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

In re Application of: Heath Lambert Limited	
	Robert H. Coggins Law Office 107
Mark: HLA GLOBAL & Design	
Serial No.: 76/292,021	

APPLICANT'S APPEAL BRIEF

Applicant is a leading commercial insurance and reinsurance broker that offers its insurance brokerage, risk management, and consulting services to multinational organizations through a worldwide network of brokers. Applicant seeks to register a mark consisting of the words HLA GLOBAL in a distinctive geometric design. Registration of Applicant's mark has been refused on the grounds that it is likely to cause confusion with the mark shown in Registration No. 2,391,229, issued to Hamilton Lane Advisors, LLC ("Registrant"). Applicant respectfully disagrees with the examining attorneys' decision, and appeals the refusal.

The examining attorneys have asserted that Applicant's goods and Registrant's services are "closely related and of the type that purchasers expect to emanate from a single source." The evidence fails to support this assertion. More importantly, even if one assumes that the same company could provide both Registrant's services and Applicant's services, it would not mean that those products and services move in the same channels of trade.

Applicant assists companies in evaluating their insurance needs and obtaining international commercial insurance coverage. In contrast, the services in the cited registration are described as investment advisory services. There is no overlap between the services at all. If the same

company were to offer investment advisory services and international commercial insurance under the same mark, the services would be sold to different customers. Applicant's customers are not investors, but risk managers at multinational organizations. This fundamental difference in the parties' markets, together with the sophistication of Applicant's clients and the differences in the marks themselves, makes confusion unlikely. Thus, Applicant respectfully requests that the Board reverse the refusal and permit this application to register.

Amendment of Recitation of Services

As explained below, the examining attorney's refusal of the Request for Reconsideration evidences a misunderstanding of the nature of Applicant's market. Simultaneously with the submission of this Appeal Brief, Applicant has filed a request that the Board remand the application to the examining attorney for consideration of the following amendment to Applicant's recitation of services:

> "Insurance and reinsurance brokering, marine insurance underwriting, and insurance risk management and risk analysis services, all provided through an international network of associated insurance brokers to businesses and institutions with multinational operations; consultancy services in the field of insurance, reinsurance, and insurance risk management and risk analysis, provided through an international network of associated insurance brokers to businesses and institutions with multinational operations" (Class 36)

Discussion

The examining attorneys have refused registration under Section 2(d) on the grounds that Applicant's mark HLA GLOBAL & Design so resembles the mark HLA & Design (Reg. No. 2,391,229) as to be likely to cause confusion or mistake, or to deceive. As indicated above, Applicant's mark covers insurance and risk management services provided to multinational clients

by a global network of insurance brokers, while the cited mark is registered for investment advisory services. Applicant respectfully disagrees with the basis for the refusal to register.

A. The Markets and Channels of Trade are Different

The examining attorneys have asserted that Applicant's services are "closely related" to the registrant's investment advisory services. However, in order to show that marketplace confusion is likely, it is not enough simply to point out that the Applicant's and registrant's services are both in Class 36. The examining attorneys must show that the same customers would be exposed to both registrant's and Applicant's marks and, upon encountering Applicant's mark, would be likely to be confused.

The examining attorneys have failed to demonstrate how or why the same buyers would be offered both Applicant's multinational insurance services and Registrant's investment advisory services, let alone explain how the two could be confused by two very different-looking logotypes. The refusal thus omits an essential portion of the likelihood of confusion analysis. Applicant's services are in fact provided to a completely different audience than Registrant's investment advisory services. If Applicant's clients and Registrant's customers are two different groups of people, they will never be exposed to both parties' marks. If they are never even exposed to both marks, they cannot be confused.

As reflected in Applicant's current recitation of services, Applicant's mark is for insurance and related services provided to corporations and institutions, not individuals. Applicant's services are thus marketed to, and selected by, risk managers who obtain insurance coverage for their organizations. These specialized corporate decision-makers comprise a completely different

market than the individuals and institutional investors who would seek Registrant's investment advisory services.

