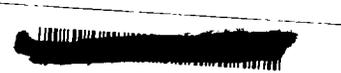


UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 78/144217
For the Mark: TALENTPORT
Filing Date: July 16, 2002



02-13-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

TALENT PLUS, INC.,)
)
Opposer,)
)
v.)
)
MANPOWER, INC.,)
)
Applicant)
)
)

Opposition No. 91158324

ANSWER TO NOTICE OF OPPOSITION

Applicant Manpower, Inc., is a Wisconsin corporation with offices at 5301 North Ironwood Road Milwaukee WISCONSIN 53201.

Applicant hereby contests and answers the numbered allegations in the Notice of Opposition, as follows.

(1) Applicant's mark depicted above is prohibited from registration under Section 2(d) of the Federal Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1052(d), because it is likely to be confused with one or more of the marks depicted in the following United States registrations owned by Opposer and duly registered on the Principal Register of the Patent and Trademark Office (PTO).

Opposer's Marks

Reg. No.	Mark	Goods/Services & Date of First Use
U.S. Reg. No. 2,457,968, Registered 6/5/2001	TALENT PLUS	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 5/0/2000)

Reg. No.	Mark	Goods/Services & Date of First Use
U.S. Reg. No. 1,694,765 Registered 6/16/1992	TALENT+	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 7/17/1989)
U.S. Reg. No. 2,643,789 Registered 10/29/2002	TALENTBANK	Computer programs used by employers for monitoring and evaluating the performance of employees, in Class 9 (first use September 2001)
U.S. Reg. No. 2,551,962 Registered 3/26/2002	TALENT INTENSITY INDEX	Employment consulting services, namely, evaluating employees and prospective employees, in Class 35 (first use 1/1/1991)
U.S. Reg. No. 2,492,575 Registered 9/25/2001	TALENT CARD	Certificates recognizing employee qualities and achievements, in Class 16 (first use 1/1/1990)
U.S. Reg. No. 2,682,377 Registered 2/4/2003	TALENTFIT	Employee recruiting services, namely, assisting in evaluating the prospective employees, in Class 35 (first use 1998)
U.S. Reg. No. 2,642,089 Registered 10/29/2002	TALENT PREDICTION	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,624,108 Registered 9/24/2002	TALENT PROFILE	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,032,573 Registered 1/21/1997	TALENT ONLINE	Employment recruiting services, in Class 35 (first use 9/1/1995)
U.S. Reg. No. 2,638,760 Registered 10/22/2002	TALENT GRAPH	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 1989)
U.S. Reg. No. 2,726,929 Registered 10/22/2002	TALENT+ MASTER TRAINER	Business personnel consultation, namely, developing and providing employers with methods and procedures to identify productive current and prospective employees, in Class 35 (first use 1989)

Answer:

Applicant denies that there is a likelihood of confusion between any of the marks asserted above. Otherwise, Applicant is without knowledge or information sufficient to form a belief as to the truth of these remaining allegations.

(2) In addition to the United States registrations owned by Opposer pleaded above, Opposer has common law rights in the "TALENT" mark represented by the following application currently pending at the PTO:

Applic. No.	Mark	Goods/Services & Date of First Use
U.S. App. Ser. No. 76/492,177, filed 2/24/2003	TALENT+ VIEWPOINT	Business management, personnel and human resources consulting services, namely, development and application of propriety structured processes, validated questionnaires and instruments for psychometric testing; development and support of related software; and associated personnel services, in Class 35 (first use 3/5/2001)

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Description of Opposer

(3) Opposer is a consultant to businesses across the United States in the field of psychometrics – the use of validated testing instruments to identify personal traits that lead to success in specific jobs.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

(4) Since its incorporation in 1989, Opposer has invested substantially in the development of a family of marks that link the word "Talent" with another word, e.g., TALENT PLUS, TALENT+, TALENTBANK, TALENT BENCHMARK, TALENT INTENSITY INDEX, TALENT CARD, TALENTFIT, TALENT PREDICTION, TALENT PROFILE, TALENT ONLINE, TALENT GRAPH, TALENT+ MASTER TRAINER, and TALENT+ VIEWPOINT, as depicted in Paragraphs 1 and 2 above.

Answer:

Applicant denies these allegations.

(5) Since adopting its "TALENT" marks, Opposer has made substantial, continuous and exclusive use of those marks in sales to business corporations, associations, executives, and human resources professionals in the specialized market for the development and application of propriety structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

(6) Opposer currently has approximately 65 employees engaged in the specialized services described above and annual revenues of around \$8 million.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

(7) In its specialized filed, Opposer's "TALENT" marks have acquired secondary meaning and are familiar to the purchasing public in that they identify Opposer as the source of products and services offered under Opposer's family of "TALENT" marks.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Acquired Secondary Meaning of Opposer's "TALENT" Marks

(8) Opposer's "TALENT" marks may be described as "suggestive" of Opposer's goods and services within the meaning of the trademark law, as they connote a quality, ingredient, or characteristic of Opposer's goods and services. However, they are not descriptive, because imagination is required to reach a conclusion as to the actual goods and services or to connect the marks with the goods and services. A person without knowledge of Opposer's products and services would not likely know that Opposer is exclusively engaged in the specialized market for the development and application of propriety structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services. Opposer's "TALENT" marks are "suggestive" because they conjure up images of Opposer's products and services without actually describing them.

Answer:

Applicant denies these allegations.

(9) While Opposer's "TALENT" marks may be suggestive on their face, as a family of marks they have acquired secondary meaning as the result of many years of use, advertising and promotion. As a result of such use, advertising and promotion, Opposer and its "TALENT" marks are well known in the market for the services offered by Opposer.

