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

Proceeding	92070407
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF Trademark Reg. No. 5,323,248
For the mark CHUBB TRAVEL SMART;
Registered on October 31, 2017**

AWP USA INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92070407
)	
CHUBB INA HOLDINGS INC.,)	
)	
Registrant.)	
_____)	

PETITIONER'S REPLY BRIEF

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I. INTRODUCTION

Registrant's arguments that Petitioner did not offer *any* admissible evidence, and that the TRAVELSMART mark is too weak to be afforded with trademark protection, rest on three incorrect or irrelevant premises: (1) the printed publications that Petitioner offered into evidence can *only* be used to prove the truth of the statements in them (and can have no other evidentiary value); (2) Petitioner's TRAVELSMART mark is merely descriptive, therefore not inherently distinctive, in connection with *information, tips, and advice about travel* (which is not Petitioner's product); and (3) the term SMART is merely descriptive in connection with any *mobile application* (not Petitioner's application). As discussed more fully below, all of these premises are flawed. In addition, all of Registrant's trial evidence should be disallowed because Registrant failed to produce any of it in discovery.

Registrant disingenuously asserts that Petitioner offered its printed publication evidence *only* to prove that Petitioner first started using its mark in 2013. That assumption is of course erroneous; the printed publications were offered, among other things, to establish that Petitioner's TRAVELSMART mark has been made known to the public since 2013, that Petitioner's goods bearing its TRAVELSMART mark have been widely advertised, and the TRAVELSMART brand has promoted in online magazines and media that targets a class of consumer in travel insurance industry. Registrant's attempt to disregard such substantial evidentiary value of Petitioner's evidence in its entirety based on a facially inapplicable hearsay objection is wholly unwarranted.

Second, Registrant improperly broadens and alters the scope of Petitioner's goods and services by defining them first as *information, tips, and advice about travel* and later as *general mobile applications* in order to make the mark seem more descriptive than it is. Registrant

subsequently argues that the term TRAVEL SMART is familiar to the public in connection with “*information, tips, and advice about travel*” and the term SMART is merely descriptive in connection with *any* mobile application, hoping the Board to extend these findings to mean that the word TRAVELSMART must also be merely descriptive in connection with a Petitioner’s particular mobile application with specific functions related to travel insurance claims and policy management.

In rebutting allegations in Registrant’s opposition brief, Petitioner states the following:

II. ARGUMENTS

A. Petitioner Clearly Has Standing to Petition to Cancel

Registrant correctly notes that, to have standing, a plaintiff must have a real interest, *i.e.*, a personal stake, in the outcome of the proceeding and a reasonable basis for its belief that the plaintiff will be damaged. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co., Inc.*, 753 F.3d 1270, 111 U.S.P.Q.2d 1058, 1062 (Fed. Cir. 2014). However, in erroneously arguing that Petitioner has not established its standing to petition to cancel Registrant’s CHUBB TRAVEL SMART registration, Registrant states (1) Petitioner did not file a copy of its pleaded pending application and had the status and title of the application admitted into evidence, (2) Petitioner merely presented allegations of standing with no direct proof or corroborating witness testimony regarding its pending application, and that (3) the printed publication evidence Petitioner submitted is hearsay *in toto* and none of it should therefore be considered. (TTABVUE No. 22, p.19-20.) The argument seems to have stemmed from Registrant’s serious misunderstandings of what the law requires to establish standing and what constitutes hearsay.

As an initial matter, the case law is clear that standing can be established by nothing more than an admission in the pleadings, which Registrant has already done in this case. In its trial

brief, Registrant relies heavily on *WeaponX Performance Prod. Ltd. v. Weapon X Motorsports*, 126 U.S.P.Q.2d 1034 (T.T.A.B. 2018). However, in that case, the Board held that the applicant's admission in its answer that the opposer is the owner of its pleaded application is itself sufficient to demonstrate the opposer's standing to pursue the opposition proceeding. The situation is identical in this case: Registrant already admitted in its own Answer that Petitioner is the owner of the pleaded application, U.S. Trademark No. 87/901,866. (TTABVue No. 4, p. 2, ¶ 1.) Accordingly, under *Weaponx*, standing is established by Registrant's admission alone, notwithstanding all of the other bases for standing in the record.

While that alone concludes the standing issue, Petitioner notes that it is not even required to have the status and title of its pending application made of record in this proceeding to prove its standing.¹ It is well-settled that standing may also be established based on a petitioner's common-law rights in its mark. *See Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 1022 (T.T.A.B. 2009) ("Petitioner has established his common-law rights in [his mark], and has thereby established his standing to bring this proceeding."). While standing may be established by the fact that the petitioner's application has been refused registration on the basis of the respondent's registration, "evidence of such a refusal is *not* a requirement to prove standing." *Anosh Toufigh v. Persona Parfum, Inc.*, 95 U.S.P.Q.2d 1872, 1874 (T.T.A.B. 2010) (emphasis added). Indeed, it is sufficient to establish standing "if the circumstances are such that it would be reasonable for a petitioner to believe that the existence of the respondent's registration would

¹ Regardless of whether or not Petitioner's pleaded application was made of record in this proceeding, the application is of very limited probative value because it proves nothing other than Petitioner filed the application with the United States Patent and Trademark Office (the "USPTO") on a certain date. *See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 U.S.P.Q.2d 1949, 1956 n.9 (T.T.A.B. 2014) ("The applications are not evidence of anything except that they were filed."); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 U.S.P.Q. 1090, 1092 n.5 (T.T.A.B. 1979) (evidence only of the filing of the application); *Lasek & Miller Associates v. Rubin*, 201 U.S.P.Q. 831, 833 n.3 (T.T.A.B. 1978) (petitioner's application file is proof only of filing, not of any facts alleged in the application); *see also Kemi Organics, LLC v. Gupta*, 126 U.S.P.Q.2d 1601, 1606 (T.T.A.B. 2018) (abandoned application only probative to show it had been filed).

damage him, *e.g.*, a reasonable belief that there is a likelihood of confusion between the marks, or that the presence on the register of the respondent's mark may hinder the petitioner in using or registering his mark.” *Id.*; *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit.”). Thus, the governing standard for proving standing is Petitioner’s “reasonable belief of damage” from the likelihood of source confusion or the possibility that the registrant’s registration’s presence may hinder Petitioner’s use of its mark.

