

THIS OPINION
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THE TTAB

Oral Hearing: July 30, 2009

Mailed: January 27, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Unidos Financial Services, Inc.

Serial No. 77126814

David Saenz of Greenberg Taurig for Unidos Financial Services, Inc.

Margaret G. Power, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Walters, Taylor and Mermelstein, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Unidos Financial Services, Inc. has filed an application to register the mark shown below on the Principal Register for "financial services, namely, money transfer services," in International Class 36.¹



¹ Serial No. 77126814, filed March 9, 2007, based on an allegation of a bona fide intent to use the mark in commerce.

The application includes the following information:

- The mark consists of the slogan "...UNIDOS.... AL ALCANCE DE TÚ MANO" with the colors of the first sequence of dots being red, yellow, green, and orange with the "UNI" and the final "S" in blue and the "DO" in red. The second sequence of dots are red, green, yellow, and orange. The "AL ALCANCE DE" and the "MANO" are blue, and the "TÚ" is red.
- The color(s) red, yellow, green, orange, blue is/are claimed as a feature of the mark.
- The foreign wording in the mark translates into English as UNITED WITHIN YOUR REACH.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark UNITED, previously registered for "financial services, namely, check cashing, money transfer and money order services," in International Class 36,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney filed briefs and appeared at the oral hearing. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm*

² Registration No. 2526927, issued January 8, 2002. The registration is owned by United Check Cashing Company, Inc. [Sections 8 & 15 affidavits accepted and acknowledged, respectively.]

Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the services and find that both the application and the registration include identical "money transfer services." Applicant does not contend otherwise. In view of the identity of these services, it is unnecessary to consider the nature or extent of any relationship between applicant's services and the other services identified in the cited registration. See *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) ("Likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application and registration.").

The trade channels and classes of purchasers of the identical services are also necessarily identical. Further, the "money transfer services" identified in the involved application and the cited registration are not limited to any specific channels of trade or classes of purchasers. Thus, we presume that these services would be offered in all ordinary trade channels for these services and to all usual classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Thus, contrary to applicant's argument regarding the sophistication of purchasers, it is reasonable for us to assume that money transfer services are rendered to the general public, which encompasses both individuals and businesses, and this broad range of purchasers will exhibit all levels of sophistication and degrees of care.

We consider, next, the marks, and we note that the question is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of

trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We begin by determining whether the examining attorney properly applied the doctrine of foreign equivalents. In this regard, the examining attorney states that the doctrine of foreign equivalents is applicable in this case because Spanish is the second most common language in the United States,³ and she contends that, in connection with the identified services, the ordinary American purchaser familiar with Spanish will stop and translate UNIDOS into English as UNITED.

Applicant contends that the examining attorney has improperly applied the doctrine of foreign equivalents to bar registration simply because the Spanish word UNIDOS means UNITED.

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into

³ In support of this statement, the examining attorney submitted information from the U.S. Census Bureau (www.factfinder.census.gov).

English to determine similarity of connotation with English words in a likelihood of confusion analysis. See *Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.*, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). This question in turn necessarily depends upon the particular facts and circumstances of the case. *In re Spirits International N.V.*, 86 USPQ2d 1078 (TTAB 2008). The Board has determined that the "ordinary American purchaser" in a case involving a foreign language mark refers to the ordinary American purchaser who is knowledgeable in English as well as the pertinent foreign language. *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006).

In the present case, there is no question that Spanish is a common, modern language that is spoken or understood by an appreciable number of U.S. consumers who also speak or understand English. It seems likely that, in connection with money-transfer services, this appreciable number of English/Spanish bi-lingual U.S. consumers will translate applicant's Spanish-language mark into English. There is nothing in this record that indicates the contrary. Neither the phrase portion of the mark, the design and red color

highlighting the "D" and "O" of UNIDOS, nor the red lettering of "TÚ" in the phrase portion of applicant's mark render the doctrine of foreign equivalents inapplicable in this case. The mark remains, obviously, a Spanish word and phrase that are likely to be translated into English. Thus, we find that the doctrine of foreign equivalents is applicable in this case.

Before comparing the marks, we consider the strength or weakness of the term UNIDOS/UNITED in connection with the identified services. Applicant contends that UNIDOS/UNITED is a weak term in the financial services industry due to the large number of third-party registrations that include the term UNITED or UNIDOS in marks registered in connection with financial services, noting that additional wording in these third-party marks is either merely descriptive or generic. Applicant also states that UNIDOS/UNITED is a highly suggestive term, noting the definition of record of "united" from the website www.dictionary.com as "adjective, (1) made or caused to act as a single entity, (2) formed or produced by the uniting of things or persons, (3) in harmony," and stating that "[i]t is common knowledge that financial institutions provide consistent services at different locations. UNITED connotes that the services rendered under

the mark at different locations, come from one source and are of a consistent quality."⁴ (Reply Brief, p. 3.)

