

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86737800
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION	
MARK	<a href="http://tmng-al.uspto.gov/resting2/api/img/86737800/large">http://tmng-al.uspto.gov/resting2/api/img/86737800/large</a>
LITERAL ELEMENT	CLAIMALERT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.

### ARGUMENT(S)

#### Refusal Under Section 2(e) of the Trademark Act

##### **I. Introduction**

Applicant seeks to register the mark CLAIMALERT for use in connection with the following amended goods and services: downloadable electronic reports and downloadable electronic data files with information and analytics relating to insurance data, insurance claims, and insurance fraud and abuse, in Class 9;

compiling and analyzing data in the field of insurance, in Class 35;

providing information and analytics relating to insurance data, insurance claims, and insurance fraud and abuse; providing information in the field of insurance claims management and analysis, information on weather and natural hazards, information on property foreclosures, personal information about insureds, third party claimants, medical providers, attorneys, and businesses, financial information about insureds, third party claimants, medical providers, attorneys, and businesses, and information about criminal backgrounds of insureds, third party claimants, medical providers, attorneys, and businesses; providing insurance information, insurance claims information, and information about insurance fraud and abuse, by email and other electronic means; providing a website featuring information and predictive analytics about insurance, insurance claims, insurance risks; providing information regarding insurance claims and insurance fraud and abuse distributed electronically by email, in Class 36;

providing online non-downloadable publications in the nature of electronic reports with information on and analysis of insurance data, insurance claims and insurance fraud and abuse via a global computer network, in Class 41;

providing online nondownloadable software for providing information and analytics about insurance and insurance claims; providing online nondownloadable software for analysis of insurance information and identification and detection of insurance fraud and abuse; providing online nondownloadable software for use in insurance claims management, in Class 42; and

fraud detection services in the field of insurance; providing a website featuring information about insurance fraud and abuse; providing an interactive website notifying insurers by electronic message notification about insurance claims and insurance fraud and abuse, in Class 45.

The Final Office Action asserts a refusal to register Applicant's mark, asserting that the mark is merely descriptive of applicant's

goods and services. Applicant respectfully disagrees and submits that its mark is not descriptive of Applicant's goods and services.

Accordingly, Applicant requests that the Trademark Office reconsider and withdraw the descriptiveness refusal.

## **II. Applicant's mark is not merely descriptive.**

Applicant's mark does not immediately and directly convey any information regarding Applicant's goods and services and consequently is not merely descriptive of Applicant's goods and services. Applicant's highly specialized goods and services primarily relate to providing information and analytics regarding insurance issues and it requires imagination, thought or perception to reach a conclusion that CLAIMALERT is used in connection with these goods and services. See Stix Prods., Inc. v. United Merchants & Manu., Inc., 160 U.S.P.Q. 777, 785 (D.C.N.Y. 1968).

It would require a great deal of imagination, thought and reasoning for one to deduce that Applicant's mark is used in connection with highly specialized goods and services relating to information and analytics involving insurance issues and closely related goods and services. See Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1218 (9<sup>th</sup> Cir. 1987) ("[t]he imagination test focuses on the amount of imagination required in order for a consumer to associate a given mark with the goods or services it identifies").

One must exercise "mature thought or follow a multi-stage reasoning process" to determine characteristics of the goods or services from the mark – the thought process involved in making this determination is not immediate and direct. Therefore the mark is considered suggestive, not descriptive. In re Tennis in the Round, Inc., 199 U.S.P.Q. 496 (TTAB 1978) (finding TENNIS IN THE ROUND suggestive of tennis services); see also Rodeo Collection, Ltd., 812 F.2d 1215 (9<sup>th</sup> Cir. 1987). Because Applicant's mark does not immediately describe Applicant's goods and services, Applicant's mark cannot be properly classified as descriptive.

Furthermore, even if Applicant's mark conveys information about Applicant's goods and services, the mark is not necessarily descriptive. It is well established that marks that convey information about goods and services can still function as trademarks. See, e.g., In re DC Comics, Inc., 215 U.S.P.Q. 394 (CCPA 1982), see also In re Frank J. Curran Co., 189 U.S.P.Q. 560 (TTAB 1975) (CLOTHES FRESH not merely descriptive of clothes and shoe spray deodorant); In re Realistic Co., 19 U.S.P.Q. 610 (CCPA 1971) (CURV not merely descriptive of permanent wave curling solutions). Here, Applicant's mark does not directly convey information about the goods and services in a manner that would be readily apparent to a consumer, but even if the mark did convey some general information about the Applicant's goods and services, Applicant's mark is still not "merely descriptive." In addition, Applicant's mark is not descriptive because Applicant's mark is not needed by Applicant's competitors to describe their goods and services. See Rodeo Collection, Ltd., 812 F.2d at 1218; Application of Reynolds Co., 480 F.2d at 904 (registration of BROWN-IN-BAG will not prevent competitors from informing buyers that goods may be brown).

## **III. Conclusion**

Applicant's mark is not merely descriptive of the proposed goods and services because Applicant's mark does not immediately and directly convey information regarding Applicant's goods and services. Accordingly, the Examining Attorney's refusal should be withdrawn.

See In re Grant Metropolitan, 30 U.S.P.Q.2d at 1976 (any doubts about descriptiveness should be resolved in the Applicant's behalf); In re Micro Instru. Corp., 222 U.S.P.Q. 252 (TTAB 1984).

### **SIGNATURE SECTION**

RESPONSE SIGNATURE	/Michael Friscia/
SIGNATORY'S NAME	Michael R. Friscia
SIGNATORY'S POSITION	Attorney of record, NJ bar member
SIGNATORY'S PHONE NUMBER	973-848-8308
DATE SIGNED	10/19/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

### **FILING INFORMATION SECTION**

SUBMIT DATE	Wed Oct 19 19:08:46 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XX.XX.XX-201 61019190846045253-8673780 0-570c95a0a22553e0afcb8da 3d5210831e34cc6b5898c0e1a df417eb62a94bada5-N/A-N/A

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PTO Form 1980 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

## **Request for Reconsideration after Final Action**

### **To the Commissioner for Trademarks:**

Application serial no. **86737800** CLAIMALERT(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86737800/large>) has been amended as follows:

#### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

### **Refusal Under Section 2(e) of the Trademark Act**

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#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Michael Friscia/ Date: 10/19/2016

Signatory's Name: Michael R. Friscia

Signatory's Position: Attorney of record, NJ bar member

Signatory's Phone Number: 973-848-8308

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86737800

Internet Transmission Date: Wed Oct 19 19:08:46 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XX.XX.XX-201610191908460452

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