

TTAB

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

WELLPOINT HEALTH NETWORKS, INC.)

Serial No. 76/445627)

Filed: August 30, 2002)

For: UNICARE COMPLETECHOICE)
HEALTHFUND)



05-10-2004

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

The Assistant Commissioner for Trademarks
TTAB - FEE
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF APPEAL FILED WITH REQUEST FOR RECONSIDERATION

Applicant hereby appeals to the Trademark Trial and Appeal Board from the final decision of the Examining Attorney. Applicant notes that it has also filed a Request for Reconsideration herewith and requests restoration of jurisdiction to the Examining Attorney. Any deficiency in the attached filing fee should be charged to our Deposit Account No. 02-2666

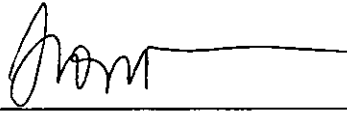
Respectfully submitted,

WELLPOINT HEALTH NETWORKS, INC.

05/11/2004 KGIBBONS 00000053 76445627

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by  5-7-04
Lori N. Boatright

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
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Los Angeles, California 90025
(310) 207-3800

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on 5-7-04

 5-7-04
Signature Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
WELLPOINT HEALTH NETWORKS, INC.)	EXAMINING ATTORNEY:
)	Robert Clark
)	
Serial No. 76/445627)	LAW OFFICE: 108
)	
Filed: August 30, 2002)	
)	
For: UNICARE COMPLETECHOICE)	
HEALTHFUND)	
_____)	

REQUEST FOR RECONSIDERATION FILED WITH NOTICE OF APPEAL

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Mr. Clark:

This letter is responsive to the outstanding Office Action dated November 7, 2003.

REMARKS

The only issue which remains is the misspelling on the drawing page, showing the mark UNICARE COMPLETECHOICE HEALTHFUND as originally reading UNICARE COMPLETECHIOCE HEALTHFUND (emphasis added). The Examining Attorney has held that a substitute drawing in which the correction of the misspelling of the component "CHOICE" constitutes a material alteration of the mark pursuant to 37 CFR Section 2.72(a).

First, a procedural issue must be addressed. While the original Office Action noted that the mark “has apparently been misspelled on the drawing page”, as an intent to use application there was no procedural basis for making a request or otherwise issuing a “refusal” (for example, there was no “inconsistency” with specimens). That said, Applicant responded to the Examining Attorney’s argument and the Examining Attorney has now “gone Final” even though there was no initial refusal – only a cautionary paragraph. Applicant questions the legitimacy of the Final, particularly in view of the Office Action heading advising Applicant that it has six months to respond to the Office Action. To maintain its rights, Applicant feels compelled to file a Notice of Appeal herewith but does not concede the legitimacy of the procedure.

Applicant believes that in any event the procedural error should be rendered moot when the facts and law are reviewed.

From the outset, it was the Examining Attorney himself who specifically noted “the misspelling” on the drawing page. Otherwise, the application would have proceeded to publication with the misspelling intact.

Moreover, in the Final refusal, the Examining Attorney argues that the reason why the substitute drawing showing the correct spelling is in fact a “material alteration” is:

“A search of the office records for ‘COMPLETECHIOCE’ would not reveal ‘COMPLETECHOICE’. Therefore, the requirement that applicant not amend the original drawing by materially altering it is continued and made Final.”

The Examining Attorney is incorrect as to the facts. As disclosed in Applicant’s prior response, the data entered into the TESS and TARR databases **from the outset of filing** shows the mark as correctly identified as COMPLETECHOICE without the misspelling (see attachments, Exhibits 1 and 2 to Response to First Office Action already of record). The records

of the U.S. Patent and Trademark Office and all private search companies use this data to conduct searches such that the “public” is already advised of the correct mark. As such, there can be no “material alteration” – in fact, should the Examining Attorney insist that the original misspelling be reinstated, only then will the public be misled – even the PTO Office Actions reflect the correct spelling – and have from the initial Office Action and before! Applicant maintains this is truly inconsistent with the intent and spirit of the law. Only if the Examining Attorney requires that all PTO records be changed to reflect a misspelling would the public be deceived – and no purpose is served to anyone, particularly Applicant. Presumably, the Examining Attorney searched the mark in a way such that no further search of Trademark Office records would be required from the Examining Attorney.

