

Applicant : The Hagerty Group, LLC  
Mark : RADIUS  
Serial No. : 90120693  
Filed : 08/18/2020  
Examiner : Lourdes Ayala  
Law Office : 106

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## **RESPONSE TO OFFICE ACTION**

### **Amendment to Identification of Goods**

Applicant requests that the examining attorney amend the goods as follows:

International Class 36: Insurance Services, namely, underwriting, issuance, and administration of automotive insurance.

### **§ 2(d) Likelihood of Confusion Refusal**

The Examining Attorney has issued a refusal to register the mark RADIUS based on § 2(d) of the Trademark Act. The Examining Attorney has cited registration no. 75,656,234 for RADIUS and registration no. 86,729,440 for RADIUS CHOICE based on her finding that there is a likelihood of confusion between Applicant's mark and the cited marks due to a similarity of the marks and relatedness of the claimed goods. Applicant respectfully submits the following response and requests that the Examining Attorney withdraw the § 2(d) refusal as there is no likelihood of confusion between Applicant's and Registrants' marks. The following analysis compares Applicant's RADIUS – 90120693 to both RADIUS – 75,656,234 *and* RADIUS CHOICE – 86,729,440 because they are owned together by Registrant.

**RADIUS – 75,656,234 and RADIUS CHOICE –86,729,440**

Analysis

In interpreting the “likelihood of confusion” standard, courts have ruled that there must be more than just a “possibility” of confusion among consumers. *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1507 (2d Cir. 1997) (“[L]ikelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely ‘possible.’”). The courts then apply a multi factor analysis to determine whether an actual likelihood of confusion exists between two marks.

The following factors are considered in a likelihood of confusion analysis under § 2(d): (1) the similarity or dissimilarity of the marks; (2) the similarity or dissimilarity of the identified goods or services; (3) the similarity or dissimilarity of established and likely to continue channels of trade; (4) the degree of care exercised by consumers when purchasing the identified goods or services; (5) the fame of the senior mark; (6) the number and nature of similar third-party marks for related goods or services; (7) the nature and degree of any actual confusion; (8) the duration and circumstances surrounding any concurrent use without actual confusion; (9) the variety of goods or services for which a mark is used; (10) the market interface between the Applicant and the owner of the senior mark; (11) the extent to which Applicant may exclude others from use of its mark on its goods or services; (12) the degree of potential confusion; and (13) any other established fact probative of the effect of use. *Id.* at 1361. The analysis may be focused on “dispositive factors.” *Royal Appliance Mfg. Co. v. Minuteman Int'l, Inc.*, 30 Fed. Appx. 964, 967 (Fed. Cir. 2002); (citing *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001) (citation omitted)). In this case, second, third, fourth, and twelfth factors weigh against a finding of a likelihood of confusion by consumers.

Similarity of the Marks

Applicant concedes that under the first factor, the marks RADIUS and RADIUS are similar. However, differences between the marks for only one of the Du Pont factors is sufficient to find dissimilarity between the marks, and the analysis below indicates that the marks differ from one another on several other factors. The marks being similar under factor one does not make certain a likelihood of confusion.

#### Dissimilarity of the Services and Channels of Trade

When making a determination as to a likelihood of confusion, the “similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use” must be considered. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Also, relevant to this analysis is the “similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* Applicant considers these two factors in conjunction with one another although each, on their own weigh heavily against a likelihood of confusion.

Applicant has applied for registration of RADIUS for use on *Insurance Services, namely, underwriting, issuance and administration of automotive insurance*. Registrant has registered their marks RADIUS and RADIUS CHOICE for use on *Disability income insurance underwriting services and administration in the field of disability income insurance*. Breaking down Registrant’s claimed goods, we find that Registrant claims use of RADIUS and RADIUS CHOICE on disability income insurance only.

The Examining Attorney bases the refusal on the assumption that because both Registrant’s and Applicant mark provide insurance services, they are related. Applicant clarifies that Hagerty is an automotive insurance company that includes specialty coverage for collectible vehicles. The

office action states that likelihood of confusion is determined by the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The office action also states that the application uses broad wording to describe the insurance services, which presumably encompasses all services of the type described, including Registrant's more narrow insurance underwriting services and administration in the field of disability income insurance.

In this response, Applicant has clarified that the insurance it provides is in the field of automotive insurance by amending the Identification of Goods to a description narrowed to automotive insurance: *Insurance Services, namely, underwriting, issuance and administration of automotive insurance*. Comparing the Identifications of Goods, Registrant clearly limits its services to disability income insurance, and Applicant now limits its services to automotive insurance. Registrant's services and Applicant's services involve offering two distinct types of insurance in the description that are neither complementary nor related. The services are not likely to be purchased by the same purchasers for the same or related purposes either. In fact, they are not likely to be purchased by the same purchasers at all.

