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Mailed:
Feb. 14, 2003

Paper No. 13
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re FM International Services (NY), Ltd.

Serial No. 76/102,991

Angelo Notaro of Notaro & Michalos P.C. for
FM International Services (NY), Ltd.

Wanda Kay Price, Trademark Examining Attorney, Law Office
111 (Kevin Peska, Acting Managing Attorney).¹

Before Hohein, Hairston and Bottorff Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below, for services recited in the

¹ The examination of the application prior to appeal was handled
by a different Trademark Examining Attorney.

application as "providing and administering employee benefit and retirement programs."²



The Trademark Examining Attorney has issued two final refusals under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on two registered marks owned by a single registrant, i.e., Franklin Mutual Insurance Company. The first cited registration is of the typed-form mark FMI, for "insurance underwriting services."³ The second cited registration, which also is for "insurance underwriting services," is of the special-form mark depicted below.⁴

² Serial No. 76/102,991, filed on August 3, 2000. The application was filed on the basis of intent to use under Trademark Act Section 1051(b), 15 U.S.C. §1051(b). On August 27, 2001, applicant filed an Amendment to Allege Use (with the proper fee), in which applicant alleged March 2000 as the date of first use of the mark anywhere but failed to include the requisite allegation of the date of first use of the mark in commerce. It does not appear that the Amendment to Allege use has been examined or accepted by the Office, and, according to the Office's automated database, the application remains in intent-to-use status at this time.

³ Registration No. 1,439,493, issued May 12, 1987. §8 affidavit (6-year) accepted; §15 affidavit acknowledged.

⁴ Registration No. 1,439,494, issued May 12, 1987. §8 affidavit (6-year) accepted; §15 affidavit acknowledged.



The Trademark Examining Attorney contends that applicant's mark, as applied to applicant's services, so resembles each of the cited registered marks as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant has appealed the final refusals. Applicant and the Trademark Examining Attorney filed main briefs, but applicant did not file a reply brief and did not request an oral hearing. We reverse the refusals to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to a determination of whether applicant's mark and the cited registered marks, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find that applicant's mark is more similar than dissimilar to each of the cited registered marks. We are not persuaded

by applicant's argument that the stylized features of applicant's mark, i.e., the lowercase "i" and the arcuate line design element, suffice to distinguish the marks. The dominant feature in the commercial impression of each of these marks, and the feature which purchasers are likely to perceive and recall, is that each of the marks consists of the three letters "f," "m" and "i"; this point of similarity between the marks outweighs the slight differences in stylization. Nor are we persuaded by applicant's argument that purchasers will be able to distinguish the marks because they will encounter (and construe) them in conjunction with applicant's and registrant's respective corporate names. We must compare the marks as they appear in the drawings of the respective registrations and application, and those drawings do not include any corporate names. For these reasons, we find that applicant's mark is similar to each of the cited registered marks, and that the first *du Pont* evidentiary factor therefore weighs in favor of a finding of likelihood of confusion.

We turn next to a comparison of applicant's and registrant's services, under the second *du Pont* factor. It is not necessary that the respective services be identical or even competitive in order to support a finding of

likelihood of confusion. Rather, it is sufficient that the services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

After careful review of the record, we are not persuaded that applicant's recited services ("providing and administering employee benefit and retirement programs")

are sufficiently related to registrant's recited services ("insurance underwriting services") that confusion is likely to result, even if the respective services are offered under the similar marks involved in this case.

