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

Proceeding	92070407
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 5,323,248  
For the trademark CHUBB TRAVEL SMART  
Registered on October 31, 2017

AWP USA INC.,  
  
Petitioner

v.

CHUBB INA HOLDINGS, INC.  
  
Registrant

Cancellation No. 92070407

**REGISTRANT CHUBB INA HOLDINGS, INC.'S TRIAL BRIEF**

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**TABLE OF CONTENTS**

- I. INTRODUCTION..... 1
- II. DESCRIPTION OF THE RECORD..... 1
  - A. Petitioner’s Evidence ..... 1
  - B. Registrant’s Evidence..... 2
  - C. Registrant’s Objections to Petitioner’s Purported Evidence. .... 2
- III. STATEMENT OF THE ISSUES ..... 3
  - A. Whether Petitioner has sufficiently established by admissible evidence that it has standing to bring this Cancellation. .... 3
  - B. Whether Petitioner has sufficiently established by admissible evidence that it has priority of use of its alleged TRAVELSMART mark over Registrant’s CHUBB TRAVEL SMART mark..... 3
  - C. If Petitioner *has* established standing and priority, whether there is a likelihood of confusion between Petitioner’s alleged TRAVELSMART mark and Registrant’s CHUBB TRAVEL SMART mark. .... 3
- IV. RECITATION OF THE FACTS ..... 4
  - A. Petitioner and its Alleged TRAVELSMART Mark. .... 4
  - B. Registrant’s CHUBB TRAVEL SMART Mark..... 4
  - C. The Market is Replete with Uses of TRAVEL SMART / TRAVELSMART..... 5
  - D. The Word SMART Has a Recognized Meaning in the Context of Technology..... 6
  - E. The Word SMART Is Commonly Used in Connection with Software and is Descriptive. ... 7
- V. PETITIONER HAS FAILED TO PROVE STANDING..... 11
- VI. PETITIONER HAS FAILED TO PROVE PRIORITY ..... 13
- VII. PETITIONER HAS NOT ESTABLISHED LIKELIHOOD OF CONFUSION ..... 16
  - A. Petitioner’s (Alleged) Mark Is Extremely Weak (if it is Protectable at All) and is Therefore Not Confusingly Similar to Registrant’s Mark, Which Contains the Distinctive Mark CHUBB..... 17
    - 1. TRAVELSMART is Commercially Weak..... 18
    - 2. Travel Smart is Inherently Weak..... 21
      - (a) The Addition of CHUBB Is Sufficient to Distinguish the Marks..... 24
        - (i) The Addition of A House Mark Will Distinguish Marks that are Otherwise Descriptive and/or Weak. .... 24
        - (ii) Petitioner Has Not Made A Case for Reverse Confusion..... 25

(b)	Petitioner’s Argument that Confusion is Likely Because the “Entirety” of its Alleged Mark is Encompassed in Petitioner’s Mark Fails Given the Weakness of the Mark .....	26
B.	There is No Evidence Relating to the Remaining DuPont Factors.....	28
VIII.	PETITIONER IS NOT ENTITLED TO TIP THE BALANCE IN ITS FAVOR.....	29
	CONCLUSION.....	29

## TABLE OF AUTHORITIES

<b>Cases .....</b>	<b>Page(s)</b>
<i>Ayoub, Inc. v. ACS Ayoub Carpet Serv.</i> , 118 U.S.P.Q.2d 1392 (T.T.A.B. 2016) .....	14
<i>Bose Corp. v. QSC Audio Prods., Inc.</i> , 63 U.S.P.Q.2d 1303, 293 F.3d 1367 (Fed. Cir. 2002).....	17
<i>Boswell v. Mavety Media Grp. Ltd.</i> , 52 U.S.P.Q.2d 1600 (T.T.A.B. 1999) .....	11
<i>Bullova Watch Co., Inc. v. Miller</i> , 463 F.2d 1376 (C.C.P.A. 1972).....	29
<i>Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC</i> , 110 U.S.P.Q.2d 1458 (T.T.A.B. 2014) .....	13, 14
<i>Cunningham v. Laser Golf Corp.</i> , 55 U.S.P.Q.2d 1842, 222 F.3d 943 (Fed. Cir. 2000).....	17
<i>Demon Int’l LC v. Lynch</i> , 86 U.S.P.Q.2d 1058 (T.T.A.B. 2008) .....	12
<i>In re E. I. du Pont de Nemours &amp; Co.</i> , 177 U.S.P.Q. 563, 476 F.2d 1357 (C.C.P.A. 1973) .....	17, 28
<i>Empresa Cubana Del Tabaco v. Gen. Cigar Co.</i> , 111 U.S.P.Q.2d 1058, 753 F.3d 1270 (Fed. Cir. 2014).....	11, 12
<i>Giersch v. Scripps Networks</i> , 90 U.S.P.Q.2d 1020 (T.T.A.B. 2009) .....	12
<i>In Re Int’l Intimates Inc.</i> , 2011 WL 5873329 (T.T.A.B. Nov. 3, 2011) .....	24
<i>Jack Wolfskin Ausrustung Fur Draussen GmbH &amp; Co. KGAA v. New Millennium Sports, S.L.U.</i> , 116 U.S.P.Q.2d 1129, 797 F.3d 1363 (Fed. Cir. 2015).....	19, 20
<i>Juice Generation v. GS Enterprises LLC</i> , 115 U.S.P.Q.2d 1672, 794 F.3d 1334 (Fed. Cir. 2015).....	19
<i>Kellogg Co. v. Pack’em Enters.</i> , 21 U.S.P.Q.2d 1142, 951 F.2d 330 (Fed. Cir. 1991).....	28

<i>Knight Textile Corp. v. Jones Investment Co.</i> , 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005) .....	24
<i>Life Zone Inc. v. Middleman Grp. Inc.</i> , 87 U.S.P.Q.2d 1953 (T.T.A.B. 2008) .....	13, 14, 17
<i>In Re Lion Capital LLP</i> , 2013 WL 2329834 (Jan. 18, 2013).....	27
<i>Lipton Indus., Inc. v. Ralston Purina Co.</i> , 213 U.S.P.Q. 185, 670 F.2d 1024 (C.C.P.A. 1982) .....	11, 12
<i>MarCon, Ltd. v. Avon Prods., Inc.</i> , 4 U.S.P.Q.2d 1474 (T.T.A.B. 1987) .....	25
<i>Moose Creek Inc. v. Abercrombie &amp; Fitch Co.</i> , 73 U.S.P.Q.2d 1287, 331 F. Supp. 2d 1214 (C.D. Cal. 2004), <i>aff'd</i> , 114 F. App'x 921 (9th Cir. 2004) .....	20
<i>Olde Tyme Foods, Inc. v. Roundy's Inc.</i> , 22 U.S.P.Q.2d 1542, 961 F.2d 200 (Fed. Cir. 1992).....	28
<i>Perfumebay.com Inc. v. eBay Inc.</i> , 84 U.S.P.Q.2d 1865, 506 F.3d 1165 (9th Cir. 2007) .....	26
<i>Ritchie v. Simpson</i> , 50 U.S.P.Q.2d 1023, 170 F.3d 1092 (Fed. Cir. 1999).....	12
<i>Safer Inc. v. OMS Investments Inc.</i> , 94 U.S.P.Q.2d 1031 (T.T.A.B. 2010) .....	13
<i>Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.</i> , 101 U.S.P.Q.2d 1163 (T.T.A.B. 2011) .....	18, 26, 28
<i>Truescents LLC v. Ride Skin Care</i> , LLC, 81 U.S.P.Q.2d 1334 (T.T.A.B. 2006) .....	22
<i>WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.</i> , 126 U.S.P.Q.2d 1034 (T.T.A.B. 2018) .....	14, 16

