

ESTTA Tracking number: **ESTTA720995**

Filing date: **01/17/2016**

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

Proceeding	86347211
Applicant	Lockton, Inc.
Applied for Mark	LOCKTON GLOBAL BENEFITS NAVIGATOR
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Submission	Appeal Brief
Attachments	Lockton Global Benefits Navigator - Appeal Brief.pdf(389285 bytes)
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Date	01/17/2016

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

In re Application of:
Lockton, Inc.
Serial No: 86/347,211
Filing Date: July 24, 2014
Mark: LOCKTON GLOBAL
BENEFITS NAVIGATOR

Law Office 102

Trademark Attorney:
Dominic J. Ferraiuolo

BRIEF FOR APPLICANT

INTRODUCTION

Lockton, Inc. (“Applicant”) appeals from the Trademark Attorney’s refusal to register the mark LOCKTON GLOBAL BENEFITS NAVIGATOR (“Applicant’s Mark”) set forth in Applicant’s application Ser. No. 86/347,211 (the “Application”) without a disclaimer of the NAVIGATOR element. The Trademark Attorney mailed his final refusal on April 28, 2015. Applicant filed a Request for Reconsideration on October 22, 2015 and Applicant filed a timely Notice of Appeal on October 27, 2015. Applicant’s Request for Reconsideration was denied and the deadline for submitting this Brief for Applicant was set at January 18, 2016.

RECITATION OF RELEVANT FACTS

Applicant filed a federal registration application for the service mark LOCKTON GLOBAL BENEFITS NAVIGATOR on July 24, 2014 covering “online business services, namely, providing an online portal for use in the field of employee benefits”. The Trademark Attorney issued an Office Action dated October 16, 2014 (the “First Office Action”) and requested, among other things, that Applicant disclaim the wording GLOBAL BENEFITS NAVIGATOR as a whole because it allegedly merely describes a function, feature, purpose, or use of Applicant’s services. The Trademark Attorney made of record four third party websites in

an effort to claim that the wording “Benefits Navigator” is commonly used in connection with similar services to identify and describe features of the services.

On April 6, 2015, Applicant responded to the First Office Action and disclaimed the BENEFITS element of Applicant’s Mark. Applicant disagreed, however, that the Trademark Attorney’s internet evidence suggested that BENEFITS NAVIGATOR is a commonly used phrase for similar services. Applicant reviewed the information available for each of the uses cited by the Trademark Attorney and none used BENEFITS NAVIGATOR in a descriptive sense. Applicant further argued that “navigator” has no descriptive meaning when applied to an online portal used in the field of employee benefits. Applicant made of record the definition of “navigator” that shows no descriptive meaning in the employee benefits field. In further support of Applicant’s position, Applicant made of record 16 third party Principal Registrations covering online portals, employee benefits and related services incorporating NAVIGATOR and without a disclaimer of that term. The Trademark Attorney did not object to the materials Applicant made of record.

The Trademark Attorney issued a second Office Action on April 28, 2015 (the “Final Office Action”) and maintained and made final his requirement for a disclaimer of the wording GLOBAL BENEFITS NAVIGATOR as a whole. The Trademark Attorney argued that Applicant’s evidence of 16 third party registrations and the submitted definition was outweighed by the separate websites that he believed showed BENEFITS NAVIGATOR commonly used in connection with providing information services in the area or field of employee benefits.

In response to the Trademark Attorney’s Final Office Action, Applicant timely filed a Request for Reconsideration after Final Action dated October 22, 2015 (the “Reconsideration Request”) and disclaimed the GLOBAL BENEFITS element of Applicant’s Mark. The

Applicant also analyzed the Trademark Attorney's evidence and concluded in a detailed response that those materials do not show that the wording BENEFITS NAVIGATOR or the term NAVIGATOR is commonly used in connection with an online portal in the field of employee benefits. The Applicant also made of record, without objection, 34 additional third party registrations and applications on the Principal Register covering certain online business services, employee services, insurance services and benefits services incorporating NAVIGATOR and without a disclaimer of that term.