The record simply does not support the Trademark Examining Attorney's conclusory contentions that the respective services "overlap" or that registrant's services "could encompass applicant's services." Indeed, the only evidence of record on this *du Pont* factor⁵ is the three third-party registrations attached to the Trademark Examining Attorney's final office action, which are summarized as follows:

Reg. No. 2,484,870 (issued September 4, 2001),
of the mark EDUCATOR'S ADVANTAGE (EDUCATOR'S
disclaimed) for "retirement benefit planning

⁵ Applicant has made of record (with its request for reconsideration of the final refusal) copies of printouts obtained from registrant's website. Applicant offers this evidence to prove: that registrant's actual services consist only of commercial and personal lines of insurance, which are different from and "not typically associated with" the types of employee benefit and retirement program services rendered by applicant; that registrant operates only in New Jersey; and that registrant renders its services only through professional independent insurance agents. We have given no probative weight to this evidence because it is irrelevant to the issue to be decided in this case. Our likelihood of confusion determination must be made on the basis of the registrant's services as recited in the registrations, i.e., "insurance underwriting services," and not on the basis of what extrinsic evidence might show to be the more limited nature and scope of registrant's actual services. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ 1813 (Fed. Cir. 1987); *In re Continental Graphics Corporation*, 52 USPQ2d 1374 (TTAB 1999).

services and administration of employee benefit plans; and insurance underwriting services, namely, underwriting personal lines of insurance for automobile, home, life and group insurance, namely, annuities";

Reg. No. 2,467,916 (issued July 10, 2001), of the mark MOSERS (and design) for "administration of a public employees retirement plan, namely, payment of benefits and investment of assets; administration of life insurance and long term disability insurance programs"; and

Reg. No. 2,576,701 (issued June 4, 2002), of the mark LINCOLN ANNUITIES (ANNUITIES disclaimed) for "insurance services, namely, underwriting services for retirement products; namely, annuity, pension and life insurance products."

Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that the services identified therein are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).⁶

⁶ The third of the above-referenced registrations (Reg. No. 2,576,701) resulted from application Serial No. 76/101,211, which was still in pending status when the Trademark Examining Attorney cited it in the November 2, 2001 final office action. Although third-party applications (as opposed to registrations) are not probative evidence under *Albert Trostel* and *Mucky Duck*, *supra*, because they prove only that the applications were filed, we have considered this application as evidence of record for purposes of

However, three is a de minimis number of third-party registrations under *Albert Trostel* and *Mucky Duck* in any event, and in this case only one of the three (i.e., Reg. No. 2,484,870) actually covers both applicant's recited services and registrant's recited services. Even assuming, as the Trademark Examining Attorney contends, that "the consuming public associates insurance programs with retirement programs," that fact is too generalized to be of significant probative value here. The issue under the second *du Pont* factor in this case is not whether purchasers understand that insurance products may be included in retirement programs, but whether they are likely to assume that a single source would provide both the insurance underwriting services recited in the registrations and the benefit and retirement plan administration services recited in the application. On this record, it appears that there is only one company which does so. We find that this evidence is insufficient to establish that the respective services are similar or related, under the second *du Pont* factor, and that this

this appeal, in view of its subsequent maturation to registration and applicant's lack of objection.

factor accordingly weighs against a finding of likelihood of confusion.

Under the third *du Pont* factor, we find that the normal trade channels and classes of purchasers for applicant's and registrant's respective types of services are likely to overlap to some extent. Businesses would be purchasers of both benefit and retirement program administration services like applicant's (through their human resources department officials), as well as of insurance underwriting services like registrant's (most likely through different officials). Assuming that a business' employees also might be deemed to be "purchasers" of benefit and retirement plan administration services (to the extent that they might be able to customize the details of their particular plans), those employees also are potential purchasers (albeit outside the workplace) of insurance underwriting services such as registrant's. The third *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

However, under the fourth *du Pont* factor, we find that applicant's and registrant's respective services are of a type which typically are purchased (whether by company officials or by individual employees and whether within or outside the workplace) not on impulse but rather with some

degree of care and consultation, a fact which mitigates against a finding of likelihood of confusion.

After careful consideration of the relevant *du Pont* factors in this case, we conclude that the Office has failed to carry its burden of proving the existence of a likelihood of confusion. Applicant's mark is similar to the cited registered marks, and the trade channels and classes of purchasers for applicant's and registrant's respective services most likely overlap. However, we cannot conclude, based on the minimal evidence in this record, that the services themselves are sufficiently related that confusion is likely to occur, especially given the likely degree of care involved in their purchase.

Decision: The refusals to register are reversed.