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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206453
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/459,781  
Mark: PLAYBOOK FOR LIFE and Design  
Published: April 26, 2012

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**Hartford Fire Insurance Company,** :  
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       Opposer :  
 :       Opposition No. 91206453  
 - against - :  
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 :  
**Mona Terrell & Associates LLC,** :  
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       Applicant. :  
 :  
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**OPPOSER HARTFORD FIRE INSURANCE COMPANY'S  
MOTION FOR SUMMARY JUDGMENT**

**TABLE OF CONTENTS**

I. PRELIMINARY STATEMENT ..... 3

II. STATEMENT OF FACTS ..... 4

    A. The Hartford’s PLAYBOOK FOR LIFE Program ..... 4

    B. The Hartford’s PLAYBOOK FOR LIFE Registration and Application ..... 6

    C. Applicant’s PLAYBOOK FOR LIFE Application and Program ..... 7

    D. Procedural Background ..... 8

III. ARGUMENT ..... 8

    A. The Summary Judgment Standard ..... 8

    B. The Hartford’s Standing In This Proceeding ..... 9

    C. The Hartford’s Priority In And To The PLAYBOOK FOR LIFE Mark ..... 10

    D. Applicant’s PLAYBOOK FOR LIFE Mark and Design Is Effectively Identical  
    and Confusingly Similar To The Hartford’s PLAYBOOK FOR LIFE Mark. .... 11

        1. Similarity of the Parties’ PLAYBOOK FOR LIFE Marks ..... 12

        2. Similarity of the Goods and Services ..... 15

        3. Identical Trade Channels and Class of Consumers ..... 18

        4. The Lack of Similar Third Party Marks In Use On Similar Goods ..... 19

        5. Conditions of Sale / Sophistication of Consumers ..... 20

        6. Strength of the PLAYBOOK FOR LIFE Mark ..... 21

IV. CONCLUSION ..... 23

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Trademark Rule of Practice 2.127, Opposer Hartford Fire Insurance Company (“The Hartford”), through its undersigned attorneys, submits this motion for summary judgment. The Hartford respectfully requests that the Trademark Trial and Appeal Board (the “TTAB”) sustain this opposition against Applicant Mona Terrell & Associates LLC (“Applicant”), and deny Applicant’s Application Serial No. 85/459,781 to register the mark PLAYBOOK FOR LIFE and Design. This motion is based on and supported by the memorandum of law below, the pleadings and filings in the opposition proceeding, the sworn Declaration of Pam Rekow, dated October 8, 2013 (the “Rekow Decl.”) and the sworn Declaration of Michael Chiappetta, dated October 8, 2013 (the “Chiapp. Decl.”).

#### I. PRELIMINARY STATEMENT

The Hartford owns an incontestable registration for the mark PLAYBOOK FOR LIFE in Classes 35 and 41, with a priority date of December 17, 2004, for *inter alia* conducting seminars and workshops to promote financial planning to student athletes and the general public. The Hartford began using the PLAYBOOK FOR LIFE mark such seminars and workshops, as well as for complementary goods such as guidebooks and manuals disseminated in connection with its PLAYBOOK FOR LIFE program,<sup>1</sup> in March 2005. This opposition proceeding concerns the application of Applicant, a junior user with a much later priority date, to register the PLAYBOOK FOR LIFE and Design mark for a “series of educational manuals directed to student athletes and other college students on the topics of career options and life skills and experiences.” Because Applicant can point to no relevant issue of disputed fact following full fact discovery in these proceedings, and because this case concerns an application to register a

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<sup>1</sup> These goods are the subject of The Hartford’s Application Serial No. 85/658,794 for the PLAYBOOK FOR LIFE mark, also pled in this case.

mark that is legally identical to The Hartford's incontestable, registered PLAYBOOK FOR LIFE mark in connection with goods identical and complementary to The Hartford's goods and services under the PLAYBOOK FOR LIFE mark provided to identical consumers in identical channels of trade, this opposition should be sustained by way of summary judgment.

## II. STATEMENT OF FACTS

### A. **The Hartford's PLAYBOOK FOR LIFE Program**

The Hartford, with its related companies, operates one of the leading insurance and financial services businesses in the United States. (Rekow Decl., ¶ 2.) Starting on or around March 2, 2005, as part of its philanthropic focus on education, The Hartford launched PLAYBOOK FOR LIFE -- a national award-winning educational program designed to help student-athletes, college students young adults and the general public develop an understanding of personal finance planning. (*Id.*, ¶ 3.) The PLAYBOOK FOR LIFE program provides students with real-life lessons in money and career management, and presents practical insights into life in the "real world." (*Id.*, ¶ 4.) Among the topics covered by the program are saving, budgeting, credit and debt management, job searching, salary expectations, employment benefits, taxes and retirement planning. (*Id.*, ¶ 4, Exh. A.) Developed by The Hartford in collaboration with and as part of its partnership with the National Collegiate Athletic Association (the "NCAA"), the PLAYBOOK FOR LIFE program has been widely praised by coaches, teachers and parents as a valuable resource for student-athletes, college students, young adults and the general public interested in planning for their financial futures. (*Id.*, ¶ 3.)

