ESTTA Tracking number: **ESTTA1100085**

Filing date: **12/07/2020**

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

Proceeding	92070407
Party	Plaintiff AWP USA Inc.
Correspondence Address	DAVID LUDWIG DUNLAP BENNETT & LUDWIG PLLC 211 CHURCH STREET SE LEESBURG, VA 20175 UNITED STATES Primary Email: trademarks@dbllawyers.com Secondary Email(s): dludwig@dbllawyers.com 703-777-7319
Submission	Brief on Merits for Plaintiff
Filer's Name	Hyung Gyu Sun
Filer's email	hsun@dbllawyers.com, dludwig@dbllawyers.com, litigation@dbllawyers.com
Signature	/Hyung Gyu Sun/
Date	12/07/2020
Attachments	AWP Petition to Cancel Trial Brief fin.pdf(246854 bytes)

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

IN THE MATTER OF Trademark Reg. No. 5,323,248
For the mark CHUBB TRAVEL SMART;
Registered on October 31, 2017

AWP USA INC.,	)	
Petitioner,	)	
v.	)	**Cancellation No. 92070407**
CHUBB INA HOLDINGS INC.,	)	
Registrant.	)	

PETITIONER'S BRIEF

Petitioner, AWP USA Inc. ("Petitioner") hereby petitions to cancel U.S Trademark Registration No. 5,323,248 because it believes that it is being and will continue to be damaged by said registration for the mark CHUBB TRAVEL SMART. In supporting the foregoing, Petitioner submits the following brief.

I. INTRODUCTION

Petitioner AWP USA Inc. is a corporation organized under the laws of District of Columbia and has its principal place of business in Richmond, Virginia. Petitioner is a leader in the travel insurance industry and assistance industry. Petitioner first launched its mobile application software TRAVELSMART for the public's use in early 2013, and since then, the app has successfully provided its users with access to travel insurance policies, medical assistance information, and local emergency and assistance information, allowed them to file and track claims, and check and track their flight status on a real time basis.

More than four years *after* Petitioner started using its TRAVELSMART mark in connection with its mobile application and web-based software services for providing information related to travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance during travels, Registrant filed for and registered the mark CHUBB TRAVEL SMART, U.S. Trademark Reg. 5,323,248 for mobile applications for planning trips and receiving travel, weather, medical, safety, health and security information. Registrant alleges in its registration that it started using the mark CHUBB TRAVEL SMART in connection with said mobile applications in 2016, which is approximately more than three years *after* Petitioner's launch of its mobile application TRAVELSMART.

Registrant's use of the mark CHUBB TRAVEL SMART is highly likely to cause consumer confusion as to the sources of Registrant's CHUBB TRAVEL SMART mark and Petitioner's TRAVELSMART mark due to the similarity of the compared marks, the parties' partially identical goods, their overlapping trade channels, and Petitioner's mark's strength. Moreover, the mobile applications by Petitioner and Registrant were featured together on online publications familiar to the public. Registrant has used the term TRAVELSMART and/or TRAVEL SMART apart from

its entire mark CHUBB TRAVEL SMART for mobile applications on some instances further increasing the already high likelihood of confusion among consumers. Thus, Petitioner respectfully prays that the Board sustain this proceeding and cancel registration of Registrant's CHUBB TRAVEL SMART mark.

II. DESCRIPTION OF THE RECORD

The evidence of the record consists of the following: the pleadings; Petitioner's First Notice of Reliance and corresponding exhibits; Petitioner's Second Notice of Reliance and a corresponding exhibit; Petitioner's Third Notice of Reliance and a corresponding exhibit; Petitioner's Fourth Notice of Reliance and a corresponding exhibit; Registrant's First Notice of Reliance and corresponding exhibits; Registrant's Second Notice of Reliance and corresponding exhibits; Registrant's Third Notice of Reliance and corresponding exhibits.

Petitioner's Evidentiary Record

1. June 11, 2020 Petitioner's First Notice of Reliance with Petitioner's Exhibit A. Exhibit A contains evidence of similarity of Petitioner's and Registrant's marks, overlapping goods/services between the marks, functional similarities of Petitioner's goods and Registrant and Registrant's alleged predecessor's goods, instances of the parties' marks and Petitioner and Registrant's mobile applications featured together in media, use of the ACE Travel Smart mark by Registrant's alleged predecessor, and Petitioner's senior use of its TRAVELSMART mark.
2. June 11, 2020 Petitioner's Second Notice of Reliance with Petitioner's Exhibit B. Exhibit B contains Registrant's responses to Petitioner's First Set of Interrogatories.