Registrant's and Applicant's services are not likely to be purchased for the same or related purposes. Registrant's product is a disability income insurance. These services cover a portion of one's income if one were to become too sick or injured to work. According to Registrant's website, disability income insurance is recommended for people who have financial dependents or who depend heavily on their regular income. In contrast, Applicant provides automotive insurance and specializes particularly in insurance coverage for collectibles. Applicant's site proclaims it offers "Insurance for people who love cars . . . protect[ing] collectibles as if they were our own." A

customer would purchase Registrant's services for insuring her income, whereas a customer would purchase Applicant's services for protecting her classic car. Therefore, the services would not be purchased for the same or related purpose.

Not only are disability income insurance and classic car insurance unrelated, Registrant's and Applicant's services are not likely to be purchased by the same purchasers, either. First, Registrant recommends its disability income insurance to those who are dependent on their income and therefore would experience financial strain if they were precluded from receiving it due to an unexpected illness or injury. It is not likely that a customer of Registrant, who is presumably somewhat dependent on her income and lacking a substantial amount of savings, would have a classic car to protect with Applicant. Classic cars are expensive and require significant sums of money to maintain and insure. If one is dependent enough on her income to warrant disability insurance, it is not likely that person would have a large amount of disposable income to spend on a classic car, nor is it likely that person would choose to spend a presumably limited amount of savings on a classic car. In the same way, it is not likely that a customer of Applicant, a classic car owner who purchases specialty insurance to protect it, is in a position that necessitates disability income insurance. Considering the added expenses for those who own and insure classic cars, it is likely customers of Applicant have more disposable income and savings such that insuring their income is not needed for them. Thus, it is not likely that Registrant and Applicant's services are purchased by the same people.

Applicant's description of services distinguishes Applicant's services as automotive insurance from Registrant's services as disability insurance. As summarized above, because each of the services stated in the application are not likely to be purchased by the same purchasers for the same purpose, factor two weighs against a likelihood of confusion.

Again, Registrant's and Applicant's consumers are completely different. These products are different, the markets are different, the channels of trade are different, and the price points are entirely different. The products are not used for the same or even complementary uses. No one is going to be confused because Registrant's customers would not have any need for nor would they likely purchase Applicant's products.

Given the above analysis, it is clear that Registrant's goods directed toward a class of consumers quite dissimilar to Applicant's classic car collectors. Applicant has no reason to market to nor to believe that Registrant's customers would purchase its products. It is likely that targeted advertising campaigns of the two parties will differ significantly due to this distinction. The channels of trade differ because the class of purchaser likely to be exposed to Applicant's and Registrant's marks is so different. Therefore, factors two *and* three together and independently weigh against a finding of a likelihood of confusion.

#### Degree of Care Exercised by Consumers

The chances of confusion as to source arising from the use of the parties' respective marks is *de minimus* by virtue of the specialized nature of each of the Registrant's and Applicant's services. Purchasing any type of insurance is a big financial decision that requires close examination of pricing, coverage options, and qualified individuals. Therefore, both Registrant's and Applicant's consumers are likely to use a very high degree of care when making decisions about purchasing Registrant's income protection and Applicant's classic car insurance. Upon a simple glance over coverage options, which can easily be viewed on Registrant's and Applicant's respective websites and are likely to be discussed before purchasing, consumers can clearly see the differences between the services provided: coverage for disability income vs. coverage for

classic cars. For example, a consumer seeking out disability income insurance by Registrant would not confuse Applicant's services for Registrant's because Applicant clearly offers automotive coverage for classic cars, not income, and a consumer would undoubtedly examine such coverage options before purchasing. Additionally, as described above, consumers are not likely to be confused by Applicant's products because they are marketed and sold in completely different streams of commerce. Therefore, this factor also weighs against a likelihood of confusion.

#### Degree of Potential Confusion

Due to the overwhelming evidence that the claimed services and streams of commerce are distinct, this factor must also weigh against any likelihood of confusion.

#### Conclusion

The above analysis makes clear the significant differences between RADIUS and RADIUS for the claimed goods. The second, third, fourth, and twelfth factors independently weigh against a finding of a likelihood of confusion by consumers. In light of this, and because there must be more than a possibility of confusion in determining that a likelihood of confusion exists, here, there can be no finding of a likelihood of confusion.

Because of the above analysis, new information and conclusions, Applicant requests that the Examining Attorney withdraw the refusal to register Applicant's RADIUS mark and allow the application to move toward registration.