

Oral Hearing:  
April 8, 1998

Paper No. 19  
GDH/gdh

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FEB. 12, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Hartford Life Insurance Company**

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Serial No. 74/410,829

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**John R. Garber** of **Cooper & Dunham LLP** for **Hartford Life Insurance Company**.

**Henry S. Zak**, Trademark Examining Attorney, Law Office 108  
(**David Shallant**, Managing Attorney).

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Before **Seeherman, Hohein and Walters**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

**Hartford Life Insurance Company** has filed an application to register the mark "CHOICE BENEFIT PLAN" for "life insurance underwriting services".<sup>1</sup>

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 applied to its goods, so resembles the mark "CHOICE OPTION," which is registered for "group insurance underwriting services in the field of health and accident

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<sup>1</sup> Ser. No. 74/410,829, filed on July 8, 1993, which alleges dates of first use of March 1990.

insurance and attendant group life insurance services,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

Turning first to consideration of the respective services, we note that they are identical in part (life insurance underwriting services) and are otherwise closely related insurance underwriting services. Clearly, if such services, which would be sold through the same channels of trade to identical classes of purchasers, were to be offered under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur. Applicant, we observe, does not contend otherwise, having stated in its initial response to the refusal to register that it "agrees that the [respective] services are related and that the primary element of both marks is the word CHOICE." Applicant maintains, however, that the marks "CHOICE BENEFIT PLAN" and "CHOICE OPTION" are not so substantially similar, particularly when considered in light of several third-party registrations for marks which feature the term "CHOICE,"<sup>3</sup> as to be likely to cause confusion.

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<sup>2</sup> Reg. No. 2,010,349, issued on October 22, 1996, which sets forth a date of first use anywhere of September 2, 1992 and a date of first use in commerce of October 31, 1992.

<sup>3</sup> Applicant, in its response to the first Office action, listed by registration number "the following marks in the insurance field which contain the word CHOICE": "CHOICE HEALTHCARE PLAN"; "CHOICE FLEX"; "EMPLOYEE'S CHOICE"; "MUTUAL CHOICE"; "CHOICE PLUS" and "LIFE CHOICE". Although the Examining Attorney, citing *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974), pointed out in reply that, "[p]rocedurally, a listing ... is insufficient to establish these registration[s] as documents of record" so as to support "the applicant's assertion of 'weakness' or dilution," applicant continued to refer to the same

Specifically, applicant contends among other things that:

The respective marks are different. CHOICE BENEFIT PLAN and CHOICE OPTION are distinct from one another and create separate and distinct commercial impressions. The Trademark Examiner's argument is that because CHOICE is the dominant portion of the marks and the services are closely related, there must be a likelihood of confusion. This argument does not hold up under logical

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listing of "registrations covering insurance related services which contain the word CHOICE" and the Examining Attorney, in his final refusal, discussed such information and treated it as being of record (raising no further objection thereto until his brief on the case). Applicant, in its brief on appeal, also listed by registration number the following four additional marks, the registrations for which "cover insurance underwriting services in the same field as those covered by [the marks] CHOICE BENEFIT PLAN and/or CHOICE OPTION": "CHOICE FUNDER"; "FIRST CHOICE"; "TERMCHOICE" and "GROUP CHOICE". In his brief on the case, the Examining Attorney, citing *Duofold, supra*, once again noted that, "[p]rocedurally, a listing ... is insufficient to establish that these registrations ... are properly introduced as evidence to support the assertion of 'weakness' of a term."

As a general proposition, the Examining Attorney is correct that a mere listing of third-party registrations (including statements of information purportedly pertaining thereto) is insufficient to make such registrations of record. See, e.g., *In re Duofold Inc., supra*. Instead, the proper procedure for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the Patent and Trademark Office's own computerized database. See, e.g., *In re Consolidated Cigar Corp.*, 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Thus, while the Examining Attorney is correct that applicant failed to follow the proper procedure, we nevertheless find that, as to the six third-party registrations initially listed by applicant, the Examining Attorney's objection thereto is considered to have been waived, especially since the information was subsequently discussed without objection and was therefore treated as being of record. See, e.g., *In re Melville Corp., supra*. Such evidence has accordingly been considered for whatever probative value it may have. However, as to the four additional third-party registrations listed for the first time in applicant's brief, the objection thereto raised in the Examining Attorney's brief is sustained and the information concerning those registrations, which in any event is untimely under Trademark Rule 2.142(d), has not been further considered. We note, nevertheless, that if applicant's information concerning such registrations was deemed to be of record, it would make no difference in the result in this appeal.

scrutiny ... and the existence of other similarly formed marks. There are numerous co-existing registrations where the prefix portions are the same and the suffix portions differ.

