

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Homestead Strategic Holdings, Inc.*  
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Serial No. 90263580  
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Donna A. Tobin and Sonia S. Shariff of Royer Cooper Cohen Braunfeld LLC for  
Homestead Strategic Holdings, Inc.

Jaime Batt, Trademark Examining Attorney,<sup>1</sup> Law Office 125,  
Robin Mittler, Managing Attorney.

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Before Zervas, Wolfson, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Homestead Strategic Holdings, Inc. (“Applicant”) seeks registration on the Principal Register of the standard-character mark CLAIM WATCHER (CLAIM disclaimed) for services ultimately identified as “Health benefit plan services, namely, insurance administration services, namely, assisting others with adjusting

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<sup>1</sup> The application was originally examined by Trademark Examining Attorney Shelby Niemann, who issued the final refusal to register from which this appeal was taken. The application was assigned to Trademark Examining Attorney Batt on appeal. We will refer to them both as the “Examining Attorney.”

insurance claims in the nature of repricing health insurance claims” in International Class 36 and “Legal services, namely, legal consulting and defense relating to health insurance claims” in International Class 45.<sup>2</sup>

The Examining Attorney has refused registration of Applicant’s mark in both classes under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the mark shown below



registered on the Principal Register for “Tracking and monitoring the status of insurance claims for business purposes” in International Class 35,<sup>3</sup> as to be likely, when used in connection with the services identified in both classes in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant requested reconsideration, which was ultimately denied, and then appealed to the Board.

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<sup>2</sup> Application Serial No. 90263580 was filed on October 19, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark and first use of the mark in commerce in both classes at least as early as July 1, 2016.

<sup>3</sup> The cited Registration No. 4500360 issued on March 25, 2014 and has been maintained through the filing of a combined declaration under Sections 8 and 15 of the Trademark Act. The registrant has disclaimed the exclusive right to use “CLAIM” apart from the mark as shown and describes its mark as follows: “The mark consists of a shield design with a black outline. The inside of the shield is yellow at the top and fade [sic] to orange at the bottom. Within the shield is a stylized letter ‘P’ appearing in black. Below the design is the wording ‘CLAIM WATCH’ in black.” The colors yellow, orange, and black are claimed as features of the mark.

Applicant and the Examining Attorney have filed briefs.<sup>4</sup> We reverse the refusal to register.

### **I. Record on Appeal<sup>5</sup>**

The record on appeal includes Applicant's multiple specimens of use;<sup>6</sup> USPTO electronic records of the cited registration;<sup>7</sup> dictionary definitions of the words "claim," "watch," and "watcher;"<sup>8</sup> third-party webpages that the Examining Attorney claims show that the involved services are offered under the same marks;<sup>9</sup> pages from the website of the cited registrant;<sup>10</sup> and third-party registrations of marks that Applicant claims are similar in nature to its mark and the cited mark.<sup>11</sup>

### **II. Analysis of Refusal**

"The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or

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<sup>4</sup> Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's brief appears at 6 TTABVUE and the Examining Attorney's brief appears at 8 TTABVUE.

<sup>5</sup> Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

<sup>6</sup> October 19, 2020 Application at TSDR 3-48; September 30, 2021 Response to Office Action at TSDR 9-10; May 11, 2022 Request for Reconsideration at TSDR 37-50.

<sup>7</sup> March 31, 2020 Office Action at TSDR 2-4.

<sup>8</sup> *Id.* at TSDR 25-26; July 21, 2022 Denial of Request for Reconsideration at TSDR 4-19.

<sup>9</sup> March 31, 2020 Office Action at TSDR 5-24; November 12, 2021 Final Office Action at TSDR 2-20; July 21, 2022 Request for Reconsideration at TSDR 20-46.

<sup>10</sup> May 11, 2022 Request for Reconsideration at TSDR 12-27.

<sup>11</sup> *Id.* at TSDR 28-36.

services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at \*2 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *Id.*, at \*4. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*29 (TTAB 2021), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant focuses on these two key factors in arguing that “the marks themselves are sufficiently dissimilar in appearance, convey different commercial impressions and the services offered [sic] each mark are sufficiently dissimilar, even if such services are respectively related to the broad field of insurance.” 6 TTABVUE 10. Applicant also argues that even if the services are deemed similar, “the USPTO in comparable

situations have [sic] allowed arguably similar marks for similar services to co-exist on the federal register.” *Id.* at 18.<sup>12</sup>

#### A. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *In re Embiid*, 2021 USPQ2d 577, at \*11 (TTAB 2021) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014)).

“The proper test regarding similarity 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 parties.” *Id.*, at \*11 (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)).

