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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re QBE Regional Companies (N.A.), Inc.

Serial No. 78874163

James D. Peterson of Godfrey & Kahn, S.C. for QBE Regional
Companies (N.A.), Inc.

James W. MacFarlane, Trademark Examining Attorney, Law
Office 104 (Chris Doninger, Managing Attorney).

Before Hohein, Hairston and Bergsman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Winterthur U.S. Holdings, Inc. filed an application to
register on the Supplemental Register the mark PRECISE
PRICING (in standard character form) for services
ultimately identified as "insurance underwriting services
in the field of property and casualty insurance" in

International Class 36.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's services, so resembles the mark PRECISE LIFE (in standard character form with a disclaimer of LIFE), which is registered for "life insurance underwriting services" in International Class 36,² as to be likely to cause confusion, mistake or deception.

Applicant and the examining attorney have filed briefs.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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, however, two key considerations are the similarities/dissimilarities between the marks and the

¹ Serial No. 78874163, filed on May 2, 2006, alleging dates of first use of at least as early as January 4, 2006. Winterthur U.S. Holdings, Inc. assigned the mark and the application to QBE Regional Companies (N.A.), Inc. on June 4, 2007. The assignment was recorded on November 15, 2007 at Reel 3661, Frame 0865.

² Registration No. 1580546, issued on January 30, 1990; renewed.

similarities/dissimilarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

It is the examining attorney's position that applicant's insurance underwriting services in the field of property and casualty insurance and registrant's life insurance underwriting services are closely related. The examining attorney maintains that the respective services travel in the same channels of trade to the same customers, namely, ordinary consumers interested in purchasing insurance. In support of his position that the respective services are closely related, the examining attorney submitted Internet printouts which describe the job of an insurance agent, and copies of third-party use-based registrations of marks which he maintains show that companies have registered their marks for both types of services involved herein. With respect to the marks, the examining attorney argues that due to the shared word PRECISE, which is the dominant portion of both marks, the marks are similar.

Applicant, on the other hand, argues that the respective services are not related because property and casualty insurance, on the one hand, and life insurance, on the other hand, are distinct types of insurance. Also,

applicant maintains that many of the third-party registrations submitted by the examining attorney cover a broad range of insurance and/or financial services, and that such registrations are not probative of whether the specific services involved herein, i.e., insurance underwriting services in the field of property and casualty insurance and life insurance underwriting services, are the types of services which may emanate from a single source. Also, applicant maintains that its insurance underwriting services are marketed solely to insurance agents; not to the ultimate purchasers of insurance. In this regard, applicant submitted an Internet printout which indicates that its services are offered to insurance agents. In addition, applicant contends that insurance agents are highly sophisticated and knowledgeable about the sources of insurance services. With respect to the marks, applicant argues that "because the [r]egistered [m]ark, PRECISE LIFE is significantly descriptive, it is a weak mark, which militates against finding a likelihood of confusion." (Brief, p. 4). Also, applicant maintains that when the marks are considered in their entirety, they are different in commercial impression.

We first consider the du Pont factor regarding the similarity or dissimilarity of the involved services. In

comparing the services, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Further, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than on the basis of what the record reveals the services to be. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991). Further, where the services in an application or cited registration are broadly described, such that there are no restrictions as to trade channels and purchasers, it is presumed that the identification of services encompasses not only all services of the nature and type described therein, but that

the identified services are provided in all channels of trade which would be normal therefor, and that they would be purchased by all potential customers thereof. See, e.g., *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

We find that the record in this case supports a finding that insurance underwriting services in the field of property and casualty insurance, on the one hand, and life insurance underwriting services, on the other hand, are closely related. As noted, the examining attorney introduced several Internet printouts which describe the job of an insurance sales agent. The information in these printouts indicates that insurance sales agents typically offer several types of insurance, including property and casualty insurance and life insurance. Moreover, as noted, the examining attorney made of record copies of use-based third-party registrations to show that services of the types identified in the application and the cited registration may be sold under a single mark by a single source. See, for example, Registration No. 3215402 for insurance underwriting in the field of property and casualty, life and health, and auto insurance services; Registration 3207308 for insurance brokerage, insurance administration and insurance underwriting services for worker's compensation, automobile, property, casualty

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services for worker's compensation, automobile, property, casualty, employer's liability and life insurance; Registration No. 3194990 for insurance agency, insurance brokerage, and insurance underwriting services in the fields of life, annuities, health, disability, and property and casualty insurance; Registration No. 3120076 for, insurance services, namely, insurance brokerage in the field of life, health, property and casualty insurance and insurance underwriting services in the field of life, health, property and casualty insurance; Registration No. 3336461 for insurance services for individuals and businesses, namely, insurance agency services provided through a single insurance agency or a group of insurance agencies; insurance underwriting services for personal property and casualty insurance, commercial property and casualty insurance, accident insurance, life insurance, and health insurance; insurance brokerage; insurance claims administration services; and insurance claims processing; Registration No. 3348207 for insurance services, namely underwriting, brokerage and consultation in the field [of] automobile liability, property, casualty, physical damage and life insurance; Registration No. 3293877 for insurance agency, brokerage, underwriting and administering services in the fields of life, accident, health, disability, long-

term care, travel accident, management and professional liability, credit and export, travel, surety, fidelity bonds, property, casualty, inland and ocean marine, boiler and machinery, automobile, home and fire insurance, claims administration and safety engineering services; providing information in the field of insurance via the Internet, global networks, telephone, facsimile, email and any other means.