Here, Petitioner filed its trademark application for the TRAVELSMART mark on Petitioner’s mobile application and web-based software (U.S. Trademark Ser. No. 87,901,868), and the assigned examining attorney issued a 2(d) likelihood of confusion refusal on the application, citing the Registrant’s CHUBB TRAVEL SMART mark and concluding that the two marks are confusingly similar and the compared goods/services are closely related. Petitioner also offered into evidence printed publications including, among other things, (1) articles from IPMI Magazine, Richmond Times-Dispatch, and cision.com showing Petitioner’s TRAVELSMART app was marketed by media and advertised to the public as early as year 2013, (2) screenshots from the Google Play and Apple Store showing Petitioner’s app has been downloaded and installed by users on the Google Play over 100,000 times, and received approximately 1,200 ratings and reviews with an average of 4.2 out of 5 stars by its users on the Apple Store, and (3) screenshots from the Apple Store showing Registrant’s CHUBB TRAVEL SMART app has ratings and reviews of an average of 2.3 out of 5 stars by its users on the Apple Store. (TTABVUE No. 11, p. *18-19, *89-92, *11-14, *47-48.)

Registrant argues that Petitioner’s “internet” evidence is only probative for what it shows

on its face and not for the truth of what is printed, and therefore the entire evidence by Petitioner should be disregarded for purposes of showing Petitioner has a “real interest” in this proceeding or a “direct and personal stake” in the outcome. Registrant further argues that “Petitioner merely presented allegations of standing with no direct proof or corroborating witness testimony . . . and the printouts from the various websites . . . submitted by Petitioner . . . are hearsay.” (TTABVUE No. 22, p. 20.) What Registrant fails to recognize is that Petitioner’s evidence was not offered to prove the truth of the matter in it and/or is not deemed statements made by a person to constitute hearsay.

Regarding the articles from IPMI Magazine, Richmond Times-Dispatch, and cision.com, they are probative for what they show on their face; that the news that Petitioner launched its TRAVELSMART app was widely circulated, advertised, and available to the public. In particular, they demonstrate Petitioner’s brand has been marketed and promoted in connection with its goods through these channels. Petitioner’s common-law rights that support its reasonable belief of damage are established by showing that Petitioner’s TRAVELSMART brand was used and advertised in connection with those goods through websites of third parties such as IPMI Magazine, Richmond Times-Dispatch, and cision.com. Because of those promotional activities, ordinary consumers were exposed to the TRAVELSMART mark and associate it with Petitioner and Petitioner’s goods. In sum, the articles were not offered into evidence to prove the veracity of the statements asserted in them, but for what they demonstrate on their face. Accordingly, they are not hearsay.

Similarly, regarding the screenshots from the Google Store and Apple Store, Petitioner referred to the name of the parties’ mobile applications and the numbers of downloads, ratings, and reviews of the apps in support of its arguments. (TTABVUE No. 20, p. 12.) That

information is not hearsay. Hearsay is an out-of-court *statement* that a party offers in evidence to prove the truth of the matter asserted in the statement. Fed. R. Evid. 801 (emphasis added). “Statement” means “a *person’s* oral assertion, written assertion, or nonverbal conduct, if the *person* intended it as an assertion.” *Id.* (emphasis added). Regarding what constitutes a statement in the hearsay context, a statement must be made by a human, not a machine. *United States v. Lizarraga-Tirado*, 789 F.3d 1107, 1110 (9th Cir. 2015). Furthermore, the word ‘statement’ is “used in a very precise, and non-colloquial sense”, only applying to “verbal conduct (spoken or written) or non-verbal conduct that is intended by a human declarant to be *assertive*.” *Lorraine v. Markel Am. Ins. Co.*, 241 F.R.D. 534, 563 (D. Md. 2007).

Here, the data and texts in the screenshots cannot be hearsay because they are not a conduct *intended by a human declarant to be assertive*. Rather, consistent with what was stated in Petitioner’s First Notice of Reliance, these screenshots have been made of record to show the similarity of the marks, the instances of the parties’ marks and goods featured together in media for the public’s read, and thus the marketplace recognition of Petitioner’s mark. (*see* TTABVUE No. 11, p. 5.) This demonstrative evidence therefore supports a finding of the likelihood of confusion between the parties’ marks.

In sum, even if we assume that Registrant’s own admission that Petitioner is the owner of its pleaded application were not deemed sufficient to prove standing (it is sufficient), it is clear that the evidence made of record by Petitioner, which is not subject to hearsay objection, shows Petitioner has a personal and “real” stake in the outcome of the proceeding and a reasonable basis of belief that it will be damaged by the likelihood of confusion between the two marks.

B. Petitioner Has Demonstrated Priority of Use

Registrant alleges that Petitioner has failed to prove priority of use based on the same

argument that Petitioner's internet article evidence is hearsay and therefore all of Petitioner's evidence should be disregarded. (TTABVUE No. 22, p. 20.) In supporting this sweeping argument, Registrant primarily relies on the Board's decision in *WeaponX*. (*Id.*, p. 21-23.) In that case, the Board reviewed all of the evidence submitted by Opposer and held Opposer's internet printouts were insufficient evidence to conclude that the pleaded mark was being used in commerce by Opposer or that it was in use prior to October 29, 2013. *WeaponX Performance Prod. Ltd. v. Weapon X Motorsports*, 126 U.S.P.Q.2d 1034, 1042 (T.T.A.B. 2018). However, this holding in *WeaponX* is inapposite here because as the Board noted, the evidence provided merely show, on their face, that "some entity [not necessarily the Opposer] is advertising products and services under the WEAPONX mark," *WeaponX Performance Prod. Ltd.*, 126 U.S.P.Q.2d at 1040 (emphasis added), and thus, found the evidence to be insufficient to establish priority for the Opposer. That is not the case here.