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<sup>12</sup> We give this argument no further consideration because “[e]ach case must be decided on its own facts, and the Board is not bound by prior decisions involving different records.” *In re The Consumer Prot. Firm, PLLC*, 2021 USPQ2d 238, at \*22 (TTAB 2021) (citation omitted).

Applicant's mark is CLAIM WATCHER in standard characters, while the cited composite word-and-design mark is again shown below:



Applicant argues that “when these marks are compared side-by-side, it should be readily apparent that a consumer is likely to distinguish Applicant’s Mark from the Cited Registration on the basis that the Cited Registration consists of a yellow-orange shield with a highly stylized and prominent letter P in the center . . . . 6 TTABVUE 10. According to Applicant, “there is no reason to assume that the ‘Claim Watch’ portion of the Cited Registration dominates over its design elements, namely, the shield with the stylized ‘P,’” *id.*, and “the dominant portion of the Cited Registration is the stylized ‘P,’ sitting in the middle of a shield design; the phrase ‘Claim Watch’ is but a secondary element in the Cited Registration and could not be viewed as being the dominant element.” *Id.* at 11. Applicant alternatively claims that “[a]t most, the words ‘Claim Watch’ should be accorded the same weight as the design element and the letter ‘P’, but certainly not more.” *Id.* Applicant concludes that “[a] true side-by-side comparison of Applicant’s Mark with the Cited Registration would yield the conclusion that the dominant element in the Cited Registration is the letter ‘P’ resting imperiously in a shield and as such should be accorded greater weight than any other part of the Cited Registration.” *Id.*

Applicant further argues that the marks as a whole have different commercial impressions. Applicant claims that “the reason why the ‘P’ in the Cited Registration is the dominant element of that mark is because it represents ‘Parker,’ the last name associated with the Cited Registration’s owner, ‘James G. Parker Insurance Associates.” *Id.* at 13. Applicant argues that “because the registrant/owner of the Cited Registration, also uses the *same* stylized letter ‘P’ . . . throughout its website to advertise its services generally, consumers have long been conditioned to associate this stylized ‘P’ with the services being offered by James G. Parker Insurance Associates,” *id.* (emphasis supplied by Applicant), and that “Applicant’s mark would evoke no such reaction or association.” *Id.* at 14. Applicant concludes that “the sufficient differences in the overall commercial impression between Applicant’s Mark and the Cited Registration, combined with the fact that consumers are already primed to notice differences (even subtle ones), obviates a finding of a likelihood of confusion between Applicant’s Mark and the Cited Registration.” *Id.*

Applicant further argues that “the term ‘claim watch’ in the Cited Registration and Applicant’s Mark, CLAIM WATCHER convey different commercial impressions. In the case of the Cited Registration, ‘claim watch’ evokes something passive, perhaps something akin to a clock or tracker that monitors claims in the background, whereas, Applicant’s ‘claim watcher’ evokes something more proactive and dynamic, perhaps even a person who is actively evaluating claims.” *Id.* According to Applicant,

[w]hile it may be true that “watch” and “watcher” have similar meanings, in the context of the Cited Registration and Applicant’s Mark, these words combined with other elements of the respective marks convey different

meanings from each other as already discussed above: CLAIM WATCH implies something more passive, while CLAIM WATCHER implies something more vigilant, alert and active.

*Id.* at 15.

Applicant claims that it is more pertinent that the letter “P” “is not only the dominant part of the mark but also the source identifying component (i.e. it points to James G. Parker Insurance Associates) and not the ‘claim watch’ portion, which could very well be considered merely descriptive or perhaps even common to the insurance industry.” *Id.*

Applicant concludes that “because Applicant’s mark is sufficiently dissimilar to the Cited Registration, the first *du Pont* factor should be dispositive here and the Board should allow Applicant’s Mark to proceed to publication.” *Id.* at 16.

The Examining Attorney responds that “the wording in the marks is very similar in appearance, sound, commercial impression, and connotation” and “the wording in the marks, CLAIM WATCH and CLAIM WATCHER, is virtually identical in commercial impression. Both marks contain the identical term CLAIM followed by the nearly identical term WATCH (registrant’s mark) or WATCHER (applied-for mark).” 8 TTABVUE 4. According to the Examining Attorney, the words “WATCH and WATCHES are merely different tenses of the same verb, and both communicate the same impression of being observed or monitored,” and the addition of the suffix ‘ER’ to the term WATCH in registrant’s mark fails to obviate the similarity in the terms,” *id.*, because “adding the -ER in applicant’s mark does not alter the overall commercial impression, which is one of observing insurance claims.” *Id.* at 5.



