

Mailing:
April 20, 2005

This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allianz Life Insurance Company of North America¹

Serial No. 75627987

Eric D. Paulsrud of Leonard, Street and Deinard for Allianz
Life Insurance Company of North America.²

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(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

A predecessor in interest to Allianz Life Insurance
Company of North America [applicant] applied to register
ACCUMULATOR BONUS MAXXX as a mark on the Principal Register

¹ The merger of Life USA Holding, Inc. and LifeUSA Insurance Company is recorded in USPTO assignment records at Reel 2147, Frame 0710. Assignment of the application from LifeUSA Insurance Company to Allianz is recorded at Reel 2194, Frame 0436.

² Mr. Paulsrud had two predecessors from other law firms. He filed the reply brief; prior counsel prosecuted the application and filed applicant's other briefs.

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for services ultimately identified as "insurance services, namely, insurance underwriting, claims processing, claims administration, consultation and brokerage in the field of life insurance and annuities," in Class 36. Applicant asserts first use of the mark and first use of the mark in commerce since September 1, 1998. During prosecution, applicant agreed to entry of a disclaimer of BONUS.

Applicant was informed by the first office action, issued by a predecessor of the current examining attorney, that there was an earlier-filed application to register BONUS MAX for "annuity underwriting services" by Jackson National Life Insurance Company, and that if such mark eventually was registered, it would potentially conflict with applicant's application and might result in a refusal of registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In fact, when the current examining attorney was assigned the application, the earlier-filed application had already resulted in issuance of a registration and that registration was therefore cited in support of a refusal under Section 2(d).

When the refusal of registration was made final, applicant appealed and filed a request for reconsideration. The Board acknowledged the appeal and the application was returned to the examining attorney for review of the

request for reconsideration, which was denied. The appeal was resumed. Applicant retained new counsel and the Board approved a request by counsel for an extension of time to file applicant's brief. Applicant subsequently filed a brief with an alternative request for remand to consider additional evidence submitted by new counsel. The Board granted this request and remanded the application to the examining attorney. Nonetheless, the examining attorney maintained the refusal of registration. The Board then resumed the appeal and allowed applicant time to file a supplemental appeal brief.

When applicant filed its supplemental appeal brief, it again requested, in the alternative, a suspension of the appeal and a remand for consideration of additional evidence. The Board denied this request for suspension and set the time for the examining attorney to file an appeal brief in response to applicant's briefs. After the examining attorney's brief was filed, applicant requested suspension of the appeal pending final disposition of applicant's co-pending application to register ACCUMULATOR as a mark for services very nearly the same as those involved in the application now before us.³ The Board

³ The application to register the ACCUMULATOR mark had been suspended pending applicant's pursuit of cancellation proceedings

granted that suspension, but later resumed this appeal after applicant's co-pending application resulted in issuance of a registration for the ACCUMULATOR mark.

The resumption order set a deadline for applicant's reply brief, which deadline applicant's newest counsel met. The examining attorney was provided with a copy of the reply brief but it did not persuade her to withdraw the refusal. Applicant did not request an oral hearing.

In essence, evidence bearing on the significance of the term ACCUMULATOR in applicant's mark includes: dictionary definitions of "accumulator" and "accumulate"; a dozen or so registrations for marks including the term "accumulator";⁴ a dozen or so excerpts retrieved from the NEXIS database that employ the term "accumulator"; reprints from three Internet web sites that use that term; a photocopy of a response by applicant to an office action issued by the examining attorney in regard to applicant's co-pending application to register ACCUMULATOR as a mark on the Principal Register for services virtually identical to those in the instant application to register ACCUMULATOR

against two registrations that had been cited against that application. Those cases were resolved in applicant's favor.

⁴ Many of these registrations have been put into the record more than once, and both the examining attorney and applicant claim they support their respective positions.

BONUS MAXXX;⁵ and a declaration from an officer of applicant providing information on applicant's ACCUMULATOR line of products and including an assertion that the declarant is not aware of any instances of actual confusion involving applicant's mark and the mark in the cited registration. Evidence bearing on the significance of BONUS and MAX/MAXXX includes: reprints of the results of certain searches conducted by applicant in the USPTO's TESS database for marks containing either BONUS or MAX; reprints of eight registrations that include the term BONUS; and a photocopy of a specimen of use of BONUS MAX by the owner of the cited registration, which applicant asserts was filed by the registrant to support the application that resulted in issuance of its registration.

