

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Oral Hearing:  
December 3, 2009

Mailed:  
February 12, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Capital Blue Cross

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Serial No. 78869843

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Elliott C. Bankendorf of Husch Blackwell Sanders Welsh & Katz, Ltd. for Capital Blue Cross.

Meghan Reinhart, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Quinn, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:


Capital Blue Cross seeks registration on the Principal Register of the standard character mark AVALON for "issuing group and individual health insurance policies and offering as a licensed insurer such health insurance policies and the administration thereof excluding acting as a broker or

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insurance agent" in International Class 36.<sup>1</sup> Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified services, so resembles the registered marks set forth below as to be likely to cause confusion, mistake or deception.

Registration No. 2388231 for the mark **AVALON RISK MANAGEMENT** ("risk management" disclaimed), for services identified as "insurance brokerage services in the field of surety bonds, marine cargo insurance, errors and omissions insurance and other lines of insurance" in International Class 36, issued September 19, 2000, Section 8 and 15 declarations accepted and acknowledged, owned by Avalon Risk Management, Inc.;

Registration No. 3271955 for the mark

 ("consulting" and "insurance/reinsurance claims management" disclaimed), for services identified as "insurance claims auditing services" in International Class 35 and "insurance services, namely, insurance consulting services; insurance and reinsurance claims management" in International Class 36, issued July 31, 2007, owned by Avalon Consulting, LLC; and

Registration No. 3271956 for the standard character mark AVALON CONSULTING ("consulting" disclaimed), for services identified as "insurance claims auditing services" in

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<sup>1</sup> Application Serial No. 78869843, filed April 26, 2006, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

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International Class 35 and "insurance services, namely, insurance consulting services; insurance and reinsurance claims management" in International Class 36, issued July 31, 2007, owned by Avalon Consulting, LLC.

The appeal is fully briefed. We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With regard to the marks, overall we find applicant's mark AVALON to be similar to the marks in all three registrations. It is not disputed that the word AVALON is the dominant element in the marks in the cited registrations. Indeed, other than the stylized A in one of the cited marks, all other matter in the cited marks is

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disclaimed. Disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ2d 749, 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

Applicant focuses its argument on the scope of protection to be given the cited marks, the differences in the services and the sophistication of the purchasers. As to the first issue, the scope of protection, this relates to the du Pont factor of "the number and nature of similar marks in use on similar goods" or the inherent weakness of the mark in that it has taken on some meaning in that field such that consumers rely on other matter to distinguish the marks.

Applicant argues that the "trademark register is crowded with other 'avalon' marks and as such, a consumer is not likely to be confused between any two of the crowd." Br. p. 5. In support of this argument applicant submitted

evidence of several third-party registrations for a variety of goods and services.<sup>2</sup> The first problem with applicant's argument is that third-party registrations are not evidence of use in the marketplace and, as such, are not probative of the sixth du Pont factor, "the number and nature of similar marks in use on similar goods." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973). However, "they may be considered to demonstrate the meaning of a word which comprises the mark, or a portion thereof, to show that there is a well-known and commonly understood meaning of that word and that the mark has been chosen to convey that meaning." *Knight Textile Corp. v. Jones Investment CO.*, 75 USPQ2d 1313 (TTAB 2005). This raises the second problem with applicant's argument. Of the Federal registrations (other than the three cited registrations) only those belonging to one third-party include insurance-related services and those are limited to and associated with its real estate services.<sup>3</sup> Thus, the relevant registrations come from only

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<sup>2</sup> Applicant also submitted hit list summaries from an Internet search engine. Search summaries are generally too truncated to provide sufficient information about the use of a particular term, and those of record in this case suffer from this limitation. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). They thus are accorded limited probative value.

<sup>3</sup> The third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion.

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three third parties and are not sufficient to establish that the term AVALON is weak in the insurance field. However, we note that these three coexist and each is for very different types of insurance-related services.

We turn then to an analysis of the services. We compare applicant's services identified as "issuing group and individual health insurance policies and offering as a licensed insurer such health insurance policies and the administration thereof excluding acting as a broker or insurance agent" with those in each of the registrations.

