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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Community Mutual Insurance Company

Serial No. 78759103

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Before Zervas, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

American Community Mutual Insurance Company filed, on
November 22, 2005, an application to register on the
Principal Register the mark PRECEDENT (in standard
character form) for services ultimately identified as
"underwriting of health care plans and life insurance plans
for others; administration of pre-paid health care plans

and life insurance plans for others" in International Class 36.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark PRECEDENCE (in typed form) for "preferred provider programs in the field of mental health and chemical dependency" in International Class 36.²

When the refusal was made final, applicant filed this appeal and requested reconsideration. The examining attorney denied the request for reconsideration and the appeal was resumed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of

¹ Application Serial No. 78759103, claiming an intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 1841483, renewed November 25, 2003.

confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. 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).

We turn initially to the first *du Pont* factor and consider whether applicant's mark and the cited registered mark are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation 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)

In the dictionary definitions from *Merriam-Webster Online Dictionary*, located at merriam-webster.com,³ which accompany the examining attorney's brief, the words "precedent" and "precedence" are defined as follows:

Precedent (adj.): "prior in time, order, arrangement, or significance"

³ Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides that the record in an application should be complete prior to the filing of an appeal. See also TBMP § 1207.01 (2d ed. rev. 2004). However, the Board may take judicial notice of dictionary definitions, including online dictionary entries which exist in printed format, and we take judicial notice of the definitions provided by the examining attorney. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre*

Precedence (noun): "the fact of preceding in time"
The marks have apparent similarities in their meanings. Additionally, because their meanings are similar, and because the words "precedent" and "precedence" are similar, the marks have similar commercial impressions. Further, the marks have apparent similarities in sound and appearance in view of the shared lettering in the marks, differing only by their endings. We therefore resolve the *du Pont* factor regarding the marks against applicant.

We next turn to the *du Pont* factor regarding the services. It is well established that when the marks at issue are the same or nearly so, the services in question do not have to be identical to find that confusion is likely. See *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983) ("... the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion.").

Registrant's identified services are "preferred provider programs in the field of mental health and chemical dependency." An article taken from trinitygc.com

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).

made of record by the examining attorney with her final Office action describes registrant as "a not-for-profit, preferred-provider organization specializing in the delivery and management of mental health and substance abuse benefit plans to area employers" and states that registrant "specializes in offering employers clinical criteria and protocols, PPO network credentialing and contracting, utilization service/case management, complaint and appeals procedures and patient, provider and health plan satisfaction surveys." We consider this evidence to better understand the nature of registrant's services, but ultimately compare applicant's services as set forth in its application with the services as set forth in the cited registration in our likelihood of confusion analysis. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Cf. *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990).

Both applicant's and registrant's services are directed in part to employers seeking mental health and substance abuse assistance for their employees.⁴ See brief at p. 5 stating "purchasers of the Appellant's services are typically businesses ...". An employer would have a choice

⁴ "Underwriting of health care plans" and "administration of pre-paid health care plans" in applicant's identification of services includes underwriting of insurance and administration of pre-paid health care plans for mental health and substance abuse issues.

of contracting directly with registrant for such assistance or contracting with applicant for insurance coverage so that the employees could obtain treatment for mental health and substance abuse issues. Ultimately, the employer would be able to secure treatment for mental health and substance abuse problems through either applicant's or registrant's services. In this respect, the services are related.

Further, to support a finding of likelihood of confusion, it is sufficient to show that the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). In this regard, the examining attorney has made of record several use-based third-party registrations that encompass the services identified in both the application and 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

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of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

See:

(1) Reg. No. 2482853 for, inter alia, administration of health care insurance, underwriting of prepaid mental health insurance and administration of preferred provider plans in the field of health care, in International Class 36; and

(2) Reg. No. 2550338 for, inter alia, administration of health care insurance, underwriting health care insurance, administration of preferred provider plans in the field of health care and administration of mental health care insurance, in International Class 36;

Also, U.S. Reg. No. 2198359 for, inter alia, "administration of health plans" in International Class 36, has some probative value because the recited services are broad enough to encompass applicant's "administration of pre-paid health care plans" and registrant's services. These third-party registrations suggest that consumers could, because of the similar nature of the marks, mistakenly believe that applicant's and registrant's services originate from the same source.

Thus, for the forgoing reasons, we resolve the *du Pont* factor regarding the similarity of the services against applicant.

We next consider the classes of consumers and the trade channels. Applicant maintains at p. 5 of its brief

that the purchasers of its services are typically businesses and the Internet article from trinitygc.com indicates that purchasers of registrant's services are also businesses. Thus, the purchasers for both applicant's and registrant's services overlap, encompassing businesses seeking mental health and substance abuse coverage for their employees. Regarding the trade channels of the services, we note that the recitation of services in both the application and the registration do not contain any limitations with regard to channels of trade. We therefore presume that applicant's and registrant's services encompass all services of the type described and that the services move in all normal channels of trade directed to the same purchasers, typically employee benefits personnel in such businesses. *Elbaum*, 211 USPQ at 640. The trade channels hence overlap.

The *du Pont* factors regarding the classes of purchasers and trade channels are also resolved against applicant.

Next, we turn to the fourth *du Pont* factor, i.e., the conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing, and applicant's contention that purchasers of its services are "relatively sophisticated"; and that "[t]he insurance

services provided by [applicant] are extremely specialized and expensive necessitating an informed and careful purchasing decision on the part of the consumers." Brief at p. 5. We accept that purchasers of registrant's and applicant's services would have some degree of sophistication and exercise some level of care in purchasing the services. However, as the examining attorney notes, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). In view thereof, and because applicant has not provided any evidence indicating the level of sophistication or care of purchasers, we find this factor to be neutral.

In weighing the relevant *du Pont* factors discussed above, we conclude that applicant's mark PRECEDENT for "underwriting of health care plans and life insurance plans for others; administration of pre-paid health care plans and life insurance plans for others" is likely to cause source confusion among purchasers with the registered mark PRECEDENCE for "preferred provider programs in the field of mental health and chemical dependency."

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Decision: The refusal to register under Section 2(d)
is affirmed.