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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/279718

**MAY 12 2003**

**APPLICANT:** Grange Insurance Association

**CORRESPONDENT ADDRESS:**

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2900 Crystal Drive  
Arlington, VA 22202-3514  
**ecom114@uspto.gov**

**MARK:** GRANGE INSURANCE GROUP

**CORRESPONDENT'S REFERENCE/DOCKET NO:** GRIG226741

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Grange Insurance Association	BEFORE THE
Trademark:	GRANGE INSURANCE GROUP	TRADEMARK TRIAL
Serial No:	76/279718	AND
Attorney:	Claire Foley	APPEAL BOARD
Address:	Christensen O'Connor Johnson Kindness 1420 Fifth Avenue Suite 2800 Seattle, WA 98101	ON APPEAL

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's final refusal to register the mark **GRANGE INSURANCE GROUP** which will be used with property and casualty insurance underwriting services. The examining attorney refuses registration on the Principal Register

because the applicant's mark is likely to be confused with the marks in Registration No. 1,535,724, GRANGE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,604,932, GRANGE LIFE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,636,326, GRANGE LIFE INSURANCE and design, and Registration No. 1,663,622, GRANGE INSURANCE and design. All four marks are used for insurance underwriting services. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §1207.01.

### ISSUE

The sole issue on appeal is whether the applicant's mark, GRANGE INSURANCE GROUP, is confusingly similar to the marks in Registration No. 1,535,724, GRANGE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,604,932, GRANGE LIFE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,636,326, GRANGE LIFE INSURANCE and design, and Registration No. 1,663,622, GRANGE INSURANCE and design, when used with identical services.

### FACTS

On July 3, 2001, the applicant sought to register the proposed mark GRANGE INSURANCE GROUP for insurance underwriting services, in International Class 36. In an office action dated August 28, 2001, the examining attorney refused registration under Trademark Act Section 2(d) because the mark was confusingly similar to the marks in Registration No. 1,535,724, GRANGE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,604,932, GRANGE LIFE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No.

1,636,326, GRANGE LIFE INSURANCE and design, and Registration No. 1,663,622, GRANGE INSURANCE and design, because the recitation of services was indefinite, and because the wording "INSURANCE GROUP" required a disclaimer under Trademark Act Section 6. In a response dated March 4, 2002, the applicant provided an acceptable recitation of services and the required disclaimer and argued that the mark was not confusingly similar to the cited marks. The refusal to register under Trademark Act Section 2(d) was made final on June 4, 2002, and this appeal ensued.

### ARGUMENTS

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

#### I. Relatedness of the services

In the present case, there is no question that the services offered by both the applicant and the registrant under their respective marks are related because the services are identical. Both parties

use the mark in relation to insurance underwriting services in the fields of property and casualty insurance.

## II. Similarity of the marks

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.* While the examining attorney must look at the marks in their entireties under Section 2(d), one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). TMEP §1207.01(b)(viii). As the applicant states in the brief and in the response to the office action, "INSURANCE" is highly descriptive if not generic and is not afforded any significant protection. The word "GRANGE" is the dominant feature of the marks at issue. While two of the registered marks contain a slogan, the word "GRANGE" is the word that clearly indicates the source of the services. It is presented in large type, and when grouped with words such as "LIFE INSURANCE" and "INSURANCE," it stands out to indicate the source and nature of the services.

The examining attorney must consider the marks in their entireties in determining whether there is likelihood of confusion. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281

(Fed. Cir. 1984); *In re MCI Communications Corp.*, 21 USPQ2d 1535 (Comm'r Pats. 1991). So, while "INSURANCE," "LIFE INSURANCE," and "INSURANCE GROUP" may all be disclaimed, they remain part of the mark, emphasizing the source and nature of the services performed – Grange Insurance Group and Grange Life Insurance.

The registered marks all contain the same design element – a waving flag with the letter "G" in the upper left corner. This does not diminish the similarity between the applicant's mark and the registered marks. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). TMEP §1207.01(c)(ii). In the case at hand, the literal portions of both marks are nearly identical in appearance, sound and meaning. The addition of the design element to the registered marks does not obviate the similarity between the marks. *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975). TMEP §§1207.01(b)(viii) and 1207.01(c)(ii). Furthermore, the applicant has presented their mark in typed form, which permits them to present the mark in virtually any manner, including one with design and stylization elements similar to those of the registrant. TMEP §1207.01(c)(iii).

Two of the registered marks, Nos. 1,535,724 and 1,604,932, contain the slogan "YOUR PARTNER IN PROTECTION." This, however, does not significantly diminish the likelihood of confusion. If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980). TMEP §1207.01(b). Furthermore, the slogan

is paired with words that indicate the source of the services, words which are virtually identical to the mark proposed by the applicant. The dominant feature of the registered marks remains the word "GRANGE."<sup>1</sup>

### **III. Absence of actual confusion is not dispositive**

The applicant asserts that there has been no actual confusion during the period of contemporaneous use. However, the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. TMEP §1207.01(d)(ii).

### **CONCLUSION**

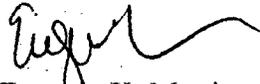
The applicant's mark, GRANGE INSURANCE GROUP, is confusingly similar to the marks in Registration No. 1,535,724, GRANGE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,604,932, GRANGE LIFE INSURANCE YOUR PARTNER IN PROTECTION and design, Registration No. 1,636,326, GRANGE LIFE INSURANCE and design, and Registration No. 1,663,622, GRANGE INSURANCE and design because it has a highly similar appearance, sound, meaning and overall commercial impression, and because it is used on services which are identical to those of the registrant. For the foregoing reasons, the

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<sup>1</sup> The applicant asserts that because The National Grange Order of Patrons of Husbandry (The "National Grange") has entered into a licensing agreement with the applicant, the applicant has the right to use the word "Grange" in its trademarks. While this licensing agreement might have some relevance if the cited registered marks were owned by the National Grange, a license from a third party does not convey any rights to the applicant with regard to registered marks cited in this case. The fact remains that there are four previously registered marks which are confusingly similar to the mark proposed by the applicant.

examining attorney respectfully requests that the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,



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