From: Ferraiuolo, Dominic

Sent: 11/18/2015 6:52:33 AM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 86347211 - LOCKTON GLOBAL BENEFITS NAVIGATOR - N/A - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 1

Files: 86347211.doc

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

U.S. APPLICATION SERIAL NO. 86347211

MARK: LOCKTON GLOBAL BENEFITS NAVIGATOR

CORRESPONDENT ADDRESS:

CHAD W. BRIGHAM

LEACH FIRM, LLC

220 W LOCKWOOD AVE STE 202

SAINT LOUIS, MO 63119-2353

GENERAL TRADEMARK INFORMATION:

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

VIEW YOUR APPLICATION FILE

APPLICANT: Lockton, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

cbrigham@leachfirm.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 11/18/2015

Applicant's amended disclaimer for the wording "Global Benefits" is accepted. However, the requirement for a disclaimer of the wording "Navigator" in the wording "GLOBAL BENEFITS NAVIGATOR" as a whole apart from the mark as shown is maintained. 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 requirement(s) and/or refusal(s) made final in the Office action dated April 28, 2015 are maintained and continue to be final: disclaimer of the wording "NAVIGATOR". *See* TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action are satisfied: requirement to disclaim the wording "Global". *See* TMEP §§715.03(a)(ii)(B), 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's statement that it is obvious that the wording "Navigator" does not immediately and only describe its services is inaccurate, based on false assumptions and made in the abstract. Applicant's arguments assume the wording "navigator" can only be descriptive of a person, when this in fact is not a correct or proper assumption. It offers dictionary definitions it claims are controlling on the meaning of the wording "navigator" in relation to its services, namely "Online business services, namely, providing an online portal for use in the field of employee benefits." In addition, applicant bases its arguments on prior registrations that include the wording "navigator" in the mark.

Applicant's reliance on the 34 prior registrations it cites for attempting to show the wording "navigator" is not merely descriptive in relation to the services is misplaced. There is not a single registration cited by applicant for the services in issue, namely "providing an online portal for use in the field of employee benefits." To the contrary, the evidence made of record in the office action dated October 16, 2014 clearly shows the wording "Benefits Navigator" in connection with online services from various sources providing information about employee benefits is used to merely describe such features, functions, purposes and/or uses of online benefits websites and online benefits portals.

For example, the attachment from www.georgialegalaid.org shows the wording "Benefits Navigator" used in connection with services that allow persons with disabilities who want to work to understand Social Security rules through the use of an online "navigator" that assists such persons. The attachment from www.calgaryunitedway.org shows the wording "Benefits Navigator" used on website or portal that provides persons with an online guide to government benefits. The attachment from www.ovdinsurance.com shows use of the wording HR BENEFITS NAVIGATOR in connection with a website or portal that provides a personalized employee benefits center to assist persons in learning about their benefits packages. The attachment from www.westcaldwellinsurance.com shows use of the wording HEALTH BENEFITS NAVIGATOR in connection with a website or portal that assists persons with their health insurance.

In sum, each of the above instances shows use of the wording “BENEFITS NAVIGATOR” to merely describe a feature, function purpose and/or use of online services that provide information about benefits in various areas or fields that are highly similar to or the same as applicant’s use of the wording “Benefits Navigator” in the instant application. The scope of the applicant’s services namely “providing an online portal for use in the field of employee benefits” clearly includes providing information about benefits, as shown by the attachments from applicant’s website to the office action dated April 28, 2015. Prospective users of applicant’s services are likely to include those who have used “Benefits Navigators” for other types of benefits and the evidence shows that the wording “Benefits Navigator” is commonly used by those providing the services of online benefits to explain benefits to users of the websites or portals that provide such information. Therefore, the wording “NAVIGATOR” in the wording “GLOBAL BENEFITS NAVIGATOR” in the applied-for mark is merely descriptive as a whole in relation to the services. The final requirement for a disclaimer of the wording “NAVIGATOR” in the wording “GLOBAL BENEFITS NAVIGATOR” in the applied-for mark as a whole apart from the mark as shown is therefore maintained.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

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