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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Guardian Life Insurance Company of America

Serial No. 78538469

Virginia R. Richard of Winston & Strawn LLP for Guardian
Life Insurance Company of America.

Karen P. Severson, Trademark Examining Attorney, Law Office
117 (Loretta C. Beck, Managing Attorney).

Before Quinn, Drost, and Bergsman, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 27, 2004, applicant, Guardian Life
Insurance Company of America, applied to register the mark
GUARDIAN IS BIG ON SMALL BUSINESS (in standard character
form) on the Principal Register for "financial services,
namely, group health, life and disability insurance for
small businesses and brokerage services related thereto" in
Class 36. Serial No. 78538469. The application is based
on applicant's allegation of a bona fide intention to use
the mark in commerce. Applicant also claims ownership of

numerous registrations including Nos. 1853811¹; 2252498²; 2268145³; 2643197⁴; and others for various GUARDIAN marks. In subsequent papers, applicant included a list of more than thirty registrations for various marks containing the term GUARDIAN for various insurance, trust, pension planning, and similar services.

The examining attorney⁵ has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark WE'RE BIG ON SMALL BUSINESS (in standard character form) for "underwriting of commercial property and casualty insurance; insurance administration and insurance claims processing services which are accessible online and via the Internet" in Class 36.⁶

The examining attorney argues that:

¹ GUARDIAN for insurance underwriting services in the field of disability insurance.

² This registration has now been cancelled.

³ THE GUARDIAN LIFE INSURANCE COMPANY OF AMERICA for services including group and individual life, disability, accident, health and dental insurance underwriting services and pension planning services.

⁴ GUARDIAN and design for services similar to those in the previous registration.

⁵ The current examining attorney was not the original examining attorney in this case.

⁶ Registration No. 3042610 issued January 10, 2006.

Applicant's mark consists of the house mark GUARDIAN and the wording IS BIG ON SMALL BUSINESS. Registrant's mark is WE'RE BIG ON SMALL BUSINESS. Accordingly, the respective marks share the identical wording BIG ON SMALL BUSINESS. Applicant's addition of GUARDIAN IS merely serves to identify the WE'RE in Registrant's mark.

Brief at unnumbered p. 5.

The examining attorney also maintains that the services are closely related.

On the other hand, applicant argues that its mark is famous and that "[c]onsumers in the insurance and financial industries have been conditioned to distinguish marks used in the industry on the basis of different elements used by different parties" and that there has been widespread use of the phrase 'Big on Small Business.'" Brief at 11. Furthermore, applicant maintains that "[l]ife and health insurance are wholly separate from commercial property and casualty insurance services and are sold by different insurance companies specializing in these fields and by different sales people licensed to sell specific types of insurance." Brief at 15.⁷

When the refusal was made final, applicant filed this appeal.

⁷ The examining attorney has objected to new evidence that was either submitted or referred to in applicant's brief. We will not consider evidence presented for the first time on appeal. 37 CFR § 2.142(d).

Inasmuch as the issue here involves the question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin our analysis by comparing applicant's and registrant's services. Applicant's services include financial services involving group health, life and disability insurance for small businesses services while registrant's services include underwriting of commercial property and casualty insurance. We must determine the issue of likelihood of confusion based on the identified services. *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"). See also *Paula*

Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

In support of her argument that the services are closely related, the examining attorney has submitted numerous registrations to show that property and casualty insurance services and health, life, and disability insurance services are registered by the same entity under a common mark. Some examples follow:

No. 2342776 - "life insurance, property and casualty insurance, and health and disability insurance"

No. 2298234 - "life insurance, health insurance, auto insurance, home insurance, and property and casualty insurance"

No. 2524770 - "insurance underwriting services in the fields of multi-line property and casualty insurance and life insurance"

No. 2572948 - "underwriting insurances, namely, providing individual and group life, health, and annuity insurance, personal and commercial property and casualty, new and used motor vehicle, surety, employer's liability, commercial multiple peril, farm multiple peril, homeowner's multiple peril, and business interruption insurance"

No. 2654094 - "writing and underwriting of casualty insurance, property insurance, liability insurance, life insurance and annuities"

No. 2686633 - "Insurance underwriting in the fields of property and casualty insurance, life insurance"

These registrations can be used to suggest that goods or services are related. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001) ("The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988)").

