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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91238574 |
| Party | Plaintiff<br>Grinnell Mutual Reinsurance Company |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| GRINNELL MUTUAL REINSURANCE COMPANY<br><br>Opposer,<br><br>vs.<br><br>PROTECTIVE INSURANCE COMPANY<br><br>Applicant. | Opposition No. 91238574<br><br>Serial No.: 87440152<br><br>Mark:  <br><br>Published: September 19, 2017 |

**OPPOSER'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

Protective Insurance Company ignores the express terms of its application and Grinnell Mutual's registration as well as the legal presumptions arising from those terms. Instead, Protective Insurance makes allegations regarding real-world conditions, which are irrelevant. *See e.g., In Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) ("It was proper … for the Board to focus on the application and registrations rather than on real-world conditions…"). The *duPont* factors are not in dispute. Therefore, the determination of likelihood of confusion - a legal question– is appropriate for summary judgment. Grinnell Mutual is entitled to entry of judgment of likelihood of confusion and the refusal of the registration sought in Application Serial No. 87440152. *See* Fed. R. Civ. P. 56.

**A. As a Matter of Law, Channels of Trade Are Overlapping.**

1. The Application Is Not Limited With Respect to Channels of Trade.

Contrary to Protective Insurance's assertion, its identification of services contains no limitation as to channels of trade. The phrase "all of the foregoing in the field of trucking and transportation" does not limit the channels through which the applied-for services will be sold. *See e.g., In Re Tapco Intl. Corp.,* 122 U.S.P.Q.2d 1369 at * 6 (TTAB 2017) (precedential)

("Even the 'building construction industry' language in Class 1 does not limit the trade channels through which the goods might be sold., e.g., in a home improvement store where they would be available both to contractors and homeowners").

2. Protective Insurance's Arguments Regarding the Parties' Actual Services Are Irrelevant and Otherwise Contrary to Law.

In its "Channels of Trade" section of its brief, Protective Insurance offers various arguments regarding the parties' actual services. (Opposition pp. 9-10). All of these arguments are irrelevant and otherwise contrary to law.

The fact that Protective Insurance is "not aware" of Grinnell Mutual actually offering insurance services in the trucking and transportation field is of no significance. (Opposition pp. 9-10). "We simply cannot curtail the rights defined by the identification of goods in the registrations to limit the goods, channels of trade or classes of customers thereof to what applicant's evidence may show them to be." *See In Re Hearthmark, LLC*, 2014 WL 1649324 at * 4 (TTAB 2014) (non-precedential). Likelihood of confusion must be based on the identifications of services in Grinnell Mutual's registration and Protective Insurance's application. *See e.g., In Re Cytosport, Inc.,* 2018 WL 2018262 at * 6 (TTAB 2018) (non-precedential). Protective Insurance "may not restrict the scope" of the services "covered in the cited registration by argument or extrinsic evidence." *In re La Peregrina Ltd.,* 86 U.S.P.Q.2d 1645 at * 2 (TTAB 2008) (precedential).

It is also irrelevant that Protective Insurance "does not consider Grinnell Mutual as a potential competitor." (Opposition p. 10). Services need not be competitive for a likelihood of confusion. *See* TMEP § 1207.01(a)(i). Moreover, the parties' services are not only competitive; they are legally identical. Grinnell Mutual has registered its mark for "writing property and casualty insurance" and "reinsurance underwriting." (Grinnell Exhibit A at GRINNELL0001).

The applied-for services include: "writing property and casualty insurance" "in the field of trucking and transportation" and "reinsurance underwriting" "in the field of trucking and transportation." (Grinnell Exhibit B at GRINNELL0036). Because the parties' services are legally identical, channels of trade must be presumed to be overlapping. *See In re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 * 10 (TTAB 2016) (precedential).