Third-party registrations which individually cover a number of different services and which are based on use in commerce are probative to the extent that they suggest that the listed services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). With respect to applicant's contention that the third-party registrations are not probative of whether the involved services are related, we acknowledge that several of the registrations are analogous to house marks because the recitations of services cover insurance services and a broad range of financial services.

Therefore, the inclusion of insurance underwriting services in the field of property and casualty insurance and life insurance underwriting services is not particularly significant. However, ten of the third-party registrations specifically cover insurance services, including the

involved services. We find that these registrations are probative of whether the involved services are related. In sum, we find that the evidence submitted by the examining attorney is sufficient to establish that insurance underwriting services in the field of property and casualty insurance and life insurance underwriting services are closely related.

Insofar as the du Pont factors pertaining to the channels of trade and classes of purchasers are concerned, applicant argues that its underwriting services are marketed solely to insurance agents, and that such agents are highly sophisticated and knowledgeable about the sources of insurance services. The examining attorney, on the other hand, argues that in the absence of any restrictions as to the channels of trade and classes of purchasers in the services identified in applicant's application, we must assume that such services are offered to ordinary consumers who are interested in purchasing insurance. As noted, applicant has submitted evidence indicating that its particular services are offered to insurance agents. However, neither applicant nor the examining attorney submitted any evidence as to whether insurance underwriting services typically are offered exclusively to insurance agents or whether such services

are also offered to ordinary consumers. In other words, there is no evidence one way or the other as to the usual classes of purchasers of insurance underwriting services. We judicially notice that the word "underwrite" is defined (in pertinent part) as:

2a. To sign (an insurance policy) so as to assume liability in case of specified losses. b. To insure. c. To insure against losses totaling (a given amount).

The American Heritage Dictionary of the English Language (4th ed. 2006).³

In view of the foregoing definition, it is not clear that insurance underwriting services are of a nature that they would not be offered to ordinary consumers. Because there are no restrictions as to the channels of trade or classes of purchasers in the services identified in applicant's application and registrant's registration, it is reasonable to assume that such services are available in all normal channels of trade to all the usual purchasers of such goods and services, including insurance agents and ordinary consumers seeking to purchase insurance.

³ The Board may take judicial notice of a dictionary definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In sum, we find that the respective services are closely related and that the trade channels and classes of purchasers are the same.

We next consider the du Pont factor focusing on the similarity or dissimilarity of the marks. We must determine whether applicant's mark and registrant's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks 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). Furthermore, 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 commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

In this case, the marks PRECISE PRICING and PRECISE LIFE are similar in sound and appearance. Both marks share the identical first term PRECISE, followed by the

disclaimed and descriptive term LIFE in registrant's mark, and the descriptive term PRICING in applicant's mark. In addition, we note that the shared word PRECISE is also the first word in the marks. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

Furthermore, the marks as a whole are similar in connotation and commercial impression. The examining attorney has made of record a definition from the Encarta Dictionary wherein the word "precise" is defined (in pertinent part) as "exact or detailed: exact and accurate or detailed and specific." In view of this definition, both PRECISE LIFE and PRECISE PRICING generally connote exactness and accuracy in the respective insurance underwriting services. PRECISE LIFE and PRECISE PRICING thus have similar connotations when used in connection with the services of both applicant and registrant, and convey similar commercial impressions.

In view of the foregoing, we find that applicant's mark PRECISE PRICING is similar to registrant's mark PRECISE LIFE in sound, appearance, connotation and commercial impression.

Insofar as the du Pont factor pertaining to the purchasing conditions is concerned, we recognize that insurance agents are knowledgeable about insurance services. Moreover, even ordinary consumers are likely to exercise some degree of care in purchasing the involved insurance underwriting services. However, even sophisticated purchasers are not immune from source confusion when similar marks are used in connection with closely related services.

With respect to applicant's contention that registrant's mark PRECISE LIFE is "significantly descriptive," such an argument is no more than an impermissible collateral attack on registrant's registration and will not be entertained in this appeal. In re Peebles, Inc., 23 USPQ2d 1795 (TTAB 1992). In any event, even if registrant's mark is considered to be weak, due to the asserted laudatory nature of the word PRECISE and the descriptive nature of the word LIFE, even weak marks are entitled to protection where confusion is likely. In this case, registrant's mark PRECISE LIFE is still similar to applicant's mark PRECISE PRICING, and the respective services are closely related.

We conclude that purchasers familiar with registrant's life insurance underwriting services offered under the mark

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PRECISE LIFE would be likely to believe, upon encountering applicant's mark PRECISE PRICING for insurance underwriting services in the field of property and casual insurance, that the services originate from or are somehow associated with or sponsored by the same source.

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