3. June 11, 2020 Petitioner's Third Notice of Reliance with Petitioner's Exhibit C. Exhibit C contains evidence of relatedness between Petitioner's and Registrant's goods and overlapping trade channels of those goods.
4. June 11, 2020 Petitioner's Fourth Notice of Reliance with Petitioner's Exhibit D. Exhibit D contains evidence of status of U.S. Trademark Reg. No. 5,323,248 for the CHUBB TRAVEL SMART mark.

Registrant's Evidentiary Record

1. August 10, 2020 Registrant's First Notice of Reliance with Registrant's Exhibits 1-32. Exhibits 1-32 contain evidence of third-party websites that use the term TRAVEL SMART.
2. August 10, 2020 Registrant Second Notice of Reliance with Registrant's Exhibits 1-7. Exhibits 1-7 contain evidence of dictionary definitions of the word SMART.
3. August 10, 2020 Registrant's Third Notice of Reliance with Registrant's Exhibits 1-96. Exhibits 1-96 contains evidence of third-party registrations in the USPTO that contain and disclaim the term SMART.

III. STATEMENT OF THE FACTS

A. Petitioner and its TRAVELSMART Mark

On or about March 23, 2013, Petitioner, d/b/a Allianz Global Assistance USA, a provider of travel insurance and travel assistance, launched its TRAVELSMART mobile app which currently delivers to its users key information on local medical providers, translations of drug and first-aid terms, and emergency phone numbers, and has used the TRAVELSMART mark in connection with the mobile app consistently since that time. (TTABVUE No. 11, p. 89-91.) Until 2013, Petitioner or its affiliates or related entities had helped millions of consumers solve their travel problems over the past 60 years, had employed almost 11,000 associates speaking 40

languages across five continents. (TTABVUE No. 11, p. 91.) The TRAVELSMART app includes Petitioner's pre-evaluated list of 2,000 hospitals in 130 countries. (*Id*.) Each hospital has been pre-evaluated and often has contact information and one-touch dialing. (*Id*.) The app's drug dictionary includes some internationally recognized names for common drugs while first aid term translations are available in 18 languages, and emergency services phones numbers were available for 217 countries and can also be reached through one-touch dialing. (*Id*.) Indeed, it had been the single most innovative app to solve medical and safety concerns for those traveling abroad.

By the end of 2017, Petitioner's TRAVELSMART app has increased its database and expanded its presence by featuring a more updated user interface which allows travelers to access their travel insurance details, travel insurance claim status, flight status, and local emergency numbers. (TTABVUE No. 11, p. 36-37.) By then, Petitioner or its affiliates or related entities were running operation centers in 34 countries, where Petitioner's subsidiary is providing insurance to 25+ million customers. (*Id*. p. 37.)

Generally, every U.S. customer who signs up for Petitioner's travel insurance receives an email confirming the details of the insurance coverage, a copy of the policy and information about the TRAVELSMART app and how to download the app. The app currently allows travelers to, among other things, (1) access their travel insurance plans, (2) receive 24-Hour Hotline Assistance services for common overseas emergencies such as filing a local police report or connecting them with a nearest U.S. embassy, (3) locate nearby hospitals, pharmacies, police stations and U.S. embassies, and (4) receive translations of first-aid and medical terms through Petitioner's medication dictionary. (*Id*. p. 15-16.) The app also provides its users up to date information on events that could impact their travels. (*Id*. p. 11.) By June 2020, the app had been downloaded and installed by users on the Google Play Store over 100,000 times, and received approximately 1,200

ratings and reviews with an average of 4.2 out of 5 stars by its users on the Apple Store. (*Id*. p. 11-14.)

On May 1, 2018, Petitioner filed its trademark application for the TRAVELSMART mark with the United States Patent and Trademark Office. On July 20, 2018, the examining attorney of Petitioner's application issued an Office Action for the application and held that the registration of Petitioner's TRAVELSMART mark is refused because of a likelihood of confusion with Registrant's CHUBB TRAVEL SMART mark.