The teachings of the PLAYBOOK FOR LIFE program have been disseminated to students in a variety of forms, including workshops and seminars, educational guidebooks and manuals, and the PLAYBOOK FOR LIFE website at [www.playbook.thehartford.com](http://www.playbook.thehartford.com) (the

“PLAYBOOK FOR LIFE Website”), all of which are provided by The Hartford to students free of charge. (*Id.*, ¶¶ 3, 5, 7-8 and Exhs. C-H.) The seminars and workshops have been held at dozens of colleges and universities throughout the country, including Duke University, Columbia University, Marshall University, University of Maryland, Wake Forest University, University of North Carolina, Chapel Hill, Boston College, Ohio State, DePaul University, University of Denver, Gonzaga University and University of Notre Dame, to name a few. (*Id.*, ¶ 5 and Exh. B.) The PLAYBOOK FOR LIFE program was also presented at the annual BEEP (Black Executive Exchange Program) Conference in 2009. (*Id.*) These workshops and seminars are administered and presented by members of “Team Hartford” -- former NCAA student-athletes, Olympians, professional athletes and other notable figures in the sporting world such as coaches, sports commentators and analysts. (*Id.*, ¶ 6.)

The centerpiece of the program is the PLAYBOOK FOR LIFE Student Guidebook. It is disseminated to attendees of the workshops and seminars, and is available for free download on the PLAYBOOK FOR LIFE Website. (*Id.*, ¶ 7, Exhs. C, G-H.) It contains 19 chapters, each covering a different topic, including, by way of example, “Budgets Give You Choices,” “The Basics of Credit Cards,” “Finding the Right Job For You,” “Evaluating the Job Offer,” “The Basics of Saving,” “Investments: Put Your Money To Work” and “Taking a Bit Out of Taxes.” (*Id.*) Other educational manuals associated with and made available through the program are the Parent’s Companion Guide, a Budgeting Guide and Teacher’s Guide Modules. (*Id.*, ¶ 7, Exhs. D-F.) Over the years, The Hartford has distributed more than 200,000 copies of the guidebooks and manuals. (*Id.*, ¶ 7.) Each of the PLAYBOOK FOR LIFE guidebooks and manuals prominently features the PLAYBOOK FOR LIFE trademark. (*Id.*, Exhs. C-F.)

The PLAYBOOK FOR LIFE Website, too, is a valuable and robust resource for students. (*Id.*, ¶ 8, Exhs. G-H.) In addition to posting a downloadable version of the PLAYBOOK FOR LIFE Student Guidebook and the Parents' Guide, the PLAYBOOK FOR LIFE Website has provided users with a compendium of the information and worksheets typically dispensed at the PLAYBOOK FOR LIFE workshops and seminars as well as user-friendly interactive informational pages and numerous links to additional resources on the internet. (*Id.*) The PLAYBOOK FOR LIFE Website has been active since at least as early as March 2005. It has always prominently displayed the PLAYBOOK FOR LIFE trademark at the top of the home page and every other page of the site. (*Id.*)

**B. The Hartford's PLAYBOOK FOR LIFE Registration and Application**

The Hartford owns U.S. Registration No. 3,102,144 (the "PLAYBOOK FOR LIFE Registration") for the mark PLAYBOOK FOR LIFE for "advertising and marketing" in International Class 35 and for "educational services; namely, conducting seminars and workshops to promote financial planning to student athletes and the general public" in International Class 41. (*Id.*, ¶ 9.) The application that gave rise to the PLAYBOOK FOR LIFE Registration was filed on December 17, 2004, on an intent-to-use basis, giving The Hartford a priority date long prior to any date on which Applicant can rely. (TTABVUE Dkt. No. 1, Exh. A.) As set forth above, The Hartford commenced use of the PLAYBOOK FOR LIFE mark in March 2005 (while the application was still pending) and so, The Hartford filed a Statement of Use upon the USPTO's issuance of a Notice of Allowance on January 31, 2006, and the PLAYBOOK FOR LIFE Registration issued on June 6, 2006. (*Id.*)

Given its longstanding use of the PLAYBOOK FOR LIFE mark in connection with its educational guidebooks and manuals associated with the program, on June 22, 2012, The

Hartford filed U.S. Application Serial No. 85/658,794 (the “PLAYBOOK FOR LIFE Application”) to register the mark PLAYBOOK FOR LIFE for “a series of books, guides, written articles, handouts and worksheets in the field of financial planning for student athletes and the general public” in International Class 16, asserting first use of the mark in connection with such goods on March 2, 2005. (Rekow Decl., ¶ 10; TTABVUE Dkt. No. 1, Exh. B.) On July 17, 2012, the United States Patent and Trademark Office issued a Suspension Letter, citing Applicant’s Application Serial No. 85/459,781 as a potential block to registration if that application were to register. (Rekow Decl., ¶ 11.)