**Statutes**

Trademark Act Section 2(d) .....	13, 16
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**Other Authorities**

American Heritage Dictionary of the English Language.....	6
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Chambers Dictionary of Science and Technology, Thirteenth Edition .....	6
F.R.E. Rule 802 .....	18
2 J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> § 11.86 (5th ed. 2020).....	22, 23
Merriam-Webster Dictionary, Sixth Edition .....	6
Webster’s New World College Dictionary, Fifth Edition.....	6

## **I. INTRODUCTION**

Petitioner AWP USA Inc. (“Petitioner”) has petitioned to cancel Registrant Chubb INA Holdings Inc.’s registration for CHUBB TRAVEL SMART, U.S. Reg. No. 5,323,248, purportedly on the basis that it is likely to cause confusion with Petitioner’s alleged prior use of TRAVELSMART.

However, Petitioner has failed to present any admissible evidence of its standing or its priority. Rather, Petitioner has simply *referred* to a pending trademark application it filed, and submitted various internet printouts of news articles that mention TRAVELSMART. This evidence is not sufficient to establish Petitioner’s standing to bring this case, and it is not sufficient to prove Petitioner’s priority, which is required for it to prevail this case. Therefore, without even reaching the merits of Petitioner’s likelihood of confusion argument, the Petition to Cancel must be denied based on these threshold evidentiary failures.

If for some reason the Board looks past Petitioner’s evidentiary fatalities, Petitioner’s alleged mark TRAVELSMART for (alleged) use in connection with a smartphone application that provides tips and information about travel is merely descriptive, and at best weak, such that the presence of the distinctive mark CHUBB in Registrant’s mark is more than sufficient to dispel any potential likelihood of confusion. The Petition to Cancel should be denied.

## **II. DESCRIPTION OF THE RECORD**

### **A. Petitioner’s Purported Evidence**

Petitioner submitted four Notices of Reliance, detailed as follows:

1. Petitioner’s First Notice of Reliance purporting to attach 26 internet printouts submitted as Exhibit A. 11 TTABVUE.



2. Petitioner's Second Notice of Reliance consisting of Registrant's Responses to Petitioner's First Set of Interrogatories submitted as Exhibit B. 12 TTABVUE.
3. Petitioner's Third Notice of Reliance purporting to attach a January 2018 issue of the International Travel & Health Insurance Journal submitted as Exhibit C. 13 TTABVUE.
4. Petitioner's Fourth Notice of Reliance consisting of a title and status copy of Registrant's U.S. Reg. No. 5,323,248 submitted as Exhibit D. 14 TTABVUE.

**B. Registrant's Evidence**

Registrant submitted three Notices of Reliance, detailed as follows:

1. Registrant's First Notice of Reliance submitting a representative sampling of internet materials showing third party uses of TRAVELSMART / TRAVEL SMART in connection with tips and information about travel, with Exhibit Nos. 1–32. 15 TTABVUE.
2. Registrant's Second Notice of Reliance submitting dictionary definitions of SMART in the context of technology, with Exhibit Nos. 1–7. 16 TTABVUE.
3. Registrant's Third Notice of Reliance submitting ninety-six third party U.S. trademark registrations covering software in which the word SMART is disclaimed, with Exhibits No. 1–96. 17 TTABVUE.

**C. Registrant's Objections to Petitioner's Purported Evidence.**

Registrant objects to Petitioner's characterization of its evidence in its Brief. Petitioner states that its First Notice of Reliance:

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.

Petitioner's Brief p. 2, 20 TTABVUE 12 (Consent Motion for Leave to Amend Petitioner's Brief, with Petitioner's Amended Brief attached as Exhibit No. 1). Petitioner's First Notice of Reliance does not contain admissible evidence of any of these things, as detailed below in Section VI.

Petitioner states that its Third Notice of Reliance "contains evidence of relatedness between Petitioner's and Registrant's goods and overlapping trade channels of those goods." Petitioner's Brief p. 3, 20 TTABVUE 13. Again, Petitioner's Third Notice of Reliance does not contain admissible evidence of either of these things, as detailed below in Section VI.

### **III. STATEMENT OF THE ISSUES**

**A.** Whether Petitioner has sufficiently established by admissible evidence that it has standing to bring this Cancellation.

**B.** Whether Petitioner has sufficiently established by admissible evidence that it has priority of use of its alleged TRAVELSMART mark over Registrant's CHUBB TRAVEL SMART mark.

**C.** Whether, if Petitioner *has* established standing and priority, there is a likelihood of confusion between Petitioner's alleged TRAVELSMART mark and Registrant's CHUBB TRAVEL SMART mark.

#### **IV. RECITATION OF THE FACTS**

##### **A. Petitioner's Alleged TRAVELSMART Mark.**

In its Brief, Petitioner devotes approximately two pages to a discussion of its alleged TRAVELSMART Mark. See Petitioner's Brief pp. 3 – 5, 20 TTABVUE 13–15. In this discussion, Petitioner states that it launched a mobile app under the name TRAVELSMART in 2013, discusses what that app does, how many consumers have used it, what kind of information it contains, where it is available, how it has expanded over the years, and how it works. *Id.* However, none of these factual allegations are supported by admissible evidence. See Section VI, *infra*.

Petitioner then states that it filed a trademark application for TRAVELSMART on May 1, 2018, and that Registrant's CHUBB TRAVEL SMART registration was cited against the application. Petitioner's Brief p. 5, 20 TTABVUE 15. This factual allegation is similarly unsupported by admissible evidence. See Section V, *infra*.

In fact, the record contains no admissible evidence at all regarding Petitioner's alleged mark or application.

##### **B. Registrant's CHUBB TRAVEL SMART Mark.**

Registrant is the owner of U.S. Reg. No. 5,323,248 for the mark CHUBB TRAVEL SMART in connection with “downloadable mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool” in Class 9, filed April 10, 2017 and registered October 31, 2017. The word TRAVEL is disclaimed. See 14 TTABVUE 6.

**C. The Market is Replete with Uses of TRAVEL SMART / TRAVELSMART.**

Registrant has made of record numerous websites and articles showing the use of TRAVEL SMART / TRAVELSMART in the marketplace in connection with tips and information about travel, including in connection with travel insurance. 15 TTABVUE 82–85 (Registrant’s First Notice of Reliance, Ex. No. 21).

Those uses<sup>1</sup> are:

Exhibit	Term	Use
1	TRavel SmarT	Training program for seniors and persons with disabilities utilizing public transportation.
2	TRAVELSMART	Membership and rewards program for frequent travelers.
3	TRAVEL SMART	Travel agent
4	TRAVEL SMART	Recurring column about travel by Los Angeles news station
5	TRAVEL SMART	Line of travel accessories such as electricity converters
6	TravelSmart	Program that encourages alternative methods of transportation to reduce traffic and congestion
7	TRAVEL SMART	Tips and information about traveling to Alaska
8	TRAVEL SMART	Travel club that offers reduced rates and concierge services
9	TRAVEL SMART BY DESIGN	Travel agency
10	TRAVEL SMART	Article with list of tips for travelers
11	TravelSmart	Article with list of financial tips for travelers
12	TravelSmart Woman	Online newsletter for solo women travelers
13	TravelSmart	Information about Georgia’s Department of Transportation.
14	CT Travel Smart	Interactive travel map for Connecticut drivers
15	TravelSmart	Travel information about mass transit for visitors to Vancouver
16	Travel Smart	List of travel tips for parents of small children
17	Travel Smart	Blog focused on accessible travel
18	TRAVEL SMART	Section of travel website devoted to practical travel tips

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<sup>1</sup> See generally 15 TTABVUE.

