

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

In the Matter of Service/Trademark Application:) I hereby certify that this paper is being deposited postage
Serial No.: 75/486139) prepaid with the U.S. Post Office as Express Mail
Filed: May 15, 1998) addressed to: Commissioner for Trademarks
By: Blue Cross and Blue Shield) P.O. Box 1451, Alexandria, VA 22313-1451
A New Jersey, Not for Profit Corp.) July 29, 2008
Mark: HORIZON) By: Carl Stanley
) Exp. No.: 3V73170650109

BOX TTAB/FEE
Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF APPEAL

To the Trademark Trial and Appeal Board:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney dated April 9, 2008, finally refusing registration for the above-identified trademark. The Trademark Office is authorized to charge the fee of \$100 to the Deposit Account No. 2309205563 of the undersigned attorney as well as any deficiency associated with the Notice of Appeal. Applicant has submitted a response to the final office action concurrently with this notice of appeal.

Dated: July 29, 2008

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07-29-2008

Respectfully submitted,

By: MyLynda J. Moore

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Blue Cross and Blue)
Shield of New Jersey)
Serial No.: 75/486139)
Filed: May 15, 1998)
Class(es): IC036, IC042)
Mark: HORIZON)
Examiner: James A. Rauen)
Attorney Docket No. 6587-72925)

I hereby certify that this paper is being deposited with the United States Postal Service, postage prepaid as Express Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on this date.

Carl Stanley
Date 7-29-08
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REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Mr. Rauen:

This request for reconsideration is submitted in response to the Office Action mailed on April 8, 2008, refusing registration based on likelihood of confusion with Registrations Nos. 1375260 and 1911733 owned by Pacificare Life and Health Insurance Company Corporation; and, 2084836 owned by Allied National, Inc. A Notice of Appeal to the Trademark Trial and Appeal Board was filed simultaneously with this Request. The Applicant respectfully submits that this correspondence fully responds to all issues raised by the Examiner, and traverses each of the Examiner's rejections in the office action dated April 8, 2008. Accordingly, Applicant respectfully requests Examiner reverse the refusal for registration for the reasons that follow.

I. Standard of Review

The Trademark Examining Attorney (the “Examiner”) refused registration of Applicant’s mark HORIZON under Trademark Act Section 2(d) (15 U.S.C. § 1052(d)) alleging a likelihood of confusion between the mark and the registered marks, SECURE HORIZONS (U.S. Registration No. 1375260), SECUREHORIZONS (U.S. Registration No. 1911733), WELLNESS HORIZONS (U.S. Registration No. 2084836). Applicant’s mark HORIZON is used in connection with “prepaid financing and administration of medical, hospital and related health care services, Insurance and Financial Services” and “comprehensive health care benefit programs, including those rendered through a health maintenance organization, namely, physician, dental, hospital, home health care, preventative health treatment, therapy, pharmacy, and ambulatory services”; while the registered mark SECURE HORIZONS (U.S. Registration No. 1375260) is used for “prepaid health care services”; SECUREHORIZONS (U.S. Registration No. 1911733) is used for “health care services in the nature of health care utilization, review and cost containment services” and “medical cost management and cost management for the health benefit plans of others; and, prepaid health care services; and health care in the nature of a health maintenance organization”; and WELLNESS HORIZONS (U.S. Registration No. 2084836) is used for “administration of pre-paid health care plans.”

The Examiner bases the determination of likelihood of confusion on a two-part analysis: a comparison of similarities of the marks and similarities of the services. Applicant respectfully disagrees with the Examiner’s finding and requests that she reconsiders and withdraw her refusal because there is no likelihood of confusion between Applicant’s mark and the cited registrations when the marks are viewed in their entirety.

II. Discussion of DuPont Factors for Analysis of Likelihood of Confusion

a. When examined in their entirety, the marks are dissimilar in connotation and commercial impression.

The Examiner contends that Applicant's mark and the cited registrations SECURE HORIZONS, SECUREHORIZONS and WELLNESS HORIZONS all have the prominent feature of the word HORIZON; and that this prominent feature creates similar commercial impressions. The prominent feature of a common word, however, is not determinative of similar commercial impressions or a likelihood of confusion. *See, e.g., In re Gary Null and Assoc., Inc.*, 2000 T.T.A.B. LEXIS 442, at *9 (TTAB 2000). Commercial impression is to be determined by considering the marks in their entireties. *See, e.g., In re PGB P'ship.*, 2000 T.T.A.B. LEXIS 657, at *8 (It is improper to dissect the marks "PLAYERS CHOICE 21" and "PLAYERS CHOICE POKER" because the ultimate conclusion of likelihood of confusion rests on consideration of the marks in their entireties); *see also, In re Kernoghan Brune Ltd.*, 2002 T.T.A.B LEXIS 492, *4 (Consumers are not likely to dissect the mark and will view the mark as a whole). The Examiner, therefore, erred in improperly dissecting the cited registrations to compare their individual components separately. *In re Hutchinson Technology*, 852 F.2d 552 (Fed. Cir. 1988).

