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

Proceeding	87026036
Applicant	John M Fickewirth Associates Insurance Services, Inc. dba Fickewirth Benefits Advisors
Applied for Mark	OPTIMUM BENEFITS PACKAGE
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Examiner: Howard Smiga

Appl. No.: 87/026,036

Att'y Dkt. No.: 315-47-075

Mark: OPTIMUM BENEFITS  
PACKAGE

Filed: May 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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**APPLICANT'S REPLY BRIEF**

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## TABLE OF CONTENTS

	<b>Page</b>
TABLE OF AUTHORITIES.....	ii
INTRODUCTION .....	1
REPLY ARGUMENT .....	1
A.    Applicant’s Mark Must Be Considered in its Entirety and the “Dominant Feature” Analysis is Erroneous.....	1
B.    Applicant’s Mark, When Considered in its Entirety, is Not Confusingly Similar to the Registered Marks.....	2
CONCLUSION .....	4

## TABLE OF AUTHORITIES

### Cases

<u>In re E.I. du Pont de Nemours &amp; Co.,</u> 476 F.2d 1357 (CCPA 1973) .....	2
<u>Keebler Co. v. Murray Bakery Prods.,</u> 886 F.2d 1386 (Fed. Cir. 1989) .....	2
<u>Kellog Co. v. Pack'em Enterprises, Inc.,</u> 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) .....	3
<u>Knudsen &amp; Sons, Inc. v. Vita-Pakt Citrus Products Co.,</u> 11 U.S.P.Q.2d 1654 (Fed. Cir. 1989) .....	3
<u>Pacific Sunwear of California, Inc. v. AIT, Inc.,</u> 2004 TTAB LEXIS 76 (TTAB 2004).....	2
<u>Supply Mfg. Co. v. King Trimmings, Inc.,</u> 220 F. Supp. 947, 950 (S.D.N.Y. 1963) .....	2

## **INTRODUCTION**

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on September 25, 2017, Applicant filed an Appeal Brief on December 18, 2017 appealing from the Examining Attorney's final refusal on March 23, 2017 to register the above-identified mark. The Examining Attorney filed an Examining Attorney's Appeal Brief ("Examining Attorney's Brief") on April 6, 2018.

Applicant respectfully files this Reply to the Examining Attorney's Brief. Applicant respectfully submits that the Examining Attorney's Brief fails to successfully demonstrate that there is a likelihood of confusion between Applicant's mark OPTIMUM BENEFITS PACKAGE in Application Serial No. 87026036 ("Applicant's Mark") and the registered marks OPTIMUM in Registration No. 2010333 and THE OPTIMUM in Registration No. 1473487 ("Registered Marks") because:

- (1) The Applicant's Mark must be considered in its entirety and the Examining Attorney's "dominant feature" analysis is erroneous; and
- (2) The Applicant's Mark, When Considered in its Entirety, is Not Confusingly Similar to the Registered Marks.

Applicant incorporates herein all of its previous arguments presented in its Appeal Brief.

## **REPLY ARGUMENT**

### **A. Applicant's Mark Must Be Considered in its Entirety and the "Dominant Feature" Analysis is Erroneous**

The Examining Attorney continues to conclude that Applicant's Mark "OPTIMUM BENEFITS PACKAGE" is confusingly similar to the Registered Marks OPTIMUM and THE OPTIMUM because of their alleged similarity in sound, appearance, commercial impression, and

connotation. Examining Attorney's Brief, 4/6/2018, TTAB, p. 2. The Examining Attorney focuses on the first word of the marks for the reason of it being the first word (disregarding "THE" in THE OPTIMUM mark). Instead of considering Applicant's Mark and the Registered Marks in their entirety, the Examining Attorney isolates a single similar feature. *Contra In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In determining whether there is a likelihood of confusion between marks, however, the overall impression in commercial context made by each mark is determinative, not whether the marks share a component. *See Pacific Sunwear of California, Inc. v. AIT, Inc.*, 2004 TTAB LEXIS 76 (T.T.A.B. Feb. 18, 2004) (PAC SUN and PAC AIT are different in overall commercial impression and not confusing).

