

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76710584
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (current)	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	DEFINITY COMMUNITY
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
MARK SECTION (proposed)	
MARK	DEFINITY COMMUNITY
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	DEFINITY COMMUNITY
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_66289810-154628665_._DefinityAmendmentRemarks.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\767\105\76710584\xml3\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\767\105\76710584\xml3\RFR0004.JPG

	\\TICRS\EXPORT16\IMAGEOUT16\767\105\76710584\xml3\RFR0005.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\767\105\76710584\xml3\RFR0006.JPG
DESCRIPTION OF EVIDENCE FILE	See attached.
GOODS AND/OR SERVICES SECTION (035)(current)	
INTERNATIONAL CLASS	035
DESCRIPTION	
Conducting employee incentive award programs directed to eye care practitioners to promote on the job quality and productivity; providing innovative business building tools that are used to take better care of your patients and your practice, including automate appointment scheduling and confirmation using email and text messaging, enhancing on-line reputation with certified reviews, connecting with patents through target and customized promotions, newsletters, tracking results and revenue from all communications and on-line marketing efforts to provide real-time visibility into the success of the practice	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (035)(proposed)	
INTERNATIONAL CLASS	035
TRACKED TEXT DESCRIPTION	
Conducting employee incentive award programs directed to eye care practitioners to promote on the job quality and productivity; Conducting employee incentive award programs for eyecare professionals who offer DEFINITY brand lenses to their patients to promote on the job quality and productivity; providing innovative business building tools that are used to take better care of your patients and your practice, including automate appointment scheduling and confirmation using email and text messaging, enhancing on-line reputation with certified reviews, connecting with patents through target and customized promotions, newsletters, tracking results and revenue from all communications and on-line marketing efforts to provide real-time visibility into the success of the practice	
FINAL DESCRIPTION	
Conducting employee incentive award programs for eyecare professionals who offer DEFINITY brand lenses to their patients to promote on the job quality and productivity	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (041)(current)	
INTERNATIONAL CLASS	041
DESCRIPTION	Team employment training services in the field of eye care
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (041)(proposed)	

INTERNATIONAL CLASS	041
TRACKED TEXT DESCRIPTION	
Team employment training services in the field of eye care; <u>Providing business training for eyecare professionals who offer DEFINITY brand lenses to their patients in the fields of business management, business operations, advertising, promotion and marketing</u>	
FINAL DESCRIPTION	
Providing business training for eyecare professionals who offer DEFINITY brand lenses to their patients in the fields of business management, business operations, advertising, promotion and marketing	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Kay Lyn Schwartz/
SIGNATORY'S NAME	Kay Lyn Schwartz
SIGNATORY'S POSITION	Attorney of Record
SIGNATORY'S PHONE NUMBER	2149994702
DATE SIGNED	07/02/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Jul 02 15:50:24 EDT 2013
TEAS STAMP	USPTO/RFR-66.28.98.10-201 30702155024262961-7671058 4-5003035dae29043c6498b3c a24d788118edb6f83140c5ece ca69aafa4886bfcaf0-N/A-N/ A-20130702154628665148

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **76710584** has been amended as follows:

MARK

Applicant proposes to amend the mark as follows:

Current: DEFINITY COMMUNITY (standard characters)

Proposed (USPTO generated image): DEFINITY COMMUNITY (Standard Characters, see [mark](#))

The mark consists of standard characters, without claim to any particular font, style, size, or color.

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of See attached. has been attached.

Original PDF file:

[evi_66289810-154628665_DefinityAmendmentRemarks.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for Conducting employee incentive award programs directed to eye care practitioners to promote on the job quality and productivity; providing innovative business building tools that are used to take better care of your patients and your practice, including automate appointment scheduling and confirmation using email and text messaging, enhancing on-line reputation with certified reviews, connecting with patients through target and customized promotions, newsletters, tracking results and revenue from all communications and on-line marketing efforts to provide real-time visibility into the success of the practice

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Conducting employee incentive award programs directed to eye care practitioners to promote on the job quality and productivity;~~ [Conducting employee incentive award programs for eyecare professionals who offer DEFINITY brand lenses to their patients to promote on the job quality and productivity;](#) ~~providing innovative business building tools that are used to take better care of your patients and your practice, including automate appointment scheduling and confirmation using email and text messaging, enhancing on-line reputation with certified reviews, connecting with patients through target and customized promotions, newsletters, tracking results and revenue from all communications and on-line marketing efforts to provide real-time visibility into the success of the practice~~

Class 035 for Conducting employee incentive award programs for eyecare professionals who offer DEFINITY brand lenses to their patients to promote on the job quality and productivity

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 041 for Team employment training services in the field of eye care

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Team employment training services in the field of eye care;~~ [Providing business training for eyecare professionals who offer DEFINITY brand lenses to their patients in the fields of business management, business operations, advertising, promotion and marketing](#)

Class 041 for Providing business training for eyecare professionals who offer DEFINITY brand lenses to their patients in the fields of business management, business operations, advertising, promotion and marketing

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Kay Lyn Schwartz/ Date: 07/02/2013

Signatory's Name: Kay Lyn Schwartz

Signatory's Position: Attorney of Record

Signatory's Phone Number: 2149994702

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76710584

Internet Transmission Date: Tue Jul 02 15:50:24 EDT 2013

TEAS Stamp: USPTO/RFR-66.28.98.10-201307021550242629
61-76710584-5003035dae29043c6498b3ca24d7
88118edb6f83140c5eeca69aafa4886bfcaf0-N
/A-N/A-20130702154628665148

DEFINITY COMMUNITY

AMENDMENT AND RESPONSE TO OFFICE ACTION**Amendment to Services**

In response to the Examiner's objection to the description of services as being indefinite, Applicant has amended the description of services and believes the service description, as amended, is proper and properly classified in Classes 35 and 41. Applicant also wishes to specifically point out that the services provided by Applicant are directed to eyecare professionals who offer DEFINITY lenses to their patients. As such, although Applicant believes that such recitation is unnecessary, Applicant has included the recitation "for eyecare professionals who offer DEFINITY brand lenses to their patients" in the description of services to help clarify the nature of Applicant's services. Further, as has been previously made of record, Applicant's parent company Essilor International is the owner of U.S. Reg. No. 3,372,820 for the trademark DEFINITY for "eyeglass lenses" and also is the owner of U.S. Reg. No. 4,292,506 for the trademark DEFINITY FAIRWAY for "optical lens; progressive optical lens; progressive optical lens for golfers; coated optical lens; optical lens with photochromic coating".

