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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Travelers Indemnity Company
v.
Jose Ivan Vilches

Opposition No. 91239697

David M. Kelly, Linda K. McLeod, and Jason M. Joyal of Kelly IP, LLP,
for The Travelers Indemnity Company.

Jose Ivan Vilches,
pro se.

Before Bergsman, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Jose Ivan Vilches (“Applicant”) seeks registration on the Principal Register of the

word and design mark  for “auto body repair services” in

International Class 37.¹

¹ Application Serial No. 87611104 was filed on September 16, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. The Application has the following description: “The mark consists of a black uppercase ‘R’, a black uppercase ‘C’, a red broken umbrella representing a red uppercase ‘C’ an a red lowercase ‘l’, a black lowercase ‘a’, a black lowercase ‘I’, a black

The Travelers Indemnity Company (“Opposer”) has opposed registration of Applicant’s mark on the grounds of likelihood of confusion and dilution. 15 U.S.C. §§ 1052(d), 1125(c).² Opposer claims to own 13 registrations for marks consisting of or comprising an umbrella logo, used in connection with a variety of insurance services, including underwriting and issuing auto insurance, property and casualty insurance, and personal property insurance.³ Its registered marks include:



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lowercase ‘m’ and a black lowercase ‘s.’” The colors black and red are claimed as a feature of the mark.

² Notice of opposition, 1 TTABVue.

³ Notice of opposition ¶¶ 3, 7, ex. A, 1 TTABVue 14-21, 26-124.

⁴ Reg. no. 3417049, issued April 29, 2008, renewed, for “Insurance underwriting services in the fields of property and casualty, fire, allied lines, farmowners multiple peril, homeowners multiple peril, commercial multiple peril, ocean marine, inland marine, earthquake, workers’ compensation, other liability, product liability, private passenger auto liability, commercial auto liability, auto physical damage, fidelity, surety, burglary and theft, boiler and machinery, and reinsurance; insurance claims services and administration; insurance claims processing; insurance claims adjusting; insurance agency and brokerage services, namely, policyholder services and services to agents and brokers; providing information in insurance matters; risk management and risk management consultation” in Class 36. For the same mark, Reg. no. 4085573, issued Jan. 17, 2012, for “Insurance underwriting services in the fields of property and casualty, commercial lines, farm, auto commercial, boiler and machinery, commercial multi peril, liability, inland marine, fidelity, surety, crime, workers compensation, property, personal lines, personal auto, homeowners, boat/yacht, dwelling fire, identity fraud reimbursement, kidnap and ransom, excess and surplus, high valued homeowners, personal articles floater, wedding insurance, and reinsurance ; insurance claims administration; insurance claims processing; insurance claims adjusting; insurance agency services; providing information in the field of insurance; providing a website with information and resources in the field of insurance; and insurance and insurance-related



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services in the nature of loss prevention and risk control management for others” in Class 36. The registrations describe the mark as follows: “The mark consists of an upright, open umbrella with handle turned to the left.” The color red is claimed as a feature of the mark.

⁵ Reg. no. 3494648, issued Sept. 2, 2008, renewed, for services including “Insurance underwriting services in the fields of property and casualty, fire, allied lines, farmowners multiple peril, homeowners multiple peril, commercial multiple peril, ocean marine, inland marine, earthquake, workers’ compensation, other liability, product liability, private passenger auto liability, commercial auto liability, auto physical damage, fidelity, surety, burglary and theft, boiler and machinery, and reinsurance; claims adjustment in the field of insurance, insurance claims processing and administration, risk control and loss prevention consultation; risk control and loss prevention services, namely, risk management; insurance claims and; insurance agency and brokerage services, namely, policyholder services and services to agents and brokers; providing information in insurance matters” in Class 36. For the same mark, Reg. no. 3991521, issued July 12, 2011, declarations of use and incontestability accepted and acknowledged, for “Insurance underwriting services in the fields of property and casualty, commercial lines, farm, auto commercial, boiler and machinery, commercial multi peril, liability, inland marine, fidelity, surety, crime, workers compensation, property, identity fraud reimbursement, kidnap and ransom, excess and surplus, personal lines, personal auto, homeowners, high valued homeowners, dwelling fire, boat/yacht, personal articles floater, wedding insurance, and reinsurance; insurance claims administration; insurance claims processing; insurance claims adjusting; insurance agency services; providing information in the field of insurance; providing a website with information and resources in the field of insurance; and insurance and insurance-related services in the nature of loss prevention and risk control management for others” in Class 36. The registrations describe the mark as follows: “The mark consists of the word ‘Travelers’ in black with a red umbrella at the end of the word.” The colors black and red are claimed as a feature of the mark.



