

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing
April 4, 2000
9/29/00

Paper No. 15
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AFBA Financial Services Company¹

Serial No. 75/094,841

Simor L. Moskowitz of Jacobson, Price, Holman & Stern PLLC
for AFBA Financial Services Company.

Asmat Khan, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Cissel, Hairston and Wendel, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by AFBA Financial
Services Company to register the mark FIVE STAR WHOLE LIFE
and design as shown below,

¹ We note that Office assignment records show that applicant has
changed its name from Armed Forces Benefit Services, Inc. to AFBA
Financial Services Company.

for "insurance services, namely, marketing, underwriting and administration of life insurance."²

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, if used in connection with applicant's services, would so resemble the previously registered mark FIVE STAR for "insurance underwriting services in the field of property and casualty,"³ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs and an oral hearing was held before this panel.

We affirm the refusal of registration.

Our determination is based on an analysis of all of

² Serial No. 75/094,841, filed April 16, 1996, alleging a bona fide intention to use the mark in commerce. The term WHOLE LIFE is disclaimed apart from the mark as shown.

³ Registration No. 2,038,224 issued February 18, 1997.

the probative facts in evidence that are relevant to the factors set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant contends that there is no likelihood of confusion in this case because the services are not competitive and the marks have different connotations and create different commercial impressions. In particular, applicant maintains that FIVE STAR in its mark connotes the military because applicant issues life insurance policies to members and veterans of the Armed Forces and their families which are befitting a five-star general, whereas FIVE STAR in the cited mark connotes exclusivity because registrant's insurance is offered only to "five star" restaurants and hotels. Applicant submitted a letter from Robert Puglisi, a private investigator, who determined that registrant's FIVE STAR insurance was offered only to well-established and upscale, i.e., "five star," restaurants and hotels. As to the respective services, applicant argues that they are not competitive and the mere fact that both applicant's services and registrant's services fall into

the general category of insurance services does not mean that consumers will assume that they emanate from the same source.

The Examining Attorney maintains that the marks are similar due to the shared presence of the words FIVE STAR. Further, the Examining Attorney contends that applicant's services and the services rendered by the registrant are related. In this regard, the Examining Attorney made of record over sixteen use-based third-party registrations for marks, which, in each instance, are registered for life insurance underwriting services, on the one hand, and casualty and property insurance underwriting services, on the other hand. For example, ARBELLA and design is registered for, inter alia, insurance underwriting services in the fields of life insurance and commercial property and liability insurance (Registration No. 2,038,945); PRICOA is registered for, inter alia, life, property and casualty insurance underwriting services (Registration No. 2,169,633); CNA is registered for, inter alia, underwriting services in the fields of life and property insurance (Registration No. 2,169,594); NDIRECT is registered for, inter alia, insurance services, namely underwriting of life, property and casualty insurance (Registration No. 2,142,880); PFN is registered for, inter alia, insurance

agency in the fields of life insurance and property and casualty insurance (Registration No. 2,150,438); and AMERUS DIRECT is registered for, inter alia, insurance underwriting in the fields of property and casualty, and life insurance (Registration No. 2,119,595).

Also, the Examining Attorney made of record advertisements from the Internet and a Yellow Pages Directory which show that insurance companies offer a wide range of insurance services, including life insurance and property insurance.

With respect to the services, it is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the services specified in the subject application vis-à-vis the services set forth in the cited registration, without limitations or restrictions not reflected therein. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In this case, because applicant's application and the cited registration contain no restrictions/limitations as to channels of trade and purchasers, we must presume that the respective services travel in all the normal channels of trade for such services and that they are available to all potential customers. In other words, we can not take into

consideration applicant's argument that registrant offers its services only to upscale hotels and restaurants.

Moreover, it is not necessary that the services be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In this case, we find that the record supports the Examining Attorney's position that applicant's services of marketing, underwriting and administration of life insurance and registrant's underwriting services in the field of property and casualty are related. Although the third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re

Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

Turning next to a comparison of applicant's mark FIVE STAR WHOLE LIFE and design and the registered mark FIVE STAR, we find that the marks, when considered in their entirety, are very similar. Although we have compared the marks in their entirety, there is nothing improper in giving more weight, for rational reasons, to a particular portion of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ..." 224 USPQ at 751. The dominant portion of applicant's mark is the words FIVE STAR, which is identical to the cited mark FIVE STAR. Applicant has disclaimed WHOLE LIFE, thereby acknowledging the descriptiveness of this phrase. Also, the five star design in applicant's mark is subordinate matter and simply reinforces the words FIVE STAR.

In view of the foregoing, we conclude that purchasers familiar with registrant's insurance underwriting services in the field of property and casualty rendered under its mark FIVE STAR, would be likely to believe, upon

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encountering applicant's mark FIVE STAR WHOLE LIFE and design for marketing, underwriting and administration of life insurance, that applicant's services originated with or are somehow associated with or sponsored by the same entity. In particular, purchasers would be likely to believe that due to the shared term FIVE STAR, the life insurance services offered by applicant under the mark FIVE STAR WHOLE LIFE and design represents a new insurance service from registrant.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.

R. F. Cissel

P. T. Hairston

H. R. Wendel
Administrative Trademark Judges
Trademark Trial and Appeal Board