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Subject: U.S. TRADEMARK APPLICATION NO. 86196263 - AMERICAN SHIELD INSURANCE - 70000404.002
- Request for Reconsideration Denied - Return to TTAB - Message 1 of 2

Attachment Information:

Count: 24

Files: 85835612P001OF003.JPG, 85835612P002OF003.JPG, 85835612P003OF003.JPG,
85861453P001OF002.JPG, 85861453P002OF002.JPG, 85835558P001OF003.JPG,
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bbva-5.jpg, bankiung-1.jpg, 86196263.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86196263

MARK: AMERICAN SHIELD INSURANCE



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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Shelter Mutual Insurance Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

70000404.002

CORRESPONDENT E-MAIL ADDRESS:

trademarks.us@dentons.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 6/21/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated November 15, 2014 is maintained

and continues to be final: Refusal under Section 2(d)- Likelihood of Confusion. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, and the Board will be notified to resume the appeal. See TMEP §715.04(a).

Refusal under Section 2(d)- Likelihood of Confusion– Refusal Maintained and Continues to be FINAL

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is maintained and continues to be FINAL with respect to U.S. Registration Nos. 1427790, 1956992, 4140212, 4170524 and 4234976. See 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

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.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarity of Marks

Applicant's mark is AMERICAN SHIELD INSURANCE (in standard character form.)

The mark in U.S. Registration No. 1427790 is AHS AMERICAN HOME SHIELD (in design form.)

The mark in U.S. Registration No. 1956992 is AMERICAN HOME SHIELD (in typed form.)

The mark in U.S. Registration No. 4140212 is AMERICAN HOME SHIELD (in design form.)

The mark in U.S. Registration No. 4170524 is AMERICAN HOME SHIELD (in standard character form.)

The mark in U.S. Registration No. 4234976 is AMERICAN HOME SHIELD (in design form.)

The five cited registrations are owned by the same entity.

In this case, the wording "AMERICAN SHIELD" in the applied-for mark is nearly identical to the wording "AMERICAN HOME SHIELD" in the cited registered marks. The additional wording "HOME" in the cited registered marks and the additional design elements are not sufficient to prevent confusion between the marks. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985); TMEP §1207(b)(viii).

In its first response, the applicant argued that the commercial impressions of the marks differ and that the marks are relatively weak, and thus any additional matter is sufficient to obviate a likelihood of confusion. Additionally, the applicant attached third-party registrations to show the dilution of the wording "AMERICAN" and "SHIELD" in the register.

In its request for reconsideration, the applicant argued it has long-standing rights to use the applied-for mark, there are substantial third-party registrations containing the terms "AMERICAN" or "SHIELD" and

reiterates the applicant's service expressly exclude the registrant's services. The examining attorney respectfully is unpersuaded by these arguments for the reasons set forth below.

First, applicant argued that it is a "natural and logical progression" for the applicant to use the applied-for mark "AMERICAN SHIELD INSURANCE" in connection with its services based on its prior registrations for different marks. Additionally, the applicant argued it has "long standing rights" and consumer recognition of the term "SHIELD" in its mark because it owns marks that contain the wording "SHIELD". 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 goods 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 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. 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 obviate the Section 2(d) refusal.

Furthermore, applicant's claim of priority of use is not relevant to this ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

Second, applicant has 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. 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).

Additionally, in its first response, the applicant argued that the common wording among the marks is “weak,” and thus any differences among the marks are sufficient to obviate a likelihood of confusion in this case. While the common wording “American” may be perceived as laudatory, the wording “SHIELD” is arbitrary in the context of the applied-for mark and the cited registered marks. Specifically, “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.” See <https://www.ahdictionary.com/word/search.html?q=shield>. Thus, the wording as it appears in the applied-for mark and the cited registered marks is arbitrary in that the services provided do not offer a piece of broad armor, but rather warranty and insurance services.

Further, 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 in its request for reconsideration that many of its third-party registrations have filed their Section 8 affidavits, this evidence still does not show how the marks are used in the marketplace. Furthermore, the services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the services at issue.

Moreover, a search conducted on June 21, 2015 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.”

“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. Thus, the wording “AMERICAN” and “SHIELD” is not diluted on the register for services similar to applicant’s and registrant’s services.

Third, marks must be compared in their entireties and should not be dissected; 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.”)).