The Examining Attorney in the initial refusal stated that even a misspelling is the subject of a material alteration refusal is warranted under case law, citing *In re Tetrafluor Inc.*, 17 USPQ 2nd 1160 (TTAB 1990) to stand for the proposition. In that case, an applicant petitioned the Commissioner to allow an amendment to the mark which was originally applied for as SEALS to reflect the mark DITHERSEAL. The Commissioner denied the petition but discussed the issue of material alteration. The primary concern of the petitioner in refusing the petition to amend the drawing was: "properly based upon consideration of the public, who may have relied to its detriment on the absence within the PTO record of pending applications of notice of an application to register the mark DITHERSEAL." *Id.* at 1162.

The public would not have relied to its detriment in the subject application for reasons discussed, namely that the records already reflect the proper mark. When the data entry clerk at the PTO and the Examining Attorney properly enter the correctly spelled mark into the database, it would require negative acts of the most ridiculous kind of bureaucracy to go back and reenter the incorrect spelling so as to justify this refusal.

The Examining Attorney is within his authority to accept the substitute drawing – by both logic and by law. See *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) (TTAB reversed the Examining Attorney’s position that NEW YORK JEWELRY OUTLET was a material alteration of NY JEWELRY OUTLET). See also *In re Larios S.A.*, 35 USPQ2d 1214 (TTAB 1995) (“VINO DE MALAGA LARIOS” and design was held **not** a material alteration of “GRAN VINO MALAGA LARIOS” with similar design).

Finally, the Examining Attorney is within his rights to accept the new drawing per TMEP Section 807.14(a), which states:

“The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.”

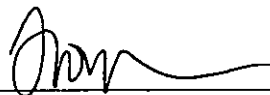
In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740,743-44 (TTAB 1983).

In this case, one viewing the Office record respecting this mark already knows the correct mark – to allow the amendment will only maintain that record and not materially alter any part of the mark

Applicant respectfully requests the Examining Attorney accept the substitute drawing (which requires no action by the data entry clerk as the records already reflect the correct spelling and have since the original filing – see original filing receipt attached hereto) and pass the mark to publication in the Official Gazette at his earliest possible convenience. If the Examining Attorney has any questions, he is urged to telephone the undersigned attorney.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

Dated: MAY 7 04 By: 
Lori N. Boatright

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FILING RECEIPT FOR TRADEMARK APPLICATION

Sep 24, 2002

Receipt on the DATE OF FILING of the application for registration and filing fees is acknowledged for the mark identified below. The DATE OF FILING is contingent upon the collection of any payment made by check or draft. Your application will be considered in the order in which it was received and you will be notified as to the examination thereof. Action on the merits should be expected from the Patent and Trademark Office in approximately 06 months from the filing date. When inquiring about this application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME, and MARK.

MICHAEL W. HICKS
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12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
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ATTORNEY
REFERENCE NUMBER
002396.T049

LAB

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Preexamination File Receipt Section. Or fax a request to 703-308-9096. The Patent and Trademark Office will review the request and make corrections when appropriate.

ENTERED

SEP 27 2002

STATUS DB-LA

RECEIVED
SEP 27 2002

SERIAL NUMBER: 76/445627
FILING DATE: Aug 30, 2002
REGISTER: Principal
LAW OFFICE: 108

MARK: UNICARE COMPLETECHOICE HEALTHFUND

MARK TYPE(S): Service Mark
DRAWING TYPE: Words, letters, or numbers in typed form
FILING BASIS: Sect. 1(b) (Intent to Use)

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
LOS ANGELES

ATTORNEY: Michael W. Hicks

OWNER: WellPoint Health Networks, Inc. (DELAWARE, Corporation)
1 Wellpoint Way
Thousand Oaks, CALIFORNIA 91362

FOR: health insurance services
INT. CLASS: 036

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED