

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
WellPoint Health Networks Inc.)	EXAMINING ATTORNEY:
)	
)	Melissa Shella
)	
Serial No. 78/395484)	Law Office 101
)	
Filed: April 2, 2004)	
)	
For: ARCUS)	
)	
_____)	

REQUEST FOR RECONSIDERATION FILED
CONTEMPORANEOUSLY WITH NOTICE OF APPEAL

BOX RESPONSES
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Ms. Shella:

This letter is responsive to the outstanding Office Action dated June 15, 2005.



AMENDMENT

12-27-2005

U.S. Patent & TMO/c/TM Mail RcptDt. #30

1. Please amend the recitation of services to read:

“computer hardware and communications server hardware and software for use in sensing and monitoring health and wellness; computer software used for drug safety management, namely, management and declaration of adverse event reactions including tracking and reporting safety issues related to the clinical trials for life science companies; computer software used for managing the data entry of safety issues, create a workflow to assist users in handling the issues, reference a product's overall safety from statistical, bureaucratic, and research perspective, and track all data; computer software used in the

management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom; computer software for insurance claim preparation and electronic submission, payment tracking and payment comparisons, management of medical and hospital data for regulatory compliance, managing managed care and capitation contracts with payor analysis, batch payment processing, collections, and referral authorization.”

2. Please amend the application to accept the drawing page attached.

REMARKS

Applicant has attached hereto an amended drawing page. No other informalities remain.

The only issue is the final refusal to register under Section 2(d) of the Lanham Act. Applicant respectfully requests that the Examining Attorney withdraw the refusal based on the arguments/amendments discussed more fully below.

Applicant appreciates that the Examining Attorney has withdrawn the refusal to register the mark based on likelihood of confusion with **ARKOSE** and **ARKOSE SECURING** and design. The Section 2(d) refusal is now solely based on likelihood of confusion between the proposed mark and **ARCUS** and **ARCUS DATA SECURITY** for a variety of document storage and inventory management services in two separate registrations, and **ARCIS** for “computer hardware for use in imaging documents, document management and archiving documents; computer software used in operating computer systems for imaging documents, document management and archiving

documents; software for use in storing, transmitting and receiving and organizing data relating to document management and archiving” owned by Siemens.

Applicant respectfully requests that the refusal to register based on ARCIS (U.S. Reg. No. 2277240) be withdrawn, or at the very least suspended, based on the fact that Registrant’s Section 8 was due on September 13, 2005 but has not to date been filed (based on information available to Applicant). See attachment from TARR web server. However, arguments below as to why the refusal should be withdrawn respecting the Iron Mountain registrations (U.S. Reg. Nos. 2616280 and 2673579) are likewise applicable to Reg. No. 2277240.

Applicant respectfully submits that it has amended its identification of goods so that there can be no mistake as to the distinctions between Applicant’s goods and Registrant Iron Mountain’s services (and Siemens’ goods). Specifically, Applicant has stricken from its identification of goods the following: **“computer software for medical and hospital business office administration and information management, including electronic and paper billing, patient information storage and retrieval, appointments management”**.

Applicant is still convinced that the deleted goods are not likely to cause confusion with either of the cited registrants’ marks due to distinctly different goods, services, and channels of trade. Applicant has made clear that Iron Mountain is in the business of document storage services; Applicant appreciates that the Examining Attorney cannot consider evidence that Iron Mountain no longer uses ARCUS or ARCUS DATA SECURITY but the evidence as to the nature of the business is helpful to view the context of the goods and services. Again, Applicant maintains that there is and was no direct overlap in the services of Applicant and Registrants but regardless, Applicant has

now eliminated any element of possible likelihood of confusion by deleting the goods which the Examining Attorney cited as arguably likely to overlap or result in confusion.

Clearly the Siemens' document management software appeared to be in far greater direct competition with Iron Mountain than Applicant is with either company. It appears clear that no one would believe that ARCUS for very distinct health and medical software – especially now that it excludes medical office functions – would be likely to cause confusion.

Applicant is also the owner of four co-pending applications, all for the identical mark ARCUS for various goods and services, each of which has been approved by the Examining Attorney and has been published for opposition (see attached). While each has goods and services different from those offered hereunder (for obvious reasons), this family of goods and services is the context in which the public will view the mark – and all are health and wellness related. The context in which the mark is viewed greatly impacts the commercial impression they create. See, e.g., *In re Sears, Roebuck and Co.*, 2 USQP2d 1312 (TTAB 1987).

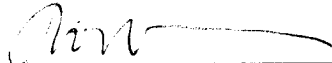
Applicant acknowledges that the Examining Attorney has provided numerous pages of excerpts from the web, although in many instances it is unclear from whom, or for what purpose, each is offered. Because the goods at issue are no longer to be considered in the evaluation, Applicant withholds any judgment on the evidence of record, and its relevance and its value as evidentiary support, noting that Applicant believes that due to its amendment to delete goods that the issue is now moot. Clearly none of the remaining goods would be considered related to Iron Mountain's services or Siemens' goods. It has long been held that even where the marks are identical in every respect, confusion would not be likely if the goods or services are not related, or if the goods are not marketed in such a way that would create the incorrect assumption that they

originate from the same source. See, e.g., *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990).

Applicant respectfully requests that the Examining Attorney pass the mark to publication in the Official Gazette at her earliest convenience. If not, please return the application to the Board for resumption of the appeal. If she has any questions, she is urged to telephone the undersigned attorney.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 12-15-05



Lori N. Boatright

12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025-1026
(310) 207-3800

DRAWING PAGE

WellPoint Health Networks Inc.

1 WellPoint Way

Thousand Oaks, CA 91362

Class 9

Goods: computer hardware and communications server hardware and software for use in sensing and monitoring health and wellness; computer software used for drug safety management, namely, management and declaration of adverse event reactions including tracking and reporting safety issues related to the clinical trials for life science companies; computer software used for managing the data entry of safety issues, create a workflow to assist users in handling the issues, reference a product's overall safety from statistical, bureaucratic, and research perspective, and track all data; computer software used in the management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom; computer software for insurance claim preparation and electronic submission, payment tracking and payment comparisons, management of medical and hospital data for regulatory compliance, managing managed care and capitation contracts with payor analysis, batch payment processing, collections, and referral authorization

ARCUS

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 11:47:39 ET

Serial Number: 75379747

Registration Number: 2277240

Mark (words only): ARCIS

Standard Character claim: No

Current Status: Registered.

Date of Status: 1999-09-14

Filing Date: 1997-10-27

Transformed into a National Application: No

Registration Date: 1999-09-14

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 1999-09-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Siemens Nixdorf Informationssysteme AG

Address:

Siemens Nixdorf Informationssysteme AG

Heinz-Nixdorf-Ring 1, Paderborn

Fed Rep Germany

Legal Entity Type: Corporation

State or Country of Incorporation: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 009

COMPUTER HARDWARE FOR USE IN IMAGING DOCUMENTS, DOCUMENT MANAGEMENT AND ARCHIVING DOCUMENTS; COMPUTER SOFTWARE USED IN OPERATING COMPUTER SYSTEMS FOR IMAGING DOCUMENTS, DOCUMENT MANAGEMENT AND ARCHIVING DOCUMENTS; COMPUTER SOFTWARE FOR USE IN STORING, TRANSMITTING, RECEIVING AND ORGANIZING DATA RELATING TO DOCUMENT MANAGEMENT AND ARCHIVING

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 44(e)

International Class: 042

DEVELOPMENT OF DATA PROCESSING PROGRAMS FOR OTHERS; RENTAL OF DATA PROCESSING PROGRAMS

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 44(e)

ADDITIONAL INFORMATION

Foreign Registration Number: 2028868

Foreign Registration Date: 1993-01-27

Country: Fed Rep Germany

Foreign Expiration Date: 2002-11-30

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1999-09-14 - Registered - Principal Register

1999-06-22 - Published for opposition

1999-05-21 - Notice of publication

1999-03-17 - Approved for Pub - Principal Register (Initial exam)

1999-02-12 - Communication received from applicant

1999-02-12 - ITU claim deleted

1998-08-14 - Non-final action mailed

1998-08-05 - Case file assigned to examining attorney

1998-08-04 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

LAWRENCE E ABELMAN (Attorney of record)

LAWRENCE E ABELMAN
ABELMAN FRAYNE & SCHWAB
150 E 42ND ST
NEW YORK NY 10017-5612

Domestic Representative

Abelman, Frayne & Schwab

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 17:25:12 ET

Serial Number: 78395521

Registration Number: (NOT AVAILABLE)

Mark

ARCUS

(words only): ARCUS

Standard Character claim: Yes

Current Status: Opposition period completed, a Notice of Allowance has been issued.

Date of Status: 2005-12-06

Filing Date: 2004-04-02

The Notice of Allowance Date is: 2005-12-06

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

Attorney Assigned:
DWYER SEAN W Employee Location

Current Location: 700 -Intent To Use Section

Date In Location: 2005-12-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. WellPoint Health Networks Inc.

Address:

WellPoint Health Networks Inc.
1 WellPoint Way
Thousand Oaks, CA 91362
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 310 207 3800

GOODS AND/OR SERVICES

International Class: 044

health spa services and spa services offered in hotel and conference centers; health spa and medical clinic services, namely, nutritional counseling, physical fitness consultation, cosmetic and plastic surgery, cosmetician services, weight management diet planning and supervision, physical rehabilitation and therapy, beauty and skin care salons; health care services, namely, hospital, nursing home, and clinic-based and home-based health care services; physical therapy, occupational therapy, speech and hearing therapy and rehabilitation services; wellness, pain management and complementary medical services; counseling in the fields of mental health and chemical dependency; organizing support groups focusing on health care issues for patients and their families; consulting services, namely, analysis by health care professionals of industrial and occupational health and safety issues and development of recommendations to improve employee health and safety; and health information services, namely, a global computer network website providing information for health care professionals and for patients and their families

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-12-06 - Notice of allowance - mailed
2005-09-13 - Published for opposition
2005-08-24 - Notice of publication
2005-05-16 - Law Office Publication Review Completed
2005-05-13 - Assigned To LIE

2005-05-12 - Approved for Pub - Principal Register (Initial exam)

2005-05-03 - Amendment From Applicant Entered

2005-04-25 - Communication received from applicant

2005-04-27 - PAPER RECEIVED

2004-10-24 - Non-final action e-mailed

2004-10-24 - Non-Final Action Written

2004-10-24 - Case file assigned to examining attorney

2004-04-12 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Lori N. Boatright (Attorney of record)

Lori N. Boatright
Blakely Sokoloff Taylor & Zafman LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025
Phone Number: 310 207 3800
Fax Number: 310 820 5988

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 17:25:30 ET

Serial Number: 78395515

Registration Number: (NOT AVAILABLE)

Mark

ARCUS

(words only): ARCUS

Standard Character claim: Yes

Current Status: Opposition period completed, a Notice of Allowance has been issued.

Date of Status: 2005-12-06

Filing Date: 2004-04-02

The Notice of Allowance Date is: 2005-12-06

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

Attorney Assigned:
DWYER SEAN W Employee Location

Current Location: 700 -Intent To Use Section

Date In Location: 2005-12-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. WellPoint Health Networks Inc.

Address:

WellPoint Health Networks Inc.
1 WellPoint Way
Thousand Oaks, CA 91362
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 310 207 3800

GOODS AND/OR SERVICES

International Class: 043

hotel services; restaurant services; and travel agency services, namely making reservations and bookings for transportation and for temporary lodging

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-12-06 - Notice of allowance - mailed

2005-09-13 - Published for opposition

2005-08-24 - Notice of publication

2005-05-24 - Law Office Publication Review Completed

2005-05-20 - Assigned To LIE

2005-05-13 - Approved for Pub - Principal Register (Initial exam)

2005-05-03 - Amendment From Applicant Entered

2005-04-25 - Communication received from applicant

2005-04-27 - PAPER RECEIVED

2004-10-24 - Non-final action e-mailed

2004-10-24 - Non-Final Action Written

2004-10-24 - Case file assigned to examining attorney

2004-04-12 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Lori N. Boatright (Attorney of record)

Lori N. Boatright
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Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025
Phone Number: 310 207 3800
Fax Number: 310 820 5988

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 17:25:44 ET

Serial Number: 78395512

Registration Number: (NOT AVAILABLE)

Mark

ARCUS

(words only): ARCUS

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2005-10-11

Filing Date: 2004-04-02

The Information will be/was published in the Official Gazette on 2005-10-11

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
DUKOVIC JOANNA M Employee Location

Current Location: L10 -TMEG Law Office 101

Date In Location: 2005-10-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. WellPoint Health Networks Inc.

Address:

WellPoint Health Networks Inc.
1 WellPoint Way
Thousand Oaks, CA 91362
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 310 207 3800

GOODS AND/OR SERVICES

International Class: 041

Entertainment services, namely organizing health and fitness conventions, education and training conventions and exhibitions in the field of health and fitness, demonstrations of master classes in the field of health and fitness in spas, health and fitness centers, and stands at trading exhibitions including rehabilitation and medical exhibitions, conventions and conferences; television production services

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-10-12 - Case file assigned to examining attorney

2005-10-11 - Published for opposition

2005-09-21 - Notice of publication

2005-07-01 - Law Office Publication Review Completed

2005-06-14 - Approved for Pub - Principal Register (Initial exam)

2005-06-14 - EXAMINERS AMENDMENT E-MAILED

2005-06-14 - Examiners Amendment -Written

2005-05-25 - Amendment From Applicant Entered

2005-05-09 - Communication received from applicant

2005-05-25 - Assigned To LIE

2005-05-09 - PAPER RECEIVED

2004-11-05 - Non-final action e-mailed

2004-11-05 - Non-Final Action Written

2004-10-24 - Case file assigned to examining attorney

2004-04-12 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

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Lori N. Boatright
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Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025
Phone Number: 310 207 3800
Fax Number: 310 820 5988

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 17:25:58 ET

Serial Number: 78395505

Registration Number: (NOT AVAILABLE)

Mark

ARCUS

(words only): ARCUS

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2005-10-11

Filing Date: 2004-04-02

The Information will be/was published in the Official Gazette on 2005-10-11

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
DUKOVCIC JOANNA M Employee Location

Current Location: L10 -TMEG Law Office 101

Date In Location: 2005-10-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. WellPoint Health Networks Inc.

Address:

WellPoint Health Networks Inc.
1 WellPoint Way
Thousand Oaks, CA 91362
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 310 207 3800
Fax Number: 310 820 5988

GOODS AND/OR SERVICES

International Class: 039

Travel agency services, namely, booking and arranging air, land and sea transportation for individuals and groups via a global computer network, in person, by telephone and via print media; travel agency services, namely, leisure and business travel transportation reservations; arranging and conducting travel and vacation packages for business and leisure travel, namely arranging travel and tour ticket reservations and conducting tours; coordinating and planning leisure and business travel arrangements for individuals and groups via a global computer network, in person, by telephone and via print media, namely travel, excursion and cruise arrangement; providing information as to travel and leisure activities, namely travel information services

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-10-12 - Case file assigned to examining attorney
2005-10-11 - Published for opposition
2005-09-21 - Notice of publication
2005-07-01 - Law Office Publication Review Completed
2005-06-24 - Assigned To LIE
2005-06-20 - Approved for Pub - Principal Register (Initial exam)
2005-06-20 - EXAMINERS AMENDMENT E-MAILED

2005-06-20 - Examiners Amendment -Written
2005-05-31 - Amendment From Applicant Entered
2005-05-09 - Communication received from applicant
2005-05-09 - PAPER RECEIVED
2004-11-05 - Non-final action e-mailed
2004-11-05 - Non-Final Action Written
2004-10-24 - Case file assigned to examining attorney
2004-04-12 - New Application Entered In Tram

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12400 Wilshire Boulevard
Los Angeles, CA 90025
Phone Number: 310 207 3800
Fax Number: 310 820 5988

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-12-15 17:26:10 ET

Serial Number: 78395500

Registration Number: (NOT AVAILABLE)

Mark

ARCUS

(words only): ARCUS

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2005-10-11

Filing Date: 2004-04-02

The Information will be/was published in the Official Gazette on 2005-10-11

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
DUKOVCIC JOANNA M Employee Location

Current Location: L10 -TMEG Law Office 101

Date In Location: 2005-10-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. WellPoint Health Networks Inc.

Address:

WellPoint Health Networks Inc.
1 WellPoint Way
Thousand Oaks, CA 91362
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 310 207 3800

GOODS AND/OR SERVICES

International Class: 038

cable television and radio broadcasting services, and satellite television and radio broadcasting services, and Internet services namely broadcasting programs with content from television networks via a web site on the Internet

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-10-12 - Case file assigned to examining attorney
2005-10-11 - Published for opposition
2005-09-21 - Notice of publication
2005-07-01 - Law Office Publication Review Completed
2005-06-14 - Approved for Pub - Principal Register (Initial exam)
2005-05-25 - Amendment From Applicant Entered
2005-05-09 - Communication received from applicant
2005-05-25 - Assigned To LIE
2005-05-09 - PAPER RECEIVED
2004-11-05 - Non-final action e-mailed

2004-11-05 - Non-Final Action Written

2004-10-24 - Case file assigned to examining attorney

2004-04-12 - New Application Entered In Tram

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Lori N. Boatright (Attorney of record)

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Blakely Sokoloff Taylor & Zafman LLP
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12400 Wilshire Boulevard
Los Angeles, CA 90025
Phone Number: 310 207 3800
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