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07/25/2003TTAB

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

In the Matter of Application Serial No. 76/077,426
Published in the Official Gazette on April 15, 2003



07-14-2003

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

PAUL J. BERUBE,

*

Opposer,

*

v.

*

Opposition No.: _____

BENESIGHT, INC.,

*

Applicant.

*

BOX TTAB FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

"Express Mail" Label No. ER 240613885 US
Date of Deposit: July 14, 2003

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.10

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Box TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Date of Signature: 7-14-03


James A. Hinkle
Attorney for Applicant

NOTICE OF OPPOSITION

PAUL J. BERUBE, an individual, (hereinafter referred to as "Opposer") believes he will be damaged by registration of the mark shown in Serial No. 76/077,426 in International Classes 036 and hereby opposes the same.

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As grounds of opposition, it is alleged that:

1.

BENSIGHT, INC., a corporation organized and existing under the laws of the State of Delaware, (hereinafter referred to as "Applicant") seeks to register BENESIGHT as a trademark for providing benefit administration services to employers, members, benefit consultants and healthcare providers, namely, design, implementation and administration of group health and insurance plans, namely, medical, dental, flexible benefit, vision, short term disability, prescription drug, employee assistance, Cobra, HIPAA, managed care, medication utilization management and stop-loss insurance, and funding and benefit reporting services; insurance claims administration; insurance claims processing; insurance claims adjudication; insurance consultation, namely, consultation in the field of insurance plans; providing online administration of and participation in group health and insurance plans for employers, members, benefit consultants and providers by means of a global computer information network in International Class 036. Applicant claims a first use date of at least as early as August 1, 2000, and a use in commerce at least as early as August 1, 2000, as evidenced by the publication of said mark in the Official Gazette on April 15, 2003.

2.

The Opposer has used the mark BENESCRIP since July 1, 1990, on employee benefit plans and administrative services in International Class 036. Opposer is submitting herewith, as part hereof and marked as Exhibit "A", a copy of U.S. Registration No. 2,396,009 registered on October 17, 2000, covering said mark.

3.

There is no issue as to priority. The Applicant's date of first use is subsequent to Opposer's first use and subsequent to Opposer's application filing date.

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4.

Opposer has sold his services listed in the aforesaid registration under the aforesaid mark as herein before referred to throughout the United States. Opposer has developed an exceedingly valuable goodwill and respect to the mark covered by the aforesaid registration.

5.

By virtue of his efforts and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of his products, the Opposer has gained a most valuable reputation for his above identified mark.

6.

The trademark proposed for the registration by the Applicant, namely, BENESIGHT, is substantially incorporated in its entirety in Opposer's mark BENESCRIP and is applied to the identical services as those sold by Opposer, and so nearly resembles the Opposer's mark as to be likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer's mark so as to cause confusion and lead to deception as to the origin of Applicant's services bearing the Applicant's mark.

7.

If the Applicant is permitted to use and register its mark for its services as specified in the application herein opposed, confusion and trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's mark and the Opposer's mark. Persons familiar with Opposer's mark would be likely to buy Applicant's services as for a service sold by the Opposer. Such confusion and trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's services marketed under its mark would necessarily reflect upon and seriously injury the reputation which the Opposer's has established for his services merchandised under his mark.

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8.

If the Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

WHEREFORE, the Opposer prays that the U.S. Application Serial No. 76/077,426 be rejected and that the mark therein sought for the services specified in International Class 036 be denied and refused.

Opposer hereby gives notice under Rule 2.122(d) of the Rule of Practice that after hearing and any appeal of this opposition proceeding it will rely on its registration which is annexed as Exhibit "A" to this Notice Of Opposition as evidence in support of this Notice Of Opposition.

A duplicate copy of this Notice Of Opposition and the fee required in Section 2.6a(17) are enclosed herewith.

Respectfully submitted,

PAUL J. BERUBE, Opposer



by James A. Hinkle
Attorney for Opposer
Registration No. 22,221

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Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,396,009

United States Patent and Trademark Office

Registered Oct. 17, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

BENESCRIP

BERUBE, PAUL J. (UNITED STATES CITIZEN)
3300 HOLCOMB BRIDGE ROAD
SUITE 228
NORCROSS, GA 30092

FIRST USE 7-1-1990; IN COMMERCE 7-1-1990.

SER. NO. 75-865,941, FILED 12-7-1999.

ROGER BORA, EXAMINING ATTORNEY

FOR: EMPLOYEE BENEFIT PLANS ADMINISTRATIVE SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

EXHIBIT A