As noted above, the services in Registration No. 2833281 are "insurance brokerage services in the field of surety bonds, marine cargo insurance, errors and omissions insurance and other lines of insurance." We find the services in the registration to be quite distinct from applicant's services. Most prominently they differ by field of use in that applicant's insurance services are limited to the health care field and registrant's services are limited to surety bonds, marine cargo and errors and omissions. We do not read the remainder of registrant's identification to include the health care field. This is

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Allstate Insurance Co. v. Delibro, 6 USPQ2d 1220, 1223 (TTAB 1988). In any event, only two of those are listed in the insurance field.

entirely out of the natural scope of this identification. In addition, as applicant states "registrant is not operating as the issuer of health insurance policies, but rather as a brokerage. As such, the Registrant is not a licensed insurer and cannot legally issue insurance policies. Registrant, as an insurance broker, is an insurance salesperson that searches the marketplace in the interest of clients (not insurance companies). The Registrant's legal obligation is to the individual or group who will ultimately be covered by the insurance and not to the issuer of insurance." Br. p. 7. See also May 29, 2007 Response Exh. K (excerpts from LOMA Textbook, Insurance Company Operations 2d ed.; and [www.ambest.com](http://www.ambest.com) "Best's Insurance Resources Glossary of Insurance Terms" containing definitions for "brokerage," "policy," and "licensed insurer").

The services in Registration Nos. 3271955 and 3271956 are "insurance claims auditing services" in International Class 35 and "insurance services, namely, insurance consulting services; insurance and reinsurance claims management" in International Class 36. Applicant argues that "[r]egistrant is not operating, and cannot legally operate, as the issuer of health insurance policies, but rather only as a consultant to sophisticated corporate

entities, specifically in the highly technical field of underwriting and issuing insurance policies under stringent state licensing programs. Without specific state licensure and oversight the Registrant may not act as a licensed insurer and cannot legally issue insurance policies. On the other hand, Applicant is a licensed insurer. This means that Applicant holds a license in one or more states to actually underwrite specified policies in the lines of insurance for which it qualifies." Br. p. 7.

The examining attorney argues that there is an "abundance of evidence demonstrating that 'issuing group and individual health insurance policies,' 'administration of policies,' 'insurance brokerage services,' 'insurance claims auditing services,' 'insurance consulting services,' and 'insurance and reinsurance claims management' services are closely related and often undertaken by the same company." Br. p. 14. The examining attorney submitted several third-party use-based registrations in support of this argument. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The problem with the evidence is that none of the third-party registrations exactly overlap with applicant's services and the services listed in each respective registration. See, e.g., Reg. No. 3103817 for the mark STONEBRIDGE CASUALTY INSURANCE, for "insurance



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services, namely, brokerage, claims processing, consultation, underwriting and administration of property insurance, disability insurance, fidelity and surety insurance, marine and transportation insurance, casualty insurance, credit insurance, accident and health insurance, motor vehicle insurance, aircraft insurance, workers' compensation insurance, fire insurance, malpractice insurance, earthquake insurance, liability insurance, mortgage guaranty insurance, homeowners insurance, crop and livestock insurance, personal injury insurance"; and Reg. No. 3340023 for the mark for the mark THE POWER TO COMPETE, for "cost management for the health benefit plans of others; cost management for the health care benefit plans of others; health care cost containment; health care cost review; ...insurance claims auditing services; managing the operations of insurance agencies and brokers on an outsourcing basis." In addition, many of these third-party registrations are for wide-ranging services that include banking and financial services along with various services within the larger insurance field. See, e.g., Reg. No. 2970759 for the mark THE WEBSTER WAY for, inter alia, "financial and insurance services, namely, banking services; personal and commercial banking services; checking account services, savings account services ...

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providing working capital loans ... providing working capital loans ... trust and estate planning ... insurance agency, brokerage, underwriting and administration services in the fields of life, accident, health, disability, long-term care, management and professional liability ...investment management ... risk management."

The examining attorney also points to excerpts from the webpages of various health care benefit providers, contending that they "show that a wide variety of insurance products and services, including claims auditing, claims management and issuing health insurance policies, are provided by one source." Br. p. 15. However, these examples merely underscore the difference between insurance services from a health benefits provider and the insurance services listed in the registrations. For example, the website for UnitedHealthcare includes the following description of services:

We are a part of Unitedhealthcare, a subsidiary of UnitedHealth Group Incorporated, an innovative leader in the health and well-being industry, serving more than 50 million Americans. To help you attract and retain top-caliber employees, we offer a variety of health care coverage options, ...