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Opposer also claims common law rights in the logo for:

Insurance services; Insurance underwriting services; surety services; insurance claims administration; insurance claims processing; insurance claims adjusting; insurance claims reporting; insurance claims referrals to auto repair shops; insurance agency services; providing information in the field of insurance; providing a website with information and resources in the field of insurance; insurance and insurance-related services in the nature of loss prevention and risk control management for others; educational services in the field of insurance; providing software in the field of insurance; marketing services.⁷

Applicant's Answer generally denies the claims in the Notice of Opposition, averring, in pertinent part, that: "All of Travelers' design marks consists of a 'UPRIGHT, OPEN UMBRELLA', applicants' is a 'BROKEN UMBRELLA'.

⁶ Reg. no. 4554402, issued June 24, 2014, for "Downloadable software in the nature of a mobile application providing users with the ability to collect, view, manage, store, and transmit auto accident information including ... and images, obtain auto accident guidance, use mapping features to locate and contact vehicle and travel related services, and providing policyholders with the ability to file automobile insurance claims," in Class 9. The registration describes the mark as follows: "The mark consists of an upright, open, red umbrella with handle turned to the left against a blue background." The colors red and blue are claimed as a feature of the mark. Opposer's other pleaded registrations are nos. 1161313, 3417048, 3494647, 3991520, 4085572, 4649396, 4649397, 4554401.

⁷ Notice of opposition, 1 TTABVue 11.



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I. Background

The parties have a history. Applicant was once Opposer's employee. According to Opposer, "From July 2004 to January 2009, Mr. Vilches was a senior automobile appraiser for Travelers whose job duties included inspecting and appraising damaged automobiles of Travelers' policyholders for which an insurance claim had been submitted and providing a cost estimate to repair the vehicles."⁹ After Opposer terminated Applicant's employment, Applicant filed a civil lawsuit for unpaid overtime, and sought certification of a class action. The dispute led to arbitration between the parties, after which Applicant filed another civil lawsuit, which was dismissed in June 2014.¹⁰

Two months later, in August 2014, Applicant registered the domain name TravelersLaborDispute.com, on which he displayed the "broken umbrella" logos:

TravelersLaborDispute.com



and

⁸ Answer ¶ 1, 4 TTABVUE 2.

⁹ Declaration of Michael Bucci, Chief Intellectual Property Counsel for Opposer, ¶ 8, 22 TTABVUE 20. *See also* Applicant's decl. ¶¶ 1-2, 40 TTABVUE 3, 42 TTABVUE 2.

¹⁰ Bucci decl. ¶ 9, 22 TTABVUE 20, 658 (order of dismissal).



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That same month, he also registered the domain name TravelersClassAction.com, on which he displayed the logo:



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In a third website, RCClaims.com, registered in 2017, Applicant has displayed the applied-for mark:



According to Applicant, “[t]he broken umbrella on the RC Claims logo represents an altered version of the logo created by applicant in August of 2014, as the result of applicant’s personal and professional interactions with Travelers.”¹⁴ Applicant uses the logo in connection with his allegation that Opposer Travelers improperly uses automobile replacement parts that are not certified as required by Federal Law.¹⁵

¹¹ Applicant’s decl. ¶ 5, 40 TTABVUE 3, 42 TTABVUE 3. Declaration of Jason Joyal, Opposer’s counsel, ¶ 4 and ex. 3, Applicant’s May 5, 2018 email responding to Joyal correspondence, 27 TTABVUE 3-5, 12-13, 19.

¹² Joyal decl. and ex. 3, Applicant’s email responding to Joyal, May 5, 2018, 27 TTABVUE 5, 12-13, 19.

¹³ Applicant’s decl. ¶ 6, 40 TTABVUE 3, 42 TTABVUE 3.

¹⁴ Joyal decl. ex. 3, Applicant’s email responding to Joyal, May 5, 2018, 27 TTABVUE 19.

¹⁵ Applicant’s decl. ¶¶ 4, 6, 40 TTABVUE 3, 42 TTABVUE 3; Applicant’s notice of reliance no. 3, 40 TTABVUE 43.

In his present application, though, Applicant simply claims a bona fide intent to use the applied-for mark in connection with “auto body repair services.”

II. Opposer’s Entitlement to a Statutory Cause of Action

“Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor....” 15 U.S.C. § 1063(a).

Standing to file an opposition under the statute is now termed entitlement to a statutory cause of action. *Major League Soccer, LLC v. F.C. Int’l Milano S.p.A.*, 2020 USPQ2d 11488, at *5 n. 18 (TTAB 2020). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). As the Court of Appeals for the Federal Circuit has observed, there is “no meaningful, substantive difference between the analytical frameworks” in the prior “standing” case law, under which a plaintiff must show a real interest in the proceeding and a reasonable basis for its belief in damage, *see Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), and the current “entitlement” case law, under which a plaintiff must show an interest falling within the zone of interests protected by statute and damage proximately caused by registration. *Corcamore v. SFM*, 2020 USPQ2d 11277 at *4.

