

TTAB



DX RESPONSES- NO FEE

02-11-2003

rademark Law Office: 114

U.S. Patent & TMO/TM Mail Rcpt Dt. #26

Serial No.: 76/279,718

MARK. GRANGE INSURANCE GROUP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Grange Insurance Group

Attorney Docket No. GRIG226741

Serial No.: 76/279,718

Trademark Attorney: Eugenia K. Martin

Filed: July 3, 2001

Law Office: 114

Mark: GRANGE INSURANCE GROUP

International Class: 36

APPLICANT'S APPEAL BRIEF

Seattle, Washington 98101

February 7, 2003

TO THE COMMISSIONER FOR TRADEMARKS:

TABLE OF CONTENTS

INTRODUCTION..... 2

JURISDICTION..... 2

BACKGROUND AND PROCEDURAL HISTORY..... 2

ISSUE ON APPEAL..... 3

ARGUMENT..... 3

 License Agreement Rights..... 3

 Absence of Actual Confusion in Purchasing Environment..... 4

CONCLUSION..... 5

TABLE OF AUTHORITIES

FEDERAL CASES

In re General Motors Corp., 23 U.S.P.Q.2d 1465 (TTAB 1992)..... 4

In re Software Design, Inc., 220 U.S.P.Q. 662 (TTAB 1983)..... 5

FEDERAL STATUTES

15 U.S.C. § 1070 and 37 C.F.R. § 2.142..... 2

LAW OFFICES OF
 CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
 1420 Fifth Avenue
 Suite 2800
 Seattle, Washington 98101
 206.682.8100

K

INTRODUCTION

This is an appeal from the final refusal to register U.S. Trademark Application Serial No. 76/279,718 for the mark GRANGE INSURANCE GROUP. The final refusal was mailed by the Trademark Office on June 4, 2002, and a Notice of Appeal was filed on December 4, 2002. The registration of Appellant's mark GRANGE INSURANCE GROUP was refused on the basis that the mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration Nos. 1535724, 1604932, 1663622, and 1636326 as to be likely to cause confusion, or to cause mistake, or to deceive.

JURISDICTION

The jurisdiction of the Trademark Trial and Appeal Board is invoked under the provisions of 15 U.S.C. § 1070 and 37 C.F.R. § 2.142.

BACKGROUND AND PROCEDURAL HISTORY

The present application to register Appellant's mark GRANGE INSURANCE GROUP in International Class 36 was filed in the United States Patent and Trademark Office on July 3, 2001. In a first Office Action, mailed August 28, 2001, registration on the Principal Register was refused under Trademark Act § 2(d) based on a determination that there was a likelihood of confusion between Appellant's mark and other registered marks.

In answer to the first Office Action, Appellant filed a response on February 28, 2002. In this response, Appellant resolved issues with the description of services and submitted a disclaimer, and argued that Appellant has a right to use the term "Grange" in its trademark because of a preexisting license agreement and because the remaining portions of Appellant's and Registrant's marks are not confusingly similar.

In the second and final Office Action, mailed June 4, 2002, the Examining Attorney again refused registration under Trademark Act § 2(d) based on a likelihood of confusion, the

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

similarities of the marks, and the similarities of the services. In response to this finding, Appellant has submitted this appeal.

ISSUE ON APPEAL

The following ultimate issue is before the Trademark Trial and Appeal Board in the present appeal:

Whether there is a likelihood of confusion between Appellant's mark GRANGE INSURANCE GROUP and the marks in U.S. Registration Nos. 1535724, 1604932, 1663622, and 1636326.

In support of the present appeal, Appellant relies upon the arguments set forth below and the arguments made in the previously filed response.

ARGUMENT

License Agreement Rights

In order to determine the scope of protection afforded to a trademark, it is necessary to determine the strength of the mark. The strength of the mark is primarily determined by its placement on the spectrum of distinctiveness. In the current situation, the Trademark Examiner determined that there is a likelihood of confusion between Appellant's proposed mark GRANGE INSURANCE GROUP and previously registered trademarks also incorporating the terms "Insurance" and "Grange." Clearly, the term "Insurance" is a common term used in trademarks for insurance companies. It is, therefore, highly descriptive if not generic and is not afforded any significant protection.

According to the Third Edition of the *American Heritage College Dictionary*, the other term of concern, "Grange" is defined as (1) G. an association of farmers founded in the United States in 1867. (b) One of the branch lodges of this association. (2) Chiefly British. A farm especially the residence and outbuildings of a gentleman farmer. (3) Arabic. A granary.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

(Page 592, Third Edition, *American Heritage College Dictionary*.)

Of primary interest in this situation is the first definition, i.e., an association of farmers founded in the United States in 1867. The National Grange of the Order of Patrons of Husbandry, better known as the "National Grange," is the owner of several federal trademark registrations including THE GRANGE FOUNDATION, GRANGE, and NATIONAL GRANGE. Appellant's roots stem from the National Grange and Appellant currently has a license agreement with the National Grange for use of the term "Grange." Based on the highly descriptive nature of the term "Insurance," the fact that as a licensee of the National Grange, Appellant has a right to use the term "Grange" in its trademark and because the remaining portions of applicant's and registrant's marks are not confusingly similar, Appellant respectfully submits that Registrant's marks should not be a bar to registration of Appellant's mark.

Absence of Actual Confusion in Purchasing Environment

There has been a long period of contemporaneous use without any actual confusion having occurred between the mark for which registration is sought and the marks upon which the rejection is based. *See In re General Motors Corp.*, 23 U.S.P.Q.2d 1465, 1470 (TTAB 1992). Specifically, Appellant has continuously used the term "Grange" in connection with its services since at least as early as 1932. Appellant's marks are used with respect to insurance services. Registrant has federal trademark registrations for the marks G GRANGE LIFE INSURANCE (U.S. Trademark Reg. No. 1,636,326), G GRANGE INSURANCE (U.S. Trademark Reg. No. 1,663,662), and G GRANGE LIFE INSURANCE YOUR PARTNER IN PROTECTION (U.S. Trademark Reg. Nos. 1,604,932 and 1,535,724). Registrant's marks have been used since 1989 in insurance underwriting services in the field of property, casualty, life, accident, and health.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Decisions made by sophisticated purchasers that concern expensive products or services and that are made after careful examinations of the products or services are less likely to subject to a likelihood of confusion even if the marks are highly similar. *See, e.g. In re Software Design, Inc.*, 220 U.S.P.Q. 662 (TTAB 1983). Here, Appellant and Registrant each have their own distinctive labeling and advertising style, and despite over thirteen years of concurrent use, Appellant is not aware of any confusion between the marks. Appellant submits that there is no likelihood of confusion between Appellant's marks and Registrant's marks because although they share similar words, because of their different appearances and difference in sound when spoken, the marks convey different commercial impressions, thereby minimizing any likelihood of confusion arising from concurrent use in connection with similar services.

CONCLUSION

For the foregoing reasons, Appellant submits that the mark GRANGE INSURANCE GROUP is not likely to cause confusion, mistake, or to deceive despite the similarities with the marks in U.S. Registration Nos. 1535724, 1604932, 1663622, and 1636326. Accordingly, Appellant

////
////
////
////
////
////
////
////
////
////
////

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

respectfully requests that the rejection in the present application by the Examining Attorney be reversed and the application be allowed.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Claire Foley

Direct Dial No. 206.695.1779

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

Date:

February 1, 2003

Patricia Gubble

CF:pag/gm

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100