While the examining attorney disagrees and argues that the record does not establish that UNIDOS/UNITED is either suggestive or weak in connection with financial services, applicant has submitted the following use-based, active third-party registrations for numerous marks that include the word UNITED in Spanish or English for various financial services⁵:

- 3181279 LOS CHAPINES ESTAMOS UNIDOS (The Guatemalans are together) for investment fund transfers;
- 2553006 Chinese characters transliterate as LIAN HE ZAO BAO (United Morning News) for financial information and evaluations;
- 2312482 UNITEDAUTO for lease-purchase financing for vehicles;
- 3027019 UNITED COMMUNITY ADVISORY SERVICES for money lending, savings and checking accounts, investment fund transfer, money order services, bill payment services;
- 3027782 UNITED COMMUNITY BANKS for money order services, currency transfer services, money lending, checking and savings accounts, mortgage banking;
- 3078462 UNITED FINANCIAL HOME LOANS for mortgage banking, money lending;

⁴ Additionally, applicant argues that the marks are distinguishable by referring to evidence it submitted from registrant's website that allegedly shows how registrant actually uses its mark, and applicant's statement that it will promote its services in the Spanish-speaking community. Neither of these arguments is relevant to our determination herein because we must consider only the marks shown in the drawings and the recitations of services as listed in the application and registration, neither of which contain any limitations in this regard.

⁵ We list only the most relevant goods and services in each registration and we have paraphrased the recitations of services from the registrations. We have not listed or considered as probative the five third-party registrations based on Trademark Act Section 44, the two pending applications, or the one third-party registration that does not include the word UNITED in the mark.

2750420 UNITED GUARANTY DIRECT for insurance underwriting and financial services in relation thereto;
2882958 ONEUNITED BANK and design for banking services;
2887524 ONE UNITED for banking services (same owner as above);
2776848 HUDSON UNITED BANK OPTIMUM LC for online letter of credit account services;
2684796 UNITED HERITAGE CREDIT UNION MEMBERSHIP MADE EASY! and design for credit union money lending;
2714692 UNITED STATES. UNITED PEOPLE. for financial analysis, consumer lending, credit and debit card services, electronic bill payment;
3266207 UNITED WESTERN BANK for banking services;
3321153 UNITED WESTERN BANK and design for banking services (same owner as above);
2887524 ONEUNITED: BLACK AMERICA'S BANK for deposit services, consumer loans, mortgage banking, credit card services;
3387891 UNITED PLANET for financial sponsorship of various charitable programs;
2900301 UCI UNITED CONSULTANTS INTERNATIONAL for financial management;
2848293 ONE UNITED BANK for deposit services, consumer loans, mortgages, credit card services;
2857205 UNITED COMMUNITY INVESTMENT SERVICES for financial management and planning services;
2501781 UNITED HIGH INCOME FUND II, INC. for investment management services;
2500046 UNITED INCOME FUND for investment management services (same owner as above);
2519630 UNITED SMALL CAP FUND, INC for investment management services (same owner as above);
2501780 UNITED TAX-MANAGED EQUITY FUND, INC. for investment management services (same owner as above);
2508888 and 2508889 UNITED GUARANTY'S PC UNITE for online database and software for loan processing;
2627143 BANKUNITED EXPRESS and design for retail banking services;
1990112 UNITED ACTION FOR ANIMALS for fund-raising services for care, spaying and neutering of dogs and cats;
1937138 UNITED CURRENCY OPTIONS MARKET for trading currencies and options;
1638626 UNITED JERSEY for banking and related financial services;
1457732 IRA UNITED for brokerage house financial services;
1287252 UNITED GUARANTY for insurance services and managing mortgage revenue bond issues.

In view of the fact that a few of the above-noted registrants own more than one of the listed registrations, the registrations in evidence represent twenty-five different third-party registrants.⁶

Third-party registrations may be relied on to show that a word common to each of the marks has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). In this case, these registrations show that at least twenty-five entities have adopted the term UNIDOS/UNITED as part of a mark for financial services. However, the financial services field is very broad, encompassing, as we see from these third-party registrations, investment and management services, loan services, currency trading and more. There is no evidence in the record establishing the nature or extent of any relationship between those services and the identical money transfer services identified herein.