B. <u>Registrant's CHUBB TRAVEL SMART Mark</u>

Registrant is the world's largest publicly traded property and casualty insurance company. (TTABVUE No. 11, p. 70.) Since its inception, Registrant has used its house mark CHUBB in connection with a variety of goods or services. (*See Id*. p. *45-51, *67-70, *73, *83-84.) On or about January 15, 2016, Registrant first launched its mobile application CHUBB TRAVEL SMART for planning trips, receiving travel, weather, medical, safety, heath, and security information, receiving security alerts, and currency conversion and allegedly used the CHUBB TRAVEL SMART in connection with the mobile apps. (TTABVUE No. 12, p. 8-10.) Registrant's CHUBB TRAVEL SMART app provides travelers with easily accessible country-specific information and pre-travel advice, and, when they are abroad, instant connectivity to emergency medical or security assistance, local emergency services and location-based alerts and security threats. (TTABVUE No. 11, p. 69.) The app also includes useful travel information, information about the quality of local health care facilities, recommended vaccinations, a currency converter, embassy locator and a handy medical database of conditions and medications, including alternative generic drug names and brands, any possible side-effects, possible interactions with other drugs.

(*Id*.) Registrant filed for and registered the mark CHUBB TRAVEL SMART, U.S. Trademark Reg. 5,323,248 on April 10, 2017. (TTABVUE No. 14, p. 6.)

C. The Current Coexistence of the TRAVELSMART and CHUBB TRAVEL SMART Marks

The record in this case shows that there are multiple instances of both Petitioner's TRAVELSMART app and CHUBB TRAVEL SMART app being featured together in media and journal in the context of travel insurance. A 2019 Forbes article named 'Here Are The Best Travel Insurance Apps For Your Next Trip' introduces Petitioner's TRAVELSMART app as one of the best and most popular travel insurance apps with more than 470,000 downloads. (*Id*. p. 52-54.) The writer of the article emphasized the TRAVELSMART app's feature of using "geolocation to direct travelers to the closest, hospital, clinic, pharmacy, police station or U.S. embassy" using a choice of Google or Apple maps, and recommending "hospitals within the app so [users] can identify vetted facilities quickly." (*Id*.) The article subsequently introduces other travel insurance apps for travelers including Registrant's CHUBB TRAVEL SMART app which "aggregates and filters information including . . . security and health information databases" for Registrant's insurance policy holders. (*Id*.)

A 2020 eCloudBuzz article named 'Best Travel Insurance Apps For Your Next Trip' highlights traveler's need to have travel insurance and subsequently introduces the "List of Best Travel Insurance Apps." (TTABVUE No. 11, p. 64-65.) Within the list of five apps, both Petitioner and Registrant's apps are included. (*Id*.) The article states (1) the TRAVELSMART app allows users to view their plan details, file and trace their insurance claims, and connect to Petitioner's 24/7 customer support for help with medical and other travel-related emergencies and (2) the CHUBB TRAVEL SMART app enables identification of potential threats based on users location

or planned destination, and aggregate and filter information including news media, government institutions, security and health information databases, and social media. (*Id*.)

Lastly, Issue 204 of International Travel & Health Insurance Journal from January 2018 features the parties' apps under the same article with the heading named 'Travel smart with TravelSmart.' (TTABVUE No. 13, p. 6-7.) The article discusses the aforesaid functions of Petitioner's TRAVELSMART app first and does the same for Registrant's app under the subheading named '… and with Travel Smart.' (*Id*. p. 6.)

IV. OPPOSER HAS STANDING TO OPPOSE THE APPLICATION

Registrant seeks to improperly enjoy unrestricted federal protection of the CHUBB TRAVEL SMART mark for travel-related mobile application software. If the registration of the mark is maintained, it will continue to constitute prima facie evidence of Registrant's exclusive right to use the CHUBB TRAVEL SAMRT mark in connection with travel-related mobile application throughout the United States. Such use of the mark by Registrant will inevitably cause a likelihood of confusion among consumers as to the sources of the CHUBB TRAVEL SMART mark and Petitioner's TRAVELSMART mark for travel-related mobile apps because the marks are substantially similar, Petitioner and Registrant's goods are highly related and in part identical, and the goods' trade channels overlap. As such, Petitioner has a direct and personal stake in the outcome of the current cancellation proceeding and reasonably believes it has been and will continue to be damaged by the registration of Registrant's confusingly similar mark. T.B.M.P. § 303.03.

V. PETITIONER HAS PRIORITY

It is undisputed that Petitioner commenced using its TRAVELSMART mark for its travel mobile app since early 2013. (TTABVUE No. 11, p. 89-92.) Registrant applied for and registered

its CHUBB TRAVEL SMART mark in 2017. Registrant alleges that it has started using the CHUBB TRAVEL SMART mark in connection with its mobile app since January 2016. (TTABVUE No. 12, p. 3-4.) That Petitioner is a senior user of its mark and has superior rights over the Registrant's alleged rights in its CHUBB TRAVEL SMART mark is clear because the date Petitioner first used its mark in commerce predates both Registrant's first use date of its mark and the filing date of its trademark application.