“A claim of likelihood of confusion that is not wholly without merit, including prior use of a confusingly similar mark, may be sufficient ‘to establish a reasonable basis

for a belief that one is damaged.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *2 (TTAB 2020) (internal punctuation omitted). Opposer’s entitlement to oppose registration of Applicant’s mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer.¹⁶ *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Comm’s., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016). It has also adduced testimony of its common-law use of its marks.¹⁷ *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark ..., and has thereby established his standing to bring this proceeding.”). Once a plaintiff has shown entitlement to a statutory cause of action on one ground, it has the right to assert any other ground. *Hole in One Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, * 3 (TTAB 2020).

Opposer has thus established its entitlement to oppose registration under the applicable statutes.

III. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s application. The record also includes:

A. Opposer’s Evidence

- Declaration of Michael Bucci, Chief Intellectual Property Counsel for Opposer, with exhibits;¹⁸

¹⁶ Notice of opposition ex. A, 1 TTABVUE 26-124; Opposer’s notice of reliance no. 1, 28 TTABVUE.

¹⁷ *See, e.g.*, declaration of John Morris, ¶¶ 7-16, 23 TTABVUE 3-8.

¹⁸ 22 TTABVUE.

- Declaration of John Morris, Vice President, Advertising & Media for Opposer, with exhibits;¹⁹
- Declaration of Jason Joyal, counsel for Opposer, with exhibits;²⁰
- Notice of reliance no. 1, on status and title copies of Opposer's 13 U.S. trademark registrations;²¹
- Notice of reliance no. 2, on TESS/TSDR printouts of 15 third-party used-based registrations for marks covering both insurance services and auto repair services;²²
- Notice of reliance no. 3, on unsolicited media attention toward Opposer and its umbrella logo;²³
- Notice of reliance no. 4, on Internet websites showing third parties that provide both insurance services and auto repair and/or auto repair referral services²⁴
- Notice of reliance no. 5, on Internet websites, including Applicant's websites, showing Applicant's use of the "broken umbrella" logo;²⁵
- Notice of reliance no. 6, on documents produced by Applicant.²⁶

B. Applicant's Evidence

- Applicant's declaration, with exhibits;²⁷
- Notice of reliance no. 1, on National Highway Traffic Safety Administration (NHTSA) requirement publications;²⁸
- Notice of reliance no. 2, on Certified Auto Parts Association (CAPA) documents from CAPACertified.org, offered to show "Traveler's use of auto replacement parts that are not certified as required by Federal Law";²⁹
- Notice of reliance no. 3, on Internet web pages from the CAPA website, CAPAcertified.org;³⁰
- Notice of reliance no. 4, on one of Opposer's television commercials;³¹

¹⁹ 23-26 TTABVUE.

²⁰ 27 TTABVUE.

²¹ 28 TTABVUE.

²² 29 TTABVUE.

²³ 30 TTABVUE.

²⁴ 31 TTABVUE.

²⁵ 32 TTABVUE.

²⁶ 33-34 TTABVUE.

²⁷ 40 TTABVUE 2-18, 42 TTABVUE.

²⁸ 40 TTABVUE 19-27.

²⁹ 40 TTABVUE 28-42, 43 TTABVUE.

³⁰ 40 TTABVUE 43-57, 44 TTABVUE.

³¹ 40 TTABVUE 58-61, 45 TTABVUE.

- Notice of reliance no. 5, on screenshots of Applicant's website TravelersLaborDispute.com, "relevant to Applicant's creation of the 'broken umbrella'";³²
- NHTSA requirement publications;³³
- CAPA publications.³⁴

IV. Objection to Evidence

Opposer objects to Applicant's declaration (paragraphs 3-4 and exhibits 1-4) and Applicant's notices of reliance 1-3, as well as the exhibits they contain, on the ground that they are irrelevant to any issue in this opposition proceeding. "Applicant's testimony and documents regarding 'bumper' standards and NHTSA publications and similar topics and documents have no probative value on the narrow issue of entitlement to registration before the Board," Opposer states (citing Fed. R. Evid. 402).³⁵

We find Applicant's evidence relevant to the issues in this proceeding. At a minimum, it bears on Applicant's intended connotation of his applied-for mark, representing Opposer's "broken promise" to motorists, and Applicant's argument that he adopted the mark in good faith.³⁶ "Suffice it to say, 'we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.'" *Ricardo Media Inc. v. Inventive*

³² 40 TTABVUE 62-68, 41 TTABVUE, 46 TTABVUE.

³³ 47-51 TTABVUE.

³⁴ 52-54 TTABVUE.

³⁵ 61 TTABVUE 3-4.

