

This Opinion is not a  
Precedent of the TTAB

Mailed: November 6, 2019

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*The Lincoln National Life Insurance Company*  
*v.*  
*Kansas City Life Insurance Company*

Opposition No. 91236982

John D. Simmons, Bridget H. Labutta, and Keith A. Jones, of Panitch Schwarze  
Belisario & Nadel LLP,  
for The Lincoln National Life Insurance Company.

Clinton G. Newton and Reid L. Williams of Shook Hardy & Bacon LLP,  
for Kansas City Life Insurance Company.

Before Wellington, Ritchie, and Heasley,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On January 26, 2017, Kansas City Life Insurance Company (“Applicant”) applied to register ACCELETERM on the Principal Register in standard character form for “insurance services, namely, underwriting, issuance, and administration of life insurance policies,” in International Class 36.<sup>1</sup>

<sup>1</sup> Application Serial No. 87315051 was filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intent to use the mark in commerce.

On October 2, 2017, The Lincoln National Life Insurance Company (“Opposer”) filed an opposition, alleging priority and likelihood of confusion with its prior registered mark LINCOLN TERMACCEL, also in standard character form, for “insurance services, namely, underwriting, issuance and administration of life insurance,” in International Class 36.<sup>2</sup>

Applicant denied the salient allegations of the Notice of Opposition, except that Applicant admitted that “the services listed in its application are identical to the services listed in Opposer’s registration.”<sup>3</sup> As discussed below, the parties agreed to conduct this proceeding via Accelerated Case Resolution (“ACR”) based on summary judgment briefs and attached evidence.

### **I. The Record and ACR Stipulation**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. As noted, the parties agreed to conduct this proceeding via the streamlined process of ACR. The parties submitted to the Board on August 2, 2019 a Joint Stipulation to Proceed via Accelerated Case Resolution, which stipulates, *inter alia*, that 1) “summary judgment motions, and all accompanying declarations and evidence, be treated as the final record and briefs in the case;” 2) the “summary judgment evidence be treated as properly of record for purposes of final decision;” and 3) the parties “consent to the Board’s resolution of any and all disputed issues of material fact.”<sup>4</sup>

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<sup>2</sup> Registration No. 4783326 issued on July 28, 2015.

<sup>3</sup> 5 TTABVUE 3 (paragraph 12).

<sup>4</sup> 28 TTABVUE 2-3.

The stipulation was approved by the Board on August 8, 2019.<sup>5</sup> Opposer included with its brief the declarations of Nancy Smith, Vice President, Legal & Assistant Corporate Secretary of Lincoln Financial Company, a “holding company which operates multiple insurance businesses, including the Opposer,”<sup>6</sup> as well as the declaration of Keith Jones, attorney for Opposer, and exhibits thereto. Applicant included with its brief the declaration of Donald Krebs, Senior Vice President of Sales and Marketing for Applicant, as well as the declaration of Clinton G. Newton, attorney for Applicant, and exhibits thereto.<sup>7</sup>

## **II. Standing and Priority**

To have standing, a plaintiff must have a real interest, *i.e.*, a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999). Opposer submitted a copy of its pleaded registration into the record as Exhibit E to the declaration of Nancy Smith. Although Exhibit E is not a status and title copy of the pleaded registration, Ms. Smith testified that Opposer “owns the federal trademark registration,” and that Opposer has used the mark LINCOLN TERMACCEL for “insurance services, namely, underwriting, issuance

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<sup>5</sup> 29 TTABVUE.

<sup>6</sup> 16 TTABVUE 24.

<sup>7</sup> 22 TTABVUE 23 *et. seq.* In the June 28, 2019 order denying summary judgment, the Board cautioned that several exhibits were improperly designated as “confidential.” The order further cautioned that “[i]n the future, the Board may disregard the ‘confidential’ designation for those matters which are improperly designated.” 24 TTABVUE 5, n.5 (cites omitted). As noted, we treat only properly designated information as confidential.

and administration of life insurance” since “at least as early as May 11, 2015” as further “set forth in U.S. Registration No. 4783326,”<sup>8</sup> which issued as a registration on July 28, 2015. Applicant filed its intent to use application on January 26, 2017, and Applicant has not filed a Statement of Use. We find that Opposer has established its standing and priority in this proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King’s Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

### III. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and 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.”). We discuss the *du Pont* factors for which there is relevant argument and evidence.

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<sup>8</sup> 16 TTABVUE 25 (Paras. 10-13).

A. Services and Channels of Trade

As noted above, Applicant admitted in its answer that “the services listed in its application are identical to the services listed in Opposer’s registration.”<sup>9</sup> We agree that the services, as identified, are identical. To the extent Applicant argues that the parties are not competitors, and that the services will travel in different channels of trade to different classes of consumers, we are bound by the unrestricted identifications. *See Octocom Sys., Inc. v. Hous. Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.” (citations omitted)).

Where, as here, the services are identical, they are presumed to travel in the same channels of trade to the same class of consumers. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Thus, without regard to Applicant’s arguments and evidence of marketplace use, we must presume that the trade channels are the same.

The second and third *du Pont* factors weigh heavily in favor of finding a likelihood of confusion.