All of the printed publications mentioning Petitioner's mobile application by Petitioner point to one particular name that is completely different from Registrant's: Allianz Global Assistance, Petitioner's brand. Additionally, the articles from the Richmond Times-Dispatch and cision.com from 2013 include images of a person holding a smartphone displaying Petitioner's travel insurance mobile application screen and an enlarged version of that screen, displaying not only Petitioner's brand Allianz Global Assistance on the upper left-hand corner of it and but also Petitioner's TravelSmart mark on its upper right-hand corner. (TTABVUE No. 11, p. *89, p. *91.) Accordingly, not only do these printed publications differ markedly from those at issue in *WeaponX* because they clearly identify that Petitioner was using the mark, they also are not hearsay.

As discussed above, hearsay is an out-of-court *statement* that a party offers in evidence to

prove the truth of the matter asserted in the statement and “statement” means “a *person*’s oral assertion, written assertion, or nonverbal conduct, if the *person* intended it as an assertion.” Fed. R. Evid. 801 (emphasis added). These images are not statements made by a person and thus cannot constitute hearsay. *See Perfect 10, Inc. v. Cybernet Ventures, Inc.*, 213 F. Supp. 2d 1146, 1155 (C.D. Cal. 2002) (“To the extent these images and text are being introduced to show the images and text found on the websites, they are not statements at all—and thus fall outside the ambit of the hearsay rule.”); *see also McKee v. Audible, Inc.*, No. CV 17-1941-GW(EX), 2017 WL 7388530, at *4 (C.D. Cal. 2017). Rather, the images are probative of what they demonstrate *on their face*: a mobile application named TRAVELSMART was offered by Petitioner in 2013, and a consumer was using that mobile application in 2013.

Additionally, Registrant erroneously assumes that the internet publication evidence by Petitioner dating back to 2013 is offered for the *sole* purpose of proving that Petitioner launched its TRAVELSMART mobile app in 2013, and argues that, absent corroborating testimony attesting to the truth of that particular fact, the entirety of Petitioner’s evidence constitutes hearsay and cannot be considered. However, even if Registrant were correct that the evidence is hearsay (it is not, for the reasons discussed above), even hearsay is admissible for purposes other than the truth of the matter asserted. *See Cross Trailers, Inc. v. Cross Trailer Mfg. & Sales, LLC*, 363 F. Supp. 3d 774, 785 (W.D. Tex. 2018). Here, at a minimum, the evidence demonstrates a public awareness of Petitioner’s mark dating back to 2013.

In the absence of a federal registration, a party must establish its prior trademark rights through actual use or through use analogous to trademark use, such as “use in advertising brochures, trade publications, catalogues, newspaper advertisements and internet web sites, *which creates public awareness of the designation as a trademark identifying the party as a*

source.” *Donald A. Gange v. Agility Sports LLC*, No. 91194831, 2013 WL 6858021, at *3 (T.T.A.B. 2013) (emphasis added). The internet publications from 2013 as well as the January 19, 2016 article from PropertyCasualty360.com that Petitioner placed into evidence in its First Notice of Reliance are unquestionably admissible for what they show on their face, which includes the fact they were published on certain dates and that they contain the subject text or images. *Brooks v. Creative Arts by Calloway*, 93 U.S.P.Q.2d 1823, 1827 (T.T.A.B. 2010) (truth of the matter not considered, but publication illustrative of consumer exposure to mark). Accordingly, at a minimum, the publications are probative in showing, on their face, matters such as public perception and likelihood of confusion, which are relevant to trademark claims. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2, *11 (TTAB 2020) (“[S]uch materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false”; third-party documentary evidence corroborates pervasive use by others in the industry) (quoting *Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014)); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) (“sometimes what Internet printouts and printed publications show on their face is relevant to trademark cases, including likelihood of confusion cases”).

Indeed, the evidentiary value Petitioner’s internet publications from IPMI, Richmond Times-Dispatch, cision.com has is significant in establishing its senior trademark rights.² They establish that Petitioner’s mark has been known to the public in 2013, that its mobile application goods bearing the TRAVELSMART mark have been widely advertised or marketed in 2013, and that the TRAVELSMART brand has been promoted in these publications targeting a class of

² Note that Petitioner’s First Notice of Reliance states that the internet articles from IPMI Magazine, Richmond Times-Dispatch and cision.com were being offered to show, *inter alia*, “Petitioner’s earlier use of its mark on goods and services that are identical and/or related to Registrant’s . . . goods.” (see TTABVUE No. 11, p. 5.)

consumers in travel insurance industry in 2013. *See Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1721 n.50 (T.T.A.B. 1999) (evidence of manner in which term is used in articles and of fact that the public has been exposed to articles and may be aware of information contained there), rev'd on other grounds, 284 F. Supp. 2d 96 (D.D.C. 2003); *see also Wagner Elec. Corp. v. Raygo Wagner, Inc.*, 192 U.S.P.Q. 33, 36 n.10 (T.T.A.B. 1976) (advertisements were probative of fact that opposer advertised under its mark in particular publications on those dates). Other internet articles from 2016 submitted by Petitioner as evidence do the same for year 2016.