19	STUDY HARD TRAVEL SMART	A website with information about culturally immersive travel
20	Travel Safe – Travel Smart	Tips for successful travel in Europe
21	Travel Smart Plans	Travel insurance
22	8 Ways to Travel Smart This Summer	Article with travel tips
23	FGA Travel Smart	Program about environmentally sustainable travel
24	TravelSmart International	Information for travelers and travel policy of university
25	(duplicate of #1)	
26	Travel Smart With Amtrak’s Chief of Police	Travel tips for traveling by train
27	Travel Smart	Travel information and safety tips for university students
28	Travel Smart	Travel tips for traveling on a budget
29	TRAVEL SMART ESSENTIALS	Line of travel products and accessories
30	Travel Smart: A Holistic Approach to Jet Lag	Article with tips for overcoming jet lag
31	Travel Smart / TravelSmart	Collection of apps available for download through Google Play with TRAVEL SMART as part (or all) of the name
32	Travel Smart / TravelSmart	Collection of apps available for download though the App Store with TRAVEL SMART as part (or all) of the name

**D. The Word SMART Has a Recognized Meaning in the Context of Technology.**

Registrant has made of record seven dictionary definitions that define the word SMART in the context of technology:

1. Merriam-Webster.com;
2. YourDictionary.com;
3. Dictionary.com;
4. Chambers Dictionary of Science and Technology, Thirteenth Edition;
5. Webster’s New World College Dictionary, Fifth Edition;
6. The Merriam-Webster Dictionary, Sixth Edition
7. The American Heritage Dictionary of the English Language, Fifth Edition.

16 TTABVUE 6–42 (Registrant’s Second Notice of Reliance, Ex. Nos. 1–7). These definitions show that in the context of technology, SMART has a particular meaning. One of these definitions (Webster’s New

World College Dictionary) specifically refers to “navigation,” which Petitioner alleges is part of its TRAVELSMART app’s functionality. Petitioner’s Brief p. 6, 20 TTABVUE 16; 1 TTABVUE 4, ¶ 1.

**E. The Word SMART Is Commonly Used in Connection with Software and is Descriptive.**

Registrant has submitted copies of ninety-six active U.S. Trademark Registrations that cover computer software and that disclaim the word SMART.<sup>2</sup> Those registrations are:

Mark	Reg. No.	Goods (in part)	Mark	Reg No.	Goods (in part)
DOKA SMART POURING (Design)	6,050,383	downloadable computer software, for use on mobile devices	DS SMART	5,970,931	downloadable computer application software for mobile devices
CONTRACTOR’S SMART PRICE (Design)	5,856,457	downloadable mobile applications	MRCOOL SMART HVAC CONTROLLER	5,957,370	downloadable computer application software for mobile phones
SMART PLAY	6,056,194	computer application software for mobile devices, smart phones, tablet computers, and personal computers	TOP GREENER SIMPLE SMART SOLUTIONS	5,878,086	Downloadable mobile applications;
DS SMART	5,941,618	downloadable computer application software for mobile devices	ATOMI SMART (Design)	5,747,580	computer application software for mobile phones
YOYO SMART ERGONOMICS	5,864,839	mobile applications	YOYO SMART ERGONOMICS Stylized	6,055,396	downloadable software
SMARTPASS Design	5,711,613	computer application software for mobile phones	CE SMART	5,631,232	downloadable mobile applications
SMART PARENTING PLAY RHYMES	5,754,621	computer application software for mobile phones	AMP SMART	5,599,494	downloadable software
TORRES SMART WINE	5,870,364	software applications for mobile telephones	TEND SMART FARM	5,764,781	software for computers and mobile devices

<sup>2</sup> See generally 17 TTABVUE (Registrant’s Third Notice of Reliance, with Ex. Nos. 1–96).

SMART TANK TECHNOLOGY BY BLUE SKY Design	5,582,253	downloadable mobile application	KENMORE SMART	5,668,221	downloadable software in the nature of a mobile application
SMART SMILE	5,681,376	computer application software for mobile phones	TEOCO SMART HUB	5,509,677	computer application software for mobile phones
COYOTE SMART	5,488,735	downloadable software and application software for portable and mobile communication devices	SMART IMAGE Design	5,566,648	downloadable software applications
MVOW SMART TURBINE	5,624,614	computer application software in the form of apps for mobile phones and tablets	SMART EMBOSSING	5,612,645	computer software
SMARTAAC Design	5,578,076	computer application software for mobile phones	SMART CAMPO	5,399,255	computer software for mobile devices
SMART BODY SCALE Design	5,413,778	computer software for use with mobile devices	SMART READY TO Stylized	5,382,937	application software for mobile phones
SMART READY TO	5,366,744	application software for mobile phones	ERDA SMART	5,235,299	computer software for mobile phones
PRO TEK SMART	5,649,679	downloadable mobile applications and software	INNOVIC SMART	5,494,907	downloadable mobile applications for mobile phones
SAMSUNG SMART VIEW	5,332,580	computer application software for mobile devices	SMARTGRILL BY LYNX	5,312,423	downloadable software application for mobile devices
THE ONE SMART PIANO	5,179,446	computer application software for mobile devices	SMART INNOVIC Design	5,489,173	downloadable mobile applications for mobile phones
SMART AIR	5,273,820	computer application software for mobile phones	SMART BULLETIN	5,225,899	computer application software for smartphones

SMART GESTURE	5,313,836	computer application software for smart phones	SMART KITCHEN TV	5,033,396	computer application software for mobile smart phone
SMART QD	5,169,255	computer application software for mobile phones	SMART QUANTUM	5,577,915	computer software for mobile phones
SMART LINK	5,220,738	computer application software for mobile phones	SMART CROWN	5,126,779	application software for mobile phones
TT SMART MAPS	5,335,882	software application. . . for use on computers and mobile devices	SMART VIEW	5,258,584	computer application software for mobile phones and handheld computers
DRAFTLINE SMARTSYSTEM	5,043,847	computer program and downloadable mobile application	SMART BUTTON	5,028,406	downloadable computer application software
SMART HUMAN DYNAMICS	5,728,068	computer software for computers, mobile phones	MAXIMUS SMART SECURITY LIGHT Design	4,862,352	computer software, namely, mobile internet applications
S SMART CONNECT Design	4,925,277	downloadable computer software for mobile phones	SMART VINE	5,093,565	software for mobile phones
SMART eCONNECT	5,028,737	computer software and programs	SMART eBEHAVIOR	5,023,333	computer software and programs
SMART eMARKUP	5,028,738	computer software and programs	SMART MANAGER	4,897,394	computer software
SMART BEACON	4,755,230	software for enabling the mobile applications of others	SMART BEACON Design	4,754,950	software for enabling the mobile applications of others
MYLAN SMART INJECTION TRACKER	5,335,719	downloadable mobile applications	SMART VPO Design	4,711,246	computer application software