In order to be related, it "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could 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 producer or that there is an association between the producers of each parties' goods or services." *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002). We agree with the examining attorney that this evidence supports her determination that the life and health insurance and property and casualty insurance services are closely related.

In addition to finding that the services of applicant and registrant are closely related, we also find that the prospective purchasers of these services would overlap. Applicant's group health, life and disability insurance services are specifically identified as being "for small businesses." Applicant argues that "registrant's commercial property and casualty insurance is specifically marketed to property owners seeking liability coverage for property, not life and health insurance for small business employees." Brief at 15. However, a small business seeking insurance for its operations would likely be in the market for commercial property and casualty insurance as well as group life, health and disability insurance. Registrant's services include commercial property and casualty insurance underwriting. These commercial

insurance services would include commercial property and casualty insurance for small businesses.

Applicant also argues that the purchasers of these services are sophisticated purchasers.

The circumstances regarding the purchase of insurance products further eliminates any likelihood of confusion. The parties' respective services are offered at high price points. In addition, the insurance products offered by the parties are not the subject of impulse buying. They are the subject of careful consideration and research by the small business consumer and, particularly, the employees of small business in charge of selecting an insurance carrier. The nature of the insurance business necessitates frequent contact between the insurance provider and the policyholder, in the form of premium invoices, policy updates, benefits inquiries, payment of claims, explanatory insurance coverage and claims payment policies and procedures, and the like, all of which ensure that policyholders know exactly which company they are dealing with when they purchase an insurance policy, and throughout the life of the policy. The degree of inquiry made prior to purchase by the sophisticated, highly trained and educated purchasers of insurance services is so thorough as virtually to preclude confusion as to the source of those services.

Reply Brief at 16-17.

We have several problems with applicant's arguments that prohibit us from giving them much weight. First, there is little evidence in the record that would permit us to draw the specific conclusions that applicant asserts to be facts. Also, small businesses would include a variety of entities with different levels of experience. The examining attorney (Brief at 14) "is not disputing that the

respective parties' consumers are relatively sophisticated." However, while these purchasers may be relatively sophisticated, it is hard to imagine that all owners of restaurants, convenience stores, and similar small businesses are "sophisticated, highly trained and educated purchasers." It is not clear why some of these purchasers would not include novices who are starting their first business with little business experience. Third, while no one is arguing that the purchase of business insurance is an impulse purchase, we cannot conclude based on this record that these decisions are always the result of very careful study and analysis. Fourth, we are concerned with the decision to purchase. The fact that subsequent to the purchase the small business owner may understand that the actual company is a different entity than what the purchaser originally thought does not eliminate the likelihood of confusion. Finally, we add that even sophisticated purchasers are not immune to being confused. In this case, purchasers, who were aware of the insurance industry practices as demonstrated by the examining attorney's third-party registrations, are likely to believe that the source of these related services was the same or at least associated in some way. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*

1772, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) 1695 (“[E]ven more sophisticated purchasers might be aware that champagne houses offer both types of products under similar marks, and could easily conclude that VEUVE ROYALE was Veuve Clicquot's sparkling wine”).