Applicant appealed the Trademark Attorney's refusal set forth in the Final Office Action. Applicant filed a timely Notice of Appeal on October 27, 2015.

On November 8, 2015, the Trademark Attorney denied Applicant's Reconsideration Request and continued the requirement that NAVIGATOR in the wording GLOBAL BENEFITS NAVIGATOR be disclaimed. The Trademark Attorney again stood on his four website examples of use and argued that this evidence proved use of the wording BENEFITS NAVIGATOR as immediately descriptive of online services that provide information about benefits in various areas or fields.

STATEMENT OF THE ISSUE

The issue in this appeal is whether, based upon the record created in this matter, the NAVIGATOR element of the mark LOCKTON GLOBAL BENEFITS NAVIGATOR is merely descriptive under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), of the Trademark Act when used in connection with “[o]nline business services, namely, providing an online portal for use in the field of employee benefits”?

THE TEST FOR MERE DESCRIPTIVENESS

The test for mere descriptiveness is whether a term *only, immediately* and *with particularity* conveys knowledge of a quality, feature, function, or characteristic of the services with which it is used. In re Carlson, 91 U.S.P.Q.2d 1198, 1199-1200 (TTAB 2009); In re Shutts, 217 U.S.P.Q. 363 (TTAB 1983); In re Quick-Print Copy Shop, Inc., 203 U.S.P.Q. 505, 507 n.7 (CCPA 1980) (“in the [merely descriptive] context, ‘merely’ is considered to mean ‘only’”); In re TMS Corp. of the Americas, 200 U.S.P.Q. 57, 59 (TTAB 1978) (finding that THE MONEY STORE fell short of describing applicant’s services “with particularity”).

APPLICANT’S ARGUMENT

1. *The dictionary definition of “navigator” supports that the relevant purchasing public would not immediately, only and with particularity associate NAVIGATOR with a characteristic of Applicant’s services.*

As is clear from the dictionary definition of “navigator” that Applicant made of record¹ without objection, the meaning of “navigator” does not immediately and only describe with particularity an online employee benefits portal. For ease of reference, the dictionary definition provided the following meanings:

1. One who navigates,
2. A device that directs the course of an aircraft or missile,
3. A person who is skilled in or performs navigation, i.e., on a ship or aircraft,
4. A person who explores by ship,
5. An instrument or device for assisting a pilot to navigate an aircraft,
6. A person who practices, or is skilled in, navigation, and
7. A person who conducts explorations by sea.

The dictionary entry is evidence that the relevant purchasing public would not immediately associate NAVIGATOR with a quality or characteristic of an online employee benefits portal. The Trademark Attorney gave little weight to the dictionary entry in his analysis.

¹ April 6, 2015 Response to First Office Action, TSDR p. 24.

2. *Numerous third party registrations and applications support that the relevant purchasing public does not immediately, only and with particularity associate NAVIGATOR with a characteristic of Applicant's services.*

To add further support to Applicant's argument that the purchasing public does not immediately and only associate NAVIGATOR with a characteristic of online business services in the nature of an employee benefits portal, Applicant made of record 50 applications and registrations on the Principal Register covering online portals, benefits services, online business services and insurance services incorporating NAVIGATOR and without a disclaimer of that term.²² A list of the printouts taken from the USPTO's trademark database is set forth below for ease of reference.