**C. Applicant’s PLAYBOOK FOR LIFE Application and Program**

In discovery responses served by Applicant in this case, Applicant describes its PLAYBOOK FOR LIFE program as a volunteer mentoring program provided to college athletes and other university-level students to help them chart their paths to successful careers after college. (Chiapp. Decl., ¶ 2, Exh. A at Interr. No. 3.) Applicant further explains that it uses the PLAYBOOK FOR LIFE mark in connection with “a series of mentoring and leadership educational sessions via presentations (manuals) currently directed to a team of student athletes and team staff on the topics of career options and life skills and experiences.” (*Id.* at Interr. No. 9.) Applicant plans to disseminate to program participants printed “presentations, agendas, and primers that recap key ideas, opinions and sentiments” of the program, all of which will bear the PLAYBOOK FOR LIFE mark. (*Id.* at Interr. No. 5 and Exhs. B-D.) Applicant claims to have commenced offering its PLAYBOOK FOR LIFE program to students in 2010. (*Id.* at Interr. No. 9.) Like The Hartford, Applicant does not charge a fee for its PLAYBOOK FOR LIFE program or manuals. (*Id.* at Interr. No. 2.)

On October 30, 2011, Applicant filed the Application at issue in this opposition proceeding, to register the mark PLAYBOOK FOR LIFE and Design for a “series of educational manuals directed to student athletes and other college students on the topics of career options and life skills and experiences” in International Class 16 on an intent-to-use basis.

#### **D. Procedural Background**

The Hartford filed this opposition proceeding on August 8, 2012. The Hartford served discovery requests and Applicant served responses. (Chiapp. Decl., ¶ 2.) Applicant elected not to pursue any discovery (*id.*), and the discovery period closed in this case on July 17, 2013, so there is no basis for Applicant to request discovery in lieu of responding to this summary judgment motion. This motion is timely as The Hartford’s testimony period is not scheduled to open until October 15, 2013. *See* 37 C.F.R. § 2.127(e)(1).

### **III. ARGUMENT**

#### **A. The Summary Judgment Standard**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, a motion for summary judgment should be granted when there is “no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986); *Dena Corp. v. Belvedere Int’l, Inc.*, 21 U.S.P.Q.2d 1047, 1049 (Fed. Cir. 1991); *Copelands’ Enters., Inc. v. CNV, Inc.*, 20 U.S.P.Q.2d 1295, 1297 (Fed. Cir. 1991). When there are no disputed material facts, the Board has had no difficulty in issuing summary judgment. *See, e.g., Sweats Fashions, Inc. v. Pannill Knitting Co.*, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987). “[T]he mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S.

242, 247-48 (1986) (emphasis added). “Only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude entry of summary judgment.” *Id.* at 248. Moreover, the “non-movant may not rest on conclusory pleadings, but under Rule 56, must set out... what specific evidence could be offered at trial.” *Saab Cars USA, Inc. v. United States*, 434 F.3d 1359, 1368 (Fed. Cir. 2006) (quoting *Sweats Fashions*, 4 U.S.P.Q.2d at 1795); Fed. R. Civ. P. 56(e).

“The uniform precedent of [the Federal Circuit] is that the issue of likelihood of confusion is one of law... [and] the board may unquestionably resolve that issue on summary judgment.” *Sweats Fashions*, 4 U.S.P.Q.2d at 1797. In a trademark proceeding alleging likelihood of confusion, the opposer is entitled to judgment as a matter of law when there is no genuine issue of material fact that (1) the opposer has priority of rights in and to the mark at issue and (2) the applicant’s mark, as applied for, is so similar to opposer’s mark as to be likely to cause confusion, mistake or deception. *See Bongrain Int’l (Am.) Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626, 626 (T.T.A.B. 1986).

**B. The Hartford’s Standing In This Proceeding.**

As the owner of the PLAYBOOK FOR LIFE Mark, including the PLAYBOOK FOR LIFE Registration as well as common law rights in the mark (*see* Section III.C, *infra*), The Hartford has a real interest in challenging Applicant’s Application to register the PLAYBOOK FOR LIFE and Design mark, which has been cited against The Hartford’s own PLAYBOOK FOR LIFE Application and which Applicant is using and seeking to register in violation of The Hartford’s undisputed trademark rights. Accordingly, The Hartford has standing. *See* 15 U.S.C. §§ 1052(d), 1063, 1064; Trademark Trial & Appeal Board Manual of Procedure (“TBMP”) § 309.03; *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000).

**C. The Hartford's Priority In And To The PLAYBOOK FOR LIFE Mark.**

To establish priority, The Hartford must show proprietary rights in its PLAYBOOK FOR LIFE mark arising from “a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); TBMP § 309.03(c)(A); 15 U.S.C. § 1052(d) (a mark may be refused registration if it resembles a mark registered or previously used). Here, The Hartford is the owner of the PLAYBOOK FOR LIFE Registration, which was applied for in 2004 and issued in 2006, both long before the October 30, 2011 filing date for Applicant's intent-to-use Application, and long before Applicant's alleged first use of the PLAYBOOK FOR LIFE mark in 2010.<sup>2</sup> (TTABVUE Dkt. No. 1, Exh. A.) This alone is evidence sufficient to show The Hartford's priority. *See Nat'l Football League v. Jasper Alliance Corp.*, 16 U.S.P.Q.2d 1212, 1215 (T.T.A.B. 1990) (citing *Borg-Warner Corp. v. Pneumatic Hydraulic Dev. Co.*, 185 U.S.P.Q. 181, 182-83 (T.T.A.B. 1975)); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974); TBMP § 309.03(c)(A).