We now move on to consider the marks of applicant and registrant. This “first *DuPont* factor requires examination of ‘the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *Palm Bay Imports*, 73 USPQ2d at 1691 (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)). It is not disputed that both marks contain the identical expression “Big on Small Business.” Applicant refers to the slogan as an “inherently weak slogan.” Reply Brief at 8. The examining attorney describes the expression as a “play on words.” Brief at 8. Applicant submits several excerpts from publications and argues that the “common nature of the phrase BIG ON SMALL BUSINESS in the cited mark precludes a finding that the mark can function as a source-identifier.” Brief at 10.⁸ However, these references are not used in a

⁸ We will assume that applicant here is not attacking the validity of the entire registered mark. Applicant is, of course, prohibited from doing so. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). But we will not entertain applicant’s additional argument (Reply Brief at 10)

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trademark manner and the uses do not appear to be "in the relevant industry." Examining attorney's brief at 7.

Nissan Bets Big on Small
BusinessWeek, March 4, 2002

Postini's E-Mail Security Big on Small Biz
www.internetnews.com

Betting Big on Small Jets
www.ocala.com

China big on small carmakers
www.boston.com

Riverside thinks big on small equity deals
<http://smallbusiness.yahoo.com>

Penn thinks big on small-scale research
www.upenn.edu

Betting Big on Small Companies
www.kiplinger.com

Whirlpool thinks big on small kitchen appliances
<http://economictimes.indiatimes.com>

GM Canada bets big on small cars in 2004
www.globeinvestor.com

IBM to bet big on small enterprises
www.tmcnet.com

BIG ON SMALL COMPONENTS
Wholesale distributorship services for items of metal hardware
Registration No. 3022099

Furthermore, most of these uses are not even for registrant's entire expression "Big on Small Business."

that the "cited mark is merely a secondary slogan mark that does not function as a service mark in the absence of the close proximity to a distinguishing mark."

Also, there is no requirement that a trademark be used only in association with the trademark owner before it could be a source identifier. Obviously, applicant's GUARDIAN marks, which themselves consist of a common word, would conflict with such a test.⁹ We point out that none of the articles (or the registration) appears to refer to insurance-related services. *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988) ("[E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner's skin care products or respondent's stuffing box sealant"). The fact that authors of news articles have used a similar term as part of a story's title hardly establishes that the term "Big on Small Business," when used in association with registrant's services, has no source-identifying significance.

Inasmuch as the ending of the marks are identical and not devoid of trademark significance, the next question becomes whether the differences in the beginning of

⁹ Guardian is defined, inter alia, "a person who guards, protects, or preserves." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applicant's and registrant's marks result in the marks being dissimilar. Applicant's mark begins GUARDIAN IS, while registrant's mark begins WE'RE. Both applicant and the examining attorney agree that applicant's mark includes its house mark "Guardian." Applicant's brief at 3; Examining attorney's brief at 5. Interestingly, applicant argues that "Consumers cannot identify any source of origin from the cited mark alone. The cited mark must be used in connection with the cited registrant's house mark, as the 'WE'RE' portion of the cited mark fails to identify a specific source or service." Reply Brief at 10. However, this type of mark meets the statutory definition of a service mark: "The term 'service mark' means any word... used by a person... to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, *even if that source is unknown.*" 15 U.S.C. § 1127 (emphasis added). There simply is no requirement that a trademark or service mark contain a reference to a specific source in order for it to function as a trademark.

There have been numerous cases that involve a situation where a party adds a house mark to another party's registered mark. The addition of a house mark to another's mark often does not avoid confusion. *Menendez v.*

Holt, 128 U.S. 514, 521 (1888). Indeed, "such addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion." *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (LE CACHET DE DIOR confusingly similar to CACHET). "However, there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark." *New England Fish Company v. The Herwin Company*, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975) (BLUE MOUNTAIN KITTY O's and KITTY not similar).

One situation where the addition of a house mark does avoid confusion is in cases where the common part of the marks is weak. See *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1315 (TTAB 2005) ("In terms of overall commercial impression, we find that although the word ESSENTIALS is the entirety of the commercial impression created by opposer's mark, in applicant's mark it contributes relatively less to the mark's commercial impression than does the house mark NORTON MCNAUGHTON... [W]e find that the word ESSENTIALS is highly suggestive as applied to the parties' clothing items and as it appears in both parties' marks, especially in applicant's mark"). In

this case, we have not found that the common portion of the marks is descriptive or even highly suggestive. While the mark WE'RE BIG ON SMALL BUSINESS is not arbitrary and it does suggest that the registrant is directing its services toward small businesses, we cannot conclude that it is a very weak mark. Therefore, the *Knight Textile* case, upon which applicant relies, does not support applicant's argument that there is no likelihood of confusion here.

