

Hearing:
May 16, 2007

**THIS DECISION IS
NOT A PRECEDENT
OF THE TTAB**

Mailed:
August 3, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aspen Insurance Holdings Limited¹

Serial No. 78185508

Martin Schwimmer of Schwimmer Mitchell Law Firm for Aspen Insurance Holdings Limited.

Kevin S. Corwin, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Holtzman, Drost and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On November 15, 2002, Exali Reinsurance Holdings Limited (now Aspen Insurance Holdings Limited) filed an application (Serial No. 78185508) to register the mark ASPEN SPECIALTY (in standard character form) on the Principal Register for services in International Class 36, ultimately identified as follows:

¹ On January 30, 2004, the Office recorded a change of name from Exali Reinsurance Holdings Limited to Aspen Insurance Holdings Limited at Reel No. 2905, Frame No. 0334.

underwriting special risk insurance for businesses, namely writing insurance for contingencies not considered standard property or casualty business insurance risks, namely cancellation of events, transportation of valuable objects, contingencies for special events and projects, terrorism, and surplus coverage for unique business assets, namely marine, energy, aviation and satellite infrastructure; all such insurance excluding risk coverages for individuals and homeowners.

The application claims a bona fide intent to use the mark in commerce under Trademark Act 1(b), 15 U.S.C.

§ 1051(b). Applicant has entered a disclaimer of the term SPECIALTY.

The examining attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of Registration No. 2644518 for the mark ASPENCROSS (also in standard character form) on the Principal Register for "insurance brokerage services, financial planning, financial asset management, estate planning, financial consultation, financial consultation in the field of employee benefits and retirement plans, risk management, investment advisory services for the purpose of funding education" in International Class 36. Registration No. 2644518, which issued on October 29, 2002, claims first use anywhere and first use in commerce on November 15, 2000.

Applicant has appealed the final refusal. Both applicant and the examining attorney have filed briefs. An oral hearing was held on May 16, 2007.

We first address one evidentiary point. With its response to the first Office action, applicant listed the particulars of five third-party registrations. This is not the proper way to make such registrations of record. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). However, the examining attorney did not advise applicant that the listing was insufficient at a point where applicant could have corrected the error. Therefore, the registrations are deemed to have been stipulated into the record to the extent that the specific data provided by applicant has been considered. See TBMP § 1208.02.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act 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. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, but not exclusive, considerations are

the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Each of the relevant *du Pont* factors is discussed below.

We first consider the *du Pont* factor regarding the similarity or dissimilarity of the marks. Our focus is on whether the marks are similar in sound, appearance, meaning and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's two-word mark consists of the term ASPEN followed by the term SPECIALTY. According to applicant, SPECIALTY "refers to 'specialty' forms of insurance - insurance against narrowly defined risks such as professional liability insurance or industry-specific forms of insurance." See p. 2 of applicant's November 5, 2003 response. Applicant also maintains that there is "common use of the SPECIALTY element by large insurers such as HARTFORD SPECIALTY, RELIANCE SPECIALTY and AIG SPECIALTY" SPECIALTY hence is a commonly used term which identifies a characteristic of applicant's services. As such, SPECIALTY is descriptive and has been disclaimed.

Descriptive terms which have been disclaimed are often less significant in creating the mark's commercial impression and may be given little weight in reaching a conclusion on the likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *In re Code Consultants, Inc.*, 60 USPQ2d 1699 (TTAB 2001). See also, *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ("When comparing the similarity of marks, a disclaimed term, here 'COMMUNICATIONS,' may be given little weight, but it may not be ignored"). Thus, we find that ASPEN is the dominant term in applicant's mark and is the component purchasers will likely recall in referring to applicant's services.

Registrant's mark is ASPENCROSS, which is a compound term formed from the words ASPEN and CROSS. Since "Aspen" is the beginning portion of registrant's compound term, it would likely have greater significance for potential purchasers than the term CROSS. In addition, registrant's mark is in standard character form. It is settled that a mark registered in standard character form is not limited to any particular manner of display; its scope of protection extends to all reasonable manners of display. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *INB National Bank v.*

Metrohost, 22 USPQ2d 1585 (TTAB 1992). Thus, the scope of protection for registrant's mark extends to a stylization in which ASPEN is emphasized over CROSS. When we consider the marks as a whole, as we must, we find the marks to be similar in sound and appearance in view of the shared term ASPEN which is the first term in both standard character form marks.