The *In re Thor Tech* decision cited by Protective Insurance is easily distinguishable. In that case, the Board held that the parties' goods were not similar, even finding they had "nothing in common with respect to their essential characteristics." 113 U.S.P.Q.2d 1546 at * 5 (TTAB 2015). The same certainly cannot be said of Grinnell Mutual and Protective Insurance's legally identical insurance services.[1]

**B. As a Matter of Law, The Prospective Purchasers Are Identical And Include Ordinary Consumers.**

1. The Application Is Not Limited With Respect to Prospective Purchasers.

There is no merit to Protective Insurance's claim to have "expressly limited classes of consumers" in its identification of services. (Opposition p. 3). The phrase "in the field of trucking and transportation" does not limit the classes of consumers for the applied-for services. *Cf. In Re Myopain Seminars, LLC*, 2017 WL 5197914 at * 7 (TTAB 2017) (non-precedential) ("directed to medical professionals and clinicians" is a limitation as to classes of customers).

2. The Prospective Purchasers Must Be Presumed Identical.

Protective Insurance alleges that it actually "targets" organizational customers in the transportation industry and that it is "not aware" of Grinnell Mutual actually offering services to these same customers. (Protective Insurance Exhibit D ¶¶ 13, 18). These arguments regarding

[1] For the same reason, the *Coach* case cited by Protective Insurance is easily distinguishable. In *Coach*, the court affirmed a finding of no likelihood of confusion when the same mark was used for the unrelated goods of educational materials and fashion accessories. 668 F.3d 1356 (Fed. Cir. 2012).

real-world conditions are contrary to law. *See Octocom Sys., Inc. v. Houston Computer Servs.,* 918 F.2d 937, 942 (Fed. Cir. 1990) ("Because OSI seeks an *unrestricted* registration, such evidence as there is of a specific class of customers did not relate to a *material* fact"); *DC Comics v. Gotham City Networking, Inc.,* 2015 WL 4464694 * 15 (TTAB 2015) (non-precedential) ("we may not resort to extrinsic evidence to restrict the classes of consumers for Applicant's services"). Because Grinnell Mutual's registered services and Protective Insurance's applied-for services are legally identical, the classes of purchasers must be presumed identical. *See e.g., In re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 at * 10.

3. Protective Insurance's Arguments Regarded Customer Sophistication Are Contrary to Law.

Protective Insurance claims that the purchases of its services are "mostly" handled by professionals with specialized training or experience. (Protective Insurance Exhibit D ¶ 16). However, likelihood of confusion analysis must be based on the least sophisticated potential purchasers. *See In Stone Lion*, 746 F.3d at 1325.

Moreover, because Protective Insurance's application contains no limitations regarding prospective purchasers, "we cannot resort to extrinsic evidence to restrict the classes of consumers and, as a result, ascribe to that subset of consumers a higher level of sophistication than we otherwise would." *McDonald's Corp. v. McSweet, LLC*, 112 U.S.P.Q.2d 1268 at * 16 (TTAB 2014) (precedential). *See also In re Funktronic Labs*, 2018 WL 898613 at * 8 (TTAB 2018) (non-precedential) ("[E]vidence or argument relating to the fact that Applicant's services are directed to 'sophisticated gamers' must be disregarded since there is no restriction in the application or registration limiting the services to particular channels of trade or classes of customers").

The potential purchasers of the parties' applied-for and registered insurance services include ordinary consumers who exercise only normal care. *See In Re American Community Mutual Insurance Company*, 2008 WL 4354144 at * 5-6 (TTAB 2008) (non-precedential) (prospective purchasers included ordinary consumers looking for insurance coverage).

**C. As a Matter of Law, The Applied-for Mark and Registered Mark Are Very Similar.**

1. The Parties' Marks Must Be Compared As Set Forth in the Application and Registration.

Protective Insurance asks the Board to view the parties' marks in "context." (Opposition p. 13).[2] Specifically, Protective Insurance argues that the applied-for mark is "most often used in direct proximity to the wording 'Protective Insurance'" and that the registered mark is "often used in direct proximity to the company name" of Grinnell Mutual. (Opposition p. 5 ¶ 25; p. 7 ¶ 35). Protective Insurance goes so far as to depict a) its shield design in color with the words "PROTECTIVE INSURANCE" and b) Grinnell Mutual's shield design in color with the words "GRINNELL MUTUAL." (Opposition p. 12).

