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061308-0072

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/874163

MARK: PRECISE PRICING



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<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

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APPLICANT: QBE REGIONAL COMPANIES
(N.A.), INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark "PRECISE PRICING," covering "insurance underwriting in the field of property and casualty insurance," on the basis that the mark is likely to be confused with "PRECISE LIFE," U.S. Registration No. 1,580,546, under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). As demonstrated herein, the refusal to register the mark under Section 2(d) of the Trademark Act should be affirmed.

I. FACTS

On May 2, 2006, applicant, QBE Regional Companies (N.A.), Inc.,¹ applied for registration on the Supplemental Register of the trademark "PRECISE PRICING," covering the following services (as amended):

¹ As noted by applicant in its brief, the original applicant, Winterthur U.S. Holdings, Inc., assigned its

International Class 36 – Insurance underwriting in the field of property and casualty insurance

Registration was refused on October 10, 2006, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the likelihood of confusion with “PRECISE LIFE,” U.S. Registration No. 1,580,546, for “life insurance underwriting services.” The Office also initially refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and required applicant to clarify the identification. The Trademark Act Section 2(e)(1) was subsequently withdrawn, and applicant submitted a revised identification of services that satisfactorily addressed the identification requirement. A Final Refusal of registration was issued under Section 2(d) on May 6, 2007. Applicant filed its notice of appeal and request for reconsideration on November 5, 2007, and the examining attorney responded to and denied the request for reconsideration on December 20, 2007.

II. ARGUMENT

THE MARKS OF APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR AND THE SERVICES OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, the strength of the trademark, similarity of the services, and similarity of trade channels of

rights in the application to QBE Regional Companies (N.A.), Inc. on November 15, 2007. (Applicant’s Appeal Brief at 1.)

the services. The other factors cannot be considered because no relevant evidence concerning those factors is contained in the record. *See In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

The question in determining whether a likelihood of confusion exists is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison – rather, the question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b). Moreover, any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant, who has a legal duty to select a mark that is distinct from trademarks already being used. *See In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

- a. THE DOMINANT PORTIONS OF THE MARKS ARE IDENTICAL AND THE DOMINANT WORD “PRECISE” IS STRONG IN THE CONTEXT OF THE SERVICES AT ISSUE

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re DuPont* at 1357.

Applicant's proposed mark is "PRECISE PRICING." Registrant's mark is "PRECISE LIFE." Disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); TMEP §1207.01(b)(viii).

In this case, the term "LIFE" from the registered mark is merely descriptive of the services (life insurance underwriting services) and is disclaimed, and thus does not serve to create a distinct commercial impression that would allow consumers to distinguish the marks. Similarly, although applicant has not disclaimed the word "PRICING," were registration being sought on the Principal Register, it would be required to be disclaimed, as it merely describes an aspect of the underwriting process at the core of applicant's services. Thus, both of these words factor less significantly in the analysis of similarity.

In addition, consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Thus, consumers will be more impressed, when viewing the marks, with the identical first word than the differing subsequent words.

When applicant's mark is compared to the registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). Here, the

marks share identical, dominant first words, followed by material that will not have source-identifying significance to consumers, and confusion is thus likely.

Despite the strong similarities between the marks, applicant argues that they are not confusingly similar. Applicant asserts that the word “PRECISE” is “itself weak because it is a laudatory term.” (Applicant’s Appeal Brief at 4.) Applicant points out that, because the examining attorney initially refused registration under Trademark Act Section 2(e)(1), he regarded the mark as merely descriptive. Applicant then asserts that the examining attorney, however, “apparently did not consider that the Registered Mark, PRECISE LIFE, was also descriptive to a significant degree.” (Applicant’s Appeal Brief at 4.) Applicant concludes that “because the Registered Mark is significantly descriptive, it is a weak mark, which militates against a finding of a likelihood of confusion.” (*Id.* at 4.)

Even if, as applicant alleges, registrant’s mark is “weak,” the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register – thus, even if registrant’s mark were registered on the Supplemental Register, the same analysis would apply. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978).

Applicant goes on to argue that, since “both marks consist of largely descriptive terms, the additional material – even if it is itself descriptive – serves to distinguish the

marks.” (Applicant’s Brief at 4.) In support of this proposition, applicant cites *General Mills, Inc. v. Kellogg Company*, 824 F.2d 622, 627 (8th Cir. 1987).

In *General Mills*, the United States Court of Appeals for the Eighth Circuit was reviewing the district court’s denial of injunctive relief under an “abuse of discretion” standard. *General Mills*, 824 F.2d at 624. The marks at issue were “APPLE RAISIN CRISP,” registered to Kellogg, and “OATMEAL RAISIN CRISP,” which General Mills was preparing to market. Kellogg had sought to enjoin General Mills from selling its new cereal, and the district court denied the injunction. *Id.* The district court found that “APPLE RAISIN CRISP” was likely a weak mark and thus entitled to a lesser scope of protection, and that Kellogg had failed to show probable success in proving likelihood of consumer confusion. The Eighth Circuit held that the district court did not abuse its discretion in denying the injunction.