SMART + TV WEBOS Design	4,883,863	Computer software	SENSORSHIELD WIRELESS LOW ENERGY SMART SENSORS	4,771,424	downloadable computer software
SAMSUNG SMART ORGANIZER	4,710,907	downloadable computer software applications	SMART SUGGESTION	4,948,866	application software for mobile phones
BLUELINK SMART CONNECT	4,773,695	downloadable application software for use on a mobile device	MYCARELINK SMART	4,918,670	computer software that can be downloaded to a mobile device
SAMSUNG SMART HOME Design	4,853,536	Computer software	SMART CLINIC	4,660,951	the software for use on computers, hand-held computers and mobile phones
SMART YARD	4,938,550	computer application software for mobile phones	RICOH SMART DEVICE PRINT & SCAN	4,896,072	Application software
SAMSUNG SMART HOME	4,710,377	computer application software for mobile phones	SMART BOT	4,627,229	computer application software for mobile phones
SMART REMOVER	4,639,440	computer application software for mobile phones	CONTRACTOR'S CALL SMART Design	4,698,058	computer application software for mobile phones
LG SMART AD Design	4,677,283	computer application software for mobile phones	LG SMART MALL	4,639,373	computer application software for mobile phones
THE CONNECTED SMART CARD	4,507,931	Computer software	SMART webOS	4,642,718	computer application software for mobile phones
SAMSUNG SMART MEMORY	4,733,873	computer application software for mobile phones	SAMSUNG SMART SCROLL	4,726,030	computer application software for mobile devices
SAMSUNG SMART	4,562,281	computer application software for mobile phones	SMART HUB Design	4,784,067	computer software

HOME CONTROL Design					
SMART TUTOR Design	4,496,674	computer application software for mobile devices	SAMSUNG SMART SWITCH	4,509,005	computer application software for mobile phones
SMART MOBILE MARKETING FOR THE DIGITAL AG	4,544,015	computer application software for mobile phones	TECHSMITH SMART PLAYER	4,393,456	downloadable software for mobile devices
AHNLAB MOBILE SMART DEFENSE	4,478,523	downloadable computer software	SMART FORAGE	4,265,541	computer application software for mobile phones
SMART THINQ Design	4,541,392	computer application software for mobile phones	SMART STYLE	4,541,387	computer application software for mobile phones
SMART LIFE	5,860,285	software as a service (saas)	AMP SMART	5,599,496	software as a service (saas)

These registrations present overwhelming evidence that (a) the word SMART is commonly used in connection with software, and (b) the USPTO considers the word SMART to be descriptive in connection with software.

## ARGUMENT

### V. PETITIONER HAS FAILED TO PROVE STANDING

As an initial matter, Petitioner has not proven standing to petition to cancel the CHUBB TRAVEL SMART registration. Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 111 U.S.P.Q.2d 1058, 1062, 753 F.3d 1270 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 189, 670 F.2d 1024 (C.C.P.A. 1982). Although allegations in support of standing may be sufficient for *pleading* purposes, those allegations must be affirmatively *proved* by the plaintiff at trial. See *Boswell v. Mavety Media Grp. Ltd.*, 52 U.S.P.Q.2d 1600, 1605 (T.T.A.B. 1999) (at final decision, inquiry is not whether pleading of

standing is sufficient but whether allegations have been proven); *Lipton Indus. Inc.*, 213 U.S.P.Q. at 189 (“The facts regarding standing, we hold, are part of a petitioner’s case and must be affirmatively proved. Accordingly, appellee is not entitled to standing solely because of the allegations in its petition.”); *see also* TBMP § 309.03(b) (2020). In order to prove standing, Petitioner must demonstrate that it possesses a “real interest” in the proceeding and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco*, 111 U.S.P.Q.2d at 1062 (citing *Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023, 1025–26, 170 F.3d 1092 (Fed. Cir. 1999)). To prove a “real interest” in this case, Petitioner must show that it has a “direct and personal stake” in the outcome and that it is more than a “mere intermeddler.” *See Ritchie*, 50 U.S.P.Q.2d at 1026.

In its Petition to Cancel, Petitioner alleges its standing by pleading that it is the owner of trademark application Serial No. 87/901,868 for the mark TRAVELSMART for travel-related mobile apps.

1 TTABVUE 4, ¶ 1. In its trial brief, Petitioner maintains that it has standing because:

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 . . . 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.

Petitioner’s Brief p. 7, 20 TTABVUE 17. However, in order for Petitioner’s pleaded pending application to be received in evidence and made part of the record, Petitioner had to file a copy of its pleaded pending application showing the current status and title under a notice of reliance during its assigned testimony period. *See e.g.*, *Giersch v. Scripps Networks*, 90 U.S.P.Q.2d 1020, 1022 (T.T.A.B. 2009) (explaining that a pending application must be properly introduced before Board will rely upon application in determining plaintiff’s standing); *Demon Int’l LC v. Lynch*, 86 U.S.P.Q.2d 1058, 1060–61 (T.T.A.B. 2008) (dismissing opposition in its entirety where plaintiff did not submit proof of ownership

and the issuance of its asserted registration and thus had not satisfied its responsibility for proving its standing).

Here, Petitioner failed to submit a copy of its pleaded pending application showing the current status and title of the application during its assigned testimony period. Petitioner has merely presented *allegations* of standing with no direct proof or corroborating witness testimony regarding its pending application, the status thereof, or the alleged damage resulting from Registrant's mark. The printouts from the various websites submitted by Petitioner, absent testimony from a competent witness, are hearsay. They do not prove that Petitioner owns its pleaded mark, has sold or distributed products under that pleaded mark, or has any enforceable rights in the pleaded mark. As discussed below, Petitioner's internet evidence is only probative for what it shows on its face and not the truth of what is printed. See *Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q.2d 1458, 1467 n.30 (T.T.A.B. 2014) (holding that internet webpage evidence admissible only to show what has been printed and not for the truth of what has been printed); *Safer Inc. v. OMS Investments Inc.*, 94 U.S.P.Q.2d 1031, 1039 (T.T.A.B. 2010). Accordingly, Petitioner has failed to prove its standing and this cancellation proceeding should be dismissed.

#### **VI. PETITIONER HAS FAILED TO PROVE PRIORITY**

Petitioner has similarly failed to prove priority of use.

To prevail on a claim of likelihood of confusion under Section 2(d) of the Trademark Act based on a previously used mark, Petitioner must prove by a preponderance of the evidence both priority of use and likelihood of confusion. See *Life Zone Inc. v. Middleman Grp. Inc.*, 87 U.S.P.Q.2d 1953, 1959 (T.T.A.B. 2008). However, the only evidence submitted by Petitioner to demonstrate its priority of use is four pages of internet printouts submitted with a notice of reliance, accompanied by a blanket, unsupported

statement that “[i]t is undisputed that Petitioner commenced using its TRAVELSMART mark for its travel mobile app since early 2013.” Petitioner’s Brief p. 7, 20 TTABVue 17 (citing “TTABVue No. 11, p. 89–92”). As noted above, internet evidence is only admissible for what it shows on its face, and because it does not fall within an exception to the hearsay rule, it cannot be used to demonstrate priority of use absent testimony from a competent witness. See *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 U.S.P.Q.2d 1034, 1040–41 (T.T.A.B. 2018) (“[A]ssertions appearing in the printouts submitted by Opposer under notice of reliance cannot be used to demonstrate its priority without testimony corroborating the truth of this matter.”); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 U.S.P.Q.2d 1392, 1399 n.62 (T.T.A.B. 2016) (“We do not consider the statements made on the [opposer’s] website as establishing its prior use.”); *Coach/Braunsdorf Affinity, Inc.*, 110 U.S.P.Q.2d at 1467 n.30; *Life Zone*, 87 U.S.P.Q.2d at 1959 (dismissing opposition where opposer failed to establish its priority and noting “while this evidence shows that such a website exists, it is not evidence that opposer is using its mark on any goods or services displayed or discussed on the site”); see also TBMP § 704.08(b).