VI. REGISTRANT'S CHUBB TRAVEL SMART MARK IS LIKELY TO CAUSE CONFUSION WITH PETITIONER'S TRAVELSMART MARK

Registration of a mark is refused if it "consists of . . . a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark . . . previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

In finding whether there exists a likelihood of confusion between marks, any reasonable doubt should be resolved in favor of the senior user. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010) ("for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so."); *In re Chtam Int'l Inc.*, 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004) (noting that any doubt regarding confusion should be construed against the subsequent user and finding the parties marks are confusing similar even if the parties' goods, tequila and beer or ale, were not identical.). In determining a likelihood of confusion, the Board may consider the thirteen factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1974). Not all of the Dupont factors are relevant to every case, and the Board may only give weight to the ones that are significant to the marks at issue. *In re Mighty Leaf Tea*, 601 F.3d at 1346. Here, each of the following relevant factors weighs heavily in favor of finding a

likelihood of confusion: similarity of marks; partially overlapping goods; undistinguishable trade channels; and the strength of a mark.

A. Opposer's TRAVELSMART Mark Is Inherently Distinctive, Has Acquired At Least Niche Fame and Is a Strong Mark

The strength of a mark is determined by considering two aspects of strength: "(1) Conceptual Strength: the place of the mark on the spectrum of the marks; and (2) Commercial Strength: the marketplace recognition value of the mark." *Yah Kai World Wide Enterprises, Inc. v. Napper*, 195 F. Supp. 3d 287, 317 (D.D.C. 2016). The spectrum of the marks classifies marks in five categories of increasing distinctiveness; they may be (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary; or (5) fanciful. *United States Patent & Trademark Office v. Booking.com B. V.*, 140 S. Ct. 2298, 2302, 207 L. Ed. 2d 738 (2020); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *see Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The last three categories are deemed inherently distinctive and are therefore entitled to trademark protection. *Id*.

The definitions of the word "SMART" cited by Registrant do not merely describe an ingredient, quality, characteristic, function, feature, purpose or use of Petitioner's travel insurance mobile applications, and Petitioner's TRAVELSMART mark is, at a minimum, suggestive. Suggestive marks imply some characteristic or quality of the goods/services to which they are attached, and if consumers must use imagination or any type of multi-stage reasoning to understand the marks' significance, then such suggestive marks are considered sufficiently distinctive to be entitled to protection from infringing use. *Yah Kai World Wide Enterprises, Inc.*, 195 F. Supp. 3d at 314. In contrast, descriptive marks, which are deserving of less protection under the Lanham Act, *directly* identify or describe some aspect, characteristic, or quality of the service to which they

are affixed, in a straightforward way that requires no exercise of imagination to be understood. *Id*. (emphasis added).

As Registrant identified in the Exhibits to its Second Notice of Reliance, the plain meanings of the word "Smart" include, *inter alia*, "operating by automation," "using a built-in microprocessor for automatic operation, for processing of data, or for achieving greater versatility," "something that can act on its own accord," "equipped with electronic control mechanisms and capable of automated and seemingly intelligent operation," "programmed in advance with certain features, as navigation information or sensing and self-correcting functions," "containing a microprocessor for limited computing capability," and "[c]apable of making adjustments that resemble those resulting from human decisions, chiefly by means of electronic sensors and computer technology."[1] (TTABVUE No. 16, p. *6, *14, *22, *34, *38, *42) Undoubtedly, the definition of the word "Smart" is limited to mean operating by automation, using a microprocessor, or containing navigation information or sensing and self-correcting functions.

When the wording Smark is combined with the term Travel, the overall meaning of the mark TRAVELSMART or TRAVEL SMART may *imply* some characteristic or quality of Petitioner's travel insurance mobile application software, but certainly *cannot directly identify or describe* some aspect, characteristic, quality of Petitioner's travel insurance mobile application software. That is, the plain meaning of the word TRAVELSMART or TRAVEL SMART cannot identify any functionality, characteristic, or purpose of Petitioner's smartphone application. Nor does it describe anything beyond what is common among smartphones and mobile applications;

[1] The definition of the word "Smart" in Exhibit 4 of Registrant's Second Notice of Reliance is simply not relevant to the word's plain meaning as the definition applies specifically to aero-related goods or services.

every application or software operates by automation, and virtually every smartphone has multiple microprocessors to properly function, and contains at least some degree of navigation information or sensing and self-correcting functions.

