ESTTA Tracking number: **ESTTA247592**
Filing date: **11/07/2008**

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

Proceeding	77205836
Applicant	NewDominion Financial Corporation
Correspondence Address	Karl S. Sawyer, Jr. K & L Gates, LLP 214 North Tryon StreetHearst Tower, 47th Floor Charlotte, NC 28202 UNITED STATES donna.millard@klgates.com, karl.sawyer@klgates.com, docket@klgates.com
Submission	Appeal Brief
Attachments	NEWDOMINIONAppealBrief.PDF (10 pages)(272437 bytes)
Filer's Name	D. Daniel Dzara, II
Filer's e-mail	donna.millard@klgates.com, dan.dzara@klgates.com, karl.sawyer@klgates.com
Signature	//D. Daniel Dzara, II//
Date	11/07/2008

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

In re U.S. Service Mark Application of:	)	
NewDominion Financial Corp.	)	Trademark Examining Attorney:
	)	Lana H. Pham
Serial No.: 77/205,836	)	
Filed: June 14, 2007	)	Law Office: 115
For: NEWDOMINION	)	

Charlotte, North Carolina

BOX TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BRIEF ON APPEAL

This is an appeal from the Final Refusal of September 5, 2008, refusing registration of the service mark NEWDOMINION.

I. APPLICANT'S MARK

Applicant has filed this application to register the service mark NEWDOMINION to identify banking services, in International Class 36. The application was filed on June 14, 2007, based upon actual use of the mark in commerce on or in connection with the identified services. The mark was first used anywhere at least as early as January 31, 2005, and the mark was first used in commerce at least as early as January 31, 2005.

II. PROSECUTION AND FINAL REJECTION

In an initial Office Action mailed September 25, 2007, registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration No. 2886020 for THE TORONTO-DOMINION BANK, U.S. Registration No. 2820113 for DOMINION RESOURCES, U.S. Registration No. 2505474 for DOMINION CREDIT UNION, U.S. Registration No. 2156058 for DOMINION CAPITAL, U.S. Registration No. 2759078 for DOMINION DIRECT, and U.S. Registration No. 2531583 for DOMINION DIRECT as to be likely to cause confusion, or to cause mistake, or to deceive.

According to the Examining Attorney, each of the cited registrations contains the word "DOMINION" or the words "DOMINION DIRECT." In addition, it was stated that applicant's and the registrant's services were both financial and/or banking services. Therefore, applicant's mark was also rejected because each mark allegedly covered services that were closely related to the applicant's services.

Applicant responded to the initial Office Action with an Amendment dated December 11, 2007. In the Response applicant submitted arguments that the present mark could not be confused with any of the cited marks.

On January 26, 2008, the Examining Attorney maintained the refusal of this application based upon two registrations, U.S. Registration Nos. 2886020 and 2505474. The Examining Attorney also made the refusal of applicant's mark final.

On July 21, 2008, applicant responded to the Final Office Action by submitting a Request for Reconsideration. In that Request for Reconsideration, applicant submitted arguments that the present mark could not be confused with either of the registered or pending marks.

On July 24, 2008, applicant filed a Notice of Appeal to appeal the Official Action of January 26, 2008, finally rejecting the application.

On September 5, 2008, the Examining Attorney withdrew U.S. Registration No. 2886020 as a citation against the pending application, but maintained the rejections based upon U.S. Registration No. 2505474, thereby rejecting the Request for Reconsideration.

III. ISSUES ON APPEAL

The issue on appeal is whether applicant's mark NEWDOMINION when used on or in connection with the applicant's identified services is likely to be confused with the mark of DOMINION CREDIT UNION, U.S. Registration No. 2505474.

IV. ARGUMENTS AND AUTHORITY

A. Applicant's Mark Would Not Create A Likelihood Of Confusion Or Else The Existence Of Previously Cited Registered Marks Must Necessarily Be Confusing With Each Other, Which Is Legally Unsupportable As Contrary To The Statutorily Mandated Presumption Of Validity (And Absence Of Confusion) Of The Cited Marks.

Applicant respectfully submits that the refusal of registration on the grounds that there would be a likelihood of confusion is contradictory to the fact that the cited Registration (2505474) and the previously cited registration (2886020), owned by differing and unrelated parties, co-exist with one another. Specifically, the Office Action explains the refusal of registration as being basically grounded on the single similarity between the present mark and the cited registered mark as sharing the common term "DOMINION" and as having related services, but the Office Action fails to acknowledge and reconcile the fact that the cited Registration and the previously cited registration are owned by differing and unrelated parties,

and themselves have precisely the same similarities between their respective marks and services for which the present mark is being refused registration. If, as asserted in previous Office Actions, applicant's mark is likely to be confused with either of these marks for these reasons, then it would necessarily follow that the cited and previously cited mark are confusingly similar with one another. However, such cannot be the case inasmuch as the Trademark Act provides that the cited and previously cited registration must be presumed valid (15 U.S.C. § 1115) and, as a necessary corollary, it must be presumed that these registered marks are not confusing with one another. Since the present applicant's mark and services under the current application have no greater similarities to the cited and previously cited mark and their respective services than such marks and services are similar to one another, the only logical and legally supportable conclusion is that the applicant's mark is no more likely to cause confusion with the cited and previously cited mark than they are likely to be confused with one another. Thus, in turn, it is submitted that the applicant's mark must be equally entitled to registration.

