

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86845331
LAW OFFICE ASSIGNED	LAW OFFICE 121
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86845331/large
LITERAL ELEMENT	CHUBB. INSURED.
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)

In an Office Action dated April 19, 2016, the Examining Attorney made final a request that Applicant disclaim allegedly merely descriptive matter from its "CHUBB. INSURED." mark as a whole. Applicant submits the following response in support of registration.

#### A. Background

It is well-settled that the validity of a mark is not judged by an examination of its individual parts, but rather by viewing the trademark as a whole. "It is axiomatic that a mark should not be dissected and considered piecemeal . . . ." Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, "[t]he whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark." Association of Coop. Members, Inc. v. Farmland Industries, Inc., 684 F.2d 1134, 1140 (5th Cir. 1982), cert. denied, 460 U.S. 1038 (1983). The validity of Applicant's mark, "CHUBB. INSURED.", is doubtless contemplated by the reasoning in Farmland Industries.

Besides the general rule that elements of marks must not be considered in a piecemeal fashion, it is especially important that unitary marks that include elements physically connected by lines or other design features (e.g., full stops), unique verbal structure of the component words in the mark, or the relative location of the respective elements, be considered in their entirety instead of part-by-part. Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 1561, 21 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991). Referring to T.M.E.P. § 1213.05, it is clear that Applicant's mark must be viewed as unitary. As defined by the T.M.E.P., a mark or

portion thereof is considered unitary when it creates a commercial impression that is separate and apart from any unregistrable component. T.M.E.P. § 1213.05.

In addition to being a unitary display, Applicant's "CHUBB. INSURED." mark is a slogan and, therefore, fully registrable on the Principal Register. A registrable slogan is one that is used in a trademark sense. T.M.E.P. § 1213.05(b). Moreover, "[a] registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer." Id. In the case In re Sotille, 156 U.S.P.Q. 655 (T.T.A.B. 1986), the Board maintained the general policy of allowing highly suggestive slogans to be registered on the Principal Register. There, the Board reversed a final refusal to register the slogan YOUR FINANCIAL SECURITY IS OUR BUSINESS for use in connection with insurance services. The Board characterized the mark's highly suggestive nature as follows:

Applicant's mark is a slogan and slogans are usually composed of dictionary words. Slogans may be ingenious, clever, catchy, trite, dull, nonsensical and the like but to be registered a slogan need not be a work of art.

Id. at 656.

**B. "INSURED" Should Not Be Disclaimed.**

Applicant respectfully submits that its trademark constitutes a unitary mark that is registrable without disclaimer of "INSURED". Applicant urges the Examining Attorney to consider the composition of Applicant's "CHUBB. INSURED." mark, which is a slogan consisting of two words, tied together by two full stops. This structure embodies the mark with an unusual visual style - the presence of the full stops breaks up the mark, while at the same time binding the mark together as a unitary stamp or seal of approval. From an aural perspective, the presence of two sentences creates a memorable mark with a halting pause in the middle indicated by the first full stop; the presence of the full stop creates a natural pause in the Applicant's Mark, while also binding the entirety of the mark together in a unified whole. Together the statements form a confident proclamation, one which is more than a promotional statement, but which states the assured feeling of Applicant's customers, who know that their interests are protected by Chubb.

The use of two short sentences in the "CHUBB. INSURED." mark is powerful, memorable, and capable of being associated in the mind of the consumer with the services offered by the Applicant. In other words, the term "INSURED" in Applicant's slogan is not merely a description of Applicant's services, but instead is an integral part of the "CHUBB. INSURED." source-identifying seal of approval. Applicant's mark is not unlike the registered "YOU.INSURED" (U.S. Registration No. 4,802,279) and "BE SAFE. SECURE. INSURED." (U.S. Registration No. 3,207,693) marks, both of which are on

the Principal Register without disclaimer.

In view of the above arguments, Applicant requests the Examining Attorney to withdraw the disclaimer requirement and approve Applicant's mark for publication.

#### SIGNATURE SECTION

RESPONSE SIGNATURE	/matthew homyk/
SIGNATORY'S NAME	Matthew A. Homyk
SIGNATORY'S POSITION	Attorney of record, Pennsylvania bar member
SIGNATORY'S PHONE NUMBER	215-569-5360
DATE SIGNED	10/19/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

#### FILING INFORMATION SECTION

SUBMIT DATE	Wed Oct 19 16:21:44 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XXX.XX-2 0161019162144842847-86845 331-570fee332d498cec7b454 69d2a411c88f9ef6a2fc88616 93b13471ad63dd811-N/A-N/A -20161019161859619174

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.  
PTO Form 1960 (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. **86845331** CHUBB. INSURED.(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86845331/large>) has been amended as follows:

#### ARGUMENT(S)

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

In an Office Action dated April 19, 2016, the Examining Attorney made final a request that Applicant disclaim allegedly merely descriptive matter from its "CHUBB. INSURED." mark as a whole. Applicant submits the following response in support of registration.