In contrast, Registrant did not submit *any* evidence to contest or oppose Petitioner's evidence concerning its senior use of the TRAVELSMART mark. In fact, Registrant did not offer any evidence concerning its use of the CHUBB TRAVEL SMART mark at all. (*See* TTABVUE Nos. 15-17.) The only materials from which we can speculate Registrant's first use of the mark are the information stated in U.S. Trademark Reg. No. 5,323,258 and Registrant's response to Petitioner's Interrogatory No. 3, both of which are submitted by Petitioner. In the interrogatory response, Registrant stated that it "has used [the CHUBB TRAVEL SMART] mark in connection with a downloadable mobile application for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency conversions in the United States since January 15, 2016." (TTABVUE No. 12, p. 10.)

Registrant argues that Petitioner must prove its priority of use by a preponderance of the evidence, and has failed to do so. (TTABVUE No. 22, p.20, 23.) However, "[p]reponderance rests with that evidence which when fairly considered, produces the *stronger* impression, and has the *greater* weight, and is *more* convincing as to its truth when weighed *against the evidence in opposition thereto . . .*" *Spaulding Bakeries Inc. v. Interstate Brands Corp.*, 209 U.S.P.Q. 355, 357 (T.T.A.B. 1980) (emphasis added). Here, while Petitioner has made of record at least 3

internet publications which show Petitioner's mark in connection with its mobile application has been actively marketed, advertised and known to the public prior to Registrant's alleged first use, Registrant offered *no* evidence in opposition. The weight of evidence by Petitioner clearly overbears the weight of the evidence by Registrant (which is none) in both quantity and effect. As such, Petitioner has met its burden to prove its priority of use by preponderance of the evidence.

C. All of Registrant's Evidence Should be Stricken Because It Was Not Produced in Discovery

All of Registrant's trial evidence that was submitted to the Board in this matter (TTABVUE Nos. 15-17.) must be stricken because none of it was produced in discovery. During the parties' discovery period, Petitioner specifically requested that Registrant produce "[a]ll documents that do, or may, support any claim of Registrant herein, and/or which Registrant believes would be admissible evidence on its behalf at the trial of this case." Exhibit A, p. 14. In response, Registrant stated it "will make available those non-privileged, responsive documents in its possession, custody, or control for inspection and copying." *Id.* However, no documents whatsoever were produced during the discovery period. Registrant attempted to submit the responsive documents under its Notices of Reliance with exhibits almost a year later from the date it responded to Petitioner's request. Because all of the submitted evidence under the Notices of Reliance are responsive to the Request for Production No. 23, but were not produced during the discovery period, all of Registrant's evidence should be stricken in its entirety. *See Underpinning & Foundation Skanska, Inc. v. Travelers Cas. & Sur. Co. of America*, 726 F. Supp. 2d 339 (S.D. N.Y. 2010); *see also Saunders v. City of Chicago*, 320 F. Supp. 2d 735, 739 (N.D. Ill. 2004); *see also Danaher v. Wild Oats Markets, Inc.*, 779 F. Supp. 2d 1198 (D. Kan. 2011); *see also Cruz v. Bristol Myers Squibb Co. PR, Inc.*, 777 F. Supp. 2d 321 (D.P.R. 2011).

D. TRAVELSMART Is Commercially Strong In Connection with Petitioner's Goods

Registrant argues that Petitioner's mark is extremely weak because the wording TRAVEL SMART is very commonly used in connection with "*providing tips and information about travel.*" (TTABVUE No. 22, p. 25-26.) However, Registrant's articulation of Petitioner's goods and services is factually incorrect. The correct description of Petitioner's goods/services are shown in the U.S. Trademark Ser. No. 87/901,868 (which Registrant admitted that Petitioner is the owner) are:

“[d]ownloadable mobile application software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services,” in International Class 009, and “Providing temporary use of web-based software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services,” in International Class 042.

Petitioner's opening brief provides an adequate summary of the above as “mobile application and web-based software services for providing information related to travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance during travels.” (TTABVUE No. 20, p. 11.)

Registrant's argument that Petitioner's mark is commercially weak is based on several erroneous assumptions and skewed factual assertions. First, Registrant incorrectly assumes that *none* of the evidence offered by Petitioner is admissible for *any* purpose such that there is no evidence relating to the commercial strength of Petitioner's mark. (TTABVUE No. 22, p. 26.) Second, Registrant falsely broadens Petitioner's goods and services to include *anything* that is

related to “providing tips and information about travel,” rather than genuinely addressing Petitioner’s actual mobile application software with its particular functions. (*Id.*) Third, Registrant asserts that its own evidence (which was not produced in discovery) related to use of the words “travel smart” generally in connection with all aspects of “providing tips and information about travel” demonstrates that consumers who are looking for tips and information about travel have likely encountered the phrase “Travel Smart” or “TravelSmart” in multiple contexts, from multiple sources. (*Id.*, p. 27.) Finally, Registrant makes a leap and argues that Petitioner’s mark is commercially weak specifically in connection with its *particular kind of mobile application software* (as though there was absolutely no difference between “providing tips and information about travel” and “mobile application and web-based software services for providing information related to travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance during travels.”) Unfortunately for Respondent, this flawed argument is simply unsupported by the applicable law.

Petitioner has established the commercial strength of its mark consistent with the applicable law. “A mark’s commercial strength depends on *public recognition, or the extent to which people associate the mark with the product* it announces.” *Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 430 (6th Cir. 2017) (emphasis added). As a preliminary matter, Registrant’s allegation that consumers are generally familiar with the phrase “Travel Smart” in connection with *anything* related to “providing tips and information about travel” has no bearing on how commercially strong Petitioner’s mark is because the strength depends on the extent to which the public associate Petitioner’s mark with *Petitioner’s particular product*, not with anything that is vaguely or generally related to travel.