Further, Applicant can proffer no evidence to counter The Hartford's documentary and declaration testimony evidence (*see* Section II.A, *supra*) of nationwide use of the PLAYBOOK FOR LIFE mark in the United States since March 2005 in connection with educational guidebooks, manuals and worksheets in the field of financial planning for student athletes and the general public (the goods identified in The Hartford's PLAYBOOK FOR LIFE Application), well before Applicant commenced use of its PLAYBOOK FOR LIFE and Design mark in

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<sup>2</sup> Applicant claims to have commenced its PLAYBOOK FOR LIFE program in 2010. (Chiapp. Decl., Exh. A at Interr. No. 9.) Applicant has not claimed use of the PLAYBOOK FOR LIFE educational manuals that are the subject of its intent-to-use application at any time before commencement of its program.

connection with such goods in 2010. Thus, The Hartford has priority by virtue of its common law rights in the PLAYBOOK FOR LIFE mark in connection with such goods. *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 1 U.S.P.Q.2d 1772, 1774 (Fed. Cir. 1987) (“[T]rademark rights in the United States are acquired by such adoption and use....”) (citations omitted); *Aktieselskabet Af 21. Nov. 2001 v. Fame Jeans, Inc.*, 77 U.S.P.Q.2d 1861, 1864 (T.T.A.B. 2006) (“It is well settled that ‘[p]riority of trademark rights in the United States depends solely upon priority of use in the United States....’”) (citation omitted).

**D. Applicant’s PLAYBOOK FOR LIFE Mark and Design Is Effectively Identical and Confusingly Similar To The Hartford’s PLAYBOOK FOR LIFE Mark.**

Section 2(d) of the Lanham Act provides in pertinent part that a trademark shall be refused registration if it so resembles a prior used or registered mark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). In determining likelihood of confusion, the Board weighs the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (“*du Pont*”) to the extent those factors are relevant. *See also Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1896-97 (Fed. Cir. 2000). The *DuPont* factors that are pertinent to this proceeding include the (1) the similarity of the parties’ PLAYBOOK FOR LIFE marks; (2) the similarity of the parties’ goods and services in issue; (3) the lack of similar marks in use on similar goods or services; (4) the direct overlap of the channels of trade for the parties’ products, (5) sophistication of relevant consumers; and (6) distinctiveness and strength of the PLAYBOOK FOR LIFE mark. As detailed below, each of these factors weighs in favor of finding a likelihood of confusion.<sup>3</sup>

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<sup>3</sup> Also, the *du Pont* factors must be applied in accordance with several guiding principles. *First*, all doubts about whether confusion is likely must be resolved in favor of the prior user. *See Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989). *Second*, the

1. Similarity of the Parties' PLAYBOOK FOR LIFE Marks

The “similarity of the marks” factor focuses on the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 U.S.P.Q. at 567. The parties’ respective PLAYBOOK FOR LIFE marks are identical in *all four respects* and thus, this factor weighs heavily in The Hartford’s favor.

Applicant may point to the design features of its applied-for mark and The Hartford’s stylized presentation of its mark, and argue that these design features render the marks different in appearance and/or commercial impression. As an initial matter, this argument is irrelevant to the sound and connotation of the marks, which remain identical regardless of how the marks are presented. Moreover, any differences in Applicant’s mark design and the stylization sometimes used by The Hartford (indeed, the evidence shows that the mark frequently appears in The Hartford’s program materials without the stylization) are irrelevant both as a matter of law and fact for numerous reasons.

*First*, The Hartford’s PLAYBOOK FOR LIFE Registration is for the word mark (i.e., block letters) and its rights “are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.” *Cunningham*, 222 F.3d at 950. Thus, that The Hartford sometimes presents its PLAYBOOK FOR LIFE using a particular stylization is completely irrelevant to the analysis. Indeed, The Hartford’s block letter registration for the mark covers the use of the PLAYBOOK FOR LIFE mark “in any reasonable style of lettering... .” *Mattel, Inc. v. Funline Merch. Co.*, 81 U.S.P.Q.2d 1372, 1375 (T.T.A.B.

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later user has an obligation to avoid selecting a mark that even comes close to the prior user’s mark in order to protect the prior user’s goodwill in its prior-used mark and protect consumers from confusion. *Bridgestone Americas Tire Operations, L.L.C. v. Fed. Corp.*, 102 U.S.P.Q.2d 1061, 1063 (Fed. Cir. 2012) (“a new entrant presenting a new mark for registration has an obligation to avoid confusion with established marks in the same market.”); *TBC Corp. v. Holsa, Inc.*, 44 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1997).

2006). This would include the lettering style employed by Applicant with respect to its PLAYBOOK FOR LIFE and Design mark and thus, Applicant's stylization is inconsequential, or at best of minor significance, to the similarity of the marks analysis.