Protective Insurance's argument regarding actual usage of the parties' marks violates the fundamental principle that similarity of marks must be analyzed based on the marks as set forth in the application and registration. *See e.g.,* TMEP § 1207.01(b); *In Re: I.Am.Symbolic, LLC*, 866 F.3d 1315, 1324 (Fed. Cir. 2017); *In re Midwestern Pet Foods, Inc.,* 2011 WL 6012205 at * 4 (TTAB 2011) (non-precedential) ("[O]ur determination of the similarities or dissimilarities between the marks is based upon the applied-for and registered marks themselves, not evidence of the context in which the marks are used").

[2] Protective Insurance also suggests the Board should consider "public perception," quoting *Opryland* . The *Opryland* court held that in granting summary judgment for the applicant, the Board should not have ignored the opposer's evidence of fame, which lead the court to describe "public perception" as a "material fact." 970 F.2d 847 (Fed. Cir. 1992). Grinnell Mutual's motion for summary judgment does not raise fame, making *Opryland* not on point.

Grinnell Mutual's registered mark does not include the words GRINNELL MUTUAL, and it does not include a claim of color. (Grinnell Exhibit A at GRINNELL001). Protective Insurance's applied-for mark does not include the words PROTECTIVE INSURANCE, and it does not include a claim of color. (Grinnell Exhibit B at GRINNELL0036). Thus, the words and colors the parties may sometimes use along with their shield designs cannot be considered when analyzing similarity of marks. *See In Re Microsoft Corp.,* 68 U.S.P.Q.2d 1195, 1198 (TTAB 2003) (precedential) ("[I]t is well-settled that use of a house mark in conjunction with a product mark will not serve to prevent a finding of likelihood of confusion when the house mark is not included in the mark for which registration is sought").

2. The Overall Impression of the Parties' Abstract Shield Designs Is Identical.

Protective Insurance focuses on the precise lines contained in the parties' marks. For example, Protective Insurance argues that Grinnell Mutual's mark does not contain a pointed, triangular bottom. (Opposition p. 4). This approach is contrary to law. Similarity of design marks cannot be determined "by simply comparing individual features of the marks." *In Re Pure Networks, Inc.,* 2007 WL 2698294 at * 4 (TTAB 2007) (non-precedential). Similarity must be "determined by considering the overall impression created by the marks as a whole …." *Id.*

The overall impression created by the applied-for mark is identical to the overall impression created by the registered mark. (Grinnell Exhibit A at GRINNELL001); (Grinnell Exhibit B at GRINNELL036). Both of these marks are abstract shield designs:

| **Grinnell Mutual's Registered Mark** | **Protective Insurance's Applied-For Mark** |
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The average purchaser, whose recollection of design marks "is likely to be especially general and hazy," would not recall any distinction between the applied-for mark and the registered mark. *In Re Speciality Sports Ltd.,* 2005 WL 2865164 at * 2 (TTAB 2005) (non-precedential).

Moreover, the parties' services are legally identical, as explained above. Thus, the degree of similarity in marks required for a likelihood of confusion is lessened. *See e.g.,* TMEP § 1207.01(b); *Century 21 Real Estate Corp. v. Century Life of Am.,* 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992).

3. The Applied-For Mark Does Not Contain The Letter "P."

In an attempt to distinguish its shield design from Grinnell Mutual's shield design, Protective Insurance argues that its mark contains the letter "P." This argument has no merit.

The applied-for mark as set forth in Protective Insurance' application is the following:

(Grinnell Exhibit B at GRINNELL0036). This mark does not contain the letter "P."

The fact that Protective Insurance's applied-for mark does not contain the letter "P" is confirmed by the description of the mark in the application. When filing its application, Protective Insurance was required to "clearly and accurately" describe the applied-for mark. *See* TMEP § 808.02; 37 C.F.R. § 2.37. Section 808.02 of the TMEP provides that a description of a mark "should not create a misleading impression by either positive statement or omission." TMEP § 808.02 (emphasis added). Furthermore, Protective Insurance was required to describe all significant aspects of its mark. "The description should describe all *significant* aspects of the mark, including both literal elements and design elements. …If a mark contains both wording and design features, the description should describe both aspects of the mark in order to be complete…." *Id.* Protective Insurance's application describes the applied-for mark as follows: "The mark consists of a shield design." (Grinnell Exhibit B at GRINNELL 0038). Thus,

Protective Insurance has represented to the Trademark Office that its applied-for mark does not contain the letter "P." There is no basis for Protective Insurance to now argue that its mark contains this letter, much less that the letter is purportedly the dominant portion.