Another situation is where "there are some recognizable differences between the assertedly conflicting product marks, so that the addition to one of a trade name or house mark or other such matter may be sufficient to render the marks as a whole distinguishable and thus to avoid confusion." *In re C. F. Hathaway Co.*, 190 USPQ 343, 344 (TTAB 1976). *See also Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (CCPA 1967) (ROCKWOOD BAG-O-GOLD for candy not confusingly similar to CUP-O-GOLD for candy). Here, the common part of the marks is identical, "Big on Small Business," so there is no "recognizable difference" between the marks besides the initial portion of both marks.

At this point, we add that even assuming that applicant is the owner of famous mark, this fact does not permit the famous mark owner to appropriate the marks of

others and avoid confusion by simply arguing that prospective purchasers will believe its mark is not owned by the registrant. *C. F. Hathaway Co.*, 190 USPQ at 344 (Board rejected applicant's argument that "registrant's rights should not be extended to preclude applicant from combining the words 'golf' and 'classic' with its famous mark 'HATHAWAY'"). See also *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 740 (TTAB 1978):

Applicant has incorporated within its mark the entire mark of opposer, namely, "GUARDIAN" and merely added the name "SCOTT" which is nothing more than a house mark of applicant. While such house mark cannot be ignored in evaluating applicant's mark, we cannot lose sight of the fact that marks generally identify an anonymous source, and the resemblance between "SCOTT GUARDIAN" and "GUARDIAN" is such that to those who notice the term "SCOTT," the association may carry over to opposer's mark as well as that of applicant. Thus, we conclude that applicant's mark "SCOTT GUARDIAN" is confusingly similar to opposer's mark "GUARDIAN."

The cases that applicant cites simply demonstrate that many factors can influence the question of whether there is a likelihood of confusion. For example, in *King of the Mountain Sports Inc. v. Chrysler Corp.*, the goods and services were not closely related. 185 F.3d 1084, 51 USPQ2d 1349, 1354 (10th Cir. 1999)¹⁰ ("However, in a case involving pure sponsorship confusion, the parties may have

¹⁰ Applicant refers to the district court decision. 968 F. Supp. 568 (D. Colo. 1997).

little similarity in their products or manner of marketing. Here, KOM's clothing is only marginally related to defendant's ski event. This disconnection greatly reduces the relevance of the similarity of products factor"). In *Genovese Drug Stores, Inc. v. TGC Stores, Inc.*, the marks were found to have different meanings. 939 F. Supp. 340 (D.N.J. 1996) ("[T]he two names connote different meanings- Genovese's emphasis is that it will take good care of its customers; whereas, **take good care** teaches its customers how to take good care of themselves").

Applicant also points to a non-precedential board case in which the board found that applicant's "Guardian" marks "enjoy[ed] considerable renown." *Guardian Life Insurance Co. of America v. England*, Opp. No. 91118054 (TTAB March 21, 2000).¹¹ Whether a mark is famous is a question of fact, and the Federal Circuit has indicated a reluctance to take judicial notice of a mark's fame. *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) ("We consequently decline to consider

¹¹ Applicant cites other nonprecedential board decisions. In at least one instance (Reply Brief at 4), it refers to the reasoning in, inter alia, a nonprecedential case as "controlling." We remind applicant that nonprecedential cases by definition are not precedential decisions and are not binding on the board or the examining attorney. More generally, we add that the citation of opinions that are designated as "NOT A PRECEDENT OF THE TTAB" is a poor substitute for relying on the precedential decisions of the courts and this board.