In response to Applicant's arguments regarding the significance of the letter "P" in the cited mark, the Examining Attorney argues that "the term 'Parker' or registrant's entity name is not at issue" because the "marks are compared as they appear in the drawing of the application and in the registration; the USPTO does not consider how an applicant and registrant actually use their marks in the marketplace." *Id.* The Examining Attorney further argues that "applicant's mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark," *id.* at 6, and that "the P has been integrated into the shield design, so it is reasonable for consumers to focus more on the wording CLAIM WATCH which is independent of the design element." *Id.* at 7. The Examining Attorney concludes that "applicant's mark is identical as to registrant's as to the term CLAIM and essentially identical as to the term WATCH and WATCHER, and the P and shield design is not sufficient to distinguish the marks. As a result, the marks are confusingly similar." *Id.* at 7-8.

While the marks must be considered in their entireties, "in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties." *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*30-31 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ

749, 751 (Fed. Cir. 1985)). As discussed above, Applicant argues that “the dominant portion of the Cited Registration is the stylized ‘P,’ sitting in the middle of a shield design; the phrase ‘Claim Watch’ is but a secondary element in the Cited Registration and could not be viewed as being the dominant element,” 6 TTABVUE 11, while the Examining Attorney argues that “it is reasonable for consumers to focus more on the wording CLAIM WATCH which is independent of the design element.” 8 TTABVUE 7. We thus will begin by determining the dominant element of the cited mark, which we reproduce again below for ease of reference in following our discussion:



We must make our determination based on the drawing of the mark in the cited registration shown immediately above rather than on any extrinsic evidence of the mark’s use. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1185-86 (TTAB 2018).

In marks such as the cited mark, which “consist[ ] of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods [or services].” *Sabhnani*, 2021 USPQ2d 1241, at \*31 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d

1579, 218 USPQ 198, 200 (Fed. Cir. 1983)).<sup>13</sup> “The verbal portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Viterra*, 101 USPQ2d at 1911). *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015) (“We have also explained that when a mark consists of both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.’”) (quotation omitted).

This general principle applies to the cited mark. The words CLAIM WATCH appear in capital letters apart from the shield design that serves as a carrier for the highly stylized letter “P.” Although the design containing the stylized letter “P” may be verbalized and recalled as part of consumers’ “general rather than . . . specific impression” of the cited mark,<sup>14</sup> *Embiid*, 2021 USPQ2d 577, at \*11, as between that highly stylized single letter and the block letter words CLAIM WATCH, we find that “the words are more ‘likely to make a greater impression upon purchasers, to be

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<sup>13</sup> Applicant quotes Section 1207.01(c)(ii) of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) for the proposition that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue” (citing *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990)). 6 TTABVue 11. The involved marks in *Electrolyte Labs.* did not contain words, however, and the Federal Circuit’s discussion of the relative significance of letters and designs in that case is not inconsistent with the court’s subsequent analysis regarding the general dominance of words over designs in cases such as *Viterra*.

<sup>14</sup> The letter “P” could be viewed in the nature of an abbreviated house mark, with CLAIM WATCH as the primary brand for the services identified in the cited registration.

remembered by them, and to be used by them to request the goods.” *Sabhnani*, 2021 USPQ2d 1241, at \*32 (quoting *Aquitaine Wine USA*, 126 USPQ2d at 1184).

Applicant’s arguments that the highly stylized letter “P” dominates the cited mark “because it represents ‘Parker,’ the last name associated with the Cited Registration’s owner, ‘James G. Parker Insurance Associates,” 6 TTABVUE 13, as shown on a printout from the registrant’s website, is unavailing because “we do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application.” *Aquitaine Wine USA*, 126 USPQ2d at 1186. We “must compare the marks as they appear in the drawings” and not in connection with other materials, such as the registrant’s website, that may have additional wording or information. *Id.*

Applicant also cites several cases in which the Board found that the design elements of composite word-and-design marks were the dominant elements of the marks. 6 TTABVUE 11-12 (citing *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014); *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009)). It is axiomatic that we must determine the dominant portion of the cited mark based on the mark itself, but the marks in the cited cases, which we display below, are qualitatively different from the cited mark:



*(Covalinski).*



*(Ferro).*



**BODYMAN**

*(Parfums de Coeur)*



*(Steve's Ice Cream)*



*(White Rock Distilleries)*

Unlike in *Covalinski*, where the design element made the “letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice,” *Covalinski*, 113 USPQ2d at 1368, the words CLAIM WATCH in the cited mark are distinct from the design and very easy to see, and the shield element in the cited mark is less unusual and eye-catching vis-à-vis the words than were the designs in *Ferro*, *Parfums de Coeur*, *Steve’s Ice Cream*, and *White Rock Distilleries*.

We find that the words CLAIM WATCH are the dominant portion of the cited mark and we turn now to the required comparison of the marks in their entirety, giving greater weight in that comparison to the words CLAIM WATCH than to the design element and the stylized letter “P” in the cited mark. *Sabhnani*, 2021 USPQ2d 1241, at \*30-31.

