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Subject: U.S. TRADEMARK APPLICATION NO. 77600844 - ZURICH VIRTUAL
CONCIERGE - 287740-00568 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77600844

MARK: ZURICH VIRTUAL CONCIERGE



CORRESPONDENT ADDRESS:

DAVID V. RADACK
ECKERT SEAMANS CHERIN & MELLOTT LLC

600 GRANT STREET 44TH FLOOR
PITTSBURGH, PA 15219

GENERAL TRADEMARK INFORMATION:

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

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

APPLICANT: ZURICH INSURANCE COMPANY
LTD

CORRESPONDENT'S REFERENCE/DOCKET NO:

287740-00568

CORRESPONDENT E-MAIL ADDRESS:

dradack@eckertseamans.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark ZURICH VIRTUAL CONCIERGE for providing financial risk management information and insurance information via emails, personalized websites and electronic press releases and announcements. Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) on the grounds that the applicant's mark, ZURICH VIRTUAL CONCIERGE, is likely to be confused with the prior registered mark, VIRTUAL CONCIERGE, U.S. Registration No. 3,089,727 for business management consulting services.

FACTS

On October 27, 2008, the applicant, Zurich Insurance Company, (hereinafter referred to as applicant) filed application Serial No. 77/600844 to register ZURICH VIRTUAL CONCIERGE on the Principal Register for use in connection with “providing emails, personalized websites, and electronic press releases and announcements regarding insurance and risk management topics.”

On February 2, 2009, the trademark examining attorney issued an Office Action in which she refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because applicant’s mark, when used in connection with the above identified services, was found likely to cause confusion with the registered mark in U.S. Registration No. 3,089,727 (VIRTUAL CONCIERGE). The trademark examining attorney also required that the applicant provide a more definite identification of services, pay for additional classes or limit the identification to services in a single class, and disclaim the wording “ZURICH VIRTUAL” apart from the mark as shown.

On July 30, 2009, the applicant responded to the Office Action and presented arguments in an effort to overcome the Section 2(d) refusal. The applicant also provided an amended identification of services, a disclaimer as to the term “VIRTUAL,” and a Section 2(f) claim, in part, as to the term “ZURICH.”

On August 17, 2009, the trademark examining attorney made FINAL the refusal to register based upon the Section 2(d) refusal. The requirements to provide an acceptable identification of services, to limit the services in a single class or pay for additional classes and the disclaimer requirement as to “VIRTUAL” were withdrawn as satisfied. Additionally, the Section 2(f) claim as to the term “ZURICH” was accepted

into the record and the disclaimer requirement as to the term “ZURICH” was therefore withdrawn.

On November 6, 2009, the applicant filed an assignment of ownership, changing the applicant’s name to add “LTD” to the end of applicant’s name.

On March 18, 2010, the application was abandoned due to the applicant’s failure to respond to the final Office action.

On May 18, 2010, the applicant submitted a petition to revive and a notice of appeal. The petition to revive was granted on May 18, 2010.

On July 2, 2010, the applicant filed its appeal brief. The application was forwarded to the trademark examining attorney for a brief in accordance with Trademark Rule 2.142(b) on July 12, 2010.

ISSUE

The sole issue on appeal is whether the applicant’s mark ZURICH VIRTUAL CONCIERGE for “providing financial risk management information and insurance information via emails, personalized websites and electronic press releases and announcements” is confusingly similar to U.S. Registration No. 3,089,727 for the mark VIRTUAL CONCIERGE for “business management consulting services,” thus creating a likelihood of confusion with the meaning of Section 2(d) of the Trademark Act.

ARGUMENTS

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). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

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. TMEP

§1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

I. THE MARKS ARE HIGHLY SIMILAR

Turning first to consideration of the marks at issue, the trademark examining attorney submits that the marks are highly similar. The dominant portion of the applicant's mark is identical to the registrant's mark: "VIRTUAL CONCIERGE." Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 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 1987); *see* TMEP §1207.01(b)(viii), (c)(ii).