As already stated in the prior sections, should Petitioner’s printed publications be

inadmissible solely for the purpose of proving the truth of the statements therein, it does *not* mean that they are inadmissible for other purposes relevant to Petitioner’s claims. In fact, Registrant correctly summarized in its brief the very purpose for which Petitioner’s printed publications were offered into evidence: public recognition of Petitioner’s mobile application under the brand TRAVELSMART. (TTABVUE No. 22, p. 25.) Similarly, other documents Petitioner made of record under its First Notice of Reliance establish, *on their face*, that Petitioner’s mark has been known to the public in connection with its mobile application software, and that the product has been widely advertised and promoted through online channels that are open to the public. For example, the screenshots from the Apple Store and Google Play Store showing the number of times Petitioner’s app has been downloaded by the public and the number related the app’s ratings and reviews do just that. (*See* TTABVUE No. 11, p.11-14.)³ These in turn demonstrate that the TRAVELSMART mark is commercially strong.

E. TRAVELSMART Is Suggestive and Inherently/Conceptually Strong in Connection with Petitioner’s Goods

Registrant further argues that Petitioner’s mark is inherently weak. (TTABVUE No. 22, p. 21.) In so doing, Registrant again improperly changed the scope of Petitioner’s specific goods by defining them broadly as a “mobile application,” without any limitation, particular purpose, function, or field. Based on that overly broad and inaccurate definition, Respondent argues that the term SMART is descriptive of all mobile applications because that term has the meanings of “operating by automation” and/or containing microprocessors, navigation information, and sensing and self-correcting functions. (TTABVUE No. 22, p. 28-29.) However, even if that were the case, Petitioner’s mark is not just SMART (it is TRAVELSMART), and Petitioner’s goods

³ Because the numbers in the screenshots are not statements made by a person, they cannot constitute hearsay for this reason alone. *See Perfect 10, Inc.*, 213 F.Supp.2d at 1155.

are not a generic mobile application (but one with insurance claims management functionality, among other things).

Petitioner argued in its brief that none of the definitions of SMART describes an ingredient, quality, characteristic, function, feature, purpose or use of *Petitioner's particular mobile application* namely, a mobile application for providing information related to travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance during travels. (See TTABVUE No. 20, p. 19). While Petitioner does not concede that SMART is merely description of mobile applications generally, it is certainly not merely descriptive of any aspect, characteristic, or quality of *Petitioner's* particular mobile application software. Accordingly, Registrant's descriptiveness argument completely ignores that Petitioner's goods are clearly defined by limitations and particular functions.

Notwithstanding the above, whether or not the term SMART is merely descriptive or inherently weak does not even dictate whether or not Petitioner's TRAVELSMART Mark is inherently or conceptually weak. SMART and TRAVELSMART are two visually and aurally different marks with dissimilar overall commercial impressions. Indeed, a court cannot dissect a mark to determine if component parts are conceptually weak; it must make that determination concerning the mark as a whole. *Vapor Spot, LLC v. Breathe Vape Spot, Inc.*, No. CV 15-02110 MMM (EX), 2015 WL 12839123, at *7 (C.D. Cal. 2015); *Official Airline Guides*, 6 F.3d at 1392 (“[T]he district court analyzed the strength of OAG's mark by examining its component parts and found that the term ‘Travel Planner,’ standing alone, is descriptive and therefore weak. But under the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace”); *Cacique, Inc. v. Reynaldo's Mexican Food Co., LLC*, No. 2:13-cv-1018, 2014 WL 537061, *3-4 (C.D.

Cal. Feb. 10, 2014) (rejecting defendant's argument that plaintiff's mark was not conceptually strong because its component parts were generic and/or descriptive, and stating that "this individualized approach is contrary to the law"); *powerlineman.com, LLC v. Kackson*, No. CIVS07-879LKK/EFB, 2007 WL 3479562 at *2 (E.D. Cal. 2007) ("Even if the court were to take judicial notice of defendant's proffered dictionary definition of 'lineman' ... it would, at best, show that the word 'lineman' was generic, rather than plaintiff's trademark, 'powerlineman' "). Thus, the issue in this case is whether the word TRAVELSMART, not the word SMART, is merely descriptive or inherently/conceptually strong in connection with Petitioner's goods. Accordingly, Registrant's ninety-six U.S. registrations that cover software in which SMART is disclaimed (which were not produced in discovery) may demonstrate that the term SMART is descriptive in connection with *any* software, but they do nothing to prove that the word TRAVELSMART is merely descriptive in connection with Petitioner's particular mobile application software.

Rather than being merely descriptive of Petitioner's goods and services, Petitioner's TRAVELSMART mark is conceptually and inherently strong. A "mark's conceptual strength depends largely on the obviousness of its connection to the good or service to which it refers. The less obvious the connection, the stronger the mark, and vice versa." *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1032–33 (9th Cir. 2010). Thus, in order to evaluate the conceptual strength of the TRAVELSMART mark, the Board must determine whether it would be obvious for ordinary consumers to connect the word TRAVELSMART to Petitioner's mobile application software for providing information related to travel *insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance* during travels, which is clearly not the case. Moreover, the word

TRAVELSMART does not have any dictionary definition, which alone should be sufficient to render the mark conceptually and inherently strong.

Even if we assume Petitioner's mark were TRAVEL SMART (with a space), the mark is subject to so many possible interpretations in meaning. For example, "Travel Smart" could mean being mindful of one's surroundings when traveling. Or it could mean being savvy in getting travel discounts. It could also mean using advanced luggage or packing methods to streamline the travel experience. Clearly there is nothing obvious about the words' direct connection to Petitioner's particular mobile application software and ordinary consumers must use imagination or multi-stage reasoning to make that connection. *See Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F3d 902, 911 (9th Cir. 1995) (Under this "imagination test," "[i]f the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.", quoting 1 MCCARTHY § 11:21 (3d ed.1991) (§ 11:67 in 4th ed), *cert denied*, 531 U.S. 1126 (2001)). For these reasons, Petitioner's mark is conceptually and inherently strong.