At the outset, we note that Applicant urges a side-by-side comparison of the marks three times in its brief. 6 TTABVUE 9 (“this comparison of the marks side-by-side can be dispositive of whether confusion is likely and the Board is not required to consider each and every so-called *DuPont* factor); *id.* at 10 (“when the marks are compared side-by-side, it should be readily apparent that a consumer is likely to distinguish Applicant’s mark from the Cited Registration” in appearance); *id.* at 11

("[a] true side-by-side comparison of Applicant's Mark with the Cited Registration would yield the conclusion that the dominant element in the Cited Registration is the letter 'P' . . ."). This is not the correct manner in which to assess the similarity or dissimilarity of the marks in their entireties. "[M]arks 'must be considered . . . in light of the fallibility of memory' and 'not on the basis of side-by-side comparison.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). As discussed above, we must assess similarity or dissimilarity from the standpoint of a consumer with a general rather than specific impression of the appearance, sound, and meaning of one mark who separately sees or hears the other mark. *Sabhnani*, 2021 USPQ2d 1241, at \*39.

With respect to appearance, Applicant's standard-character CLAIM WATCHER mark "may be used in 'any particular font style, size, or color'" including "the same font, size and color as the literal portions of [the cited] mark." *Aquitaine Wine USA*, 126 USPQ2d at 1186 (quoting Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a)). We thus must assume that CLAIM WATCHER could be displayed in exactly the same font size and style as the words CLAIM WATCH in the cited mark. Given the near identity in appearance of the words CLAIM WATCHER to the dominant words CLAIM WATCH in the cited mark, whether in plain block letters or in the font style in the cited mark, the marks are more similar than dissimilar in appearance from the standpoint of a consumer with a general recollection of one mark who separately sees the other.

With respect to sound, Applicant's mark will be verbalized as "Claim Watcher." As the Federal Circuit held in the *Electrolyte Labs.* case cited by Applicant, 6 TTABVUE 11, a "design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark," *Electrolyte Labs.*, 16 USPQ2d at 1240, and it is thus more likely that the cited mark will be verbalized as "Claim Watch" than as "P" alone or as "P Claim Watch." "Claim Watch" (and "P Claim Watch") are very similar in sound to "Claim Watcher" because consumers are not likely to process minutia such as the number of syllables in the phrases "Claim Watch" and "Claim Watcher" in forming general impressions of the involved marks. *See In re John Scarne Games, Inc.*, 120 USPQ2d 315, 316 (TTAB 1959) ("Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.").

Finally, with respect to meaning, Applicant's mark CLAIM WATCHER and the dominant portion of the cited mark, CLAIM WATCH, both connote the close observation of a claim because the word "watch" means "to keep someone or something under close observation," and the word "watcher" means "a person who closely follows or observes someone or something."<sup>15</sup> Applicant's argument that "claim watch" evokes something passive, perhaps something akin to a clock or tracker that monitors claims in the background," while "claim watcher" evokes something more proactive and dynamic, perhaps even a person who is actively evaluating

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<sup>15</sup> July 21, 2022 Denial of Request for Reconsideration at TSDR 4, 10 (MERRIAM-WEBSTER DICTIONARY).



claims,” 6 TTABVUE 14, assumes a level of subtlety of consumer perception that is inconsistent with our working understanding, in the absence of evidence to the contrary, that the average consumer of the involved services “retains a general rather than specific impression of marks.” *Embiid*, 2021 USPQ2d 577, at \*11 (quoting *i.am.symbolic*, 127 USPQ2d at 1630).<sup>16</sup> The involved marks are far more similar than dissimilar in meaning.

We find that the marks are similar in appearance, sound, connotation, and commercial impression when considered in their entireties, and the first *DuPont* factor supports a conclusion that confusion is likely.

### **B. Similarity or Dissimilarity of the Services**

“The second *DuPont* factor ‘considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration . . . .’” *Embiid*, 2021 USPQ2d 577, at \*22 (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1051-52 (quoting *DuPont*, 177 USPQ at 567)). The “services need not be identical or even competitive to find a likelihood of confusion.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*4 (TTAB 2019) (citations omitted). “They need only be ‘related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [they] emanate from the same source.’” *Id.*

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<sup>16</sup> To the extent that the stylized letter “P” in the design in the cited mark is recalled as an initial in the mind’s eye of a consumer with a general recollection of the cited mark, it could be understood as abbreviating the name of the source of the services offered under the mark. When that consumer separately encounters Applicant’s CLAIM WATCHER mark, which connotes the same thing as the dominant portion of the cited mark, Applicant’s mark could readily be understood as simply omitting the letter abbreviation while maintaining the substance of the branding.

(quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir 2012) (internal quotation omitted)).