³⁶ See Applicant's brief, 62 TTABVUE 4-5.

Software, LLC, 2019 USPQ2d 311355, *3 (TTAB 2019) (quoting *Hunt Control Sys. Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011)). The objection is therefore overruled.

V. Likelihood of Confusion

“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985). Consistent with these purposes, Section 2(d) of the Lanham Act prohibits registration of a mark that so resembles a mark previously used in the United States by another and not abandoned as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d).

A. Priority

To prevail on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, based on a previously used mark, it is Opposer’s burden to prove both priority of use and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf*, 55 USPQ2d at 1848. An opposer must prove that it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion as to source. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). It may establish its prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994).

Here, Opposer has established its ownership of 13 registrations of marks consisting of or containing the umbrella logo.³⁷ *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (Where a plaintiff has properly made a registration of record, and there is no pending counterclaim to cancel the registration, priority is not an issue with respect to the goods or services identified in the registration). And it has—through the testimonial declaration of John Morris, Opposer's Vice President of Advertising and Media, supported by exhibits—established its use of the umbrella logo mark in commerce in connection with insurance services for decades, commencing at least as early as 1960, long prior to Applicant's constructive use date of September 16, 2018.³⁸ *See Executive Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1180, 1184 (TTAB 2017) (the testimony of a single witness may be adequate to establish use before applicant's constructive use date). Opposer has proven priority.

B. The *DuPont* Factors

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In assessing likelihood of confusion, we consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Zheng Cai v. Diamond*

³⁷ Notice of opposition ex. A, 1 TTABVUE 26-124; Opposer's notice of reliance no. 1, 28 TTABVUE.

³⁸ *See, e.g.*, declaration of John Morris, ¶¶ 12-16, 23 TTABVUE 3-8.

Hong, Inc., 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented in a particular case. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004), cited in *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at *5.

1. Fame

Under the fifth *DuPont* factor, we consider the fame or strength of Opposer’s marks in order to evaluate the scope of protection to which they are entitled. The fame of a mark is not “an all-or-nothing measure” in the context of likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). Rather, it “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted).

In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength, based on marketplace recognition. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686

(Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”). J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. Dec. 2020 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

In determining the conceptual strength of Opposer’s mark, “we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). Inasmuch as the marks are registered on the Principal Register, we must presume that they are at least suggestive. *In re Fiesta Palms*, 85 USPQ2d 1360, 1363 (TTAB 2007) (citing *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997)). The elements composing Opposer’s marks reveal their suggestive nature.

An “umbrella” is “something that covers or protects.”³⁹ We thus find the umbrella



logo, , suggestive of Opposer’s insurance services, which cover or protect its insureds. *In re Texas With Love, LLC*, 2020 USPQ2d 11290, 3 (TTAB 2020) (a design is the legal equivalent of the word that describes it, and must be treated as such). Opposer’s early advertisements made the suggestion clear:

³⁹ AHDictionary.com.



Time—February 15, 1960
Newsweek—February 29, 1960
Parents—April, 1960

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We take judicial notice that the word TRAVELER is defined as “one that travels: such as one that goes on a trip or journey.”⁴¹ This definition accords with the origin of the Travelers Insurance Company:



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⁴⁰ Morris decl. ¶ 38, 23 TTABVUE 31.

⁴¹ www.merriam-webster.com/dictionary/traveler. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or regular fixed editions. *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, * 17 n. 115 (TTAB 2020).

⁴² Exhibit 7 to Morris decl., Travelers SEC filing, 24 TTABVUE 184.

Even though Opposer has expanded its lines of insurance, it still covers travelers, including insureds who travel by automobile. So Opposer's umbrella logo marks—with or without the wording—are conceptually suggestive of its relevant services, covering the insurance needs of those who travel by automobile.

The commercial strength of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards v. Fairmont Holdings*, 122 USPQ2d at 1734 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). “Strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the services identified by the marks; and the general reputation of the services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (citing *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength)).

Opposer proves the strength of its umbrella logo marks by all these means. Its umbrella logo has been in continuous use for insurance services, including auto insurance, since 1960.⁴³ These services are sold in all 50 states.⁴⁴ Since 2011, it has issued more than four million unique personal auto insurance policies under its logo.⁴⁵ Since 2010, Opposer has earned revenues of over \$25 billion a year from goods

⁴³ Morris decl. ¶¶ 12-13, 23 TTABVue 4-5.

⁴⁴ *Id.* at ¶ 9, 23 TTABVue 4.