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<sup>9</sup> 5 TTABVUE 3 (paragraph 12).

B. The Strength of Opposer's Mark

Although neither Opposer nor Applicant makes a specific argument as to the strength of Opposer's LINCOLN TERMACCEL mark, both parties discuss generally the conceptual and commercial strength of the mark. The parties agree that the term LINCOLN, a house mark used by Opposer, is arbitrary, although they disagree as to the effect of this element on Opposer's mark as a whole.<sup>10</sup>

In the confidential record, Opposer provided evidence of its revenue and advertising expenses for the LINCOLN TERMACCEL mark between 2015 and 2017. There is no evidence that third parties use a combination of "TERM" and "ACCEL," the shared elements of the parties' respective marks, as a mark for life insurance services. Overall, there is insufficient evidence for us to make a finding of commercial strength, and we find it to be neutral.

As for conceptual strength, both parties agree that "TERM" may be understood by consumers as referring to "term life insurance."<sup>11</sup> The parties disagree as to whether consumers would have an understanding of "ACCEL" with regard to life insurance. There is, however, ample evidence in the record of life insurance policies referring to provisions that may "Accelerate" their "Term," such as "Accelerated Death Benefit for Chronic Condition;" "Accelerated Death Benefit for Critical Illness;" and "Accelerated Death Benefit for Terminal Illness."<sup>12</sup> In this regard, we find that Opposer's LINCOLN TERMACCEL is suggestive of life insurance policies that may

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<sup>10</sup> 16 TTABVUE 26; 22 TTABVUE 11, 100.

<sup>11</sup> 16 TTABVUE 25; 22 TTABVUE 24.

<sup>12</sup> 22 TTABVUE 33.

include term acceleration provisions. Opposer's mark is nevertheless inherently distinctive, and entitled to a normal scope of protection under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

C. Comparison of the Marks

We thus consider the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567; *Palm Bay Imps.*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to 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. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). Where, as here, the identified services are identical, the degree of similarity between the marks necessary to support a determination of likelihood of confusion declines. *See Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

Opposer's mark is LINCOLN TERMACCEL. Applicant's mark is ACCELETERM. Opposer argues that Applicant's mark merely transposes the elements "TERM" and "ACCEL," and omits the house mark, LINCOLN. Applicant argues in response that the terms are not merely transposed, and that LINCOLN is the dominant portion of

Opposer's mark.

As noted above, we find the elements "TERM" and "ACCEL" to be suggestive of life insurance policies that may include an acceleration provision on the term of the policy. The order of the elements does not affect our finding. *See In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with "RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil); *Bank of America National Trust and Savings Ass'n v. The American National Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978) (holding BANKAMERICA and BANK OF AMERICA, on the one hand, and AMERIBANC, on the other, convey the same meaning and create substantially similar commercial impressions). In this regard, Applicant's ACCELETERM gives a very similar commercial impression to Opposer's LINCOLN TERMACCEL, as applied to identical life insurance services.

Although Opposer's mark contains a house mark, LINCOLN, our precedent dictates that the addition of a house mark does not necessarily avoid likelihood of confusion. "[S]uch addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion." *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (citations omitted) (finding LE CACHET DE DIOR confusingly similar to CACHET). *See also In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (stating that addition of a trade name will make consumers think that products have a common origin or that the companies have merged); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1201-02 (TTAB 2007) (applying principle that "the addition

of a trade name or house mark or other such matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion.”). We find, rather, that consumers are likely to perceive Applicant’s mark as a variant on Opposer’s LINCOLN TERMACCEL.

Overall, we find the similarities in connotation and commercial impression to outweigh differences in sight and sound. The first *du Pont* factor also favors finding a likelihood of confusion.

#### D. Conditions of Sale

Applicant asks us to consider the conditions of sale for the identified life insurance services. Applicant points out that life insurance policies present a fairly substantial investment for purchasers. It is axiomatic that we must make our determination based on the least sophisticated consumer, which in this case may include members of the general public who have expertise in neither the insurance nor the legal fields. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163 (affirming that TTAB properly considered all potential investors for recited services, including not only sophisticated investors, but also “the least sophisticated potential purchasers”). Nevertheless, the record does indicate that life insurance policies would typically cost a consumer thousands of dollars over a twenty or thirty year term.<sup>13</sup> Consumers are thus likely to exercise a somewhat heightened level of care, and we find the fourth *du Pont* factor to weigh somewhat against a finding of likelihood of confusion.

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<sup>13</sup> *See* for example, Opposer’s submitted advertised materials for LINCOLN TERMACCEL at 16 TTABVUE 40-41.

E. Balancing the Factors

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that the services and channels of trade are identical. While the shared elements of the parties' marks are suggestive of these services, Opposer's pleaded mark is nevertheless inherently distinctive, and the marks, considered as a whole, are similar, especially in connotation and commercial impression. While consumers of the identified life insurance services may be expected to exercise a somewhat heightened degree of care in their purchasing decisions, this is outweighed by the use of similar marks on identical services.

We find a likelihood of confusion between Opposer's LINCOLN TERMACCEL and Applicant's ACCELETERM as identified for identical services.

**Decision:** The opposition is sustained.