

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Modern Woodmen of America

Serial No. 77203020

Thomas J. Moore of Bacon & Thomas, PLLC for Modern Woodmen of America.

Cory Boone, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Holtzman, Taylor and Kuczma
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

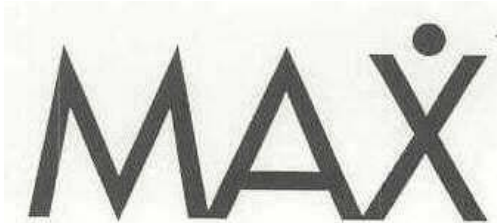
Modern Woodmen of America, an Illinois corporation ("applicant"), filed an application seeking registration of the mark MaxCL in standard character form for the following services in Class 36, as amended:

fraternal services, namely, life insurance underwriting.

The examining attorney issued a final refusal to register the mark pursuant to § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), citing Registration Nos.

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2866938 and 3108696 as a bar to registration.¹ Registration No. 2866938 is for the mark MAX in typed drawing format² and Registration No. 3108696 is for the following non-standard character mark:



Both registrations are for "underwriting of property and casualty insurance" in Class 36 and are owned by MutualAid eXchange Reciprocal Insurance Co.

Applicant and the examining attorney submitted briefs, and appeared at an oral hearing before the Board.

Likelihood of Confusion

Our determination of likelihood of confusion under § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567

¹ Registration No. 2866938 issued July 27, 2004, §§ 8 and 15 combined declaration accepted and acknowledged April 15, 2010; Registration No. 3108696 issued June 27, 2006, §§ 8 and 15 combined declaration accepted and acknowledged February 13, 2012.

² In 2003, Trademark Rule 2.52(a) was amended to refer to "typed" drawings as "standard character" drawings. See Trademark Rule 2.52(a); 37 C.F.R. § 2.52(a); TMEP § 807.03(i).

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(CCPA 1973). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. The similarity or dissimilarity of the marks as to appearance/sound/meaning and commercial impression

We first consider the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, meaning and commercial impression. *du Pont*, 177 USPQ at 567.

Because the design portion of cited Registration No. 3108696 presents an additional point of difference with applicant's mark, we confine our analysis to the issue of likelihood of confusion between applicant's mark and the MAX mark in cited Registration No. 2866938. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the Max and Design mark in Registration No. 3108696; conversely, if there is no likelihood of confusion between applicant's mark and the MAX mark in Registration No. 2866938, then there would be no likelihood of confusion with the MAX and

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Design mark in Registration No. 3108696. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

To the extent that applicant's mark and the cited mark in Registration No. 2866938 begin with the core term "MAX," the marks are similar in sound, appearance and meaning.

In arguing the different commercial impressions between the marks, applicant contends that the letters "CL" at the end of its mark would be viewed as arbitrary and distinctive, serving to distinguish its mark from the cited marks.³ However, adding a term to a mark does not necessarily obviate the similarity or overcome any likelihood of confusion under § 2(d). See *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glassworks*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS). Given that the letters CL do not appear to have any meaning, the addition of CL in applicant's mark is likely to be viewed as a variant of the cited mark instead of distinguishing applicant's mark from the cited mark.

When considering the similarity of the marks, the test is not whether the marks can be distinguished when

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subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

"MAX" is the focus in both applicant's MaxCL mark where MAX has prominence as the first word, and in the cited mark which consists solely of the word "MAX." See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (consumers are generally more inclined to focus on the first word, prefix or syllable in a mark); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (often the first part of a mark is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions).

Applicant submitted the initial pages of a summary chart from a TESS search listing 100 of 402 records for marks containing the word "max" in Class 36 arguing that

³ Applicant's Appeal Brief p. 8.

