

Mailed: February 24, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Capital Blue Cross

Serial No. 78869843

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

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

Notice of Correction

Before Quinn, Zervas and Kuhlke, Administrative Trademark
Judges.

By the Board:

The attached decision, mailed February 12, 2010, has been
corrected to list Sherry L. Rollo as co-counsel for
applicant.

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
December 3, 2009

Mailed:
February 12, 2010

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Elliott C. Bankendorf and Sherry L. Rollo of Husch
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Meghan Reinhart, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

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

 ("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

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