Indeed, one does not use "SMART" together with "TRAVEL" in order to describe in any particular characteristic or function of travel insurance mobile application software, for instance, to describe what the applications can do to help their users who are traveling. Simply put, what distinguishes a suggestive mark from a descriptive mark is, while the latter has to directly describe its goods' features, qualities, or ingredients in ordinary language, the former merely suggests the nature of its goods, requiring the consumer to use imagination, thought, and perception to reach a conclusion as to what those features, qualities, or ingredients are. *See Globalaw Ltd. v. Carmon & Carmon Law Office*, 452 F. Supp. 2d 1, 29 (D.D.C. 2006). Here, ordinary consumers cannot immediately identify any direct relationship between the meaning of TRAVELSMART and Petitioner's goods and services, and instead must engage in some mental exercise and multi-stage reasoning to understand the mark's significance and the nature of the goods and services provided under that name. Accordingly, Plaintiff's mark is suggestive and inherently distinctive, which renders it a conceptually strong mark.

The commercial strength of the owner's mark means marketplace recognition of the mark. *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 221 (3d Cir. 2000). Naturally, courts will look to factual evidence of "marketplace recognition." *Id*. The fame of a mark plays a dominant role in the likelihood of confusion analysis as famous marks are afforded a broader scope of protection or exclusivity of use. *Major League Baseball Properties, Inc.*, 2018 WL 3533447 (T.T.A.B. 2018). Fame can be measured by the "volume of sales and advertising expenditures for the goods . . . identified by the marks at issue," "the length of time those indicia

of commercial awareness have been evident," . . . as well as "the general reputation of the products and services." *Id*.; *Bose Corp. v. QSC Audio Prods. Inc.,* 63 U.S.P.Q. 2d 1303, 1305-06, 1309 (Fed. Cir. 2002).

In this case, because Petitioner's TRAVELSMART mobile application is offered for free, the length of time indicia of commercial awareness have been evidenced and the general reputation of the products are most relevant to assess the market strength of the mark. Notably, Petitioner's TRAVELSMART app has already been recognized by media and the public more than two years before Registrant launched its CHUBB SMART TRAVEL app. (TTABVUE No.11, p. *18-19, *89-92.) By the time Registrant launched its CHUBB TRAVEL SMART app in January 2016, Petitioner's app was recognized as one of the top 16 mobile applications in the property and casualty insurance industry. (*Id*. p. 26-30.) Petitioner's app had been downloaded and installed by users on the Google Play over 100,000 times, and received approximately 1,200 ratings and reviews with an average of 4.2 out of 5 stars by its users on the Apple Store. (*Id*. p. 11-14.) In contrast, Registrant's CHUBB TRAVEL SMART app has ratings and reviews of an average of 2.3 out of 5 stars by its users on the Apple Store, further showing that Petitioner has sustained market harms due to the source confusion caused by Registrant's confusingly similar app. (*Id*. p. 47-48.) Moreover, a 2019 Forbes article noted Petitioner's TRAVELSMART app as one of the best and most popular travel insurance apps with more than a total of 470,000 downloads. (*Id*. p. 52-54.) That Petitioner's mobile application has been praised as one of the most popular travel insurance mobile applications on the app stores receiving 1,200 overall positive ratings and reviews by users demonstrates the app's strong commercial presence and positive reputation of the product.

The TRAVELSMART brand has unquestionably acquired a niche fame in travel insurance mobile application market and therefore should be entitled to a broad scope of protection or exclusivity of use under U.S. trademark law. Thus, Petitioner's TRAVELSMART mark is inherently distinctive in terms of its conceptual as well as marketplace strength.

B. The Parties' Marks Are Highly Similar and Addition of Registrant's House Mark CHUBB to Petitioner's TRAVELSMART Mark Does Not Obvious Likelihood of Confusion

The similarity of the compared marks has always been considered an important factor for likelihood of confusion analysis. *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000). Indeed, a single *DuPont* factor may be dispositive in a likelihood of confusion analysis when that single factor is the dissimilarity of the marks. *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1347 (Fed. Cir. 2010). Nevertheless, "a court does not consider the similarity of the marks in the abstract, but rather in light of the ways the marks are encountered in the marketplace and the circumstances surrounding the purchase." *Perfumebay.com Inc. v. eBay, Inc.*, 506 F.3d 1165, 1174 (9th Cir. 2007).

