

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE TTAB**

Mailed: May 31, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

\_\_\_\_\_  
In re F.N.B. Corporation

\_\_\_\_\_  
Serial No. 77059129

Jennifer L. Whitelaw of Whitelaw Legal Group for F.N.B. Corporation.

W. Wendy Jun,<sup>1</sup> Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

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Before Quinn, Taylor and Lykos, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

F.N.B. Corporation has filed an application to register on the Principal Register the mark FNBSECURE (in standard character form) for services ultimately identified as "Banking services; financial services, namely, electronic interactive banking services, financial information provided by electronic means, financial management services, financing services, internet banking

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<sup>1</sup> A different examining attorney initially examined the application.

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services, information services for all the foregoing provided via a global computer network" in International Class 36.<sup>2</sup> The application was filed on December 7, 2006, based upon applicant's bona fide intention to use the mark in commerce. The application was published on July 22, 2008 and a notice of allowance issued on October 14, 2008. After one extension, on June 29, 2009, applicant filed its statement of use, accompanied by the specimen of use, i.e., a cover sheet for an email communication sent by applicant, shown below.<sup>3</sup>

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**From:** [REDACTED]  
**To:** [REDACTED]  
**Date:** 4/24/2009 9:54 AM  
**Subject:** Fw: [MX]Lock Secure Email from: davidson@fnb-corp.com

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----- Original Message -----  
**From:** FNB of PA Secure Email  
**To:** [REDACTED]@org  
**Sent:** Thursday, April 23, 2009 9:51 AM  
**Subject:** [MX]Lock Secure Email from: davidson@fnb-corp.com

Recipient,

Your email is being delivered securely via FNBsecure(TM), due to FNB Security Compliance policies. The message can be viewed by following the link below. If you have any questions or concerns about this email please contact FNB Call Center at 800-555-5455.

To respond securely you MUST use the "REPLY" button contained within the link below. The "REPLY" link is located on the bottom right of the page. Do not respond to this message directly.

[View your email](#)

If you cannot view the link properly, please copy and paste the following link into your browser:  
[REDACTED]

-----DISCLAIMER:-----

The information in this message is confidential and is legally privileged. It is intended solely for the addressee. Access to this message by anyone else is unauthorized. If you are not the intended recipient, any disclosure, copying, or distribution of the message, or any action or omission taken by you in reliance on it, is prohibited and is unlawful. Please immediately contact the sender if you have received this message in error. FNBsecure(TM)

<sup>2</sup> Serial No. 77059129.

<sup>3</sup> Applicant claimed as its date of first use and date of first use in commerce December 31, 2005.

The examining attorney refused registration of applicant's mark under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127,<sup>4</sup> on the ground that the specimen submitted by applicant does not show use of the mark in connection with "banking services; financial services, namely, electronic interactive banking services, financial information provided by electronic means, financial management services, financing services, internet banking services, information services for all the foregoing provided via a global computer network." After the refusal was made final, applicant appealed and filed a request for reconsideration that included a substitute specimen consisting of three emails sent to applicant, an account report, a retirement plan account statement and a letter of correspondence (shown below). The request for reconsideration was denied on July 26, 2010 and this appeal resumed on August 16, 2010. Both applicant and the examining attorney filed appeal briefs.

Applicant's substitute specimen:

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<sup>4</sup> The examining attorney also cited 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a) [and] TMEP §§ 904 and 904.07(a) in support of the refusal.

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Sent: Tuesday, December 09, 2008 3:56 PM E-mail 1  
To: FNBsecure@fnb-corp.com; [REDACTED]  
Subject: Fwd: Re: TAS Testing  
Attachments: TEX7.htm; Q910 tas.zip

[REDACTED]  
Treasury Management Department  
First National Bank of Pennsylvania  
532 Main Street  
Johnstown PA 15901

Phone: 814-532-3221  
Fax: 814-532-3123

\*\*\*\*\* EMBEDDED MESSAGE: \*\*\*\*\*

Date: 2008/12/08 12:56:19 PM

From: [REDACTED]@fnb-corp.com

To: [REDACTED]@fnb-corp.com

Subject: Fwd: Re: TAS Testing

Scott, here are [REDACTED] of both accounts. I was working with the one that  
ends in [REDACTED]