#### **A. Background**

It is well-settled that the validity of a mark is not judged by an examination of its individual parts, but rather by viewing the trademark as a whole. "It is axiomatic that a mark should not be dissected and considered piecemeal . . . ." Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, "[t]he whole, in trademark law, is often greater than the sum of its parts. Common words in which no

one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark." Association of Coop. Members, Inc. v. Farmland Industries, Inc., 684 F.2d 1134, 1140 (5th Cir. 1982), cert. denied, 460 U.S. 1038 (1983). The validity of Applicant's mark, "CHUBB. INSURED.", is doubtless contemplated by the reasoning in Farmland Industries.

Besides the general rule that elements of marks must not be considered in a piecemeal fashion, it is especially important that unitary marks that include elements physically connected by lines or other design features (e.g., full stops), unique verbal structure of the component words in the mark, or the relative location of the respective elements, be considered in their entirety instead of part-by-part. Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 1561, 21 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991). Referring to T.M.E.P. § 1213.05, it is clear that Applicant's mark must be viewed as unitary. As defined by the T.M.E.P., a mark or portion thereof is considered unitary when it creates a commercial impression that is separate and apart from any unregistrable component. T.M.E.P. § 1213.05.

In addition to being a unitary display, Applicant's "CHUBB. INSURED." mark is a slogan and, therefore, fully registrable on the Principal Register. A registrable slogan is one that is used in a trademark sense. T.M.E.P. § 1213.05(b). Moreover, "[a] registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer." Id. In the case In re Sotille, 156 U.S.P.Q. 655 (T.T.A.B. 1986), the Board maintained the general policy of allowing highly suggestive slogans to be registered on the Principal Register. There, the Board reversed a final refusal to register the slogan YOUR FINANCIAL SECURITY IS OUR BUSINESS for use in connection with insurance services. The Board characterized the mark's highly suggestive nature as follows:

Applicant's mark is a slogan and slogans are usually composed of dictionary words. Slogans may be ingenious, clever, catchy, trite, dull, nonsensical and the like but to be registered a slogan need not be a work of art.

Id. at 656.

**B. "INSURED" Should Not Be Disclaimed.**

Applicant respectfully submits that its trademark constitutes a unitary mark that is registrable without disclaimer of "INSURED". Applicant urges the Examining Attorney to consider the composition of Applicant's "CHUBB. INSURED." mark, which is a slogan consisting of two words, tied together by two full stops. This structure embodies the mark with an unusual visual style - the presence of the full stops breaks up the mark, while at the same time binding the mark together as a unitary stamp or seal of approval. From an aural perspective, the presence of two sentences creates a memorable mark with a halting pause in the middle indicated by the first full

stop; the presence of the full stop creates a natural pause in the Applicant's Mark, while also binding the entirety of the mark together in a unified whole. Together the statements form a confident proclamation, one which is more than a promotional statement, but which states the assured feeling of Applicant's customers, who know that their interests are protected by Chubb.

The use of two short sentences in the "CHUBB. INSURED." mark is powerful, memorable, and capable of being associated in the mind of the consumer with the services offered by the Applicant. In other words, the term "INSURED" in Applicant's slogan is not merely a description of Applicant's services, but instead is an integral part of the "CHUBB. INSURED." source-identifying seal of approval. Applicant's mark is not unlike the registered "YOU.INSURED" (U.S. Registration No. 4,802,279) and "BE SAFE. SECURE. INSURED." (U.S. Registration No. 3,207,693) marks, both of which are on the Principal Register without disclaimer.

In view of the above arguments, Applicant requests the Examining Attorney to withdraw the disclaimer requirement and approve Applicant's mark for publication.

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /matthew homyk/ Date: 10/19/2016

Signatory's Name: Matthew A. Homyk

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

Signatory's Phone Number: 215-569-5360

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86845331

Internet Transmission Date: Wed Oct 19 16:21:44 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XXX.XX-2016101916214484

2847-86845331-570fee332d498cec7b45469d2a

411c88f9ef6a2fc8861693b13471ad63dd811-N/

A-N/A-20161019161859619174