

ESTTA Tracking number: **ESTTA477742**

Filing date: **06/13/2012**

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

Proceeding	85343985
Applicant	MidWestOne Financial Group, Inc.
Applied for Mark	MIDWESTONE BANK
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Submission	Appeal Brief
Attachments	123366.004 MIDWESTONE logo appeal brief (final).PDF (5 pages)(54707 bytes)
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Date	06/13/2012

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

Mark: MIDWESTONE BANK
Application Serial No. 85/343,985
ESTTA Tracking number: ESTTA467728
Appeal filed: 04/18/2012
Applicant: MidWestOne Financial Group, Inc.

Appeal Brief

The Examiner refused the application under Section 2(d) because of a likelihood of confusion with U.S. Registrations Nos. 3024993 (MIDWEST BANC), 3161246 (MIDWEST BANK), and 3304609 (MIDWEST BANK THE BANK WHERE YOU BELONG), together the “Cited Registrations”. The Cited Registrations are in IC 036 having descriptions of bank holding company services, banking services and banking services, respectively.

The current application, Serial Number 85/343,985, is for the logo mark MIDWESTONE BANK, the “Current Mark”, in IC 036 having a description of banking and financing services. This is the companion application to Serial No. 85/343,983, also on appeal (ESTTA467725).

The likelihood of confusion analysis involves a totality of the circumstances analysis of the *du Pont* factors. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The Examiner asserts that the *du Pont* analysis weighs in favor of a likelihood of confusion. Applicant respectfully disagrees.

While the services are similar, contrary to the assertion of the Examiner, the marks in question are nonetheless dissimilar to each other and there is no likelihood of confusion. The Cited Registrations fail to utilize the word ONE. The addition of ONE in the Current

Mark separates the mark from the Cited Registrations. First, the addition of the ONE visually changes the Current Mark by adding an obvious visual distinction from the Cited Registrations. While located in the middle of the mark, and thus possibly less prominent, it is nonetheless a significant visual change from the Cited Registration that is not easily overlooked by the consumer.

Second, the addition of ONE changes the sound of the Current Mark by adding a syllable and a new vowel sound in the middle of the mark. A consumer speaking the Current Mark will not be able to avoid the additional syllable. The vowel sound is not easily avoided when speaking. The vowel sound is not a glide or otherwise easily swallowed; meaning that is spoken consistently. This makes the syllable and vowel sound a prominent aspect of the Current Mark, even though it is in the middle of the mark. The additional syllable and vowel sound create an aurally distinct mark from the Cited Registrations.

Third, the addition of ONE changes to the connotation of the Current Mark. The ONE in the middle signifies the prime or singular nature of the services offered under the Current Mark. While this may be considered puffery on the part of Current Mark owner, it is nonetheless provides an additional connotation to the Current Mark that is absent from the Cited Registrations. The additional connotation creates a distinctive mark from the Cited Registrations.

Fourth, the overall commercial impressions of the marks are different. Taken together, the visual dissimilarities, the aural dissimilarities and the dissimilar connotations mean that the Cited Registrations and the Current Mark have different commercial impressions, contrary to the assertion of the Examiner. The Examiner appears to assume that the consumer would merely skip over or ignore the ONE in the Current Mark, thus

giving the same commercial impression as the Cited Registrations. However, this is not case when the visual, aural and connotation dissimilarities are properly evaluated.

Thus, contrary to the assertion of the Examiner, the marks are not similar. And the likelihood of confusion analysis fails on this point and should be withdrawn.

Further, in assessing likelihood of confusion, it is important to consider the strength or weakness of the portions of the marks that the Current Mark and Cited Registrations have in common.

If the common element of conflicting marks is a word that is 'weak' then this reduces the likelihood of confusion. A portion of a mark may be 'weak' in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market. 4 McCarthy on Trademarks and Unfair Competition § 23:48 (4th ed. 2012).

BANK is obviously in common usage for banking services and is also highly suggestive of banking services. MIDWEST is all three: descriptive of geographic location, high suggestive of geographic location and in common usage in the Midwest. Thus, combination of relatively weak terms is entitled to a narrow scope of protection. And small differences will serve to allow consumers to distinguish between the marks, even in cases where the services are similar or the differences are small. See for example, See In re Hamilton Bank, 222 U.S.P.Q. 174 (T.T.A.B. 1984) (KEY v. KEYCHECK/KEYBANKER); Pacquin-Lester Co. v. Charmaceuticals, Inc., 484 F.2d 1384, 179 U.S.P.Q. 45 (C.C.P.A. 1973) (SILK 'N SATIN v. SILK); and Melaro v. Pfizer, Inc., 214 U.S.P.Q. 645, 648 (T.T.A.B. 1982) (SILK v. SILKSTICK).

This proposition is born out by other registrations issued by the Trademark Office. For example, the Cited Registrations were registered in spite of the existence of a live registration for FIRST MIDWEST BANK (Reg. No. 1481870; issued March 22, 1988). The

Cited Registrations issued on December 13, 2005, October 24, 2006 and October 2, 2007, respectively. It is clear that the small elimination of FIRST was sufficient to distinguish the Cited Registrations from FIRST MIDWEST BANK. Similarly, the addition of ONE is sufficient to distinguish the Current Mark from the Cited Registrations.

More particularly, the Trademark Office has issued registrations to marks that include ONE despite the existence of the registrations to the base mark. For example, a registration for VOXONE (Reg. No. 4114638) was issued on March 20, 2012 in IC 035 for advertising, marketing and promotion services, in spite of a live registration for VOX (Reg. No. 3297867) issued on September 25, 2007 in IC 035 for business consulting service for improvement of customer retention and referrals. PINGONE (Reg. No. 4151401) issued May 29, 2012 in IC 045 for identity verification services, namely, providing user authentication between two or more entities in the field of digital security, in spite of multiple registrations for PING (e.g. Reg. No. 3813431) issued on July 6, 2010 in 045 for online social networking services. As can be seen, the addition of ONE to a mark with an existing registration is sufficient to create a distinctive mark with no likelihood of confusion even if the services are similar or in the same class.

Taken together, it is reasonable that consumers will be able to distinguish among banking service providers based minor differences in the marks and that there is no likelihood of confusion between the Current Mark and the Cited Registrations. For this reason, Applicant respectfully requests that the likelihood of confusion rejection be overturned.

Table of Authorities

Cases

<u>In re E.I. du Pont de Nemours & Co.</u> , 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).....	1
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