When viewed in their entireties, the marks are dissimilar. The Examiner has based the rejection on the fact that, "simply put, the applicant's mark and all of the registered marks contain the term 'Horizons.'" However, "the use of identical, even dominant, words in common does not automatically mean that two marks are similar." *Freedom Savings & Loan Assoc. v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985). By focusing on the use of one word alone, the Examiner has made an improper conclusion regarding a

likelihood of confusion. When all of the components of the cited registrations are considered, that is, when the Examiner looks at the marks in their entireties, it is clear that the differences are numerous; and a likelihood of confusion is unlikely.

In the case where there is a common element, in this case the word "Horizon," it is the additional elements of the mark that are to be considered in a likelihood of confusion analysis. *See, e.g., In re Jacques Bernier Inc.*, 1 USPQ 2d 1924, 1925 (TTAB 1987); *In re Hearts Corp.*, 25 USPQ 2d 1238 (TTAB 1992) (the differences in sound, appearance and commercial impression proved VARGAS GIRL not to be confusingly similar to VARGAS); *In re Roto Frank AG*, 1996 TTAB LEXIS 40 (TTAB 1996) (the additional terms created a difference in sound, appearance and commercial impression so that the mark ROTO ALPINE was registerable over the marks ROTO-MATIC and ROTO-SWING). The main element for consideration is the inclusion of additional words. Both U.S. Registration No. 1375260 and U.S. Registration No. 1911733 contain the additional word SECURE; and U.S. Registration No. 2084836 contains the additional word WELLNESS. The additional words change the sound and appearance of the cited registrations; and are therefore, likely to obviate any confusion among consumers. *See, e.g., In re Springery, Inc.*, 1997 TTAB LEXIS 152 (TTAB 1997) (The Board reversed the refusal for registration on the basis that the additional letter X in the mark REV-X was not confusingly similar to the registration REV when both marks were used for bicycle accessories); *see also, Colgate Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401 (CCPA 1970) (PEAK PERIOD was allowed registration over the cited registration PEAK).

Additionally, there are several other elements of the marks to be considered in this likelihood of confusion analysis. The fact that the cited registrations included multiple words while Applicant's mark is only one word is but one element to be considered. The specific font employed by registration 1911733, which dramatically alters the positioning of the letters in the mark, is yet another element for consideration. Lastly, the fact that all of the cited registrations contain the word HORIZONS in plural, whereas Applicant's mark only contains the singular form of the word HORIZON should also be considered. When viewed in their entirety, all of these differences create a substantial difference in sound and appearance between the marks.

Furthermore, the Examiner erroneously compared U.S. Registration No. 2084836 to Applicant's mark. This cited registration contains the additional word WELLNESS. Although the Examiner was sure to point out that this additional term is descriptive and has been disclaimed, consumers are not aware of disclaimed words when viewing the mark. *See, e.g., In re Nat'l Data Corp.*, 224 USPQ 749, 750 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution.... Thus, it is inappropriate to give the presence or absence of a disclaimer any legal significance."). To the consumer, who views the cited registration in its entirety, the additional word WELLNESS most certainly will preclude any confusion with Applicant's mark. The additional word creates a difference in sound, appearance, connotation and commercial impression. *Clarks of England, Inc. v. Glen Shoe Co.*, 465 F.Supp. 375, 379 (S.D.N.Y. 1960) ("Such differences of connotation and meaning are key factors in determining the likelihood of confusion. Differing

connotations themselves can be determinative, even where identical words with identical meanings are used.”). Clearly the addition of the word SECURE was purposeful by the owners of the cited registrations. By not considering this additional word in the cited registrations, and the lack thereof in Applicant’s mark, the Examiner has discounted the importance or significance of its meaning in the cited registrations.

For the foregoing reasons, the Applicant submits that the Examiner’s conclusion of a likelihood of confusion between the three registrations and Applicant’s mark due to similar commercial impressions was erroneous. The Examiner improperly dissected the marks and chose only certain parts to compare. In this manner, the Examiner failed to view the marks in their entirety; and therefore, the refusal for registration should be reversed.

b. The nature of the services are distinguishable.

Applicant submits that Applicant’s services are not used generally in the field of health care services, but rather are specifically for those services offered by Applicant, a trusted name in the health care industry. Applicant has a license to operate under the widely recognizable name BLUE CROSS AND BLUE SHIELD names and marks. Therefore, a likelihood of confusion between Applicant’s services and those of the cited registrations is unlikely.