F. The Addition of a House Mark to an Inherently Strong Mark Is Not Sufficient to Avoid Consumer Confusion

Registrant's argument that the addition of its house mark CHUBB to TRAVEL SMART is sufficient to distinguish its mark from Petitioner's mark rests entirely on the erroneous assumption that the TRAVELSMART mark is merely descriptive or extremely weak in its strength. (TTABVue No. 22, p. 31-32.) However, as discussed in the preceding sections of this brief, Petitioner's TRAVELSMART mark is actually both commercially and conceptually strong. Registrant's argument therefore must fail.

In support of its flawed argument, Registrant equates this case with *Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005). However, what Registrant

attempts to do in this case—relying on *Knight Textile* to argue that Petitioner’s mark is weak and diluted to avoid a finding of likelihood of confusion between the two marks—is precisely what the applicant in *In Re Aramark Unif. & Career Apparel Grp., Inc.*, No. 87583832, 2019 WL 1491520 (T.T.A.B. 2019) argued, with no success.

As Registrant does here, in *Aramark*, the applicant argued that its ARAMARK FLEXFIT mark (used in connection with various clothing items) is not likely to cause consumer confusion when compared with many FLEXFIT marks owned by the registrant (also in connection with various clothing items) because the shared term FLEXFIT is “inherently weak and diluted.” In support of this argument, the applicant in *Aramark* relied on evidence that third parties use and own registration for marks containing FLEXFIT or variations thereof for clothing. *In Re Aramark Unif. & Career Apparel Grp., Inc.*, No. 87583832, 2019 WL 1491520, at *4 (T.T.A.B. 2019). However, the Board in *Aramark* held that (1) FLEXFIT is suggestive of how apparel or accessories fit, specifically that the fit is flexible, (2) the compared goods are legally identical in part, and (3) Applicant’s mere addition of the house brand ARAMARK to the term FLEXFIT is insufficient to avoid confusion when the marks are used on identical goods.⁴ *Id.* at *6.

In so holding, the Board distinguished its reasoning from the reasoning in *Knight Textile* (upon which Registrant relies here). The Board in *Aramark* distinguished *Knight Textile* by holding that the mark at issue in *Knight Textile* was more descriptive than the mark at issue in *Aramark*. In *Knight Textile*, the competing marks were NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS (both for women’s clothing), and the Board found the addition of the house mark sufficient to avoid a likelihood of confusion because evidence established that the shared term ESSENTIALS is “highly suggestive.” *Id.* at *34. The Board’s finding that the

⁴ The Board also noted that the addition of a house mark or a trade name to a senior mark is generally found insufficient to avoid confusion and is sometimes even found to be an aggravation, and not a justification. *In Re Aramark Unif. & Career Apparel Grp., Inc.*, 3 2019 WL 1491520, at *3.

shared term ESSENTIALS is “highly suggestive” of women’s clothing based was based in part on a dictionary definition indicating that the term “connotes that the clothing items sold under the marks are basic and indispensable components of, or ‘essentials’ of, one’s wardrobes.” *Id.* This finding was also supported by 23 third-party registrations for marks that include ESSENTIALS for clothing. *Id.*

In contrast to *Knight Textile*, the Board in *Aramark* found that FLEXFIT is *not* “highly suggestive” such that there is a likelihood of confusion notwithstanding the addition of a house mark. In so holding, the Board noted that there are no dictionary definitions of FLEXFIT of record, and there is no evidence that FLEXFIT is an actual word. *In Re Aramark Unif. & Career Apparel Grp., Inc.*, No. 87583832, 2019 WL 1491520, at *4 (T.T.A.B. 2019). The Board in *Aramark* also noted that the third party use and registration evidence does *not* support a finding that FLEXFIT is “highly suggestive” for clothing, pointing out that the printout from “flexfitactivewear.com” suggests that the use of “flex” may refer to “flexing muscles, rather than a “flexible” fit. *Id.* Accordingly, the distinction between *Knight Textile* and *Aramark* comes down to (1) whether the common term is “highly suggestive,” (2) whether the common term has a dictionary definition, and (3) whether the common term is capable of multiple meanings.

The facts in *Aramark* are very similar to the ones in this case. In this case, there is no dictionary definition for TRAVELSMART and there is no evidence that TRAVELSMART is even an actual word. None of the 32 third-party use cases that Registrant improperly (not produced in discovery) submitted as evidence shows the term TRAVELSMART being used in connection with a *mobile application software for providing travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance during travels.*⁵ (See

⁵ Indeed, the *only* user using a similar mark in connection with this type of application is the Registrant.

TTABVUE No. 22, p.12-13.) In fact, Registrant’s third-party internet evidence does not even properly show that “TRAVEL SMART” or “TRAVELSMART” is being used as a trademark. (See TTABVUE No. 15) Instead, most of the internet evidence shows instances of the phrase “Travel Smart” being used in a purely descriptive manner and not as a signifier of source, and not in connection with a particular mobile application or in the travel insurance field.⁶ Clearly, these irrelevant submissions are merely Registrant’s poor attempt to distract the Board from focusing on the clearly demonstrated infringement on Petitioner’s mark.

In light of the foregoing, it is clear that the shared term here cannot be “highly suggestive” like the ESSENTIALS mark in *Knight Textile*. Instead, like the FLEXFIT mark in *Aramark*, the shared term is distinct or, at a minimum, just suggestive. Consistent with the decision in *Aramark*, consumers familiar with Petitioner’s TRAVELSMART mark who encounter Registrant’s CHUBB TRAVEL SMART mark for mobile applications related to similar or identical services could very well assume that there is some connection or affiliation between Petitioner and Registrant. *In Re Aramark Unif. & Career Apparel Grp., Inc.*, 2019 WL 1491520, at *6; see also *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (finding sufficient similarity when “persons who encounter the marks would be likely to assume a connection between the parties”). In sum, the mere addition of Registrant’s house mark CHUBB to Petitioner’s TRAVELSMART inherently distinctive (not highly suggestive) mark does not prevent the likelihood of consumer confusion between the two brands.