Applicant has introduced a variety of evidence showing that the management of insurance for a business or institution is a profession unto itself. It is a field so specialized that a variety of professional associations serve the needs of its practitioners. These corporate risk managers must make complex decisions about the extent to which a company will seek insurance from an underwriter or insure itself, and then closely scrutinize the financial and legal terms of the policies available through various brokers. Needless to say, businesses have far greater exposure to a variety of risks than an individual homeowner, for example, and business insurance coverage is vastly more complicated.

Applicant's newly-amended identification of services further clarifies the specialized nature of this client audience. Applicant's insurance and risk management services are limited to companies with multinational operations. These companies are constantly engaged in business activities which cross borders, and they require insurance coverage for the risks inherent in such multinational operations. Its employees travel from country to country, and are often transferred from country to country. Its products are shipped from country to country. If injury or damage occurs in these transnational activities, the company must be confident that it has insurance coverage no matter where the injury or damage occurred. To effect such coverage, Applicant employs an international network of brokers who can provide a company with comprehensive insurance coverage for its operations in dozens of countries.

This is a business totally and completely different from the neighborhood insurance agent who sells life or auto insurance policies to individuals. In terms of complexity and sophistication,

the neighborhood agent is at one end of the spectrum of the insurance business, and Applicant is at the other. Applicant's brokerage network assists huge multinational organizations in obtaining coverage for billions of dollars of risk exposure in countries around the world.

The market for Registrant's investment advisory services is completely different than Applicant's customer base. Under the Investment Company Act of 1940, the term "investment adviser" means "any person who, for compensation, engages in the business of advising others, either directly or through publications or writings, as to the value of securities or as to the advisability of investing in, purchasing, or selling securities, or who, for compensation and as part of a regular business, issues or promulgates analyses or reports concerning securities . . . ." 15 U.S.C. §§ 80b-2(a)(11). By definition, "investment advisory services" concern securities, and are marketed to those who are looking to invest in securities. And, by definition, they are heavily regulated under the Investment Company Act of 1940.

A corporation which is licensed and registered as an investment advisor exists in a completely different environment than a corporation which is licensed as an insurance broker. Serving as an investment advisor and serving as an insurance broker are separate professions, each with its own mandatory training, government licensing, and government regulatory scheme. The professionals who provide brokerage services for multinational commercial insurance do not work as investment advisors on the side. It is a highly specialized field. The markets which they serve are also very different.

Registrant's investment advisory services could be provided to individual investors, who are not part of Applicant's market at all. Even if Registrant's services are provided to corporations or institutions, the audience is completely different, because investment advisory

services would be marketed to the people who are responsible for investing the organizations' funds, not to professional risk managers who are responsible for selecting insurance coverage for a company's international operations.

As evidence for the contention that Applicant's and Registrant's services are related, the examining attorneys have cited a number of trademark registrations that purportedly encompass services from both Registrant's and Applicant's identifications. In his response to Applicant's Request for Reconsideration, the examining attorney cites In re Albert Trostel & Sons Co., 29 U.S.P.Q.2d 1783, 1785-86 (T.T.A.B. 1993) and In re Mucky Ducky Mustard Co. Inc., 6 U.S.P.Q.2d 1467, 1470 n.6 (T.T.A.B. 1988), for the proposition that third-party registrations "have probative value to the extent they serve to suggest that the services listed therein are of the kinds which may emanate from a single source." The examining attorney has mischaracterized the holdings of the Board, which noted in these cases that third-party registrations "may have some probative value" (emphasis added). In neither of the cited cases did the Board actually rely on third-party registrations to support a finding of likelihood of confusion: In Albert Trostel & Sons Co., the Board reversed the refusal to register, and in Mucky Ducky Mustard Co., the Board relied on other facts and precedents, including a series of cases relating specifically to likelihood of confusion between food services and food products.

Even if the examining attorney were justified in his emphasis on the evidentiary value of third-party registrations, the registrations he has cited would fail to show that Registrant's services and Applicant's services typically emanate from the same source. None of the cited third-party registrations indicate that the services are offered to Applicant's market -- i.e., multinational organizations seeking insurance coverage for international operations. The mere

fact that a handful of third-party registrants claim to offer both investment advice and insurance services does not establish that any one company offers both investment advisory services and insurance coverage for multinational businesses.

