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

Proceeding	78805983
Applicant	Vision One Mortgage, Inc.
Applied for Mark	VISION ONE MORTGAGE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: Vision One Mortgage, Inc..

Serial No.: 78/805,983

Filed: February 2, 2006

Mark: VISION ONE MORTGAGE

Examiner: Robert Clark

Law Office: 101

Commissioner of Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
MS:_Trademark Trial and Appeal Board

BRIEF FOR APPLICANT

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on February 2, 2006, Applicant files it's brief on appeal from the Examining Attorney's final refusal to register VISION ONE MORTGAGE for mortgage banking and mortgage lending, in International Class 036 on the grounds that the Applicant's mark is likely to be confused with U.S. Registration No. U. S. Registration No. 2369714 for VISION 1 for financial services in the field of investment and securities brokerage, namely, brokerage services in the field of securities, mutual funds and commodities, but excluding banking services, in International Class 036. Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

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ALPHABETICAL INDEX OF CASES

- Am. Home Prods. Corp. v. B.F. Ascher & Co.*, 473 F.2d 903, 904 (C.C.P.A. 1973)
- Cabot Corp. V. Titan Tool, Inc.*, 209 U.S.P.Q. 338, 344 (T.T.A.B. 1980)
- Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 283
- General Mills, Inc., v. Kellogg Co.* 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987)
- E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d, 1525, 1533, 225 U.S.P.Q. 1131 (6th Circ. 1997)
- In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q.2d 1910, 1911 n1912 (TTAB 1988)
- In re E.I. Dupont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)
- In re the Lucky Co.*, 209 U.S.P.Q. 422 (T.T.A.B. 1980)
- In re N.A.D. Inc.*, 224 U.S.P.Q. 969, 971 (Fed. Cir.1985)
- In re National Novice Hockey League, Inc.*, 222 U.S.P.Q. 638, 640 (T.T.A.B. 1984)
- Microwave Sys. Corp.*, 126 F. Supp. 2d at 1214
- Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 U.S.P.Q. 412 (T.T.A.B. 1962)
- Spoons Restaurants, Inc. v. Morrison, Inc.* 23 U.S.P.Q. 2d 1735, 1740 (T.T.A.B. 1991)
- Sure-Fit Products Co. v. Saltzson Drapery Co.*, 117 U.S.P.Q. 295 (C.C.P.A. 1958)
- United Foods v. J.R. Simplot Co.*, 4 U.S.P.Q. 2d 1172, 1174 (T.T.A.B. 1987)
- Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 30 U.S.P.Q. 2d 1930, 1933 (10th Cir. 1994)
- Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986)

DESCRIPTION OF THE RECORD

Trademark application filed on February 2, 2006.

First Office Action on July 25, 2006.

Reply to Office Action on November 16, 2006.

Final Rejection Office Action on December 29, 2006.

Reply to Final Office Action on January 26, 2007.

Notice of Appeal filed on June 22, 2007.

STATEMENT OF ISSUES

Is there a likelihood of confusion between Applicant's mark VISION ONE MORTGAGE for mortgage banking and mortgage lending, in International Class 036 and U.S. Registration No. U.S. Registration No. 2369714 for VISION 1 (and design) for financial services in the field of investment and securities brokerage, namely, brokerage services in the field of securities, mutual funds and commodities, but excluding banking services, in International Class 036.

RECITATION OF THE FACTS

On February 2, 2006, Applicant filed an application to register the word mark VISION ONE MORTGAGE with the U.S. Patent and Trademark Office, on the Primary Register under Section 1(B) of the Trademark Act, 15 U.S.C. § 1051(b). This application was filed in International Class 036 for mortgage banking and mortgage lending, and was assigned Serial No. 78/805,983.

In an initial office action dated July 25, 2006, the Examining Attorney refused to register VISION ONE MORTGAGE in International Class 036 contending that the mark is likely to be confused with U.S. Registration No. 2369714 for financial services in the field of investment and securities brokerage, namely, brokerage services in the field of securities, mutual funds and commodities, but excluding banking services in International Class 036. In response, Applicant argued that confusion is unlikely because of dissimilarities between Applicant's and cited marks

in terms of sound, appearance, meaning, and connotation. In addition, Applicant submitted printouts of 112 third party registrations as evidence documenting the extreme weakness of the component VISION

In the final Office Action of April 29, 2002, the Examining Attorney finally refused registration, contending: (a) the marks are confusingly similar and (b) Applicant's and Registrant's services are related. In response, on January 26, 2007, Applicant submitted further arguments that first VISION is a relatively weak mark and should be offered a narrow scope of protection. Receiving no response, Applicants filed a Notice of Appeal on June 22, 2007.

