

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/445627

3.8.06

APPLICANT: WellPoint Health Networks, Inc.

\*76445627\*

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CORRESPONDENT'S REFERENCE/DOCKET NO: 002396.T049

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CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

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Applicant is requesting reconsideration of a final refusal dated May 10, 2004.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. This application will be returned to the Board for resumption of the appeal. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

In this case, applicant's mark on the drawing is unequivocally for the letters COMPLETECHIOCE.

In *In re Who? Vision Systems Inc.*, 57 USPQ2d 1211, 1217-18 (TTAB 2000) the Board decided whether applicant's proposed amendment of its mark from TACILESENSE to TACTILESENSE would be a material alteration prohibited under amended Trademark Rule 2.72(b) (2).

The Board stated that the test for determining whether an amendment is a material alteration was articulated in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983): "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." 220 USPQ at 743. "That is, the new and old forms of the mark must create essentially the same commercial impression." *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988).

The Board held as follows:

We find that the proposed amendment of applicant's mark from TACILESENSE to TACTILESENSE would be a material alteration of the mark. As applied to the goods identified in the application, i.e., "fingerprint imaging systems, namely fingerprint image generator, image sensor, and image processor," TACTILESENSE and TACILESENSE have distinctly different commercial impressions.

TACTILESENSE is a composite of two actual words, each of which has suggestive significance in relation to the other and as applied to the goods. "Tactile" is defined as "perceptible by touch" and "of or relating to the sense of touch." Webster's Ninth New Collegiate Dictionary (1990) at 1201. "Sense" is defined, inter alia, as "the faculty of perceiving by means of sense organs" and "a specialized animal function or mechanism (as sight, hearing, smell, taste, or touch) basically involving a stimulus and a sense organ." *Id.* at 1071. Together, the words "tactile" and "sense" create a connotation suggesting the sense of touch, a commercial impression which is reinforced by the very nature of applicant's goods. By contrast, no such connotation is created by the mark TACILESENSE. "Tactile" is not a word at all, and its meaninglessness is not alleviated by combining it with the word "sense." Nor does the composite TACILESENSE have any recognizable meaning, either in itself or in relation to the goods. Whatever connotation TACILESENSE might have, it certainly does not have the same distinctive connotation, as applied to the goods, that TACTILESENSE has.

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