

Applicant : The Hagerty Group, LLC
 Mark : HAGERTY
 Serial No. : 88/377,168
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 Examiner : Joanna Scleidorovich
 Law Office : 128

RESPONSE

§ 2(e)(4) Refusal

In a June 26, 2019 Office Action, the examining attorney refused registration of the subject application on the grounds that the applied-for mark is primarily merely a surname. The Hagerty Group, LLC (“Applicant”), hereby respectfully requests reconsideration of the office action, which denied registration of application Serial No. 88/377,168 for INTERCHANGE BY HAGERTY pursuant to Section 2(e)(4) as primarily merely a surname. Applicant avers that the HAGERTY component of Applicant’s mark has acquired distinctiveness through its longstanding use in association with a variety of goods and services through its family of HAGERTY marks and, therefore, is not primarily merely a surname. In connection with this Response, Applicant has gathered evidence as discussed below that shows consumers have long viewed Applicant’s HAGERTY mark as a source indicator. Applicant therefore, respectfully requests that the above-captioned application proceed to registration.

A. Applicant Owns and Uses a Large Family of Well-Known and Respected Trademarks Incorporating HAGERTY as a Dominant and Shared Literal Element

Applicant is currently the owner of thirteen registered trademarks containing the formative “Hagerty:”

Mark	Reg. No.	First Use	Goods/Services
HAGERTY	2,814,153	08/01/2002	IC 036: Insurance services namely automobile insurance underwriting
HAGERTYPLUS	2,779,514	08/28/2002	IC 041: Internet newsletter and world wide web-based interactive informational services in the field of collector cars, emphasizing the preservation, safety and enjoyment of collector cars
HAGERTY DRIVING EXPERIENCE	4,217,642	07/2011	IC 041: Education and entertainment services, namely, providing a program featuring training in driving collector vehicles; education services, namely, providing information regarding collector vehicles
HAGERTY VALUATION TOOLS	4,236,758	09/11/2011	IC 035: Providing a website featuring information regarding the value of vehicles; providing an interactive database that permits

			users to research, track and compare the value of vehicles
HAGERTY PLUS	4,892,318	01/01/2007	IC 035: Club services, namely, promoting the interests of automobile collectors; IC 037: Emergency roadside assistances, namely, responding to calls for roadside assistance, changing tired, providing fuel, dispatches for lockouts, and jump starting batteries; IC 039: Emergency automobile towing
VALVE COVER RACING HAGERTY	4,945,542	05/30/2014	IC 041: Organizing, conducting and operating model vehicle racing competitions; Entertainment services, namely, conducting contests
HAGERTY. FOR PEOPLE WHO LOVE CARS.	5,205,570	01/16/2016	IC 016: Printed products, namely, guides, magazines, and pamphlets featuring information on topics relating to motor vehicle and boat collection; IC 035: Club services, namely, promoting the interests of motor vehicle and boat collecting; Providing a website featuring information regarding the value of vehicles; providing an interactive database that permits users to research, track and compare the value of vehicles; IC 036: Insurance services, namely, insurance underwriting and administration services in the fields of motor vehicle, marine, and collectable items; providing online information on insurance underwriting and insurance risk quotes; insurance services, namely, motor vehicle insurance services, which covers emergency roadside assistance for policyholders; financing services relating to motor vehicles; providing information about motor vehicle and boat collecting for investment purposes via a global computer network; IC 041: Providing information about motor vehicle and boat collecting for hobby purposes via a global computer network; providing a website featuring nondownloadable digital media, namely, an online interactive database of photographs, pictures, articles, e-zines, and videos, all in the field of motor vehicle and boat collecting; education services, namely, providing seminars in the field of motor vehicle and boat collecting