⁴⁵ *Id.* at ¶ 42, 23 TTABVue 39.

and services advertised, offered, and sold under its umbrella logo.⁴⁶ Between 2008 and 2017, it spent over \$90 million a year on advertising, marketing and promotion under its umbrella logo.⁴⁷ This advertising includes commercials, which were broadcast 106,759 times in the U.S. from 2011 through 2018, and viewed more than 22 billion times during that time period.⁴⁸ The commercials also feature the umbrella logo, as these stills show:

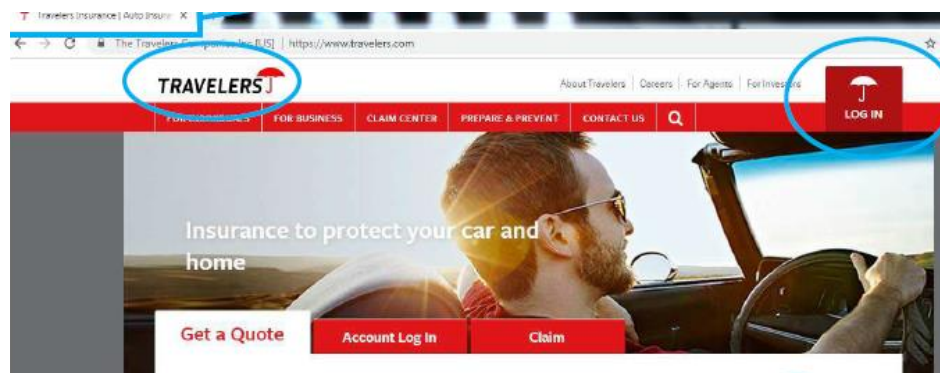


1986



2015

To complement its commercials, Opposer places its logo at the top of every page of its Travelers.com website, which received more than 15 million unique visitors between 2014 and 2019:



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⁴⁶ *Id.* at ¶19, 23 TTABVUE 11.

⁴⁷ *Id.* at ¶24, 23 TTABVUE 15.

⁴⁸ *Id.* at ¶27, 23 TTABVUE 17.

⁴⁹ *Id.* at ¶31, 23 TTABVUE 20-21.

Opposer places its logo on its social media pages—such as Facebook and Twitter—which have received hundreds of thousands of view in the same time period.⁵⁰ It places banner or display ads bearing the logo on third-party websites, including cnn.com, bloomberg.com, expedia.com, foxsports.com, and nytimes.com, as well as the popular social media platforms LinkedIn, Facebook, Twitter, YouTube, and Pinterest, generating more than 900 million impressions between 2016 and 2018.⁵¹ And it displays its umbrella logo in email marketing to customers and prospective customers in the U.S.; it sent more than 7.5 million such email marketing messages bearing the Travelers Logo between 2013-2018.⁵²

Opposer has also pursued more traditional print advertising, placing advertisements in publications such as Forbes, Golf Digest, and Fortune, on billboards in heavily-trafficked railroad station platforms, and on flyers, brochures and sell sheets promulgated to its independent agents and brokers, exclusive agents and brokers, and direct marketing, and/or salaried employees throughout the country.⁵³

Opposer's umbrella logo has, in consequence, garnered unsolicited media attention in publications such as:

- The *New York Times*: “As corporate logos go, the red Travelers umbrella ranks with icons of instant recognition like Prudential’s rock or Disney’s mouse ears. ‘It’s a beautiful device,’ said Tom De Vito, a retired ad man. ‘The minute you see the red umbrella, you say Travelers.’”;

⁵⁰ *Id.* at ¶33, 23 TTABVUE 21, 23-24.

⁵¹ *Id.* at ¶37, 23 TTABVUE 28-29.

⁵² *Id.* at ¶35, 37, 23 TTABVUE 25, 28.

⁵³ *Id.* at ¶¶ 9, 38-40, 23 TTABVUE 4, 31, 34, 36.

- The *Washington Post*: “...Travelers Group Inc., a financial conglomerate best known for its red umbrella logo.”;
- *Adweek*: “Travelers, whose iconic red umbrella logo appears in much of its advertising....”⁵⁴

In view of this evidence, which Applicant does not controvert, we find Opposer’s marks conceptually suggestive—and thus inherently distinctive—and commercially strong or famous for insurance services. Its marks “thus enjoy a wide latitude of legal protection.” *Bose v. QSC Audio*, 63 USPQ2d at 1305 (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). Opposer’s strong or famous marks “cast[] a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). The fifth *DuPont* factor thus weighs heavily in favor of a likelihood of confusion.

2. Similarity of Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Opposer’s and Applicant’s marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110

⁵⁴ David Gonzalez, “Criticism Never Rains But It Pours,” *The New York Times* (May 24, 1997)); Allan Sloan, “Buffett’s Decision About Salomon Proves Everyone Makes Mistakes,” *The Washington Post* (September 30, 1997); Steve McClellan, “100 Mil. Travelers Biz Goes to MediaCom,” *Adweek* (July 16, 2010)); Morris decl. ¶21, 23 TTABVUE 13-14.