*WeaponX Performance* is particularly instructive. In *WeaponX Performance*, the opposer’s evidence for establishing priority consisted solely of internet printouts submitted under a notice of reliance with no accompanying testimony attesting to the truth of the matters contained in the notice. *WeaponX Performance*, 126 U.S.P.Q.2d at 1041. One of those internet printouts was a press release that stated “WeaponX Performance announced today that its revolutionary new spark plug is now available to consumers on its new Web site.” *Id.* The Board held that the press release was “not evidence of the truth of the matters stated in the press release” and therefore the opposer had not demonstrated it had priority and could not prevail on its claim of likelihood of confusion. *Id.*

Here too, Petitioner’s evidence for establishing priority consists solely of internet printouts, including a purported press release from its website with no accompanying testimony. Petitioner’s Brief p. 7, 20 TTABVUE 17 (citing “TTABVUE No. 11, p. 89–92”).

Notably, the only “evidence” Petitioner submitted that bears dates earlier than Registrant’s filing date of April 10, 2017, are:

- (i) what purports to be an article in IPMI Magazine bearing a date of May 7, 2013, titled “*Allianz Global Assistance Launches TravelSmart Mobile App.*” 11 TTABVUE 18–19;
- (ii) what purports to be an article from Business Insider bearing a date of June 26, 2016, titled “*Here are the safety tips you need to know if you’re planning to travel to Europe.*” *Id.* at 20–24;
- (iii) what purports to be an article from PropertyCasualty360.com bearing a date of January 19, 2016, titled “*16 of the coolest P&C insurer mobile apps.*” *Id.* at 26–30;
- (iv) what purports to be an article from the Richmond Times-Dispatch bearing a date of March 23, 2013, titled “*Travelers can find emergency medical information on smartphone app.*” *Id.* at 89–90; and
- (v) what purports to be an article from cision.com bearing a date of March 25, 2013, titled “*Allianz Global Assistance Launches TravelSmart Mobile App.*” *Id.* at 91–92.

All of these documents are third-party articles (or possibly re-printed press releases) that *refer to* Petitioner’s alleged product or alleged “launch.” However, Petitioner cannot rely on article printouts to show the date of first use of its alleged mark because there has been no corroborating testimony attesting to the **truth** of the matters contained within these internet printouts.<sup>3</sup>

The unreliability of this type of evidence without corroborating testimony is highlighted by the purported article submitted in Petitioner’s First Notice of Reliance at 11 TTABVUE 38–44, which bears a

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<sup>3</sup> For the avoidance of doubt, Registrant does not accept as fact any portion of the Internet evidence submitted by Petitioner under its Notices of Reliance.

date of November 19, 2018, and refers to the “New” TravelSmart app and says “Allianz Global Assistance has launched TravelSmart . . . .” So—did Petitioner’s alleged TravelSmart app launch in 2013, as it claims in its brief, or in 2018, as suggested by this article? Without any corroborating testimony it is impossible to know.

Further, any suggestion that Registrant has somehow conceded Petitioner’s priority is completely unsupported, and misses the point – it is not up to Registrant to dispute Petitioner’s priority, it is up to Petitioner to affirmatively prove it.

Accordingly, much like the opposer in *WeaponX Performance*, Petitioner has not demonstrated it has priority and therefore cannot prevail on its claim of likelihood of confusion. Therefore, this cancellation proceeding should be dismissed.

## **VII. PETITIONER HAS NOT ESTABLISHED LIKELIHOOD OF CONFUSION**

In light of Petitioner’s failure to prove its threshold requirements of both standing and priority, the Board need not reach the substantive issue of whether there is a likelihood of confusion between Petitioner’s alleged mark and Registrant’s Mark. *See, e.g., WeaponX at 1041:*

We add for completeness that a failure of proof also prevents Opposer from showing that there is a likelihood of confusion between Opposer's pleaded WEAPONX mark and Applicant's involved WEAPON X MOTORSPORTS mark. Opposer has not presented any evidence that it has sold any of its pleaded goods or rendered any of the pleaded services in its notice of opposition under its pleaded WEAPONX mark. We therefore cannot weigh the relationship of the parties' respective goods and services as well as other du Pont factors, i.e., similarities in trade channels and classes of purchasers, in order to determine if there is a likelihood of confusion. In view of the failure of Opposer to prove use (which in this case is the factual predicate for demonstrating the similarity of the parties' goods and services, channels of trade, and classes of purchasers), Opposer has failed to prove by a preponderance of the evidence there is a likelihood of confusion between its pleaded WEAPONX mark and Applicant's involved WEAPON X MOTORSPORTS mark.

Nonetheless, for completeness, Registrant demonstrates below why—even if Petitioner *had* established standing and priority—there is nonetheless no likelihood of confusion between Petitioner’s (alleged) mark and Registrant’s mark.

To prevail on a claim of likelihood of confusion under Section 2(d) of the Trademark Act based on a previously used mark, it is Petitioner’s burden to prove by a preponderance of the evidence both priority of use and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1848, 222 F.3d 943 (Fed. Cir. 2000); *Life Zone*, 87 U.S.P.Q.2d at 1959. For the reasons detailed in Sections V and VI, Petitioner has not proven it is the owner of its alleged mark, and has not demonstrated it has priority. Therefore, Petitioner *cannot* prevail on its claim of likelihood of confusion. And Petitioner cannot prevail for the additional reason that confusion is unlikely.

Whether a likelihood of confusion exists is a question of law, determined on a case-specific basis, applying the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567, 476 F.2d 1357 (C.C.P.A. 1973). Examination of each of the *du Pont* factors is not necessary to determine likelihood of confusion, and different factors may play a dominant role in determining likelihood of confusion depending on the evidence of each case. *Bose Corp. v. QSC Audio Prods., Inc.*, 63 U.S.P.Q.2d 1303, 1305, 293 F.3d 1367 (Fed. Cir. 2002) (citing *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456, 963 F.2d 350 (Fed. Cir. 1992)).

**A. Petitioner’s Alleged Mark Is Extremely Weak, Entitled to Only a Narrow Scope of Protection, and is Therefore Not Confusingly Similar to Registrant’s Mark, Which Contains the Distinctive Mark and Source Identifier CHUBB.**

Petitioner’s alleged mark is TRAVELSMART (one word). Registrant’s mark is CHUBB TRAVEL SMART (three words). Thus, the only common elements of the marks are the words “TRAVEL” and “SMART”—although in Petitioner’s case the two words are combined into one word. Both of these



words are entitled to very little, if any, protection when applied to either Petitioner's (alleged) goods. On the other hand, Registrant's mark contains its well-known and distinctive mark CHUBB. Thus, there can be no likelihood of confusion.

