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- EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86196263

MARK: AMERICAN SHIELD INSURANCE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Shelter Mutual Insurance Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

7000404.002

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EXAMINING ATTORNEY'S APPEAL BRIEF

The Applicant, Shelter Mutual Insurance Company, has appealed the Examining Attorney's refusal to register the proposed mark AMERICAN SHIELD INSURANCE under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. Section 1052(d). Registration was refused on the Principal Register on the ground that the Applicant's mark is likely to be

confused with the marks AHS AMERICAN HOME SHIELD and AMERICAN HOME SHIELD in U.S. Registration Nos. 1427790, 1956992, 4140212, 4170524 and 4234976. This refusal is the only issue on appeal.

FACTS

On February 18, 2014, the Applicant applied to register the mark AMERICAN SHIELD INSURANCE based on its intent to use in commerce under Section 1(b) of the Trademark Act in connection with "Providing insurance underwriting in the fields of life, home, auto, business, personal liability and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability and boating; banking services and investment services; providing online banking services; insurance brokerage and financing services." ¹

On June 3, 2014, the Examining Attorney issued an Office action with the refusal under Section 2(d) for a likelihood of confusion with the marks in U.S. Registration Nos. 1427790, 1956992, 4140212, 4170524 and 4234976, as well as requirements for a definite identification of services and a disclaimer statement.

On October 24, 2014, the Applicant submitted arguments and evidence against the Section 2(d) refusal as well as amended its identification of services and submitted a disclaimer statement. ²

On November 15, 2014, the Examining Attorney issued a final Office action with the refusal under Section 2(d) for a likelihood of confusion with the marks in U.S. Registration Nos. 1427790, 1956992, 4140212, 4170524 and 4234976.

¹ The identification of services was amended to the current identification in the Applicant's response dated October 24, 2014.

² The wording "AMERICAN" and "INSURANCE" are disclaimed in the applied-for mark and the Applicant satisfied the identification of services and disclaimer statement requirements in its October 24, 2014 response.

On May 14, 2015, the Applicant submitted a Request for Reconsideration after the final Office action and filed a timely appeal.

In its Request for Reconsideration, Applicant submitted arguments and evidence in response to the Examiner's final refusal. The Examining Attorney reviewed Applicant's response and found the arguments and evidence to be unpersuasive, and thus denied the Applicant's Request for Reconsideration on June 21, 2015.

Applicant filed its appeal brief on August 21, 2015.

ISSUE ON APPEAL

The sole issue on appeal is whether the Applicant's use of the mark AMERICAN SHIELD INSURANCE in connection with "providing insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; banking services; investment services, namely, investment banking services and investment consultation services; providing online banking services; insurance brokerage and financing services, all of the foregoing excluding home warranty and real estate warranty services" creates a likelihood of confusion with the registered marks AHS AMERICAN HOME SHIELD and AMERICAN HOME SHIELD in U.S. Registration Nos. 1427790, 1956992, 4140212, 4170524 and 4234976 in relevant part for "warranty services - namely, arranging for repairs and replacement of home utility systems, built-in appliances and parts thereof, pursuant to contracts with homeowners," "warranty services, namely arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements; providing business information to real estate professionals, home buyers, home sellers, home inspectors and home repair contractors; issuing home service contracts, home warranties, home repair referral contracts and home inspection contracts; providing home warranty services, professional liability insurance, risk management and

client referral programs to real estate professionals, home inspectors and home repair contractors,” “warranty services, namely, arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements; providing business information in the field of home warranties to real estate professionals, home buyers, home sellers, home inspectors and home repair contractors” and “preventive maintenance services, namely, underwriting, providing and administrating service contracts for preventive maintenance of home systems, appliances and parts thereof; extended warranty services, namely, underwriting, providing and administrating service contracts for repairs and replacements of individual home systems, appliances and parts thereof beyond the manufacturer warranty period.”³

ARGUMENT

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, mistaken, or deceived as to the source of the services of the Applicant and Registrant. See 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court 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 the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

³ The five cited registrations are owned by the same entity.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

I. Marks are Highly Similar and not Weak or Diluted

Applicant's mark is AMERICAN SHIELD INSURANCE in standard character form. Registrant's marks are AHS AMERICAN HOME SHIELD in design form, AMERICAN HOME SHIELD in typed form, AMERICAN HOME SHIELD in design form, AMERICAN HOME SHIELD in standard character form and AMERICAN HOME SHIELD in design form.

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). However, a trademark Examining Attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”)).

