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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Barkley International Incorporated

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Serial No. 77311059

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Peter Andrew Koziol of Assouline & Berlowe, P.A., for Barkley International Incorporated.

Sara N. Benjamin, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Bucher, Taylor and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Barkley International Incorporated has filed an application to register on the Principal Register the mark HOMER, in standard character form, for services which were ultimately identified as "financial engineering software for institutions, accredited investors, governments, hedge funds, and bankers to measure, process, analyze, manage, and/or transact securities, derivatives namely financial engineering software for use in funds and investment risk management" in International Class 9, and "financial

engineering services for institutions, accredited investors, governments, and bankers, namely, financial risk analysis, financial risk consultancy, financial investment and risk information, financial risk management, financial risk evaluation, structured financial asset management, and financial securities hedging, namely, hedge fund investment services; financial investment risk management and financial investment market value equity insurance consultancy for institutions, accredited investors, governments, hedge funds, and bankers; asset value management services, namely asset market value financial risk mitigation and asset equity insurance consultancy for institutions, accredited investors, governments, hedge funds, and bankers" in International Class 36.[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to the identified goods and services, so resembles the following three marks, all registered to the same registrant as to be likely to cause confusion, mistake, or deception:

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[1] Application No. 77311059, filed October 23, 2007 under Section 1(b) of the Trademark Act, claiming a bona fide intent to use.

1. HOMER, in typed drawing format, for "savings and loan financial services," in International Class 36;[2]
2. HOMER'S CLUB, in typed drawing format, for "savings and loan services," in International Class 36;[3] and
3. HOMER'S CLUB and design, as shown below, for "savings and loan services," in International Class 36.[4]:

Applicant and the examining attorney filed briefs, and applicant filed a reply brief.

We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir.

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[2] Registration No. 1106282, issued November 14, 1978. Sections 8 and 15 affidavits accepted and acknowledged. Renewed twice.
[3] Registration No. 1057936, issued February 1, 1977. Sections 8 and 15 affidavits accepted and acknowledged. Renewed twice.
[4] Registration No. 1057937, issued February 1, 1977. Sections 8 and 15 affidavits accepted and acknowledged. Renewed twice.

2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Another key factor in this case concerns the conditions under which and buyers to whom sales of the goods and services at issue are made.

For our analysis of the likelihood of confusion, we have chosen to focus on Registration No. 1106282 for the mark HOMER (in typed format) for "savings and loan financial services," since it covers the most similar mark and the most relevant services. If we find a likelihood of confusion with the '282 registration, then it would serve little purpose to consider the other registrations. Conversely, if there is no likelihood of confusion with the '282 registration, there would certainly be no likelihood of confusion with the HOMER'S CLUB marks – especially with the special form drawing depicting its lion mascot that registrant describes in its advertising as "the homeliest lion," "wind-tossed," and with his "eyes crossed."

Applicant, in urging reversal of the refusal to register, argues that consumers will not believe that the

goods and services offered by registrant and applicant under their respective marks emanate from the same source because the goods and services are different, applicant's consumers are sophisticated, the decision to purchase applicant's goods and services is not made on impulse, and the normal trade channels do not overlap. Applicant has supported its position with the declaration of Joseph D. Koziol, Managing Director of applicant, along with various articles, definitions, and related Internet printouts.

We first consider the *du Pont* factor of similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.,* 177 USPQ at 567. The mark in Registration No. 1106282 is HOMER, in typed drawing format. Applicant's mark is HOMER, in standard character form. Accordingly, they are legally identical. Applicant contends that the mark in the cited registration is weak. In support of this argument, applicant cites a few third-party registrations that contain the term "Homer" as evidence that consumers will distinguish its mark from that in the cited registration. Third-party registrations may be used to show that a term has been commonly registered for its suggestive meaning.

However, applicant has not provided sufficient evidence of a pattern of third-party usage of the term for use with related goods and services, instead submitting merely a list of registrations containing the word HOMER as well as one use-based registration for THE HOMER FUND. As advised by the examining attorney, in order to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office should be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Merely listing such registrations, as applicant has done here, is insufficient to make them of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998). Accordingly, we sustain the examining attorney's objection to the list of registrations. The existence of one or even a few other use-based registrations with the term HOMER is not sufficient for us to find suggestive meaning in the term for purposes of our analysis.