We next consider the meaning of the marks. Applicant maintains that "there is some folkloric belief that the term ASPEN CROSS refers to the cross of the crucifixion, in that it was made of aspen wood," referring to a Wikipedia entry from the Internet for the term "aspen." Brief at p. 2. The Wikipedia entry, and other web pages purportedly addressing this "folkloric belief" regarding "aspen cross" are not properly of record. Applicant has not provided copies of these web pages; applicant has merely provided the web addresses for such web pages. See November 6, 2003 response to the first Office action. Web pages and their contents do not become of record simply by providing their web addresses. See *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004). An applicant must provide a copy of the web page to make the web page of record. Thus, applicant's contention regarding the folkloric belief of "aspen cross"

is without evidentiary support and we give it no further consideration.

Applicant has also stated on p. 2 of its brief that "aspen" is the name of a type of wood and has argued at p. 2 of its November 5, 2003 response that "Aspen" is "the name of a well-known skiing destination." "Cross" too has different meanings. For example, besides "The upright post with a transverse piece upon which Jesus was crucified" or "A crucifix," the definition of "cross" in *The American Heritage Dictionary of the English Language* (4th ed. 2006), of which we take judicial notice, includes "To combine the qualities of two other things: a *movie that crosses horror with humor*" and "to go or extend across; pass from one side of to the other." See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions). In the context of registrant's services, "cross" may thus suggest that registrant combines the expertise of its professionals in rendering its services, or that with registrant's assistance, a client may reach financial security.

Because of the possible meanings that may be attributed to ASPENCROSS, we are not persuaded by

applicant's arguments regarding the specific connotation of applicant's mark, which applicant maintains is different from the connotation of registrant's mark. We find rather that to the extent that the term ASPENCROSS has any specific connotation as applied to registrant's services, the connotation would be similar to the connotation of ASPEN SPECIALTY for applicant's services.

Additionally, we find that the commercial impression of each mark is similar. ASPEN would be pronounced separately from the other terms in each mark and would create a separate impression from such other terms. It also would be pronounced first in both marks and its impression would be immediate in perceiving both marks. Hence, we find that ASPEN plays a significant role in forming the commercial impression of both applicant's and registrant's marks, and that the commercial impression of both applicant's mark and registrant's is similar.

Applicant has argued in its response to the first Office action that ASPEN is a "non-unique" term, relying on the list of five registrations noted earlier in our opinion. The list of registrations has limited probative value because one of the registration numbers is obviously incorrect ("19888120") with too many digits (and not subject to verification), and the services mentioned for

two other registrations are in unrelated fields ("computer consultation and design services" and "marketing advertising services"). As for the two registrations for services identified as "business consultations," because they do not identify in what field such consultations are, they too are of limited probative value. Further, registrations are not evidence of use of the marks shown therein and hence are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result would be able to distinguish between ASPEN marks. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

Thus, upon consideration of the foregoing, we find the *du Pont* factor regarding the similarity of the marks weighs in favor of finding a likelihood of confusion.

We now consider the *du Pont* factor regarding the similarity or dissimilarity of the services. Our determination of the issue of likelihood of confusion between the applied-for and registered marks must be made on the basis of the services as they are identified in the involved application and registration. In such circumstances, if there are no limitations in the

identification, we must presume that the registration encompasses all services of the nature and type described. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Included within registrant's services is "insurance brokerage services." Because there is no limitation as to the type of insurance brokerage services in registrant's identification of services, we construe registrant's identification of services as including special risk insurance brokerage services for businesses.

The case law is clear that it is not necessary that the services of applicant and the registrant be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). In this case, the examining attorney has established that the services are related by submitting a number of third-party registrations demonstrating that a single mark has been adopted by various entities for both the services identified in applicant's application and certain services

(insurance brokerage, estate planning and financial planning) identified in the cited registration. 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. See *In re Infinity Broadcasting Corp.* 60 USPQ2d 1214 (TTAB 2001).

