

Hearing:
September 18, 1996

Paper No. 27
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Life Insurance Company
v.
Americo Life, Inc.

Opposition No. 94,781
to application Serial No. 74/437,939
filed on September 20, 1993

William J. Thomashower of Kaplan, Thomashower & Landau for
American Life Insurance Company.

Robert D. Hovey of Hovey, Williams, Timmons & Collins for
Americo Life, Inc.

Before Cissel, Seeherman and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Americo Life, Inc. to
register the mark



for "life insurance underwriting services."¹

An opposition has been filed by American Life Insurance Company on the grounds that since at least as early as 1952 opposer has used the trade name and service mark AMERICAN LIFE INSURANCE COMPANY and the service mark ALICO for life insurance, annuities, group life, and accident and health insurance; that opposer is the owner of the following previously used and registered marks:



for "underwriting of life insurance and annuities,"² ALICO

¹Application Serial No. 74/437,939 filed September 20, 1993; claiming dates of first use and first use in commerce on July 6, 1993. The words "LIFE" and "INC" are disclaimed apart from the mark as shown.

²Registration No. 1,771,807 issued May 18, 1993. The words "LIFE INSURANCE COMPANY" are disclaimed apart from the mark as shown.

for underwriting of life and accident and health insurance and annuities,"³ and



**American Life
Insurance Company**

for underwriting of life and accident and health insurance and annuities;"⁴ and that applicant's mark AMERICO LIFE INC and design, when used in connection with life insurance underwriting services, is likely to cause confusion under Section 2(d) of the Trademark Act with opposer's previously used trade name and service marks.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

Two evidentiary disputes have arisen between the parties. The first involves the materials submitted by applicant under notice of reliance. Applicant submitted over 100 plain copies of third-party registrations of marks which include the word AMERICAN for insurance services; copies of excerpts from Best's Insurance Reports (1994) listing insurance companies with trade names which include

³Registration No. 1,046,125 issued August 10, 1976; Sections 8 & 15 affidavit filed.

⁴Registration No. 1,042,480 issued June 29, 1976; Sections 8 & 15 affidavit filed. The words "LIFE INSURANCE COMPANY" are disclaimed apart from the mark as shown.

AMERICAN;⁵ and the file history of each of opposer's pleaded registrations. Opposer objected to the third-party registrations and the registration file histories on the ground that they are not certified and objected to the excerpts from Best's Insurance Reports on the ground that they are not authenticated.

It is not necessary that the copy of a third-party registration submitted with a notice of reliance be certified or that it be a current status and title copy prepared by the Office. A plain copy is sufficient. See Trademark Trial and Appeal Board Manual Of Procedure (TBMP) §703.02(b) and cases cited therein. Further, certification of the file history of a registration is not required. See TBMP §703.02(a). Finally, it is not necessary that the excerpts from Best's Insurance Reports be authenticated. See TBMP §708 and Trademark Rule 2.122(e). In view of the foregoing, opposer's objections to the materials submitted by applicant under notice of reliance are not well taken.

The second dispute involves the testimony of opposer's witness, Karen Gatenby, taken during opposer's rebuttal testimony period. Applicant has moved to strike Ms. Gatenby's deposition, with exhibits, as improper rebuttal. According to applicant, Ms. Gatenby testified "about the

⁵Each excerpt lists, inter alia, the name, address, and telephone number of the insurance company; its financial rating; and a summary of its financial operations.

nature of [opposer's] business, its ownership, its annual reports, its formation, its submission of financial information to authorities, its financial statements, its use of certain business forms and marks, its promotional activities and expenditures, and its challenges in the courts and the Patent and Trademark Office to marks of third parties, and [to] her opinion as to the likelihood of confusion between the marks of the parties in this case." (Applicant's Motion to Strike, p. 3). Applicant maintains that testimony relating to these matters should have been taken during opposer's case-in-chief, rather than during rebuttal.⁶ Opposer, however, contends that the testimony is proper rebuttal since it serves to refute applicant's evidence that opposer's marks are weakened by the existence of third-party registrations and trade names.

During rebuttal testimony, an opposer may introduce facts and witnesses appropriate to deny, explain or otherwise discredit the facts or witnesses of applicant. See *Western Leather Goods Company v. Blue Bell, Inc.*, 178 USPQ 382 (TTAB 1973). Because applicant's record includes third-party registrations and a list of trade names which include AMERICAN, opposer is entitled to present testimony which shows opposer's efforts to police its marks. See *Burns Philip Food, Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992). However, testimony relating to the nature of

⁶Opposer took no testimony during its case-in-chief.

opposer's business, its financial condition, advertising and promotional activities, etc. should have been presented as part of opposer's case-in-chief. See *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767 (TTAB 1980).⁷ Thus, applicant's motion to strike is granted to the extent that only those portions of Ms. Gatenby's testimony and exhibits which pertain to opposer's efforts to police its marks have been considered.⁸

The record in this case consists of the pleadings; the file of the involved application; status and title copies of opposer's pleaded registration submitted under notice of reliance; copies of third-party registrations, excerpts from Best's Insurance Reports, and the file histories of opposer's pleaded registrations submitted by applicant under notice of reliance; and relevant portions of the testimony deposition with exhibits of Ms. Gatenby.

