

TTAB

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TRADEMARK

Ref. No.: 00630000105

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:)
Wintrust Financial Corporation)
Serial No.: 75/935,479)
Filed: February 17, 2000)
Mark: NORTHBROOK BANK &)
TRUST COMPANY)

Examining Attorney: B. Brown
Law Office: 105

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CERTIFICATE OF MAILING

I hereby certify that Applicant's Reply Brief is being deposited with the United States Postal Service as First Class Mail, postage pre-paid, on this date November 12, 2002, in an envelope addressed to:

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November 12, 2002
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APPLICANT'S REPLY BRIEF

I. INTRODUCTION

This Reply Brief is responsive to the Examining Attorney's Appeal Brief mailed October 23, 2002. The prior procedural history related to this application has been accurately set forth in Applicant's Appeal Brief and the Examining Attorney's Appeal Brief.

II. RELEVANT FACTS

The Examining Attorney has continued to refuse registration, contending that Applicant's mark so resembles the marks shown in U.S. Registration Nos.:

DD

1,265,418 for "Northbrook" for use in connection with insurance services and property and casualty loss control services;

1,679,641 for "Northbrook" for use in connection with commercial and liability insurance underwriting services and insurance consulting services; and

2,266,244 for "Northbrook" for use in connection with commercial and liability insurance administration services; underwriting and administration services in the field of life insurance; underwriting and administration services in the field of annuities,

as to be likely to cause confusion, to cause mistake or to deceive in violation of Trademark Action §2(d), 15 U.S.C. §1052(d).

The above refusal is the only issue outstanding in the pending application. All other matters having been resolved.

As set forth in the following sections of this reply brief, Applicant asserts that the Examining Attorney's contentions are in error and asks that this Board reverse the refusal and pass this mark to publication.

III. ARGUMENT

The Examining Attorney has submitted that the similarity of the marks and the goods/services are the most relevant *Du Pont* factors and that all other *Du Pont* factors cannot be considered because there is no relevant evidence concerning those factors in the record.

Applicant strenuously objects to the Examiner's misrepresentation of the record. Applicant's June 5, 2002 Response to Office Action specifically addresses and provided evidence with respect to each of the following factors:

1. Dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. The dissimilarity and nature of the services as described in the subject application with which a prior mark is in use;
3. The dissimilarity of established, likely-to-continue trade channels;
4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing;
5. The lack of fame of the prior mark;
6. The number and nature of similar marks in use on similar goods or services; and,
7. The lack of any concurrent use without evidence of actual confusion.

Accordingly, all evidence in the record and Applicant's Appeal Brief is properly before this Trademark Trial and Appeal Board ("TTAB"). Therefore, this TTAB must evaluate and weigh evidence directed to all the factors addressed by Applicant and disregard the Examiner's assertion as patently false.

Applicant respectfully submits that after a careful analysis of the *Du Pont* factors, this Board will conclude that each of the factors weights in favor of Applicant and that registration is proper.

1. Dissimilarity of the Marks

The Examiner states that the “issue is whether the marks create “the same overall impression.” Yet, the Examiner continues to dissect the proposed mark in order to generate the desired outcome. The Examiner fails to provide any discussion or evidence directed an overall impression or marks in their entirety, composite marks or extreme weakness of the cited registrations. Rather, the Examiner provides conclusory statements and premature conclusions based upon superficial analysis.

The use of identical words is often insufficient to conclude that marks are confusingly similar. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th Cir. 1987); *See, Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 181 U.S.P.Q. 44 (C.C.P.A. 1974) (finding that DUTCHMASTERS and DUTCHAPPLE are not confusingly similar); *see also, Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (finding that PEAK and PEAK PERIOD are not confusingly similar); *see also, Smith v. Tobacco By-Products and Chemical Corp.*, 113 U.S.P.Q. 339 (C.C.P.A. 1957) (finding that GREENLEAF and BLACKLEAF are not confusingly similar). The ultimate conclusion rests on consideration of the marks in their entireties. *In re National Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985).

A composite mark should not be fragmented into its various pieces. *Estate of P. D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It is the likely reaction of customers to the total mark that is at issue, not the dissected parts. *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 U.S.P.Q. 563 (C.C.P.A. 1967) (emphasis added). See *Ex Parte Maya de Mexico*, 103 U.S.P.Q. 158 (Comm'r Pat. 1954).