HAGERTY VEHICLE RATING	5,326,730	07/26/2016	IC 035: Providing online consumer information, ratings, and rankings in the field of automobiles and boats; Providing online consumer information in the field of automobiles and boats; Providing an online interactive database featuring collector automobile valuation information, ratings, and rankings for use in providing comparisons of automobiles.
HAGERTY INSIDER	5,544,851	01/07/2017	IC 009: Downloadable mobile applications for providing the valuation of and auction listings and data concerning classic and exotic automobiles, boats, and motorcycles.
DRIVESHARE BY HAGERTY	5,596,851	08/01/2018	IC 009: Computer application software for mobile phones, namely, software for facilitating the rental of automobiles; IC 042: Providing temporary use of on-line non-downloadable software for facilitating the rental of automobiles; Providing a website featuring non-downloadable software for facilitating the rental of automobiles.
HAGERTY DRIVERS CLUB	5,846,327	01/01/2019	IC 016: Printed products, namely, guides, magazines, and pamphlets featuring information on topics relating to motor vehicle and boat collection. IC 035: Club services, namely, promoting the interests of motor vehicle and boat collectors; providing an on-line computer database featuring trade information in the field of motor vehicles that permits users to research, track, and compare the value of vehicles. IC 036: Insurance services, namely, insurance underwriting and administration of insurance for motor vehicles, marine vehicles, and collectable items; insurance information, namely, providing online information on insurance underwriting and insurance risk quotes; insurance services, namely, motor vehicle insurance administration; financing services relating to motor vehicles; providing financial information about motor vehicle and boat collecting for investment purposes via a global computer network; providing information on vehicles for sale via a global

			<p>communications network, namely, vehicle valuations.</p> <p>IC 041: Providing information about motor vehicle and boat collecting for hobby purposes via a global computer network; providing a website featuring nondownloadable digital media, namely, an online interactive database of photographs, pictures, articles, e-zines, and videos, all in the field of motor vehicle and boat collecting; education services, namely, providing seminars in the field of motor vehicle and boat collecting.</p>
HAGERTY DRIVERS CLUB	5892103	01/01/2019	<p>IC 016: Printed products, namely, guides, magazines, and pamphlets featuring information on topics relating to motor vehicle and boat collection.</p> <p>IC 035: Club services, namely, promoting the interests of motor vehicle and boat collectors; Providing a website featuring information regarding the value of vehicles; Providing an on-line computer database featuring trade information in the field of motor vehicles that permits users to research, track, and compare the value of vehicles.</p>
HAGERTY DRIVERS CLUB	5892104	01/01/2019	<p>IC 016: Printed products, namely, guides, magazines, and pamphlets featuring information on topics relating to motor vehicle and boat collection.</p> <p>IC 035: Club services, namely, promoting the interests of motor vehicle and boat collectors; Providing a website featuring information regarding the value of vehicles; Providing an on-line computer database featuring trade information in the field of motor vehicles that permits users to research, track, and compare the value of vehicles.</p>

Exhibit A, Hagerty’s Registered Trademarks. Applicant’s numerous well-established registered trademarks all share the dominant literal element HAGERTY and are composed and used by Applicant in such a manner that the relevant consumers associate the individual marks and the common characteristic held between those marks, the use of the term “Hagerty,” with Applicant. *See In re Lc Trademarks, Inc.*, 121 U.S.P.Q.2d 1197 (T.T.A.B. 2016). As a result, Applicant’s marks are a family of marks under the law. *Id.*

1. Hagerty's Family of Marks Centers on the Literal Element HAGERTY

“[T]he rationale for the ‘family of marks’ theory is that a party has in effect established a ‘secondary meaning’ in a term which serves as the characteristic feature of a number of marks used and promoted together by him in his field of endeavor....” *Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 597 (TTAB 1980); *see also In re LC Trademarks, Inc.*, 121 U.S.P.Q.2d at 1197 (“A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner.”) (citation omitted). “Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.” *J&J Snack Foods v. McDonald's Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991). “To prove the existence of a family of marks, Applicant must show that its putative family (1) has a recognizable common characteristic, (2) that is distinctive, and (3) that has been promoted in such a way as to create ‘recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods or services.’” *In re LC Trademarks, Inc.*, 121 USPQ 2d 1197 (T.T.A.B. 2016) (citing *Wise F&I, LLC v. Allstate Ins. Co.*, 120 U.S.P.Q.2d 1103, 1109 (T.T.A.B. 2016)).