General Mills, obviously, does not bind the Board. In addition, the case is questionable authority for the proposition for which applicant cites it. Because of the procedural posture of *General Mills* and the deferential standard of review being applied by the Eighth Circuit – the “abuse of discretion” standard – the Court did not actually hold “that an additional descriptive word was enough to distinguish the mark[s],” as asserted by applicant. (Applicant’s Appeal Brief at 5.) Rather, the Court of Appeals merely held that the district court had not abused its discretion in denying the injunction. Even considering the underlying facts in *General Mills*, however, it is clear that its facts and the marks at issue therein are distinguishable from those at issue here. In the *General Mills* case, the shared and identical portions of the marks were the second portions of the

marks – “RAISIN CRISP.” Here, the first and most impressive portions of the marks are shared.

In addition, consumers are less likely in the context of food products to assume that all of a certain kind of food product is made by the same entity. Simply because two products incorporate the word “spaghetti” does not mean that consumers will assume they originate from the same source – clearly, they will realize that a variety of manufacturers make spaghetti, just as they would realize a variety of manufacturers make different kinds of “CRISP” cereals that have “RAISINS” and “APPLE” and “OATMEAL” as ingredients.

Moreover, there is no indication in *General Mills* of how “weak” the elements of the marks were. Here, the term “PRECISE,” although arguably descriptive, is strong in the context of the services at issue – insurance services. As demonstrated by the examining attorney in the May 6, 2007 Office Action, the word “PRECISE” is one that consumers are not accustomed to seeing used in reference to insurance services. The word has been used only twice in active applications and registrations, one instance of which is in the registrant’s mark “PRECISE LIFE” and one instance of which is in the applicant’s proposed mark “PRECISE PRICING.” Given the infrequency of this term in the insurance services context, consumers are more likely to be confused when viewing this word used in the marks of applicant and registrant, whether or not the word is descriptive.

Applicant also argues that the examining attorney did not adequately consider the disclaimed portions / second words of the marks – that these portions of the marks were “simply brushed . . . aside by deeming ‘precise’ to be the dominant and only significant

part of the marks.” (Applicant’s Appeal Brief at 5.) As noted above, the words “PRICING” and “LIFE” have both been considered in the analysis, but weighed less than the shared word “PRECISE.” The second words are descriptive and/or generic and lack any source-identifying significance. In contrast, the shared word “PRECISE” is laudatory but not commonly used in reference to the services at issue. Although the marks are thus different when viewed in their entireties, they have confusingly similar impressions because of the shared, dominant word “PRECISE,” which is strong in the context in which it is being used.

b. THE SERVICES AND THE TRADE CHANNELS ARE ALL CLOSELY RELATED

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289 (Fed. Cir. 1984) (“[I]t is important to note that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion”).

Applicant’s mark is for “insurance underwriting in the field of property and casualty insurance.” Registrant’s mark is for “life insurance underwriting services.” These services, and the channels of trade through which they travel, are highly related. This relatedness is demonstrated by the seven copies of printouts from the USPTO X-Search database attached to the May 6, 2007 Office Action, as well as the ten additional

copies of printouts attached to the December 20, 2007 Denial of Reconsideration. These printouts have probative value to the extent that they serve to suggest that the services listed therein, namely life insurance underwriting and property and casualty underwriting, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); TMEP §1207.01(d)(iii). Thus, such services are likely to travel in the same channels of trade, likely to be displayed to consumers under circumstances giving rise to a likelihood of confusion, and likely to be perceived as emanating from the same source.

Moreover, the cited registration does not indicate any limitation with respect to the services or the intended consumers of the services. Likelihood of confusion is determined on the basis of the goods and/or services identified in the application and registration. If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); TMEP §1207.01(a)(iii). Because the channels of trade in the registration are unrestricted, applicant's argument that its services are only marketed to insurance agents is irrelevant, as registrant could be offering its services to precisely the same consumers – applicant introduces no evidence otherwise. (*See Applicant's Appeal Brief at 7.*)

In arguing that its services are different from registrant's, applicant first asserts that "the Registrant's services relate to *life* insurance, and the Applicant's relate to *property and casualty* insurance." (Applicant's Appeal Brief at 5.) Even though both

relate to underwriting, applicant asserts that “[i]nsurance underwriting’ is by itself not an acceptable designation of services in the Manual.” (*Id.*) Rather, applicant argues that “[t]he Manual . . . recognizes that insurance underwriting encompasses a range of diverse services that the Examining Attorney has condensed into one.” (*Id.*)

Although the services are not precisely the same, they are highly related and likely to emanate from the same source. Applicant challenges the X-search printouts of record, but they clearly establish that entities that offer insurance underwriting services tend to offer a wide variety of underwriting services, including life, property, and casualty underwriting services, among others. The fact that some of the registrations reveal that entities offer different types of insurance services, like “underwriting” and “claims processing” and “insurance agency services,” does not undermine their probative value on the relatedness of the underwriting services offered by applicant and registrant.