The Examining Attorney's assertion that similarity in either sound, appearance, meaning or commercial impression alone is sufficient to find a likelihood of confusion completely distorts and mischaracterizes the holding and analysis of *In re Mack*, 197 U.S.P.Q. 755 (T.T.A.B. 1977). Rather, as nearly every other trademark decision clearly states, other likelihood of confusion factors must also be evaluated before drawing any such conclusion. Applicant respectfully requests this Board to note the above cited cases in which identical or nearly identical marks were registered as a result of lack of likelihood of confusion.

Moreover, the cited registrations are registered on the Supplemental Register or so lacking in secondary meaning that a Section 2(f) affidavit was required. As a result thereof, the scope of protection accorded such a descriptive mark is significantly narrowed and limited such that likelihood of confusion can only be found where the marks are nearly identical as with respect to the marks and the services provided in connection therewith. *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994). In the subject

application, the marks are sufficiently different to avoid a likelihood of confusion as discussed above.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's mark NORTHBROOK BANK & TRUST COMPANY is sufficiently different than the cited mark as to appearance, sound, connotation and commercial impression, as to avoid a likelihood of confusion.

2. Dissimilarity of the Services

While the services need not be identical or directly competitive, where the services are non-competing, the degree of similarity necessary to establish likelihood of confusion increases dramatically. *David Sherman Corp. v. Heubein, Inc.*, 144 U.S.P.Q. 249 (8th Cir. 1965). Cases where courts have found likelihood of confusion between two non-competing goods, the relationship between the products was clear. *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 192 U.S.P.Q. 555 (7th Cir. 1976)(liquor with restaurant selling liquor); *Union Carbide Corp. v. Ever-Ready, Inc.*, 188 U.S.P.Q. 623 (7th Cir. 1976)(batteries and lamps with light bulbs and lamps); *Scarves by Vera, Inc., v. Todo Imports, Ltd.*, 192 U.S.P.Q. 289 (2d Cir. 1976)(women's scarves and apparel with women's cosmetics and fragrances).

The relationship between the services provided by the Applicant and the non-competing services provided by Registrant is not clear. The nature and scope of Registrant's services must be determined on the basis of the services set forth in the registration, not in third party registrations. See, e.g.,

Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 177 U.S.P.Q. 76 (C.C.P.A. 1973).

Banking services and insurance services are not clearly related on their face and the Examiner has failed to produce any evidence to rebut this fact.

It is also not clear that Registrant will ever participate in providing banking services similar to those offered by the Applicant, and the Examiner has failed to produce any evidence to rebut this fact.

Furthermore, Registrant is barred by law from providing banking services, and the Examiner has failed to produce any evidence to rebut this fact.

Finally, the Examining Attorney has failed to provide any evidence that Registrant can or intends to provide banking services in the future. Even though there may be a remote possibility that the Registrant may in the future time provide banking services in addition to the insurance services now provided, at this time, Registrant does not even "intimate such a purpose." See, *S.C. Johnson & Sons, Inc. v. Johnson*, 175 F.2d 176, 180 (2d Cir. 1949) (No confusion was found between floor wax and cleaner and furniture polish with brooms and mops: "Although the Plaintiff may at some future time wish to make cleaning fluids, it does not now even intimate such a purpose.").

The Examiner further asserts that there are no restrictions or limitations as to the channels of trade. However, the cited registrations are in fact limited in their channels of trade. The cited registrations are limited to commercial

business-to-business channels of trade. The commercial relationship of the recited services and the marketplace limits the cited registrations channels of trade to commercial business insurances. The recited services of "property and casualty loss control services" is recognized and acknowledged in the insurance industry as provided exclusively in the commercial business channel of trade, essentially a business-to-business transaction. Furthermore, "commercial and liability insurance underwriting services" and "insurance consulting services" are also recognized and acknowledged in the insurance industry as provided through the commercial business channel of trade.

