

TTAB

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

PAUL J. BERUBE,)
)
 Opposer,)
)
 v.)
)
 BENESIGHT, INC.,)
)
 Applicant.)
 _____)



02-09-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

Opposition No.: 91158878

<p>Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3514 BOX TTAB FEE</p>	<p>CERTIFICATE OF FIRST CLASS MAILING 37 CFR 2.197</p> <p>I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage paid, in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 BOX TTAB FEE on January 30, 2004.</p> <p><i>Susan J. Anderson</i> Susan J. Anderson</p>	
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APPLICANT'S ANSWER TO OPPOSITION AND COUNTERCLAIM

Applicant Benesight, Inc. (hereinafter "Applicant"), a Delaware Corporation, having its principal place of business at 708 East Lake Street, Wayzata, Minnesota 55391, applicant in United States Application Serial No. 76/077,426, by and through its attorneys, hereby answers the allegation set for in the Notice of Opposition filed by Paul J. Berube (hereinafter "Opposer") as follows:

1. Answering paragraph 1 of the Notice of Opposition: Applicant admits the allegations thereof.

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2. Answering paragraph 2 of the Notice of Opposition: Applicant does not have sufficient knowledge or information to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations. Applicant notes that Exhibit "A" does appear to be a copy of a service mark registration.

3. Answering paragraph 3 of the Notice of Opposition: Applicant has no knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.

4. Answering paragraph 4 of the Notice of Opposition: Applicant has no knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.

5. Answering paragraph 5 of the Notice of Opposition: Applicant has no knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and accordingly denies the allegations.

6. Answering paragraph 6 of the Notice of Opposition: Applicant denies each and every allegation contained therein.

7. Answering paragraph 7 of the Notice of Opposition: Applicant denies each and every allegation contained therein.

8. Answering paragraph 8 of the Notice of Opposition: Applicant denies each and every allegation contained therein, although Applicant admits that obtaining registration of the mark BENESIGHT would grant Applicant a *prima facie* exclusive right to use of BENESIGHT.

AFFIRMATIVE DEFENSES

No Likelihood of Confusion

9. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded mark of the Opposer are not confusingly similar.

10. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark is not confusingly similar to the pleaded mark of Opposer. On information and belief, Opposer's pleaded mark is used to identify Opposer's business, a pharmacy benefit management company, offering services which are different in nature from Applicant's benefits administration services. Applicant's and Opposer's services are sold to separate, different and distinct customers, through different channels of trade.

11. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark is not confusingly similar to the pleaded mark of Opposer. Any similarity, if at all, between Applicant's mark and the pleaded mark of Opposer is in the prefix "bene" which, on information and belief, has been used and registered as a component of numerous marks by numerous third parties in the benefits administration industry. As a result, Opposer cannot base a claim of likelihood of confusion between its pleaded mark and Applicant's mark on the common use of the prefix "bene." The remaining portions of Applicant's and Opposer's marks, and the marks when compared in their entirety are not confusingly similar.

12. Applicant's and Opposer's marks do not look alike, sound alike or have any similarity in meaning sufficient to cause any reasonable likelihood of confusion, mistake, or deception as to the origin of Applicant's or Opposer's services.

Descriptive Mark

13. Opposer's mark is descriptive because, *inter alia*, the suffix of the mark, "script," is descriptive of Opposer's services. On information and belief, Opposer is in the business of

providing pharmacy benefit management services, which coordinate payment of prescription drugs between health insurance plans and pharmacies. On information and belief, it is common in the pharmacy industry to refer to a prescription as a "script." Accordingly, Opposer's mark, BENESCRIP, is descriptive as a whole, being a combination of two descriptive terms, and the mark is therefore not entitled to trademark protection and cannot be asserted to prevent registration of Applicant's mark.

COUNTERCLAIM FOR CANCELLATION

As and for its Counterclaim against Opposer, Applicant alleges as follows:

1. Applicant has adopted and continuously used the mark BENESIGHT since at least as early as August 1, 2000 to the present, in connection with 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, medical 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, and other related goods and services in International Class 36.

2. Applicant has applied for registration of the mark BENESIGHT, Serial No. 76/077,426, for goods and services as described *supra* in paragraph 1 of this Counterclaim.

3. Registration No. 2,396,009, sought to be cancelled, is for the mark BENESCRIP, registered for use on employee benefit plans administration services, and is owned by Opposer.

4. On information and belief, Opposer uses the mark BENESCRIP to identify his business, a pharmacy benefit management company that coordinates the payment of prescription drug purchases between pharmacies and consumers' health insurance plans.

5. On information and belief, Opposer makes no other use of the mark BENESCRIP, except as described *supra* in paragraph 4 of this Counterclaim, and Opposer has no intent to use this mark for any other purpose.

6. On information and belief, the term "script", as used in Registration No. 2,396,009, is a general descriptive reference for the term prescription, as used in the pharmaceutical industry.

7. Pursuant to 15 U.S.C. § 1052(e) a descriptive mark is not registrable. Opposer's mark consists of a combination of the descriptive prefix "bene," referring to "benefits," and the descriptive term "script," referring to prescriptions. Opposer's mark as a whole is merely descriptive of Opposer's services, and therefore, Opposer's mark should be cancelled. In the alternative, Opposer's registration should be restricted to those services with which Opposer actually uses the mark, namely, the provision of pharmacy benefit management services.

WHEREFORE, having duly answered the Notice of Opposition filed against them, Applicant requests the following relief:

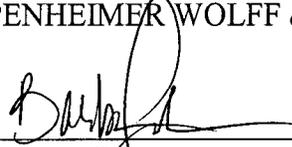
1. Opposer's Opposition No. 91158878 for rejection of Application Serial No. 76/077,426 be denied in all respects, and registration of the mark BENESIGHT be granted; and

2. Applicant's counterclaim seeking to cancel, or in the alternative restrict, Registration No. 2,396,009 be granted.

The Trademark Trial and Appeal Board is authorized to charge the filing fee of \$300.00 for this Petition to Cancel in the form of a counterclaim, and any other fees that may be due, to deposit account No. 50-1901.

Respectfully submitted,

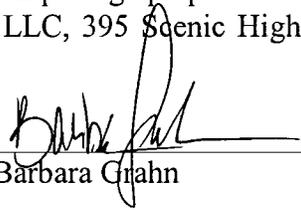
BENESIGHT, INC.
by its Attorneys
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CERTIFICATE OF SERVICE

One copy of the foregoing APPLICANT'S ANSWER TO OPPOSITION AND COUNTERCLAIM has been mailed by first class mail postage prepaid this 30th day of January, 2004, to James A. Hinkle, Hinkle & O'Bradovich, LLC, 395 Scenic Highway, Lawrenceville, Georgia 30045.


Barbara Grahn