USPQ2d at 1812).

Because Opposer's marks are commercially strong or famous, the degree of similarity between the parties' marks needed to support a conclusion of likely confusion declines. *Bose v. QSC Audio*, 63 USPQ2d at 1305, 1309; *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1885 (TTAB 2011).

Applicant argues that the umbrella logo in his applied-for mark represents his personal opinion. That is, while Opposer's "open umbrella" offers protection, the "broken umbrella" in his mark represents failure, or a broken promise.⁵⁵ The commercial impression is completely different, he argues, just as an unbroken egg mark differs from a broken egg mark:



Furthermore, Applicant argues, Opposer's claim that his logo is likely to cause dilution by tarnishment of Opposer's logo is inconsistent with its claim that the marks are highly similar in commercial impression.⁵⁷

We agree with Opposer, however, that the relevant consumers—ordinary motorists—are likely to perceive the parties' marks as more similar than dissimilar. *See Speedbar, Inc. v. JEC Dev., Inc.*, 76 USPQ2d 1034, 1040 (TTAB 2005) (finding purchasers of auto repair services are "ordinary consumers who are not necessarily

⁵⁵ Applicant's brief, 62 TTABVUE 4-5.

⁵⁶ *Id.* at 4.

⁵⁷ *Id.*

sophisticated.”) Consumers encountering the marks would immediately perceive their similar, eye-catching red umbrellas:



Although one umbrella is open and one is broken, “we must look to the likely consumer perception of the mark in connection with the identified [services], rather than applicant’s intended connotation.” *UMG Recordings v. Mattel*, 100 USPQ2d at 1886. In the context of auto body repair services, motorists could just as easily perceive the broken umbrella as symbolizing a damaged automobile in need of repair. The broken umbrella also forms the recognizable letter C, part of the word “CLAIMS,” connoting insurance claims for auto repairs. *Cf.* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.05(g)(i) (Oct. 2018) (mark with distinctive design replacing a letter in descriptive or generic wording must still be disclaimed, if word is still recognizable). And the black san-serif lettering in Applicant’s mark emulates the lettering in Opposer’s word and design mark. So in appearance, connotation, and commercial impression, Applicant’s mark yields the impression that it is a variation on Opposer’s marks, used in connection with auto body repair services covered by Opposer’s insurance. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (Opposer’s use of variations on the dominant portion of its mark “would increase the likelihood that consumers would misconstrue the source of insurance under the mark”).

Applicant’s “broken egg” analogy is unavailing. As Opposer correctly notes, “Applicant cites no application, registration, or decision concerning or discussing the



alleged logos **Sunrise Farm** and **West Park Dinner**.⁵⁸ There is no indication that either logo is famous, or that they are used on or in connection with related goods or services.

Opposer draws a closer analogy to a nonprecedential decision, *PRL USA Holdings, Inc. v. Thread Pit, Inc.*, Cancellation no. 92047436 (TTAB 2012), in which the Board found confusing similarity between the famous Polo Player mark



and a falling Polo Player mark,



, both for clothing.⁵⁹

Comparing the marks, the Board found that “Given the fame of petitioner’s mark, the points of similarities in appearance, connotation and commercial impression outweigh the dissimilarities.” *Id.* at *13.

Here, as in the Polo Player case, Applicant’s alteration of Opposer’s famous mark does not dispel the marks’ confusing similarity. Ordinary motorists encountering the parties’ marks would normally retain a general rather than a specific impression of the marks. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). Given the fame of Opposer’s umbrella logo, they are likely to remember it, associate it with Opposer, and regard the parties’ marks as more similar than

⁵⁸ Opposer’s reply brief, 63 TTABVUE 10.

⁵⁹ Opposer’s brief, 60 TTABVUE 42-43; Opposer’s reply brief, 63 TTABVUE 10. “Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold.” *In re Soc’y of Health & Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018), *quoted in In re Alabama Tourism Dep’t*, 2020 USPQ2d 10485, at *6 n. 25 (TTAB 2020).

dissimilar. *See Bose v. QSC Audio*, 63 USPQ2d at 1305. Those “purchasers who do notice the difference in the marks will not necessarily conclude that there are different sources for the [services], but will see the marks as variations of each other, pointing to a single source.” *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014).

Applicant’s argument that tarnishment is incompatible with confusing similarity also misses the mark. In *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988) the Board found the applicant’s design mark displaying a defecating dog



confusingly similar to Greyhound’s famous design mark



even though the dogs were engaged in clearly different activities. The Board found likelihood of confusion under Section 2(d) even though, under the law applicable at the time, the applicant’s mark was deemed scandalous and disparaging under Section 2(a), as well. *Id.* A confusingly similar mark may tarnish a famous mark.

