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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AEGON Financial Services Group, Inc.  
v.  
Rogers Publishing, Ltd.

Opposition No. 91115854  
to application Serial No. 775467330  
filed on April 13, 1998

Jack A. Wheat, John W. Scruton and Joel T. Beres of Stites & Harbison for AEGON Financial Services Group, Inc.

James W. McKee and Sandra M. Koenig of Fay, Sharpe, Fagan, Minnich & McKee for Rogers Publishing, Ltd.

Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Rogers Publishing, Ltd. (formerly known as Maclean Hunter Publishing Ltd.) to register the mark ADVISOR'S EDGE for "magazines concerning finance and investments."<sup>1</sup>

<sup>1</sup> Application Serial No. 75467330, filed April 13, 1998, claiming a right of priority under Section 44(d) of the Trademark Act. The underlying Canadian application matured into Canadian Registration No. 504,335 on November 19, 1998. The change of

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Registration was opposed by AEGON Financial Services Group, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, as applied to applicant's goods, so resembles the previously used and registered marks ADVISOR'S EDGE for "variable annuity underwriting services"<sup>2</sup> and ADVISOR'S EDGE SELECT for "annuity underwriting services"<sup>3</sup> as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations in the notice of opposition. Applicant also set forth allegations characterized as "affirmative defenses," but which serve merely to amplify the denial of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; applicant's responses to certain of opposer's discovery requests made of record by way of opposer's notice of reliance; and opposer's responses to certain of applicant's discovery requests introduced in applicant's notice of reliance. Both parties filed briefs.<sup>4</sup>

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<sup>2</sup> Registration No. 1,968,897, issued April 16, 1996; combined Sections 8 and 15 affidavit filed.

<sup>3</sup> Registration No. 2,352,512, issued May 23, 2000.

<sup>4</sup> Opposer's reply brief was accompanied by evidence not previously made of record during trial. Applicant filed a motion to strike the evidence and the Board, in an order dated July 9, 2003, granted the motion. Accordingly, this evidence and the discussion based thereon, have not been considered in reaching our decision.

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An oral hearing was not requested.

Michael Lane, president of the advisor resources division of opposer, testified that opposer sells variable annuities. According to Mr. Lane, a variable annuity is an investment that incorporates a series of variable annuity subaccounts, similar to mutual funds, and an insurance benefit. Variable annuities are attractive to investors who are interested in tax-deferred growth and a guarantee against loss of principal. The investor has a choice of variable annuity subaccounts to incorporate into the investment, and the subaccounts are offered by companies that also offer mutual funds, such as Janus. The variable annuities sold under opposer's two marks are very similar, with the difference being that annuities sold under the mark ADVISOR'S EDGE SELECT are the subjects of higher fees (or "load") to compensate for commissions paid to the financial advisors who sell it. Because of the fees associated with the insurance component of the product, opposer's variable annuities are generally used as a retirement investment.

Opposer does not directly market its products to consumers, but rather opposer markets its variable annuities to financial advisors such as broker-dealers who act as a "middleman.". The financial advisors ultimately sell the product to their customers. Opposer publishes a newsletter,

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which it sends to financial advisors, wherein opposer's marks and products sold thereunder are mentioned.

Mr. Lane testified that sales under the mark ADVISOR'S EDGE total approximately \$200 million, and sales under ADVISOR'S EDGE SELECT are around \$50 million. Opposer's products sold under the mark ADVISOR'S EDGE account for 25-30% of the no-load variable annuity market, making opposer "a market leader." According to Mr. Lane, opposer has about 3,200 clients who have purchased annuities under opposer's ADVISOR'S EDGE marks. Mr. Lane estimated, based on his personal knowledge of the market and opposer's database of financial professionals, that about 70% of financial advisors were aware of opposer's products.

Applicant's magazine, according to the testimony of Paul Williams, a vice president of applicant, is published in Canada. The magazine is directed at professional financial planners and investment advisors, with the objective of helping them build their business. About 90% of applicant's subscriptions are provided free of charge to qualified financial advisors. Articles in the magazine cover a wide range of topics, including different types of investments and investment strategies. The circulation of applicant's magazine is approximately 37,000, with only a dozen subscriptions sold in the United States. Advertisers in applicant's magazine are typically investment companies

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offering their products, such as mutual funds and insurance, to professional financial planners and investment advisors. The advertisements include those for retirement investments.

Copies of opposer's pleaded registrations were made of record during the deposition of Mr. Lane. Mr. Lane testified that opposer owns the registrations and that they are currently subsisting. Accordingly, priority is not an issue in this case with respect to the mark and goods identified therein. See: King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). (brief, p. 18) The only issue to be decided is whether opposer has established that a likelihood of confusion exists between its pleaded marks and the mark applicant seeks to register.