Applicant, with one of its requests for suspension and introduction of additional evidence -- the request that the Board granted -- submitted lists of marks retrieved from a commercial database. The examining attorney accepted all the other evidence attached to that request for remand, but objected to the lists of database search results. We agree that the objection was appropriate and have not considered those lists. Mere listings of registrations, or copies of

⁵ That response is supported by exhibits, including a declaration from an officer of applicant's predecessor in interest.

private company search reports, are not sufficient to make the registrations of record. In re Dos Padres Inc., 49 USPQ2d 1860, n. 2 (TTAB 1998); In re Broadway Chicken Inc., 38 USPQ2d 1559, n. 6 (TTAB 1996). See also, Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). In a subsequent request for suspension of the appeal and remand -- a request the Board denied -- applicant attempted to introduce proper copies of the registrations covered by the database lists. Because the Board denied that request for suspension and remand, the evidence attached thereto is not part of the record and has not been considered.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also, In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities or dissimilarities of the marks and the similarities or dissimilarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of

differences in the essential characteristics of the goods [and services] and differences in the marks").

We consider first the services, for there is less disagreement about this factor than there is as to the marks. In the final refusal, the examining attorney noted that applicant had not, to that point, presented any arguments on the question whether the services are related. In support of the final refusal, the examining attorney put into the record registrations showing the relatedness of applicant's and registrant's services. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) (Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source); In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1469 (TTAB 1988), aff'd in unpublished opinion 88-1444 (Fed. Cir. 11/14/1988). In an office action issued in response to the remand applicant obtained when it filed its main brief (and alternatively requested suspension of the appeal and remand), the examining attorney asserts that the services are in part identical because "both parties underwrite annuities." This is not technically correct, insofar as registrant's identification covers underwriting of

annuities but the only underwriting identified in applicant's application is underwriting of insurance; and the only reference to annuities in applicant's identification is in the reference to "consultation and brokerage in the field of life insurance and annuities." Nonetheless, the record is clear that annuities can be packaged with "universal" or "whole life" life insurance and there can be no genuine disagreement that the services are related, even if they may not overlap.⁶

While applicant does not argue that the services are unrelated, it does argue that insurance services are "generally sold through agents" and the sources of various insurance/annuity products would be part of any presentation by agents of a customer's options. The examining attorney argues in response that "many insurance and annuity purchasers research their options on their own at first instead of using an insurance agent," and it is likely such purchasers would be confused by the respective marks. We cannot accept either argument.

There are no restrictions in applicant's identification of services, so we must consider that it can

⁶ From the specimens in applicant's application and the specimen copied from the application that resulted in the cited registration, it appears likely that the applicant and registrant do offer competing insurance products or services. Our focus, however, in the discussion above, is on the identifications.

market its insurance or annuity services through direct sales as well as through agents. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). Thus, we cannot assume that prospective purchasers would always receive a presentation of options by an agent who would carefully delineate the sources of competing services. Also, there is nothing in the record to support the examining attorney's assertion that consumers who obtain insurance or annuity services through agents routinely research options on their own prior to consulting with an agent.

The record reveals that sale of the involved services is a regulated industry, with service availability varying by state. It is also clear that we are not dealing with off-the-shelf or inexpensive products that may be subject to impulse buying. Nonetheless, because there are no restrictions in the identifications on channels of trade or

classes of consumers, we must assume that these related services can be offered to the same consumers in common channels of trade.

Turning to the marks, their comparison requires consideration of the likely pronunciation of the marks, their visual similarities or differences, their connotations, and their overall commercial impressions. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). It is a well-established principle that, when comparing marks, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). This well-established principle does not, however, mean that one first determines the dominant portions of marks and then compares only those portions for similarity in sound, appearance, connotation and commercial impression. Rather, what the principle means is that in making any one of these four assessments a dominant element in a mark may contribute significantly to a finding of similarity or dissimilarity.

Applicant and the examining attorney have argued at length about whether ACCUMULATOR or BONUS MAXXX is the dominant portion of applicant's mark. Understandably, applicant argues that the former is the dominant portion, while the examining attorney has endeavored to draw applicant's mark closer to the registered BONUS MAX mark by arguing that the BONUS MAXXX portion of applicant's mark is dominant. As noted above, however, we do not consider the dominant element question in the abstract but, rather, in each of the comparisons we make of the marks.

In sound, the marks are very different. There are more syllables in ACCUMULATOR than there are in BONUS and MAXXX combined. Thus in speaking applicant's mark, ACCUMULATOR would be the dominant term. Of course, while applicant's mark uses the spelling MAXXX, and registrant's mark uses only MAX, the BONUS MAXXX portion of applicant's mark would be pronounced the same as registrant's mark. Nonetheless, the ACCUMULATOR portion, having more sounds in it, contributes to a composite that is pronounced very differently from registrant's mark.⁷

⁷ Further, there is nothing in the record to indicate that applicant's and registrant's services are advertised by radio, or that they are the types of services that one would ask for by name, as in the case where one might ask a retailer where a particular product is located within a retail store. Thus, even though the registered mark BONUS MAX and the BONUS MAXXX portion of applicant's mark would be pronounced the same, this may not be

In sight, again the marks are very different. The ACCUMULATOR portion of applicant's mark contains as many letters as the BONUS MAXXX portion. In other words, it is half the mark. In addition, applicant's spelling of MAXXX looks different than registrant's MAX. In sum, while registrant's mark can be "seen" within applicant's mark, the marks are not visually similar.

