

From: Twohig, Shannon

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/399607

MARK: CIS TEXAS

CORRESPONDENT ADDRESS:

TAWNYA R. WOJCIECHOWSKI
TRW LAW GROUP
1990 MACARTHUR BLVD STE 1150
IRVINE, CA 92612-8433



GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Superior Access Insurance Services,
Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

tawnya@trwlawgroup.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the examining attorney's final refusal to register the proposed mark CIS TEXAS in International Class 036 under Section 2(d) of the Trademark Act, as amended, 15 U.S.C. §1052(d). The refusal was issued on the grounds that applicant's mark, as used in connection with applicant's services, so resembles the marks CIS RISK GROUP (U.S. Registration No. 2969264) and CIS plus a triangle design (U.S. Registration No. 3385082) that it is likely to cause confusion, or to cause mistake, or to deceive. It is respectfully requested that the refusal be affirmed.

OBJECTION TO NEW EVIDENCE

The record in an application must be complete prior to the filing of an appeal; however, applicant has submitted additional evidence with its appeal brief. Of the approximately thirty-four third party registrations and pending applications submitted with the applicant's appeal brief, only three have been previously made of record.¹ Because the proposed evidence was untimely submitted, this evidence should not be considered. 37 C.F.R. §2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont'l Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

The Trademark Trial and Appeal Board need not take judicial notice of third-party registrations. *See, e.g., In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); *see* Fed. R. Evid. 201; 37 C.F.R. §2.122(a). To make third-party registrations part of the record, an applicant must submit copies of registrations from USPTO records prior to appeal. *Ruffin*, 66 USPQ2d at 1925 n.3; *Carolina*, 48 USPQ2d at 1543 n.2; TBMP §1208.02; TMEP §710.03. Applicant failed to do so. Accordingly, the third-party registrations submitted by applicant with its appeal brief should not be considered.

FACTS

¹ U.S. Registration No. 1299872 (cancelled July 16, 2005); U.S. Registration No. 2452720 (cancelled March 1, 2008) and U.S. Registration No. 3147799.

On February 18, 2008, applicant applied for registration on the Principal Register for the mark CIS TEXAS for the services “insurance brokerage services, insurance consultation services, wholesale insurance underwriting services in the fields of automobile, commercial automobile, marine, homeowners, apartment, fire, earthquake, flood, personal property, personal liability, personal umbrella, professional liability, contractor liability, life, health, accident, medical, worker's compensation, in-home business, commercial umbrella, unemployment, bond and multiple lines of business insurance” in International Class 036.

The Examining Attorney required a statement of the significance of CIS, a disclaimer of TEXAS, and refused registration of the mark due to a likelihood of confusion with U.S. Registration Nos. 2969264 and 3385082. The disclaimer and significance statement requirements were satisfied. Applicant’s arguments that there was no likelihood of confusion with the registered marks were unpersuasive and the refusal was made final. Applicant’s request for reconsideration was denied whereupon applicant filed its appeal brief.

ISSUE

The sole issue remaining on appeal is whether the proposed mark is likely to be confused with the marks in U.S. Registration Nos. 2969264 and 3385082.

ARGUMENTS

The applicant's proposed mark CIS TEXAS is likely to cause confusion, mistake, or deception with regards to the registrants' marks CIS and CIS RISK GROUP.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d).

All circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. See *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b). In comparing the goods and/or services, it is necessary to show that they are related in some manner. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

The applicant's proposed mark is CIS TEXAS for "insurance brokerage services, insurance consultation services, wholesale insurance underwriting services in the fields of automobile, commercial automobile, marine, homeowners, apartment, fire, earthquake, flood, personal property, personal liability, personal umbrella, professional liability, contractor liability, life, health, accident, medical, worker's compensation, in-home business, commercial umbrella, unemployment, bond and multiple lines of business insurance." The mark in U.S. Registration No. 3385082 is CIS enclosed in a triangle for "insurance agencies in the field of property, general business liability, automobile, workers' compensation, professional liability, employment practices, fidelity crime, equipment breakdown, excess liability and employee benefits liability." The mark in U.S. Registration No. 2969264 is CIS RISK GROUP, with RISK GROUP disclaimed, for "insurance services, namely, insurance underwriting, insurance claims administration, and insurance agencies in the field of property, casualty, life, automobile, boat, farm and ranch, flood, workers compensation, mortgage protection, renters, townhouse, condominium, and homeowners; insurance brokerage in the field of automobile insurance and home insurance."

A. The Marks Are Similar

When the proposed mark is compared to the cited registrations, applicant's mark is similar to the cited registrations in sound, appearance, and commercial impression. The proposed mark shares the identical text element CIS with both registrations. The letters CIS constitute the only text elements of the mark in U.S. Registration No. 3385082. The

presence of a design element in the mark in U.S. Registration No. 3385082 does not obviate a finding of likelihood of confusion. 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 and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). When calling for the services of the applicant or registrant in the marketplace, potential purchasers will use the identical letters CIS, rather than the triangle carrier design.

The letters CIS are the first text elements in both the proposed mark and the mark in U.S. Registration No. 2969264, with the remaining wording disclaimed in both marks. The first term or word in a mark is most likely to be impressed upon the mind of a consumer when purchasing goods or services. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Additionally, as the remaining wording has been disclaimed, the letters CIS are left as the dominant wording in the proposed mark CIS TEXAS and CIS RISK GROUP. While the disclaimed wording is certainly not ignored, disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Further, even if potential purchasers realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that applicant's goods and/or services sold under the "CIS TEXAS" mark constitute a new or additional product and/or services

line from the same source as the goods and/or services sold under the “CIS RISK GROUP” mark with which they are acquainted or familiar, and that “CIS TEXAS” is merely a variation of the registrant’s “CIS RISK GROUP” mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant’s marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer’s preexisting mark [ANDREA SIMONE] for its established line of clothing.”).

