Oral Hearing:
December 3, 2009

Mailed:
February 12, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Capital Blue Cross

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Serial No. 78869843

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Elliott C. Bankendorf of Husch Blackwell Sanders Welsh & Katz, Ltd. for Capital Blue Cross.

Meghan Reinhart, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Quinn, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Capital Blue Cross seeks registration on the Principal Register of the standard character mark AVALON for "issuing group and individual health insurance policies and offering as a licensed insurer such health insurance policies and the administration thereof excluding acting as a broker or

insurance agent" in International Class 36.[1] Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified services, so resembles the registered marks set forth below as to be likely to cause confusion, mistake or deception.

Registration No. 2388231 for the mark AVALON RISK MANAGEMENT ("risk management" disclaimed), for services identified as "insurance brokerage services in the field of surety bonds, marine cargo insurance, errors and omissions insurance and other lines of insurance" in International Class 36, issued September 19, 2000, Section 8 and 15 declarations accepted and acknowledged, owned by Avalon Risk Management, Inc.;

Registration No. 3271955 for the mark AVALON Consulting Insurance/Reinsurance Claims Management ("consulting" and "insurance/reinsurance claims management" disclaimed), for services identified as "insurance claims auditing services" in International Class 35 and "insurance services, namely, insurance consulting services; insurance and reinsurance claims management" in International Class 36, issued July 31, 2007, owned by Avalon Consulting, LLC; and

Registration No. 3271956 for the standard character mark AVALON CONSULTING ("consulting" disclaimed), for services identified as "insurance claims auditing services" in

[1] Application Serial No. 78869843, filed April 26, 2006, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

International Class 35 and "insurance services, namely, insurance consulting services; insurance and reinsurance claims management" in International Class 36, issued July 31, 2007, owned by Avalon Consulting, LLC.

The appeal is fully briefed. We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With regard to the marks, overall we find applicant's mark AVALON to be similar to the marks in all three registrations. It is not disputed that the word AVALON is the dominant element in the marks in the cited registrations. Indeed, other than the stylized A in one of the cited marks, all other matter in the cited marks is

disclaimed. Disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ2d 749, 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"); In re Code Consultants, Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

Applicant focuses its argument on the scope of protection to be given the cited marks, the differences in the services and the sophistication of the purchasers. As to the first issue, the scope of protection, this relates to the du Pont factor of "the number and nature of similar marks in use on similar goods" or the inherent weakness of the mark in that it has taken on some meaning in that field such that consumers rely on other matter to distinguish the marks.

Applicant argues that the "trademark register is crowded with other 'avalon' marks and as such, a consumer is not likely to be confused between any two of the crowd." Br. p. 5. In support of this argument applicant submitted

evidence of several third-party registrations for a variety of goods and services.[2] The first problem with applicant's argument is that third-party registrations are not evidence of use in the marketplace and, as such, are not probative of the sixth du Pont factor, "the number and nature of similar marks in use on similar goods." AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973). However, "they may be considered to demonstrate the meaning of a word which comprises the mark, or a portion thereof, to show that there is a well-known and commonly understood meaning of that word and that the mark has been chosen to convey that meaning." Knight Textile Corp. v. Jones Investment CO., 75 USPQ2d 1313 (TTAB 2005). This raises the second problem with applicant's argument. Of the Federal registrations (other than the three cited registrations) only those belonging to one third-party include insurance-related services and those are limited to and associated with its real estate services.[3] Thus, the relevant registrations come from only

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[2] Applicant also submitted hit list summaries from an Internet search engine. Search summaries are generally too truncated to provide sufficient information about the use of a particular term, and those of record in this case suffer from this limitation. In re Fitch IBCA, Inc., 64 USPQ2d 1058, 1060 (TTAB 2002). They thus are accorded limited probative value.

[3] The third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion.

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