*Second*, it is well-established that the word component of a composite or design mark is the dominant portion of a mark as that is what makes the greater and longer lasting impression. *See Herbko Int'l*, 64 U.S.P.Q.2d at 1380-81 ("words dominate the design feature... [and the design] does not diminish the substantial identity of the marks in their entirety"); *M.C.I. Foods, Inc. v. Bunte*, 96 U.S.P.Q.2d 1544, 1551 (T.T.A.B. 2010) (the words are "normally accorded greater weight" in a word-design combination mark); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 U.S.P.Q.2d 1192, 1197-98 (T.T.A.B. 1994) (word portion of composite mark makes greater and longer lasting impression). Therefore, the dominant element of Applicant's mark is the phrase PLAYBOOK FOR LIFE, which is identical to The Hartford's registered PLAYBOOK FOR LIFE word mark in sound, connotation, commercial impression and appearance. Certainly, the stylization of Applicant's mark is insufficient to render the marks dissimilar.

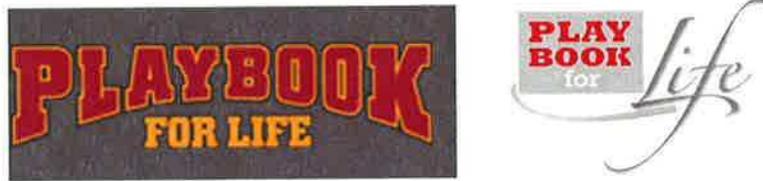
*Third*, as the Board has repeatedly noted, the focus must be on the recollection of the average purchaser who normally retains a general, rather than a specific impression of trademarks. *See Baseball Am., Inc. v. Powerplay Sports, Ltd.*, 71 U.S.P.Q.2d 1844, 1848 (T.T.A.B. 2004); *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* ("McCarthy"), § 23:41 at 23-213 (4th ed. 2012). It is highly unlikely that a student seeing one party's mark will remember all of the specific graphic elements when it later encounters the other party's mark. Also, when a student familiar with The Hartford's PLAYBOOK FOR LIFE program sees a

PLAYBOOK FOR LIFE manual from Applicant's program, even if the student has some recollection of The Hartford's stylized presentation of its mark and actually recognizes the difference between the parties' stylized presentations, the student will just assume that The Hartford had altered that presentation of its mark.

*Fourth*, because Applicant seeks to register the PLAYBOOK FOR LIFE mark in connection with goods identical to those distributed by The Hartford under the mark (*see* Section III.D.2, *infra*), much less similarity is needed between the parties' marks to support a finding of likelihood of confusion. *See In re Mighty Leaf Tea*, 94 U.S.P.Q.2d 1257 (Fed. Cir. 2010) (less similarity needed when marks are used in connection with virtually identical goods or services; finding ML for personal care products and ML MARK LEES for skin care products confusingly similar); *Bridgestone*, 102 U.S.P.Q.2d at 1064 (“[w]hen the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different”; finding confusion between Bridgestone's POTENZA and TORANZA marks on the one hand and Federal's MILANZA mark on the other hand); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992); *see also Centraz Indus., Inc. v. Spartan Chem. Co.*, 77 U.S.P.Q.2d 1698, 1700-01 (T.T.A.B. 2006) (ICE SHINE and ISHINE deemed “remarkably similar . . . especially [since] identical products are involved.”).

*Fifth*, to the limited extent the stylization of the parties' respective PLAYBOOK FOR LIFE marks has any relevance, it further supports a finding that there is a likelihood of confusion. Applicant presents the term PLAYBOOK in an all-capitals block letter typeface similar to the typeface The Hartford uses when it elects to use the stylized format, and uses

similar red color on a gray background (as shown below). If anything, Applicant's stylization would only exacerbate the likelihood of confusion.



The bottom line is that no consumer is going to assume that guidebooks and manuals bearing Applicant's PLAYBOOK FOR LIFE and Design mark that are for a program designed to educate student athletes and other college students on the topics of career options and life skills derive from a source different from The Hartford's guidebooks and manuals bearing the PLAYBOOK FOR LIFE mark that are for its program designed to educate student athletes and other college students how to prepare for their economic and professional futures. Thus, this factor strongly favors The Hartford.

## 2. Similarity of the Goods and Services

This factor examines the similarity of the goods or services being offered under the parties' respective marks. The examination is based on the description of goods or services in the applicant's application. *See Nat'l Football League*, 16 U.S.P.Q.2d. at 1215; *Octocom Sys., Inc. v. Hous. Computers Servs., Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). The goods and services identified in the parties' respective registration and applications are as follows:

<b>Applicant's Application Serial No. 85/459,781 for PLAYBOOK FOR LIFE and Design</b>	<b>The Hartford's PLAYBOOK FOR LIFE Registration</b>	<b>The Hartford's PLAYBOOK FOR LIFE Application</b>
Series of educational manuals directed to student athletes and other college students on the topics of career options and life skills and experiences.	Educational services; namely, conducting seminars and workshops to promote financial planning to student athletes and the general public.  Advertising and marketing.	A series of books, guides, written articles, handouts and worksheets in the field of financial planning for student athletes and the general public.