1. SEC FILINGS NAVIGATOR, Reg. No. 3,729,014;
2. CSCNAVIGATOR, Reg. No. 4,150,750;
3. EMPLOYEE NAVIGATOR, Reg. No. 4,208,597;
4. AON HEWITT NAVIGATORS, Reg. No. 4,129,829;
5. CARE NAVIGATOR, Reg. No. 4,500,165;
6. EC-NAVIGATOR, Reg. No. 4,453,698;
7. NAVIGATOR REIMBURSEMENT AND ACCESS PROGRAM, Reg. No. 4,503,079;
8. SURVEYNAVIGATOR, Reg. No. 4,595,825;
9. EC NAVIGATOR (Stylized), Reg. No. 4,494,550;
10. DEBT NAVIGATOR & Design, Reg. No. 3,536,184;
11. JOB NAVIGATOR, Reg. No. 2,275,684;
12. DOCTORNAVIGATOR, Reg. No. 3,652,278;
13. DOCTORNAVIGATOR & Design, Reg. No. 3,652,279;
14. GEOBLUE NAVIGATOR, Reg. No. 4,408,318;
15. COMPENSATIONNAVIGATOR, Reg. No. 4,468,994; and,
16. AVALERE EBM NAVIGATOR; Reg. No. 4,165,243.
17. RMDNAVIGATOR, Reg. No. 3,702,138;
18. SPEND NET NAVIGATOR, Reg. No. 4,502,440;
19. CULTURAL NAVIGATOR, Reg. No. 3,691,282;
20. NAFTA NAVIGATOR, Reg. No. 2,866,593;
21. NAVIGATOR, Reg. No. 3,201,048;
22. CLAIMS NAVIGATOR, Reg. No. 4,030,718;
23. CHANNEL NAVIGATOR, Reg. No. 4,190,205;
24. NOVARICA MARKET NAVIGATOR, Reg. No. 4,303,994;
25. ACE NAVIGATOR, Reg. No. 4,363,772;

²² April 6, 2015 Response to First Office Action, TSDR pp. 7-23; October 22, 2015 Reconsideration Request, TSDR pp 14-80.

26. FIFTH THIRD MONEY MARKET NAVIGATOR, Reg. No. 4,502,968;
27. NAVIGATOR PLATFORM, Reg. No. 4,416,886;
28. RX NAVIGATOR, Reg. No. 2,432,492;
29. THE ENTREPRENEURS NAVIGATOR SYSTEM, Reg. No. 2,864,009;
30. HEALTH PLAN NAVIGATOR & Design, Reg. No. 2,902,024;
31. LIFETIME NAVIGATOR, Reg. No. 3,632,324;
32. NAVIGATOR, Reg. No. 3,203,413;
33. YOUR LONG-TERM CARE NAVIGATOR, Reg. No. 4,106,181;
34. PAYMENT NAVIGATOR, Reg. No. 4,290,833;
35. NAVIGATORS LS ELITE, Reg. No. 3,954,660;
36. CERTIFIED HEALTHCARE NAVIGATOR, Reg. No. 4,469,926;
37. INSURANCE EXCHANGE NAVIGATORS, Reg. No. 4,668,211;
38. IN-HOUSE NAVIGATOR, Reg. No. 4,680,596;
39. POSITION CONTROL NAVIGATOR, Reg. No. 2,106,933;
40. INSIGHTS NAVIGATOR, Reg. No. 3,894,296;
41. SUCCESS PROFILES NAVIGATOR, Reg. No. 3,595,277;
42. OPTION NAVIGATOR, Reg. No. 3,298,707;
43. ECOM NAVIGATOR, Reg. No. 3,923,696;
44. TREATY NAVIGATOR, Reg. No. 4,370,598;
45. LIABILITY NAVIGATOR, Ser. No. 86/404,422 (no requirement in the record to disclaim NAVIGATOR);
46. MSP NAVIGATOR, Ser. No. 86/404,387 (no requirement in the record to disclaim NAVIGATOR);
47. WC NAVIGATOR, Ser. No. 86/404,406 (allowed for registration);
48. HOME LOAN NAVIGATOR, Ser. No. 86/298,641 (allowed for registration);
49. EY GROWTH NAVIGATOR, Reg. No. 4,871,339; and,
50. LIBERTY MUTUAL NAVIGATOR, Reg. No. 4,842,133.