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 contains the wording “AMERICAN SHIELD” and the cited registered marks contain the wording “AMERICAN HOME SHEILD”. While in its first response, the applicant argued that the commercial impressions differ because the wording “HOME SHIELD” creates the impression of home warranty services in the cited registered marks and “AMERICAN SHIELD” modifies the term

“INSURANCE” in the applied-for mark, the overall commercial impressions nevertheless remain nearly identical. Specifically, the common wording in the marks and the commercially related services create the impression of strong “American” protection in all of the marks. The fact that the cited registered marks use the wording “HOME” merely describes the type of services provided by the registrant and in this case, the applicant also provides services for the home, and thus the deletion of this wording in the applied-for mark only slightly alters the commercial impression. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant’s mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark, except for the generic wording “INSURANCE”.

Fourth, although marks are compared in their entireties, 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.

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. Further, the design elements present in the cited registered marks contain a depiction of a shield and a house, which merely reinforce the wording in the marks.

Fifth, 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 Viterro 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.

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

Relatedness of Services

Applicant's services **as amended** 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.

In its first response, the applicant argued the differences between insurance services and home warranty services. Additionally, the applicant amended its identification of services to exclude “home warranty and real estate warranty services.” Lastly, the applicant argued that the target consumers for the applicant’s services and the registrant’s services differ. The examining attorney respectfully disagrees for reasons set forth below.

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 response, the applicant amended its identification of services to exclude the home warranty and real estate warranty services; however, this exclusion does not negate the commercial relatedness of the applicant’s and registrant’s services or preclude the registrant from offering its “professional liability insurance” services listed in its identification of services. Additionally, this amendment does not preclude the applicant or registrant from marketing their services or targeting their services to any particular group or persons.

The previously attached and newly attached Internet evidence consists 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 or complementary in terms of purpose.

Specifically, the previously attached evidence from the AIG web site showed that the same source that provides insurance services also provides warranty administration services. Similarly, the previously attached evidence from The Warranty Group web site showed that the same source that provides warranty management services also provides insurance and underwriting services. Additionally, the previously attached evidence from the Bankers Insurance Group showed that the same source that provides insurance services also provides warranty services. Lastly, the previously attached evidence from the First American web site showed 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/>.

Also, the examining attorney previously attached evidence showing that the applicant's and registrant's services are complementary and often provided by the same source under the same mark. Specifically, the previously attached evidence from the registrant's web site stated "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/>. Additionally, the previously attached evidence from the First American web site showed that home insurance and home warranties are often marketed together 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/>. Also, the previously attached evidence from the Home Warranty Reviews web site showed that while these services 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. Further, the previously attached evidence from the Edina Realty and Stewart web sites showed that the same source provides insurance services as well as home warranty services. Lastly, the previously attached evidence from the Harbour Insurance web site showed that the same source that provides home, auto, boat and life insurance services also provides professional liability insurance.

Further, the examining attorney has attached new evidence showing that the same source provides applicant's and registrant's services and that the services are complementary in the marketplace. Specifically, the newly attached evidence from the Long & Foster web site shows the LONG & FOSTER mark is used on home warranty plans and homeowner's insurance. Additionally, the newly attached evidence from the 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). Similarly, the newly attached evidence from the BBVA Compass web site shows the same source provides home service plans as well as banking services, investment services, insurance services and financial services. Also, the newly attached evidence from the 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). Lastly, the newly attached evidence from the 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 attached 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. This evidence showed 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, applicant's mark and registrant's marks create the same commercial impression and the services are commercially related and likely to be encountered together in the marketplace by consumers. Therefore, consumers are likely to be confused and mistakenly believe that the services originate from a common source. Therefore, the refusal to register the applied-for mark under Section 2(d) of the Lanham Act is maintained and continues to be final.

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numerous benefits and conveniences for covering your home.



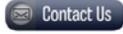
Long & Foster Home Warranty Plan



The Long & Foster Home Warranty Plan comes with features such as the Homeowner's Insurance Deductible Reimbursement, and it's backed by the Long and Foster Service Commitment.

All covered repairs are guaranteed for 180 days. If you want to extend your coverage, the Long & Foster Home Warranty Plan is renewable for as long as you own your home.

To find out more information on the Long & Foster Home Warranty Plan click here or:



2-10 Home Buyers Warranty®



LONG LIVE HAPPY HOMES™

2-10 HBW's new Home Warranty Service Agreement provides protection of systems and appliances at competitive rates, including enhanced standard coverage. The agreement also features a simple, easy-to-use format that provides buyers with a clear understanding of their homes protection.

Backed by an A+ rating from the Better Business Bureau, all parts and labor are guaranteed for 60 days on authorized service requests.

