance services, namely, financial risk assessment and management assistance, underwriting and actuarial assistance, insurance claims administration and processing management advice; consulting in the field of insurance, underwriting, and financial management

Class 41

Providing on-line non-downloadable publications in the nature of articles, books, brochures, magazines, memoranda, newsletters and pamphlets in the field of business, risk, insurance, reinsurance, and related field information; providing on-line non-downloadable electronic newsletters in the field of risk, insurance, reinsurance, and related field information

Class 42

Insurance and reinsurance product development for others

WHEREAS MRA's Registration No. 3,747,881 has been cited by the U.S. Patent and Trademark Office as a bar to registration of Geskes' Application Serial No. 79/066,317.

NOW THEREFORE for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree as follows:

1. The parties agree that, based upon their professional judgment, there is no likelihood of confusion between Geskes' use of THE MUNICH for the services identified in U.S. Application Serial No. 79/066,317, on the one hand, and MRA's use of MUNICH RE AMERICA for the services identified in U.S. Registration No. 3,747,881, on the other. The basis for this conclusion is the parties' expertise in the marketplace, the differences between the marks, the nature of the services offered by each party, the nature of the trade, and the overall sophistication of their respective customers.
2. MRA consents to Geskes' use and registration in the United States and worldwide of the mark THE MUNICH for the services shown in U.S. Application Serial No. 79/066,317, whereas

Geskes consents to MRAs' use and registration in the United States and worldwide of the mark MUNICH RE AMERICA for the services shown in U.S. Trademark Registration No. 3,747,881, or any other trademark applications or registrations bearing the word element MUNICH.

3. In the event either party becomes aware of any actual confusion among their respective customers or clients, each party agrees to notify the other and to work together in good faith to alleviate the source of any such actual confusion.

4. The parties each warrant that they have the full power, authority and legal right to execute, deliver and perform the terms of this Agreement, that there is no other person, entity or court whose consent is necessary to make this Agreement fully effective, and that this Agreement has been duly authorized by all necessary corporate action and shall constitute a valid and binding obligation of the respective parties hereto and is enforceable in accordance with its terms.

5. This Agreement may be executed in any manner of multiple originals by different parties hereto, each of which shall be deemed to be an original and all of which shall constitute collectively one agreement. In making proof of this Agreement, it shall not be necessary to produce or account for more than one such fully executed counterpart.

6. The parties agree that upon the request of any one of them, they will execute and deliver such further documents and undertake such further action as may reasonably be required to effect any of the agreements and covenants contained in this Agreement.

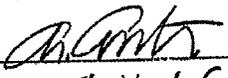
7. In case any one or more provisions or portions hereof is determined to be invalid, illegal or unenforceable in any respect, the validity, legality and enforceability of the remaining provisions contained herein shall not in any way be affected or impaired thereby.

8. This Agreement shall be binding upon and inure to the benefit of the parties, and their respective parent companies, subsidiaries, heirs, representatives, successors, and assigns.

9. The parties agree that they have read this Agreement and have had their rights fully explained by their attorneys; that they have been advised by their attorneys that it is a fair and reasonable Agreement; and that they have been advised by their attorneys to execute the Agreement.

IN WITNESS WHEREOF, the parties have caused this Consent Agreement to be executed as of the date first written above.

Christoph Geskes

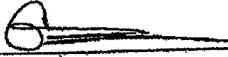
By: 

Printed Name: Christoph Geskes

Title: \_\_\_\_\_

Date: 3/10/11

Munich Reinsurance America, Inc.

By: 

Printed Name: Carlton Smith

Title: Assistant General Counsel

Date: 3/10/11

3

Robi Willer