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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87026036

MARK: OPTIMUM BENEFITS PACKAGE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

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315-47-075

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has applied for registration on the Principal Register for the mark, OPTIMUM BENEFITS PACKAGE (Benefits Package is disclaimed) for services described as "Insurance administrative services, insurance brokerage services, insurance underwriting services in the field of life, health, accident, disability and longterm care insurance." Registration was refused pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on a likelihood of confusion with Registration No. 2010333

for the mark, OPTIMUM for the relevant services described as “underwriting, brokerage and management of all types of life insurance and reinsurance; and actuarial consulting services” and Registration No. 1473487 for the mark, THE OPTIMUM for the relevant goods described as “developing and writing insurance contracts” as to be likely, when used in connection with the identified services, to cause confusion or to cause mistake or to deceive. The cited registrations are owned by a single entity. This appeal follows the Examining Attorney’s final refusal under Section 2(d).

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrants. See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

The applicant's mark and the registrant's marks are highly similar in sound, appearance, commercial impression and connotation. Consumers are generally more inclined to focus on the first

word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Additionally, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. In the instant case, although the first word in Registration No. 1473487 is THE, the Trademark Trial and Appeal Board has found that inclusion of the term “the” at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE “virtually identical” marks; “[t]he addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS “virtually identical” marks; the inclusion of the definite article “the” is “insignificant in determining likelihood of confusion”). Moreover, the disclaimed portion in the applicant’s mark, BENEFITS PACKAGE, is a commonly used descriptive term in relation to the applicant’s

services and therefore, entitled to less weight. It is well-settled case law that wording that is descriptive of or generic for a party's services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). Accordingly, the first word and most dominant, nondescriptive feature of the marks of the parties are identical: OPTIMUM.

Therefore, the marks are confusingly similar.

THE SERVICES OF THE PARTIES ARE CONFUSINGLY SIMILAR

As indicated above, the applicant's services are identified as "insurance administrative services, insurance brokerage services, insurance underwriting services in the field of life, health, accident, disability and longterm care insurance." The services of Registration No. 1473487 are identified as "developing and writing insurance contracts." The services of Registration No. 2010333 are identified as "underwriting, brokerage and management of all types of life insurance and reinsurance; and actuarial consulting services." It should be noted that in its Brief, the applicant fails to raise any specific contentions concerning the similarity of the services of the parties.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991);

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the services would be encountered by the same consumers under circumstances such that offering the services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

In the present case, the services of the parties could well be presumed to be from the same source inasmuch as the services of the parties relate to insurance services. The services of Registration No. 1473487, which involves the developing and writing of insurance contracts, most certainly encompasses the insurance administrative, underwriting and brokerage services performed by the applicant. Furthermore, the services of Registration No. 2010333 and the applicant's services are nearly identical inasmuch as both involve underwriting, brokerage and management of insurance. Consequently, the services of the present parties clearly move in the same normal channels of trade, are available to all potential customers and may be utilized for the same or similar (i.e., related) purposes by the same classes of purchasers.

Therefore, the services of the parties are confusingly similar.

CONCLUSION

Under Trademark Act Section 2(d), the overriding concern is not only to prevent buyer confusion as to the source of the services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Based on the record evidence and case law, the applicant's mark, when used on the identified services, so resembles the mark in U.S. Registration Nos. 2010333 and 1473487 as to be likely to cause confusion, to cause mistake, or to deceive. The trademark examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

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