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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lion Capital Management Limited

Serial No. 79051786

Peter D. Vogl and Stephen F. Kampmeier of Jones Day for Lion Capital Management Limited.

Nicholas Altree, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

Before Walters, Bergsman and Wolfson,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On February 6, 2008, applicant Lion Capital Management Limited applied to register the mark LION GLOBAL INVESTORS, in standard character form, for services ultimately identified as "investment management of pension funds, endowment funds, trust funds and assets of accredited or institutional investors; financial advisory services in relation to pension funds, endowment funds, trust funds and assets of accredited or institutional investors," in Class 36. The application is a request for extension of protection filed under Section 66(a) of the Trademark Act of 1946, 15 U.S.C. §1144f(a). Applicant

disclaimed the exclusive right to use the term "Global Investors."

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the two previously-registered marks, listed below, owned by the same entity.

1. Registration No. 3543654 for the mark LION CAPITAL, in standard character form, for "equity capital investment; venture capital services, namely providing financing to emerging and start-up companies; leveraged buy outs and investments in financially distressed or underperforming companies; real estate investment; hedge fund services," in Class 36.¹ Registrant disclaimed the exclusive right to use "Capital"; and

2. Registration No. 3645484 for the mark LION, in standard character form, for "financial services, namely, financial and investment planning and research, financial consultation, and assisting others with the completion of financial transactions for stocks, bonds, securities and equities; venture capital services, namely, providing financing to emerging and start-up companies; leveraged buy outs and investments in financially distressed or under performing

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companies; real estate affairs, namely, real estate investment services; equity capital investment; investment services, namely, investment management services, mutual fund and hedge fund investment services, management of a capital investment fund, capital investment consultation and financial trust operations; trust services, namely, investment and trust company services; advisory and consultancy services relating to corporate finance and venture capital services; investment in the field of private equity, venture capital and specialized funds and other funds; advising on and managing investments; private equity investment management; buying, selling and holding of securities; investment management services relating to acquisitions and mergers; management of equity and debt investment portfolios; investment asset management," in Class 36.²

Our determination of likelihood of confusion 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks

² Issued June 30, 2009.

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and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

We focus our likelihood of confusion analysis on Registration No. 3645484 for the mark LION because the mark and the services in that registration are most closely related to those in the application at issue. If we find that there is no likelihood of confusion with this registered mark in connection with the listed services, there is no need for us to consider the likelihood of confusion with the other registered mark. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The similarity or dissimilarity and nature of the services described in the application and registration at issue and the similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Applicant is seeking to register its mark for investment management and financial advisory services for pension funds, endowment funds, trust funds and assets of accredited or institutional investors. The cited registration for the mark LION is for, *inter alia*, investment management services, financial and investment planning and research, and trust services, namely, investment and trust company services. Because there are no limitations as to channels of trade or classes of

purchasers in the recitation of services in the cited registration, it is presumed that registrant's investment management and financial advisory services move in all channels of trade normal for those services, and that they are available to all classes of purchasers for those services, including the channels of trade and classes of consumers related to investment management and financial advisory services rendered to pension funds, endowment funds, trust funds and assets of accredited or institutional investors. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Thus, for our likelihood of confusion analysis, applicant's services and registrant's services are in part identical and, therefore, we must presume that the channels of trade and classes of purchasers are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

B. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn now to the *du Pont* likelihood of confusion factor focusing on the 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. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely

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to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

The marks are similar in appearance, sound, meaning and commercial impression because they share the word "Lion." In fact, applicant's mark incorporates the entire registered mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo is likely to cause confusion with the mark CONCEPT for cold permanent wave lotion and neutralizer); *Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and soldier design for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL LANCER for gin); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is likely to cause confusion with WEST POINT for woolen piece goods).

We are not persuaded that the presence of the term "Global Investors" in applicant's mark is a sufficient basis for

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consumers to differentiate applicant's mark from the registered mark because that term is merely descriptive of the geographic scope and nature of applicant's investment management and financial advisory services. In this regard, applicant has disclaimed the exclusive right to use the term "Global Investors."

Because the term "Global Investors" is descriptive, the word "Lion" is the dominant element of applicant's mark. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The significance of the word "Lion" as the dominant element of applicant's mark is further reinforced by its location as the first part of the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the

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first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Accordingly, applicant's mark LION GLOBAL INVESTORS is substantially similar to registrant's mark LION.

Applicant argues that the word "Lion" is diluted when used in connection with investment management and financial advisory services and, therefore, it should be accorded only a narrow scope of protection. Applicant submitted numerous third-party registrations issued in Class 36 to prove that "Lion" marks can coexist on the Principal Register. Listed below are the registrations related to investment management and financial advisory services. See *In re Melville*, 18 USPQ2d 1386, 1388-13789 (TTAB 1991) (registrations for goods unrelated to those at issue are irrelevant).

Mark	Reg. No.	Services
LIONSHARES	2831924	Providing online databases in the fields of financial and mutual fund analysis
LIONHART	2471170	<i>Inter alia</i> investment advice and mutual fund management
LR LION ROCK	3100624	Financial portfolio management; investment management
THE SABLE LION GROUP	2904257	Capital investment consultation, investment advice, investment consultation, investment management

Mark	Reg. No.	Services
ROARING LION	2948611	Venture capital funding services to emerging and start-up companies, venture capital services, namely, providing financing to emerging and start-up companies
LION SUBACCOUNTING SYSTEM	1871557	Financial and investment services in the field of mutual funds and other investment products
THE LION ADVISOR ACCOUNT	2770957	<i>Inter alia</i> financial and investment services, namely, the offering and sale of mutual funds to others; investment advisory and financial planning services

The third-party registrations do not prove that "Lion" is a weak term. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). See also *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

While third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of the services at issue, we fail to see any descriptive or suggestive meaning of the word "Lion" in connection with investment management and financial advisory services.

In view of the foregoing, we find the similarity of the marks is a factor that weighs in favor of finding that there is a likelihood of confusion.

C. The degree of consumer care.

Even though the applicant did not introduce any evidence regarding the degree of care exercised by consumers purchasing investment management and financial advisory services, we can make certain suppositions about the degree of care such consumers will exercise when selecting such services based on the very nature of those services. Purchasers of investment management and financial advisory services will exercise a high degree of care, and therefore focus on the trademark for the services and become aware of the source of the service because these purchases will be characterized by a personal sales experience by knowledgeable salespersons and a focused need for the services. Nevertheless, even sophisticated consumers are not immune to trademark confusion especially, where as here, the

marks are similar and the services are in part identical. While the degree of care factor weighs in favor of applicant, it is not sufficient to outweigh the other factors.

E. Balancing the factors.

In view of the facts that the marks are similar, the services are in part identical and, therefore, there is a presumption that the channels of trade and classes of consumers are the same, we find that applicant's mark LION GLOBAL INVESTORS for "investment management of pension funds, endowment funds, trust funds and assets of accredited or institutional investors; financial advisory services in relation to pension funds, endowment funds, trust funds and assets of accredited or institutional investors" so resembles the registered mark LION for, *inter alia*, investment management services, financial and investment planning and research, and trust services, namely, investment and trust company services as to be likely to cause confusion.

Decision: The refusal to register is affirmed.