

UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Wellington

Mailed: May 26, 2004

Opposition No. 91156105

Principal Financial
Services, Inc.

v.

Beacon Bank¹

Before Quinn, Hairston and Chapman, Administrative Trademark
Judges.

By the Board:

Applicant has filed an application to register the
mark:



for "business and consumer banking services" in
International Class 36.²

¹ On August 1, 2001, applicant recorded with the Trademark Office [at reel/frame nos. 2349/0419] its change of name from First State Bank of Excelsior to Beacon Bank. The caption of this proceeding is amended to reflect this name change. See TBMP § 512.02 (2d ed. June 2003).

² Application Serial No. 75624099 was filed on January 21, 1999. An amendment to allege use was filed on August 17, 2001, wherein applicant alleges a date of first use anywhere and in commerce of February 1, 1999.

Opposition No. 91156105

Registration has been opposed by Principal Financial Services, Inc. ("opposer") under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark is "confusingly similar to opposer's family of (triangular) design marks" and is "likely to cause confusion, deception and mistake among purchasers." The "family of triangular design marks" that opposer relies on is comprised of the following registered and applied-for marks:



Princor

for "administering and marketing mutual funds and securities" in International Class 36;³



thePrincipal

for "consulting and contract management services to health maintenance organizations and preferred provider organizations" in International Class 35; "arranging for prepaid medical care for others" in International Class 36; and "health care services rendered through preferred provider organizations and health maintenance organizations" in International Class 42;⁴

³ Registration No. 1435905 issued on April 7, 1987 with a date of first use anywhere and in commerce of March 5, 1986. The Section 8 affidavit was accepted.

⁴ Registration No. 1504246 issued on September 13, 1988 with a date of first use anywhere and in commerce of September 5, 1985. The Section 8 affidavit was accepted.



thePrincipal

for "life, health, accident and casualty insurance and reinsurance underwriting and brokerage services; underwriting, administering and managing annuities and pension funds for others; variable life insurance and variable annuities funded through a variety of funding media" in International Class 36;⁵



thePrincipal

*Financial
Group*

for "life, health, accident and casualty insurance underwriting services, investment management services, administering annuities, mutual funds, pensions and income programs for others, registered investment advisory services and broker-dealer securities services" in International Class 36;⁶



thePrincipal

for "life, health, accident and casualty insurance underwriting services, investment management services, administering annuities, mutual funds, pensions and income programs for others, registered investment advisory services and broker-dealer securities services" in International Class 36;⁷

⁵ Registration No. 1508542 issued on October 11, 1988 with a date of first use anywhere and in commerce of September 5, 1985. The Section 8 affidavit was accepted.

⁶ Registration No. 1530022 issued on March 14, 1989 with a date of first use anywhere and in commerce of September 5, 1985. The Section 8 affidavit was accepted.

⁷ Registration No. 1530023 issued on March 14, 1989 with a date of first use anywhere and in commerce of September 22, 1985. The Section 8 affidavit was accepted. The mark in the drawing is lined for the color blue, which is a feature of the mark.



for "life, health, accident and casualty insurance underwriting services, investment management services, administering annuities, mutual funds, pensions and income programs for others, registered investment advisory services and broker-dealer securities services" in International Class 36;⁸



for "real estate leasing and management services" in International Class 36;⁹ and



for "financial analysis and consulting, financial investment in the field of securities for others and securities brokerage services; life, health, accident and casualty insurance and reinsurance underwriting and insurance and investment brokerage services; underwriting, investment management and distribution of annuities and pension funds for others; underwriting variable life insurance and underwriting, investment management and distribution of variable annuities funded through a variety of funding media; commercial and residential real estate services, namely, brokerage, investment, management, mortgage loan, and financial valuation services; investment management services, investment management and distribution of mutual funds and income programs for others, investment advice and consultation services and security brokerage services; real estate leasing and management services; financial services,

⁸ Registration No. 1531199 issued on March 21, 1989 with a date of first use anywhere and in commerce of September 22, 1985. The Section 8 affidavit was accepted. The mark in the drawing is lined for the color blue, which is a feature of the mark.

