Paper No. 10
HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 8/7/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Convenant Insurance Company[1]

Serial No. 75/301,531

Gene S. Winter of St. Onge Steward Johnston & Reens LLC for applicant.

Linda M. King, Trademark Examining Attorney, Law Office 101 (Christopher Wells, Managing Attorney).

Before Simms, Walters and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Convenant Insurance Company filed an application to register the mark shown below for "commercial and personal

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[1] Applicant was identified in the original application as Convenant Insurance Company. The specimens of record show use of the name Covenant Insurance Company. Applicant in its papers filed in the Office has referred to itself first as Covenant Insurance Company and more recently as The Covenant Group, Inc. As pointed out by the Examining Attorney, there has been no assignment made of record in the Office to this latter entity. Furthermore, although not previously raised, there is no indication in the record that applicant's name was misspelled in the original application. Accordingly, for our purposes the applicant remains Convenant Insurance Company.

property and casualty insurance and reinsurance brokerage, administration and indemnity services."[2]

Registration has been finally refused under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion with the mark shown below, which is registered for "worker's compensation medical and disability case management services."[3]

Applicant and the Examining Attorney have filed

[2] Serial No. 75/301,531, filed June 2, 1997, claiming a first use date and first use in commerce date of April 1997.
[3] Registration No. 2,002,964, issued September 24, 1996. Disclaimers have been made of the terms EMPLOYER, EMPLOYEE, PHYSICIAN, EARLY INTERVENTION, QUALITY CARE and RETURN TO WORK.

briefs,[4] but no oral hearing was requested.

Here, as in any determination of likelihood of confusion, two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Looking first to the respective marks, the Examining Attorney maintains that the term TEAMWORKS is the dominant feature in both applicant's and registrant's marks; that the descriptive, disclaimed matter in registrant's mark adds little to the commercial impression of the mark; that the design features of the marks are less significant and in fact are very similar; and that the term ADVANTAGE in registrant's mark is less significant than the term TEAMWORKS, since it directly refers to TEAMWORKS.

Applicant contends that the marks differ in sound, appearance and overall connotation. Applicant argues that

[4] As pointed out by applicant in its brief, the Examining Attorney incorrectly identified the refusal as being under Section 2(e)(1) in the final refusal, although arguing the issue of likelihood of confusion. Applicant proceeded on the basis that the refusal was under Section 2(d), as did the Examining Attorney in her brief. Although the Examining Attorney should have corrected her error, we find that applicant has continually treated the refusal as one under Section 2(d) and thus has in no way been deprived of a full opportunity to present its case.

the mere fact that the two marks share a word in common is not determinative; that while TEAMWORKS is the only term in its mark, TEAMWORKS is but a small portion of registrant's mark. Applicant points out that the words THE and ADVANTAGE are of equal size and lettering as TEAMWORKS and that there are also other phrases in registrant's mark, all of which applicant insists results in a different commercial impression from applicant's mark. Applicant asserts that registrant's mark is highly suggestive of its services and accordingly must be treated as a weak mark for purposes of determining consumers' ability to distinguish between the two marks.

While it is true that marks must be considered in their entireties in determining likelihood of confusion, it is also well established that there is nothing improper in giving more or less weight to a particular portion of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although disclaimed matter cannot be ignored, the fact remains that purchasers are more likely to rely on the non-descriptive portions of the mark as the indication of source. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

In the present case, we consider the disclaimed phrases in registrant's mark, i.e., EARLY INTERVENTION, QUALITY CARE and RETURN TO WORK, to have minimal significance as an indication of source. However, contrary to applicant's argument that the entire mark is highly suggestive of registrant's services, we see no reason to conclude that the TEAMWORKS ADVANTAGE portion of registrant's mark is any less distinctive than the TEAMWORKS portion of applicant's mark. Applicant has made no evidence of record of any third-party use of the term TEAMWORKS in marks for similar services, that might support its assertion that registrant's mark as a whole is weak and that purchasers would readily distinguish between the two marks, despite the presence of the common word TEAMWORKS.

Instead, we agree with the Examining Attorney that the overall commercial impressions created by the respective marks are very similar. The dominant portion of applicant's mark is TEAMWORKS. The dominant portion of registrant's mark as a indication of source is THE TEAMWORKS ADVANTAGE, the additional matter being descriptive of the services. In the absence of any evidence of the use of the term TEAMWORKS by others in the field, we find it reasonable to assume that purchasers might well view THE TEAMWORKS ADVANTAGE simply as an

embellishment of the TEAMWORKS mark or TEAMWORKS as a shortened form of THE TEAMWORKS ADVANTAGE, both being used by the same source. Furthermore, although design portions of marks are normally assigned to a lesser status, the word portion usually being relied upon in referring to the goods or services, we believe that here the common use of arrow designs in the two marks significantly heightens the similarity of the general overall impressions created by the marks.

As for the respective services, the Examining Attorney maintains that the insurance services of applicant and registrant are closely related. She has made third-party registrations of record to support her contentions that that a significant number of insurance companies offer both worker's compensation insurance, personal property insurance and casualty insurance under the same mark and that several companies focus exclusively on these areas. She also relies upon these registrations to show that administration and management of insurance is directly related to underwriting and that consumers are accustomed to the same sources providing both aspects of insurance services. In addition, she has made of record a dictionary definition of "administration" as "management" to support

her argument that applicant's "administration" services encompass registrant's "management" services.

Applicant insists that there is no overlap in the services; that its services relate to insurance and the insuring process and no case management is involved. Applicant further argues that the channels of trade are distinct for the respective services, stating that its insurance services are offered directly to consumers whereas registrant's services are directed to employers for case management.

We find the third-party registrations made of record by the Examining Attorney fully adequate to establish that a number of insurance companies offer underwriting services in the fields of both property and casualty insurance and worker's compensation under the same mark.[5] Although these registrations are admittedly not evidence of actual use of the marks, they are sufficient to suggest that these various types of insurance services may be offered by a single entity. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988). Similarly, we find the third-party registrations adequate to show that the insurance

[5] We refer to the specific examples pointed out by the Examining Attorney in her brief.

services offered by these companies often cover a broad spectrum, including, inter alia, underwriting, administration and claims management and adjustment services. Accordingly, we concur with the Examining Attorney that the services of applicant, which include not just brokerage, but also administration and indemnity services, might well be presumed by potential purchasers to emanate from the same source as registrant's worker's compensation case management services, when offered under a mark similar to registrant's mark.

Applicant's argument that the channels of trade differ for the services of applicant and registrant is to no avail. Applicant has placed no restrictions on the channels of trade for its services in its application and thus the channels of trade must be presumed to encompass all the normal ones for services of this nature. See Kangol Ltd. v. KangaROOS U.S.A., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). We find no basis in the identification of services for limiting the offering of applicant's insurance services to individual consumers, rather than also to companies for their employees. In fact, as pointed out by the Examining Attorney, the specimens of record show that applicant's services are specifically marketed to employers so that these insurance

services may be offered to their employees as company benefits.

Accordingly, in view of the similar commercial impressions created by the respective marks and the related nature of insurance services with which they are being used, we find confusion likely.

Decision: The refusal to register under Section 2(d) is affirmed.

R. L. Simms

C. E. Walters

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board