A. Dominant portion of the marks are the distinctive terms “AMERICAN” and “SHIELD”.

First, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

In this case, the wording “AMERICAN SHIELD” in the applied-for mark “AMERICAN SHIELD INSURANCE” is nearly identical to the wording “AMERICAN HOME SHIELD” in the cited registered marks. In its brief, the Applicant argues that the generic wording “INSURANCE” in the applied-for mark is the dominant portion of the applied-for mark because “AMERICAN” and “SHIELD” are weak and diluted. (App. Br. at 9, 19-21). Similarly, the Applicant also argues that the dominant wording in the cited registered marks is “HOME”. *Id.* Further, the Applicant argues that the significance of the design elements appearing in three of the cited registered marks was discounted by the Examining Attorney and that the designs are “significant and prominent.” (App. Br. at 7).

Contrary to Applicant’s argument, the wording “AMERICAN” and “SHIELD” appearing in the same mark for similar services or in the same field is not diluted or weak. For instance, a search conducted on June 21, 2015 in the USPTO’s XSearch database for marks containing the wording “AMERICAN” and “SHIELD” returned results for three registered marks, excluding the marks owned by the Registrant:

- AMERICAN AUTO SHIELD for “emergency road side repair services.”
- AMERICAN GOLD SHIELD KEEPING OUR COMMUNITIES SAFE & SOUND and AMERICAN GOLD SHIELD for “charitable foundation services, namely, providing financial assistance for programs and services of others; charitable fundraising services” and “educational services,

namely, conducting classes, lectures, seminars, training programs, and workshops in the field of drug and violence prevention and distribution of training material in connection therewith.”

The mark “AMERICAN AUTO SHIELD” is for unrelated automobile repair services and the marks “AMERICAN GOLD SHIELD KEEPING OUR COMMUNITIES SAFE & SOUND” and “AMERICAN GOLD SHIELD” are also for unrelated charitable financial assistance services and educational services in the field of drug and violence prevention.⁴

Thus, the wording “AMERICAN” and “SHIELD” appearing in the same mark is not diluted on the register for services related to Applicant’s and Registrant’s insurance, banking and warranty services.

Furthermore, Applicant previously submitted printouts of third-party registrations for marks containing the wording “AMERICAN” or “SHIELD” to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. (App. Br. at 15-17). The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with *similar* services. See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). In its brief, the Applicant states that a search of the USPTO’s TESS database retrieves about 1,488 pending applications and registrations containing the wording “AMERICAN” or variations of this wording in the mark. (App. Br. at 15). Please note this number includes pending applications that may not mature to registration and marks that contain variations of the wording “AMERICAN”, both of which inflate the number given by the Applicant because it includes irrelevant pending applications and different wording.

⁴ The marks “AMERICAN GOLD SHIELD KEEPING OUR COMMUNITIES SAFE & SOUND” and “AMERICAN GOLD SHIELD” are owned by the same entity. See attached copies of the third-party registrations previously made of record in the June 21, 2015 Office action.

Regardless of the distorted numbers provided by the Applicant, evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by Applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). While the Applicant argues that third-party registrations show the dilution and weakness of the wording in the marks, the goods and services listed in most of the third-party registrations submitted by Applicant are wholly different from those at issue, and thus do not show that the relevant wording is commonly used in connection with the services at issue or even in the same field. Dilution is considered within the context of the services at issue and is not based on the number of the marks containing the particular wording alone.

Similarly, the Applicant argues that the wording “SHIELD” appears about 193 times in applications and registrations in the USPTO’s TESS database. (App. Br. at 16). Likewise, this number is inflated because it includes pending applications as well as marks that are for wholly different goods and services than the services at issue.

Further, in its analysis, the Applicant erroneously considers the number of marks on the register containing the wording “AMERICAN” (and variations of the wording “AMERICAN”) or “SHIELD” rather than considering the relevant number and nature of the marks on the register that contain “AMERICAN” (no variation) *and* “SHIELD” in the same mark. It is these two words together that create the commercial impression in each mark. Thus, even though the Applicant argues that the Examining Attorney erred in

asserting that the Applicant's third-party registrations are entitled to little weight, it is respectfully submitted that the third-party registrations are of little significance for the foregoing reasons.

Additionally, the Applicant argues that the common wording "AMERICAN" and "SHIELD" among the applied-for mark and cited registered marks is "weak," and thus any differences among the marks are sufficient to obviate a likelihood of confusion in this case.