Moreover, even if the services were similar, a likelihood of confusion remains unlikely. In *In re Int’l Lutheran Laymen’s League*, 2000 T.T.A.B. LEXIS 621, *9, the Trademark Trial and Appeal Board reversed the refusal for registration of applicant’s mark “THE PUZZLE PLACE.” In that case, the Examiner refused registration based on a likelihood of confusion with the registered mark, “THE PUZZLE CLUB.” Applicant’s

mark identified “education and entertainment services” while the registered mark named “entertainment services.” The Trademark Trial and Appeal Board found no likelihood of confusion although the marks had similar services because the marks had definite differences in sound and appearance. Hence, even if Applicant and registrants offered similar goods, due to a definite difference in sound and appearance from the registered marks, a determination of likelihood of confusion would be inappropriate in this instance.

c. The number and nature of similar marks on similar goods weighs in favor of Applicant.

The Examiner has noted that the existence of third party registrations is entitled to little weight in a likelihood of confusion analysis. Although, generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark, third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive or so commonly used that the public will look to other elements to distinguish the source of the services. *See e.g. AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406 (C.C.P. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541, 544 (TTAB 1983). The Applicant submits that in this instance the existence of third party registrations do have bearing on the likelihood of confusion analysis.

The Board has held that third party registrations are competent to establish that “the inclusion of [a common element] in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity.” *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ 2d 1404, 1406 (TTAB 1988). In *Red Carpet*, the Board found no likelihood of confusion with two marks containing pentagonal designs in the field of real estate services. Additionally, “[e]vidence of widespread third-party use, in a

particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing source of goods or services in the field.” *In re Broadway Chicken, Inc.*, 38 USPQ 2d 1559, 1565-66 (TTAB 1996) (citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 (Fed. Cir. 1986); *Miles Labs, Inc., v. Naturally Vitamin Supplements Inc.*, 1 USPQ 2d 1335 (TTAB 1986); *Fortunoff Silver Sales, Inc. v. Normal Press Inc.*, 225 USPQ 863 (TTAB 1985)). Thus, third party registrations should have bearing in the likelihood of confusion analysis that has precluded registration of Applicant’s mark.

The trademark register is crowded with other “horizon” marks and as such, a consumer is not likely to be confused between any two of the crowd. *In re Lucky Co.*, 209 U.S.P.Q. 422 (T.T.A.B. 1980). To date, there are 110 live applications or registrations for the mark HORIZON; there are an additional 14 live applications or registrations for the mark HORIZONS; there are 11 live applications or registrations for the mark HORIZON and HORIZONS over International Class 042 and 12 live applications or registrations over International Class 036. These third party registrations indicate the registrability of Applicant’s mark. Furthermore, the Examiner is granting too broad a range of exclusivity to the cited registrations by prohibiting registration of Applicant’s mark. *See, e.g., Knudsen & Sons, Inc. v. Vita-Paket Citrus Prods. Co.*, 11 USPQ 2d 1654, 1655 (Fed. Cir. 1980) (The widespread of use of the word VITA in third party registrations was enough to show that VITA JUICE was not confusingly similar to VITA-PAKT when both were for fruit juices). Clearly, due to the numerous third party registrations that exist, the cited registrations are not entitled to such exclusivity; and the Examiner erred in refusing registration of Applicant’s mark.

III. Insurance Consumers Are Sophisticated

Applicant acknowledges that purchasers who are sophisticated or knowledgeable in a particular field are not necessarily immune from source confusion. *In re Decombe*, 9 U.S.P.Q.2d 1812 (TTAB 1988). However, circumstances that show differences in relevant purchasers, sophistication of those purchasers, care with which services are purchased, and the expenses thereof, mitigate against finding that the services are related even though they may be provided in the same general field.

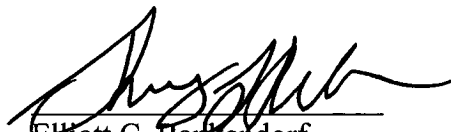
In this case, Applicant's purchasers include sophisticated corporate administrators responsible for obtaining insurance plans for employees and/or other sophisticated individuals who are looking for individual insurance coverage. Great care is invariably taken when making purchasing decisions regarding Applicant's insurance services, at great expense too. Similarly, consumers of the Registrants' services are likely taking great care, and also at great expense, in making purchasing decisions.

As such, purchasers of Applicant's and Registrants' services are discerning and discriminating buyers who recognize that the respective services come from different sources.

IV. Conclusion

In conclusion, it is submitted that the Applicant has fully responded to the Trademark Examining Attorney's inquiries and traversed and/or cured the remaining objections of the Examining Attorney for obviating likelihood of confusion or potential confusion based on the cited registrations. For the foregoing reasons, Applicant requests that the Examiner's refusal for registration of Applicant's mark for likelihood of confusion be withdrawn and the application for HORIZON be approved for publication.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Elliott C. Bankendorf", written over a horizontal line.

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