Our 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. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the marks, applicant's mark ADVISOR'S EDGE is identical to opposer's mark ADVISOR'S EDGE in sound,

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appearance and meaning. Further, applicant's mark is substantially similar to opposer's mark ADVISOR'S EDGE SELECT. Opposer's mark ADVISOR'S EDGE SELECT is dominated by the ADVISOR'S EDGE portion which is identical to applicant's mark. The "SELECT" portion of opposer's mark plays a subordinate role, merely suggesting a better or preferred line of product under the ADVISOR'S EDGE brand.<sup>5</sup>

In comparing the marks, applicant contends that while both marks are suggestive, they convey different ideas. Applicant's mark, according to applicant, "suggests that the magazine gives investment professionals a competitive advantage in their respective businesses" while opposer's marks "give individual consumers of Opposer's annuity services the impression that Opposer's agents are savvy about their products, or that the products are at the leading edge over competitive annuities." (Brief, p. 6). We are not persuaded by this argument. Both marks convey the idea that financial advisors who purchase the goods or services sold thereunder will have an edge or advantage over those who do not make such a purchase.

In sum, the parties marks are, in the case of ADVISOR'S EDGE, identical in sound, appearance and meaning and, in the

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<sup>5</sup> We take judicial notice of the meaning of "select": "chosen in preference to another or others; preferred; choice; of special excellence." The Random House College Dictionary (rev. ed. 1980).

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case of ADVISOR'S EDGE SELECT, substantially similar in all respects. The fact, pointed out by applicant (Brief, pp. 8-9), that its name is prominently displayed on the magazine masthead is of no consequence inasmuch as we must consider applicant's mark as set forth in the involved application.

The crux of the controversy between the parties, and the duPont factor on which the parties concentrated their arguments, is the similarity/dissimilarity between opposer's services and applicant's goods. It is well established that the goods and/or services of the parties need not be similar or competitive, or even move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or 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 or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods and/or 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 & Telephone Corp.*, 197 USPQ

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910, 911 (TTAB 1978). Moreover, the greater the degree of similarity between applicant's mark and opposer's marks, the lesser degree of similarity between applicant's goods and opposer's services that is required to support a finding of likelihood of confusion herein. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

In comparing the goods and services, we initially note that the question of registrability herein 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 applicant's goods. *Hewlett-Packard v. Packard Technologies*, 227 F.3d 1352, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000); and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1814-15 (Fed. Cir. 1987). Thus, the facts that applicant's magazine is published in Canada, with few subscribers located in the United States, and that applicant may have no concrete plans to publish in this country, are irrelevant.

We readily acknowledge that a financial magazine is specifically different from variable annuity underwriting services. Nevertheless, these goods and services are commercially related and are directed to the same classes of purchasers. Both the goods and services relate to financial

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products; applicant's magazine discusses and advertises financial products and opposer's services involve financial products. Advertisers in applicant's magazine include investment firms offering products such as mutual funds and insurance. In this connection, Mr. Lane testified that some of these advertisers are companies whose variable annuity subaccounts are offered through the ADVISOR'S EDGE brand annuity, including Janus. Further, both the goods and services are marketed to the same target audience, namely financial advisors.

The record includes exhibits showing that opposer markets its products, at least in part, through newsletters. Although opposer's publication bears a different name, financial advisors would not be unfamiliar with the fact that publications may originate from investment firms.

Given that opposer's services and applicant's goods are marketed to financial professionals, purchases are likely to be made by relatively sophisticated individuals. This would especially be the case with opposer's services in view of the significant costs of the annuities. Opposer's services generally involve a significant investment, often in the amount of tens of thousands of dollars.<sup>6</sup> Opposer's services

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<sup>6</sup> Applicant's goods, on the other hand, are typically mailed on a complimentary basis to financial professionals; the cost of an annual subscription is around \$125.

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are marketed to financial professionals who in turn recommend them to investors as appropriate.

The sophistication of financial advisors with respect to financial instruments and investments does not mean, however, that such consumers are immune from confusion as to the origin of the respective goods and services, especially when sold under the identical marks. See: *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). That is, even relatively sophisticated financial professionals could believe that the respective goods and services come from the same source if offered under identical marks. See: *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

With respect to actual confusion, applicant asserts that there have been no instances despite contemporaneous use for nearly five years. This statement, standing alone, is insufficient to establish a finding of this factor in applicant's favor. See: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In the present case, there is insufficient information to gauge whether and to what extent there has been a meaningful opportunity for actual confusion to occur. If anything, the

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opportunity has been virtually nonexistent given that there are only one dozen subscribers of applicant's magazine in the United States. Accordingly, this duPont factor is neutral. In any event, the test is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, supra; and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Opposer maintains that its marks are famous. In support thereof, opposer alleges use of ADVISOR'S EDGE since 1994; sales of over \$250 million of variable annuities under the marks; that brand awareness of opposer's marks is 70% among financial advisors; and that opposer's ADVISOR'S EDGE brand annuity has 25-30% of the no load variable annuity market, making it "a market leader."

Opposer also points to the absence of any evidence of third-party uses or registrations of the same or similar marks in the financial field. Although applicant contends that there are numerous third-party registrations of ADVISOR and EDGE formative marks for magazines and annuity goods and services, this contention is entirely unsupported by any evidence.

The record leads us to conclude that opposer's ADVISOR'S EDGE marks are well known and are strong marks in the financial field. This factor favors opposer in our likelihood of confusion analysis.

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We conclude that purchasers familiar with opposer's variable annuity underwriting services rendered under the marks ADVISOR'S EDGE and ADVISOR'S EDGE SELECT would be likely to believe, upon encountering applicant's mark ADVISOR'S EDGE for magazines concerning finance and investments, that the goods and services originated with or were somehow associated with or sponsored by the same entity.

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The opposition is sustained.