In the Mucky Duck case the Board discounted third-party registrations issued to "owners of a large department store and an amusement theme center ... where a wide variety of goods and services are sold." 6 U.S.P.Q.2d 1467, 1470 n.6. Applicant notes that many of the third-party registrations identified by the examining attorney were issued to entities that offer a wide variety of financial services to the consumer market. Indeed, many of the cited third-party registrations refer specifically to life and health insurance, which would obviously be sold to individual consumers or, at the corporate level, to employee benefit managers. While an individual might seek insurance and investment advice from different subsidiaries of the same financial services company, it does not follow that a multinational business organizations would purchase investment advisory services and commercial insurance from a single source, or that the same people in those organizations would be involved in both investment and insurance matters.

In refusing registration, the examining attorney also quite astonishingly cited Applicant's own U.K. registration of the HLA GLOBAL logo, which covers "printed publications, printed matter and books, all relating to financial matters, pensions or insurance." The citation of a foreign registration for a different set of goods is completely inappropriate and irrelevant to the services that Applicant is offering in this country. It obviously proves nothing about the relatedness of insurance services and investment advisory services, since it does not cover either.

Other than the registrations noted above, the examining attorneys' only evidence consists of 10 news articles from a 14-year period that purportedly show that the services described in the

pending application and in the cited registration "emanate from a single source." Of course, given that the examining attorneys found only 10 articles over 14 years in the vast NEXIS database that supposedly support their position, one could readily conclude that their position doesn't reflect reality. And that is in fact the case. These articles do not stand for the premise on which registration has been refused. None of them establishes that the services described in the pending application and in the cited registration share a common marketplace or set of customers. Specifically:

- A June 11, 2001 article from Pensions and Investments reports that Lance Inc. hired mPower to provide online investment advice to participants in Lance's 401(k)/profit-sharing plan. The article makes no suggestion whatsoever that mPower also offers commercial insurance brokerage services. The examining attorney presumably cited the article because it refers to a "senior director of benefits and risk management at Lance" -- a corporate officer who is evidently responsible for managing investment risk in connection with his company's employee pension fund. This type of risk management has nothing to do with the risk management services that would be provided by a network of insurance brokers, who seek to limit the kinds of risk that companies face in their day-to-day business operations.
- The articles from Securities Industry News and the Lancaster, Pennsylvania Intelligencer Journal describe firms that offer both "investment advice" and "risk management" services. Again, there is nothing in the articles to suggest that these firms offer the type of risk management services that Applicant's insurance brokers offer; rather, it appears that they help customers hedge against investment risk.

- The 1989 article from The Orange County Register describes a company staffed with four financial planners and several support employees that offer "financial planning and investment advice in such areas as taxes, risk management and retirement." This article does not use "risk management" in the insurance sense, and these services are obviously directed to individuals, not businesses, much less multinational businesses.
- The two articles from The Washington Post describe a company called Crestar Financial Corp., whose "four nonbank subsidiaries offer insurance, brokerage, mortgage loan, and investment advisory services." The articles give no indication about what markets these subsidiaries serve, or even whether the different subsidiaries serve the same markets.
- The 1997 article from the "Life & Health/Financial Services Edition" of National Underwriter is about life insurance agents who offer investment advice to individuals, not commercial insurance brokers like Applicant.
- The 1991 Chicago Tribune article concerns banks and thrift institutions that ceased offering promotions such as "free toasters" to their customers. The examining attorney has highlighted a reference to a "financial superstore" that offers customers both insurance and investment services, but these services are clearly directed to individuals, not businesses.
- The 1987 Los Angeles Times article refers to a real estate services firm that offers a range of financial services relating to real estate assets. The fact that a real estate services firm offers investment advice relating to real estate and insurance brokerage relating to real estate obviously does not establish that Registrant's investment advisory services and Applicant's multinational commercial insurance services are likely to emanate from a single source.