Both parties filed briefs on the case and were present at the oral hearing.

Priority is not in issue since opposer has made of record status and title copies of its three pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover,

⁷While certain of the testimony (e.g., the extent of use of opposer's pleaded marks and opposer's promotional activities) may also relate to the strength of opposer's marks, it nonetheless should have been presented during opposer's case-in-chief.

⁸Even if we had considered the remainder of Ms. Gatenby's testimony, our decision herein would be the same.

applicant has conceded the virtual identity of the parties' services. (Brief, p. 6). We turn then to a consideration of the similarity/dissimilarity of the parties' marks.

We find that applicant's mark AMERICO LIFE INC and design and opposer's ALICO mark are sufficiently different in sound, appearance and commercial impression that confusion is not likely to result even though the marks are used in connection with virtually identical services. *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990).

We turn then to a comparison of applicant's mark and opposer's two AMERICAN LIFE INSURANCE COMPANY and design marks.

We begin our analysis by keeping in mind two principles set forth by the Court of Appeals for the Federal Circuit. First, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Second, "in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 748, 751 (Fed. Cir. 1985).

Applying these principles here, we find that applicant's mark AMERICO LIFE INC and design is sufficiently similar to each of opposer's AMERICAN LIFE INSURANCE COMPANY and design marks that confusion among consumers is likely to occur as the result of the contemporaneous use of these marks on virtually identical services. In reaching this conclusion, we recognize that applicant's mark and opposer's marks include different design features. However, we think it is appropriate to give greater weight to the word portions of the respective marks because it is by the words that customers will refer to the services, and the words, rather than the designs, play a larger role in creating the commercial impressions these marks engender. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). The word portions of the parties' marks--AMERICO LIFE INC and AMERICAN LIFE INSURANCE COMPANY--are strikingly similar in commercial impression. We must keep in mind that the average consumer retains a general rather than a specific impression of trademarks in the marketplace and may not even notice the slight differences between applicant's and opposer's marks. If consumers do notice the differences, they are not likely to regard the differences as indicating that the services come from different sources. Rather, when the parties' marks are used in connection with virtually identical services, consumers are likely to believe that the services emanate from the same source, and that the marks

are merely variants, used by a single source to differentiate its different lines of insurance.

While we have carefully considered the evidence of third-party marks and trade names submitted by applicant, we do not find it persuasive of a different result. We acknowledge that AMERICAN is an element in numerous marks for insurance companies. However, our finding of likelihood of confusion is not based simply on the inclusion of AMERICAN and AMERICO in the parties' marks. Rather, we considered, as required, the disclaimed matter LIFE INSURANCE COMPANY and LIFE INC. It is the entire literal portions of the parties' marks which engender markedly similar commercial impressions. Thus, the fact that other marks containing AMERICAN have been registered is not controlling as to whether or not the specific marks involved herein are in conflict. See *Gastown Inc. of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975). Moreover, we note that none of the marks in the third-party registrations is as similar to opposer's marks involved here as is applicant's mark. Of the over 100 third-party registrations submitted by applicant, only twelve are for marks which include the words AMERICAN and LIFE. Each of the twelve registered marks contains other distinguishing wording, e.g., HERITAGE, BENEFIT, CONTINENTAL, MAYFLOWER, FOUNDERS, PHILADELPHIA.

As to the excerpts from Best's Insurance Reports, this evidence is cumulative of the third-party registrations in

showing the sense in which AMERICAN is employed in the marketplace.⁹ Only about twenty of the companies listed in this publication incorporate AMERICAN and LIFE in their trade names. Of those twenty companies, all but one include other distinguishing wording in their trade names. Thus, applicant's evidence of third-party use of AMERICAN does not persuade us that consumers will believe that opposer's AMERICAN LIFE INSURANCE COMPANY and design marks and applicant's mark AMERICO LIFE INC and design identify insurance services emanating from separate sources.

Finally, applicant argues that opposer is estopped from maintaining that there is a likelihood of confusion here because this is inconsistent with the position taken by opposer during the prosecution of the application which matured into opposer's Registration No. 1,771,807. The Examining Attorney in charge of that application refused registration under Section 2(d) of the Trademark Act in view of a registration for the mark AMERICAN LIFE AND CASUALTY INSURANCE COMPANY and design. Opposer subsequently obtained a consent from the owner of the cited registration and agreed therein that there was no likelihood of confusion between the respective marks. Apart from the fact that we do not view opposer's positions as inconsistent, it is well settled that an opposer is not estopped in an opposition

⁹There is significant overlap between the trade names in Best's Insurance Reports and the marks in the third-party registrations.

proceeding from taking a position different from that which it took before the Examining Attorney during prosecution of its application. See *Institutional Wholesalers, Inc. v. Saxons Sandwich Shoppes, Inc.*, 170 USPQ 107 (TTAB 1971).

In sum, when applicant's mark AMERICO LIFE INC and opposer's AMERICAN LIFE INSURANCE COMPANY and design marks are compared in their entireties, with appropriate weight given to the dominant word portions, the marks are substantially similar in commercial impression. Thus, the contemporaneous use of these marks in connection with virtually identical services is likely to cause confusion among consumers.

Decision: The opposition is sustained.

R. F. Cissel

E. J. Seeherman

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board