These registrations include the following:

Registration No. 2367656 for inter alia insurance brokerage and underwriting services, namely securing insurance coverage in the areas of hard to place and high risk insurance coverage, and fire, flood and home;

Registration No. 2683745 for inter alia financial planning, insurance underwriting and insurance brokerage (without limitation);

Registration No. 2686208 for inter alia insurance underwriting and insurance brokerage, both in the fields of accident, health, life, executive and professional errors and omissions, worker's compensation, property, casualty, and specialty insurances covering risks including weather contingencies, kidnap and ransom, lottery and event cancellation;

Registration No. 2723753 for inter alia insurance underwriting (without limitation), insurance brokerage and estate planning services;

Registration No. 2805520 for inter alia financial planning, insurance brokerage and insurance underwriting (without limitation);

Registration No. 2955827 for inter alia insurance underwriting, and brokerage services, both in the field of special risk accident and property and casualty insurance; and

Registration No. 3049542 for inter alia insurance brokerage and underwriting in various fields including commercial and specialty lines, environmental claims, fine art/jewelers block, property and construction insurance.

Additionally, Registration Nos. 2367656 and 2686208, and the following third-party registrations, suggest that the consuming public has come to expect that underwriters of insurance provide policies for both specialty and non-specialty insurance under a single trademark:

Registration No. 1487753 for inter alia underwriting of insurance in connection with all classes of property, casualty, marine, bonding, life and excess and special risk insurance; and

Registration No. 2876514 for insurance brokerage in the fields of life, disability, property and casualty, homeowner's, mortgage protection and special hazards insurance.

The examining attorney has thus made a prima facie showing of the relatedness of the services.

As for the *du Pont* factor regarding the similarity or dissimilarity of trade channels, because there are no restrictions in registrant's identification of services, registrant's trade channels would also include the normal channels of trade for insurance underwriting of the specific special risks for businesses included in applicant's identification of services. See *Canadian Imperial Bank of Commerce, National Association v. Wells*

Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In view of the similarity of applicant's and registrant's services, we find that applicant's trade channels overlap with registrant's trade channels.

Turning next to the *du Pont* factor regarding the conditions of purchase, we assume that that purchasers of applicant's underwriting special risk insurance for businesses and purchasers of registrant's insurance brokerage services would exercise some sophistication and degree of care in purchasing. However, assuming sophistication of and care taken by the purchasers of these services, "even careful purchasers are not immune from source confusion." *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). That is, even sophisticated purchasers of these related services are likely to believe that the services emanate from the same source, when offered under similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

Applicant has argued that the "prior registrant's [services], which all, by their nature, require, if not a face-to-face encounter between consumer and vendor, then certainly some extended form of interaction in order for

the services to be provided." Brief at p. 3. Applicant, however, has not submitted any evidence in support of its argument and we are not persuaded that this is necessarily the case with such services. Additionally, to the extent that applicant maintains at p. 3 of its brief that the fact that the terms "planning," "management," "consultation" and "advisory" services appear in registrant's identification of services, registrant intends some extended form of interaction with its purchasers in rendering its "insurance brokerage services," applicant's argument is not well taken. Applicant, in describing registrant's identification of services has improperly added a limitation which has not been explicitly stated in registrant's identification of services. We do not construe "insurance brokerage services" as being provided under similar conditions to the other services in the identification - which may require some extensive interaction between the purchaser and vendor - simply because "insurance brokerage services" is listed with the other services. The Board must make determinations of likelihood of confusion on the basis of the identifications of goods and services set forth in applications and registrations and may not read in limitations into such identifications. *Hewlett-Packard Co. v. Packard Press*

Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Thus, a fair reading of registrant's identification of services does not compel the conclusion that the insurance brokerage services must be rendered through some extended form of interaction. However, even if registrant's purchasers take care in their purchasing decisions and their decisions are rendered through some extended form of contact, and they may well be aware of the differences between the marks, we find that in view of the shared term ASPEN in both two-word marks, they likely will assume that the differences indicate variant marks of a single source, rather than identify separate sources. See, e.g., *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Further, as noted earlier, even careful, sophisticated purchasers are not immune from confusion as to the source of the goods and services, particularly when they are sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). The *du Pont* factor regarding the conditions of purchase hence is neutral.

After considering all the evidence of record and the arguments in this case bearing on the relevant *du Pont*

factors, we conclude that there is a likelihood of confusion between applicant's mark and the marks in the cited registrations. We conclude so principally due to the similarity of the marks and the fact that applicant's and registrant's services are related and because the conditions of purchase do not remove the likelihood of confusion. While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against applicant, which, as the newcomer, has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) in view of Registration No. 2644518 is affirmed.