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods [or services] are used together or used by the same purchasers; advertisements showing that the relevant goods [or services] are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods [or services] and the goods [or services] listed in the cited registration.” *Embiid*, 2021 USPQ2d 577, at \*22-23. In addition, “[t]he application and registration themselves may provide evidence of the relationship between the services.” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at \*14 (TTAB 2023) (citations omitted).

“Because each class in Applicant’s multi-class application is, in effect, a separate application, we consider each class separately, and determine whether [the Examining Attorney] has shown a likelihood of confusion with respect to each.” *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1228 (TTAB 2015).

We “begin with the identifications of . . . services in the registration and application under consideration.” *Country Oven*, 2019 USPQ2d 443903, at \*5. The services identified in the application are “Health benefit plan services, namely, insurance administration services, namely, assisting others with adjusting insurance claims in the nature of repricing health insurance claims” in Class 36 and “Legal services, namely, legal consulting and defense relating to health insurance claims” in

Class 45. The services identified in the cited registration are “Tracking and monitoring the status of insurance claims for business purposes” in Class 35.

It is not clear on the face of the identification of the Class 36 services in the application exactly what services are encompassed within “repricing health insurance claims” and who the “others” are who receive assistance in adjusting those claims through repricing. “When identifications are technical or vague and require clarification, it is appropriate to consider extrinsic evidence of use to determine the meaning of the identification of goods [or services].” *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1354 (TTAB 2015) (citing *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990)). We will thus review Applicant’s original specimen of use, consisting of marketing materials bearing the CLAIM WATCHER mark,<sup>17</sup> to determine the meaning of the identified Class 36 services.

Applicant’s specimen indicates that the recipients of the identified services are “self-funded employers” for whom Applicant says that its CLAIM WATCHER services can “significantly improve the medical claim costs . . . .”<sup>18</sup> A “self-funded employer” appears to be one that offers a “self-insured plan,” which is a type of health plan “where the employer itself collects premiums from enrollees and takes on the responsibility of paying employees’ and dependents’ medical claims. These employers can contract for insurance services such as enrollment, claims processing, and

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<sup>17</sup> October 19, 2020 Application at TSDR 1.

<sup>18</sup> *Id.* at TSDR 3.

provider networks with a third party administrator, or they can be self-administered.”<sup>19</sup> Applicant’s specimen indicates that it is a “third party administrator” providing “insurance administration services, namely, assisting others with adjusting insurance claims in the nature of repricing health insurance claims” within the meaning of the Class 36 recitation in the application.

Applicant’s specimen states that under its CLAIM WATCHER mark, it “works with self-funded employers to control health care costs through a unique claims review and audit process that maximizes savings in a transparent, defensible and consistent way,”<sup>20</sup> and that Applicant acts as the employer’s agent in negotiating with providers to lower costs.<sup>21</sup> The “repricing” of “health insurance claims” described in the Class 36 identification of services appears to be a part of that negotiation process.

We need not concern ourselves with the particulars of Applicant’s own form of “repricing,” called “Referenced-Based Pricing,”<sup>22</sup> because we must consider the “full scope” of the services identified in the application as so construed. *Country Oven*, 2019 USPQ2d 443903, at \*9. We thus must construe the Class 36 services identified as “Health benefit plan services, namely, insurance administration services, namely,

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<sup>19</sup> Healthcare.gov, last accessed on May 10, 2023. The Board may take judicial notice of definitions on government websites. *In re Int’l Fruit Genetics, LLC*, 2022 USPQ2d 1119, at \*3-4 (TTAB 2022); *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015).

<sup>20</sup> October 19, 2020 Application at TSDR 3. The specimen notes that in connection with these services, Applicant offers “[a] vigorous defense of the Plan and/or Member in the event of a balance bill or collection action including legal defense.” *Id.* A “balance bill” is defined as the “difference between the provider billed charges, the plan allowance, and member responsibility.” *Id.* at TSDR 10. Applicant provides a legal defense to the employee under the employer’s plan. *Id.* at TSDR 24.

<sup>21</sup> *Id.* at TSDR 24.

<sup>22</sup> *Id.* at TSDR 3.

assisting others with adjusting insurance claims in the nature of repricing health insurance claims” to include any form of negotiation by a third-party insurance administrator (on behalf of a health benefit plan) with a health care provider to adjust the provider’s health insurance claim to the plan.

We similarly must consider the full scope of Applicant’s Class 45 “legal services, namely, legal consulting and defense relating to health insurance claims.”<sup>23</sup> The language “legal consulting and defense relating to health insurance claims” limits the full scope of the services to legal services relating to the defense of “health insurance claims,” including the sort of consulting and defense provided by Applicant in the context of claims asserted by a health care provider against a health care plan or its members. The identification cannot reasonably be construed to cover the prosecution of “health insurance claims” against a health insurer by an insured because the recitation specifically relates to consulting and defense, not prosecution.