whether to take judicial notice of the fame of HP's marks").¹² See also *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1408 (TTAB 1998) (Hard Rock Cafe Licensing Corp. alleged that its marks were famous. "[W]e cannot conclude from this record, as discussed *infra*, that opposer's marks are famous. Nor do we have a stipulation that the HARD ROCK CAFE marks are famous, as was present in *Hard Rock Cafe Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454, 21 USPQ2d 1368, 1370 (W.D. Wash. 1991). Further, while applicant does not appear to dispute opposer's allegations of fame, he has not admitted that opposer's marks are famous and we will not take judicial notice of fame"). The fact that a non-precedential board decision found that applicant's mark had "considerable renown" does not relieve applicant of the obligation to establish the fame of its mark in this proceeding.

We also note that this is not a traditional house mark case in which one party takes another's entire mark and adds its house mark to that mark. Here, applicant has changed the initial part of registrant's mark by deleting

¹² The *Packard Press* court noted that the Federal Circuit "on one occasion in the past, [had] taken judicial notice of the fame of a mark when considering a Board decision on appeal. See *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 728 [6 USPQ2d 1719] (Fed. Cir. 1988)." In that case, the term B.V.D. appeared as a dictionary entry. 6 USPQ2d at 1720.

the term "We're" and substituting "Guardian is." Applicant acknowledges that the source of the services of the cited registration is not identified and its mark does identify "Guardian" as the source of its related services.

Consumers familiar with registrant's mark are likely to believe, when they encounter applicant's mark that substitutes "Guardian is" for "We're," that the previously anonymous source has now chosen to identify itself.

Thus, for purposes herein, the "LUMBERJACK" marks of the parties are identical. In such a situation, the addition of applicant's house mark "HILL-BEHAN'S" thereto is not deemed sufficient to distinguish the marks as a whole and to avoid confusion in trade. This is especially so when one considers that a trademark or a service mark identifies an anonymous source so that the average consumer in the marketplace is, more often than not, unaware of the producer of the goods sold under a mark and often doesn't care, so long as the quality of the goods identified by the mark remains the same. Thus, if those individuals familiar with registrant's "LUMBERJACK" products were to encounter "HILL-BEHAN'S LUMBER JACK" stores at which lumber products are sold, there is nothing to preclude them from assuming that "HILL-BEHAN" is the source of the "LUMBERJACK" products and has established retail outlets to market them. Whether it be confusion of source or sponsorship, the likelihood of such confusion is there and, as a consequence, registrant's registered mark is a bar to the registration sought by applicant.

In re Hill-Behan Lumber Co., 201 USPQ 246, 249-50 (TTAB 1978). See also *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007) ("When, as in this case, the common part of the marks is identical, purchasers familiar with the

registrant's mark are likely to assume that the house mark simply identifies what had previously been an anonymous source").

In likelihood of confusion cases, we must not just compare the individual elements, but we must look at the similarities and dissimilarities of the marks in their entireties. We conclude that the differences in the marks in their entireties are not significant. Applicant points out that the registrant's mark identifies an anonymous source and applicant's mark identifies a specific source. When consumers who are familiar with registrant's mark encounter applicant's mark with the identical "Big on Small Business" portion, they are likely to believe that these closely related services come from a common source. Under these circumstances, we find that the marks GUARDIAN IS BIG ON SMALL BUSINESS and WE'RE BIG ON SMALL BUSINESS are similar in sound, appearance, meaning, and commercial impression. For example, applicant argues that its mark conveys the meaning that it is "focused on providing insurance and financial services targeted to small business." Brief at 7. It is not clear why the identical language "Big on Small Business" would not convey the identical meaning that an unidentified entity is also "focused on providing insurance ... services targeted to

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small business." The difference between the initial terms is not likely to lead purchasers to believe that the underlying services originate from different sources.

To the extent that we have any doubts, we resolve them, as we must, in registrant's favor. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.