The Examiner attempts to prove that banking services are within the normal field of expansion for a commercial insurance provided by reliance upon an act of Congress. The Examiner's reliance on the repeal of the 1939 Glass-Steagal Act is wholly unfounded. Applicant is unaware of and the Examining Attorney has failed to provide any basis or showing that the TTAB or the Federal Circuit have held in a published opinion that the repeal of the 1939 Glass-Steagal Act creates a presumption that banking services and insurance services are so highly related as to be nearly identical, as the Examining Attorney asserts.

Further, the Examiner's "evidence" of the normal field of expansion for commercial insurance, namely the June 1 2002 article regarding Met Life and the May 15, 2002 article regarding Webster Bank, is based upon supposition from which the Examiner draws a dubious conclusion. Each article fails to

provide a critical element of information, the mark under which such new services are proposed to be offered.

The Met Life article states that they have formed a banking unit and that it hopes to provide banking services. Obviously, Met Life has not provided any banking services, so the Examiner cannot properly conclude that banking services are within the normal field of expansion without huge leaps in logic and reasoning. The fact that a banking unit has been formed is only the first step of many necessary for any entity to begin providing banking services. It is equally likely that governmental approval or prohibitive costs may make the provision of such services unattractive for MetLife. Until such services are provided, this article is nothing more than marketing fluff with no evidentiary value with respect to likelihood of confusion. Further, there is no mention of the mark under which the proposed banking services would be provided. Accordingly, there is no basis the Examiner can rely on to prove that the public would conclude from this that insurance and banking services emanate from the same source.

The Webster Bank article states that one small bank is branching out into different services including insurance coverage and that Webster Bank just bought its second insurance agency. There is no evidentiary value for this article because the article fails to state whether the bank offers such insurance coverage in connection with its banking services. It is equally likely from this marketing piece that the insurance agency continued to operate under its prior trademark and management. Accordingly there is no evidence that the

insurance agency is operated under a mark which leads consumers to believe that the banking and insurance services emanate from the same service or that insurance services are within the normal field of expansion from banking services. Accordingly, there is no evidentiary value in these articles to the decision of relatedness of the services or likelihood of confusion.

Moreover, if this is all the Examiner's evidence that the public may have the mistaken belief that the services emanate from the same source, Applicant contends that such evidence is woefully inadequate.

Finally, the Examiner has failed to provide any evidence that the repeal of the Glass-Steagal Act would lead any purchaser to believe that banking and insurance services are likely to emanate from the same source. Applicant submits that reasonable purchasers are much more familiar with trademarks and goods and services associated therewith than acts of Congress which regulate and control business activities; such that a reasonable purchaser would be able to identify the source of NIKE shoes or POLO clothes but would be at a loss to identify any of the goals or purposes of the Glass-Steagal Act, much less what the impact of the repeal of such act means to them. Accordingly, the Examiner's attempt to bootstrap relatedness from the repeal of the Act fails.

Next, the Examiner attempts to have his cake and eat it too. The Examiner asserts that the nine (9) registrations evidence that banking and insurance services often emanate from the same source. However, third-party registrations are not evidence of what happens in the marketplace or that the

public is familiar with the use of the marks. *National Semantics and Space Admin. v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975). Further, the Examiner admits that even sophisticated or knowledgeable purchasers in a particular field are not sophisticated or knowledgeable in the field of trademarks. *In re Decombe*, 9 USPQ 2d 1812 (TTAB 1988). Therefore, these third-party registrations cannot be considered evidence of what happens in the marketplace or, in other words, the commercial relationship of the services.

Banking services are not present in any of the recitations of services of the cited registrations. Further, the Examining Attorney has failed to make satisfactory showing that Registrant is licensed to provide banking services. Hence, this TTAB must conclude that Registrant is barred at law from providing banking services. Accordingly, Registrant cannot provide banking services and will not be viewed by the public as a source of banking services in the same channels of trade as Applicant's services.

Further, the Examining Attorney fails to provide any showing that the relationship between non-competitive banking services and insurance services could give rise to the mistaken belief that the services emanate from a common source. The third party registrations are not probative as a determination of likelihood of confusion analysis between the cited registration and the subject application.

Moreover, Applicant's services are sufficiently different from the cited registration to avoid a likelihood of confusion because the cited registrations are on the Supplemental Register or so each secondary meaning that Section

2(f) affidavit was required. As a result thereof, the scope of protection accorded such a registration is significantly narrowed such that likelihood of confusion is only found where the services are nearly identical with respect to the marks and the services provided in connection therewith. *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994). Accordingly, the only conclusion this Board can draw is that the services of Applicant and Registrant are sufficiently different such that a finding of likelihood of confusion cannot be supported.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's services are significantly different than those recited in the cited registration as to avoid a likelihood of confusion.