On the contrary, the differences in the marks' appearances and sound are negligible. For instance, while the common wording "AMERICAN" may be perceived as laudatory or geographically descriptive, the wording "SHIELD" is arbitrary in the context of the applied-for mark and the cited registered marks. Specifically, a "shield" is defined most commonly as "[a] broad piece of armor made of rigid material and strapped to the arm or carried in the hand for protection against hurled or thrust weapons."⁵ Thus, the wording as it appears in the applied-for mark and the cited registered marks is arbitrary in that the services provided are unrelated to armor and weaponry. Alternatively, at the very least, the wording "SHIELD" as it appears in each mark is suggestive of the Applicant and Registrant protecting a consumer through the rendering of their services. Nevertheless, the term "SHIELD" still remains the most distinctive term in the applied-for and cited registered marks.

Next, while the wording "AMERICAN" is disclaimed in the cited registered marks and "AMERICAN" is disclaimed in the applied-for mark, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *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); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). In this case, the first word in the applied-for mark is "AMERICAN" and the first word in the

⁵ See the dictionary evidence previously made of record in the November 15, 2014 Office action.

phrase “AMERICAN HOME SHIELD” in the cited registered marks is also “AMERICAN”. Thus, the term “AMERICAN” is given greater weight in this analysis even though it is not the most distinctive term appearing in each mark.

In any case, the wording “INSURANCE” in the applied-for mark is generic for the Applicant’s *insurance* underwriting and *insurance* brokerage services. Similarly, the wording “HOME” is in the same manner generic or highly descriptive for the Registrant’s *home* warranty and repair services.

Thus, the wording given the least amount of weight in this analysis is the generic wording “INSURANCE” in the applied-for mark and “HOME” in the cited registered marks. It follows that the dominant wording in the applied-for mark is the laudatory or geographically descriptive wording “AMERICAN” and the arbitrary wording “SHIELD”. Likewise, the dominant wording in the cited registered marks is also the laudatory or geographically descriptive wording “AMERICAN” and the arbitrary wording “SHIELD”.⁶

However, even if the marks are at issue are deemed to be weak, 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 services. 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) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’”); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”). This protection even extends to marks registered on

⁶ Applicant did not address the significance of the acronym “AHS” appearing in the mark in U.S. Registration No. 1427790 and the examining attorney respectfully asserts that “AHS” merely reinforces the wording “AMERICAN HOME SHIELD” in the mark, and thus does not alter the commercial impression of the dominant wording in that mark.

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, 189 (TTAB 1975).

In sum, the dominant portion of the applied-for mark is the wording “AMERICAN SHIELD” and the dominant terms in the cited registered marks are the terms “AMERICAN” and “SHIELD” because the terms are not diluted or weak and the additional terms “INSURANCE” and “HOME” are generic or highly descriptive of the Applicant’s and Registrant’s services.

B. Designs in the cited registered marks reinforce the common distinctive wording “SHIELD” and do not alter the commercial impressions.

Second, for a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the services. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In this case, the marks in U.S. Registration Nos. 1427790, 4140212 and 4234976 contain design elements; however, it is the word portion of the marks that are impressed upon a consumer’s memory.

In its brief, the Applicant argues that three of the cited registered marks contain significant and prominent designs and the Examining Attorney erroneously discounted the significance of the design elements in the refusal. (App. Br. at 7). Even though it is well settled that consumers generally request goods and services by the literal elements in the marks, the Examining Attorney does also argue that the

design elements present in the cited registered marks merely reinforce the wording in the marks. Specifically, the design elements in U.S. Registration Nos. 4140212 and 4234976 contain the depiction of a shield interlocking with the outline of a simple house. The designs of the shield in the marks merely reinforce the previously discussed distinctive wording in the marks, "SHIELD". Conversely, the design in the mark in U.S. Registration No. 1427790 simply contains three lines, serving as over and underlines and does not alter the commercial impression of the mark as a whole.

Furthermore, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). In this case, the applied-for mark and the marks in U.S. Registration Nos. 1956992 and 4170524 are in standard character or typed form. Thus, either the Applicant or Registrant can display their respective marks in any style, which can cause the marks to be confusingly similar if the applied-for mark and registered marks are displayed in identical or similar fashions.

C. Marks are similar in appearance, meaning and sound.

Third, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion

as to the source of the services offered under Applicant's and Registrant's marks is likely to result.

Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A., 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both Applicant's and Registrant's mark. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

In this case, the applied-for mark is entirely comprised of the wording "AMERICAN SHIELD INSURANCE" and the cited registered marks contain the wording "AMERICAN HOME SHIELD". The Applicant argues that the commercial impressions differ because the wording "HOME SHIELD" in the cited registered marks creates the impression of home warranty services in that a consumer is defending its home and "AMERICAN SHIELD" modifies the term "INSURANCE" in the applied-for mark and that this modification evokes the idea of "insurance of a high quality." (App. Br. at 9). The Applicant then concludes that the wording "SHIELD" should not be given "any significant weight" in the analysis based on the forgoing commercial impressions.

On the contrary, based on the Applicant's interpretation of the commercial impressions, it should be concluded that the wording "SHIELD" should be given significant weight in this analysis. As previously discussed, the wording "SHIELD" as it appears in all of the marks is the most distinctive wording in the marks. Furthermore, the Applicant concedes that the wording "SHIELD" in the cited registered marks "strongly" conveys the idea of "defending one's home against events..." *Id.* As previously defined, a "shield" is used to defend oneself, and thus the term "SHIELD" as it appears in the applied-for mark *and* the cited registered marks convey the same idea of defense. The mere addition of the generic wording "INSURANCE" in the applied-for mark does not alter the commercial impression of the wording "AMERICAN" or "SHIELD" because it is understood by consumers to refer to the category of services and not a specific source. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991); *see* TMEP §§1209.01(c) *et seq.*, 1209.02(a).

In any case, the wording "INSURANCE" as it appears in the mark can identify a wide variety of insurance services provided to consumers, such as Registrant's "professional liability insurance" and the wording in the mark does not limit the scope of services that the Applicant provides.⁷

Thus, the overall commercial impressions nevertheless remain nearly identical.

Lastly, similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); *see In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). In this case, the addition of the sound of the wording "HOME" in the cited registered marks and the addition of the

⁷ The "professional liability services" appear in the identification in U.S. Registration No. 1956992.

sound of the wording “INSURANCE” in the applied-for mark is insufficient to obviate a likelihood of confusion in this case.

In sum, the applied-for mark and the cited registered marks contain similar dominant terms, and thus are highly similar in appearance and sound and convey similar meanings.

II. Applicant’s Prior Registrations are Irrelevant and Actual Confusion is not the Legal Standard

In its brief, the Applicant argues it has long-standing rights to use the applied-for mark and that consumers are familiar with the Applicant’s use of the wording “SHIELD” in connection with its services. (App. Br. at 8, 22). Applicant bases this argument on its prior registrations for different marks asserting that they contain the wording “SHIELD” and it is a natural progression to amend its marks over time. *Id.*

However, in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012), the Trademark Trial and Appeal Board (Board) only reversed a Section 2(d) refusal based on an Applicant’s prior registration for the following unique set of facts: (1) the marks in Applicant’s prior registration and application were virtually identical (“no meaningful difference” existed between them, such that they were “substantially similar”); (2) the services were identical in part; and (3) the prior registration had co-existed for at least five years with the cited registration. *See* TMEP §1207.01. The Board acknowledged these facts constituted a “unique situation,” such that an Applicant’s prior registration would generally need to fit within these precise parameters to overcome a Section 2(d) refusal. *In re Strategic Partners, Inc.*, 102 USPQ2d at 1400; *see* TMEP §1207.01.

In this case, by contrast, Applicant’s referenced prior registrations do not correspond to the facts set forth in *In re Strategic Partners, Inc.* *See* TMEP §1207.01. Specifically, Applicant’s prior registrations are not for the same mark. More specifically, the applied-for mark is “AMERICAN SHIELD INSURANCE” and Applicant’s prior registrations are “SHELTER INSURANCE”, “SHIELD OF SHELTER” and “PLATINUM

SHIELD". Thus, Applicant's prior registrations do not meet the criteria to overcome a likelihood of confusion refusal and the Applicant's prior registrations reinforce the Examining Attorney's argument that the wording "SHIELD" is part of the dominant portion of the applied-for mark.

Additionally, the Applicant further argues that there is no actual confusion because of its "long standing rights" and "consumer and trade recognition." (App. Br. at 22).

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii).

Thus, the Applicant's argument that there is no actual confusion because of its long standing use and consumer recognition is unpersuasive because the standard of confusion is a "likelihood," which is a lower standard than "actual" confusion.

III. Services are Commercially Related, Complementary and Commonly Provided by the Same Source

Applicant's services are "providing insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; banking services; investment services, namely, investment banking services and investment consultation services; providing online banking services; insurance brokerage and financing services, all of the foregoing excluding home warranty and real estate warranty services."

