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RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Venture Insurance Company

Serial No. 75/573,049

Donald Cayen for Venture Insurance Company.

Cynthia Sloan, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Cissel, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 19, 1998, applicant filed the above-identified application to register the mark "VENTURE" on the Principal Register for "claims administrative services and underwriting services solely in the field of property and casualty insurance," in Class 36. The application was based on applicant's claim of use of this mark in interstate commerce in connection with these services since February 27, 1991.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with the services set forth in the application, so resembles two registered marks, both registered to the same entity, that confusion is likely. The registered marks are "VENTURE," for "life insurance services, namely underwriting and administering annuities," in Class 36,[1] and the mark shown below,

for "life insurance services, namely fixed and variable annuities," in Class 36.[2]

Applicant responded to the refusal to register with a number of arguments, but no evidence was submitted in support of any of them. The Examining Attorney was not

[1] Reg. No. 1,502,489, issued on the Principal Register on August 30, 1988 to North American Security Life Insurance Co.; combined affidavit under Sections 8 and 15 of the Act accepted and received.

[2] Reg. No. 1,617, 0 55, issued on the Principal Register on October 9, 1990 to North American Security Life Insurance Co.; the combined affidavit under Sections 8 and 15 of the Act accepted and received.

persuaded by applicant's arguments, and the refusal to register was made final in the second Office Action. Attached to the final refusal were copies of seventeen third-party trademark registrations submitted by the Examining Attorney to establish that applicant's property and casualty insurance services are related to the life insurance and annuity services set forth in the cited registrations. The third-party registrations show that entities have registered their respective marks for underwriting, brokerage or agency services involving property, casualty and life insurance. In several instances, annuities are specified in the registrations as features of the particular life insurance services.

Applicant timely filed a Notice of Appeal from the final refusal to register, and both applicant and the Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board.

Applicant attached a number of exhibits to its appeal brief. The Examining Attorney properly objected to our consideration of this evidence. Trademark Rule 2.142(d) specifies the procedure by which additional evidence may be allowed into the record after a Notice of Appeal has been filed, but applicant neither requested nor received permission from the Board to submit evidence after the

record had closed. Accordingly, we have not considered the evidence untimely submitted with applicant's brief.

In the case of In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods or services as set forth in the application and cited registrations, respectively.

In the case at hand, the record before us shows that the services recited in the application are closely related to those specified in the cited registrations, and the mark applicant seeks to register creates a commercial impression similar to those engendered by the cited registered marks, so use of applicant's mark in connection with these related services is likely to cause confusion.

The cited registered mark "VENTURE" is identical to the mark applicant seeks to register. When the marks in question are identical, the goods or services with which they are used ordinarily do not have to be as closely related in order to find confusion likely as would be the case if there were differences between the marks. Amcor,

Inc. v. Amcor Industries, Inc., 210 USPQ 70 (TTAB 1981). In the instant case, however, the record establishes that the services set forth in the application and this registration are very closely related. As noted above, the third-party registrations made of record by the Examining Attorney show that insurance underwriters, agents and brokers have registered their respective marks in connection with life insurance, property insurance and casualty insurance services, and that several of these registrations specify annuities as well as administrative services in connection with such insurance services. These third-party registrations establish that the services set forth in the application, administrative services and underwriting services in the field of property and casualty insurance, are closely related to the services recited in the registration for the mark “VENTURE” as “life insurance services, namely underwriting and administering annuities.” See: Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Co., 6 USPQ2d 1467 (TTAB 1988). Plainly, the use of the identical mark in connection with these closely related services is likely to cause confusion.

The mark applicant seeks to register is also similar to the second cited registered mark, “VENTURE PRA” and design, and the services specified in the registration for

"VENTURE PRA" and design, "life insurance services, namely fixed and variable annuities," are closely related to the services specified in the application, which include underwriting property and casualty insurance.

Applicant's arguments that its mark is not likely to cause confusion with this registered mark are not persuasive. While the marks are not identical and must be considered in their entireties, it is well settled that one feature of a mark may be recognized as having more significance in creating the commercial impression for that mark, and greater weight may be given to that dominant feature in determining whether confusion is likely. In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985). In the case at hand, the commercial impression created by the mark applicant seeks to register, "VENTURE," is similar to the commercial impression engendered by the "VENTURE PRA" and design mark because applicant's mark is a significant part of the dominant component of the cited registered mark. Although the registered mark includes the design shown above, the literal portion of the mark, "VENTURE PRA," is the dominant part of the mark, the part which would be remembered and used when referring to the services when ordering or recommending them. In re Apitito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Contrary to applicant's

argument, this record does not establish that either "VENTURE" or "PRA," or the combination, "VENTURE PRA," is merely descriptive in connection with the services identified in the cited registrations. A prospective purchaser of insurance who is familiar with use of "VENTURE PRA" in connection with life insurance services including annuities, when faced with applicant's offer of closely related services under the mark "VENTURE," is likely to assume that the mark used by applicant indicates that applicant's insurance services emanate from the same source as those rendered under the registered mark.

This record, as noted above, establishes that consumers have a basis for expecting that the use of the same or similar marks in connection with both life insurance services involving annuities and property and casualty insurance underwriting services is an indication that all such services emanate from a single source. This record does not, however, establish that the insurance services set forth in the application and cited registrations are purchased by anyone more "prudent" or sophisticated than ordinary consumers exercising ordinary care, nor does it provide any basis for adopting applicant's argument that the marks create different commercial impressions when they are used in connection

with the services at issue herein because “VENTURE” has a different connotation in connection with the services set forth in the registrations than it does in connection with the services recited in the application.

Further, applicant’s argument that “[i]n evaluating the similarity or dissimilarity of two marks, the common portions of the marks are given less weight than the remainder of the marks” (brief, p.4) is not an accurate statement of the law. While this might be the case if the common portions of the marks were merely descriptive in connection with the goods or services at issue, in the case at hand, where the record does not establish that either “VENTURE” or “VENTURE PRA” has descriptive significance in connection with these services, the word common to these marks, “VENTURE,” has great significance. “VENTURE” is applicant’s mark in its entirety, so if we are to consider applicant’s mark at all, we must consider it to be dominant. As noted above, this word is the same as one of the cited registered marks in its entirety, and it is the same as the dominant word in the other cited registered mark. When these similar marks are used in connection with

these closely related insurance services, confusion is plainly likely.

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