Even if Applicant's common law trademarks are not taken into account, Applicant's federally registered family of marks all share the dominant literal element HAGERTY, which makes each registered mark distinctive, and, as discussed below, Applicant has consistently promoted its family of trademarks to focus attention on its primary source indicator, the word HAGERTY, which binds all of Applicant's sub brands together in the minds of the relevant consumers. Of Applicant's registrations shown in the table above, the registration with the earliest first use date, Registration No. 2,814,153, identifies Applicant's core services and protects Applicant's core mark, HAGERTY as a stand-alone literal element. Applicant's other registrations incorporating HAGERTY do so in a manner that draws attention to the literal element HAGERTY. For example, HAGERTY DRIVING EXPERIENCE is a three-word mark put together in such a way that HAGERTY exerts a degree of ownership over the DRIVING EXPERIENCE, and those two words point back at HAGERTY. Consumers considering the services Applicant provides under HAGERTY DRIVING EXPERIENCE trust that the services will be of a high quality not because of the two-word phrase DRIVING EXPERIENCE, they can have faith in high quality because the DRIVING EXPERIENCE is from HAGERTY. Other marks shown above such as HAGERTY VALUATION TOOLS and HAGERTY VEHICLE RATING similarly emphasize the importance of the literal element HAGERTY in the minds of the relevant consumers. The VALUATION TOOLS are trustworthy because HAGERTY is their source. HAGERTY VEHICLE RATING is credible because the services are provided by HAGERTY as highlighted by the structure of the three-word phrase.

2. Applicant Has Expended a Significant Amount of Time and Energy Developing the Goodwill Consumers Associate with Applicant's HAGERTY Brand

Applicant is the world's largest insurer of classic and exotic automobiles, boats, and motorcycles. **Exhibit B**, Declaration of Kuzma. Applicant was founded in 1973 by Frank and Louise Hagerty and has, since that time, provided its insurance and related services to consumers in the United States, Canada, the United Kingdom, and the European Union. **Exhibit B**, Declaration of Kuzma. Since its founding forty-six years ago, Applicant has consistently and exclusively used the term "Hagerty" as the common element among all of its registered and common law trademarks and business lines. **Exhibit B**, Declaration of Kuzma. For example, Applicant's economic performance metric, which measures the value of a classic car against the market as a whole, is named HAGERTY VEHICLE RATING. **Exhibit A**, Hagerty's Registered Trademarks. Applicant's valuation algorithm, which produces a value of a classic car, is titled HAGERTY VALUATION TOOLS. **Exhibit A**, Hagerty's Registered Trademarks. When Applicant has acquired third party businesses, such as Classics & Exotics, which allows third parties to rent their classic car to others, Applicant has rebranded those third-party businesses with its common element (DRIVESHARE BY HAGERTY). **Exhibit A**, Hagerty's Registered Trademarks. **Exhibit C**, DriveShare Purchase. Applicant currently has twenty-one registered or pending trademarks containing the common "Hagerty" element. **Exhibit D**, TESS Printout. For these reasons, it is clear that the Hagerty family of marks share a common characteristic that has been used substantially exclusively and continuously for nearly half a century.

That shared common characteristic is also recognizable, distinctive, and has been promoted in such a way as to create recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods or services. Applicant has consistently used the "Hagerty" common characteristic since 1973 in association with its insurance services. **Exhibit B**, Declaration of Kuzma. Applicant has consistently advertised its insurance services through the <hagerty.com> domain name and associated website since as early as 1996. **Exhibit B**, Declaration of Kuzma. Applicant has consistently used the "Hagerty" common characteristic in association with mobile software applications since 2017, club services, towing, and emergency roadside assistance since 2007, and informational services since 2002. **Exhibit B**, Declaration of Kuzma. These longstanding, continuous, and exclusive uses evidence that the formative "Hagerty" is distinctive.