The addition of the house mark term "ZURICH" to the registrant's mark does not overcome the likelihood of confusion between the marks. The applicant does not dispute the term ZURICH is a house mark, but instead avers that the added term is "its famous "Zurich" mark." *See*, applicant's brief, p. 2. When marks are otherwise virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks; it is likely that the two products sold under such marks would be attributed to the same source. *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986) (holding GLUE STIC for general purpose adhesive in stick form likely to be confused with UHU GLU STIC for adhesives for paper and stationery); *Key West*

Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168, 170 (TTAB 1982) (holding SKIN SAVERS for face and throat lotion likely to be confused with MENNEN SKIN SAVER for hand and body lotion); *see Hamermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662, 663, 143 USPQ 237, 238 (C.C.P.A. 1964) (holding HAMMERMILL E-Z CARRY PAK and E-Z PAPER PAK for carrying cases or boxes for typewriter or duplicator paper likely to be confused with E-Z PAK and E-Z CARI for paper bags); TMEP §1207.01(b)(iii).

Moreover, the added term “ZURICH” is clearly descriptive. As a result, this word lacks source-identifying significance, and it is the term “VIRTUAL CONCIERGE” that consumers would look to as the indicator of source.

Applicant however, contends that the wording “VIRTUAL CONCIERGE” in the marks is weak and therefore entitled to limited protection. *See*, applicant’s brief, p. 2. This argument is flawed and must be rejected. First, there is no evidence that the wording is weak. The applicant made of record only one other registration for the mark VIRTUAL CONCIERGE, namely, U.S. Registration No. 3,190,428, and said registration is for unrelated services. There is no evidence of record that the wording VIRTUAL CONCIERGE is weak or diluted in relation to the applicant’s and registrant’s services.

Second, even *assuming arguendo* that the terms VIRTUAL and CONCIERGE are weak, the registrant is still entitled to trademark protection. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or

services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). As stated previously herein however, there is no evidence to support the applicant's assertion that the mark is in fact weak. The cited mark is registered on the Principal Register.

II. THE SERVICES AND TRADE CHANNELS ARE HIGHLY RELATED

The second consideration is the services at issue and the channels of trade for said services. The trademark examining attorney submits that the services are highly related, and that they travel in the same channels of trade.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii). Therefore, it is presumed that the applicant's and registrant's

services travel in the same channels of trade. Moreover, the registrant has not limited its channels of trade.

Of record are copies of thirty (30) U.S. Registrations, which show third-party registrations of marks used in connection with the same or similar services as those of applicant and registrant in this case. Specifically,

- U.S. Registration Number 3568744 for the mark RISK LAYERING
- U.S. Registration Number 3282363 for the mark DECISION DETECTIVE and the design of a shadowed figure
- U.S. Registration Number 2957363 for the mark AIGC
- U.S. Registration Number 3195804 for a bended circle design mark
- U.S. Registration Number 3212370 for the mark WIRCHOW KRAUSE & COMPANY
- U.S. Registration Number 3195942 for the mark KBA GROUP
- U.S. Registration Number 3260123 for the mark MACTEC
- U.S. Registration Number 3506515 for the mark SAFE TRANSIT
- U.S. Registration Number 3350134 for the mark FILAMENT
- U.S. Registration Number 3297810 for the mark CRYSTAL COMPASS and the design of a crystal, oval and four triangles
- U.S. Registration Number 3318061 for the mark UBE SERVICES
- U.S. Registration Number 3344128 for the mark CSM METHOD
- U.S. Registration Number 3455761 for the mark ALIGNED MANAGEMENT SOLUTIONS
- U.S. Registration Number 3304800 for the mark GOT GREEN?

- U.S. Registration Number 3510160 for the mark INTELITECH
- U.S. Registration Number 3382010 for the mark COSMOBRANDLAB
- U.S. Registration Number 3254615 for the mark AON
- U.S. Registration Number 3548739 for a bird design mark
- U.S. Registration Number 3416833 for the mark PEREGRINE
- U.S. Registration Number 3544243 for the mark POINTRIGHT
- U.S. Registration Number 3425495 for the mark BLACKROCK
- U.S. Registration Number 3452419 for the mark NAVIGANT
- U.S. Registration Number 3614466 for the mark OLIVER WYMAN
- U.S. Registration Number 3477853 for the mark VIRIATHUS
- U.S. Registration Number 3517951 for the mark UNITING BUSINESS & PERSONAL STRATEGIES FOR WEALTH
- U.S. Registration Number 3566748 for the mark SECURPLACE
- U.S. Registration Number 3611410 for the mark THE POWER OF PURPOSE
- U.S. Registration Number 3605522 for the mark SCHUMACHER GROUP
- U.S. Registration Number 3214047 for the mark ALGO
- U.S. Registration Number 3613921 for the mark NOTICEABLY DIFFERENT

These registrations, attached as printouts to the First and Final Office Actions, have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely business management services and risk management

and/or insurance services, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

The applicant contends that the registrant's services are not the services set forth in the registrant's identification of services. Instead, the applicant avers that the registrant's services are "really corporate concierge services." *See*, applicant's brief, p. 3. The applicant supports this contention merely by asserting that the registrant owns a website that presumably references corporate concierge services.