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"max" has been incorporated into numerous registered marks that do not result in confusion.⁴ Third-party registrations may be submitted to demonstrate the meaning of a word which comprises a mark, or a portion thereof, in the same way dictionary definitions are used. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). However, applicant failed to submit soft copies of the registrations or the electronic equivalent (i.e., complete printouts taken from any of the USPTO's automated systems, including TESS) in order to make the registrations of record.

Because the examining attorney failed to object to such evidence or to advise applicant of the insufficiency of this evidence, we deem the objection to be waived, and consider this evidence. See *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) and TBMP § 1208.02 (3rd edition, 1st revision June 2012). Unfortunately, critical information such as the nature of the services identified in the listed registrations is not contained in applicant's TESS summary chart. Additionally, many of the entries indicate the status of the corresponding registration or application as "dead" and as

⁴ See Applicant's 5/28/2009 Response to Suspension Inquiry.

such are not relevant. Therefore, the summary TESS chart is not probative evidence and entitled to no weight.⁵

In view of the foregoing, the marks are similar in appearance, sound, meaning and commercial impression.

B. The similarity or dissimilarity and nature of the services, channels of trade and classes of consumers

We turn next to the *du Pont* factor involving the similarity or dissimilarity of applicant's services ("fraternal services, namely, life insurance underwriting"), in relation to the services in the cited registration ("underwriting of property and casualty insurance"). It is well-settled that the issue of likelihood of confusion between applied for and registered marks must be determined on the basis of the services as they are identified in the involved application and registrations. *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

The essence of the services provided by applicant and the owner of the cited registration are the same, namely,

⁵ Nor do we consider applicant's citation to *Max Capital*, 93 USPQ2d at 1246, where the Board determined that MAX has a suggestive meaning in connection with insurance services, and held that Registration No. 2866938, which is the cited registration in this case, is not entitled to a broad scope of protection. The Board's finding in *Max Capital* was based on evidence of third-party registrations and a dictionary definition

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underwriting insurance. The services need not be identical or directly competitive to find a likelihood of confusion.

See In re Melville, 18 USPQ2d 1386, 1388 (TTAB 1991).

Rather, they need only to be related in some manner or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under

circumstances that would give rise to the mistaken belief that the services come from a common source. *See On-line*

Careline Inc. v. America Online Inc., 229 F.3d 1080, 56

USPQ2d 1471, 1475-76 (Fed. Cir. 2000) and *In re Total*

Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999).

In support of the relatedness of applicant's life insurance underwriting services and the property and casualty underwriting services in the cited registration, the examining attorney submitted internet evidence and third-party registrations. This evidence demonstrates that the same entities underwrite these three types of insurance.

The websites for insurance companies show that they offer life insurance as well as property and casualty insurance under a single mark. The State Farm Insurance website, located at www.statefarm.com, contains a link

that are not part of the record in this case. See Applicant's Reply Brief p. 3.

labeled INSURANCE "Auto, Home, Life & More;" at www.thehartford.com, The Hartford insurance company lists "Auto Insurance, Life Insurance, Homeowners Insurance" as some of its products; similarly, the websites of Prudential and Farmers Insurance located at www.prudential.com and www.farmers.com, advertise the availability of Life, Auto and Home insurance products.⁶ (As explained at the U.S. Department of Labor's Bureau of Labor Statistics' website, www.bls.gov, property and casualty insurance underwriting covers automobile, homeowners, fire or marine insurance.)⁷

The examining attorney also submitted seventeen use-based third-party registrations owned by fourteen different owners that serve to suggest that applicant's life insurance underwriting and registrant's property and casualty underwriting services are of a kind that may emanate from a single source.⁸ The registrations listed below demonstrate the relatedness of life insurance and property and casualty insurance underwriting services:⁹

⁶ See attachments to 12/14/2010 Request for Reconsideration Denied.

⁷ See attachment to 12/14/2010 Request for Reconsideration Denied.

⁸ These third-party registrations and others submitted by the examining attorney were attached to the 6/7/2010 Office Action.

⁹ Only the services that are pertinent to the services identified in applicant's application and the cited registration are listed in the chart.