1. TRAVELSMART is Commercially Weak

Petitioner makes the wholly unfounded statement that TRAVELSMART is "inherently distinctive, has acquired at least niche fame, and is a strong mark." Petitioner's Brief p. 9, 20 TTABVUE 19. There is no evidence of record to support such a sweeping statement. And as detailed above, Petitioner has not submitted any admissible evidence of its use of or rights in TRAVELSMART, let alone evidence sufficient to establish that the alleged mark has "acquired at least niche fame."

In support of its contention that its alleged mark has acquired "niche fame" or is otherwise commercially strong, Petitioner cites printed publications it submitted as part of its First Notice of Reliance in the nature of:

- news articles / press releases to show that Petitioner's alleged app has "already been recognized by media and the public more than two years before Registrant" used its mark;
- apparent screenshots from the App Store and Google Play Store to show that Petitioner's alleged app has been downloaded "over 100,000 times and received approximately 1,200 ratings. . .";
- a 2019 Forbes.com article that refers to Petitioner's alleged app as "one of the best and most popular travel insurance apps with more than a total of 470,000 downloads."

Petitioner's Brief p. 12, 20 TTABVUE 22, citing 11 TTABVUE 18–19; 89–92, 11–14, 52–54. Even if this evidence were admissible for the truth of the matters asserted by Petitioner, it fails to come close to proving consumer recognition or renown, let alone "niche fame." To the contrary, this would not likely be sufficient to establish any kind of strength. *See, e.g., Top Tobacco, L.P. v. North Atlantic Operating*

*Co., Inc.*, 101 U.S.P.Q.2d 1163, 1173 (T.T.A.B. 2011), finding that CLASSIC CANADIAN in connection with tobacco was not commercially strong despite evidence of 20 years of use and “significant annual sales.” *Id.* Regardless, none of this evidence is admissible to show the facts they are offered for—Petitioner’s alleged priority, the number of times Petitioner’s app has been downloaded, or how good or popular the app is. See Section VI *infra*; F.R.E. Rule 802. Thus, the notion that Petitioner’s alleged TRAVELSMART mark has acquired “niche fame” or is in any way “commercially strong” is completely unsupported.<sup>4</sup>

And in fact, Registrant has submitted evidence that TRAVEL SMART / TRAVELSMART when used in connection with information, tips, and advice about travel is commercially *weak*.

TRAVEL SMART is very commonly used in connection with providing tips and information about travel—which is the alleged function of Petitioner’s app. Registrant has submitted evidence of over 30 third party uses of TRAVEL SMART in connection with travel tips and information. See *generally* 15 TTABVue. As the Court of Appeals for the Federal Circuit has noted:

[S]ufficient evidence of third party use of similar marks can show that customers . . . have been educated to distinguish between different marks on the basis of minute distinctions. More broadly, evidence of third party use bears on the strength or weakness of an opposer’s mark. The weaker [a senior user’s] mark, the closer [a junior user] can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.

*Juice Generation v. GS Enterprises LLC*, 115 U.S.P.Q.2d 1672, 1674, 794 F.3d 1334 (Fed. Cir. 2015) (internal quotes and citations omitted). In *Juice Generation*, the court found that the TTAB had discounted the evidence of third party use presented by the applicant because it was not accompanied by details of sales, promotional activities, etc. *Id.* at 1674–75. The Federal Circuit explained that it was improper for the TTAB to disregard this evidence on this basis, finding that the evidence submitted was

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<sup>4</sup> Again, for the avoidance of doubt, Registrant does not accept as fact any portion of the Internet evidence submitted by Petitioner under its Notices of Reliance.

“powerful on its face” even though the specific extent and impact of the use has not been established. *Id.* at 1674.

The CAFC also considered evidence of third-party use in the form of web sites in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d 1129, 1135–36, 797 F.3d 1363 (Fed. Cir. 2015). In *Jack Wolfskin*, as here, the Applicant submitted as evidence web printouts showing 28 third party uses of the paw print mark at issue. *See* Opp. No. 91195604, 52–53 TTABVue, Ex. A–BB. As with *Juice Generation*, the Board did not consider this evidence because, in the Board’s view, it did not constitute evidence that the marks were actually in use. *Jack Wolfskin*, 116 U.S.P.Q.2d at 1136. And again on appeal, the CAFC held that the Board was too quick to dismiss the significance of this evidence. *Id.*

The co-existence of these third-party uses makes confusion unlikely. *See, e.g., Moose Creek Inc. v. Abercrombie & Fitch Co.*, 73 U.S.P.Q.2d 1287, 331 F. Supp. 2d 1214 (C.D. Cal. 2004), *aff’d*, 114 F. App’x 921 (9th Cir. 2004), in which the defendant—like Registrant here—had “proffered substantial evidence, in the form of internet advertisements, that demonstrates that many retailers are selling clothing” bearing a mark similar to the plaintiff’s. 73 U.S.P.Q.2d at 1294. The court concluded:

Regardless of whether the owners of these clothing companies . . . [use the design] as a trademark or as an ornamental design, the point is that members of the public (who would include Plaintiff’s customers) have likely seen a picture of a realistic-looking moose on many different brands of clothing, and thus are not likely to associate [one of defendant’s products] containing a picture of a moose exclusively with Plaintiff’s Moose Creek clothing brand.

*Id.* Similarly, whether the multiple users of the phrase “Travel Smart” or “TravelSmart” identified in Registrant’s Notice of Reliance use the term “as a trademark” or simply as a term that describes their content or offering, the point is that members of the public who are looking for practical tips and information about travel have likely encountered this term in multiple contexts, from multiple sources.

2. Travel Smart is Inherently Weak

Petitioner also claims that its alleged mark is “inherently distinctive”—although in the process of making that argument Petitioner essentially concedes that it is not. Clearly, the word TRAVEL in the context of Petitioner’s alleged use is highly descriptive or generic. For this reason, Petitioner argues that SMART is not descriptive, and that therefore the combined term TRAVELSMART is inherently distinctive.

Petitioner’s alleged goods consist of a “mobile application.” Petitioner’s Brief p. 18, 20 TTABVue 28. In the context of certain technologies, “smart” has a descriptive meaning. As shown in Registrant’s Second Notice of Reliance, numerous dictionaries define SMART in a technology context. *See generally* 16 TTABVue. For example, some definitions of SMART include:

- Merriam-Webster: “operating by automation” or “using a built-in microprocessor for automatic operation, for processing of data, or for achieving greater versatility.” *Id.* at Ex. No. 1;
- Webster’s New World: “programmed in advance with certain features, as navigation information or sensing and self-correcting functions.” *Id.* at Ex. No. 5; and
- American Heritage: “capable of making adjustments that resemble those resulting from human decisions, chiefly by means of electronic sensors and computer technology.” *Id.* at Ex. No. 7.

Petitioner attempts to dismiss these definitions by arguing that SMART does not “directly identify or describe” a characteristic or quality of its alleged app, but in doing so Petitioner states:

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; 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.**

Petitioner’s Brief 10 – 11, 20 TTABVUE 20–21 (emphasis added). Through its own arguments, Petitioner has admitted that SMART describes a characteristic, quality, or ingredient of its alleged smartphone app. Further, the Webster’s definition cited above specifically refers to “navigation information”, and the Petitioner has specifically alleged that its TRAVELSMART app includes “geolocation” functionality. Petitioner’s Brief p. 6, 20 TTABVUE 16; Petition to Cancel p. 2, ¶ 1, 1 TTABVUE 4, ¶ 1.