First, likelihood of confusion is determined on the basis of the services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1637-38 (TTAB 2009); TMEP §1207.01(a)(iii).

In this case, the registrant's goods and/or services are identified broadly as business management consulting services. Therefore, it is presumed that the registration encompasses all services of the type described, not merely limited to concierge services, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(a)(iii). The applicant may not, *sua sponte*, limit or change the registrant's identification of services.

Second, even if such amendment to the registrant's services by the applicant were permissible simply through the applicant's assertions in the instant application (and the trademark examining attorney specifically refutes this point) the applicant has not provided any evidence in support of the contention that the registrant's services are merely corporate concierge services rather than business management consulting services. The applicant contends that the registrant's website "which is of record" demonstrates that the registrant's services are limited to corporate concierge services. *See*, applicant's brief, p. 2. No such evidence is of record. The applicant merely provided a link to a website that is presumably owned by the registrant. Applicant is obligated to provide information if required or necessary, not simply direct the Trademark Trial and Appeal Board or the trademark examining attorney to a website. *See In re Planalytics Inc.*, 70 USPQ2d 1453 at 1457 (TTAB 2004). As the TTAB further stated in *Planalytics* at 1457, "A mere reference to a website does not make the information of record. In order to review the facts in this case, there should be evidence in the record." Moreover, even if the registrant does own a website providing concierge services, there is nothing to suggest that the registrant does not also provide business management consulting services to consumers through other means and methods. It is unreasonable to presume that all of the registrant's services are provided through a single venue: one website. Accordingly, the applicant's contention that the registrant's services are limited to corporate concierge services is unsupported by the record and must be disregarded.

The applicant acknowledges that the services must be compared based on what is recited in the registration, but argues that the services are unrelated and notes that the

services are in different classes. *See*, applicant's brief, p. 3. As demonstrated by the thirty registrations wherein entities provide both business management consulting services and risk management and/or insurance services, the services of the applicant and registrant are in fact highly related.

Moreover, the fact that the Office classifies goods or services in different classes does not establish that the goods and services are unrelated under Trademark Act Section 2(d). *See* TMEP §1207.01(d)(v). The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

Furthermore, 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); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/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); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471,

1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant also contends that the channels of trade are different, namely, that the applicant's services are provided electronically while the registrant's services are "traditionally... provided "in person." *See*, applicant's brief, p. 3. This argument is also unsupported by the record. The registrant did not limit its channels of trade and the applicant is not permitted to limit the registrant's channels of trade on its own. Moreover, the applicant specifically references the registrant's website, which supports the assumption that the registrant's services are provided through a variety of means, including the same electronic channels as the applicant.

The applicant's final contention is that its consumers are sophisticated and will not be confused. *See*, applicant's brief, p. 3. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Moreover, the applicant's identified services could foreseeably be used by average consumers, as many consumers in the general public seek information concerning insurance. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

Based on the similarity of the marks and the close relationship of the services, the examining attorney submits that purchasers who encounter the marks of applicant and registrant for the specified services would mistakenly believe that the services originate from or are in some way associated with the same producer. *See Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1247 (TTAB 1984).

Finally, it is well settled that the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

SUMMARY

In summary, the marks are highly similar. Further, the services at issue are highly related to each other and are found in the same trade channels. Because consumers would mistakenly believe that the services of the applicant and the registrant emanated from a common source, there is a likelihood of confusion as to the source of the services. The refusal to register the mark pursuant to Section 2(d) of the Trademark Act should therefore be affirmed.

Respectfully submitted,

/Andrea Koyner Nadelman/
Andrea Koyner Nadelman
Trademark Attorney
Law Office 110
(571) 272-9370

Chris A. F. Pedersen
Managing Attorney
Law Office - 110