Answer:

Applicant denies these allegations.

PTO Recognition of Secondary Meaning in Opposer's Marks

(10) The PTO has recognized the acquired secondary meaning associated with the word "TALENT" as used in Opposer's marks. Specifically, the PTO has registered the following marks of Opposer pursuant to Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), based on a finding that the word "TALENT" has acquired distinction as used in connection with Opposer's goods and services:

- **TALENT GRAPH**, U.S. Reg. No. 2,638,760, Oct. 22, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989);
- **TALENT PREDICTION**, U.S. Reg. No. 2,642,089, Oct. 29, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989);
- **TALENT PROFILE**, U.S. Reg. No. 2,624,108, Sept. 24, 2002, for business personnel consultation, namely, developing and providing employers with methods and procedures to assess and develop productive current and prospective employees, in Class 35 (first use 1989);
- **TALENT BENCHMARK**, U.S. Reg. No. 2,716,938, registered May, 2003, for employment consulting services, namely evaluating employees and prospective employees, in Class 35 (first use 1991).

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Incontestability

(11) Opposer's registrations for TALENT ONLINE, U.S. Reg. No. 2,032,573, registered Jan. 21, 1997, and TALENT+, U.S. Reg. No. 1,694,765, registered June 16, 1992, are "incontestable" under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and constitute conclusive evidence of the validity of the registered marks pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Enforcement History

(12) Opposer has consistently and vigorously enforced its rights in the "TALENT" marks alleged in this Notice of Opposition by protesting against confusingly similar uses by third parties. In 2000, Opposer filed a suit that led to a third party's agreement to terminate its use of the name "TalentPoint." In addition, Opposer is presently prosecuting a federal trademark infringement action involving Opposer's family of "TALENT" marks.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Overlapping Recitations

(13) The recitation in the opposed application is drawn in a manner that could be interpreted to encompass the development and application of propriety structured interview processes, validated questionnaires and testing instruments, supporting software and related personnel services, in which Opposer's family of "TALENT" marks is especially well known. As the recitation in the opposed application is not limited to exclude that possibility, registration of Applicant's mark would allow Applicant to compete directly with Opposer in the specialized market where Opposer's family of "TALENT" marks is especially well known.

Answer:

Applicant is without knowledge or information sufficient to form a belief as to the truth of these allegations.

Conclusion

(14) Applicant's proposed mark so resembles Opposer's family of "TALENT" marks in appearance, sound, connotation and commercial impression as to be likely, when applied to Applicant's goods and services, to cause confusion, mistake and/or deception. Registration of Applicant's mark is therefore prohibited under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and would be damaging to Opposer's exclusive rights in its registered and unregistered marks pleaded above.

Answer:

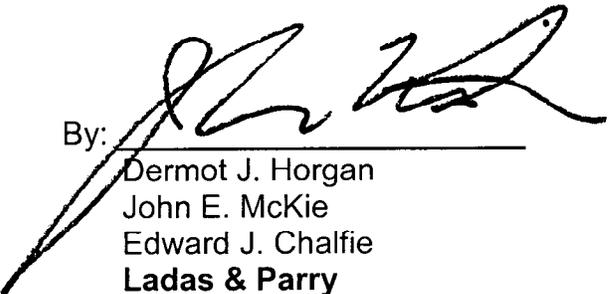
Applicant denies these allegations.

Prayer for Relief

WHEREFORE, Manpower Inc. requests that this Honorable Board to issue judgment denying and dismissing the subject Opposition, allowing the subject application for TALENTPORT to proceed to allowance.

Respectfully submitted,

MANPOWER, INC.

By: 

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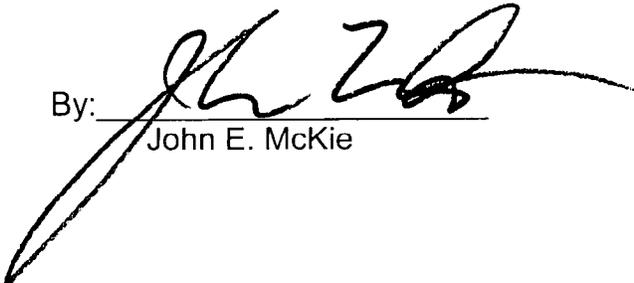
(312) 427-1300

Dated: February 10, 2004.

Certificate of Service

The undersigned hereby certifies that a copy of the foregoing Answer to Notice of Opposition has been served upon the attorney for the Opposer on this 10th day of February, 2004, by depositing the same in the United States Mail, first class postage prepaid, in an envelope addressed as follows:

Mr. Bruce A. McDonald
Wiley Rein & Fielding LLP
1776 K Street, N.W. Washington, D.C.
20006

By: 
John E. McKie

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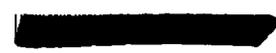
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February 10, 2004

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2900 Crystal Drive
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02-13-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Re: Answer to Notice of Opposition
Talent Plus, Inc. v. Manpower, Inc.
Opposition No: 91158324
Against Appln. SN: 78/144217
Mark: **TALENTPORT**

Dear Madam:

Please find for filing the enclosed:

1. Answer to Notice of Opposition
2. Certificate of Service
3. Return-receipt postcard.

Please affix your stamp to the postcard to indicate the date of receipt, and return it to us.

Very truly yours,

JOHN E. MCKIE

Enclosures: as recited above

JEM/kmz

S:/KatherineZ/letters.1/TALENTPORT 2-10-04

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box TTAB NO FEE Commissioner of Trademarks 2900 Crystal Drive, Arlington, Virginia 22202-3513 on February 10, 2004.

John E. McKie