Registration No.	Mark	Services	OWNER
1087834	State Farm Insurance Auto Life Fire and Design	UNDERWRITING LIFE, CASUALTY AND FIRE INSURANCE BUSINESS	State Farm Mutual Automobile Insurance Company Corporations
2376437	American International Group	UNDERWRITING SERVICES, NAMELY, AUTOMOBILE, PROPERTY AND CASUALTY, LIFE . . .	American International Group, Inc.
2599438	Metlife Bank	. . . UNDERWRITING, BROKERAGE AND ADMINISTRATION SERVICES FOR INDIVIDUAL AND GROUP LIFE, DISABILITY, LONG TERM CARE, DENTAL, PROPERTY AND CASUALTY INSURANCE . . .	Metropolitan Life Insurance Company
2646316	Prudential Financial	INSURANCE AND FINANCIAL SERVICES, NAMELY, INSURANCE UNDERWRITING, ADMINISTRATION AND AGENCY SERVICES IN THE FIELDS OF LIFE, HEALTH, PROPERTY AND CASUALTY, DISABILITY, LONG TERM CARE, AND ANNUITIES;	The Prudential Insurance Company of America
3686546	Farmers Value Insurance Package	INSURANCE UNDERWRITING SERVICES IN THE FIELD OF PROPERTY AND CASUALTY INSURANCE, AUTOMOBILE, HOMEOWNERS, RECREATIONAL VEHICLES, WORKERS' COMPENSATION, BUSINESS AND COMMERCIAL INSURANCE, AND LIFE INSURANCE AND ANNUITIES; . . .	Farmers Group Inc.
3196175	Nationwide Insurance	INSURANCE UNDERWRITING AND BROKERAGE FEATURING ALL TYPES OF INSURANCE, INCLUDING FIRE, LIFE, AND CASUALTY	Nationwide Mutual Insurance Company
3215402	AIG Marketing, Inc.	INSURANCE UNDERWRITING IN THE FIELD OF PROPERTY AND CASUALTY, LIFE AND HEALTH, AND AUTO INSURANCE SERVICES	American International Group, Inc.
3293877	Webster Insurance	INSURANCE AGENCY, BROKERAGE, UNDERWRITING AND ADMINISTRATION SERVICES IN THE FIELDS OF LIFE, ACCIDENT, HEALTH, DISABILITY, LONG-TERM CARE, TRAVEL ACCIDENT, MANAGEMENT AND PROFESSIONAL LIABILITY, CREDIT AND	Webster Financial Corporation

		EXPORT, TRAVEL, SURETY, FIDELITY BONDS, PROPERTY, CASUALTY, INLAND AND OCEAN MARINE, BOILER AND MACHINERY, AUTOMOBILE, HOME AND FIRE INSURANCE, CLAIMS ADMINISTRATION AND SAFETY ENGINEERING SERVICES;	
3498513	Old South and Design	. . . INSURANCE UNDERWRITING, INSURANCE ACTUARIAL SERVICES, ALL THE AFOREMENTIONED SERVICES IN THE FIELDS OF LIFE, HEALTH, HOME, ACCIDENT, FIRE, AUTO, DENTAL AND MEDICAL INSURANCE	Walnut Advisory Corporation
3573779	Citi Never Sleeps	INSURANCE SERVICES, NAMELY, UNDERWRITING, BROKERAGE, ADMINISTRATION AND AGENCY SERVICES IN CONNECTION WITH LIFE, ACCIDENT, DISABILITY, PROPERTY AND CASUALTY, HOMEOWNERS, AUTO, CREDIT, DEBT PROTECTION AND FIRE; AND UNDERWRITING AND BROKERAGE OF PROPERTY, CASUALTY AND LIFE INSURANCE POLICIES AND ANNUITY CONTRACTS	Citigroup Inc.
3663100	First National Bank and Design	. . . INSURANCE SERVICES, NAMELY, INSURANCE UNDERWRITING, BROKERAGE AND EXTENDED WARRANTY CONTRACTS IN THE FIELDS OF LIFE, HEALTH, ACCIDENT, FIRE, MARINE, MEDICAL AND PRE-PAID HEALTH CARE AND LEGAL SERVICES;. . .	F.N.B. Corporation
3686546	Farmers Value Insurance Package	INSURANCE UNDERWRITING SERVICES IN THE FIELD OF PROPERTY AND CASUALTY INSURANCE, AUTOMOBILE, HOMEOWNERS, RECREATIONAL VEHICLES, WORKERS' COMPENSATION, BUSINESS AND COMMERCIAL INSURANCE, AND LIFE INSURANCE AND ANNUITIES; INSURANCE CLAIMS PROCESSING, INSURANCE CLAIMS ADMINISTRATION, . . .	Farmers Group Inc.
3706053	Western Prairie	. . . INSURANCE UNDERWRITING,	Walnut Advisory

