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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wintrust Financial Corporation

Serial No. 75/935,479

Michael J. Turgeon of Vedder, Price, Kaufman & Kammholz for
Wintrust Financial Corporation.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Seeherman and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Wintrust Financial Corporation (applicant) applied to
register the mark NORTHBROOK BANK & TRUST COMPANY (in typed
form) for "banking services" in International Class 36.¹
Although applicant initially sought registration on the
Principal Register, the application was subsequently
amended to request registration on the Supplemental

¹ Serial No. 75/935,479, filed February 17, 2000. The
application was based on applicant's assertion of a bona fide
intention to use the mark in commerce. Subsequently, applicant
submitted an amendment to allege use and asserted a date of first
use and a date of first use in commerce on November 22, 2000.

Register. Applicant has also disclaimed the words "Bank & Trust Company."

The examining attorney ultimately refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of two registrations for the mark NORTH BROOK and design shown below.



The first registration is on the Supplemental Register and the services are identified as "insurance services" in International Class 36 and "property and casualty loss control services" in International Class 37.² The second registration is on the Principal Register under the provision of Section 2(f) and it is registered for "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" in International Class 36.³

² Registration No. 1,265,418, issued January 24, 1984, Section 8 accepted.

³ Registration No. 2,266,244, issued August 3, 1999.

After the examining attorney made the refusal final,⁴ this appeal followed.

The examining attorney's position is that the dominant portion of both marks is the word "Northbrook," and applicant's addition of the descriptive words "Bank & Trust Company" does not change the similar overall commercial impression created by the marks. Regarding the relatedness of the services, the examining attorney submitted evidence that included NEXIS printouts indicating that banking and insurance services are provided by the same entities.

Met Life is one of the first US insurers to form a banking unit.
Post Magazine, June 1, 2000.

The barriers between banking, insurance and brokerages are already starting to fall.
Waterbury Republican-American, May 15, 2000.

In addition, the examining attorney submitted copies of nine registrations (Nos. 2,608,826; 2,604,392; 2,545,286; 2,543,123; 2,595,710; 2,587,508; 2,579,902; 2,583,428; and 2,569,613) as evidence "that both banking and insurance services often emanate from a single source under the same mark." Brief at 6. The examining attorney

⁴ The examining attorney's final refusal also included a third registration (No. 1,679,641) for the same mark shown above for "commercial and liability insurance underwriting services; insurance consulting services" in International Class 36. However, that registration was cancelled on December 21, 2002, and it, therefore, no longer is a bar to registration of applicant's mark.

concluded that the "marks are highly similar and the services are related. Consumers encountering applicant's mark and the cited marks in the marketplace are therefore likely to mistakenly believe that the services emanate from a common source." Brief at 9.

Applicant, on the other hand, maintains that the examining attorney has not shown that registrant is licensed to provide banking services or that "non-competitive banking services and insurance services could give rise to the mistaken belief that the services emanate from a common source." Brief at 11. Regarding the marks, applicant argues that because the cited registrations are either on the Supplemental Register or registered on the Principal Register under the provisions of Section 2(f), "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." Brief at 5. Finally, applicant argues that there is no actual confusion, the mark is weak, the trade channels are different, and the services are dissimilar, and, therefore, the examining attorney's refusal should be reversed.

We affirm.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., ___ F.3d ___, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We start by comparing applicant's and registrant's marks. Applicant's mark consists of the words NORTHBROOK BANK & TRUST COMPANY; registrant's mark is for the word NORTH BROOK and design shown below.



Both marks feature the word NORTHBROOK or NORTH BROOK. See Seaguard Corp. v. Seaward International, Inc., 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"). Applicant adds the disclaimed words "Bank & Trust Company" to its mark while registrant displays its marks with a simple block design. However, the dominant part of both marks would be the word NORTHBROOK. The addition of the words "Bank & Trust Company" does not

significantly alter the appearance, pronunciation, meaning, or commercial impression. In a similar case, the Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

In addition, the simple design in registrant's mark does not change the basic impression of the mark.

Neither the design element nor the generic term "cafe" offers sufficient distinctiveness to create a different commercial impression. Indeed, as the board

found, the design is an ordinary geometric shape that serves as a background for the word mark.

Dixie Restaurants, 41 USPQ2d at 1534.

We conclude that, when we consider these marks in their entireties, the differences in appearance, pronunciation, meaning, and commercial impression are minor and the word NORTHBROOK would be the feature that prospective purchasers would use to refer to the services.