Moreover, several of the cited registrations are directed to commercial products which travel in different trade channels to different purchasers and banking services available to the public.

3. Dissimilarity of Trade Channels

As discussed above, Registrant provides insurance services in the commercial business channel of trade in a business-to-business commercial relationship and is barred by law from providing banking services. Accordingly, the services of the cited registrations cannot legally travel through the same channels of trade as the Applicant's services. Further, as discussed above, Registrant does not "intimate such a purpose" of providing banking services in the future.

The Examining Attorney has failed to provide a satisfactory showing that Registrant is entitled to provide banking services other than an over-generalized reference to the repeal of the 1939 Glass-Steagal Act. Reliance on such an act of Congress and actions of other third parties is irrelevant with regards to registration. *See e.g., Canadian Imperial; Paula Payne.* Additionally, the Examining Attorney has failed to provide any evidence that Registrant has filed for or has been granted authorization to provide banking services or that Registrant is considering such a request.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's services travel in sufficiently different channels of trade than those recited in the cited registration as to avoid a likelihood of confusion.

4. Conditions Under Which Sales are Made

The Examiner states that "minimal proof regarding sophistication of the customer" is provided by Applicant. Applicant recommends that the TTAB review Section 4 of Applicant's Brief on page 12 where there is a thorough discussion of this factor.

Again, the Examiner's conclusory statements lack any analysis from which a meaningful conclusion may be drawn.

Applicant submits that it is reasonable to conclude that where sizeable sums of money are either expended or involved, the purchaser is knowledgeable and sophisticated. A business interested in obtaining property and casualty insurance coverage is going to spend a sizeable amount of money.

It follows that the business will thoroughly investigate the insurance companies and coverage options available before expending such sizeable sums. In the course of such investigation the purchaser will become knowledgeable about the trademarks associated with such services sufficient to be immune from source confusion.

Likewise for banking services, a reasonable purchaser of such services will investigate where and with whom their money is going to be kept such that they become knowledgeable and sophisticated. These purchasers will also be knowledgeable about the trademarks under which such services are provided.

The Examiner has failed to indicate any holding which states that a purchase must be knowledgeable about the entire field of trademarks and trademark law. In this day of advertising overkill nearly every purchaser is aware of trademarks without intimate knowledge of the trademark laws or process. Further, knowledge about trademarks is gained through investigation of a field pertinent to the purchaser. In this manner purchasers become sophisticated and knowledgeable about the trademarks in the field of interest. Moreover, the purchasing public must be credited with a modicum of intelligence. *Carnation Company v. California Growers*, 37 U.S.P.Q. 735, 736 (C.C.P.A. 1938).

Accordingly, Applicant respectfully submits that it would be strange for sophisticated, well-informed customers of these disparate services to be confused about whom they are dealing with. *Amalgamated Bank of New York*

v. Amalgamated Trust & Savings Bank, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988); *Cohn v. Petsmart, Inc.*, 61 U.S.P.Q.2d 1688 (9th Cir. 2002).

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the purchasers of banking services and insurances services are both sophisticated and careful enough such that a likelihood of confusion is highly improbable.

5. Lack of Fame

The Examining Attorney has failed to rebut this factor or to provide any evidence that the cited registration is entitled to any deference with regard to fame. Accordingly, Applicant must reasonably conclude that the cited registration is not famous and must be accorded a limited scope of protection. As further evidence of such limited scope of protection, the court in *In re Smith and Mehaffey* held that likelihood of confusion is found for marks on the Supplemental Register or so lacking secondary meaning as to require a Section 2(f) affidavit only where the marks and goods are nearly identical. 31 U.S.P.Q.2d at 1533.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited marks and Applicant's subject mark are sufficient to avoid a likelihood of confusion.

6. Similar Marks in Use

The Examiner failed to rebut Applicant's evidence directed to this factor. Accordingly, Applicant respectfully submits that the cited marks are extremely weak.