Applicant has also advertised the "Hagerty" common characteristic throughout the United States and through a variety of media sources. Applicant has produced twenty-three nationally aired television commercials, which have played on such widely distributed and well-known networks as Velocity and ESPN, which are more than well-known to Applicant's consumers. **Exhibit B**, Declaration of Kuzma; **Exhibit E**, Television Commercials. Applicant spends in excess of \$4,000,000 in paid advertisements on a yearly basis. **Exhibit B**, Declaration of Kuzma. Applicant's social media channels also evidence the reach of its brand and the "Hagerty" common characteristic. Applicant has over 1.2 million Facebook followers, over 17,000 Twitter followers, 100,000 Instagram followers, and over 760,000 YouTube subscribers. **Exhibit F**, Social Media Channels. Many of Applicant's YouTube videos have millions of views, such as its rebuild of a Ford Flathead V8 engine, which boasts over 10 million views. **Exhibit G**, YouTube Views.

Applicant has also entered into many partnerships and sponsorships, which further the recognition and distinctiveness of the “Hagerty” common characteristic. Applicant’s youth programs help engage younger generations with the classic car hobby by allowing them to participate in judging classic car contests, teaching them to drive manual transmissions, and teaching them automotive skills, such as design and photography. **Exhibit H**, Youth Programs. Applicant’s Hagerty Dawn Patrol hat, which is given to attendees at an early morning event at the Pebble Beach Concours d’Elegance, the world’s premiere classic car event, has been described as “THE status symbol for car collectors.” **Exhibit I**, Dawn Patrol Article. Applicant has sponsored an Indy 500 car, which was viewed on NBC by 5.45 million people. **Exhibit J**, Indy 500 Sponsorship. Applicant has entered into partnerships with Nationwide Insurance, Progressive Insurance, and Markel, whereby Applicant provides classic car insurance to the millions of customers serviced by these insurance companies. **Exhibit B**, Declaration of Kuzma; **Exhibit K**, Insurance Partnerships. The wide and diverse reach of Applicant’s advertising and its consistent use of the “Hagerty” common element make clear that the purchasing public sees “Hagerty” as indicative of a common origin of Applicant’s services.

B. Applicant’s HAGERTY Mark has Acquired Secondary Meaning for Many Goods and Services, Including the Class of Goods Cited in the Subject Application

This market evidence is of the sort that applicants submit and examining attorneys evaluate when determining whether individual marks have acquired secondary meaning. *See In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985). Once proven, a family of marks may help the owner of that family establish a new family member’s acquired distinctiveness. See 5-5 Gilson on Trademarks § 5.03 (“In a family of marks case, a court or the Trademark Trial and Appeal Board asks whether consumers would view the defendant’s marks as members of the plaintiff’s family of marks.”). “If an applicant had a well-established family of marks characterized by a common characteristic, and applied to register a mark with the same family characteristic, it could credibly argue that its prior family of marks would expedite the public’s recognition of applied-for mark as a member of the family.” *In re Lc Trademarks, Inc.*, 121 U.S.P.Q. 2d 1197.

Supported by Applicant’s family of well-curated marks, the HAGERTY mark has acquired secondary meaning within Class 035. **Exhibit A**, Hagerty’s Registered Trademarks. Section 2 of the Trademark Act provides, “[N]othing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” Though a term may be first considered primarily merely a surname, such a term may nevertheless be registered if it has become distinctive of the applicant’s goods:

The statutory word “primarily” refers to the main significance of a word as a word, not to its significance as a trademark due to advertising and promotion. MCDONALD’S for quick service restaurants was found to be “primarily merely a surname” even though it has achieved trademark significance. Secondary meaning under § 2(f) must always be submitted on the record to register such a surname as a mark.