Even if SMART does not describe a characteristic, quality, or ingredient of Petitioner’s alleged smartphone app, it is certainly “laudatory” and thus falls into the descriptive category. See TMEP § 1209.03(k).

When making its argument that SMART is not descriptive and that therefore TRAVELSMART is inherently distinctive, Petitioner does not mention the *ninety-six* U.S. registrations that cover software in which SMART is disclaimed. See 17 TTABVUE. These registrations show that the USPTO and TTAB have repeatedly determined that SMART is descriptive when used in connection with software, especially software used on mobile devices.

The Board may rely upon these registrations as evidence that SMART is descriptive in connection with software. See *Truescents LLC v. Ride Skin Care, LLC*, 81 U.S.P.Q.2d 1334, 1341 (T.T.A.B. 2006) (finding that evidence comprised of 46 third-party registrations in which the term “GENUINE” appeared and was disclaimed helped prove that “genuine” has a laudatory and descriptive meaning); *In re Monsalvat Farm Holdings LLC*, 2020 TTAB LEXIS 245, \*18–19 (T.T.A.B. May 29, 2020) (finding that evidence of 25 third-party registrations disclaiming “FARM” was “admissible and competent to negate a claim of exclusive rights in [a term] and the disclaimers are evidence, albeit not conclusive, of descriptiveness of the [disclaimed] term”); *Manhattan Int’l Trade Inc. v. Industrie IP Pty Ltd.*, 2018 TTAB LEXIS 164, \*24–25 (T.T.A.B. May 11, 2018) (“[O]ut of the total of 83 Principal and Supplemental Register registrations

identified herein, 60 include disclaimers of INDUSTRY or INDUSTRIES, also evidencing that these terms have been considered non-distinctive.”).

Further, evidence of third party registrations is admissible to show that consumers have become conditioned to seeing a word used by a variety of different users. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11.86 (5th ed. 2020). Professor McCarthy has summarized the plethora of decisions in this area as follows:

Marks like ACME and NATIONAL, which are in common use by many sellers, are not entitled to the same scope of protection as strong marks . . . So also, commonly used marks as ROYAL, BLUE RIBBON, GOLD MEDAL, PREMIUM, ADVANTAGE, CHAMPION, EUREKA, IDEAL, JEWEL, PREMIER, STAR, etc. etc. are of the regarded as relatively “weak” marks and given a relatively narrow scope of protection against alleged infringement. Of course, such decisions implicitly recognize that it is difficult to build up strong secondary meaning in commonplace “laudatory” marks that many sellers use.

*Id.* (citing *National Cable Television Ass’n v. American Cinema Editors, Inc.*, 937 F.2d 1572 (Fed. Cir. 1991)).

The dictionary definitions and the 96 third party registrations covering software that disclaim the word SMART constitute overwhelming evidence that SMART is inherently weak when used in connection with software.

Therefore Petitioner’s alleged mark consists of a possibly generic and definitely descriptive word (TRAVEL) combined with a descriptive (or at most inherently weak) word (SMART). TRAVELSMART / TRAVEL SMART is therefore inherently weak, in addition to being commercially weak. Consequently it is entitled to an exceedingly narrow scope of protection, and the presence of Registrant’s strong and distinctive mark CHUBB is significant.

(a) The Addition of CHUBB Is Sufficient to Distinguish the Marks

Petitioner argues that the addition of Registrant’s house mark CHUBB “causes direct confusion and reverse confusion.” Petitioner’s Brief p. 14, 20 TTABVUE 24.

(i) The Addition of A House Mark Will Distinguish Marks that are Otherwise Descriptive and/or Weak.

Petitioner begins its argument by acknowledging that when “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.” Petitioner’s Brief 7, 20 TTABVUE 17 (emphasis in original). That is exactly the case here. As detailed above, Petitioner’s alleged mark is merely descriptive and extremely weak—both inherently and commercially. Thus, the addition of Registrant’s distinctive mark CHUBB renders the marks dissimilar enough to avoid confusion.

Petitioner’s entire argument that the presence of CHUBB in Registrant’s mark does not obviate a likelihood of confusion misses the mark as it is dependent upon Petitioner’s alleged mark being “inherently distinctive, and not merely descriptive or weak[.]” *Id.* The only example relied upon by Petitioner for its argument that the presence of CHUBB does not sufficiently distinguish the marks is *In Re Int’l Intimates Inc.*, 2011 WL 5873329 (T.T.A.B. Nov. 3, 2011). At issue in that decision was the mark KISS KISS INTERNATIONAL INTIMATES, which the Board held was confusingly similar to QISS QISS despite the addition of INTERNATIONAL INTIMATES. *Id.* at \*5. This decision is completely inapplicable to the current matter. The Board in *In Re Int’l Intimates* came to the unremarkable conclusion that KISS KISS (or its phonetic equivalent) is not weak in connection with clothing goods. *Id.* at \*4. Unlike TRAVELSMART, KISS KISS is truly inherently distinctive—it bears no relationship to clothing. Thus, the Board noted that the general rule that “the addition of a house mark **to inherently distinctive** matter

does not obviate likely confusion” applied. *Id.* (emphasis added). TRAVELSMART is simply not inherently distinctive.

The current situation is more akin to that faced by the Board in *Knight Textile Corp. v. Jones Investment Co.*, 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005), in which the Board held that NORTON MCNAUGHTON ESSENTIALS was not likely to cause confusion with the opposer’s registered mark ESSENTIALS, both for women’s clothing. The Board found that “although the word ESSENTIALS is the entirety of the commercial impression created by opposer's mark, in applicant's mark it contributes relatively less to the mark's commercial impression than does the house mark NORTON MCNAUGHTON,” because ESSENTIALS was “highly suggestive” as applied to clothing items. *Id.* at 1315. The Board determined that ESSENTIALS was “highly suggestive” due to its presence in various other clothing marks, as well as dictionary definitions. *Id.* at 1316. Similarly, in *MarCon, Ltd. v. Avon Prods., Inc.*, 4 U.S.P.Q.2d 1474 (T.T.A.B. 1987), the presence of the house mark AVON was sufficient to distinguish SILK from AVON SILKEN SOAP, in light of the suggestive nature of SILKEN and SILK in connection with soap and hair and skin care products. *Id.* at 1476. Here, TRAVELSMART does not even rise to the level of “suggestive.” It does not require any sort of “mental leap” to think that something called TRAVEL SMART is going to provide useful information relating to travel.

(ii) Petitioner Has Not Made A Case for Reverse Confusion.

Petitioner also argues that Registrant’s use of CHUBB is likely to cause “reverse confusion”— although again Petitioner acknowledges that its argument hinges on Petitioner’s alleged mark being “distinctive.” Petitioner’s Brief 16, 20 TTABVUE 26. Therefore, as a threshold matter, this argument fails for all the reasons set forth above.



Further, Petitioner’s “reverse confusion” argument relies on a variety of unsupported factual statements about the size and market share of Registrant, the time frame during which Petitioner and Registrant began using their marks, Registrant’s “extensive use”, and how Petitioner was once the “sole leader in the market” and no longer is because Registrant has “saturate[d] the market.” See Petitioner’s Brief p. 16 – 17, 20 TTABVUE 26–27. All of these factual statements suffer from the same evidentiary deficiencies as Petitioner’s priority claim, as detailed in Section VI above. Therefore, Petitioner’s argument of reverse confusion has no basis.