These third party registrations and applications overwhelmingly show that the USPTO and consumers have found the term NAVIGATOR to be an indication of origin, distinctive and capable of gaining trademark protection in connection with similar services. The Trademark Attorney disagreed.

3. The Trademark Attorney's four third party websites do not support that the relevant purchasing public would immediately, only and with particularity associate NAVIGATOR with a characteristic of Applicant's services.

The Trademark Attorney's only argument for finding that the NAVIGATOR element of Applicant's Mark is merely descriptive is that, because of the commonplace usage of BENEFITS NAVIGATOR, it is allegedly recognizable in the field of providing information on employee

benefits. The Trademark Attorney's best case for his position that the NAVIGATOR or BENEFITS NAVIGATOR element of Applicant's Mark is prevalent in the online employee benefits area is the following four third party internet web pages made of record:³

- (i) a page from the *georgialegalaid.com* website for the Shepherd Center's Benefits Navigator Work Incentives Planning and Assistance Program;
- (ii) an apparent landing page on *calgarayunitedway.org* to enter an online Canadian government guide called THE BENEFITS NAVIGATOR;
- (iii) a page from *odvinsurance.com* that shows a website maintained by an insurance agency for employee benefits package information branded with HRBENEFITS NAVIGATOR & Compass design; and,
- (iv) a page on *westcaldwellinsurances.com* briefly describing a health insurance agency with a business name of "Health Benefits Navigator".

It must be presumed that the four internet print-outs made of record by the Trademark Attorney was the Trademark Attorney's best case possible for his position that the NAVIGATOR element of Applicant's service mark is commonly used in connection with Applicant's services. See In re The Monotype Corporation PLC, 14 U.S.P.Q.2d 1070, 1071 (TTAB 1989). Applicant respectfully disagrees with the Trademark Attorney that the four internet print-outs made of record show that BENEFITS NAVIGATOR or NAVIGATOR is so commonly used that purchasers have redefined it to mean providing an informational website in the field of employee benefits.

First, the *westcaldwellinsurances.com* page made of record by the Trademark Attorney only shows that there is or was an insurance agency with a business name of "Health Benefits Navigator" that specializes or specialized in health insurance and group health insurance.⁴ The

³ October 16, 2014 First Office Action, TSDR pp. 12-18.

⁴ The *westcaldwellinsurances.com* domain name no longer resolves to an active website.

chosen business name of a single health insurance agency; however, is completely different and distinct from an online portal used in the field of employee benefits and nothing on the *westcaldwellinsurances.com* web page evidence submitted by the Trademark Attorney suggests that this page is an employee benefits online portal or even contains information about employee benefits. Contrary to the Trademark Attorney's claim, if a consumer encountered this *westcaldwellinsurances.com* web page, the only logical and immediate commercial impression that could be created is that a business exists called "Health Benefits Navigator".

Second, the *georgialegalaid.org* website is not an online portal or an informational website in the field of employee benefits. As the domain name and the tag line on the page suggests, *georgialegalaid.org* is a website dedicated to providing Georgia residents with access to basic legal information and legal resources in that state. The page made of record by the Trademark Attorney is included on *georgialegalaid.org* merely to inform Georgia residents that the Shepherd Center (an injury rehabilitation center in Atlanta, GA) provides work planning and assistance consulting services for persons receiving Supplemental Security Income (SSI) or Social Security Disability Insurance (SSDI) under the name "Benefits Navigator Work Incentives Planning and Assistance Program". This governmental entitlements consulting program name adopted by a single injury rehab center, however, is completely different and distinct from an online portal used in the field of employee benefits and nothing on the *georgialegalaid.org* web page evidence submitted by the Trademark Attorney suggests that this page is an employee benefits online portal or even contains information about employee benefits. When a consumer encounters this web page, the only logical and immediate commercial impression that could be created is that the Shepherd Center has a governmental entitlements

consulting program called the “Benefits Navigator Work Incentives Planning and Assistance Program”.