[REDACTED]  
Systems Analyst III  
Information Systems  
F.N.B. Technology Center  
Mail Code - IFS  
Phone 724-983-6758  
Fax 724-983-4191  
[REDACTED]@fnb-corp.com

>>> [REDACTED] 12/8/2008 11:04 AM >>>

[REDACTED]  
Systems Manager  
F.N.B. Technology Center  
4140 E. State St.  
Hermitage, PA 16148  
[REDACTED]@fnb-corp.com  
Office: 724-983-3613  
Cell: [REDACTED]  
Fax: 724-983-4191  
Mail code: IFS

Text 1

INST : 000

DDAM FILE DUMP

REPORT: ADS/0910-001 19.06.0

PAGE: 1

PREMIER SYSTEM

SYSTEM: 12/08/08 12:48

RUN DATE: 12/08/08

XXXXXXXXXXXX

REC-KEY: 00216446 INST: 000 BR: 0022 ACCT:  
PROCESSED THRU: 12/08/08

RECORD-KEY: [REDACTED] INST: 000 BR: 00022 ACCOUNT: XXXXXXXXXXXX [REDACTED]

CIS MASTER INDEX RECORD:

INDEX-TYPE	001	ACCOUNT-NUMBER
XXXXXXXXXXXX	[REDACTED]	ACCOUNT-LINK
INST-NUMBER	000	PRIMARY-OWNER-CODE
001	[REDACTED]	PORTFOLIO-LINK
BRANCH-NUMBER:	00022	CLASS-CODE:
010		

CURRENT BALANCES:

CURR-BALANCE	507.25	CURR-CASH-AVAIL-BALANCE
507.25		CURR-ACCRUED-INTEREST
		.00
CURR-AVAIL-BALANCE	507.25	CURR-CHECK-AVAIL-BALANCE
507.25		.00
CURR-ACCRUED-SERV-CHRG		

PREVIOUS BALANCES:

PREV-BALANCE	498.00	PREV-CASH-AVAIL-BALANCE
498.00		PREV-ACCRUED-INTEREST
		.00
PREV-AVAIL-BALANCE	498.00	PREV-CHECK-AVAIL-BALANCE
498.00		.00
PREV-ACCRUED-SERV-CHRG		

REPORT THIS RUN:

INT-ADJUSTED-THIS-RUN	.00	YTD-FWT-ADJUSTED-THIS-RUN
.00		00000
NSF-ITEMS-THIS-RUN		
INT-EARNED-THIS-RUN	.00	YTD-FWT-REPORTED-THIS-RUN
.00		0
YTD-PASSED-FLAG		
YTD-INT-ADJUSTED-THIS-RUN	.00	YTD-SWT-ADJUSTED-THIS-RUN
.00		0
YTD-PASSED-FLAG		
YTD-INT-REPORTED-THIS-RUN	.00	YTD-SWT-REPORTED-THIS-RUN
.00		

REPORT EVENT FLAGS:

01=1	04=0	07=0	10=0	13=0	16=0	19=0	22=0	25=0	28=0	31=0	34=0	37=0	40=0
43=0	46=0	49=0	52=0	55=0	58=0								
02=0	05=0	08=0	11=0	14=0	17=0	20=0	23=1	26=0	29=0	32=0	35=0	38=0	41=0
44=0	47=0	50=0	53=0	56=0	59=0								
03=0	06=0	09=0	12=0	15=0	18=0	21=0	24=0	27=0	30=0	33=0	36=0	39=0	42=0
45=0	48=0	51=0	54=0	57=0	60=0								

FLOAT AMOUNTS:

(1)	.00	(3)	.00	(5)	.00	(7)
.00						
(2)	.00	(4)	.00	(6)	.00	

REGULATION CC INFORMATION:

REG-CC-CASH-FLOAT (1)	.00	REG-CC-CHECK-FLOAT (1)
.00		000
REG-CC-DAYS-NSF (1)		
REG-CC-CASH-FLOAT (2)	.00	REG-CC-CHECK-FLOAT (2)
.00		000
REG-CC-DAYS-NSF (2)		
REG-CC-CASH-FLOAT (3)	.00	REG-CC-CHECK-FLOAT (3)
.00		000
REG-CC-DAYS-NSF (3)		
REG-CC-CASH-FLOAT (4)	.00	REG-CC-CHECK-FLOAT (4)
.00		000
REG-CC-DAYS-NSF (4)		
REG-CC-CASH-FLOAT (5)	.00	REG-CC-CHECK-FLOAT (5)
.00		000
REG-CC-DAYS-NSF (5)		

E-mail 2

From: FORCEPLACEDINSURANCE  
Sent: Friday, January 09, 2009 11:13 AM  
To: [REDACTED]; FNBsecure@fnb-corp.com; Insurance.Center  
Subject: Re; [REDACTED]  
Attachments: Text.htm; OneTouch Jan 09, 2009 (6).PDF

Please see attached.

FORCE PLACED INSURANCE  
FNB Technology Center  
Mail Code LAC  
Telephone 724 983 6065  
or 724 983 6117  
Fax 724 983 6751

>>> [REDACTED]  
>>> 12/30/2008 6:17 PM >>>  
<[REDACTED].pdf>>  
Drawer: LOAN  
FileNo: [REDACTED]

===== DO NOT DELETE INDEXING INFORMATION BELOW THIS LINE ===== DRAWER: 'LOAN'  
FILENO: [REDACTED] DOCTYPE: -999 PACKAGETYPE: 2070

12/30/2008  
B.CB

\*\*\*\*\* Blanket Policy Permission \*\*\*\*\*

Lender: [REDACTED]  
FIRST NATIONAL BANK OF  
PENNSYLVANIA  
Attn: [REDACTED]

Dear [REDACTED]

We have received an insurance document for the following loan which does not specifically list the vehicle(s) used as collateral on the loan. Instead the policy lists "Blanket" or "Open Lot" coverage for all insured vehicles.

Please assist us by completing the appropriate information below. In order to accept this policy as valid coverage for the loan listed below, we must have the loan officer's written approval.

We have noted the receipt of this policy in our tracking system. If we do not hear from you the customer will continue to receive notices requesting a copy of their insurance.

Please check and sign beneath your desired response at the bottom of this form and fax it back to us at (877) 512-6972 Attn: 2070.

Loan #: [REDACTED]  
Name on Loan: [REDACTED]

Collateral on Loan: [REDACTED]

Thank you,

HJB International  
Fax (877) 512-6972 Attn: 2070

Please accept this document as valid proof of coverage even though the loan vehicle is not listed on the policy. Blanket/Open Lot coverage is acceptable for this vehicle and this loan for this one policy period.

\_\_\_\_\_  
Authorized Signature \_\_\_\_\_ Date

Please accept this document as valid proof of coverage even though the loan vehicle is not listed on the policy. Blanket/Open Lot coverage is acceptable for this vehicle and this loan for the entire remaining term of the loan.

\_\_\_\_\_  
Authorized Signature \_\_\_\_\_ Date

This document is not acceptable. The loan officer will contact the customer and request that they resolve the blanket coverage issue.

\_\_\_\_\_  
Authorized Signature \_\_\_\_\_ Date

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Sent: Thursday, December 04, 2008 11:07 AM E-mail 3  
To: FNBsecure@fnb-corp.com;  
Subject: Fwd: [REDACTED]  
Attachments: TEXT.htm; [REDACTED]

[REDACTED]

Thanks,

[REDACTED]

Client Services Specialist  
F.N.B. Wealth Management  
2 S. Market Street  
P.O. Box 57  
Selinsgrove, PA 17870

Phone: 570-372-2135  
Phone: 866-731-3213  
Fax: 570-374-5001  
Email: [REDACTED]

\*\*\*\*\* EMBEDDED MESSAGE: \*\*\*\*\*

Date: 2008/12/04 12:01:43 PM  
From: [REDACTED]@fnb-corp.com  
To: [REDACTED]  
Subject:

This E-mail was sent from "[REDACTED]"

Scan Date: 12.04.2008 12:01:42 (-0500)  
Queries to: [REDACTED]



[REDACTED]  
 [REDACTED] 401(K) PLAN  
 [REDACTED]  
 [REDACTED]

Retirement Plan Account Statement  
 From 1/01/08 to 11/10/08

Social Security Number [REDACTED]  
 Date Of Birth [REDACTED]  
 Date Of Hire [REDACTED]  
 Date Of Termination [REDACTED]

This statement has not been audited.  
 Please review your account and report any errors to the Plan Administrator within 30 days.