Ultimately, a finding of “reverse confusion” relies on a finding of a likelihood of confusion. For example, in *Top Tobacco, L.P.*, the Board stated:

On the record before us, we find that reverse confusion is not any more likely than “forward” confusion or that the relevant facts are such that our likelihood of confusion analysis requires any adaptation. In particular, it has not been shown that [Applicant] is a ‘significantly larger or prominent newcomer’ who has ‘saturated the market’ with its [product]. Accordingly, [Opposer’s] arguments concerning reverse confusion do not compel any change in our ultimate determination regarding likelihood of confusion between the parties’ marks.

101 U.S.P.Q.2d at 1175. Similarly, here it has not been shown that Registrant is a ‘significantly larger or prominent newcomer’ who has ‘saturated the market’ for all the evidentiary deficiencies discussed above. So the bottom line remains that “reverse confusion” is no more likely than “forward confusion”, and does not change the analysis.

(b) Petitioner’s Argument that Confusion is Likely Because the “Entirety” of its Alleged Mark is Encompassed in Petitioner’s Mark Fails Given the Weakness of the Mark

Petitioner argues that confusion is likely here because “The [TTAB] has consistently held that there exists a likelihood of confusion when the *entirety* of one mark is incorporated within another.” Petitioner’s Brief p. 13, 20 TTABVUE 23. Once again, this argument loses steam when the weak and

descriptive nature of Petitioner’s mark is considered. Indeed, the very authority relied on by Petitioner makes this point: In *Perfumebay.com Inc. v. eBay Inc.*, 84 U.S.P.Q.2d 1865, 506 F.3d 1165 (9th Cir. 2007) the Ninth Circuit repeatedly notes that eBay’s mark was strong, as noted even by Petitioner in its Trial Brief: “*Perfumebay.com* . . . 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 . . . .” Petitioner’s Brief p. 14, 20 TTABVUE 24.<sup>5</sup> The court in *Perfumebay.com* repeatedly emphasizes this. *See id.* at 1871 (“[T]he application refers to ‘perfumebay.com’ and ‘Perfume-Bay’, both of which completely incorporate eBay’s **strong** mark”; “Although differences exist between the two marks, the fact that eBay’s mark **is a strong one** weighs against Perfumebay”) (emphases added). Similarly, in *In Re Lion Capital LLP*, 2013 WL 2329834 (Jan. 18, 2013), a non-precedential decision relied on by Petitioner, the Board cites to *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) for the proposition that “the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.” *Id.* at \*8 (internal cites and quotations omitted). And in *In Re West-Com Nurse Call. Sys., Inc.*, 2017 TTAB LEXIS 426, \*8 (T.T.A.B. Nov. 14, 2017), another non-precedential decision relied upon by Petitioner, the Board similarly notes that “additions or deletions to marks may be sufficient to avoid a likelihood of confusion if . . . the matter common to the marks is . . . merely descriptive or diluted.” *Id.* (quoting Trademark Manual of Examining Procedure § 1207.01(b)(iii)). Unlike here, in that case there was “no evidence” that the shared term was descriptive or diluted. *Id.*

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<sup>5</sup> Petitioner incorrectly refers to *Perfumebay.com* as an opinion of the Court of Appeals for the Federal Circuit in this section of its Brief; it is an opinion of the Ninth Circuit.

In sum, Petitioner’s alleged mark TRAVELSMART is both commercially and inherently weak. Thus, it is entitled to an extremely narrow scope of protection—assuming it is entitled to any protection at all. Therefore Registrant’s use of TRAVEL SMART as two words instead of one following the distinctive word CHUBB is more than sufficient to negate any likelihood of confusion.

**B. There is No Evidence Relating to the Remaining DuPont Factors.**

In its Brief, Petitioner also argues that “[t]he parties’ goods are similar and in part identical,” and “Petitioner’s and Registrant’s goods travel through identical trade channels.” Petitioner’s Brief pp. 17, 19 – 20, 20 TTABVue 27, 29–30.

But there is no evidence in the record that establishes Petitioner’s goods or its trade channels. As detailed in Section V, Petitioner’s application is not of record, so any identification of goods and services, and any channels of trade restriction (or lack thereof) is not of record. Further, as detailed in Section VI, there is no admissible evidence in the record that establishes Petitioner’s actual use of its alleged mark, so there is no evidence of what its actual goods or its actual channels of trade are.

Thus there is no basis on which to evaluate remaining *du Pont* factors. A single *du Pont* factor can be dispositive, including the similarity of the marks. *See Top Tobacco L.P.*, 101 U.S.P.Q.2d at 1175 (“[W]e find that . . . ZIG ZAG CLASSIC AMERICAN BLEND is sufficiently dissimilar from . . . CLASSIC CANADIAN to make confusion unlikely and that this *du Pont* factor is dispositive.”); *Kellogg Co. v. Pack’em Enters.*, 21 U.S.P.Q.2d 1142, 1145, 951 F.2d 330, 333 (Fed. Cir. 1991) (“[W]e know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.”). In this case, given that there is no basis on which to evaluate any factors, the dissimilarity of the marks should be dispositive.

### **VIII. PETITIONER IS NOT ENTITLED TO TIP THE BALANCE IN ITS FAVOR**

Petitioner argues that “all doubts” in trademark cases should be resolved in favor of the senior user, and that therefore “any doubt regarding the likelihood of confusion between the TRAVELSMART and CHUBB TRAVEL SMART marks should be resolved in favor of the Petitioner.” Petitioner’s Brief p. 20, 20 TTABVue 30.

As detailed in Sections V and VI, the Board should not even reach the issue of likelihood of confusion. But if it *were* evaluating likelihood of confusion, it is worth noting that the notion that doubts should be resolved in favor of the senior user is not a presumption, nor is it evidence. Rather, it is a “tie-breaking rule.” See *Olde Tyme Foods, Inc. v. Roundy’s Inc.*, 22 U.S.P.Q.2d 1542, 1547, 961 F.2d 200, 205 (Fed. Cir. 1992) (“[T]his tie-breaking rule is not a presumption or a substitute for evidence.”). Petitioner still carries the burden of establishing likelihood of confusion, and it has failed to meet that burden. And this case is certainly not a “tie” that should therefore tip in favor of Petitioner (who has not even established that it is the senior user). Rather, this is a case where there is “no serious doubt,” and thus “that rule has no application.” *Bullova Watch Co., Inc. v. Miller*, 463 F.2d 1376, 1377 (C.C.P.A. 1972).

### **CONCLUSION**

Petitioner has failed to present evidence establishing standing to bring this Cancellation, and on that basis alone this Cancellation should be dismissed. Beyond that, Petitioner has failed to establish, that it has priority over Registrant, and on that basis this cancellation must also fail. Furthermore, even if *arguendo* Petitioner’s claims had successfully established standing and priority (which it did not), there is no evidence that there is a likelihood of confusion between Petitioner’s mark and Registrant’s alleged mark. Therefore Registrant asserts that the Cancellation should be dismissed.

Respectfully submitted,

CHUBB INA HOLDINGS INC.  
By its Attorneys



Date: January 14, 2021

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the Registrant's Trial Brief was served on  
Petitioner by forwarding a copy on January 14, 2021, via email to:

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