⁹ Registration No. 1698013 issued on June 30, 1992 with a date of first use anywhere and in commerce of December 1, 1985. The Section 8 affidavit was accepted; renewed.

Opposition No. 91156105

namely, administration of healthcare plans and insurance claims administration for healthcare plans" in International Class 36.¹⁰

Opposer also specifically alleges, *inter alia*, in the notice of opposition that "through its licensees, subsidiaries and predecessors-in-interest, [opposer] is using and has used its (triangular) design marks worldwide since at least as early as 1985 for a wide variety of services"; that these services "include but are not limited to banking services and financial investment services"; that these services are "marketed and sold through various distribution channels" and "as such, opposer sells, distributes and promotes its services to the general public"; that "long prior to applicant's filing of its application to register the BEACON & (triangular) Design mark, opposer, through its licensees, subsidiaries and predecessors-in-interest, has used opposer's family of (triangular) design marks in interstate commerce in connection with opposer's goods and services"; and that applicant is using the color blue in connection with its proposed mark and two of opposer's pleaded registrations, namely, Registration Nos. 1530023 and 1531199, claim the color blue as a feature of the mark.

¹⁰ Application Serial No. 76423430 was filed June 20, 2002, with an allegation of a date of first use anywhere and in commerce of November 1, 1985. The application is pending and was published in the Official Gazette for opposition on April 27, 2004.

Opposition No. 91156105

Applicant, in its answer, admitted "the existence of [opposer's] cited registrations and pending application"; that "applicant is using the color blue in connection with [applicant's mark]"; and that "of opposer's federal registrations for its family of (triangular) design marks, both Reg. No. 1530023 and Reg. No. 1531199 claim the color blue as a feature of the mark." Applicant otherwise denied the remaining allegations in the notice of opposition.

This case now comes up for consideration of opposer's motion (filed January 12, 2004) for summary judgment on the issue of likelihood of confusion. The parties have briefed the motion. In order to expedite our decision, the Board presumes familiarity with the issues presented and does not provide a complete recitation of the allegations and contentions of each party.

In its motion, opposer asserts that on November 14, 2003, it served discovery requests, including requests for admissions, on applicant; that applicant has not responded to these discovery requests; and, therefore, the requests for admissions are deemed admitted by applicant under Fed. R. Civ. P. 36. [A copy of opposer's requests for admissions is attached to the motion]. Opposer argues that these admissions by applicant include admissions that "[a]pplicant is aware of instances or occurrences of actual consumer confusion between [the parties marks]"; that both parties

Opposition No. 91156105

offer the same services, namely, "consumer and mortgage loan, credit card, checking and savings account, construction, and business loan services" in connection with their respective marks; that "[a]pplicant was aware of opposer's (triangular) Design marks prior to filing [the subject application]"; that applicant's proposed mark is similar in appearance to opposer's "(triangular) design marks"; that opposer has used its (triangular) Design marks since at least as early as 1985; and that opposer's "(triangular) design marks" are famous.

In addition, opposer notes that applicant made the previously discussed admissions in its answer to the notice of opposition. And, based on the admissions in the answer and those deemed by Rule 36 to be admitted, opposer concludes that there is no genuine issue of material fact in this case as to any of the relevant factors pertaining to likelihood of confusion; and that opposer is entitled to judgment as a matter of law.

In response to the motion, applicant does not offer substantive arguments as to why judgment as a matter of law should not be entered in opposer's favor. Indeed, applicant does not contend that a genuine issue of material fact remains. Instead, applicant argues in its response that it believed "an understanding had been reached with opposer's attorney that all discovery would be deferred." Applicant

Opposition No. 91156105

refers to a letter (dated November 5, 2003) from opposer's counsel to applicant's counsel and a consented motion for extension of time (filed by opposer on November 7, 2003). Applicant states that it was its understanding that "all discovery, including any discovery responses, would be deferred until after the holidays with a schedule to be determined." Applicant further states that opposer's discovery requests (including the admission requests relied on in the summary judgment motion) were "served during the extended discovery period and the undersigned would not have consented to the extension without the described understanding as to the deferral." Applicant does not seek leave to withdraw or amend any admissions effectively admitted under Fed. R. Civ. P. 36 but requests that the summary judgment motion be denied.