THIS PLAN DOES NOT ALLOW IN-SERVICE OR HARDSHIP DISTRIBUTIONS		YOUR ACCOUNT AT A GLANCE	
Inception to Date Contributions	[REDACTED]	Beginning Balance	[REDACTED]
EE - Pre-Tax Contribution	[REDACTED]	Change This Period	[REDACTED]
ER - Pre-Tax Contribution	[REDACTED]	Ending Balance	0.00
		Vested Balance	0.00

ACTIVITY THIS PERIOD							
Investment	Beginning Balance	Contributions & Forfeitures	Withdrawals	Payments & Transfers	Gain or Loss	Ending Balance	Vested Percent
VANGD LS CONS GROWTH	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	
VANGD LS GROWTH	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	
VANGD LS INCOME	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	
VANGD LS MOD GROWTH	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	
Total Balance	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	

SOURCE OF FUND							
Source of Money	Beginning Balance	Contributions & Forfeitures	Withdrawals	Payments & Transfers	Gain or Loss	Ending Balance	Vested Percent
SALARY DEFERRAL	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	100.00%
ER MATCH	[REDACTED]	[REDACTED]	[REDACTED]	0.00	[REDACTED]	0.00	100.00%
Total Balance	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	0.00	

SHARE PRICES & INVESTMENT ALLOCATION AT END OF PERIOD			
Investment	Shares	Price Per Share	Allocation Percentage

Applicant, in urging reversal of the refusal, maintains that its mark is properly shown as a service mark on the specimens of record and that the specimens "must be taken together because they are a part of a single and unitary user experience, show[ing] both (1) the electronic delivery of the branded services and (2) the applied for



mark on the services." Applicant's br. p. 8. Applicant particularly argues (emphasis in the original):

...[A]t the very beginning of the delivery of the FNBSECURE services, the customer is presented with the applied for mark, FNBSECURE™, including the TM designation [shown in the original specimen]. ... A consumer sees this communication and this brand **first** and is presented then with an immediate-acting, live and secure link. The FNBSECURE™ link delivers the financial information of the recited services to a customer [as shown in the additional exhibits]. These exhibits show the reader the specific kinds of financial information being delivered via the necessary introductory communication of [the original exhibit] for the FNBSECURE™ services."

Applicant's br. p. 7.

The examining attorney, on the other hand, contends that the specimens submitted by applicant do not show use of the mark in connection with the identified services and that the various specimens do not show that they are connected in a way that justifies accepting them together as one specimen.

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services identified in the application, and there must be sufficient reference to the services to create this association. In re Monograms America Inc., 51 USPQ2d 1317 (TTAB 1999). That is, the mark must be used in

such a manner that it readily would be perceived as identifying the source of such services. In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); In re Adair, 45 USPQ2d 1211 (TTAB 1997). A specimen that shows only the mark, with no reference to the services, does not show service mark usage. See In re Adair, *supra* (tags affixed to decorated Christmas trees that bear the mark TREE ARTS CO. and design and the applicant's location, but make no reference to the services, fail to show use for "design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees"); and In re Johnson Controls, Inc., 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacturing of valves).

In the initial specimen, i.e., the email cover sheet, submitted by applicant on June 29, 2009, the mark appears in the specimen as follows: "Your email is being delivered securely via FNBsecure(TM), due to FNB Security Compliance polices." and "Please immediately contact the sender if you have received this message in error. FNBsecure(TM)."