It is well-established that when an opposer's goods or services are complementary to the goods or services identified in the application in issue, this strongly supports a finding that the parties' goods and services are related for purposes of this *DuPont* factor. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567 (Fed. Cir. 1984) (bread and cheese can be used together and are therefore complementary and related); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 U.S.P.Q.2d 1584, 1598 (T.T.A.B. 2011) (breakfast cereal and yogurt are complementary and therefore related for purposes of likelihood of confusion analysis); *In re Iolo Techs., L.L.C.*, 95 U.S.P.Q.2d 1498, 1500 (T.T.A.B. 2010) (computer performance analysis software and computer troubleshooting services complementary and therefore related because the software is used in connection with provision of the troubleshooting services). Because educational manuals directed to student athletes and other college students (the goods in the opposed Application) are goods that would be and in fact are used in connection with seminars and workshops to promote financial planning to student athletes educational services (the services in The Hartford's PLAYBOOK FOR LIFE Registration), they are complementary to

one another and therefore highly related. For this reason alone, the relatedness of the goods and services *DuPont* factor must strongly favor a finding that confusion is likely.

Further, the undisputed evidence shows that The Hartford likewise uses its PLAYBOOK FOR LIFE mark in connection with educational guidebooks and manuals used in connection with its PLAYBOOK FOR LIFE program, and as a result, owns common law trademark rights in the mark in connection with such goods. (See Section III.C, *supra*.) Such goods (which are the basis for The Hartford's PLAYBOOK FOR LIFE Application) are in all material respects identical to the goods identified in the opposed Application. Indeed, given the highly similar subject matter in the parties' respective PLAYBOOK FOR LIFE educational manuals and guidebooks, confusion is inevitable. For this additional reason, the relatedness of the goods and services factor strongly favors a finding that confusion is likely.

Applicant has taken the position in this case that, although both parties' PLAYBOOK FOR LIFE educational programs and written materials are targeted towards college students, in particular student-athletes, and although both parties' PLAYBOOK FOR LIFE programs and written materials are designed to prepare students for post-graduate life, Applicant's PLAYBOOK FOR LIFE program and materials are dissimilar to those of The Hartford in terms of "mission, vision, goals, and/or benefits." (Chiapp. Decl., Exh. A at Interr. No. 10.) Applicant takes the position that its program and materials focus on career options and general life skills, while The Hartford's PLAYBOOK FOR LIFE program and manuals focus primarily on financial concerns. (*Id.*) Even if true, this would be a nominal distinction, insufficient to render confusion unlikely, as both parties' PLAYBOOK FOR LIFE programs and manuals concern preparing students for post-graduate success. Under the doctrine of natural expansion, The Hartford's rights in the PLAYBOOK FOR LIFE mark extend to prevent registration "of the same or similar

mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark.” *Mason Eng’g & Design Corp. v. Mateson Chem. Corp.*, 225 U.S.P.Q. 956, 962 (T.T.A.B. 1985). Clearly, despite any distinctions in the parties’ respective PLAYBOOK FOR LIFE programs, consumers familiar with The Hartford’s PLAYBOOK FOR LIFE educational program and guidebooks would reasonably expect that Applicant’s PLAYBOOK FOR LIFE educational manuals derive from The Hartford or are otherwise associated with The Hartford’s PLAYBOOK FOR LIFE educational program.

Moreover, Applicant overstates the differences between the parties’ respective PLAYBOOK FOR LIFE programs and materials. Like Applicant’s program and manuals, The Hartford’s PLAYBOOK FOR LIFE program and manuals include a focus on searching for and securing employment, as well as the importance of taking into account both salary and benefits when comparing potential jobs. While there may be some philosophical and pragmatic differences in how the parties approach their respective PLAYBOOK FOR LIFE programs and materials, such distinctions (i) are not sufficient to render confusion between the marks unlikely for the reasons set forth above and further, (ii) are not reflected in the applications and registration in issue and therefore, are irrelevant to the similarity of the goods and services analysis. *See Nat’l Football League*, 16 U.S.P.Q.2d at 1215; *Octocom Sys.*, 16 U.S.P.Q.2d at 1787. For all of the foregoing reasons, this factor also strongly favors The Hartford.

### 3. Identical Trade Channels and Class of Consumers

Two other *DuPont* factors that weigh in The Hartford’s favor are the overlap of the parties’ trade channels and consumers. *DuPont*, 177 U.S.P.Q. at 567. Because the parties’ goods and services in issue are identical and/or highly related as set forth above, it necessarily and logically follows that the trade channels and classes of purchasers are identical as well. *See*

*Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002); *Octocom*, 16 U.S.P.Q.2d at 1783. But in this case, the Board does not need to infer trade channel and consumer identity from the nature of the product in issue, as Applicant's Application and the PLAYBOOK FOR LIFE Registration both specify that the goods and services are directed to "student-athletes." And the undisputed evidence further shows that both parties provide their goods and services to such student-athletes at colleges and universities.<sup>4</sup> Thus, these factors strongly favor The Hartford.

