

**THIS OPINION IS NOT A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Zurich Insurance Company Ltd.

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Serial No. 77600833

Serial No. 77600844

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Zurich Insurance Company Ltd.

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Before Walters, Kuhlke and Bergsman,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Zurich Insurance Company Ltd. filed intent-to-use applications for the marks VIRTUAL CONCIERGE, in standard character form, and ZURICH VIRTUAL CONCIERGE, in standard character form, both for services ultimately identified as "providing financial risk management information and insurance information via emails, personalized websites and electronic press releases and announcements," in Class 36. In both applications, applicant disclaimed the exclusive

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right to use the word "virtual."<sup>1</sup> In the application for ZURICH VIRTUAL CONCIERGE, applicant claimed that "Zurich" has become distinctive of applicant's services as evidenced by applicant's ownership of Registration No. 1941954 for the mark ZURICH, in typed drawing form, for "insurance underwriting in the fields of liability, damage, annuity and reinsurance; surety services; and risk management," in Class 36.

Registration has been refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used in connection with the services listed in the applications, so resemble the previously registered mark VIRTUAL CONCIERGE, in standard character form, for "business management consulting services," in Class 35, as to be likely to cause confusion.<sup>2</sup>

Because the applications are owned by the same applicant and the appeals involve common issues of fact and law, we have consolidated the appeals.

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<sup>1</sup> The Examining Attorney required applicant to disclaim the exclusive right to use the word "virtual" on the ground that it is merely descriptive. "The term 'virtual' immediately informs the potential purchaser that applicant's goods and/or services are 'virtual' or non-physical, or are simulated or provided electronically or online." (The first office actions).

<sup>2</sup> Registration No. 3089727, issued May 9, 2006.

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Our determination of likelihood of confusion under Section 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 (CCPA 1973); *see also, In re Majestic Distilling Company, Inc.*, 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. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the

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marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988).

Applicant's mark VIRTUAL CONCIERGE is identical to the cited registration for the mark VIRTUAL CONCIERGE.

Applicant's mark ZURICH VIRTUAL CONCIERGE is similar to the cited registration for the mark VIRTUAL CONCIERGE in that both marks include the term "Virtual Concierge." However, applicant contends that "the term 'ZURICH' is dominant in [applicant's] mark, as Applicant's service relates to insurance, which is where Applicant's mark has strong goodwill and recognition."<sup>3</sup> In fact, applicant contends that "due to the strength, recognition and dominance of the mark 'ZURICH' in the insurance field," consumers are able to distinguish the marks.<sup>4</sup> However, applicant did not introduce any evidence regarding the strength, recognition and dominance of the mark "ZURICH" in the insurance field.

Applicant's reliance on its registration of the mark ZURICH under Section 2(f) and the Examining Attorney's acceptance of applicant's claim of acquired distinctiveness of name "Zurich" in application Serial No. 77600844 as

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<sup>3</sup> Applicant's Brief, p. 2.

<sup>4</sup> *Id.*

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evidence of strength is misplaced. The inquiry into whether a mark has acquired distinctiveness is a threshold issue of trademark validity. "Acquired distinctiveness" or "'secondary meaning' is merely a label given that quantum of 'strength' sufficient to activate some terms into life as a trademark.'" McCarthy On Trademarks And Unfair Competition §11:82 (4<sup>th</sup> ed. 2010); see also McCarthy On Trademarks And Unfair Competition §15:25. Once acquired distinctiveness is established, the scope of protection, or strength, accorded a mark is commensurate with the degree of consumer association that is proven. *Id.*; *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 204 USPQ 808, 814 n.12 (9<sup>th</sup> Cir. 1979); see also *Jiffy, Inc. v. Jordan Industries, Inc.*, 481 F.2d 1323, 179 USPQ 169, 170 (CCPA 1973) ("Development of association with the user as a source of the goods through continued sales and advertising of the goods may turn a 'weak' mark into a strong, distinctive trademark"); *Standard International Corp. v. American Sponge and Chamois Co., Inc.*, 394 F.2d 599, 157 USPQ 630, 631 (CCPA 1968) ("a mark which is initially a weak one may, by reason of subsequent use and promotion, acquire such distinctiveness that it can function as a significant indication of a particular producer as source of the goods with which it is used"); *Hyde Park Footwear Co., Inc. v.*

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*Hampshire-Designers, Inc.*, 197 USPQ 639, 641 (TTAB 1977)

("The registrations alone are incompetent to establish any facts with regard to the nature or extent of opposer's use and advertising of its trademarks or any reputation they enjoy or what purchasers' reactions to them may be");

*Martha White, Inc. v. American Bakeries Co.*, 157 USPQ 215, 217 (TTAB 1968) (opposer's registration is not evidence of the nature and extent of opposer's use and advertising of its mark and, thus, is not probative of consumer reaction to the mark no matter how long it has been registered).