To find out more information on the 2-10 HBW click here or:





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Home > Buyers > Home Warranty

Coldwell Banker® Home Protection Plan

Buyers

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Get the coverage you need with a Coldwell Banker® Home Protection Plan

A Coldwell Banker® Home Protection Plan, administered by American Home Shield, helps provide affordable protection against the cost of repairs or replacements to many of your major home system components and appliances.

When you buy a new home, you're making a major investment in your family and your future. A home protection plan can give you the reassurance of knowing you're helping to safeguard that investment.

Benefits for the homebuyers:

- Relief from some of the expenses of unexpected breakdowns on covered items
- Affordable, flexible and customizable plans
- Access to a network of service contractors
- Increased confidence in your home purchase

When you're selling a home, you want to find ways to make your home more attractive to potential buyers. A home protection plan can make your property stand out simply by giving buyers the boost of confidence they need to make a decision in your favor.

Benefits for the home seller:

- It may discourage downward price negotiation
- It can help distinguish properties from other listings
- It can help boost buyer confidence

Related Links

- Request More Information
- Home Selling Process
- Request Home Warranty



Information

- It can help boost buyer confidence
- It can help reduce your liability in post-sale issues

What is a home protection plan? A home protection plan is a service contract that covers the repair or replacement of many of the most frequently occurring breakdowns of home system components and appliances. It puts you in control of your budget with an economical way to help protect against otherwise potentially costly situations.

[American Home Shield FAQ Sheet](#)

We are proud to serve over one million homeowners just like you.

Your Coldwell Banker Residential Brokerage broker can help you select the right plan. Contact us today and discover how the Coldwell Banker Home Protection Plan can help benefit you in the buying of a home.

For pricing and additional information please call: 1-800-493-1181

You can also contact us via [e-mail](#) or get a free quote online by visiting [ahshome.com](#)

Refer to [sample contract](#) for complete coverage details.

For more information about American Home Shield, visit [ahs.com](#)





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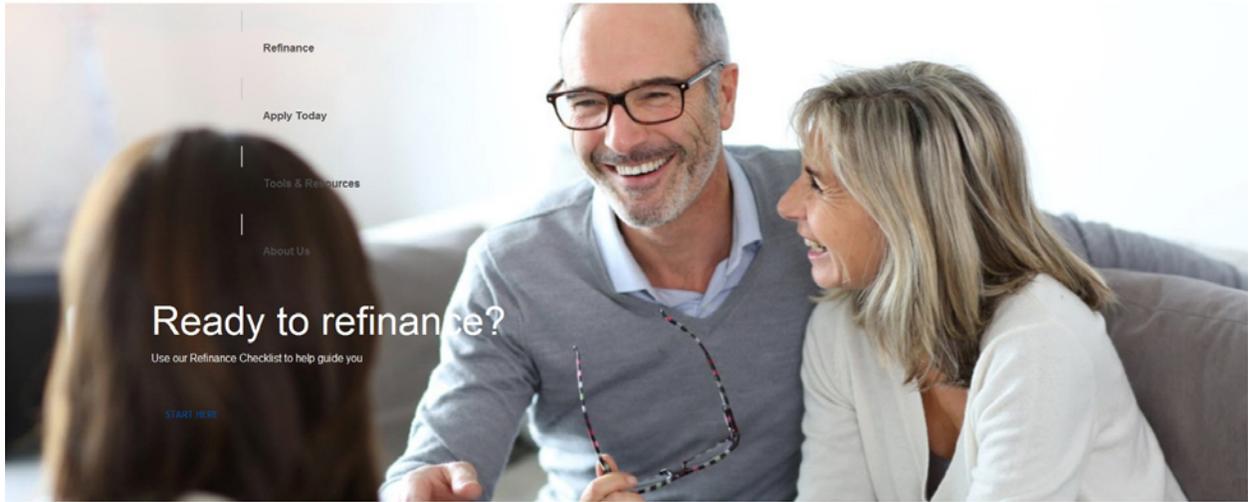
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Coldwell Banker Home Loans is dedicated to meeting your unique home financing needs.

We complement Coldwell Banker to bring you a full-service solution. Customers across the country rely on Coldwell Banker real estate professionals to guide them through the home-buying process. Every day, Coldwell Banker Home Loans works to provide home financing solutions for these customers.

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- ✓ Determine how much you can afford
- ✓ Organize your personal information

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- ✓ Define your goals
- ✓ Determine how much you still owe
- ✓ Run the numbers

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Overview [Plan Comparison](#)

Protect Your Home and Your Budget with a Home Service Plan

Regardless of the age of your home, everyday wear and tear takes its toll on your most important systems and appliances.