1. Petitioner's Mark Is Strong and the Entirety of the Mark Is Incorporated within Registrant's Mark

The Trademark Trial and Appeal Board (the "Board") has consistently held that there exists a likelihood of confusion when the *entirety* of one mark is incorporated within another. *See Lion Capital LLP*, No. 91191681, 2013 WL 2329834 (T.T.A.B. 2013) (STONE LION CAPITAL for financial services are likely to cause confusion with LION CAPITAL for equity capital investment and venture capital services); *In Re W.-Com Nurse Call Sys., Inc.*, No. 86935321, 2017 WL 6033956 (T.T.A.B. 2017) (ECAREBOARD for video-on-demand transmission services are likely to cause confusion with CAREBOARD for electronic indicator board and medical workstation); *In Re Cent. Garden & Pet Co.*, No. 85024647, 2012 WL 2024445 (T.T.A.B. 2012) (WILD BY

NATURE for cat food and dog food is likely to cause confusion with BY NATURE for feeds for smalls animals and pet treats).[2] This is especially true when the result of the consideration of one factor can influence the consideration of another. *Perfumebay.com Inc.*, 506 F.3d at 1174. In *Perfumebay.com*, the Federal Circuit Court of Appeals held that when the senior user's mark is strong, the fact that the public would likely notice the difference between two marks is not sufficient to conclude that the marks are dissimilar. *Id*. Based on the reasoning, the court held that the plaintiff's Perfumebay mark incorporates defendant's eBay mark in its entirety and that, despite the differences between the two marks, the fact that the eBay mark is a strong one supports a finding that there exists the similarity between the marks sufficient to cause likelihood of consumer confusion. *Id*.

Similarly, in this case, Petitioner's TRAVELSMART mark and Registrant's CHUBB TRAVEL SMART mark are almost identical except for the additional term CHUBB in the latter. As discussed in the preceding section, Petitioner's TRAVELSMART mark is strong, inherently distinctive, and has acquired niche fame in connection with travel insurance mobile application software. Thus, that the public would likely perceive the difference of one term between the two marks is insufficient to establish the dissimilarity of the marks and that the remaining terms in Registrant's Mark constitute the entirety of Petitioner's Mark together establish the marks are similar as a whole to cause likelihood of confusion among the public.

2. Addition of Registrant's House Mark to Petitioner's Inherently Distinctive Mark Causes Direct Confusion and Reverse Confusion

[2] The Board has recently held that POLITICAL TINDER and TINDER marks are confusingly similar when the compared goods and services are not even similar to each other; the Opposer Match Group, LLC has used the TINDER mark on computer software applications for dating while the Applicant RLP Ventures, LLC sought to register the POLITICAL TINDER mark for use in services of advertising and marketing services, providing information and new related to politics.

In limited circumstances, when the compared marks in their entireties convey *significantly different* commercial impressions or the common matter is *merely descriptive* or *so diluted* that the similarities presented would be overshadowed by the house mark, the two marks can be deemed dissimilar enough to prevent consumer confusion. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645 (TTAB 2010), aff'd, 98 USPQ2d 1253 (Fed. Cir. 2011) (CAPITAL CITY BANK held not likely to be confused with CITIBANK) (emphasis added). However, in general, the addition of a house mark to an inherently distinctive, and not merely descriptive or weak, matter does not obviate likelihood of confusion, and instead increases the likely confusion. *In Re Int'l Intimates Inc.*, No. 77911197, 2011 WL 5873329, at *4 (T.T.A.B. 2011). In *International Intimates*, the Board reviewed the applicant's mark KISS KISS BY INTERNATIONAL INTIMATES INC. for "clothing and apparel, namely, undergarments, lingerie and sleepwear" and the registrant's mark QISS QISS for *inter alia*, "bras, bustiers, robes, slips, boxer briefs, boxer shorts, lingerie, loungewear, sleepwear, and underwear," and concluded that the term KISS KISS or its phonetic equivalent QISS QISS is not weak in connection with clothing goods after mentioning that the parties' marks are the only two marks on the Principal Register of the USPTO database that use the repeated sound 'kiss kiss' for lingerie, sleepwear, and undergarments. *Id*. It further held that applicant's INTERNATIONAL INTIMATES mark is well-known does not sufficiently distinguish the two marks because KISS KISS mark would be perceived as the secondary or product mark and the remaining INTERNATIONAL INTIMATES mark as the house mark, and as a result purchasers familiar with registrant's distinctive QISS QISS lingerie products are likely to believe that applicant is the source of registrant's QISS QISS products. *Id*.