Nevertheless, we may take judicial notice that Zurich, a city in Switzerland, is "an important financial centre, and that Switzerland is "one of the world's most important financial centres."<sup>5</sup> In this regard, applicant argues that "the addition to Applicant's strong house mark, 'ZURICH,' to the admittedly weaker and diluted term 'VIRTUAL CONCIERGE' means that the relevant consumers will focus on the dominant 'ZURICH' term and not on the weaker 'VIRTUAL CONCIERGE' term."<sup>6</sup> There are several problems with

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<sup>5</sup> Encyclopedia Britannica (2010). The Board may take judicial notice of information published in encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (the Board may take judicial notice of information in dictionaries and other standard reference works).

<sup>6</sup> Applicant's Brief, p. 4.

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applicant's argument. First, applicant failed to prove that "Zurich" is a house mark. In fact, there is no evidence in the record regarding the use of ZURICH.

Applicant also failed to prove that the term "Virtual Concierge" is weak and diluted when used in connection with "business management consulting services." The only evidence applicant submitted was a copy of Registration No. 3190428 for the mark VIRTUAL CONCIERGE, in standard character form, for computer services providing information regarding retail shopping, area attractions, restaurants and lodging.

One third-party registration does not prove that "Virtual Concierge" is a weak or diluted term. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *see also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party

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(sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as their weakness in distinguishing source.

*In re Hub Distributing, Inc.*, 218 USPQ at 286.

In any event, one third-party registration for different services is hardly a persuasive showing that registrant's mark is weak or diluted.

The word "virtual" means "being such in power, force, or effect, though not actually or expressly such."<sup>7</sup> Computer dictionaries define "virtual" as "conceptual rather than actual, but possessing the essential characteristics of a real function"<sup>8</sup> and as "[n]ot physical. Exists in the software only or in the imagination of the machine."<sup>9</sup> Applicant's disclaimer of the word "virtual" pursuant to the Examining Attorney's requirement is a concession that "[t]he term 'virtual' immediately informs the potential purchaser that applicant's goods and/or

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<sup>7</sup> The Random House Dictionary of the English Language (Unabridged), p. 2125 (2<sup>nd</sup> ed. 1987).

<sup>8</sup> The Illustrated Dictionary of Microcomputers, p. 418 (3<sup>rd</sup> ed. 1990).

<sup>9</sup> net.speak: the internet dictionary, p. 193 (1994).

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services are 'virtual' or non-physical, or are simulated or provided electronically or online."<sup>10</sup>

The word "concierge" is a "doorkeeper" or "a member of a hotel staff in charge of special services for guests, as arranging for theater tickets or tours."<sup>11</sup>

We find, therefore, that the term "virtual concierge" as used in applicant's mark and the cited registration suggests the meaning and engenders the commercial impression of an online aide or online assistance. There is nothing in the record that persuades us that applicant's addition of the word "Zurich" alters the meaning or commercial impression engendered by the term "virtual concierge." Thus, the facts before us are similar to the facts in the line of cases that hold that the addition of a house mark or trade name does not distinguish terms that are otherwise similar. In this case, the shared term "virtual concierge" is identical in both marks and it is not highly suggestive or merely descriptive. See *In re Dennison Manufacturing Co.*, 229 USPQ 141, 144 (TTAB 1986) ("It is a general rule that the addition of extra matter

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<sup>10</sup> See footnote No. 1.

<sup>11</sup> The Random House Dictionary of the English Language (Unabridged), p. 423.

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such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion" and, therefore, GLUE STIC is similar to UHU GLUE STIC); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (the addition of the house mark "Dior" in applicant's mark "Le Cachet de Dior" does not serve to distinguish it from the previously registered mark "Cachet"); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982) ("Where the marks are otherwise virtually the same, the addition of a house mark ... is more likely to add to the likelihood of confusion than to aid to distinguish the marks" and, therefore, SKIN SAVERS is similar to MENNEN SKIN SAVER).