The services in U.S. Registration No. 1427790 are “warranty services - namely, arranging for repairs and replacement of home utility systems, built-in appliances and parts thereof, pursuant to contracts with homeowners.”

The services in U.S. Registration No. 1956992 in relevant part are “warranty services, namely arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements; providing business information to real estate professionals, home buyers, home sellers, home inspectors and home repair contractors; issuing home service contracts, home warranties, home repair referral contracts and home inspection contracts; providing home warranty services, professional liability insurance, risk management and client referral programs to real estate professionals, home inspectors and home repair contractors.”

The services in U.S. Registration No. 4140212 are “warranty services, namely, arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements; providing business information in the field of home warranties to real estate professionals, home buyers, home sellers, home inspectors and home repair contractors.”

The services in U.S. Registration No. 4170524 in relevant part are “preventive maintenance services, namely, underwriting, providing and administrating service contracts for preventive maintenance of home systems, appliances and parts thereof; Extended warranty services, namely, underwriting, providing and administrating service contracts for repairs and replacements of individual home systems, appliances and parts thereof beyond the manufacturer warranty period.”

The services in U.S. Registration No. 4234976 in relevant part are: “preventive maintenance services, namely, underwriting, providing and administrating service contracts for preventive maintenance of home systems, appliances and parts thereof; Extended warranty services, namely, underwriting,

providing and administrating service contracts for repairs and replacements of individual home systems, appliances and parts thereof beyond the manufacturer warranty period.”

As case law, internet evidence, and third-party registrations show, services such as Applicant’s insurance and banking services, and Registrant’s administration and underwriting of warranties are commercially related, even though the services are not identical.

The services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the services in question are different from, and thus not related to, one another in kind, the same services can be related in the mind of the consuming public as to the origin of the services.”); TMEP §1207.01(a)(i).

The respective services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); *see On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In its brief, the Applicant argues the wording “all of the foregoing excluding home warranty and real estate warranty services” in its amended identification of services excludes the “core” services provided by the Registrant, and thus the services are not related. (App. Br. at 14). Additionally, the Applicant argues that the Applicant’s specific services do not appear in the Registrant’s identifications and vice versa. (App. Br. at 15). However, this exclusion does not negate the commercial relatedness of the

Applicant's and Registrant's services, as shown below, or preclude the Registrant from offering its "professional liability insurance" services listed in its identification of services.⁸ Further, this amendment does not preclude the Applicant or Registrant from marketing their services or targeting their services to any particular group or persons, also shown below.

Furthermore, the Applicant mischaracterizes the nature of the Applicant's services when it argues that its services are "well known and understood to comprise casualty losses" and are narrow in scope. (App. Br. at 12, 15). Rather, Applicant's insurance services are "underwriting in the fields of life, home, auto, business, personal liability, and boating" and "insurance brokerage," which includes other types of coverage and is not limited to casualty losses. Even so, Applicant's broad use of insurance fields also includes types of insurance not specifically named in its identification. For example, "business insurance" includes property insurance, liability insurance, worker's compensation insurance, business auto insurance, life insurance for business owners, employment practice liability and business crime insurance. Thus, the Applicant improperly characterizes its services as "considerably narrow" casualty insurance. (App. Br. at 15).

To show the relatedness and complementary nature of the services, the Examining Attorney previously made of record Internet evidence consisting of excerpts from web sites. This evidence establishes that the same entity commonly provides the relevant services and markets the services under the same mark, the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use and the services are similar *and complementary* in terms of purpose.

Specifically, the previously attached evidence is as follows:

⁸ The "professional liability services" appear in the identification in U.S. Registration No. 1956992.

- AIG web site shows that the same source that provides insurance services also provides warranty administration services.
- The Warranty Group web site shows that the same source that provides warranty management services also provides insurance and underwriting services.
- Bankers Insurance Group and Bankers Warranty Group web sites show that the same source that provides insurance services also provides warranty services, using “insurance” in its name for its insurance services and “warranty” in its name for its warranty services.
- First American web site shows that the same source provides insurance, banking and warranty services. “The First American Family of Companies’ core business lines include title insurance and closing/settlement services; title plant management services; title and other real property records and images; valuation products and services; home warranty products; property and casualty insurance; and banking, trust, and investment advisory services.” See <http://www.firstam.com/>.
- Registrant’s web site states “Unlike most homeowners insurance, a home warranty covers the repair or replacement of these crucial items when they break down due to normal wear and tear, saving you money.” See <https://www.ahs.com/>. This evidence shows that home insurance and home warranties are complementary in nature and commonly sought out together.
- First American web site shows that home insurance and home warranties are often marketed together (“Insurance and Home Warranty” heading) because of the nature of their similarities. “First American helps to protect home buyers and homeowners from potential significant costs due to damage to their home, or the costs associated with repairing or replacing a home’s systems and appliances, through both homeowners insurance and home warranty products. First American’s suite of homeowners insurance and home warranty products offer

homeowners both important coverage as well as risk reduction.” See

<http://www.firstam.com/about/our-operations/insurance-and-home-warranty/>.