Turning now to the services identified in the cited registration, “tracking and monitoring the status of insurance claims for business purposes,” we must construe those services as broadly as reasonably possible “to include all [services] of the nature and type described therein,” *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (quoting *In re Jump Design LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)), and we must resolve any ambiguities regarding their coverage in favor of the

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<sup>23</sup> These legal services must necessarily be provided by attorneys who are “legally qualified and licensed to represent a person in a legal matter, such as a transaction or lawsuit,” *In re Sausser Summers, PC*, 2021 USPQ2d 618, at \*8 (TTAB 2021), either in a law firm or on a company’s in-house counsel staff.

registrant “given the presumptions afforded the registration under Section 7(b)” of the Trademark Act. *C.H. Hanson*, 116 USPQ2d at 1355 (citing 15 U.S.C. § 1057(b)). Applicant argues that “the ‘monitoring and tracking’ services offered in connection with the Cited Registration appear to be limited to **property and casualty claims** -- and are therefore distinguishable from Applicant’s **health** insurance related services,” relying on the website of the owner of the cited registration, 6 TTABVUE 16-17 (emphasis in boldface in italics in original).

Because there is no restriction on the nature of the “insurance claims” that are the subject of the registrant’s tracking and monitoring services, we must construe the recitation as including the tracking and monitoring of the status of health insurance claims. Nonetheless, there is a distinct difference between tracking and monitoring the status of a claim and assisting others in the repricing of health insurance claims. Moreover, the limiting language “for business purposes” further narrows the registrant’s services to encompass only those “insurance claims” submitted “for business purposes” and the registrant’s “tracking and monitoring” of the “status” of such claims.

As discussed above, we must consider each class in the application separately and determine whether the Examining Attorney has shown that the services identified in that class are related to the services identified in the cited registration. Applicant and the Examining Attorney do not aid us in that effort because they do not discuss the classes separately, but instead lump them together. 6 TTABVUE 16-18; 8 TTABVUE 8-11.

Applicant argues that

the Examining Attorney appears to have missed the point somewhat, assuming that anything that touches the insurance industry is similar for the purpose of a likelihood of confusion analysis. Even if arguably, [the] Cited Registration's owner could be viewed as offering health insurance services (which it does not), there is still no evidence to show that those services would include the specific type of health insurance service that Applicant offers, which is the repricing of health insurance (as opposed to offering general health insurance services which the Examining Attorney's third party evidence appears to be limited to). Nor is there sufficient evidence even amongst the myriad third party pages the Examining Attorney is on [sic] relying on that the Cited Registrant's owner is representative of an insurance provider that would typically also offer legal services relating to health insurance claims, as recited in International Class 45 of the Application. After all, the insurance field is fairly broad and not all types of insurance services could be deemed as emanating from the same source.

6 TTABVUE 17.

The Examining Attorney responds that

it is clear from the evidence of record that the services are related because the same entity commonly provides the relevant insurance claim related services offered by both applicant and registrant and markets the services under the same mark, the relevant services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and the applied-for legal services are similar or complementary in terms of purpose or function . . . .

8 TTABVUE 8. The Examining Attorney cites seven third-party websites in support of this position. We begin with a review of the four websites on which the Examining Attorney primarily relies, *id.* at 9-10, and then turn to the other websites to which the Examining Attorney refers.

The website of Sanus Health Corporation, an insurance service provider, offers, among other services, “repricing” for “employer ‘self-funded’ plans both private and government,”<sup>24</sup> which are similar to Applicant’s Class 36 services, and “Legal Counsel,” which appear to encompass the Class 45 “legal consulting and defense relating to health insurance claims” identified in the application.<sup>25</sup> The Examining Attorney claims that on the Sanus website, a “bullet point listing of insurance consulting services provided, which includes ‘Pricing’ and “Claim Reserve Analysis and Certification,” “would involve both monitoring and tracking of insurance claims.” 8 TTABVUE 9.<sup>26</sup> The “repricing” services offered by Sanus have not been shown to have anything to do with tracking or monitoring the “status” of insurance claims. The Sanus website does not show that the services identified in either class in the application are related to the services identified in the cited registration.

The website of Flatworld Solutions offers a variety of services, including “PPO Health Insurance Claims Repricing Services” for medical insurance companies and healthcare providers,<sup>27</sup> which are similar to Applicant’s Class 36 services, and “Litigation Support Services.”<sup>28</sup> With respect to the latter services, the website states that the company has an “expert team of lawyers, document specialists, subject

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<sup>24</sup> July 21, 2022 Denial of Request for Reconsideration at TSDR 20.