ARGUMENT

1. STANDARD OF EXAMINATION

Determining the absence or presence of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. Other factors, such as third party use must be considered. In re E.I. Dupont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); In re National Novice Hockey League, Inc., 222 U.S.P.Q. 638, 640 (T.T.A.B. 1984); TMEP §1207.01. Here, the weakness of the cited mark, the differences between Applicant's and the cited mark in their entireties, the fact that banking services were explicitly excluded from the cited mark, appearance, sound, meaning and commercial impression, all make confusion unlikely.

2. THE VISION COMPONENT OF THE CITED MARK IS EXTREMELY WEAK

Trademark rights are not static; a mark may lose its distinctiveness, or its strength may change over time. E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc., 756 F.2d, 1525,

1533, 225 U.S.P.Q. 1131. A portion of a mark may be “weak” in the sense that such portion is in common use by many other sellers in the market. Knapp-Monarch Co. v. Poloron Products, Inc., 134 U.S.P.Q. 412 (T.T.A.B. 1962). Evidence of widespread third-party use in a particular field, obtained from sources such as telephone directories or registrations of marks containing a certain shared term, are competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. In re Dayco Products-Eagle Motive Inc., 9 U.S.P.Q. 2d 1910, 1911 n1912 (TTAB 1988) “This means that competitors in the field may come closer to such weak marks without violating the owner’s rights therein, than would be the case with a stronger mark”. In re the Lucky Co., 209 U.S.P.Q. 422 (T.T.A.B. 1980)(Striped shoe logos); Also see, Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295 (C.C.P.A. 1958) (“Rite-Fit” vs. “Sure Fit” for slipcovers; 11 third party registrations). Similar third party usage on products in the same “field” as Registrant’s products tend to prove the weakness of the Registrant’s mark; the closer the product and their channels of trade, the more probative the evidence is of weakness. Spoons Restaurants, Inc. v. Morrison, Inc. 23 U.S.P.Q. 2d 1735, 1740 (T.T.A.B. 1991); Cabot Corp. V. Titan Tool, Inc., 209 U.S.P.Q. 338, 344 (T.T.A.B. 1980).

Applicant has submitted print-outs of **112 third party registrations** in which VISION has been used in International Class 36 to refer to financial services of one sort or another registrations in International class 036 showing that others not only use the word VISION but use them on similar SERVICES sold in the same channels of trade. (See TARR printouts of these marks attached as Exhibit A to applicant’s response dated November 14, 2006). Such evidence of third party use clearly shows that these registrations are able to coexist on the

Principal Register with the cited mark without a likelihood of confusion. In this case, consumers are more likely to focus on the crest/shield logo which is prominently displayed in the middle of Registrant's mark. Accordingly, applicants' mark should also be able to coexist with the cited mark without a likelihood of confusion.

3. THE EXAMINING ATTORNEY HAS NOT GIVEN PROPER WEIGHT TO THE DIFFERENCES IN APPLICANT'S AND REGISTRANT'S MARKS IN THEIR ENTIRETIES

The mere fact that the marks in issue share elements, even dominant elements, does not compel a conclusion of likelihood of confusion. General Mills, Inc., v. Kellogg Co. 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987). Indeed, the non-common matter which is "equally suggestive or even descriptive, may be sufficient to avoid confusion." Wooster Brush Co. v. Prager Brush Co., 231 U.S.P.Q. 316, 318 (T.T.A.B. 1986); United Foods v. J.R. Simplot Co., 4 U.S.P.Q. 2d 1172, 1174 (T.T.A.B. 1987). Identifying the dominant portion of the mark never ends the analysis. No element of a mark is ignored simply because it is not dominant. The mark must be compared in its entirety. Universal Money Centers, Inc. v. American Tel. & Tel. Co., 22 F.3d 1527, 30 U.S.P.Q. 2d 1930, 1933 (10th Cir. 1994).

