

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION

In re Application of:

Riskwise.com, L.L.C.

Serial No.: 76/007,040

Filed: March 22, 2000

Mark: CHARGEBACK DEFENDER

International Class 36

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Law Office 104

Trademark Attorney:  
Catherine Pace Cain, Esq.

**NOTICE OF APPEAL**  
**AND**  
**REQUEST FOR REMAND**

Applicant hereby appeals from the Examining Attorney's refusal to register the mark CHARGEBACK DEFENDER. Applicant also requests that the Board stay this Appeal and remand the case to the Examining Attorney for reconsideration of the refusal to register based on the attached Request for Reconsideration and evidence.

Respectfully submitted,

Riskwise.com, LLC

Dated: 11-25-02

By: Carla C. Calcagno  
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**REQUEST FOR RECONSIDERATION**

AMENDMENT

Please amend the identification of services to read in its entirety:

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Credit verification and risk assessment services, namely providing information to Internet merchants at point of sale on the likelihood of a credit card transaction being charged back to the merchant, in IC 36.

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INTRODUCTION

Applicant has amended its description of services to make clear that its services are offered only to Internet merchants. Applicant also hereby makes of record approximately 14 federal registrations and applications and common law references for the term DEFENDER and variations thereof. All these registrations and applications relate to the financial services field. See Exhibit A attached.

Applicant respectfully requests that the Examining Attorney reconsider the refusal to register in light of the amended description of services and the additional evidence of record. Applicant offers its services only to "Internet merchants." Registrant offers its services only to

“credit card issuers.” Thus, Applicant’s customers and the Registrant’s customers differ. Moreover, Applicant clearly has established the weakness of the term DEFENDER in the Registrant’s field.

### ARGUMENT

Applicant has made of record both dictionary definitions and 14 third party registrations and applications and common law references that unquestionably show that “defender” is highly suggestive in the Registrant’s field. To show that a mark is suggestive, rather than arbitrary, in an examination proceeding, an Applicant may rely on dictionary definitions. Additionally, in a series of cases, the Board has accepted evidence of anywhere from 3-10 third party registrations and applications as evidence that a term is suggestive in a particular field. *See e.g., In re Professional Systems Corporation*, 2001 TTAB LEXIS 681 (September 17, 2001) [four third party registrations evidence that DATA EXPRESS is weak]; and *In re Iberia Lineas Aero de Espana, S.A.* 2001 TTAB LEXIS 634 (TTAB 2001) [ten third party registrations evidence that INTERCONTINENTAL is weak.] Thus, the additional evidence Applicant has submitted in this case overwhelmingly shows that Registrant does not possess exclusive rights to the term DEFENDER in its field.

As a highly suggestive term, DEFENDER alone cannot form the basis for a refusal to register. *See, e.g., In re Social Work P.R.N.*, 2002 TTAB LEXIS 661 (October 10, 2002) [SOCIAL WORK P.R.N. not likely to cause confusion with NURSES P.R.N. or P.R.N. for temporary employment services, because of the highly suggestive nature of P.R.N. and despite the descriptive nature of “social work” and “nurses”]; *In re Charter Communications Holding Company, LLC*, 2002 TTAB LEXIS 501 (July 31, 2002) [CHARTER MEDIA not likely to cause confusion with CHARTER GROUP for advertising services, because of weak nature of CHARTER and despite disclaimer of “group” and “media”]; and *In re Flexible Resources Inc.*, 2001 TTAB LEXIS 761 (October 29, 2001) [FLEXIBLE RESOURCES not likely to cause confusion with FLEXIBLE PERSONNEL for employment recruitment services, because of highly suggestive nature of FLEXIBLE and despite descriptive nature of “resources” and

“personnel”]. Copies of these opinions are attached. Notably, in each of these cases cited above, the common suggestive portion of the marks was combined with descriptive matter. *Id.* Nonetheless, the descriptive portions of the mark distinguished the marks’ commercial impressions. Thus, the mere fact that the additional matter in the marks is descriptive is not sufficient, as the Examining Attorney appears to contend, to render that matter unimportant.

Overall, the marks BANKRUPTCY DEFENDER, COLLECTIONS DEFENDER and ATTRITION DEFENDER neither look the same, nor sound the same, nor have the equivalent meaning as CHARGEBACK DEFENDER. While the Examiner has stressed the similarity of the marks, given the weakness of the term DEFENDER, and the sophistication of the differing purchasers, the marks’ dissimilarities are of particular significance. Though they share the same last word, CHARGEBACK DEFENDER, ATTRITION DEFENDER, COLLECTIONS DEFENDER, and BANKRUPTCY DEFENDER are pronounced differently. In addition they look different and the connotations differ. In this regard, this case is directly on point with *In re Flexible Resources Inc., supra*, where the Board stated in reversing the refusal to register:

... We find the dissimilarities of the marks of particular significance. FLEXIBLE PERSONNEL and FLEXIBLE RESOURCES, though they share the same first word are pronounced differently. In addition, they look different, particularly when Applicant’ s mark FLEXIBLE RESOURCES and design is considered. The connotation of FLEXIBLE PERSONNEL is quite specific. The connotation of FLEXIBLE RESOURCES is quite different.

Furthermore, as the Board consistently makes clear, the first word of a mark often creates the most significant impression on the consumer even when that term is merely descriptive. *See e.g., In re Iberia Lineas Aero de Espana, S.A.* 2001 TTAB LEXIS 634 (TTAB 2001) [Holding “BUSINESS” to be dominant portion of the mark BUSINESS INTERCONTINENTAL, despite descriptiveness of the term, because it appeared first, among other things].

Finally, Applicant and the Registrant do not sell their products to the same customers. Registrant offers its services to credit card companies. Applicant offers its services to Internet merchants. Thus, the parties' customers specifically differ.

Moreover, both parties' customers are by their nature professional purchasing agents, and therefore sophisticated. Such sophisticated purchasers should be able to distinguish between the marks and moreover use care in determining that the services are NOT provided by the same source. Such purchasers will know that Registrant's services provided to credit card issuers, such as Mastercard, are not the same as those provided to Internet merchants. Further, in light of the thirteen parties using DEFENDER in the same field as Registrant, such sophisticated purchasers will not assume that any mark including the term DEFENDER denotes the same source. Under such circumstances, confusion simply is unlikely to occur. *See e.g. In re Professional Systems Corporation*, 2001 TTAB LEXIS 681 (September 17, 2001) [holding that billing services are offered to sophisticated purchasers able to distinguish between suggestive marks] A copy of this decision is attached.

Wherefore, Applicant respectfully requests that the Examining Attorney reconsider and withdraw her refusal to register. If not, Applicant respectfully requests an interview with the Examining Attorney to discuss this further. Overall, the marks neither look the same, nor sound the same, nor present the same connotation. The sole common portion of the mark is not arbitrary and is, in fact, highly suggestive. Based therefore on the evidence of record, the cited marks are entitled to a very narrow scope of protection. The parties' services differ and are offered to different customers. These customers are highly sophisticated. Under the circumstances, *all* the *Dupont* factors weigh in Applicant's favor and Applicant respectfully requests that the Examining Attorney reconsider and withdraw her refusal to register. Together with this Request, Applicant attaches a Notice of Appeal and Request for Remand and the required fees.

Respectfully submitted,

Riskwise.com, LLC

Dated: 11-25-02

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