Applicant argues that, notwithstanding this similarity, “insurance purchasers can understand that different types of insurance come from different providers, even if different types can be sold by one broker or agent.” Applicant offers no evidence in support of this proposition, however. Moreover, clearly if the consumer of the service is used to going to one underwriter for all of its underwriting needs – life, property and/or casualty – the consumer is more likely to assume that such services tend to originate from the same source, especially when confronting highly similar marks such as those at issue here.

Finally, any goods or services in the registrant’s normal fields of expansion must also be considered in order to determine whether the registrant’s goods or services are related to the applicant’s identified goods or services for purposes of analysis under

Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). Here, an entity selling one type of underwriting services would thus reasonably be expected to expand to offer other types of underwriting services, especially considering the relatedness of the services as evidenced by the X-Search printouts of record.

c. SOPHISTICATION DOES NOT OBVIATE A FINDING OF LIKELIHOOD OF CONFUSION

Applicant asserts that “[t]he Examining Attorney did not properly consider the sophistication of the Applicant’s target market in evaluating the likelihood of confusion.” (Applicant’s Appeal Brief at 7.) The alleged sophistication of the Applicant’s target market was considered by the examining attorney, but as noted in the May 6, 2007 Office Action, such alleged sophistication does not obviate the likelihood of confusion here. The fact that purchasers may be sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Applicant also misconstrues the evidence attached by the examining attorney to the December 20, 2007 Denial of Reconsideration. This was not included because the examining attorney would only consider the sophistication of the purchasers if they were experts in intellectual property. (*See* Applicant’s Appeal Brief at 7.) In fact, their alleged sophistication was considered fully, but it was not sufficient to overcome the likelihood of confusion. As part of this analysis, their supposed lack of training in trademarks is

certainly one relevant factor, and was considered as such. Training in intellectual property was not considered a prerequisite in the analysis, and the examining attorney apologizes if the wording of the December 20, 2007 Denial of Reconsideration was construed the way applicant has mistakenly argued it was intended.

The evidence regarding insurance agents was provided to show that such individuals are not necessarily college-educated, but may be hired from high school. (*See* evidence attached to December 20, 2007 Denial of Reconsideration.) Their training, although it may include insurance-related coursework, does not involve coursework in distinguishing the source of the services that they encounter. Although they must be licensed, this does not establish that they are more likely to be able to distinguish source. The evidence also indicates that the “insurance industry employs relatively few people in professional and related occupations.” (*See id.*) The only arguably more “sophisticated” of the employees in the insurance field detailed in the evidence – in terms of amount of presumably more advanced education – are actuaries, who may be required to have “degrees in actuarial science, mathematics or statistics” and who must pass a series of exams taking from 5 to 10 years. (*See id.*) Actuaries are not at issue in this case.

Ultimately, there is no evidence of record establishing that the alleged consumers of applicant’s services are “sophisticated” in such a way as to enable them to distinguish between the confusingly similar marks and services at issue herein. Similarly, there is no evidence that the *actual users* of applicant’s services are only insurance agents, or that its services are only offered to agents. On the contrary, applicant’s services, just as registrant’s, are not limited in scope to a certain target audience consisting of insurance agents. Since the services in the application are identified broadly, and there are no

limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant’s argument that its goods are sold only in its own retail stores is not persuasive There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a)(iii).

Based on applicant’s identification, the relevant consuming class is thus assumed to be comprised of both professionals and the general public, and the standard of care when purchasing the services is equal to that of the *least* sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) (as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285, 60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)). Thus, even if insurance agents were assumed to be sophisticated enough to be able to distinguish the services of applicant and registrant here, the same assumption could not be made of the consuming public at large and the relevant consuming class as a whole.

III. CONCLUSION

The record thus establishes that the marks of applicant and registrant share the same dominant word and create confusingly similar commercial impressions. The record also establishes that that the services of applicant (insurance underwriting in the field of property and casualty insurance) and registrant (life insurance underwriting services), are sufficiently related under Section 2(d) of the Trademark Act, such that purchasers would

confuse the source of these services, especially in view of the great similarity of the marks themselves. Because of these similarities, purchasers familiar with the mark of the cited registration, upon seeing applicant's mark, would be likely to conclude that applicant's services emanated from the same source or that applicant's services were associated with or sponsored by the registrant. Accordingly, the refusal to register the mark under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

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