4. The Lack of Similar Third Party Marks In Use On Similar Goods.

This factor weighs the number and nature of similar marks in use by unrelated parties on similar goods or services ("third-party marks"). Evidence that third-party marks are in use, and that consumers are aware of such use, shows that a mark is relatively weak and entitled to only a narrow scope of protection. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). Conversely, a lack of third party use of similar marks shows that a mark is strong, meaning it is entitled to a broad scope of protection, extending to non-identical marks for non-identical goods and services. *See id.*; *Frehling Enters., Inc. v. Int'l Select Grp., Inc.*, 52 U.S.P.Q.2d 1447, 1450 (11th Cir. 1999) ("The case law is clear that such lack of third-party use should be considered in assessing the strength of a mark... Where there is a lack of third-party use, the mark's strength is enhanced, as it is more distinctive, and therefore more easily recognized by consumers.")

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<sup>4</sup> The Hartford's educational seminars, workshops, guidebooks and manuals may have a slightly broader application than the educational manuals of Applicant (i.e., the PLAYBOOK FOR LIFE Registration and Application refer to "student athletes and the general public," whereas the Application refers only to "student athletes and other college students"). Of course, this only provides further support for the conclusion that Applicant's consumers and trade channels directly overlap with those of The Hartford.

In response to The Hartford's interrogatory asking Applicant to identify any third parties of which it is aware that use the PLAYBOOK FOR LIFE mark in connection with any goods or services, Applicant stated "there are no third parties that use the Mark in connection with any goods or services."<sup>5</sup> (Chiapp. Decl., ¶ 2, Exh. A at Interr. No. 13.) And in response to The Hartford's request for documents showing any such third party use, Applicant produced no responsive documents. (*Id.* at Request No. 20.) Accordingly, this factor strongly favors The Hartford.

5. Conditions of Sale / Sophistication of Consumers

It is generally accepted that consumers exercise a lesser degree of care when purchasing inexpensive items, increasing the risk of consumer confusion. *See Gen. Mills*, 100 U.S.P.Q.2d at 1600. Here, the goods and services of both parties are offered free of charge. Thus, there is no reason to think a student-athlete will exercise any particular care when picking up one of Applicant's PLAYBOOK FOR LIFE manuals, or when electing to attend one of Applicant's PLAYBOOK FOR LIFE seminars. Indeed, if the student is familiar with The Hartford's PLAYBOOK FOR LIFE program, he or she may not hesitate to obtain a free copy of one of Applicant's educational manuals under the PLAYBOOK FOR LIFE and Design mark thinking it

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<sup>5</sup> Elsewhere in its interrogatory responses, Applicant identifies a Matthews, North Carolina ministry entitled "Playbook for Life Ministries," which according to Applicant has a focus on athletics and athletes. (Chiapp. Decl., ¶ , Exh. A at Interrogatory No. 10.) Even if this ministry is active (Applicant produced no evidence one way or another despite The Hartford's discovery requests for any and all evidence of similar third party marks), such an isolated and geographically remote instance of use in connection with ministry services would have little or no impact on consumer perception of the parties' marks in issue in this case. *See Palm Bay Imps.*, 73 U.S.P.Q.2d at 1693 (relevant third party use inquiry is whether the relevant consumers are aware of the identified third party use); *see also McDonald's Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, 1899-1900 (T.T.A.B. 1989) (it is "entirely reasonable" for an opposer to object to certain uses and not others, if the opposer does not believe a remote use is unlikely to conflict with its own mark).

derives from or is associated with the source of The Hartford's PLAYBOOK FOR LIFE program and guidebooks. Thus, this factor strongly favors The Hartford.

6. Strength of the PLAYBOOK FOR LIFE Mark

The strength of a mark is “of little importance where the conflicting mark is identical and the goods are closely related.” *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 24 U.S.P.Q.2d 1001, 1012 (7th Cir. 1992) (citation omitted); *GoTo.com, Inc. v. Walt Disney Co.*, 53 U.S.P.Q.2d 1652, 1658 (9th Cir. 2000) (when conflicting marks and respective goods are almost identical, the strength of the plaintiff's mark is of diminished importance); *see also Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 U.S.P.Q.2d 1558, 1567-68 (T.T.A.B. 2011) (while opposer's SIMPLICITY mark was suggestive and likely weak, there was a likelihood of confusion with applicant's SENSE AND SIMPLICITY for directly competitive goods). As in the foregoing cases, give the virtual identity of the parties' marks and goods in issue in this proceeding, strength is hardly an important consideration. But regardless, the PLAYBOOK FOR LIFE is inherently distinctive and strong among the relevant consumer group.

The strength of a trademark is a function of two factors: (a) the conceptual strength of the mark, or the inherent distinctiveness of the mark and (b) the commercial strength of the mark, or the marketplace recognition of the mark. *See 2 McCarthy*, § 11:83 at 11-226; *Brown v. Quiniou*, 16 U.S.P.Q.2d 1161, 1165 (S.D.N.Y. 1990) (a mark's strength is determined by both its distinctiveness and marketplace recognition). As an initial matter, because the PLAYBOOK FOR LIFE mark cannot be considered descriptive or even suggestive of the services identified in the PLAYBOOK FOR LIFE Registration, namely workshops and seminars, it is an arbitrary and inherently distinctive mark as applied to such services. “When a mark has been deemed arbitrary, as opposed to generic, descriptive or suggestive, its very arbitrariness is an indicum of

strength.” *Morningside Grp. Ltd. v. Morningside Capital Grp., L.L.C.*, 51 U.S.P.Q.2d 1183, 1187 (2d Cir. 1999) (holding that MORNINGSIDE is arbitrary and strong for investment services). Thus, there is no question that the PLAYBOOK FOR LIFE mark is conceptually strong as applied to such services.