		INSURANCE ACTUARIAL SERVICES, ALL THE AFOREMENTIONED SERVICES IN THE FIELDS OF LIFE, HEALTH, HOME, ACCIDENT, FIRE, AUTO, DENTAL AND MEDICAL INSURANCE, . . .	Corporation
3731394	The Hartford and Design	. . . INSURANCE SERVICES, NAMELY, INSURANCE UNDERWRITING, ISSUING, ADMINISTRATION, AGENCY AND BROKERAGE SERVICES IN THE FIELDS OF . . . INDIVIDUAL LIFE INSURANCE, AUTO INSURANCE, ACCIDENT INSURANCE, HOMEOWNERS INSURANCE, FLOOD INSURANCE, FIRE INSURANCE, REINSURANCE, PROPERTY AND CASUALTY INSURANCE . . .	Hartford Fire Insurance Company
3788055	TD Bank	INSURANCE UNDERWRITING SERVICES IN THE FIELDS OF TRAVEL, LIFE, HEALTH, ACCIDENT, FIRE, VEHICLE, PROPERTY AND CREDITOR; MUTUAL FUND INVESTMENT AND BROKERAGE SERVICES	The Toronto-Dominion Bank
3792501	Hummel Group and Design	INSURANCE UNDERWRITING SERVICES IN THE FIELDS OF AUTO, MOTORCYCLE, HOMEOWNERS, FARMS, RECREATIONAL VEHICLES, HOME-BASED BUSINESS, UMBRELLA LIABILITY, HEALTH, LIFE, LUMBER, COMMERCIAL PROPERTY AND LIABILITY . . .	Hummel Group Inc.
3795727	HCC	INSURANCE UNDERWRITING AND UNDERWRITING MANAGEMENT, INSURANCE BROKERAGE, REINSURANCE, AND INSURANCE CLAIMS ADMINISTRATION, ALL IN THE FIELDS OF ACCIDENT, HEALTH, LIFE, EXECUTIVE AND PROFESSIONAL ERRORS AND OMISSIONS, PROPERTY, CASUALTY, AND SPECIALTY INSURANCES . . .	HCC Insurance Holdings, Inc.

Although such registrations are not evidence that the marks shown therein are in use or that the public is

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familiar with them, they nonetheless have probative value to the extent they are based on use in commerce and serve to suggest that that the services listed therein are of a kind which may emanate from a single source under a single mark. See *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993) and TMEP § 1207.01(d)(iii).

The foregoing evidence produced by the examining attorney indicates that it is common for the same entity to provide underwriting of life insurance as well as property and casualty insurance. Thus, consumers encountering the insurance underwriting services of applicant and the cited registrant in connection with similar marks are likely to believe the services emanate from the same source.

We next consider the similarity or dissimilarity of the established and likely to continue trade channels for applicant's and registrant's respective services, and the condition under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing, under the third and fourth *du Pont* factors.

