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PRECEDENT OF THE TTAB

Mailed: August 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John M. Fickewirth Associates Insurance Services, Inc.

Serial No. 87026036

Jaye G. Heybl and David Bancroft of Koppel Patrick Heybl & Philpott,
for John M. Fickewirth Associates Insurance Services, Inc.

Howard Smiga, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Kuhlke, Greenbaum and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

John M. Fickewirth Associates Insurance Services, Inc. (“Applicant”) seeks registration on the Principal Register of the mark OPTIMUM BENEFITS PACKAGE (in standard characters; BENEFITS PACKAGE disclaimed) for “insurance administrative services, insurance brokerage services, insurance underwriting

services in the field of life, health, accident, disability and longterm care insurance” in International Class 36.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the following two registered marks owned by the same Registrant:

- OPTIMUM (in typeset format²) for “underwriting, brokerage and management of all types of life insurance and reinsurance; and actuarial consulting services” in International Class 36;³ and
- THE OPTIMUM (also in typeset format) for “developing and writing insurance contracts” in International Class 36.⁴

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. The appeal is fully briefed. We affirm the refusal to register.⁵

¹ Application Serial No. 87026036, filed on May 5, 2016, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming April 13, 1994 as both the date of first use and the date of first use in commerce.

² Prior to November 2, 2003, “standard character” drawings were known as “typed” or “typeset” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See* TRADEMARK MANUEL OF EXAMINING PROCEDURE (“TMEP”) § 807.03(i) (October 2017).

³ Registration No. 2010333, issued on October 22, 1996; second renewal.

⁴ Registration No. 1473487, issued on January 19, 1988; second renewal.

⁵ The TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations reference the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

In this case, we have based our Section 2(d) likelihood of confusion findings and decision on only one of the cited registrations, i.e., on Registration No. 2010333, which is of the typeset mark OPTIMUM for the International Class 36 services identified in the registration that include life insurance underwriting and brokerage. A finding of likelihood of confusion between Applicant’s mark and this previously registered mark suffices by itself to bar registration of Applicant’s mark under Section 2(d); we need not reach likelihood of confusion as to the other cited registration. *See In re Max Capital Grp, Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1201-02 (TTAB 2009).

A. Similarity of the Services

We turn first to a comparison of the services identified in Applicant’s application vis-à-vis the services identified in cited Registration No. 2010333, the second *du Pont*

factor. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comps. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.2d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Registration must be refused if Applicant's mark for any of its identified services is likely to cause confusion with the Registrant's mark for any of its identified services. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). 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 identification of services in cited Registration No. 2010333 includes insurance brokerage and underwriting in the field of life insurance. Accordingly, insofar as Applicant's services and Registrant's services both include life insurance underwriting and brokerage, the services are identical in part.⁶

Thus, the second *du Pont* factor strongly favors a finding of likelihood of confusion.

B. Similarities in Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *du Pont* factor. Because Applicant's services and Registrant's services are identical in

⁶ Applicant makes a conclusory argument, without any evidentiary support, that the parties' respective services are dissimilar. *See Applicant's Appeal Brief*, p. 2, 8 TTABVUE 7. Applicant's argument is unpersuasive, not only because it is not supported by any evidence, but the identification of services in both Applicant's application and in cited Registration No. 2010333 clearly identify the identical services, i.e., life insurance underwriting and brokerage.

part, and there are no restrictions on those services in the respective identifications, these identical in part services are “presumed to travel in the same channels of trade to the same class of purchasers.”⁷ *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d at 1005) (finding that the Board is entitled to rely on this legal presumption in determining likelihood of confusion); *United Glob. Media Grp. Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

In view of the foregoing, the third *du Pont* factor also weighs in favor of finding a likelihood of confusion.

C. Similarity of the Marks

We finally address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir.

⁷ As with its argument regarding the similarities of the services at issue, Applicant contends, again without any evidentiary support, that the parties’ respective services are marketed to different members of the public. See Applicant’s Appeal Brief, pp. 2-3, 8 TTABVue 7-8. Applicant’s contention is without merit for two reasons. First, Applicant failed to submit any evidence to support its contention. Second, even if Applicant had submitted extrinsic evidence demonstrating that the parties’ services travel through disparate trade channels or are offered to different classes of purchasers, such evidence would not have been given any consideration since the Board, in determining the similarities of trade channels and classes of purchasers, is bound by the identifications in Applicant’s involved application and the cited registration which, as noted above, have no limitations as to channels of trade or types of purchasers. See *In re Bercut-Vandervoot & Co.*, 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected).