Nonetheless, because "banking services" reasonably encompasses money transfers and "currency transfer services"

⁶ The examining attorney objects to consideration of third party registrations nos. 3304814, 3145430 and 3227468 on the ground that applicant did not make the registrations properly of record prior to appeal. These registrations were listed in applicant's request for reconsideration but copies of the registrations were not made of record prior to appeal. To be considered, copies of the registrations should have been made of record prior to appeal. The mere listing of the marks, owners and registration numbers without any indication of the goods or services and status renders these registrations of no probative value and they have not been considered.

and "money order services" are similar to, and logically part of, a subset of money transfer services, the record has six third-party registrants with the identical term UNITED registered as part of a mark in connection with these services. Additionally, we note that the other wording in these marks appears to be, for the most part, merely descriptive. While third-party registrations are not evidence of use of the marks shown therein or proof that consumers are familiar with the marks, evidence of six different registrants, seven including the cited registrant, with the same or similar services identified by a mark including the term UNITED suggests that UNITED is one of those ubiquitous terms, like ACME, used in many registered trademarks in the financial services field and, more specifically, in connection with money transfer and related services.

With the weakness of UNIDOS/UNITED in mind, we consider the two marks at issue herein. The examining attorney contends that UNIDOS is the dominant portion of applicant's mark and, because it is the "literal and exact Spanish equivalent of registrant's mark, UNITED" (brief, p. 6),⁷ under the doctrine of foreign equivalents, UNIDOS is identical to the registered mark, UNITED. The examining

⁷ In support of this statement and in addition to applicant's translation in its application, the examining attorney submitted an excerpt from the "translator" function at www.dictionary.com.

attorney argues that the additional wording in applicant's mark is much smaller than the word UNIDOS in applicant's stylized mark and that the stylization and color in applicant's mark are not sufficient to distinguish it from the registered mark.

Applicant contends that the mark, considered in its entirety in either Spanish or English is a unitary phrase; and, thus, the stylization and additional wording easily distinguish applicant's mark from the registered mark. Applicant contends, moreover, that while the connotations of the term UNIDOS and UNITED may be the same, the sound and appearance of the two terms are sufficient to distinguish them.

Considering, first, applicant's word and design mark, as previously noted, the translation of the word portion of applicant's mark is "... United ... Within Your Reach." Visually, UNIDOS/UNITED appears in the mark in larger print than the phrase "AL ALCANCE DE TÚ MANO/WITHIN YOUR REACH," but in the same blue and red coloring. The word UNIDOS/UNITED is both separated from and connected to the phrase by multi-colored dots on either side of the word. One obvious meaning of the phrase "Al Alcance de Tú Mano/Within Your Reach" in connection with money transfer services is to suggest affordability or availability. Thus,

the likely connotation of the terms in the mark considered together with the dots is that United's money transfer services are available and/or affordable. Despite the different font size, in view of this connotation of the mark, we consider the wording in the mark to be a unitary phrase and, thus, we find that all wording in the mark is of equal prominence.

While purchasers often use the wording in a mark to inquire about services rendered thereunder and, thus, this wording would make a greater impression on purchasers and is the portion that is more likely to be remembered as the dominant and source-signifying portion of the registered mark,⁸ designs are not discounted and each case must be evaluated based on its facts. In this regard, we agree with applicant that, visually, the design and color aspects of the combined "D" and "O" in UNIDOS are unique. The overall blue font, with the red design formed by the "D" and "O" in UNIDOS and the red lettering of TÚ, has visual significance to emphasize the design and word TÚ and to further unify the wording. There is no question that registrant's mark is registered in standard character format and, thus, can be displayed in any lettering style, including that of the wording in applicant's mark. *In re Pollio Dairy Products*

⁸ See *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by

Corp., 8 USPQ2d 2012, 2015 (TTAB 1988). However, beyond merely the lettering, we find the additional design elements of applicant's mark to be significant. Thus, we find that the wording and design elements of applicant's mark are both significant aspects of the overall commercial impression of the mark.

Comparing the marks in their entireties, we find them more dissimilar than similar in view of the weakness of the term UNITED in connection with money transfer services and the additional wording and design elements, noted above, in applicant's mark.

However, each of the *du Pont* factors may, in any particular case, play a dominant role. In re E. I. du Pont de Nemours & Co., 177 USPQ at 567. See also, *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). In the present case, the weakness of registrant's mark and the differences in the marks deserve greater weight in the likelihood of confusion analysis. As the Court said in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 117 USPQ at 297:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to

purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987).

his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Thus, when we weigh the relevant *du Pont* factors and consider the record and all of applicant's and the examining attorney's arguments relating thereto, including those arguments not specifically addressed herein, we find that applicant's mark is not likely to cause confusion with registrant's mark for the same services. In view of the weakness of registrant's mark, the differences in the marks are sufficient to distinguish applicant's mark from registrant's mark, despite the fact that the goods are identical, must be deemed to travel in the same channels of trade, and be purchased by ordinary consumers who do not exercise a great deal of care.

Decision: The refusal under Section 2(d) of the Act is reversed.