The letters CIS appear to be arbitrary for the identified services. Further, it is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures; that is, confusion is more likely between arbitrarily arranged letters than between other types of marks. *See, e.g., Weiss Assoc. v. HRL Assoc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM).

Applicant argues that other registrations exist containing the letters CIS. Applicant’s Brief at 4. Applicant has included a list of registrations in applicant’s brief and attached copies to the brief. However, only three of the registrations were properly made of record prior to the filing of applicant’s brief. As the remaining registrations were not properly made of record, they are of no evidentiary value here.

Regarding the remaining three registrations, the first registration, U.S. Registration No. 1299872, was cancelled July 16, 2005. As the registration is not a live mark, it is of little persuasive value. Even if the registration were live, it would not be persuasive, as the mark in that registration is significantly stylized such that the portion of the mark that

could be identified as CIS does not immediately look like the letters CIS. The second registration, U.S. Registration No. 2452720, was cancelled March 1, 2008. As the registration is not a live mark, it is also of little persuasive value. Even if the registration were live, it would be of little persuasive value, as the mark contains additional design elements and the services are limited to crop insurance. The third and final registration cited by the applicant and properly made of record is U.S. Registration No. 3147799. This single registration containing the letters CIS for insurance services is not persuasive, as the services are limited to a specific industry. Finally, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

Applicant has argued that “the public obviously knows how to distinguish each mark from the others by very minimal and subtle differences between the marks.” Applicant’s Brief at 6. Applicant appears to base this conclusion on a Google® search for the term CIS. This is unpersuasive because use of the term in the marketplace is not evidence that consumers are not confused. Applicant has not supplied any evidence showing a lack of confusion between the proposed mark and the cited registrations. Even if applicant had shown its purchasers were sophisticated, being sophisticated or knowledgeable purchasers in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

The applicant also argues that the examiner has come “to the completely unfounded conclusion that the letters CIS constitute the dominant part of Applicant’s mark.” Applicant’s Brief at 7. Applicant’s statement is incorrect. The proposed mark is CIS TEXAS. Applicant has disclaimed the term TEXAS. As previously stated above, descriptive wording is typically less significant when comparing marks for likelihood of confusion purposes. In the present instance, the term TEXAS is less significant because it merely identifies a geographic location. The letters CIS, in contrast, are an arbitrary arrangement of letters that applicant has previously stated have no meaning or significance in regards to the identified services. See Applicant’s Response of August 25, 2008 at 1. Considering the above, a finding that CIS is the dominant portion of the proposed mark is appropriate.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979). The average purchaser who retains a general

impression of trademarks is likely to believe that the services identified by the mark CIS TEXAS emanate from the same source as the services identified by the marks CIS RISK GROUP and CIS and design.

B. The Services of Applicant and Registrants are Highly Similar.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Rather, they need only 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 goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). In the present case, the services of the applicant and registrants are nearly identical.

The proposed mark identifies “insurance brokerage services, insurance consultation services, wholesale insurance underwriting services in the fields of automobile, commercial automobile, marine, homeowners, apartment, fire, earthquake, flood, personal property, personal liability, personal umbrella, professional liability, contractor liability, life, health, accident, medical, worker's compensation, in-home business, commercial umbrella, unemployment, bond and multiple lines of business insurance.” CIS RISK GROUP identifies “insurance services, namely, insurance underwriting, insurance claims administration, and insurance agencies in the field of property, casualty, life, automobile, boat, farm and ranch, flood, workers compensation, mortgage protection, renters, townhouse, condominium, and homeowners; insurance brokerage in the field of automobile insurance and home insurance.” CIS plus design identifies “Insurance agencies in the field of property, general business liability, automobile,

workers' compensation, professional liability, employment practices, fidelity crime, equipment breakdown, excess liability and employee benefits liability.”

Both the proposed mark and CIS RISK GROUP identify identical insurance underwriting services. The proposed mark and CIS RISK GROUP and CIS plus design identify closely related insurance services in the same insurance fields, such as workers' compensation. To address the question of whether the services of the applicant and registrants are related 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 goods and/or services come from a common source, the examining attorney previously attached copies of third party registrations identifying instances wherein applicant's insurance services emanated from the same source under the same mark as registrants' insurance services. See Office Actions of May 30, 2008; September 18, 2008 and November 14, 2008. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely insurance brokerage, insurance consultation (applicant's services) and insurance claims administration, insurance agencies (registrants' services), are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001).

Further, if the goods and/or services of the respective parties are “similar in kind and/or closely related,” as in the present case, 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 goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

Applicant's brief does not address the similarity of the services except to concede that "the services are admittedly very similar." Applicant's Brief at 6. The applicant does not dispute the similarity of the services or that the examining attorney has shown the relatedness of the services.

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002). As the proposed mark is similar in sound, commercial impression and meaning to the registered mark, and identifies closely related services, the proposed mark CIS TEXAS is likely to cause confusion with the registered marks CIS RISK GROUP and CIS plus design.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register the proposed mark under §2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis that applicant's proposed mark CIS TEXAS is likely to cause confusion, mistake or deception with regards to CIS RISK GROUP, U.S. Registration No. 2969264 and CIS plus design, U.S. Registration No. 3385082 be affirmed.

Respectfully submitted,

/Shannon M. Twohig/
Trademark Examining Attorney
Law Office 105
Phone: (571) 272-8855
Fax: (571) 273-9105

Thomas G. Howell
Managing Attorney
Law Office - 105