2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the [owners].” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted).

Because this factor is based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

Applicant’s mark is OPTIMUM BENEFITS PACKAGE. The cited mark is OPTIMUM. The sole difference between the marks is the inclusion of the disclaimed wording BENEFITS PACKAGE in Applicant’s mark.

Applicant contends that the Examining Attorney improperly focused on the element which is identical to both marks (the term OPTIMUM) while discounting the importance of the disclaimed wording BENEFITS PACKAGE in Applicant’s mark.⁸ In Applicant’s view, the addition of BENEFITS PACKAGE in its mark sufficiently

⁸ Applicant’s Appeal Brief, p. 4-5; 8 TTABVUE 9-10.

distinguishes the marks in sound, appearance and connotation so as to avoid any confusion.⁹

Contrary to Applicant's assertion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital*, 110 USPQ2d at 1161; *Nat'l Data*, 224 USPQ at 751. Keeping this principle in mind, we observe that Applicant's and Registrant's marks are comprised, either in whole or in part, of the term OPTIMUM. Moreover, the entirety of the cited mark OPTIMUM is encompassed within Applicant's mark; in such cases, confusing similarity has often been found. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (ML similar to ML MARK LEES); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL and BENGAL LANCER and design deemed confusingly similar); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY similar to LILLI ANN); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE similar to CREST CAREER IMAGES). In addition, OPTIMUM is the first element in Applicant's mark. "[I]t 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." *Palm Bay*, 73 USPQ2d at 1692; *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). When viewing Applicant's mark, the term OPTIMUM is also

⁹ *Id.*

likely to be accorded more weight by consumers because the remaining wording BENEFITS PACKAGE is, at a minimum, descriptive of Applicant's services, as demonstrated by the evidence of record,¹⁰ and which has been appropriately disclaimed. As such, BENEFITS PACKAGE is less likely to make an impact in the minds of consumers. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks); *see also Nat'l Data*, 224 USPQ at 753.

While we have not overlooked the wording BENEFITS PACKAGE in Applicant's mark, we nonetheless conclude that Applicant's mark and the cited OPTIMUM mark, when considered in their entireties, are substantially similar. Therefore, the first *du Pont* factor supports a conclusion that confusion is likely, particularly considering that Applicant's services are identical in part to those identified in cited Registration No. 2010333. *See Coach Servs.*, 101 USPQ2d at 1722 ("When trademarks would

¹⁰ The Examining Attorney required Applicant to disclaim the wording BENEFITS PACKAGE on the ground that the wording is descriptive of Applicant's identified services. *See* August 16, 2016 Office Action, TSDR p. 5. In support of his requirement, the Examining Attorney submitted a dictionary definition of "benefits package" which is defined as follows: "An employee benefits package includes all the financial benefits & incentives provided by an employer. Employers have to provide some type of employee benefits like worker compensation, disability and unemployment...The other benefits given by a company are medical insurance, accidental insurance, family member (dependents) insurance...." *Id.*, TSDR pp. 11-14. The Examining Attorney also submitted internet evidence that demonstrates that the phrase BENEFITS PACKAGE is a commonly used term relating to, *inter alia*, benefits an employee may/would receive as an employee, including life insurance. *Id.*, TSDR pp. 15-33. Based on this evidence, we agree with the Examining Attorney that the phrase BENEFITS PACKAGE is merely descriptive of a feature and/or characteristic of Applicant's identified services and that the disclaimer requirement was appropriate.

appear on substantially identical goods, ‘the degree of similarity necessary to support a conclusion of likely confusion declines.’”) (internal citations omitted).

II. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Because we have found that the marks at issue are substantially similar and that Applicant’s identified services are identical in part to Registrant’s services and, as such, are presumed to move in the same trade channels and would be offered to the same classes of purchasers, we conclude that Applicant’s OPTIMUM BENEFITS PACKAGE mark, as used in connection with the services identified in the application, so resembles the cited mark OPTIMUM in Registration No. 2010333 as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant’s OPTIMUM BENEFITS PACKAGE mark under Section 2(d) of the Trademark Act is affirmed.