Section 2(d) Refusal – Likelihood of Confusion

Applicant maintains that there is no likelihood of confusion between Applicant's mark, when used with the identified services, and the marks of U.S. Reg. No. 3,220,451 for "DEFINITY" ("Reg. 1"), U.S. Reg. No. 3,356,989 for "DEFINITY HEALTH" ("Reg. 2"), U.S. Reg. No. 3,699,315 for "DEFINITY" ("Reg. 3"), and U.S. Reg. No. 3,696,446 for "DEFINITY PARTNERS" ("Reg. 4"). Applicant respectfully requests reconsideration and withdrawal of the Examining Attorney's rejection in light of the amendments made herein and comments below. Applicant incorporates herein its previous responses to the Section 2(d) refusal and additionally provides the following:

The Office makes no limitation as to its Section 2(d) rejection (based on 4 registrations) as to class, and in the absence of any limitation, the rejection appears to be based on each of the classes in each of the 4 registrations, cited against Applicant's services in Class 35 and 41.

The relevant services are different

Applicant respectfully submits that its specifically recited services, as amended, in both Class 35 and Class 41 are different from the services cited in each of the cited Registrations.

Reg. 1-3

As the Examining Attorney is aware, Reg. 1-3 are all owned by the same owner (or a related company) – United Health Group, a healthcare company that provides health care coverage and benefit services, as well as technology-enabled health services. See <http://www.unitedhealthgroup.com>. Reg. 1-3 relate to providing consumers with health care plans and information regarding health care providers, such as information about hospitals, insurers, and physicians. Applicant does not provide such services; rather, its services are provided to a defined group of eyecare professionals who are familiar with Applicant's parent company and its DEFINITY lens products, and are aimed at assisting such eyecare professionals with their practices.

Reg. 4 for "DEFINITY PARTNERS" is registered for on-site consulting and providing off-site seminars and training sessions in the fields of leadership, management and communications skills, personnel development and motivation, quality improvement and assurance, manufacturing efficiency, operating efficiency and profitability, and strategic planning. Applicant's service offerings are different and further, as stated above, are provided to an existing defined community of eyecare professionals familiar with DEFINITY brand lenses.

Applicant respectfully submits that none of the marks in Reg. 1-4 result in a likelihood of confusion with Applicant's mark.

The channels of trade/consumers are different, and the consumers are highly sophisticated

The channels of trade and the consumers of the cited Registrants' services and the Applicant's services are different. Further, the relevant purchasers are sophisticated. As the Examining Attorney is aware, likelihood of confusion is not found where the purchasers of the goods and services at issue are sophisticated. *M&G Electronics Sales Corp. v. Sony Kabushiki Kaisha*, 250 F. Supp. 29, 104 (E.D. N.Y. 2003). The consumers of the services at issue are predominantly businesses, who are sophisticated, discerning customers. A business (or individual) would be very discerning in selecting a health care provider (such as the owner of Reg. 1-3), or a general business consultant (such as the owner of Reg. 4) offering leadership training sessions, or sessions relating to public speaking, or sessions relating to strategic planning. Likewise the consumer of Applicant's services – eyecare professionals familiar with the DEFINITY brand of lens products – are discerning, and understand that Applicant's mark DEFINITY COMMUNITY relates to services provided to a defined group already having commonality among them in that they all provide DEFINITY lenses to their patients.

Further, the market for Applicant's services is distinctively different than the market for the cited Registrants' services. Applicant's services are offered only to specific customers who have an affiliation with Applicant or its parent company as a result of offering DEFINITY lenses to patients. Such services are not offered to the public at large. The market for each of the Registrants' services is different.

Clearly, the realities of the marketplace are such that the relevant consumers to which the very specialized services offered by the Applicant and Registrants under the respective marks would not in any way be confused.

CONCLUSION

It is incumbent upon the Examining Attorney to make the realistic appraisal of the likelihood of prospective purchasers being confused as to the source, origin or sponsorship of Applicant's services vis-à-vis those services of the cited registrations. The Applicant's mark and the cited marks, as well as the services offered by Applicant and services offered by Registrant, are not the same. Any potential confusion caused by any minor overlap of Applicant's services and the cited Registrants' services is de minimus. These factors as well as the other factors previously discussed in detail mitigate in favor of a finding that no likelihood of confusion exists and that the Applicant is entitled to registration of its mark.

Applicant respectfully requests reconsideration and withdrawal of the Examining Attorney's rejection under § 2(d) of the Lanham Act.

The present response is intended to fully address each of the issues raised by the Examining Attorney. Applicant's attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter. For the foregoing reasons, it appears that Applicant has complied with the outstanding requirements of the Examining Attorney and the present application is in condition for publication and such action is respectfully requested at the earliest possible date.

It is believed that no additional fee is due. If this is incorrect, the Commissioner is hereby authorized to charge any additional fees, which may be required by this paper to Deposit Account 070153.