Meanwhile, as our precedent indicates, even the owner of a weak mark is entitled to protection from likelihood of confusion. *See Giant Food Inc. v. Roos and Mastacco, Inc.*,

218 USPQ 521 (TTAB 1982). Accordingly, the first *du Pont* factor favors a finding of likelihood of confusion.

We next turn to a consideration of the similarity or dissimilarity of the goods and services. It is well-settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in the application vis-à-vis the services recited in the registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). It is enough that the goods and services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of registrant's and applicant's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

We find in this case, however, that applicant's goods and services are unrelated to the registrant's services for purposes of the second *du Pont* factor. Applicant's goods and services include "financial engineering software for

institutions, accredited investors, governments, hedge funds, and bankers to measure, process, analyze, manage, and/or transact securities, derivatives namely financial engineering software for use in funds and investment risk management" as well as "financial engineering services for institutions, accredited investors, governments, and bankers, namely, financial risk analysis, financial risk consultancy, financial investment and risk information, financial risk management, financial risk evaluation, structured financial asset management, and financial securities hedging, namely, hedge fund investment services; financial investment risk management and financial investment market value equity insurance consultancy for institutions, accredited investors, governments, hedge funds, and bankers; asset value management services, namely asset market value financial risk mitigation and asset equity insurance consultancy for institutions, accredited investors, governments, hedge funds, and bankers." The services in the cited registration are "savings and loan financial services."

Applicant argues that the goods and services offered under its mark are distinctly different than those offered under the registered mark and are "narrowly tailored such that there is no overlap between the two." (applicant's

brief at 13). The examining attorney, on the other hand, contends that the respective goods and services are similar because they are financial in nature and involve potentially overlapping clients or markets. In support of this position, the examining attorney made of record third-party registrations that purportedly demonstrate that consumers are familiar with entities offering applicant's type of goods and services and registrant's type of services under the same mark. Copies of use-based, third-party registrations may serve to suggest that the goods and services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783, 1785 (TTAB 1993). However, on close inspection, we find that the third-party registrations submitted into the record by the examining attorney cover goods and services that are distinctly different from those at issue in this case. For example, while all of the identifications in the third-party registrations contain *some* of the wording from the application (*i.e.,* "consulting services in the field of risk management" or "financial services, namely, financial asset management"), none of them contains the clear limitation present in applicant's identification "for institutions, accredited investors, governments, hedge funds, and bankers." In accordance with Rule 501 of

Regulation D of the Securities Act of 1933, "Accredited Investors" include entities such as "banks, insurance companies, registered investment companies, business development companies, and small business companies;" "charitable organizations, corporations, and partnerships with assets exceeding $5 million"; and "businesses in which all the equity owners are accredited investors;" and individuals such as "directors, executive officers, or general partners of the companies selling the securities." (Koziol Decl. at ¶ 10). This is overtly a very specialized group as included in applicant's identification of goods and services.

Accordingly, the third-party registrations, which do not include goods and services "for institutions, accredited investors, governments, hedge funds, and bankers" are not availing to show similarity of the goods and services at issue in this case. Without evidence showing that applicant's goods and services are related to the registrant's services, the examining attorney has not met her burden of proof on this point.

Rather, applicant's identification covers highly specialized financial engineering software, financial engineering services, and other services "for institutions, accredited investors, governments, hedge funds, and

bankers," while the cited registration covers "savings and loan financial services." Definitions in the record show "financial engineering" defined as "the design and construction of investment products to achieve specified goals"[5] and "savings and loan" defined as "a thrift institution that is required by law to make a certain percentage of its loans as home mortgages."[6] Accordingly, we find that applicant's identification, on its face, shows that applicant's goods and services are different from, and would be marketed via distinct channels of trade from, those in the cited registration. For this reason, the second and third *du Pont* factors weigh against finding a likelihood of confusion.

We turn next to the *du Pont* factor considering the conditions of sale and the sophistication of the purchasers. Although we look to the standard of care of the least sophisticated consumer, it is clear that applicant's goods and services are directed toward highly sophisticated consumers. The fact that sophisticated purchasers are the only connection between the goods and services of the applicant and the services of registrant weighs against a finding of likelihood of confusion. That applicant's customers are sophisticated is not by itself a determinative

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[5] *See* www.equityderivatives.com.

factor. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. As our principal reviewing Court has pointed out, "sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Date Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). In this case, we note that applicant's purchasers, i.e., its "highly sophisticated" investors are "high net worth institutions and accredited individuals." (applicant's brief at 14). Applicant requires these clients to be "accredited investors" under the Securities Act of 1933, as defined, *supra*. (Koziol decl. at ¶ 10). Under these circumstances, we find that the purchasers of applicant's goods and services are extremely knowledgeable and careful in their purchasing decisions. Moreover, since significant financials investments are involved, as well as sophisticated purchasers, we agree with applicant that its goods and services are not "impulse" buys by consumers, but rather are carefully considered decisions requiring significant deliberation.

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[6] *See* www.wordnet.princeton.edu.

As discussed above, we find that the evidence of record does not support a finding that there is a likelihood of confusion. While the marks are legally identical, applicant's goods and services and registrant's services, on their face, are distinctly different, and applicant's goods and services clearly are very expensive and would be bought only by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation. We therefore conclude that confusion is not likely.[7]

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

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[7] As stated above, since we find no likelihood of confusion with Registration No. 1106282, neither would we find it for the less similar or relevant cited registrations, Registration No. 1057936 and Registration No. 1057937.