The Examining Attorney also dismisses "BENEFITS PACKAGE" in Applicant's Mark because these disclaimed words are allegedly descriptive. However, consumers view and hear a mark in its entirety, including features that are disclaimed and/or allegedly descriptive. As such, the likelihood of consumer confusion is based upon the mark as a whole, including disclaimed features. *Supply Mfg. Co. v. King Trimmings, Inc.*, 220 F. Supp. 947, 950 (S.D.N.Y. 1963) ("It is immaterial that plaintiff was required to disclaim the word 'belt' apart from the mark ... a trade mark may contain one or more descriptive words and yet be a valid trade mark, for its validity is determined by the meaning of the mark as a whole, not by the meaning of any of its parts").

**B. Applicant's Mark, When Considered in its Entirety, is Not Confusingly Similar to the Registered Marks**

When appropriately compared in their entirety, the words "BENEFITS" and "PACKAGE" distinguish Applicant's Mark from the Registered Marks in sound, appearance, commercial impression, and connotation as neither of these words or similar words are found in either of the Registered Marks. *See Keebler Co. v. Murray Bakery Prods.*, 886 F.2d 1386 (Fed. Cir. 1989) (finding PECAN SANDIES for cookies and PECAN SHORTEES for cookies were not confusingly

similar). As in Keebler Co., where marks with common first words were found not confusingly similar, so also is Applicant's Mark not confusingly similar to the Registered Marks. Applicant's Mark and the Registered Marks are sufficiently distinguished by "BENEFITS PACKAGE" in Applicant's Mark, which is not found in either of the Registered Marks.

When considered appropriately in their entirety, the marks are dissimilar in appearance and sound. Applicant's mark "OPTIMUM BENEFITS PACKAGE" does not look or sound like "Optimum" or "The Optimum". With all due respect to the Examining Attorney, the Office did not meet its burden of proof in this case. Because the marks have very different connotations, sound differently, and create substantially different commercial impressions, it is very unlikely that relevant consumers of the respective goods will believe there is any connection between the two companies. At the outset, Applicant notes that the Examining Attorney has not introduced any evidence as to the likely commercial impression of the two marks. Applicant respectfully submits that its mark and the Registered Marks are not identical, nor are they confusingly similar. Moreover, the marks sound differently and do not impart the same or similar commercial impression. *See Kellog Co. v. Pack'em Enterprises, Inc.*, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (FROOTE ICE and FROOT LOOPS "sound different and create different commercial impressions."). Here, the addition of "BENEFITS" and "PACKAGE", looks and sounds very different and provides a completely different commercial impression. In Knudsen & Sons, Inc. v. Vita-Pakt Citrus Products Co., 11 U.S.P.Q.2d 1654 (Fed. Cir. 1989), the dissimilarity of the terms "PAKT" and "JUICE" in VITA-PAKT and VITA JUICE, both marks for fruit juice, was cited as grounds for finding no likelihood of confusion. The differences in this matter are more than sufficient to avoid likelihood of confusion. Based on the dissimilarity of appearance, sound, and connotation of the marks, Applicant submits that there is no likelihood of confusion between the marks.

Based on the dissimilarity of appearance, services, and connotation of the marks, Applicant submits that there is no likelihood of confusion between the marks.

**CONCLUSION**

In view of the requirement that likelihood of confusion must be probable, and not only possible, for a refusal under Trademark Act § 2(d), that the goods listed for the Application and the registered mark are distinct, and that the goods of the Application and the registered mark are directed to different target markets, there is not a likelihood of confusion between the mark of the Applications and the registered mark.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act § 2(d) and allow the Application to proceed to publication.

Respectfully submitted,

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