<sup>25</sup> *Id.* at TSDR 36. The website states that “[a]ccess to legal counsel is a critical need for services offering or providing medical treatment and/or referrals. Having this resource is an indispensable advantage which third-party health administrators are able to provide. The presence of legal counsel protects owners, employees, and clients equally.” *Id.*

<sup>26</sup> *Id.* at TSDR 25-26.

<sup>27</sup> *Id.* at TSDR 28-29.

<sup>28</sup> *Id.* at TSDR 38-41.



matter experts, and coders [who] can help you with your routine litigation services or with paralegal services,” and that “[o]ur lawyers are experienced in providing expert litigation service support to lawyers, in-house counsel, and law firms.”<sup>29</sup> It is not clear that the “litigation support services” provided by Flatworld Solutions include the Class 45 “legal services, namely, legal consulting and defense relating to health insurance claims” identified in the application.

The Examining Attorney argues that Flatworld Solutions also provides “monitoring” services and that “[m]onitoring and tracking of insurance claims is further shown as part of Flatworld Solutions’ data analysis services,” quoting language on the website that

[t]his is the final stage wherein we check for various details, such as the number of claims, paid amounts for each claim, policies issues, and the number of people insured, among others. These details are compared against a range of parameters like claims per band, age bands, amount insured, etc. This helps in ensuring the accuracy of the claims repricing.

8 TTABVUE 10.<sup>30</sup>

Like the services on the Sanus website, none of the referenced services on the Flatworld Solutions website is encompassed within the “tracking and monitoring the status of insurance claims for business purposes” services identified in the cited registration because they have nothing to do with the “status” of insurance claims submitted for business purposes. The Flatworld Solutions website similarly does not

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<sup>29</sup> *Id.*

<sup>30</sup> *Id.* at TSDR 29.

show that the services identified in either class in the application are related to the services identified in the cited registration.

The other two primary websites do not offer “Health benefit plan services, namely, insurance administration services, namely, assisting others with adjusting insurance claims in the nature of repricing health insurance claims,” any form of legal services, or the “tracking and monitoring the status of insurance claims for business purposes.” The website of Healthcare Care Compliance Advisors, LLC lists “Attorney Support Services” under the rubric of “Support Services,”<sup>31</sup> but states that “[t]he regulatory environment is complex and involves many disciplines including legal and health care consulting,” that “[a]pproximately half of our projects involve health care providers retained by legal counsel,” and that “[w]e are engaged directly by the attorney to provide an outside opinion regarding the costing, billing, and documentation of medical services.”<sup>32</sup> The website also states that “[w]e continue to partner with many leading regulatory health care attorneys” and that “[i]f you believe you need a health care attorney we will be happy to give you recommendations upon request.”<sup>33</sup> It does not appear that the referenced “outside opinion” is a legal opinion or that Healthcare Care Compliance Advisors provides legal services, much less “legal consulting and defense relating to health insurance claims.”

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<sup>31</sup> March 31, 2021 Office Action at TSDR 12.

<sup>32</sup> *Id.* at TSDR 12.

<sup>33</sup> *Id.* at TSDR 13.

The Examining Attorney argues that Health Care Compliance Advisors “provides claim monitoring services,” 8 TTABVUE 9, quoting language on the website that “[t]he key to success includes ‘doing it right the first time’ but also active monitoring the shifting regulatory and medical billing environment an[d] ensuring that ‘claims are submitted as correctly as possible,’” *id.*,<sup>34</sup> but the “monitoring” referenced by the Examining Attorney is the monitoring of the “shifting regulatory and medical billing environment,” and has nothing to do with the “tracking and monitoring the status of insurance claims for business purposes” services identified in the cited registration.

The website of the van Halem Group states that a “collaborative legal/consultative approach may provide the greatest benefit when navigating this process,” that “retaining any attorney can help protect your agency, provide a degree of protection for your communications, conduct an internal investigation and provide essential guidance for dealing with CMS, its contractors, and regulators,” and that “attorney-consultant teams provide the best overall value, having the expertise, staff, tools, and resources available to navigate this process.”<sup>35</sup> The website lists various “Advantages to hiring an ATTORNEY,”<sup>36</sup> and discusses various considerations in doing so,<sup>37</sup> but the van Halem Group appears to be the “consultant,” not the “attorney,” member of the referenced “attorney-consultant teams.”

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<sup>34</sup> *Id.* at TSDR 12.

<sup>35</sup> *Id.* at TSDR 22. “CMS” is an abbreviation for the Centers for Medicare & Medicaid Services. May 11, 2022 Specimen at TSDR 3.

<sup>36</sup> March 31, 2021 Office Action at TSDR 23.

<sup>37</sup> *Id.* at TSDR 24.