⁶ There exists only one Exhibit submitted by Registrant that seems to show the term “Travel Smart Plans” is used on (non-mobile application software) travel insurance related services. (TTABVUE No. 15, p. 82-84.) However, one instance of use of Travel Smart Plans is nowhere close to show the term TRAVELSMART is highly suggestive in connection with Petitioner’s mobile application software.

III. CONCLUSION

For the reasons set forth above and in Petitioner's Amended Brief, Petitioner respectfully requests that the Board sustain this proceeding and cancel registration of Registrant's CHUBB TRAVEL SMART mark, in order to prevent the likely consumer confusion with Petitioner's TRAVELSMART mark, used in connection with mobile application for travel, medical, safety, health, and security information.

DATED this 12th day of February 2021.

Respectfully submitted,

AWP USA Inc.,

/s/ Hyung Gyu Sun

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's Reply Brief has been served upon Registrant by E-Mail on this 12th day of February 2021, addressed as follows:

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/s/ Hyung Gyu Sun
Hyung Gyu Sun

EXHIBIT A

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

AWP USA INC.,)	
)	
Petitioner,)	
)	Reg. No.: 5,323,248
v.)	Mark: CHUBB TRAVEL SMART
)	Cancellation No.: 92070407
CHUBB INA HOLDINGS INC.,)	
)	
Registrant.)	
)	

**REGISTRANT’S RESPONSES TO PETITIONER’S
FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS**

Registrant, Chubb INA Holdings Inc. (“Registrant”), by and through its attorneys, Blank Rome LLP, responds to Petitioner’s First Set of Requests for Production of Documents as follows:

GENERAL OBJECTIONS

1. Registrant objects to the Definitions and Instructions to the extent that they impose duties over and above those required by the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Rules of Practice.
2. Registrant objects to Petitioner’s discovery requests to the extent that they seek information and documents that are protected by the attorney-client privilege or attorney work-product doctrine or that are otherwise protected from disclosure.
3. Registrant objects to Petitioner’s discovery requests to the extent that they seek information or documents that consist of proprietary business information or other confidential information.

4. Registrant objects to Petitioner's discovery requests to the extent that the scope of the requests for information, documents, and things relate to policies, plans, suggestions, recommendations, or research concerning goods, services, trademarks, trade names, or service marks or the advertising, promotion, positioning, marketing, or distribution of same that have not been implemented or publicly announced by Registrant.

5. The responses given herein, or the production of documents or tangible things, by Registrant in response to any one or more of the Document Requests, shall not be deemed to waive any claim of privilege or immunity Registrant may have as to any response, document, or thing, or any question or right of objection as to competency, relevance, materiality, or admissibility, or any objection Registrant may have as to a demand for further response to these or other discovery requests.

6. Nothing contained herein may be construed as an admission related to the existence or non-existence of any document, and no response is an admission respecting the relevance or admissibility in evidence of any statement or characterization contained in the discovery requests.

7. Redaction of any information from any document produced by Registrant in response to Petitioner's discovery requests shall not be deemed to waive any objections Registrant may have to the production of unredacted versions of such documents.

8. The responses to Petitioner's discovery requests, when made, shall be made without waiver of, or prejudice to, any objections herein made or hereafter made, and all such objections are hereby expressly reserved.

9. Petitioner's discovery requests are premature, as discovery is ongoing. Registrant will not be limited by its responses herein if, as this matter progresses, Registrant gathers additional information responsive to Petitioner's discovery requests.

10. These general objections are applicable to each specific response herein without further reference. The insertion of specific objections in the response to any discovery request shall not be construed as a waiver of such objection in any other response.

RESPONSES

REQUEST FOR PRODUCTION NO. 1:

All documents referred to by Registrant in Registrant's Initial Disclosures in this proceeding.

RESPONSE:

Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 2:

The documents requested to be identified in Petitioner's First Set of Interrogatories served on Respondent concurrently herewith.

RESPONSE:

Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 3:

The documents referenced or identified by Registrant in response to Petitioner's First Set of Interrogatories.

RESPONSE:

Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 4:

Representative documents that list, show, explain or describe any goods or services sold or offered for sale in connection with the CHUBB TRAVEL SMART Mark, including without limitations, each catalogue, brochure, publication, website, and/or online, electronic, audio, and/or video materials and/or file.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant understands what Petitioner believes is "representative." Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 5:

A specimen, sample, color photocopy or photograph of each sign, brochure, website, handbill, stationery, advertisement, business card, warranty, identification card, display, pre-print contract or form, decal, badge, label, and other advertising, promotional, and/or online, electronic, audio and/or video materials on which the CHUBB TRAVEL SMART Mark has been displayed or has appeared, and/or is intended to be used.

RESPONSE:

Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 6:

All materials that have been produced, drafted, or proposed for use, including mock-ups for same, which display, refer or relate, in any way, to the CHUBB TRAVEL SMART Mark, whether or not such have ever been used, displayed, and/or disseminated.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad, unduly vague and ambiguous. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 7:

A specimen, sample, color photocopy or photograph of each and every document and thing bearing the CHUBB TRAVEL SMART Mark, or to which the CHUBB TRAVEL SMART Mark is affixed, whether or not such material ever has been used, distributed, disseminated, or displayed.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad, unduly vague and ambiguous, and to the extent that it seeks documents that are protected by the

attorney-client privilege. Registrant further objects to this Request as duplicative of Request No. 5. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 8:

Representative documents supporting Registrant's basis for verifying that it first used and sold "downloadable mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool" marked with the CHUBB TRAVEL SMART Mark at least as early as 2016.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant understands what Petitioner believes is "representative." Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 9:

Representative documents showing Registrant first used and sold "downloadable mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool" marked with the CHUBB TRAVEL SMART Mark prior to 2016.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant understands what Petitioner believes is “representative.” Notwithstanding the General Objections and the foregoing objections, and without waiving the same, no such documents exist because Registrant’s use of the CHUBB TRAVEL SMART mark commenced on or about January 15, 2016.

