

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
Nov. 26, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Health1 Insurance Services, Inc.

Serial No. 76630041

Scott J. Fields of National IP Rights Center, LLC for
Health1 Insurance Services, Inc.¹

Scott M. Sisun, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Grendel and Rogers, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Health1 Insurance Services, Inc., applicant herein,
seeks registration on the Principal Register of the mark
depicted below

¹ The Board has been informed that Mr. Fields passed away during the pendency of this appeal. Pursuant to the Board's September 24, 2007 order, this decision and all further correspondence shall be mailed to applicant itself at its address of record, i.e., Health1 Insurance Services, Inc., 4606 FM 1960 West, Suite 400, Houston, TX 77069.

Health1One

for services recited in the application (as amended) as "health insurance brokerage services in the field of individual and group health insurance policies."²

At issue in this appeal are the Trademark Examining Attorney's final refusals to register applicant's mark on the ground that the mark, as used in connection with the recited services, so resembles two previously-registered marks (owned by the same registrant) as to be likely to cause confusion, to cause mistake or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). The first cited registration is of the mark **HEALTH ONE** (in standard character form; HEALTH disclaimed) for services recited in the registration as "hospital and healthcare services."³ The second cited registration is of the mark depicted below

² Serial No. 766300441, filed on January 26, 2005. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and January 1995 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

³ Reg. No. 1307559, issued November 27, 1984. Affidavits under Sections 8 and 15 accepted and acknowledged; renewed.



(HEALTH disclaimed), for services recited in the registration as "health care services."⁴

Applicant and the Trademark Examining Attorney have filed appeal briefs. After careful consideration of the evidence of record⁵ and the arguments of counsel, we affirm the refusals to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

⁴ Reg. No. 2439860, issued on April 3, 2001. Affidavits under Sections 8 and 15 accepted and acknowledged.

⁵ We sustain the Trademark Examining Attorney's objection to the evidence submitted by applicant for the first time with applicant's appeal brief. This evidence is untimely and shall be given no consideration. Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). We also find that the "trademark.com" listing of third-party marks submitted by applicant with its response to the first Office action is entitled to no probative value. Third-party registrations, to be considered, must be submitted in the form of copies obtained from the Office's database. See, e.g., *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 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 trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applying these principles in this case, we find that applicant's mark is similar to both the standard character mark depicted in the cited '559 registration and the design mark depicted in the cited '860 registration.

In terms of appearance, applicant's mark is similar to the registered standard character mark despite the stylized lettering in which applicant's mark appears. The registered '559 mark is depicted in standard character form, which entitles the registrant to display the mark in any reasonable manner, including in the same or similar stylized lettering in which applicant's mark is depicted. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). As for the cited '860 mark, we find that its design element would be viewed as a mere background or carrier device for the words "Health One," and that the presence of this design element in the cited registered mark does not suffice to distinguish the marks in terms of appearance. Also, the presence in applicant's mark of the additional numeral "1" does not suffice to distinguish applicant's mark from the cited registered marks when they are viewed in their entireties. The similarity in appearance which results from the fact that both marks begin with the word "health" and end with the word "one" outweighs any dissimilarity which results from the presence of the numeral "1" in applicant's mark.

In terms of sound, we find that applicant's mark is identical to or at least highly similar to both of the cited registered marks because they all begin and end with

the same words, i.e., "health" and "one." The cited registered marks would be pronounced as "health one." Applicant's mark conceivably might be pronounced "health one one," given the presence of both the numeral "1" and the word "one" in the mark. If so, we find that "health one" and "health one one" are similar in terms of pronunciation. However, we find that it is more likely that the numeral "1" in applicant's mark would not be pronounced separately or in addition to the word "one" immediately following it. The mark is constructed in such a way that the numeral "1" and the word "one" would be perceived together as a unit, connoting "the best." Consumers therefore would pronounce the mark simply as "health one," rather than the more awkward "health one one," which would diminish the mark's laudatory connotation. Applicant's mark therefore is identical to the cited registered marks in terms of pronunciation. But even if applicant's mark were to be pronounced "health one one," we find that it still would be similar to "health one" in terms of pronunciation.

In terms of connotation, we find that the marks are essentially identical. All of the marks connote a high or the highest degree of "health." The numeral "1" in applicant's mark would be seen as a mere repetition,

illustration or reinforcement of the spelled-out word "one"; it adds nothing to the meaning of the mark as a whole.

In terms of overall commercial impression, we find that the marks are highly similar if not essentially identical. The presence of the numeral "1" in applicant's mark merely repeats, illustrates, or reinforces the word "one" before which it appears. It adds nothing significant to the overall commercial impression of the mark. Neither the slight stylization of applicant's mark nor the design element in the cited '860 mark suffices to distinguish the marks' overall commercial impressions when the marks are viewed in their entireties.

For these reasons, we find that the marks are similar when viewed in their entireties. The first *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the services as identified in the application and in the cited registrations. It is settled that it is not necessary that the services be identical or even competitive in order to find that the services are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether

consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be 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); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The Trademark Examining Attorney has made of record eleven use-based third-party registrations which include in their recitations of services both health insurance brokerage services of the type recited in applicant's application and health care services of the type recited in the cited registrations. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to

suggest that the services listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find that this evidence suffices to establish that the services recited in applicant's application and the services recited in the cited registrations are similar and related, for purposes of the second *du Pont* factor.

Because applicant's mark is similar to each of the cited registered marks, and because applicant's services as recited in the application are similar and related to the services recited in each of the cited registrations, we conclude that a likelihood of confusion exists in both cases. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusals to register are affirmed.

Ser. No. 76630041