

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB SEPT, 2,99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pennsylvania Manufacturers'
Association Insurance Company

Serial No. 75/147,387

Robert E. Rosenthal of Duane, Morris
& Heckscher LLP for Pennsylvania Manufacturers'
Association Insurance Company.

Rita M. Odin, Trademark Examining Attorney,
Law Office 109 (Deborah S. Cohn, Managing Attorney).

Before Seeherman, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Pennsylvania Manufacturers' Association Insurance
Company has filed an application to register the mark THE
EXPLORER SERIES for "insurance services for businesses,

namely, providing comprehensive property and liability risk management underwriting and claims administration."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion with the registered mark THE EXPLORER for "life insurance underwriting services."²

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

Looking first to the similarity or dissimilarity of the marks involved, the Examining Attorney argues that applicant has merely added the descriptive term SERIES, which applicant has disclaimed, to registrant's mark, and has failed to create a mark which is different in commercial impression. While applicant, for the most part, argues that the marks and the services must be viewed as a whole in making any determination in this case, applicant also points to the differences in sound and appearance of the two marks.

It is well established that the addition of descriptive matter to one of two otherwise similar, nondescriptive marks will not serve to avoid the likelihood

¹ Serial No. 75/147,387, filed August 8, 1996, claiming first use dates of January 25, 1995. A disclaimer has been entered of the word "SERIES."

² Reg. No. 1,313,854, issued January 8, 1985, Section 8 & 15 affidavit filed and accepted.

of confusion. See *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) and the cases cited therein. Clearly the addition by applicant of the descriptive word SERIES to the registered mark THE EXPLORER fails to change the overall commercial impression created by the mark. Not only does the dominant term EXPLORER remain the same, even the introductory word THE has been appropriated. We fail to see how the addition of the word SERIES would be viewed by purchasers as anything other than an indication of a variety of offerings under THE EXPLORER mark.

Keeping this similarity of commercial impression of the two marks in mind, we turn to the similarity or dissimilarity of the insurance underwriting services being offered under each mark. The Examining Attorney argues that the circumstances here are very similar to those in *In re Integrity Mutual Insurance Co., Inc.*, 216 USPQ 895 (TTAB 1982), wherein the Board found life insurance and property and casualty insurance so closely related that the use of the marks OMNI LIFE and OMNI BUSINESS PLAN, respectively, for underwriting services for these two types of insurance would result in the likelihood of confusion. In particular, the Board stated:

We believe it is highly likely that a potential customer, sophisticated or otherwise, who was

familiar with a life insurance underwriting firm would, faced with a similar or the same identifying mark for casualty or property insurance, assume that the same underwriter might be involved. This is especially true in a national context where some of the nation's leading insurance enterprises do, in fact, underwrite not only life insurance but also casualty and property insurance under the same or highly similar marks and trade names; and the fact that the parties in a particular case may not be engaged in direct competition because one is operating a general casualty line insurance and the other a life insurance company, is, although relevant, not a controlling factor as to likelihood of confusion. [Cases omitted].
Supra at 896.

In addition, the Examining Attorney notes the third-party registrations and excerpts from the Lexis/Nexis database which have been made of record to show that both life insurance and property and liability insurance services are, or have been, in several instances, offered by a single entity.

Applicant insists that the conditions under which the sale of the respective services are made, the sophistication of the purchasers, and the differing channels of trade would obviate any likelihood of confusion. Applicant states that in the insurance industry it is common for insurance agents to sell either life insurance or property/liability insurance, not both; that the risk manager for a business would contact a property/liability agent to purchase insurance such as

applicant's, but an employee benefits manager would be the potential purchaser for life insurance for the business and would contact a life insurance agent; and that these managers and agents are sophisticated buyers and providers who are familiar with the names of companies providing particular types of insurance and would not be likely to be confused as to the source of the services provided under THE EXPLORER SERIES and THE EXPLORER marks. Applicant argues that although the services of both may be generally classified as "insurance," the services are directed to distinct groups of purchasers; that they are not marketed in such a way to cause confusion; and that under California law registrant is not permitted to sell property insurance.

Applicant contends that the Office cannot automatically apply the holding in *Integrity Mutual* to the present case; that in that case there was no detailed explanation of the nature of the marketplace for the particular services, such as applicant has proffered here. Applicant also argues that the registrations and Lexis/Nexis database evidence relied upon by the Examining Attorney relate to house marks or slogans of corporate parents, and do not support any connection between the individual business insurance product line of applicant and

life insurance product of registrant and the product marks being used for each.