- Home Warranty Reviews web site shows that while the services at issue are not identical, they are not only marketed side-by-side and reviewed side-by-side, but they are both complementary services and substitute services at the same time. This evidence also shows that Applicant’s and Registrant’s services “come across as the same” to consumers.
- Edina Realty web sites shows that the same source provides insurance services as well as home warranty services. “...we have a mortgage company, title company, insurance company, relocation company and offer home warranty solutions.” See <http://www.edinarealty.com/pages/real-estate-services/your-full-service-real-estate-solution>.
- Stewart web sites shows that the same source provides insurance services as well as home warranty services.
- Harbour Insurance web site shows that the same source that provides home, auto, boat and life insurance services also provides professional liability insurance.
- Long & Foster web site shows the LONG & FOSTER mark is used on home warranty plans and homeowner’s insurance.
- Coldwell Banker web sites shows the COLDWELL BANKER mark used on home warranty services (COLDWELL BANK HOME PROTECTION PLAN) as well as financing services (COLDWELL BANKER HOME LOANS).
- BBVA Compass web site shows the same source provides home service plans as well as banking services, investment services, insurance services and financial services.
- Fidelity National Financial web site shows the FIDELITY NATIONAL house mark used on insurance services (FIDELTY NATIONAL TITLE GROUP) and home warranty services (FIDELTY NATIONAL HOME WARRANTY).

- Cross Country web site shows the CROSS COUNTRY mark used on insurance services as well as home warranty services.

Therefore, Applicant's and Registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Furthermore, the trademark Examining Attorney previously made of record evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both Applicant and Registrant in this case.⁹ This evidence shows that the services listed therein, namely, insurance and baking services and administering warranty claims and warranty underwriting services, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *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).

In sum, the services are commercially related, complementary, in some instances substitutes and commonly marketed to the same consumers and provided by the same source.

IV. Fame of Cited Registered Marks is a Neutral Factor

In addition, the Applicant argues that the Examining Attorney failed to provide evidence of the fame of the cited registered marks, and thus a broader scope of protection is not warranted (App. Br. at 15). However, the Examining Attorney respectfully submits that the Examining Attorney is not expected to

⁹ The third-party registrations are made of record in the June 3, 2014 Office action.

submit evidence regarding the fame of the cited marks. And, in an ex parte analysis of the du Pont factors for determining likelihood of confusion (see TMEP §1207.01), the “fame of the mark” factor is normally treated as neutral when no evidence as to fame has been provided.

V. Sophisticated Purchasers

Finally, applicant asserts that its consumers and Registrant’s consumers procure their respective services with “discernment and a high degree of sophistication” because of the important nature of the services. (App. Br. at 12, 17-19). Additionally, the Applicant argues that its consumers exercise a greater degree of care when making purchasing decisions because Applicant’s services are more expensive. (App. Br. at 18).

However, when the relevant consumer includes both professionals and the general public, the standard of care for purchasing the services is that of the *least sophisticated purchaser*. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004); *see In re Shell Oil Co.*, 992 F.2d 1204, 1208-09, 26 USPQ2d 1687, 1690-91 (Fed. Cir. 1990). Moreover, the cost of insurance and warranty coverage varies on a case by case basis, and thus it is impossible to predict the cost of Applicant’s and Registrant’s services.¹⁰

Furthermore, 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, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

CONCLUSION

¹⁰ See attached internet evidence previously referenced, showing the “get more information” and “get a quote” nature of Applicant’s and Registrant’s services.

In this case, confusion among consumers is likely because the marks AMERICAN SHIELD INSURANCE and AHS AMERICAN HOME SHIELD and AMERICAN HOME SHIELD are highly similar and the services are highly related and complementary. The overriding concern is not only to prevent buyer confusion as to the source of the 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, to the extent that the Examining Attorney may have had any doubt, such doubt was 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).

For the reasons stated above it is respectfully requested that the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

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