Moreover, the foregoing analysis is squarely in line with the applicable case law. See, for example, *In re Tia Maria, Inc.*, 188 USPQ524 (TTAB 1975); *In re Trelleborgs Gummifabriks Aktiebolag, Inc.*, 189 USPQ106 (TTAB 1975), and other cases, in which the TTAB has consistently espoused the proposition that the fact two or more registrations have issued over one another so as to co-exist on the Principal Register diminishes their effectiveness as bars to the grant of a subsequent registration to a third party for a mark which bears no greater similarity to the co-existing marks than they bear to one another. Indeed, the seminal case of *In re E.I. DuPont de Nemours & Co.*, 476 F2d 1357, 177 USPQ563 (CCPA), explains that similarities/differences between marks and their respective good/services are only two of thirteen different possible factors bearing on the issue of likelihood-of-confusion which the *DuPont* case

mandates must be considered when relevant. One of such factors is "the number and the nature of similar marks in use on similar goods." See 177 USPQ at 567. Therefore, it is respectfully submitted that a full consideration of all of the relevant factors bearing on the question of likelihood of confusion in the present case collectively evidence that confusion between applicant's and the registrants' marks is clearly unlikely.

Indeed, in the present case, the cited registration and the previously cited registration are not the only already co-existing registered marks using the term DOMINION for similar or related Class 36 services. The Office Action also fails to recognize and reconcile that the cited Registrant also owns U.S. Registration No. 2820113 for DOMINION RESOURCES, U.S. Registration No. 2156058 for DOMINION CAPITAL, U.S. Registration No. 2759078 for DOMINION DIRECT, and U.S. Registration No. 2531583 for DOMINION DIRECT for banking and financial services.

In addition, these six marks (the four listed above, the cited registration, and the previously cited registration) also co-exist with U.S. Registration No. 2366387 for THE DOMINION SERIES, U.S. Registration No. 2368636 for THE DOMINION SERIES + DESIGN, U.S. Registration No. 2718066 for DOMINION FINANCIAL SERVICES + DESIGN, and Registration No. 1377538 for DOMINION BOND RATING SERVICE. These four marks are owned by other third parties and all of them are directed to services in Class 36, in particular services in the financial or banking arena.

Further, U.S. Application Serial No. 78/343,305 for CANADA DOMINION RESOURCE FUND LTD. is also present in the USPTO records. This mark is directed towards mutual fund services. The Examining Attorney, however, deemed this mark as not persuasive as it is a pending application. It is respectfully submitted that while the mark is not yet formally

registered, the Examining Attorney should, nonetheless, consider the mark and give it weight in the deliberations over the pending mark because, as shown in the file history of this mark, the mark has been deemed by the Office to be registrable and has only been placed on suspended status while awaiting the filing of a registration certificate from the applicant's home country. Given the '305 mark's recited services, its use of the DOMINION terminology, and the Office's indication of registrability, it is submitted that this mark should also be considered when determining the ability of the term "DOMINION" to create a likelihood of confusion.

It is respectfully submitted that given the statutory mandate of 15 U.S.C. § 1115, the Examiner does not have the authority or discretion to ignore the presumed validity of such decisions (that these various "DOMINION" marks may coexist without creating a likelihood of confusion and that the term "DOMINION" does not automatically result in a creation of confusion). In turn, the analysis and determination of the absence of likelihood of confusion as to the present mark must necessarily follow consistently with the coexistence of these registered marks. It must be recognized that if the cited and previously cited marks must be construed as being non-confusing with one another, these marks also cannot be confusing with these other nine existing marks. The Trademark Office has already made such decision by granting these registrations.

Given the applicable case law noted above, the conclusion is inescapable that the issuance by the Trademark Office to differing parties of all of the above registrations indicates that the common use in each mark of the term "DOMINION" and any relatedness of their respective services is an insufficient basis for finding the marks to be confusing with one another, but rather the differences between the marks and their respective services outweigh any such similarities and mitigate against a likelihood of confusion between such marks.