Indeed, as McCarthy explains, "a junior user cannot justify its confusing use of another's mark simply by tacking on its own house mark . . . . Such a usage may merely suggest to customers that plaintiff has licensed defendant or that the parties are affiliated in some other way." 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:43 (5th ed. 2018). Here, Registrant is engaging in a similar behavior as the applicant strived to do in *International Intimate*: adding a well-known house mark to Petitioner's strong mark and subsequently using the resulting mark in connection with the product that is similar to the Petitioner's. As noted in the previous section, the word TRAVELSMART is neither a merely descriptive nor heavily diluted term — it is an inherently distinctive and suggestive mark which requires ordinary consumers to take a mental leap to understand the relationship between the meaning of the mark and the nature of Petitioner's goods and services. Thus, the addition of a well-known mark to inherently distinctive matter only aggravates the likely confusion.

Moreover, even if we were to assume such direct consumer confusion would not be likely (it will), the combination of a house mark and a distinctive mark also causes reverse confusion. Reverse confusion has been used to describe the situation where a larger or prominent newcomer "saturates the market" with a trademark that is confusing similar to that of a smaller, senior user for related goods or services. *In re I.AM.Symbolic, LLC*, 866 F.3d 1315, 1329 (Fed. Cir. 2017); *In Re Melvin Calhoun, Jr.*, No. 77946290, 2012 WL 1708018, at *3 (T.T.A.B. 2012). Reverse confusion operates in the opposite way as direct confusion does as the junior user does not seek to benefit from the goodwill built by the senior user, and instead, it is the senior user that experiences diminution or loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark of the newcomer. *Id*. Indeed, the use of a famous house mark with an otherwise infringing

mark makes reverse confusion even more likely. *Robert Bruce, Inc. v. Sears, Roebuck & Co.*, 343 F. Supp. 1333, 1346 (E.D. Pa. 1972).

In this case, Registrant is the world's largest publicly traded property and casualty insurance company and has used its house mark CHUBB in connection with a variety of goods or services. (TTABVUE No.11, p. *45-51, *67-70, *73, *83-84.). Approximately three years after Petitioner started building goodwill of its business in connection with its travel mobile application under the TRAVELSMART brand, Registrant decided to add Petitioner's TRAVELSMART mark in its entirety to its house mark CHUBB, and commenced using the confusingly similar mark to promote its own travel-related mobile application. Since the advent of Registrant's CHUBB TRAVEL SMART app, online media has started to list both Petitioner's app and the newcomer's app together under the same travel insurance app category. (TTABVUE No. 11, p. *52-54, *64-65., TTABVUE No. 13, p. 6-7.) Due to the world's largest insurance company's participation in travel mobile application market under its Chubb house mark, and its subsequent extensive use of the confusingly similar brand, Petitioner's innovative app that once led solving medical and safety concerns of those traveling abroad is no longer the sole leader in the market, and Petitioner has experienced substantial diminution of its mark's identity and goodwill that it has built.

In sum, Petitioner's TRAVELSMART mark is highly similar to Registrant's CHUBB TRAVEL SMART mark to cause likely confusion among the public as the latter entirely incorporates the former in it, and the addition of CHUBB in the front of Registrant's mark only furthers the source confusion.

C. <u>The Parties' Goods Are Similar and In Part Identical</u>

In determining a likelihood of confusion as to the two compared marks, "it is not necessary that the goods be identical or even competitive." *In re Thor Tech Inc.*, 90 U.S.P.Q.2d 1634, 2009

WL 1098997, at *2 (T.T.A.B. 2009). It is sufficient that the goods are related in some way, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations which would give rise to a mistaken belief that there is an association between the sources of the goods. *Id*; *See also GoTo.com, Inc. v. Walt Disney Co.,* 202 F.3d 1199, 1206 (9th Cir.2000) (holding that "even [goods or] services that are not identical are capable of confusing the public."). Here, the similarity of the compared marks easily exceeds the requisite threshold. Petitioner's goods and services consist of mobile application and web-based software services through the mobile application providing information related to travel insurance, claim filing, flight status checking, medical assistance, and local emergency and assistance for travelers.

Notably, Petitioner's mobile application provides (1) access to traveler's insurance plans, (2) 24-Hour Hotline Assistance for common overseas emergencies such as filing a local police report or connecting them with a nearest U.S. embassy, (3) location information of nearby hospitals, pharmacies, police stations and U.S. embassies, and (4) translations of first-aid and medical terms through Petitioner's medication dictionary. (TTABVUE No.11, p. 15-16.) Similarly, Registrant's goods consist of mobile application for planning trips, receiving travel, weather, medical, safety, heath, and security information, receiving security alerts, and currency conversion and allegedly used the CHUBB TRAVEL SMART in connection with the mobile apps. (*Id*. p. 8-10.) Registrant's app specifically provides users with easily accessible country-specific information and pre-travel advice, and instant *connectivity to emergency medical or security assistance*, *local emergency services* and location-based alerts and security threats when they are abroad. (*Id*. p. 69.) It is well established when the compared goods/services substantially overlap, the fact weighs heavily in favor of finding a likelihood of confusion. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018); *see also Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir.