We have taken into consideration the fact that applicant's mark and one of registrant's marks is on the Supplemental Register. Merely because a mark is on the Supplemental Register, it does not follow that the mark is entitled to only a narrow scope of protection. In re Smith and Mehaffey, 31 USPQ2d 1531, 1533 (TTAB 1994). We note that Northbrook is "a village of northeast Illinois, a residential and industrial suburb of Chicago. Population 32,308." *American Heritage Dictionary of the English Language, Third Edition* (1992). Applicant's term involving a village in Illinois is not the equivalent of a commonly used descriptive term. In addition, registrant's other mark is on the Principal Register under the provisions of Section 2(f). While applicant has included telephone business page entries to show that there are other businesses in Northbrook that include the word NORTHBROOK

in their name, this evidence does not establish that the term NORTHBROOK is weak. The fact that pizza parlors, limousine services, automobile dealers and car washes in the Northbrook area use the term NORTHBROOK does not establish that it is weak mark when it is used in association with insurance services.

We now consider whether the services of the applicant and registrant are related. We must consider the services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be"). See also Octocom Systems, Inc. v. Houston Computers Services 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 mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Applicant's argument that registrant is not using its mark in connection with the same services with which applicant is using its mark is simply not relevant. If the services are related, it does not matter how registrant is actually using its mark.

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Here, applicant uses its mark in connection with banking services and registrant uses its mark for various insurance services. Applicant maintains that the services

Ser No. 75/935,479

are "not clearly related." Brief at 9. However, the examining attorney has included evidence that banking and insurance services originate from the same source. In addition to the NEXIS evidence that indicates that banks are beginning to offer insurance services, the examining attorney also included copies of registrations to show that the same entities have adopted a common mark for both banking and insurance services. See, e.g., Registration No. 2,569,613 (THE BANK OF BLOOMFIELD HILLS for banking services and insurance administration, insurance brokerage and insurance agency services in the field of life, health, and disability insurance and annuities); No. 2,604,392 (HOUSEHOLD and design for banking services and insurance underwriting services); No. 2,606,826 (HARLEYSVILLE NATIONAL BANK AND TRUST COMPANY and design for banking services and insurance agency services); No. 2,579,902 (STATE FINANCIAL for banking services and insurance services and underwriting property, casualty and life insurance); and No. 2,583,428 (CITIONE for banking services and insurance brokerage services including insurance underwriting and banking services). These registrations suggest that the same source may provide both banking and insurance services. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party

registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

We have also considered applicant's evidence of registrations that show that the U.S. Patent and Trademark Office has registered marks with the same geographic terms to different entities for banking and insurance services, however, these registrations are not very persuasive. Most of these registrations involve registrations for a well-known geographic term such as Illinois, New York, Chicago, Eastern, and America combined with other terms. Therefore, the issue of likelihood of confusion in the case before us is different. In the present case, the cited mark contains no additional terminology that would distinguish this mark from applicant's. Even if there were examples of the same geographical terms that were registered to different parties for banking and insurance services, that would hardly establish that there was not a likelihood of confusion in this case. While third-party registrations may be used to demonstrate that a portion of a mark is

suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988). The other evidence certainly supports the examining attorney's conclusion that potential consumers are likely to believe that banking and insurance services may originate from the same source or at least are related or associated in some way.

Applicant argues that the channels of trade are dissimilar because registrant's services involve "a business-to-business commercial relationship." Reply Brief at 12. However, the registrations are not so limited. See Registration No. 1,265,418 for "insurance services" and Registration No. 2,266,244 for, inter alia, "underwriting and administration services in the field of life insurance; underwriting and administration services in the field of annuities." In addition, applicant's banking services do not exclude services directed to businesses. Applicant also maintains that a "business interested in obtaining property and casualty insurance coverage is going to spend a sizeable amount of money" and that its employees are therefore "knowledgeable and sophisticated." Brief at 13. As discussed above, the registrations are not limited as applicant argues. Even if we assume that the purchasers of

insurance and banking services are knowledgeable purchasers, they would likely be confused when very similar marks are used with both banking and insurance services. Octocom Systems, 16 USPQ2d at 1787.

In addition, we note that applicant's counsel has argued that applicant is unaware of instances of actual confusion. However, the absence of actual confusion does not mean there is no likelihood of confusion. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight"). Additionally, we have considered applicant's argument regarding the lack of evidence of fame and we agree that there is no evidence of fame, but this type of evidence would not normally be of record in an ex parte case and the lack of such evidence does not indicate that there is no likelihood of confusion. See Majestic Distilling, 65 USPQ2d at 1205 (citation omitted) ("Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous").

We conclude that, when potential purchasers of insurance and banking services encounter the marks NORTH BROOK and design and NORTHBROOK BANK & TRUST COMPANY, they

Ser No. 75/935,479

would likely believe the businesses using them are in some way related. Our analysis leads us to conclude that there is a likelihood of confusion. While we acknowledge that this conclusion is not free from doubt, we must resolve any doubt in favor of the registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.