Contrary to applicant's arguments, we find the *Integrity Mutual* case to be on "all fours" with the circumstances present here. We cannot agree that applicant has demonstrated sharply different marketplace conditions for its and registrant's insurance services from those which existed in the *Integrity Mutual* case. While applicant insists that different purchasers, different agents, and different conditions would be involved for the two types of insurance, we are not convinced that this would necessarily be the case.³ There is no restriction in the registration such that registrant's life insurance underwriting services would only be marketed to businesses, much less large businesses in which the prospective buyers for life insurance and applicant's business insurance plans

³ Applicant has relied to a great extent upon the holdings in *Homeowners Group Inc. v. Home Marketing Specialists Inc.*, 931 F.2d 1100, 18 USPQ2d 1587 (6th Cir. 1991) with respect to the significance of the differences in the marketing channels and the sophistication of the purchasers in connection with the real estate services involved therein. In an infringement case such as that, however, the actualities of the marketplace may be controlling, whereas here the issue is registrability of applicant's mark, and the cited registration must be presumed to encompass all the normal channels of trade and all levels of potential customers. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) and the cases cited therein. Furthermore, in *Homeowners*, the Court found that the two companies operated at different levels in the real estate industry and sold to two distinct sets of buyers, conditions which have not been established to hold true here.

would be separate persons in the company. Instead, it is highly likely that in a small concern, one person would be responsible for all types of insurance. Even if different agents were contacted, if a property/liability agent offered an insurance plan bearing a mark highly similar to that used in connection with a life insurance plan with which the purchaser was already familiar, confusion would appear to be likely. We must also consider the distinct possibility that the purchaser for the business property and liability insurance plans, even if not responsible for group life insurance, may have had prior experience with a life insurance plan on a personal level. If he were familiar with this life insurance under the mark THE EXPLORER, we think it likely that confusion would arise upon encountering a business property and/or liability insurance, which offers a SERIES of plans for various types of businesses, under the mark THE EXPLORER SERIES.⁴

Regardless of the fact that registrant is not permitted

⁴ We note that the Board previously denied applicant's request for a remand of its application, so that additional evidence with respect to the nature of the marketing of the involved insurance services could be introduced. Even if applicant had introduced evidence to support its arguments with respect to marketplace conditions for its insurance services, there is no limitation in the registration as to the manner in which registrant's services could be offered or the scope of potential purchasers for its life insurance.

under California law to underwrite property insurance, the statement made in *Integrity Mutual* with respect to this possibility is equally true here, namely, that this is immaterial "if, in fact, the misimpression was generated." *Supra* at 897.

If anything, we have additional evidence to support the holdings in *Integrity Mutual*, in that third-party registrations have been made of record showing that several companies offer both life insurance and property insurance and/or liability insurance and have registered the same mark to be used in connection with each of these services. While applicant argues that these are house marks or slogans or designs and do not show the offering of two entirely different products under the same product name, this is beside the point. Although a house mark or slogan, if used by an entity such as a department store offering a wide variety of goods and/or services, would not in most instances be sufficient to establish a relationship between these goods and services, we do not consider this to hold true for the insurance industry. Applicant has clearly failed to show that the types of insurance or products offered by a single company are so numerous that a house mark or slogan would not be associated by potential purchasers with each of these products. Thus, the

registrations stand as evidence that the relationship drawn between the separate insurance products of a company in *Integrity Mutual* is correct; there are several insurance enterprises which underwrite both life insurance and property and/or liability insurance and purchasers would be apt to recognize this fact.

Applicant also argues that the term "explorer" is one which has been used by others in the insurance field and thus sophisticated purchasers would not be prone to assume that all "explorer" products emanate from a single source. The only evidence which applicant has introduced in support of this argument, however, was attached to its appeal brief. As such, it was untimely under Rule 2.142(d) and the Examining Attorney properly objected to any consideration thereof. Thus, in terms of the record on appeal, THE EXPLORER appears to be an arbitrary mark entitled to the full scope of protection in connection with the life insurance underwriting services for which it is registered.

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

E. J. Seeherman

H. R. Wendel

C. M. Bottorff
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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