2 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition § 13:28 (4th ed. 2017) (“McCarthy”) (citing *In re McDonald's Corp.*, 230 USPQ 304 (TTAB 1986)).

Such secondary meaning may also transfer between a previously registered or distinctive mark and the mark claimed to have acquired distinctiveness, “provided the applicant can establish that, as a result of the applicant’s use of the mark on other goods or services, the mark has become distinctive of those other goods or services and that this previously created distinctiveness will transfer to the goods and services listed in the application when the mark is used on them.” *In re Olin Corp.*, 124 U.S.P.Q. 2d 1327 (TTAB 2017). In these cases,

the applicant must establish acquired distinctiveness as to the other goods or services by appropriate evidence, such as, (i) ownership of a prior registration for the same mark for related goods or services, (ii) a prima facie claim of acquired distinctiveness based on five years use of the same mark with related goods or services or (iii) actual evidence of acquired distinctiveness for the same mark with respect to the other goods or services.

The goods and services identified in the application must be sufficiently related to the goods and services specified in the claim to support a determination that the previously created distinctiveness will transfer to the goods and services in the application upon use.

Id.

The use of the common “Hagerty” element in combination with both services within Class 035 (club services, namely, promoting the interests of motor vehicle and boat collecting) and Class 041 (providing information about motor vehicle and boat collecting for hobby purposes via a global computer network; providing a website featuring nondownloadable digital media, namely, an online interactive database of photographs, pictures, articles, e-zines, and videos, all in the field of motor vehicle and boat collecting; education services, namely, providing seminars in the field of motor vehicle and boat collecting), after its longstanding use of that same common element in association with its family of marks has expedited the public’s recognition of the HAGERTY mark. **Exhibit A**, Hagerty’s Registered Trademarks. Applicant owns numerous trademark registrations for the same HAGERTY mark for use in association with similar goods or services, including insurance services, club services, magazines, informational services, mobile software applications, education and entertainment services, emergency towing, emergency roadside assistance, racing competitions, and online consumer information. **Exhibit A**, Hagerty’s Registered Trademarks. Therefore, Applicant owns numerous prior registrations for the same mark, or its common element, for related goods and services.

The services cited in applicant’s application, which are those commonly sold together with both club services and providing information via a website or computer network, are also entitled to a prima facie claim of acquired distinctiveness based on five years of substantial, continuous, and exclusive prior use. **Exhibit A**, Hagerty’s Registered Trademarks; 15 U.S.C. §

1052. These types of services, on which the HAGERTY mark has been continuously and exclusively used since 1995, are those of the sort that are often sold with the other services cited in Applicant's application. For this reason, the "Hagerty" component of Applicant's INTERCHANGE BY HAGERTY mark is not primarily merely a surname.

Finally, as cited above, Applicant's extensive advertising and promotion of the "Hagerty" common element and the Hagerty family of marks, along with the public's knowledge and perception of the Hagerty brand, serves as actual evidence of acquired distinctiveness for the HAGERTY component of its mark with respect to the same or similar goods or services.

CONCLUSION

For these reasons, Applicant respectfully requests that the INTERCHANGE BY HAGERTY mark proceed to registration on the principal register. With respect to Class 035, Applicant asserts that the HAGERTY component of its mark has acquired distinctiveness through the longstanding use of the Hagerty family of marks and is not primarily merely a surname. Because Applicant's HAGERTY trademark has been and is the cornerstone upon which it has built its goodwill in the minds of consumers, Applicant will be forced to exhaust all roads toward the federal trademark registration that it respectfully asks be approved in light of its inclusion the precedent discussed above and the evidence presented in this Response. If the Examining Attorney has any questions or doubts, Applicant's undersigned attorney encourages a phone call.