[Get a Quote*](#)

Insurance Services

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Think about it: every day hundreds of watts of electricity flow through your wiring system, and gallons of water through your plumbing. And don't forget about your heating and air conditioning, refrigerator, dishwasher, stove, and other appliances.

This wear and tear could cause a breakdown at any moment, costing you thousands of dollars in repair or replacement costs.

Home Service Plans can provide protection and peace of mind

BBVA Compass Insurance Agency has arranged for the HomeSure Companies to help protect valued customers from the high cost of home system and appliance repairs and replacements.

No matter which level of home service plan coverage you choose, your low service call fee should cover the cost of the breakdown — even if the item needs to be replaced!*. And your major appliances and system are covered, regardless of their age, make, or model.**

Plan options include coverage of all major home appliances and systems including:

- Air Conditioning System
- Furnace/Heating System
- Electrical System
- Plumbing System & Stoppages
- Faucets
- Toilets
- Refrigerator
- Water Heater
- Ceiling Fans
- Dishwasher (built-in)
- Cooktop
- Range
- Oven
- Range Exhaust Hood
- Trash Compactor (built-in)
- Microwave (built-in)
- Clothes Washer & Dryer
- Accessible Ductwork
- Rust and Corrosion

Home

Pet Insurance

Home Warranty

- Garbage Disposal
- Garage Door Opener
- Rust and Corrosion
- Unknown Pre-Existing Conditions

One Number Is All You Need

When something breaks, simply call the toll-free number. Because systems and appliances can fail at any time, service is available 24 hours a day, 365 days a year. When you call, you will be promptly connected with a pre-qualified technician who will come to your home to diagnose and fix your problem.

Coverage Includes Repairs and Replacements

There is no limit to how frequently you can use the repair service, and all covered work performed under the plan is guaranteed for six full months.

If repairing the appliance or system isn't the best solution, your home service plan will replace the covered system or appliance with a new one of comparable features. Which means you could get a whole new cooling system for your service call!

Protect Your Most Valuable Asset

Homeowner insurance policies typically don't cover mechanical failure of your major home systems and appliances. If you really want to protect your home and your budget, try this important coverage today.

Simply select the plan you want — TotalProtect Enhanced, SystemsProtect Enhanced, or ApplianceProtect. We'll send you more details about the plan so you can make sure the coverage is right for you. You will not be billed for 30 days, during which time you can call 800.474.4047 to cancel.

If we do not hear from you within 30 days, your home service plan will automatically start for the monthly fee you selected. By enrolling in this plan, you are providing authorization for the monthly fee due to be remitted to the home service provider by initiating an ACH debit entry to your BBVA Compass checking account. Of course you can cancel at any time after your review period, for any reason, and you will no longer be billed.

Sign up today and use your no-cost, no-obligation review to see how a home service plan can provide important protection, and valuable peace of mind.

[Plan Comparison and Pricing >](#)

*By clicking the above link, you will leave the BBVA Compass Insurance Agency website and go to a website operated by a third party. BBVA Compass Insurance Agency does not provide, nor is it liable for, any of the products, services, or content on this third party site. Please review the privacy and security policies and terms and conditions for this site.

**See terms, conditions and limitations in your Service Agreement that you can review once your enrollment request is received and materials are sent to you. Covered systems and appliances must be in good working order, with no apparent visual or operational malfunctions, on your Agreement effective date. Non-covered and incidental charges may apply to certain repairs and replacements. You may cancel at any time in the first 30 days, however, you may be responsible for any costs associated with services performed during the term of your Agreement prior to cancellation. Maximum per term aggregate to all claims amount: \$5,000 (Basic Plan Coverage) or \$50,000 (Good and Best Plan Coverage) per year based on selected coverage.

The TotalProtect Enhanced, SystemsProtect Enhanced, and ApplianceProtect Home Service Plan Agreements are issued by HomeSure Services, Inc., except in the following states where they are issued by the identified entity: Alabama, Arizona, Florida, Illinois, Iowa, Massachusetts, Nevada, New Hampshire, New Mexico, New York, North Carolina, Oklahoma, South Carolina, Texas, Utah, Vermont, Washington, Wisconsin and Wyoming by

California, Texas, Utah, Virginia, Washington, Wisconsin and Wyoming by HomeSure of America, Inc.; in California by HomeSure Protection of California, Inc.; in Virginia and Oregon by HomeSure of Virginia, Inc. Services are provided by independent tradespeople/contractors. TotalProtect Enhanced, SystemsProtect Enhanced and ApplianceProtect are registered marks of Cross Country Home Services, Inc., Fort Lauderdale, FL 33355. Please see contract for actual terms and conditions; benefits may vary by state. Program subject to sales tax where applicable.

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