Analyzing the present mark in light of the factors required by *DuPont* to be considered compels the same conclusion that the present mark is equally entitled to registration. First, analyzing the present mark itself in comparison with the cited mark, the differences between the present mark and the cited mark are indeed greater than the differences between the cited mark and the above-discussed marks. Secondly, the applicant's services bear at least the same level of difference to the registrants' respective services. As to all of the other factors identified in the *DuPont* case, these remaining factors either are not relevant in the present case or tend to not indicate a likelihood of confusion (e.g., there is no evidence of actual confusion between the present mark and any of the cited marks, there is no evidence that any of the cited marks is a famous mark, there is no evidence as to any consent, laches, estoppel or other agreement between the parties, etc.). In fact, it is respectfully submitted that there is a strong indication of non-confusion between the cited mark and the other nine marks.

As shown in the affidavit executed by Mr. Guion and which was filed on July 21, 2008, NewDominion Bank (hereinafter "NewDominion") was formed in 2005. Since this time (over three years), NewDominion has not "had a single complaint, confusion or question about its name by any customers or non-customers, including other financial institutions." Additionally, the affidavit states that NewDominion "has never experienced any problems with business documents, USPS mail, or other correspondence due to name errors." Therefore, none of the owners of the cited marks or of the nine marks listed above have ever contacted NewDominion about its name, thereby showing that they do not believe that the NEWDOMINION mark creates a likelihood of confusion. Further, as the affidavit shows, neither the postal service nor any of the other mailing services have ever been confused about applicant's mark, nor have any of its customers.

It is respectfully submitted that this is due, in part, to the non-distinctive nature of "DOMINION." Additionally, as shown in the affidavit, NewDominion has a nationwide name recognition and customers in 48 of the 50 states. Hence, the applicant's mark is not restricted to a sole and small geographic region. Additionally, New Dominion enjoys a strong reputation in the banking industry as a secure and solvent financial institution and, as shown in the attachments to the affidavit, has received countless (and extensive) press coverage in a variety of media regarding its activities. This coverage, it is submitted, further broadcasts the applicant's brand and renders it less likely to be confused with other names incorporating "DOMINION," as well as showing the heightened awareness of the present mark in the public eye.

Given the extensive promotion, publicity, and recognition of applicant's mark, it is submitted that it is inconceivable that owners of other marks such as those cited by the Examiner and those identified in this Appeal Brief would not have been aware of the applicant's mark. As they would have been aware of the present mark, had these other markholders believed that there was a likelihood of confusion between applicant's and their marks, it is submitted that they would have contacted applicant (which they did not, as stated in the affidavit) regarding this. Accordingly, it is submitted that this factor should also be strongly considered and that the present mark should be allowed.

In sum, therefore, it is respectfully submitted that a full consideration of all of the relevant factors bearing on the question of likely confusion in the present case collectively evidence that confusion between the applicant's and the registrant's mark is clearly unlikely.

B. <u>The Dissimilarity In Appearance Of Applicant's Mark From The Cited Registered Marks Supports A Finding Of No Likelihood Of Confusion.</u>

The cited mark DOMINION CREDIT UNION differs from the applicant's mark, NEWDOMINION, in that applicant's mark lacks the terms "CREDIT UNION." In addition,

applicant's mark contains the term "NEW" which is placed before the common term and without a space between the two words, thereby leading to a completely new term with a new and distinguishable look, sound, and feel.

Further, applicant's mark is a play on words. It is well known that "Old Dominion" is the official nickname of Virginia (it was bestowed upon the colony of Virginia by King Charles II as a reward for remaining loyal to the crown during the English Civil War). As "Old Dominion" is a name symbolizing colonial America, the present mark connotes by contrast the new banking methodology of modern America. Rather than being constricted by old-fashioned colonial-style banking which was dependent upon branch offices and walk-in service, NEWDOMINION is intended to symbolize the internet banking of tomorrow. Even the spelling of the name (i.e., the absence of spacing between "NEW" and "DOMINION") highlights the modern nature of applicant's services. By splitting the mark apart, as the Examiner has done in the analysis performed in the previous Office Actions, this connotation is diluted or lost.

Therefore, when considered as a whole, it is submitted that Applicant's mark is clearly not similar to DOMINION CREDIT UNION and is certainly no more similar to DOMINION CREDIT UNION than the cited mark is to the other registered marks discussed above. Accordingly, it is requested for this additional reason that Applicant's mark is entitled to registration.

V. CONCLUSION

Based upon all of the above, it is earnestly submitted that applicant's mark NEWDOMINION is not likely to be confused with DOMINION CREDIT UNION (U.S. Registration No. 2505474) when used on or in connection with the identified services.

Accordingly, applicant respectfully requests that the refusal to register applicant's mark be reversed and that such mark be approved for registration.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 18-1215.

Respectfully submitted,

D. Daniel Dzara, II
K&L Gates, LLP
Hearst Tower, 47th Floor
214 North Tryon Street
Charlotte, NC 28202
(704) 331-7400
-- Attorney for Applicant