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On the next web page it discusses its online services provided as part of the overall health care coverage services:

If you are a member, you can: ... update your address ... check claim status... If you are a physician, health care practitioner or facility, you can: ...check claim status check member eligibility.

Id.

The website for Aetna includes the following:

Aetna is one of the nation's leaders in health care, dental, pharmacy, group life, and disability insurance, and employee benefits. Dedicated to helping people achieve health and financial security. Aetna puts information and helpful resources to work for its members to help them make better informed decisions about health care. ... Our customer service and claim areas represent the "face" of Aetna, serving as the important first line of contact with our customers. These professionals work directly with our members, doctors and employer groups (companies) to help them better understand our products and services and assist with timely, accurate payment of their claims, while providing a human connection at those times when it is needed most. ... Customer Service Representatives, Claim Benefits Specialists and Service Consultants work in our Customer Service Centers located across the nation.

Id.

Similarly, the website for Kaiser Permanente includes information about how to submit a claim to their claims department. Id.

The claims "auditing" and "management" services on these health insurance websites are merely ancillary to the primary services of issuing health care insurance as compared to, for example, the services provided by registrant which involve managing claims directed to another company in a variety of fields. Registrant's website reveals that the service it provides is to assist clients:

... in effectively and efficiently managing and resolving your claims. With more than forty years of combined claim experience in the property/casualty industry, the members of Avalon Consulting have learned to turn what is unexpected into what can be expected. We can also help you by evaluating claim organization structures, managing run-off claims and providing insight into the financial exposures presented by property/casualty claims.

Response Exh. B (March 20, 2008).

With regard to the "insurance consulting" in Registration Nos. 3271955 and 3271956, the examining attorney argues that "[r]egistrant's services are identified broadly and there is no limitation regarding the consumers to whom it provides its services." Br. p. 16. In order to qualify as a service for registration purposes, a service must be sufficiently separate from an applicant's principal activity. Trademark Manual of Examining Procedure (TMEP) § 1301.04(a)(iii) (6<sup>th</sup> ed. 2009). It is

not clear what "insurance consulting" services a licensed provider of health insurance would provide other than explaining the services they offer or how to utilize their services. Similarly, to the extent "insurance consulting" would extend to the general public, that would be more in the nature of an ancillary service in connection with an insurance broker or agent. In view thereof, we find that "insurance consulting" does not encompass applicant's identified services and the record does not support a finding that the consuming public would associate a single source with applicant's services, an issuer and administrator of a health benefits plan, and insurance consulting services. As applicant states "simply because Applicant and Registrants are engaged in the general field of insurance is not sufficient, in itself, to demonstrate that the respective services are related." Br. p. 10. See *General Electric CO. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977).

Because there are no limitations in the identification of services, we must presume that the services will be offered in all ordinary channels of trade and to all classes of customers for those services. However, it is not clear from this record that licensed providers of health insurance, and insurance/reinsurance claims auditing

and management on the one hand, and insurance brokerage services in the field of surety bonds, marine cargo insurance and errors and omissions insurance, on the other hand, travel in the same channels and are directed at the same consumer, other than to note that everyone seeks health insurance and within that group some individuals may be engaged in seeking other types of insurance or insurance-related services such as consulting or claims auditing or management, either as a sophisticated purchaser for a group plan or as an individual making a careful purchase. In any event, even assuming common channels of trade and overlap in purchasers, we find that these factors do not outweigh the differences present in the services themselves combined with the added degree of care, on the part of individual consumers, and sophistication, on the part of professional buyers, in the purchasing decision.

In conclusion, we find on this record that applicant's services are not sufficiently related to each of the registrants' services such that there is a likelihood of confusion and the conditions of sale of the respective services also serve to prevent customer confusion.

In making our determination here, we recognize that examining attorneys are somewhat hampered by evidentiary limitations. In re Pacer Technology, 338 F.3d 1348, 67

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USPQ2d 1629, 1631 (Fed. Cir. 2003). Perhaps on a different record developed in an inter partes case a different result would be reached.

**Decision:** The refusals to register under Section 2(d) of the Trademark Act are reversed.