

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB

AUG 26, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **General Electric Capital Insurance Company**

Serial No. 74/**560,083**

Faye Mattson of Christensen O'Connor Jonhson & Kindness,
PLLC, for General Electric Capital Insurance Company.

Darlene Bullock, Trademark Examining Attorney, Law Office
101 (Chris Wells, Managing Attorney).

Before **Simms**, Cissel and Hairston, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 11, 1994, applicant filed the above-
referenced application to register the mark "SOLUTION PLUS"
on the Principal Register for the service of "underwriting
annuities," in Class 36. The application was based on
applicant's claim that it had used the mark in connection
with these services in interstate commerce since May 2,
1994.

Registration was refused under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with underwriting annuities, so resembles the marks in eight registrations on the Principal Register that confusion is likely. The registered marks are as follows: "THE SOLUTION FAMILY,"¹ "SOLUTION VI,"² "SOLUTION VII,"³ "SOLUTION FIVE,"⁴ "SOLUTION FOUR,"⁵ "THE CHARITABLE SOLUTION,"⁶ "THE INVESTMENT SOLUTION,"⁷ and "THE SOLUTION."⁸ All the cited registrations were owned by the same entity, Hartford Life Insurance Company Corporation. Four of the cited registrations were subsequently cancelled under the provisions of Section 8 of the Act, but the registrations for "THE SOLUTION," "THE SOLUTION FAMILY," "SOLUTION VI," and "THE CHARITABLE SOLUTION" remain in full force and

¹ Reg. No. 1,643,006, issued on April 30, 1991, claiming use since 1987. Combined affidavit filed under Sections 8 and 15.

² Reg. No. 1,643,003, issued on April 30, 1991, claiming use since May 8, 1989. Combined affidavit filed under Sections 8 and 15.

³ Reg. No. 1,642,289, issued on April 23, 1991, claiming use since June 16, 1989. Cancelled under Section 8 on October 28, 1997.

⁴ Reg. No. 1,642,288, issued on April 23, 1991, claiming use since July 1, 1986. Cancelled under Section 8 on October 28, 1997.

⁵ Reg. No. 1,642,287, issued on April 23, 1991, claiming use since July 1, 1986. Cancelled under Section 8 on October 28, 1997.

⁶ Reg. No. 1,651,671, issued on July 23, 1991, claiming use since December 4, 1989. Combined affidavit filed under Sections 8 and 15. The term "CHARITABLE" is disclaimed.

⁷ Reg. No. 1,604,037, issued on June 26, 1990, claiming use since September 18, 1989. The term "INVESTMENT" is disclaimed. Cancelled under Section 8 on December 30, 1996.

⁸ Reg. No. 1,296,804, issued on September 18, 1984, claiming use since April of 1981; combined affidavit filed under Sections 8 and 15.

effect. All list the services rendered thereunder as "life insurance underwriting services." The cancelled registration for the mark "THE INVESTMENT SOLUTION" listed the services of the registrant under that mark as "life insurance and annuity underwriting services."

When the refusal to register was made final, applicant filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing.

Accordingly, we have resolved this appeal on the written record and arguments. Based on careful consideration of these materials, we find that the refusal to register is proper in this case. Confusion is likely because applicant's mark, as used in connection with the services set forth in the application, is quite similar to several of the cited registered marks, and the services with which these marks are used are closely related.

Turning first to the latter issue, we note that the record in this application clearly establishes the close relationship between underwriting annuities and underwriting life insurance. As we noted above, one of the cited registrations, No. 1,604,037, listed both services in the same registration. The registrant is an insurance company, and it underwrites not just insurance, but also annuities. Moreover, applicant's specimens, which are promotional

brochures for its own services, invite prospective customers to contact their insurance representatives in order to find out more about applicant's service of underwriting annuities. Underwriting annuities and underwriting life insurance are closely related financial services sold to the same people by the same people for related purposes. When similar marks are used in connection with these activities, confusion is likely.

Several of the marks cited as bars to registration are similar to applicant's mark. We need not find confusion likely with respect to all of the cited registered marks. It is a sufficient basis for affirming the refusal to register if confusion is likely with respect to any of them. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd* 17 USPQ2d 1726 (Fed. Cir. 1990). We find confusion particularly likely between applicant's "SOLUTION PLUS" mark and "THE SOLUTION," "THE SOLUTION FAMILY," and "SOLUTION VI."

We note for the record that the original theory of the Examining Attorney that the cited registrations constitute a family of marks to which applicant's mark would be assumed to belong is not supported by this record. As applicant points out, we cannot consider the different marks in the cited registrations to be a family without evidence that they are used and promoted as such by the registrant. In

the instant case, we have no proof whatsoever that this is so.

The mark of the applicant and the marks in the cited registrations are similar because of the prominence of the common word "SOLUTION." We acknowledge that this term has a somewhat suggestive connotation in connection with the services of underwriting life insurance and annuities, in the sense that it suggests that the services are the answer to the problems of the prospective purchaser of the services, but the suggestion raised by the word is the same in both applicant's mark and the cited registered marks, so applicant's argument that the suggestive nature of the word makes confusion less likely is not persuasive.

The word "SOLUTION" is the dominant component in applicant's mark, as well as in "THE SOLUTION," "THE SOLUTION FAMILY," and "SOLUTION VI." The other elements with which the word is combined are not as significant as "SOLUTION" is in determining the commercial impressions of each of these marks.

A primary thrust of applicant's argument in favor of registration concerns a number of third-party registrations of marks which include the word "SOLUTION" which are registered for insurance and financial services. Applicant contends that these registrations demonstrate that the field is crowded with marks which include this word, such that the

cited registered marks are weak and entitled to only a narrow scope of protection. Applicant argues that this does not extend to the barring of applicant's mark.

While the third-party registrations have been considered, in that they help establish and confirm the meaning or connotation of the word, they are not persuasive proof that confusion is unlikely. In the absence of evidence of use, they are not entitled to much weight on the issue of likelihood of confusion. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). The registrations themselves are not evidence of use of the marks therein, so we cannot conclude from them that people in the consuming public have become so familiar with marks containing "SOLUTION" for insurance and financial services that they look to other elements in such marks in order to distinguish among them. Moreover, as the Examining Attorney points out, even if applicant were to have established that the cited marks were widely used and were in fact weak, even weak marks are entitled to protection against registration of similar marks for closely related services. In re National Data Corp., 222 USPQ 515 (TTAB 1984), aff'd 224 USPQ 749 (Fed. Cir. 1985). The existence of confusingly similar marks on the register does not mandate registration of another mark likely to cause confusion. In re National Novice Hockey League, Inc., 222 USPQ 638 (TTAB 1984).

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The mark applicant has applied to register, "SOLUTION PLUS," is similar enough in sound, appearance and connotation to the registered marks "THE SOLUTION," "THE SOLUTION FAMILY," and "SOLUTION VI" that the commercial impressions these marks create are all similar. When applicant's mark is used in connection with services as closely related to underwriting life insurance as underwriting annuities is, confusion is clearly likely. Accordingly, the refusal to register under Section 2(d) of the Act is affirmed.

R. L. Simms

R. F. Cissel

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

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