As evidence of such weakness and the extremely limited scope, Applicant submitted two (2) pages from a Thomson & Thomson search report directed to common law use of the expression "Northbrook" in connection with banking, investment, financial and insurance services. Please note Exhibit A submitted with Applicant's response dated June 5, 2002. Furthermore, Applicant also provided two (2) pages from the local telephone directory covering the Northbrook, Illinois area which lists numerous other common law uses of the "Northbrook" expression by providers of goods and services which incorporate the name of the city Northbrook in the business' name to indicate the source of such goods and/or services. Please note Exhibit B submitted with Applicant's response dated June 5, 2002. Applicant respectfully submits that purchasers in Northbrook, Illinois are knowledgeable about whom they are dealing with and are not confused by the numerous uses of the geographic expression "Northbrook" in connection with various different goods and services. The source of such goods and services is obviously emanating from the Northbrook, Illinois area and more specifically from the descriptive expressions used to identify the exact goods or services.

As a result, use of the expression "Northbrook" is not unique. Further, Registrant is not the sole source for goods or services provided in connection with the "Northbrook" expression. Accordingly, the cited registration on the

Supplemental Register or so lacking in secondary meaning as to require a Section 2(f) affidavit, is of such limited, narrow scope of protection that Applicant's mark is sufficient dissimilar to avoid confusion.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited mark and Applicant's subject mark are sufficient to avoid a likelihood of confusion.

7. Actual Confusion

The Examiner failed to address or rebut Applicant's evidence directed to this factor. Applicant respectfully submits that its NORTHBROOK BANK & TRUST COMPANY mark has been in use in commerce since on or before November 22, 2000 in connection with providing banking services in the area of Northbrook, Illinois. Applicant is aware of no instance in which a customer or potential customer has come into Applicant's NORTHBROOK BANK & TRUST COMPANY bank seeking to obtain insurance coverage from "Northbrook." The Examiner has failed to provide any evidence of actual confusion.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited mark and Applicant's subject mark are

sufficient to avoid a likelihood of confusion and that there have been no instance of actual confusion.

8. Other Considerations

Applicant respectfully submits that the cited Registration is so weak as to preclude any likelihood of confusion. Weak marks are entitled to protection against subsequent registration where the junior mark is nearly identical and the goods or services are competitive. *A.H. Robins Co. v. Osco Pharmaceutical Corp.*, 190 U.S.P.Q. 340 (T.T.A.B. 1976); *In re Macao Mfg.* 192 U.S.P.Q. 573 (T.T.A.B. 1976); *In re Bayou Cigars, Inc.*, 197 U.S.P.Q. 627 (T.T.A.B. 1997). Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods or services are related. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th Cir. 1987). Accordingly, highly descriptive or laudatory marks are weak and given only a narrow range of protection.

Applicant respectfully submits that the cited registration is sufficiently different and the "Northbrook" expression is so widely used that consumers can easily distinguish Applicant's mark as the source of Applicant's services from Registrant's marks as the source of Registrant's services. As a result, there can be no likelihood of confusion. Further, for the buyer to be deceived, he must be looking for something. *Spangler Candy Co. v. Crystal Pure Candy Co.*, 143 U.S.P.Q. 94 (N.D. Ill. 1964), *aff'd.*, 147 U.S.P.Q. 434 (7th Cir. 1965). Accordingly, Applicant respectfully submits that, based upon the facts above,

purchasers would not be confused as to the source of the services or that they would be looking for such services on the basis of the "Northbrook" expression as use of such expression is so common.

Finally, the USPTO has historically registered marks having identical nouns and adjectives to different entities for banking and insurance services. Applicant submitted substantial evidence directed to this fact in responses filed with the USPTO dated January 9, 2001 and June 5, 2002. The evidence is the result of searches performed by Applicant on the Spot's TESS on-line database available over the Internet. Applicant respectfully requests that this Board note such evidence as it is not directed to the ultimate question of likelihood of confusion.

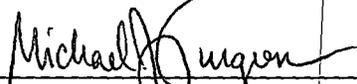
IV. CONCLUSION

For all the foregoing reasons, Applicant submits that the Examining Attorney's refusal should be reversed and the application to register this mark should be passed to publication.

Dated: November 12, 2002

Respectfully submitted,

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