Similarity is judged by comparing the marks in terms of appearance, sound and meaning. Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr., 109 F.3d 275, 283 (6th Cir. 1997). "In fact, the whole point of the inquiry turns on whether the 'overall impression' created by the marks are such that a likelihood of consumer confusion will result." Microwave Sys. Corp., 126 F. Supp. 2d at 1214. Corp., 126 F. Supp. 2d at 1214.

Here, the appearance of Applicant's and Registrant's marks is markedly dissimilar.

Registrant's mark is VISION 1, a combination of one word and a number, where the number "1" is superimposed onto a crest/shield. In sharp contrast, Applicant's mark has no design and three words, VISION ONE MORTGAGE. Indeed, because the crest/shield, is in the center of Registrant's mark, it is very prominent and confusion with Applicant's mark unlikely.

The sound of Applicant's mark is also dissimilar to Registrant's mark because Registrant's mark does not have the word "mortgage." In this respect, the case law is clear the Examiner should still compare Applicant's entire mark VISION ONE MORTGAGE for the likelihood of confusion analysis even though Applicant is disclaiming MORTGAGE, apart from the mark as shown. Am. Home Prods. Corp. v. B.F. Ascher & Co., 473 F.2d 903, 904 (C.C.P.A. 1973) (no likelihood of confusion between AYEREST and AYR TAB despite the fact that TAB was disclaimed).

Moreover, the meaning between Applicant's mark VISION ONE MORTGAGE and Registrant's mark VISION 1 is dissimilar. Applicant's mark, undoubtedly suggests Applicant's services are within the mortgage area; in contrast, the immediate meaning to the consumer of VISION 1 is in the area of health services relating to eye care. Accordingly, for all of the aforementioned differences in appearance, sound and meaning, consumers are unlikely to be confused between VISION ONE MORTGAGE and Registrant's mark VISION 1.

4. THE RESPECTIVE SERVICES ARE NOT ONLY DIFFERENT BUT THE REGISTRANT EXPLICITLY EXCLUDED BANKING SERVICES

The Examiner has totally ignored the fact that in receiving its registration, the cited mark specifically and expressly excludes banking services, to wit:

“financial services in the field of investment and securities brokerage, namely, brokerage services in the field of securities, mutual funds and commodities, **but excluding banking services**” (emphasis added).

Nothing could be clearer that even the Registrant of the cited mark believed there would be no likelihood of confusion between for Applicant’s services of “mortgage banking and mortgage lending”, which of course are banking services, and the Registrant’s services which are referred to as “**namely**, brokerage services in the field of securities, mutual funds and commodities (emphasis added).

5. THE COST OF THE RESPECTIVE SERVICES AND SOPHISTICATION OF THE PURCHASERS ARE RELEVANT

The cost of the respective services and the sophistication of the purchasers are highly relevant factors in making a likelihood of confusion determination. It is reasonable to believe that where services are relatively expensive, they will be purchased with a certain amount of care and thought. In re N.A.D. Inc., 224 U.S.P.Q. 969, 971 (Fed. Cir.1985). In this case, because Applicant’s services involve mortgage banking and lending, and Registrant’s services involve investment and securities brokerage, consumers will likely spend hundreds, if not hundreds of thousands of dollars. Accordingly, it is clear that the consumer would devote a certain amount of care in dealing with these parties, thereby making confusion unlikely.

SUMMARY

Applicant has shown that the major component of the cited mark VISION 1 is a extremely weak, as shown by the enormous number of VISION registrations. mark, in part by

presenting evidence of dictionary definitions and third party use. Moreover, when the marks are viewed in their entirety, VISION ONE MORTGAGE is substantially different when compared to VISION 1, with respect to appearance, sound, sight, meaning, connotation and commercial impression. Not only are the marks different when considering the extreme weakness of the VISION component, but the Registrant itself has disclaimed any connection with banking, the very service offered by Applicant. These important factors have been given little, if any, weight by the Examiner.. VISION ONE MORTGAGE should be registered in International Class 036.

Please charge any fees required in connection with this Brief to Deposit Account No. 50-3881.

Respectfully submitted,



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