Pointing to a list of third-party registrations which assertedly "cover insurance underwriting services in the same fields as those covered by [the marks] CHOICE BENEFIT PLAN and/or CHOICE OPTION," applicant insists that "the exact same arguments that the Trademark Examiner made in this case could have been made with equal effect with respect to any of the above referred[-]to registrations, and could also have been made in the case of any of the above marks against each other." In particular, applicant urges that:

For example, ... [t]he Trademark Examiner could have made the exact same arguments that the marks CHOICE PLUS and CHOICE BENEFIT PLAN are confusingly similar .... The fact that these arguments are interchangeable for many different marks leads to the inexcapable [sic] conclusion that no likelihood of confusion can exist. After all, CHOICE OPTION is at least as similar to CHOICE PLUS and the other CHOICE registrations as it is to CHOICE BENEFIT PLAN. If all of the ... CHOICE registrations can co-exist on the Register then the owner of CHOICE OPTION cannot, as a matter of law, be damaged by the existence of CHOICE BENEFIT PLAN on the Register.

It appears that the Trademark Examiner's decision to cite the CHOICE OPTION registration as a reference in this matter rather than CHOICE PLUS or any of the other CHOICE marks was a completely random decision which was without foundation.

Citing, in addition, BAF Industries v. Pro-Specialties, Inc., 206 USPQ 166, 175 (TTAB 1980), applicant argues that the third-party registrations listed "show the popularity of the

CHOICE portion of the mark[s] in this field." As a result, applicant asserts that such marks--including the cited registration--are entitled to but a narrow or restricted scope of protection.

We are constrained to agree with the Examining Attorney, however, that confusion is likely. Our principal reviewing court has noted, as a general proposition, that "[w]hen marks would appear on virtually identical ... services, the degree of similarity [of the marks] 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, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Here, as previously indicated, the respective services are identical in part and are otherwise closely related insurance underwriting services. The respective marks are dominated by the word "CHOICE," due not only to the prominent manner in which applicant utilizes such word, as shown by the specimens of use, but also on account of the high degree of suggestiveness in the word "OPTION" in registrant's "CHOICE OPTION" mark and the genericness of the term "BENEFIT PLAN" in applicant's mark. As the Examining Attorney accurately observes:

While the [E]xamining [A]ttorney cannot ignore a disclaimed portion of a mark and must view marks in their entirety, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

In applicant's mark CHOICE BENEFIT PLAN, the disclaimed generic term "benefit plan" has a less significant role in creating the commercial impression of the mark. Moreover, since the applicant presents the mark in typed form, it is not restricted to one format for displaying the mark. An examination of the specimens of record is permitted to view the display of the mark, and its commercial impact. In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986)[.] Such examination clearly shows that the word CHOICE is displayed on a separate line from the generic term "benefit plan" in larger bolder lettering, being [therefore] the most predominant [sic] feature of the entire mark.

For these reasons, the word CHOICE[,] in its visual display and commercial significance, creates the predominant [sic] impact of applicant's mark.

The registrant's mark consists of the words CHOICE OPTION. While not disclaimed, the term "option" is commonly used in the [underwriting] industry, identifying aspects of the same, or different, insurance policies. The applicant itself, on the specimens of record, [which are] booklets describing the services, uses the term "option" several times in a descriptive manner:

#### HERE'S HOW IT WORKS

Each option is explained in detail on the following pages. To understand your options fully, it's important that you know the basic differences between term life insurance and universal life insurance.

If you took one of the insurance options Mutual Benefit Life will waive the cost ....

How is the benefit determined under the Saver's Reduced option?

Even viewing the registrant's mark as a unitary term, the addition of the word "option" does not materially alter the commercial impression of the registered

mark--to give the consumer, in selection of insurance programs, the option of choice.

This is highly similar, if not identical, to the meaning of the applicant's mark, created by the identical word "choice": a choice of different life insurance benefit plans.

