
To: NewDominion Financial Corporation (docket@klgates.com)
Subject: TRADEMARK APPLICATION NO. 77205836 - NEWDOMINION - 32109.002
Sent: 9/5/2008 6:00:36 PM
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Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 77/205836**MARK:** NEWDOMINION**CORRESPONDENT ADDRESS:**

Karl S. Sawyer, Jr.
K & L Gates, LLP
Hearst Tower, 47th Floor
214 North Tryon Street
Charlotte NC 28202



GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: NewDominion Financial Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

32109.002

CORRESPONDENT E-MAIL ADDRESS:

docket@klgates.com**REQUEST FOR RECONSIDERATION DENIED****ISSUE/MAILING DATE: 9/5/2008**

Applicant is requesting reconsideration of a final refusal issued/mailed January 26, 2008.

After careful consideration of the law and facts of the case, the examining attorney withdraws the citation of Registration No. 2886020 but denies applicant's request for reconsideration and adheres to the final action as written with respect to Registration No. 2505474 since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Applicant does not dispute the similarities between the applicant and registrant's services. Furthermore, applicant states that it recognizes and acknowledges the similarities between applicant's mark and the cited registration. Applicant, however, dissects the marks and argues that the marks are "sufficiently" different in sight, sound, and commercial impression. The examining attorney disagrees. The dominant wording in both marks is DOMINION. While the marks are compared in their entireties under a

Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b) (viii), (c)(ii).

Applicant asserts that across various service classifications, numerous registrations and even greater numbers of unregistered users exist in the marketplace which incorporates the word DOMINION. To support this contention applicant submitted a list of list of third-party registrations and pending applications. This list, however, is not probative because it was not properly made of record. The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the mere submission of a list of registrations does not make these registrations part of the record. *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). To make registrations proper evidence of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts of the registrations taken from the electronic search records of the United States Patent and Trademark Office) must be submitted. TMEP §710.03. See *In Re JT Tobacconists*, 59 USPQ2d 1080, 1081 n. 2 (TTAB 2001); *In re Styleclique.com Inc.*, 57 USPQ2d 1445, 1446 n. 2 (TTAB 2000); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). Secondly, pending applications are not registered and thus, not persuasive in determining a mark's weakness. Thirdly, while there are several registrations for DOMINION type marks, very few are for banking services. Fourthly, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d) (vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994). And last but not least, even if the mark is "diluted" the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, *e.g.*, *In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Applicant contends that confusion is unlikely because consumers tend to exercise a relatively high degree of care in selecting banking services. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Applicant also argues that since it first began use of its mark in 2005, it is unaware of any instances of confusion. Applicant's argument is unpersuasive. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex

parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Accordingly, applicant's request for reconsideration is *denied* and the refusal under Section 2(d) is continued. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal. TMEP §715.04(a).

Lana H. Pham /lhp/
Trademark Attorney
Law Office 115
United States Patent and Trademark Office
(571) 272-9478
Lana.Pham@uspto.gov (informal)

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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 9/5/2008 FOR
APPLICATION SERIAL NO. 77205836

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