

THIS DISPOSITION IS NOT
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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Security Benefit Life Insurance Company

Serial No. 75/813,178

Request for Reconsideration

Glenn A. Gundersen of Dechert Price & Rhoads for Security Benefit Life Insurance Company.

Tanya L. Amos, Trademark Examining Attorney, Law Office 101 (Jerry L. Price, Managing Attorney).

Before Simms, Hohein and Drost, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Security Benefit Life Insurance Company (applicant) has requested reconsideration of the Board's decision, issued March 18, 2003, affirming the refusal of the Trademark Examining Attorney to register the mark SECURITY FUNDS ("FUNDS" disclaimed) for mutual fund investment

services, under Section 2(d) of the Trademark Act, on the basis of Registration No. 1,242,311 for the mark SECURITY FUND and design ("FUND" disclaimed) for banking services.

Applicant argues, among others things, that some of the evidence in the record is not reflected in our opinion and that some of our findings are at variance with the evidence. Applicant reiterates its arguments that banks and mutual funds do business in a way that ensures that consumers will understand the differences in these services, that these services are in different industries subject to different regulatory regimes, that registrant's mark is weak and commonplace, and that the marks of applicant and registrant have co-existed for 22 years without confusion. Applicant has also pointed to the fact that the registered mark has recently been amended to delete any special form or design in the mark.¹

Applicant's request largely presents reargument of contentions that have already been adequately addressed in the Board's decision. All of the evidence of record was considered, even though parts of the record may not have

¹ Office records show that the registrant filed a request for amendment of the registered mark on December 16, 2002. According to Office records, the Post Registration branch acted on this request on May 6, 2003. It is not clear if the amendment has been approved. If the amendment has been approved, the registered mark would be even more similar to applicant's mark in appearance and commercial impression, differing only by the letter "S" on the word "FUNDS." We note that

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been specifically mentioned in the opinion. The record contains evidence of the relationship of banking services and mutual fund investment services, with some institutions or companies offering both of these services. Suffice it to say that we see no error in the decision complained of.

One matter which the Board did not specifically address (other than noting that applicant had presented this argument) is its contention that confusion will be avoided because applicant's SECURITY FUNDS mark is part of an existing family of marks. However, the Board has held that the existence of a family of marks by an applicant (or a registrant in a cancellation proceeding) is not an available defense to a claim of likelihood of confusion with a registered mark. See, for example, the discussion of this defense, in the context of an inter partes proceeding, in *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052-53 (TTAB 1992).

Applicant's request for reconsideration is denied.

applicant had earlier argued that the eagle design in the registered mark was the dominant element.