While the PLAYBOOK FOR LIFE mark admittedly has suggestive qualities as applied to The Hartford’s educational guidebooks and manuals providing financial and career guidance, it is significant that the USPTO approved Applicant’s Application for publication, which is also for the PLAYBOOK FOR LIFE and Design mark in connection with educational manuals, without requiring a showing of acquired distinctiveness. (Chiapp. Decl., ¶ 4.) Thus, the USPTO concluded the mark is not descriptive of such goods, but rather at least suggestive and thus inherently distinctive. *See 2 McCarthy*, § 11:62 at 11-175 (a suggestive mark “is entitled to the same protection accorded arbitrary and fanciful marks”); *see also Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (noting that suggestive, arbitrary and fanciful marks, “because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive”) As such, the PLAYBOOK FOR LIFE is at least suggestive of The Hartford’s guidebooks and manuals, and is moderately strong as applied to such goods. *See Star Indus., Inc. v. Bacardi & Co.*, 75 U.S.P.Q.2d 1098, 1104 (2d Cir. 2005) (even without any showing of commercial strength, suggestive marks can be “moderately strong.”)

In any event, “where as here the marks are, in legal contemplation, identical the fact that they might be suggestive is of little, if any, significance in the event that the marks are use on related products or services.” *Husky Oil Co. of Del. v. Huskie Freightways, Inc.*, 176 U.S.P.Q. 351, 352 (T.T.A.B. 1972); *see also Hunt Control Sys.*, 98 U.S.P.Q.2d 1567-68 (finding

likelihood of confusion between SIMPLICITY and SENSE AND SIMPLICITY despite finding that SIMPLICITY is suggestive and likely weak).

With respect to marketplace recognition (i.e., commercial strength), while the PLAYBOOK FOR LIFE mark may not have achieved fame among the general public, the evidence supports a finding that it enjoys substantial recognition in the relevant market here, namely the market of college students and student-athletes (the market for *both* parties' products). Indeed, The Hartford has provided its PLAYBOOK FOR LIFE goods and services to hundreds of thousands of student-athletes at dozens of universities throughout the country, thus supporting a finding that the mark has significant marketplace recognition in the market where consumer confusion is most apt to occur. Moreover, considering the conceptual strength of the PLAYBOOK FOR LIFE mark, and Applicant's Application to register the identical mark in connection with goods identical to The Hartford's goods under the mark, which are to be provided to identical consumers in identical channels of trade, confusion is inevitable regardless of the mark's commercial strength. *See Sands, Taylor*, 24 U.S.P.Q.2d at 1012; *GoTo.com*, 53 U.S.P.Q.2d at 1660-61; *Hunt Control Sys.*, 98 U.S.P.Q.2d at 1567-68.

#### IV. CONCLUSION

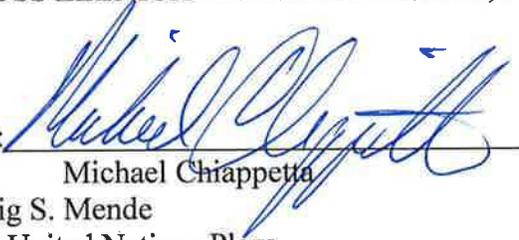
Discovery is closed in this case, so Applicant cannot claim the need for discovery before the Board may grant summary judgment (in any event, Applicant sought no discovery in the case). Nor is there any reasonable basis for claiming there is an issue of disputed fact that could impact the outcome of the case. The undisputed evidence and law, including all of the relevant *DuPont* likelihood of confusion factors, clearly supports a finding that confusion is likely between the parties' PLAYBOOK FOR LIFE marks as used on identical goods. Accordingly,

The Hartford respectfully requests that the Board sustain this opposition proceeding and deny Application Serial No. 85/459,781.

Dated: New York, New York  
October 8, 2013

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:



Michael Chiappetta

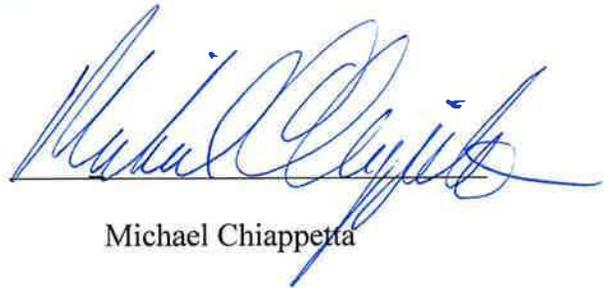
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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing HARTFORD FIRE INSURANCE COMPANY'S MOTION FOR SUMMARY JUDGMENT to be served by U.S. Mail and e-mail on October 8, 2013, on Applicant Mona Terrell & Associates LLC at the following addresses:

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Michael Chiappetta