In view of the foregoing we find that applicant's mark ZURICH VIRTUAL CONCIERGE is similar to the mark VIRTUAL CONCIERGE in the cited registration in terms of appearance, sound, meaning and connotation.

B. The similarity or dissimilarity and nature of the goods, channels of trade, classes of consumers and the degree of consumer care.

We next turn to consider the *du Pont* factor regarding the similarity or dissimilarity of the services. It is not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is

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sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

The question of likelihood of confusion is determined based on the identification of services in the applications vis-à-vis the services as set forth in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Thus applicant's contention that "Registrant is providing corporate concierge services, such as running errands for employees of clients, like (sic) picking up dry cleaning, arranging child care, etc." is irrelevant.<sup>12</sup> We are required to compare applicant's services of "providing financial risk management information and insurance information via emails, personalized websites and electronic press releases

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<sup>12</sup> Applicant's Brief, p. 2. Although applicant stated that it submitted an excerpt from registrant's website, no excerpt from that website was made of record in either application.

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and announcements" with "business management consulting services."

The Examining Attorney has submitted numerous third-party registrations to show the relatedness of the services at issue. Third-party registrations which individually cover a number of different services and that are based on use in commerce serve to suggest that the listed services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993). The table shown below sets forth an illustrative sample of the third-party registrations.<sup>13</sup>

<b>Mark</b>	<b>Registration No.</b>	<b>Services</b>
AON	3254615	Business management consultation; financial risk management; financial analysis and consultation; financial analysis for insurance purposes
PEREGRINE	3416833	Financial risk management services; business management, consulting and advisory services
POINTRIGHT	3544243	Business management consultation services; financial planning, management and consultation services, namely, ... providing risk management services

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<sup>13</sup> We have not included the entire list of services for each of the registrations. Only the services in both applicant's applications and registrant's registration are listed.

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Mark	Registration No.	Services
BLACKROCK	3425482	Providing financial risk management consultation; insurance underwriting consultation; insurance consultation; business management consultation
NAVIGANT	3452419	Business management consultation; financial management services; financial risk management; insurance claim processing; insurance rate computing services and consulting

Applicant's argument that registrant's services "are not specific to financial risk management or to the means of delivering these services" is not persuasive.<sup>14</sup> As noted above, it is not necessary for the services to be identical or even competitive. It is sufficient that they are commercially related such that use in connection with a similar mark is likely to cause confusion. Here, as evidenced by the third-party registrations, the services are closely related such that consumers would be accustomed to seeing these different services emanating from the same source.

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<sup>14</sup> Applicant's Brief, p. 3.

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Finally, applicant contends that "the circumstances surrounding the marketing of the respective services would not lead consumers to believe that these services emanate from a single source. Appellant's services are delivered to sophisticated business people who are traditionally in executive positions and who think about financial risk management in their daily work. These sophisticated purchasers realize that these services are coming from a sophisticated insurance company and will not be confused by the use of the same for concierge services."<sup>15</sup> This argument is based on the false premise that the registrant's services are "concierge services." As indicated above, we must analyze the services as set forth in the applications and cited registration, not on what the evidence shows the services to be.

We recognize that the purchasers of applicant's services products are likely to be professionals or at least somewhat careful purchasers. However, even sophisticated professionals are not immune to trademark confusion. Thus, there could very well be a likelihood of confusion when, in one case, identical marks, and in the other, the very similar marks VIRTUAL CONCIERGE and ZURICH

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<sup>15</sup> Applicant's Brief, p. 3.

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VIRTUAL CONCIERGE are used in connection with services that have been shown to originate from a common source.

C. Balancing the factors.

The *du Pont* factors require to us to consider the thirteen factors for which evidence has been made of record in likelihood of confusion cases. In view of the fact that the marks are, respectively, identical or similar and the services are related, with the presumption that the channels of trade and classes of consumers are the same, we find that applicant's registration of the marks VIRTUAL CONCIERGE and ZURICH VIRTUAL CONCIERGE in connection with "providing financial risk management information and insurance information via emails, personalized websites and electronic press releases and announcements" is likely to cause confusion with the previously registered mark VIRTUAL CONCIERGE for "business management consulting services."

**Decision:** The refusals to register applicant's marks in both applications under Section 2(d) are affirmed.