2002) (finding confusion to be likely between HEWLETT PACKARD and PACKARD TECHNOLOGIES where "several of HP's registrations cover goods and services that are closely related to the broadly described services that Packard Press seeks to register").

In the case hand, there exists a clear overlap in the goods between the parties because both mobile applications provide emergency medical or security assistance and local emergency numbers to their users. Moreover, Registrant's broad description of its goods in Trademark Reg. No. 5,323,248, mobile applications for, *inter alia*, travel, medical, health and security information fully covers Petitioner's mobile application that provides information related to flight status checking, medical assistance, and local emergency and assistance for travelers. The Board in *In Re Apple Inc*. held that the applicant's software for processing audio files and the registrant's service of providing access to non-downloadable software for processing audio files are sufficiently related to cause likelihood of confusion because the applicant' goods and registrant's services perform the similar function of controlling digital music. *In Re Apple Inc.*, No. 85019762, 2012 WL 4763144, at *4 (T.T.A.B. 2012). Undoubtedly, the compared goods and services do not even have to be overlapping to be considered sufficiently related for likelihood of confusion analysis purpose; they only need to be performing similar functions. Here, putting aside the fact that the parties' goods are partially overlapping, Petitioner's mobile application goods and web-based software services through its mobile application, at minimum, perform similar functions as Registrant's mobile applications do: providing emergency medical and security assistance, and local information for travelers. As such, there exists no doubt that this factor weighs heavily in favor of finding the requisite likelihood of confusion.

D. <u>Petitioner's and Registrant's Goods Travel Through Identical Trade Channels</u>

Both Petitioner and Registrant have not included any restriction in its trade channels or purchases in its identification of goods. In those instances, the Board must presume that the parties' goods travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 U.S.P.Q2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 f.3d 1261, 1268, 62 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 2002). The record suggests that both Petitioner's and Registrant's goods are exclusively offered and advertised through the Google Play and Apple Store. (TTABVUE No. 11, p. *11-14, *47-48.) Moreover, online articles and journal have included both Petitioner's and Registrant's products in their small list of promising travel insurance mobile applications. (TTABVUE No. 11, p. *52-54, *64-65., TTABVUE No. 13, p. 6-7.) Thus, both parties' goods are indeed traveling through the identical trade channels, causing consumers who search for Petitioner's product and who instead find Applicant's product to be confused as to the origin of the goods of both parties.

E. Any Doubts Regarding the Likelihood of Confusion Between the TRAVELSMART and CHUBB TRAVEL SMART Marks Should Be Resolved in Favor of Opposer

Courts have consistently held in trademark cases that all doubts concerning the likelihood of consumer confusion, mistake, or deception should be resolved in favor of the senior user. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987); *Kimberly-Clark Corp. v. H. Douglas Enters.*, 774 F.2d 1144, 1146, 227 U.S.P.Q. 541, 543 (Fed. Cir. 1985); *In re Shell Oil Co*., 992 F.2d 1204, 26 U.S.P.Q.2d 1687, 1690-91 (Fed. Cir. 1993). Thus, any doubt regarding the likelihood of confusion between the TRAVELSMART and CHUBB TRAVEL SMART marks should be resolved in favor of the Petitioner.

VII. CONCLUSION

For the foregoing reasons, in order to prevent the likelihood of confusion with Petitioner's TRAVELSMART mark, Petitioner respectfully prays that the Board sustain this petition to cancel and cancel registration of Registrant's CHUBB TRAVEL SMART mark.

DATED this 7th day of December 2020.

Respectfully submitted,

AWP USA Inc.,

/s/ Hyung Gyu Sun

David Ludwig
Hyung Gyu Sun
Dunlap Bennett & Ludwig PLLC
211 Church Street, SE
Leesburg, VA 20175
Tel.: (703) 777-7319
Fax.: (703) 777-3656
dludwig@dbllawyers.com
hsun@dbllawyers.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's Brief has been served upon Registrant by E-Mail on this 7th day of December 2020, addressed as follows:

Jenifer Dewolf Paine
Fish & Richardson PC
Times Square Tower 20th Floor
New York, NY, 10036
paine@fr.com; tmdoctc@fr.com; steinman@fr.com;
jlynch@fr.com; walden@fr.com

/s/ Hyung Gyu Sun
Hyung Gyu Sun