- The 1990 article from Business Insurance describes a Dublin-based company that "specializes in property/casualty insurance brokerage as well as pension consulting, life insurance and investment advice." Aside from the fact that life insurance would be sold to individuals, not businesses, the article gives no indication as to which market or markets this company serves.

The examining attorneys have thus failed to establish that the same companies offer investment advisory services and the type of commercial insurance services provided by Applicant's global network of insurance brokers. But even if they were able to prove that companies occasionally use the same mark for investment advisory services and for multinational commercial insurance, this would not establish that Applicant's mark and Registrant's mark are used in the same channels of trade. "Relevant to the issue of likelihood of confusion is consideration of how and to whom the respective goods of the parties are sold. That is, are both products sold in the same "'channels of trade'?" 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:51 (4th ed.). The mere fact that two different services are offered by the same company under one mark does not indicate that the services are offered through the same channels -- i.e., that the services are sold through the same marketing methods and to the same customer base. "[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP § 1207.01(a)(i).

Applicant's services are limited to businesses and institutions, and Applicant has documented that the personnel in these organizations who are responsible for insurance coverage are different than the personnel who are responsible for the organization's investment needs. This

is particularly true in Applicant's specialty, which consists of providing the services of a network of insurance brokers in many countries to provide insurance for multinational corporations.

Even if one assumes that Registrant could serve the same types of companies, its marketing efforts would be directed toward a treasurer or other corporate officer responsible for investing corporate funds. Applicant, by contrast, markets to the risk managers who select insurance coverage for their organization's international operations. The parties' marketing channels are thus entirely different, and their marks would not be encountered by the same purchasers. Thus, confusion is impossible.

B. Applicant's Customers are Sophisticated

In the absence of overlap between Applicant's customers and Registrant's customers, there can be no confusion. But even if an overlap somehow existed, the potential for confusion is minimized by the fact that Applicant offers its services to insurance professionals, not consumers. The examining attorney completely dismisses the relevance of a sophisticated clientele, but it is well established that "[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing" are a factor in determining likelihood of confusion. TMEP § 1207.01, quoting In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). In fact, the courts and the TTAB have long recognized that the sophistication of the class of potential purchasers can be a "critical factor" in determining confusion. See, e.g., Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 220 U.S.P.Q. 786, 790 (1st Cir. 1983) (finding no likelihood of confusion between ASTRA for pharmaceuticals and ASTRA for blood analyzer). As the Astra court observed, "there is always

less likelihood of confusion where goods are expensive and purchased after careful consideration." Id.

In today's litigious environment, corporate insurance is a high-visibility issue. Multi-million dollar insurance policies are obviously not bought on a whim, nor are they purchased without a great deal of personal contact with the broker. As its identification of services indicates, Applicant is not merely in the business of sellling insurance policies. Many different insurance companies compete in the corporate market and offer a wide range of options. A company's decision to purchase a particular amount and type of business coverage is the result of considerable advice and analysis. Applicant provides these consulting services to its clients, and then provides the services of an international network of brokers who obtain the appropriate coverage for the client from appropriate insurance carriers. Applicant's representatives obviously have a direct, collaborative, and continuing relationship with their clients. These are precisely the type of circumstances in which trademark law recognizes that confusion is unlikely.

Applicant's clients are well aware that the creator of the HLA GLOBAL network is Heath Lambert Group, one of the largest insurance brokers in the world. Under such circumstances, it is simply not plausible that a corporate insurance manager would be confused by Applicant's HLA GLOBAL logo simply because an investment advisor uses a completely different logo that also happens to contain the initials HLA.

C. The Marks are Different

The likelihood of confusion is further reduced by the fact that Applicant's design is conveys a completely different commercial impression than the cited registration. The Trademark Manual of Examining Procedure states that the meaning or connotation of a mark must be

determined "in relationship to the named goods or services" and cautions that "[e]ven marks which are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." TMEP § 1207.01(b)(1). Here, the letters HLA in Applicant's mark and Registrant's mark convey two decidedly different commercial impressions, because each is an acronym used to stand for something different.