Because the parties’ marks are similar in appearance, connotation, and commercial impression, the first *DuPont* factor weighs in favor of a likelihood of confusion.

3. Relatedness of Services

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014).

Applicant’s identified services, again, are “auto body repair services” in International Class 37. Applicant argues that while “Travelers [sic] brief goes to great

lengths to ‘infer’ that they are engaged in auto repairs, the fact is that Travelers does not have a license to operate an auto repair facility, nor does it want to have one.”⁶⁰

“Travelers’ registrations comprise classes 9, 35, 36, 41 and 42,” he insists, while “Applicant’s registration is under class 37.”⁶¹

We agree with Opposer, however, that the parties’ identified services are related and complementary. “[L]ikelihood of confusion can be found ‘if the respective [goods and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). The International Classification is solely for the convenience of the PTO, and “is wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification.” *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) also quoted in *Ricardo Media v. Inventive Software*, 219 USPQ2d 311355 at *11 n. 16).

“In making our determination regarding the relatedness of the ... services, we must look to the ... services as identified in Applicant’s application and the cited registration. See *Stone Lion Capital ...*, 110 USPQ2d at 1162 ... (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (‘The authority is legion that the question of registrability of an applicant’s

⁶⁰ Applicant’s brief, 62 TTABVue 5.

⁶¹ *Id.* 62 TTABVue 3.

mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.))....” *In re Information Builders Inc.*, 2020 USPQ2d 10444, *2 (TTAB 2020).

And where, as here, the identification of services is broad, we presume that it encompasses all services of the type identified. *In re Country Oven*, 2019 USPQ2d 443903, *4 (TTAB 2019); *Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). As Opposer notes, Applicant's “auto body repair services” encompass repairs made in connection with insurance claims, including claims made by Travelers' insureds.⁶² Opposer's cited registrations cover *inter alia* “insurance underwriting services in the fields of . . . private passenger auto liability, commercial auto liability, auto physical damage,”⁶³ “insurance underwriting services in the fields of . . . auto commercial . . . [and] personal auto,”⁶⁴ and “insurance claims processing and administration.”⁶⁵

Under its umbrella logo marks, Opposer has not only covered insurance claims for auto body repairs; it has referred consumers to auto body repair facilities, and has even joined with partner auto body repair shops, which display the umbrella logo on their facilities, their signage, and their advertising.⁶⁶

⁶² Opposer's brief, 60 TTABVUE 43; Opposer's reply brief, 63 TTABVUE 12.

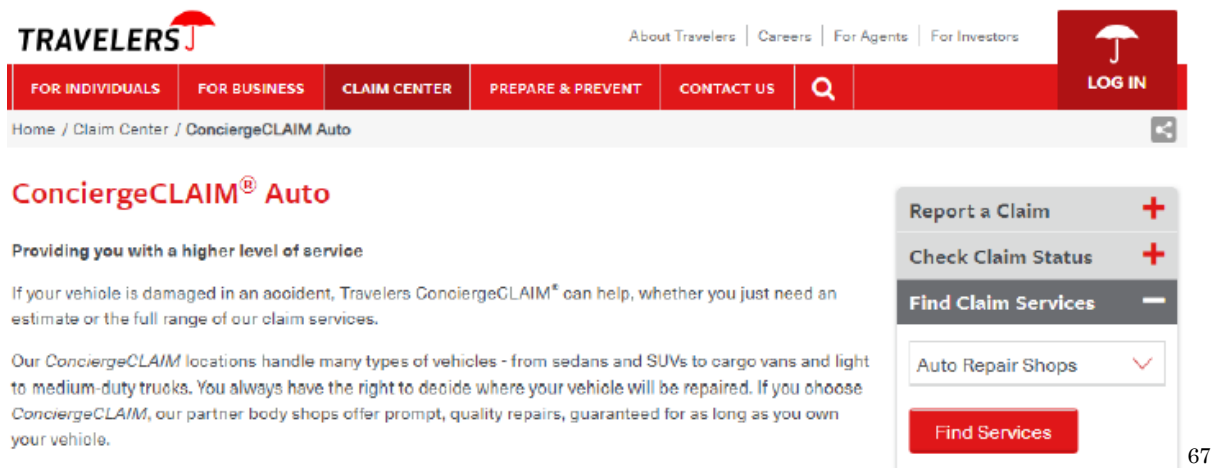
⁶³ Reg. nos. 3417048, 3417049, 3494647, and 3494648.

⁶⁴ Reg. nos. 3991520, 3991521, 4085572, 4085573.

⁶⁵ Reg. nos. 3417048, 4085573, 3494648.

⁶⁶ Opposer's brief, 60 TTABVUE 44; Opposer's reply brief, 63 TTABVUE 6; Morris decl. ¶¶ 13-17, 23 TTABVUE 5-11.