We consequently concur with the Examining Attorney that, overall, the "commercial impression generated by each mark is highly similar, if not identical" when used on the same or substantially similar life insurance services. As underscored by applicant's specimens, a prospective customer for applicant's "CHOICE BENEFIT PLAN" life insurance underwriting services could readily believe, in view of the choice of options offered, that the benefit plan provided by such services has its origin in or is sponsored by the same source as provides the attendant group life insurance underwritten by registrant's "CHOICE OPTION" insurance services (*emphasis added*):

NOW YOU HAVE A *CHOICE*

Your employer-paid life insurance has always been group term life. No matter what your personal needs were, there was only one plan. Until now. Now, your employer is offering you the Choice Benefit Plan. *With this plan, you can actually pick the life insurance benefit that best suits you and your needs.*

This booklet explains how the *plan* works and describes each of the four coverage *options*. .... In the next few weeks, a Benefits Counselor will be available to answer your questions and enroll you in the *plan of your choice*.

With respect to applicant's reliance upon information concerning several third-party registrations containing the word

"CHOICE," the Board in *BAF Industries v. Pro-Specialties, Inc.*, supra, stated in pertinent part that:

[Although third-party registrations are incompetent to establish that two composite marks, other than those disclosed by the registrations, [when] considered in their entirety are not in conflict [See: *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268 (CCPA, 1973) and cases cited therein]; they are relevant to show that a particular mark has been adopted and registered by so many individuals in a particular field for different products embraced by said field that a registration of the mark in that trade is entitled to but a narrow or restricted scope of protection [See: *The Conde Nast Publications, Inc. v. American Greetings Corporation*, 141 USPQ 249 (CCPA, 1964)] and to show the dictionary meaning of a portion of a mark by virtue of the adoption and registration of others in the same field of marks comprising this term obviously to represent the meaning thereof to customers and prospective customers who would readily be aware of its significance so that the inclusion of this term in two marks would be insufficient, per se, to support a holding of likelihood of confusion. [See: *The Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 USPQ 422 (CCPA, 1975) and *Tektronix, Inc. v. Daktronics, Inc.* 189 USPQ 693 (CCPA, 1976).]

The Board in *BAF Industries* went on to find, however, that while the evidence of third-party registrations reflected that the term "PRO," as a recognized abbreviation for the word "professional," had a laudatory connotation as applied to most products (by indicating that they were utilized by professionals or were of professional quality) and that marks which consisted of or included such term consequently were weak marks which were entitled to only a narrow scope of protection, the addition of the term "SPECIALTIES" to form the mark "PRO-SPECIALTIES" for use in connection with a variety of detergents, cleaners, polishes

and waxes was insufficient to distinguish such mark from, and avoid a likelihood of confusion with, various "PRO" marks for a variety of products including waxes, polishes and cleaners. The same is true in this case.

Here, as the Examining Attorney has correctly pointed out, third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. See, e.g., In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983). Such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and the existence on the register of confusingly similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1967); and Lilly Pulitzer, Inc. v. Lilly Ann Corp., 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967). Furthermore, none of the marks listed by applicant (with the possible exception of the mark "CHOICE HEALTHCARE PLAN") consists of the word "CHOICE" followed by, as in applicant's "CHOICE BENEFIT PLAN" mark, a generic term for life insurance underwriting services. Thus, unlike the cited "CHOICE OPTION" mark, none of the third-party registrations projects essentially the same commercial impression as applicant's "CHOICE BENEFIT PLAN" mark. Instead, as the Examining Attorney cogently argues:

[T]he terms "flex" and "plus" [in such marks as CHOICE FLEX and CHOICE PLUS] are not generic or descriptive terms in the field, but have vague or indefinite meanings. When combined with the word "choice" they create marks which, viewed in their entirety, have

significant ... differences in meaning [and commercial impression] from the marks in issue, which combine "choice" with generic or descriptive terms.

We conclude, therefore, that purchasers and prospective customers, familiar with registrant's mark "CHOICE OPTION" for group insurance underwriting services in the field of health and accident insurance and attendant group life insurance services, could reasonably assume, upon encountering applicant's substantially similar mark "CHOICE BENEFIT PLAN" for life insurance underwriting services, such identical and otherwise closely related insurance services emanate from, or are sponsored by or affiliated with, the same source. Moreover, to the extent that we may nevertheless entertain any doubt as to this conclusion, we resolve such doubt, as we must, in favor of the registrant. See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and *In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

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

E. J. Seeherman

G. D. Hohein

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board