The Examining Attorney argues that on the van Halem Group website “[t]hese services necessarily involve tracking the status of insurance claims: ‘The van Halem Group provides audit and compliance support solutions to help you navigate the complex regulatory issues related to submitting claims, responding to audits, and filing appeals.’” 8 TTABVUE 9-10.<sup>38</sup> None of these services is encompassed within the “tracking and monitoring the status of insurance claims for business purposes” services identified in the cited registration because they have nothing to do with the “status” of insurance claims submitted for business purposes.

As noted above, the Examining Attorney also cites three websites of Vee Technologies, H.H.C. Group, and Frontier Advisors, claiming that they “show, generally, that many types of insurance claim services, involving tracking, monitoring, repricing, and legal activities, are offered under the same mark.” *Id.* at 10. The relevant issue, of course, is not the relatedness of “many types of insurance claim services, involving tracking, monitoring, repricing, and legal activities,” but rather whether the specific repricing and legal services identified in the application are related to the specific claim status tracking and monitoring services identified in the cited registration. The three websites do not show such relatedness.

Like Applicant itself, Vee Technologies provides repricing services and legal services, but not the “tracking and monitoring the status of insurance claims for business purposes” services identified in the cited registration.<sup>39</sup> H.H.C. Group also

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<sup>38</sup> *Id.* at TSDR 21.

<sup>39</sup> July 21, 2022 Denial of Request for Reconsideration at TSDR 43-46.

provides repricing services and makes available “attorney negotiators,” but does not provide the “tracking and monitoring the status of insurance claims for business purposes” services identified in the cited registration.<sup>40</sup> The pages from the website of Frontier Adjusters made of record by the Examining Attorney pertain to the adjustment of property and casualty insurance claims, not health insurance claims.<sup>41</sup>

The Examining Attorney does not discuss two other websites of Strategic Management Services and Harmony Healthcare that are in the record.<sup>42</sup> These websites pertain to health care auditing and monitoring to assist health care organizations in staying abreast of, and in compliance with, applicable rules and regulations. Strategic Management Services offers “Health Care Litigation Support” for “law firms and health care organization on complex compliance issues,”<sup>43</sup> but does not offer the repricing or specific legal services identified in the application, or the claim status tracking and monitoring services identified in the cited registration.

The fact that the involved services all pertain to the complicated, multi-faceted world of insurance in some way is not enough to show that they would be perceived as originating from the same source when offered under similar marks. The record is devoid of any evidence that the services identified in the application as “Health benefit plan services, namely, insurance administration services, namely, assisting others with adjusting insurance claims in the nature of repricing health insurance

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<sup>40</sup> November 12, 2021 Final Office Action at TSDR 12-20.

<sup>41</sup> *Id.* at TSDR 2-11.

<sup>42</sup> March 31, 2021 Office Action at TSDR 5-11, 14-17

<sup>43</sup> *Id.* at TSDR 16.

claims” in Class 36 and “legal services, namely, legal consulting and defense relating to health insurance claims” in Class 45 are provided by the same entities that also provide the services of “tracking and monitoring the status of insurance claims for business purposes” identified in the cited registration. The second *DuPont* factor does not support a conclusion that confusion is likely with respect to Applicant’s Class 36 or Class 45 services.

### C. Weighing the Two Key *DuPont* Factors

We have found above that the marks are similar, but that the services are not related. These findings point us in opposite directions in the likelihood of confusion analysis, so we must “weigh the *DuPont* factors used in [our] analysis **and** explain the results of that weighing.” *Charger Ventures*, 2023 USPQ2d 451, at \*7 (emphasis in boldface originally in italics).

“In any given case, different *DuPont* factors may play a dominant role,” *id.*, at \*4, and the “weight given to each factor depends on the circumstances of each case.” *Id.* (citation omitted). A “single *DuPont* factor may, for example, be dispositive of the likelihood of confusion analysis.” *Id.* On this record, there is simply no evidence that the similar CLAIM WATCHER and CLAIM WATCH and design marks would be exposed to the same consumers when used respectively in connection with the “Health benefit plan services, namely, insurance administration services, namely, assisting others with adjusting insurance claims in the nature of repricing health insurance claims” or “Legal services, namely, legal consulting and defense relating to health insurance claims” identified in the application, and the “tracking and

monitoring the status of insurance claims for business purposes” identified in the cited registration, or that consumers have become accustomed to seeing the same marks used in connection with those sets of services. Our finding under the second *DuPont* factor that the services are dissimilar outweighs our finding under the first *DuPont* factor that the marks are similar, because while there are several points of similarity between the marks, there is little to no relationship between the services, leading us to conclude that confusion is not likely. *Cf. Morgan Creek Prods., Inc., Foria Int’l, Inc.*, 91 USPQ2d 1134, 1143 (TTAB 2013) (dissimilarity of the parties’ goods was “the dispositive factor in this case.”).

**Decision:** The refusal to register is reversed.