4. Protective Insurance's Arguments Regarding a "Common, Suggestive Element" Are Contrary to Law.

Protective Insurance attempts to rely on case law addressing a "common, suggestive element." (Opposition p. 14). This reliance is misplaced for several reasons.

Grinnell Mutual's mark and Protective Insurance's mark do not simply share an "element," such as a suffix in a word mark. *See e.g., Pictionary Inc. v. Spark Games LLC*, 2007 WL 4135852 at * 6 (TTAB 2007) (non-precedential) (addressing the suffix TIONARY as a shared element). Grinnell Mutual's and Protective Insurance's marks are similar in their entireties: they are both abstract shields. Thus, the cases regarding common shared elements do not apply.

In addition, Protective Insurance has not supported its opposition with any evidence of third-party registrations or even third-party usage of similar marks. Thus, Protective Insurance has not proven any suggestive commonality. *See In re Roar Media LLC*, 2011 WL 5014013 at * 5 (TTAB 2011) (non-precedential) ("[T]he existence of seven registrations simply does not persuade us that ROAR is considered a commonly registered element in connection with the services at issue such that the additional matter in applicant's mark is sufficient to distinguish it from the cited registered marks"); *Hachete Filipacchi Presse v Ev Intl.,* 2008 WL 4233885 at * 7 (TTAB 2008) (non-precedential) (rejecting common element argument because "there is no evidence of usage of these specific ELLE formative marks…").

Furthermore, Grinnell Mutual's and Protective Insurance's marks do not contain any "additional matter" other than the abstract shield designs. Thus, there is no basis to conclude that

some "additional matter" is sufficient to distinguish the parties' marks notwithstanding their commonalities. *See In re Don Shapiro Industries, Inc.,* 1998 WL 44538 at * 3 (TTAB 1998) (non-precedential) ("While in certain cases the presence of a common suggestive element in two marks may not be sufficient to support [a] holding of likelihood of confusion…, in the present case there are no other elements apart from the word CONTOUR[s] in applicant's mark and the registered mark which would enable consumers to distinguish them").

5. The Parties' Disagreement Is Not a Fact Dispute.

While Grinnell Mutual and Protective Insurance disagree regarding the similarity of their marks, this disagreement does not constitute a factual dispute. Similarity of the marks is a legal question for the Board to decide. *See Atraverda Ltd. v. Sze Yeung Li*, 2011 WL 3871949 (TTAB 2011) (non-precedential)("The Board is charged with the responsibility for the ultimate legal conclusion on the question of likelihood of confusion, including the similarities of the marks, and must make its own evaluation of what the average consumer will perceive the marks to be as they are encountered in marketing arena").[3]

**D. As a Matter of Law, Grinnell Mutual Owns Registration No. 5214984.**

In an attempt to generate a fact issue, Protective Insurance even denies Grinnell Mutual's ownership of Registration No. 5214984. (Opposition p. 2). There is no good-faith basis for this denial. *See* 15 U.S.C. § 1057(b) (certificate of registration is prima facie evidence of ownership); (Grinnell Exhibit A –certificate of registration).

[3] The affidavit offered by Protective Insurance's employee offering his opinions regarding the commercial impressions of the parties' marks should be disregarded. *See Freedom Federal Savings and Loan Ass'n. v. Heritage Federal Savings and Loan Ass'n*, 210 U.S.P.Q. 227 n. 1 (TTAB 1981) (opinions of opposer's employees regarding similarity of the parties' marks are not only "self-serving" but also "not binding on the Board, which must independently evaluate the facts in any given case and arrive at its own conclusion").

Respectfully submitted,

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## ELECTRONIC MAILING CERTIFICATE

I hereby certify that this REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT is being submitted electronically through the Electronic System for the Trademark Trial and Appeal Board (ESTTA) on this 16th day of May, 2018.

/Sarah J. Gayer/
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## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT will been served on the following attorney for Applicant by forwarding said copy on May 16, 2018, via email to:

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