REQUEST FOR PRODUCTION NO. 10:

With respect to the earliest date on which Registrant will rely in this proceeding to establish Registrant’s rights in the CHUBB TRAVEL SMART Mark, all documents that evidence, support, refer or relate to such claim or rights in the CHUBB TRAVEL SMART Mark by Registrant as of that date.

RESPONSE:

Notwithstanding the General Objections, Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board’s standard protective order.

REQUEST FOR PRODUCTION NO. 11:

Representative examples of social media, marketing, promotional, and/or sales materials, including marketing plans, relating to the Registrant’s Goods/Services in connection with the CHUBB TRAVEL SMART Mark between 2016 and present.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant understands what Petitioner believes is “representative.” Moreover, Registrant objects to this

request to the extent that it seeks documents that are protected by the attorney-client privilege. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available those non-privileged, responsive documents in its possession, custody or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 12:

All social media, marketing, promotional, and/or sales materials, including marketing plans, relating to the Registrant's Goods/Services in connection with the CHUBB TRAVEL SMART Mark prior to 2016.

RESPONSE:

Subject to the General Objections, Registrant objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, no such documents exist because Registrant's use of the CHUBB TRAVEL SMART mark commenced on or about January 15, 2016. From March 17, 2015 until January 15, 2016, Registrant had been using the ACE TRAVEL SMART mark in connection with its goods now identified by the CHUBB TRAVEL SMART mark.

REQUEST FOR PRODUCTION NO. 13:

All representative documents describing the types of customers to whom Registrant advertises, promotes and/or renders Registrant's Goods/Services in connection with Registrant's CHUBB TRAVEL SMART Mark.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant

understands what Petitioner believes is “representative.” Moreover, Registrant objects to this request as it is overly broad, unduly vague and ambiguous, and burdensome. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant’s possession, custody, or control, if any, for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board’s standard protective order.

REQUEST FOR PRODUCTION NO. 14:

All documents that evidence, support, refer or relate to Registrant’s knowledge of Petitioner or Petitioner’s TRAVELSMART mark and/or the circumstances under which such knowledge was obtained, including but not limited to all documents in Registrant’s possession referring or relating to Petitioner or Petitioner’s TRAVELSMART mark.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad, unduly vague and ambiguous, and to the extent that it seeks documents that are protected by the attorney-client privilege or attorney work-product doctrine. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant’s possession, custody, or control, if any, for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board’s standard protective order.

REQUEST FOR PRODUCTION NO. 15:

All documents which refer or relate to Petitioner’s TRAVELSMART mark.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad, unduly vague and ambiguous, and to the extent that it seeks documents that are protected by the

attorney-client privilege or attorney work-product doctrine. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control, if any, for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 16:

Documents sufficient to show each instance in which a person has inquired or commented upon any relationship between Registrant and Petitioner or their respective goods/services.

RESPONSE:

To the best of Registrant's knowledge, no such documents exist. To the extent responsive, non-privileged documents, if any, are located during Registrant's document review, they will be made available to Petitioner for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 17:

All documents relating and/or referring to the channels of trade through which Registrant's Goods/Services have been provided and/or in connection with the CHUBB TRAVEL SMART Mark.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as it is overly broad, unduly vague and ambiguous, and burdensome. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents in Registrant's possession, custody, or control, if any, for review and

copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 18:

All documents that evidence, support, refer, or relate to any license, agreement, other grant or transfer of trademark rights relating to the CHUBB TRAVEL SMART Mark.

RESPONSE:

To the best of Registrant's knowledge, no such documents exist. To the extent responsive, non-privileged documents, if any, are located during Registrant's document review, they will be made available to Petitioner for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 19:

Representative photographs of Registrant's Goods/Services displaying the CHUBB TRAVEL SMART Mark.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad and unduly vague and ambiguous, in particular because it assumes incorrectly that Registrant understands what Petitioner believes is "representative." Notwithstanding the General Objections and the foregoing objections, Registrant will produce relevant, responsive, non-privileged documents within its possession, custody, or control for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 20:

All documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to the CHUBB TRAVEL SMART Mark.

RESPONSE:

To the best of Registrant's knowledge, no such documents exist outside of the subject cancellation proceeding. To the extent responsive, non-privileged documents, if any, are located during Registrant's document review, they will be made available to Petitioner for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 21:

All documents relating Registrant's decision to offer mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as overly broad, unduly vague and ambiguous because it does not limit the scope of the request to the CHUBB TRAVEL SMART trademark. Moreover, Registrant objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege or attorney work-product doctrine. Notwithstanding the General Objections and the foregoing objections, and without waiving the same, Registrant will make available responsive, non-privileged documents regarding Registrant's decision to offer mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool under the CHUBB TRAVEL SMART trademark in Registrant's possession, custody, or control, if any, for review and copying pursuant to Rule 34 of the Federal Rules of Civil Procedure and subject to the Board's standard protective order.

REQUEST FOR PRODUCTION NO. 22:

All documents that support any contention made by you in this case.

RESPONSE:

Subject to the General Objections, Registrant objects to this request as it is a premature contention document request.

REQUEST FOR PRODUCTION NO. 23:

All documents that do, or may, support any claim of Registrant herein, and/or which Registrant believes would be admissible evidence on its behalf at the trial of this case.

RESPONSE:

Registrant will make available those non-privileged, responsive documents in its possession, custody or control for inspection and copying.

BLANK ROME LLP

Dated: September 30, 2019

/matthew homyk/

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Inc.*

CERTIFICATE OF SERVICE

I, Matthew A. Homyk, do hereby certify that I have on the 30th day of September, 2019, served via electronic mail, the foregoing Registrant's Responses to Opposer's First Set of Requests for Production of Documents to the following counsel of record:

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Matthew A. Homyk