While the additional word "via" may call to mind some type of email transmission service, as pointed out by the examining attorney, there is no reference whatsoever to

applicant's banking and financial services. None of the additional wording creates a direct association with applicant's mark such that consumers of applicant's services, when viewing the original email specimen, would relate the applied-for mark FNBSECURE to applicant's "banking services; financial services, namely, electronic interactive banking services, financial information provided by electronic means, financial management services, financing services, internet banking services, information services for all the foregoing provided via a global computer network."

As such, we find that applicant's original specimen does not show use of its applied-for mark in connection with the identified services.

Notably, applicant never asserts in its brief that its original specimen references its identified banking or financial services. Rather, as noted earlier, applicant contends that when that specimen is considered in conjunction with the additional specimens, submitted with its Request for Reconsideration on July 15, 2010, its specimens show proper service mark usage.

Turning then to a consideration of the additional specimens, we likewise find that they do not show the required direct association between applicant's FNBSECURE

mark and the identified banking and financial services. As previously indicated, the additional specimens consist of various documents in the nature of additional emails, an account report, a retirement plan account statement and a letter of correspondence. Of these documents, only the additional emails reference the mark at all, but the mark is imbedded in an email address which in its entirety reads "FNBsecure@fnb-corp.com." Thus, consumers viewing FNBSECURE in this context are likely to view it as merely part of a website address rather than as identifying the source of applicant's services. See e.g., *In re Roberts*, 87 USPQ2d 1474 (TTAB 2008) (The proposed service mark "irestmymcase," as used on the specimens which show the terms "www.irestmymcase.com" and "vicki@restmymcase.com," fail to distinguish or indicate the source of applicant's professional legal services.). Moreover, even if the proposed mark FNBSECURE was somehow perceived as a service mark in these emails, the emails do not in any manner reference applicant's banking and financial services and, consequently, the required direct association between the proposed mark FNBSECURE and the identified services is absent. The remaining specimens (i.e., the account report, the retirement plan account statement and the letter), although containing banking and/or financial information,

fail to reference applicant's proposed mark, or even applicant, in any way.

We now address applicant's argument that all of the specimens should be considered together, as they are "part of a single and unitary user experience," and when so considered, applicant's mark is properly shown as a service mark on the specimens of record. While the Board may view separate specimens together if it appears they are related or connected (e.g., screenshots of different web pages of a single website, copies of different pages of a single brochure), we find no basis in this record to link the different specimens. Although the original email specimen displays the mark with a "TM" symbol and appears to provide a link that delivers certain information, and some of the additional specimens contain financial information,<sup>5</sup> there is nothing on the face of the specimens that tie them together. Indeed, applicant's original specimen appears to have been transmitted on April 23, 2009, and the additional specimens containing financial information were all generated in 2008 (the account report generated on December 8, 2008, the letter dated December 20, 2008 and the

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<sup>5</sup> Because the additional emails do not reference applicant's identified services, they suffer from the same shortcoming as the original specimen.

retirement account statement covering "1/01/08 to 11/10/08"), but include no transmission information. Thus, we cannot link the specimens by transmission time. Nor is there anything else on the face of the specimens to link them. The documents simply do not support applicant's contention that they should be considered together.<sup>6</sup>

Moreover, even if we were to consider all of the specimens together, the refusal would not be overcome. As discussed, the original specimen does not show use of FNBSECURE with the identified services. In addition, because the account report, the retirement plan account statement and the letter make no reference whatsoever to the applied-for mark, or even to applicant for that matter, we cannot attribute those documents to applicant. Last, the additional emails neither include the applied-for mark or any reference to the identified services.

In conclusion, the specimens do not present applicant's proposed mark in a manner that would be

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<sup>6</sup> To the extent that applicant seeks to bolster its position by arguing that the Office has accepted multi-part specimens in the past and that the public should be able to rely on prior actions by the Office in similar situations, such argument is unpersuasive. As acknowledged by applicant, each case must be considered on its own merits based on evidence of record at the time registration is sought. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). As just discussed, the specimens in this case do not warrant that type of consideration.



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perceived by potential consumers as identifying applicant's banking and financial services and indicating their source.

**Decision:** The refusal to register is affirmed.