Third, although the *calgarayunitedway.org* web page gave little context in which THE BENEFITS NAVIGATOR is used (and therefore, should be given limited probative value⁵), Applicant’s attorney did review this web site and it is also not an online portal or an informational website in the field of employee benefits. What the Calgary, AB, Canada United Way has done is simply attempt to aggregate the Canadian government’s municipal, Provincial and Federal entitlements and financial support (e.g., income supports, childcare assistance, affordable housing and rental assistance) available for low-income Canadians and brand that foreign United Way web guide as THE BENEFITS NAVIGATOR (with a stylized display and design elements). Applicant does not agree that a Canadian web guide prominently displaying THE BENEFITS NAVIGATOR & Design and associated with Canadian low-income governmental welfare entitlements should be given much probative value in declaring that United States consumers immediately and only deem NAVIGATOR as immediately descriptive of a characteristic of an online employee benefits portal.

Finally, while the *odvinsurance.com* evidence submitted by the Trademark Attorney purports to be a client account access website associated with employee benefits, it clearly does not show that the BENEFITS NAVIGATOR wording is being used in a descriptive manner or convey a feature of the online tool. Rather, the website maintained by an insurance agency for employee benefits package information is clearly and conspicuously branded with a HRBENEFITS NAVIGATOR mark that is set apart and larger than the rest of the text on the

⁵ TBMP § 710.01(b). See also *In re Bayer AG*, 488 F.3d 960, 967 (Fed. Cir. 2007) (deeming internet search results that provided very little context of the use of a mark to be of little value in assessing the consumer public perception of the mark).

page, is used with unique coloring and font styles, and incorporates a large colored compass design. The commercial impression created when consumers encounter this website is proper use of a HRBENEFITS NAVIGATOR & Compass Design brand and not merely a phrase that describes a feature of the brand owner's online services.

For all of the foregoing reasons, Applicant believes that the materials made of record by the Trademark Attorney do not show that the wording BENEFITS NAVIGATOR or the term NAVIGATOR is commonly used in connection with an online portal in the field of employee benefits. The Applicant's submitted definition and the 50 third party registrations and applications made of record overwhelming support that the NAVIGATOR element of the Applicant's Mark is not merely descriptive, particularly when weighed against the Trademark Attorney's four internet print-outs (as clarified, differentiated and distinguished from Applicant's services as set forth herein).

4. All doubt as to the registerability of Applicant's Mark should be resolved in favor of Applicant.

Finally, where there are doubts as to registerability of marks, particularly in dealing with a fine and frequently subjective line of demarcation between the suggestive and the merely descriptive designation, doubts in such cases are to be resolved in favor of the applicant. In re Officers' Org. for Econ. Benefits, Ltd., 221 U.S.P.Q. 184, 186 (TTAB 1983); see also In re Grand Metro. Foodservice, Inc., 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994).

CONCLUSION

Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Trademark Attorney's decision so that Applicant's Mark and the Application may be approved for publication without a requirement to disclaim NAVIGATOR.

Respectfully submitted,

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INDEX OF CITED CASES

1. In re Bayer AG, 488 F.3d 960, 967 (Fed. Cir. 2007).
2. In re Carlson, 91 U.S.P.Q.2d 1198 (TTAB 2009),
3. In re Grand Metro. Foodservice, Inc., 30 U.S.P.Q.2d 1974 (TTAB 1994).
4. In re Officers' Org. for Econ. Benefits, Ltd., 221 U.S.P.Q. 184 (TTAB 1983).
5. In re Quick-Print Copy Shop, Inc., 203 U.S.P.Q. 505 (CCPA 1980).
6. In re Shutts, 217 U.S.P.Q. 363 (TTAB 1983).
7. In re The Monotype Corporation PLC, 14 U.S.P.Q.2d 1070 (TTAB 1989).
8. In re TMS Corp. of the Americas, 200 U.S.P.Q. 57 (TTAB 1978).