HLA is not a word, has no intrinsic meaning, and cannot be pronounced. Anyone encountering the mark will immediately recognize that the letters HLA are initials which stand for something else. As an indicator of origin, HLA only tells part of the story. In the unlikely event that the same people encounter both Applicant's mark and Registrant's mark, they will rely on the design elements of the marks to distinguish the two.

As the Board has determined, when letter marks are presented in a highly stylized form, the "differences in lettering style and design may be sufficient to prevent a likelihood of confusion." Textron, Inc. v. Maquinas Agricolas "Jacto" S.A., 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982). In these types of cases the examining attorney should focus on the visual dissimilarities between the marks, because "similarity of appearance is usually controlling." Id.; In re Johnson Products Co., 220 U.S.P.Q. 539 (T.T.A.B. 1983).

The first examining attorney cited In re Appetito Provisions Co., 3 U.S.P.Q.2d 1553 (T.T.A.B. 1987) and Amoco Oil Co. v. Amerco, Inc., 192 U.S.P.Q. 729 (T.T.A.B. 1976) for the proposition that the word portion of a mark is more likely to be impressed upon a purchaser's memory than the design element. In both of these cases, however, the Board relied specifically on the characteristics of the purchaser in the relevant market. In the Appetito Provisions case, which

involved marks for restaurant services and Italian sausage, the Board stressed "the propensity of persons to try restaurants based on word-of-mouth recommendations," and in the Amoco case, which involved marks for truck rentals and auto accessories, the Board emphasized that "[t]he purchasers are not extremely discriminating." Those facts don't apply here. Purchasing a corporate insurance policy involves considerably more discrimination than buying a sausage or a gallon of gasoline. Given the stakes of the potential transaction, Applicant's sophisticated clients will not overlook the significant differences in the marks.

Registrant's mark consists of the letters "HLA" in a serif typeface, in combination with a stylized outline of a globe marked with longitude and latitude lines, all elements represented in white on a square, black background. Applicant's mark, by contrast, consists of the sans-serif letters "HLA" represented in white against a distinctive black arch design, and the word GLOBAL, also sans serif but black-on-white, in lower case format. The respective fonts, lettering, words and designs used in the marks are completely different and easily distinguished from one another upon even a casual observation.

Further, the marks in context have different meanings. Registrant's HLA mark stands for Hamilton Lane Advisors, registrant's trade name, which is borne out by the pseudo mark designation in the Trademark Office records. Its mark will be recognized in that context as an acronym for the firm name. In contrast, Applicant's mark signifies its house mark, "Heath Lambert." Applicant's clients will not be confused into believing that Applicant's services are related to or endorsed by the registrant, because Applicant's clients will naturally perceive Applicant's mark as initials representing its name.

The presence of the word GLOBAL is also a key distinction for Applicant's mark. Applicant did not incorporate GLOBAL for the purpose of making its mark sound impressive. The word highlights the key distinction between Applicant's services and those of other insurance brokerage businesses -- that the services are provided by a worldwide network of insurance brokers, and that the risks insured are multinational. It is thus no less significant a part of the mark than HLA.

Because these marks create two distinct visual impressions, readily distinguished from one another, Applicant respectfully submits that its mark is not likely to cause confusion, mistake or deception. See In re Johnson Products Co., 220 U.S.P.Q. 539 (T.T.A.B. 1983); Georgia Pacific Corp. v. General Paper Corp., 196 U.S.P.Q. 762, 772 (T.T.A.B. 1977).

Conclusion

In light of the foregoing, Applicant respectfully requests that this mark be approved for registration.

Respectfully submitted,

Glenn A. Gundersen
Hal E. Borden
Dechert LLP
4000 Bell Atlantic Tower
1717 Arch Street
Philadelphia, PA 19103-2793

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Glenn A. Gundersen
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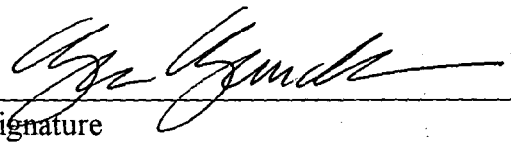
March 7, 2003



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