As for the connotation of the marks, the examining attorney essentially argues that the ACCUMULATOR portion of applicant's mark should be, if not disregarded, then certainly discounted, because it is descriptive or highly suggestive. We do not find it appropriate for the examining attorney to have maintained, throughout examination, the argument that ACCUMULATOR is descriptive, even if the argument is made in the alternative. The original examining attorney requested a disclaimer of the term, arguing that it was descriptive. The current examining attorney, however, withdrew that requirement, calling it erroneous. Accordingly, the examining attorney cannot, on the one hand, argue that it was error to require a disclaimer of ACCUMULATOR and, on the other hand, continue to argue that the term is descriptive. We agree

as significant as it would be if the involved services were routinely advertised by radio or called for by name.

with the examining attorney that the record is mixed, both in terms of how the term is treated in registrations of third party marks that include the term, and in terms of the NEXIS evidence.⁸ However, as the issue is presented on appeal, we must consider the term to be no more than suggestive.

ACCUMULATOR may suggest that applicant's products and services are backed by an accumulation of diverse assets, that interest accumulates tax-free until annuity payments begin, or that applicant has created a product or service that accumulates a desirable variety of features.⁹ As BONUS has been disclaimed, and clearly is descriptive based on applicant's specimens showing that there is the potential for bonus interest to be credited to the accounts of certain consumers dealing with applicant, its clear and unmistakable connotation is only that of bonus interest available to the consumer. MAXXX is a laudatory term

⁸ While five of twelve registrations noted by the examining attorney arguably treat the term as descriptive, seven do not. Likewise, the NEXIS evidence shows a variety of uses for the term, some of which refer to insurance products or services, but some of which refer to individuals or companies.

⁹ Applicant has argued that it markets various ACCUMULATOR products and services. In the copy made of record herein of its filing made in its ACCUMULATOR application, various ACCUMULATOR marks and product descriptions are included. The various connotations of ACCUMULATOR that consumers might attribute to applicant's mark are derived from this material and its specimens in the instant application.

suggesting that consumers of applicant's services obtain maximum value for their purchasing dollar. Overall, the connotation of applicant's mark is that of flexible insurance or annuity product which gathers together or accumulates various features desirable by the consumer, with a bonus interest feature, and is a great or maximum value. The connotation of the registered mark, BONUS MAX is in many respects similar to the connotation of applicant's mark, insofar as registrant also offers a "bonus" interest feature and MAX is just as laudatory when used by registrant as it is when used by applicant. However, registrant's mark does not have the connotation of a product or service that gathers together or accumulates various desirable features (or any of the other possible connotations that might be ascribed to ACCUMULATOR). In sum, while there are some connotative similarities, the overall connotations of the marks differ.

In terms of the overall commercial impressions of the marks, we find them different. The clear differences in appearance and sound, and the subtler but still present differences in connotation, yield marks that have different overall commercial impressions.

Applicant has argued that the mark in the cited registration is weak and entitled to only a narrow scope of

protection, relying for its argument on the asserted registration of numerous marks for insurance industry products and services that feature the term BONUS or MAX. The examining attorney has responded by arguing that the registered mark must be considered a strong mark because it is the only registered mark that includes both terms. Neither argument is quite right. First, as to applicant's argument, while it has put in a list of registration numbers and marks retrieved from the USPTO's TESS database, based on searches for the terms BONUS or MAX and for identifications that utilize certain terms, it has not put in the registrations themselves. Thus, its argument that the registered mark is entitled to only a narrow scope of protection is undercut by our inability to thoroughly examine the supposed support for the argument. As for the examining attorney's argument, it does not follow as a matter of course that the combination of two weak terms results in a strong mark. The mark may be unique in its combination of the two terms, but that alone does not make it strong.

We are certainly cognizant of those decisions that hold that even weak marks are entitled to protection against the subsequent registration of the same or similar marks for like or related products or services. See, e.g.,

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In re Davis-Cleaver Produce Company, 197 USPQ 248 (TTAB 1977). Likewise we are certainly cognizant of those decisions, so heavily relied on by the examining attorney, that hold that one may not simply add a descriptive or weak element to a registered mark and thereby avoid a finding of likelihood of confusion. Nonetheless, we do not view the instant situation as one in which applicant is attempting to add something non-distinctive to a registered mark. Rather it has merely appended a descriptive term and a laudatory term to its ACCUMULATOR mark. Thus, we do not view this situation as involving a registered mark warranting such a broad scope of protection that applicant's mark cannot take its place on the register.

Decision: The refusal of registration under Section 2(d) is reversed.