See, for example an excerpt from Opposer’s “Claim Center” page on its website at www.Travelers.com:



And examples of affiliated auto body shops and their signage:




To further underscore the related and complementary nature of the parties’ services, Opposer adduces over a dozen use-based third-party registrations covering both auto insurance services and auto repair services under the same mark.⁶⁹ For example:

⁶⁷ Morris decl. ¶ 16, 23 TTABVUE 9 ex. 2, 24 TTABVUE.

⁶⁸ Morris decl. ¶ 16, 23 TTABVUE 9 ex. 2, 24 TTABVUE 27-29.

⁶⁹ 29 TTABVUE.

Registration No.	Mark	Pertinent Services
5170891		Vehicle insurance services, namely, issuance of vehicle GAP insurance. Cl. 36 Vehicle repair and maintenance services. Cl. 37
4853808	WALSER	Insurance services, namely, providing extended warranty contracts on automobiles and issuing of automobile insurance. Cl. 36 Vehicle repair and maintenance; auto body repair services. Cl. 37
4899636	AUTOCARD 10	Insurance administration in the field of auto insurance. Cl. 36 Automobile repair and maintenance. Cl. 37
3833066	ALLSTATE DEALER SERVICES	Insurance underwriting services in the field of auto protection. Cl. 36 Automotive maintenance and repair. Cl. 37
4897094	CAR EZ	Insurance services, namely, underwriting, issuing and administration of automobile insurance. Developing and maintaining a network of pre-approved preferred provider auto body repair shops.

These registrations suggest that the parties' services may emanate from the same source. *DeVivo v. Ortiz*, 2020 USPQ2d 10153 at *13. As further evidence, Opposer introduced printouts from 25 websites showing that the same entity—such as Geico, Farmers, and Progressive--commonly provides auto insurance, auto repair, or auto repair referral services.⁷⁰ See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis....”).

Applicant does not controvert this evidence. Based on the evidence, we find that the parties' respective services are related, such that they could give rise to the


⁷⁰ 31 TTABVUE.


mistaken belief that they emanate from the same source, if offered under similar marks. *See Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1722. The second *DuPont* factor thus weighs in favor of likelihood of confusion.

4. Bad faith adoption

The thirteenth and final *DuPont* factor concerns “[a]ny other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. This factor accommodates the need for flexibility in assessing each unique set of facts. *In re Country Oven, Inc.*, 2019 USPQ2d 443903 at *15.

Opposer contends that Applicant, a former employee, has sued Opposer twice, has publicized the confidential details of those lawsuits, has criticized it on his website

while prominently using the logo , an admittedly altered version of Opposer’s umbrella logo, and has now applied to register a mark that alters that version, retaining and changing, to a certain extent, the “broken umbrella”:

 **RC Claims**. Opposer concludes that “Applicant unquestionably adopted his mark in bad faith, knowing of Travelers’ prior rights and intending for consumers to associate his logo with Travelers.”⁷¹ Applicant responds that he did not adopt the “broken umbrella” mark in bad faith, but as an expression of his personal opinion. He adds that “Applicant’s state of mind during the creation of the ‘broken umbrella’ has no bearing on his entitlement to registration.”⁷²

⁷¹ Opposer’s brief, 60 TTABVUE 46.

⁷² Applicant’s brief, 62 TTABVUE 4.

Applicant is partly right, in that his intent is not dispositive. Proof of intent to trade on another's good will can provide persuasive evidence of likelihood of confusion. *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). But good faith adoption does not avoid a likelihood of confusion. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) *quoted in* *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009). This *DuPont* factor "is highly fact specific and it is under very specific circumstances that this factor may matter." *In re Country Oven*, 2019 USPQ2d 443903 at *18.

We find the evidence falls short of showing bad faith. The evidence does not indicate Applicant's intent to trade on Opposer's goodwill; it indicates his intent to critique Opposer's policies for estimating auto body repair costs and selecting replacement parts. "[A]n inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987).

Absent a showing of bad faith, Applicant is correct that his state of mind has no bearing on likelihood of confusion. As noted, "we must look to the likely consumer perception of the mark in connection with the identified [services], rather than applicant's intended connotation." *UMG Recordings v. Mattel*, 100 USPQ2d at 1886.

For these reasons, the thirteenth *DuPont* factor is neutral.

5. Conclusion

We have considered all of the arguments and evidence of record and all relevant *DuPont* factors. Based on the fame of Opposer's marks, the similarity of the parties'

marks, and the relatedness of their services, we find that there is a likelihood of confusion under Section 2(d). 15 U.S.C. § 1052(d). In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution. *See Venture Out Props. LLC. v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007).

Decision: The opposition to registration of the mark in Application Serial No. 87611104 is sustained on the ground of likelihood of confusion under Section 2(d), and registration to Applicant is refused.