Opposer filed a reply brief wherein it states that applicant "had no reasonable basis to believe that there was any agreement to 'defer discovery.'" Opposer states that counsel for the parties "spoke regarding an extension of the discovery *period* on November 5, 2003, in order to allow time to complete discovery." [Italics in original]. Opposer states that its letter to applicant's counsel (dated November 5, 2003) and its consented motion (filed November 7, 2003) make it "quite clear" that "the actual intent was simply to extend the deadline of the discovery period."

Opposition No. 91156105

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e), and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

We have carefully considered the parties' arguments and evidentiary submissions. For the reasons discussed below, we find that no genuine issues of material fact exist as to opposer's standing, priority, and/or the factors bearing on

Opposition No. 91156105

likelihood of confusion, and that opposer is entitled to judgment as a matter of law on its Section 2(d) claim.

Preliminarily, we turn to opposer's request to deem its requests for admission as admitted based on applicant's failure to respond to said requests. Fed. R. Civ. P. 36 provides that if a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR § 2.120(j)(3)(i), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Rule 36(b), and granted by the Board. See also TBMP § 527.01(d) (2d ed. June 2003).

It is clear that applicant failed to respond to opposer's requests for admission. We also find that applicant has not shown that its failure to respond was the result of excusable neglect. See TBMP § 407.03(a) (2d ed. June 2003) regarding failure to timely respond to requests for admissions, and cases and authorities cited therein. Applicant's argument regarding its understanding that counsel for the parties agreed to "defer" discovery requests including responses is without basis and lacks logic. The November 5, 2003 letter from opposer's counsel to

Opposition No. 91156105

applicant's counsel and opposer's follow-up, consented motion for extension of time clearly set forth an "extension" of the discovery period and make no reference whatsoever to any "deferral" of any due dates for discovery responses. The consented motion for extension of time also sets forth proposed dates for the close of discovery and testimony periods. If the parties intended to also defer discovery responses, then clearly the motion's proposed resetting of testimony periods to follow shortly after the close of the discovery deadline infers that there was no intention to defer discovery. Certainly, at the very least, upon receiving opposer's November 5, 2003 letter, the consented motion to extend and opposer's discovery requests (with a demand that responses be filed within thirty days), applicant was put on notice that there were some incongruities between its stated understanding of a deferral of discovery and the fact these papers infer there was no such deferral. Applicant does not explain why it did not simply contact opposing counsel to clarify this matter, or file appropriate motions with the Board.

In view of the above, the requests for admissions served on applicant stand admitted, including applicant's admissions that its mark is similar to opposer's marks; that opposer's mark is famous; that the parties use their

Opposition No. 91156105

respective marks in connection with identical services; and that applicant is aware of instances of actual confusion.

Specifically, as to priority, applicant has admitted (by way of admission request No. 40) that opposer used its (triangular) design marks since at least as early as 1985. Thus, there is no genuine issue that opposer has priority based on its use since as early as 1985 which precedes applicant's claimed date of first use of February 1, 1999.

As to the issue of likelihood of confusion, we also find no genuine issue of material fact remains for trial. Based on the record and admissions applicant is deemed to have admitted, we find that the parties' respective marks are similar in appearance; that the parties use their marks in connection with identical services; that the parties' services travel are offered through the same trade channels to the same types of customers; that applicant is aware of instances of actual confusion between the parties' marks; and that opposer's pleaded marks are famous.

Accordingly, opposer's motion for summary judgment is granted, the opposition is sustained, and registration of applicant's mark is refused.

* * *