The amended identification of services limits the trade channel for applicant's services to those underwriting services provided as part of applicant's

fraternal services. Consistent with this limitation, applicant argues that there is no likelihood of confusion because potential customers would be restricted to members of its fraternal society.¹⁰ Unlike the subject application, the cited registration is not restricted with respect to trade channels. Because there is no limitation as to trade channels or classes of purchasers in the registration, we must presume that registrant's services are marketed in all normal trade channels for such services and to all normal classes of purchasers for such services. See *In Re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

While applicant's services are offered only to its members, its members are part of the general consuming public to which registrant's services are also presumably marketed and sold. Thus, applicant's members who may be interested in purchasing life insurance, upon seeing the property and casualty insurance services of registrant, may assume that applicant's MaxCL services are related or affiliated with the services provided by registrant under the MAX mark. To the extent that applicant's and registrant's insurance underwriting services are offered to applicant's members as part of the general consuming public, the channels of trade and classes of purchasers

¹⁰ Applicant's Appeal Brief pp. 8-9.

overlap. This overlap weighs in favor of a finding of likelihood of confusion, under the third and fourth *du Pont* factors. *In re Wilson*, 57 USPQ2d 1863, 1866 (TTAB 2001).

Applicant contends that the purchase of insurance is not an impulse purchase, but is made as part of a careful purchasing decision. According to applicant, potential purchasers of property and casualty insurance are persons who plan ahead and would exert care in selecting property and casualty insurance to ensure any claim is likely to be processed satisfactorily. Similarly, according to applicant, purchasers of life insurance who are motivated about the continued welfare of their dependents after their death, would also make a careful purchasing decision.¹¹ Other than applicant's argument, there is no evidence that purchasers of any type of insurance exercise a greater degree of care. Given the nature of insurance products, however, we agree that purchasers exert care when purchasing insurance. *See Max Capital Group*, 93 USPQ2d at 1248.

In view of the foregoing, the degree of care factor slightly favors applicant. On balance however, the *du Pont* factors of similarity of the goods, trade channels and customers favor a finding of likelihood of confusion.

C. Applicant's Ownership of Registration No. 3620338

Subsequent to the filing date of the subject application, applicant filed an application to register the mark "MaxCL Pro" for "insurance services, namely, underwriting, issuing and administration of life insurance." After the entry of a disclaimer of "Pro," this application matured into Registration No. 3620338 on May 12, 2009. Applicant argues that its potential customers, i.e., its members, would be likely to associate the present mark MaxCL with its registered MaxCL Pro mark and recognize applicant as the source of the services provided under the MaxCL mark.¹² Not only is there a lack of evidence to support any such association between applicant's marks, there is nothing that explains why customers would only associate the MaxCL mark with MaxCL Pro, and not also with the cited MAX mark.

With respect to applicant's existing registration for MaxCL Pro, we note that the Board is not bound by the prior decision of an examining attorney in allowing the foregoing mark for registration. It has been noted many times that each case must be decided on its own facts. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Accordingly, we are obligated to assess the

¹¹ Applicant's Appeal Brief pp. 10-11.

¹² Applicant's Appeal Brief, pp. 9, 11.

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registrability of applicant's mark on its own merits and not simply based on the existence of other registrations. This is particularly so when the mark involved in the existing registration is different from the mark in the subject application.

D. Balancing the factors

In view of the similarity of the marks in their entireties in sound, appearance, meaning and commercial impression, the relatedness of applicant's services to those in the cited registrations, and the overlap in the channels of trade and classes of customers, we find that applicant's mark MaxCL for the services identified in its application is likely to cause confusion with the MAX mark in Registration No. 2866938. Moreover, where the services of the applicant and cited registrant are "similar in kind and/or closely related" as they are here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); also see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

Inasmuch as any doubts as to likelihood of confusion must be resolved against applicant and in favor of

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registrant, we affirm the refusal to register. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register is affirmed.