

This Opinion is not a
Precedent of the TTAB

Mailed: March 16, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Boulevard West, Inc.
—

Serial No. 87692255
Serial No. 87692259
Serial No. 87721566
—

B. Anna McCoy of McCoy Russell LLP
for Boulevard West, Inc.

Philip Liu, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

—
Before Zervas, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Boulevard West, Inc. (“Applicant”) seeks registration on the Principal Register of
the following marks:¹

—
¹ These appeals involve common questions of law and fact and the records are substantially similar in important respects. Accordingly, we consolidate and decide these appeals in this single decision. *See, e.g., In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1102 (TTAB 2018) (Board sua sponte consolidated two appeals); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1214 (2020). References to the record refer to Application Serial No. 87692255 unless otherwise indicated.



2



3



4

² Application Serial No. 87692255 was filed on November 20, 2017, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as July 7, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). "INSURANCE STRATEGIES" is disclaimed. Color is not claimed as a feature of the mark.

Applicant provided the following description of the mark: "The mark consists of the wording 'BOULEVARD INSURANCE STRATEGIES' in stylized font next to an incomplete square comprised of five horizontal lines of varying sizes as the base and five vertical lines of varying sizes on each side."

Page references to the application record refer to the online database pages of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

³ Application Serial No. 87692259 was filed on November 20, 2017, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as July 7, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), "FAMILY WEALTH" is disclaimed. Color is not claimed as a feature of the mark.

Applicant provided the following description of the mark: "The mark consists of the wording 'BOULEVARD FAMILY WEALTH' in stylized font next to an incomplete square comprised of five horizontal lines of varying sizes as the base and five vertical lines of varying sizes on each side."

⁴ Application Serial No. 87721566 was filed on December 14, 2017, based upon Applicant's claim of first use anywhere and first use in commerce since at least as early as July 7, 2017,

all for “Financial and investment services, namely, financial portfolio management services, investment advisory services, financial planning services, and investment management services for high-wealth individuals and families” in International Class 36.

The Trademark Examining Attorney refused registration of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark BOULEVARD (in standard characters) for “accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions via a global computer network; financial transaction services, namely, providing secure commercial transactions and payment options.”⁵

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals were resumed. The appeals are fully briefed.⁶ We affirm the refusals to register.

under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). “WEST” AND “PARTNER” is disclaimed. Color is not claimed as a feature of the mark.

Applicant provided the following description of the mark: “The mark consists of the wording ‘BOULEVARD WEST PARTNERS’ in stylized font next to an incomplete square comprised of five horizontal lines of varying sizes as the base and five vertical lines of varying sizes on each side.”

⁵ Registration No. 5480322 issued May 29, 2018.

⁶ On July 21, 2020, Applicant filed a notice of appeal and request for reconsideration in application Serial No. 87721566. The application was inadvertently abandoned on August 12, 2020, and reinstated on September 4, 2020. Applicant then filed its appeal brief on September 21, 2020. After the appeal brief was forwarded to the Examining Attorney for submission of his brief, the Examining Attorney sought a remand on September 23, 2020, to

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d).

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *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.”).

address Applicant’s request for reconsideration. 4-9 TTABVUE. After remand, the Board allowed supplemental briefing in view of the Examining Attorney’s denial of reconsideration and submission of additional evidence. Serial No. 87721566, 13 TTABVUE, 17 TTABVUE, and 19 TTABVUE. On March 10, 2021, Applicant requested that the Board exclude the Examining Attorney’s supplemental brief (filed February 18, 2021) due to untimeliness. As the Examining Attorney did not provide an explanation for the late filing, we have not considered the Examining Attorney’s supplemental brief. However, even if considered, it would not compel a different result.

A. Similarity or Dissimilarity of the Marks


We turn to the first *DuPont* factor, which requires us to determine the similarity or dissimilarity of the marks in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The test under the first *DuPont* factor 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 that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

In comparing the marks, we consider them in their entirety. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). It is nevertheless appropriate, for rational reasons, to regard certain features of the marks as being more dominant or otherwise significant, and therefore to give those features greater weight. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Nat'l Data Corp.*, 224 USPQ at 751.

In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods or services. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods to

which it is affixed.”) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001) (“words are normally accorded greater weight because they would be used by purchasers to request the goods”). Also, disclaimed or otherwise descriptive matter is generally viewed as a less dominant or significant feature of a mark. *See In re Nat’l Data Corp.*, 224 USPQ at 751-52.

Applicant’s marks are  , 

and  and Registrant’s mark is BOULEVARD (in standard characters). Because Registrant’s mark is displayed in standard character form, it is not limited to any special stylization, and we must assume that it could be displayed in a similar font style to Applicant’s marks. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (“Standard character” marks are registered “without claim to any particular font style, size, or color.”).

Applicant argues that the Examining Attorney improperly dissected its marks and ignored the differences in appearance, sound, meaning and commercial impression between Applicant’s marks and the cited mark.⁷ Applicant submits that even if the disclaimed wording and design elements in Applicant’s marks are given less weight,

⁷ Applicant’s brief, 8 TTABVUE 9-11 (Serial Nos. 87692255 and 87692259) and 4 TTABVUE 9-11 (Serial No. 87721566).

these additions result in very different commercial impressions when comparing its marks in their entireties with the cited word mark.⁸

In particular, Applicant states that BOULEVARD is arbitrary in connection with either Applicant's or Registrant's services but submits that Registrant's mark BOULEVARD "leaves a mundane [commercial] impression, rather than imparting any concrete image, meaning, or impression which consumers can latch onto,"⁹ the "only meaning is incongruity ... [with] "no concrete meaning or impression,"¹⁰ while Applicant's marks provide a "clear and distinct" or "concrete" meaning or impression.¹¹

As to the design elements in its marks, Applicant argues that the design element is a "street design," "oriented to give the viewer the impression they are looking towards something far away or in the future, or moving towards some far off destination or objective."¹² As to the additional disclaimed wording in each of its marks, Applicant submits that "these additional terms [in its composite BOULEVARD INSURANCE STRATEGIES and BOULEVARD FAMILY WEALTH marks] sculpt[] a distinct meaning and impression out of the otherwise arbitrary

⁸ Applicant's brief, 8 TTABVUE 11 (Serial Nos. 87692255 and 87692259), and 4 TTABVUE 10-11 (Serial No. 87721566).

⁹ Applicant's brief, 8 TTABVUE 12, 13 (Serial No. 87692255), and 8 TTABVUE 12 (Serial No. 87692259).

¹⁰ Applicant's brief, 4 TTABVUE 11, 12 (Serial No. 87721566).

¹¹ Applicant's brief, 8 TTABVUE 13 (Serial No. 87692255 and Serial No. 87692259); Applicant's reply brief, 16 TTABVUE 9 (Serial No. 87721566).

¹² Applicant's brief, 8 TTABVUE 14 (Serial No. 87692255), 8 TTABVUE 13 (Serial No. 87692259), and 4 TTABVUE 11-12 (Serial No. 87721566).

BOULEVARD element,”¹³ and that the graphic and disclaimed elements in Applicant’s composite BOULEVARD WEST PARTNERS mark create a “meaning and commercial impression entirely distinct from the merely incongruous impression



presented by the Cited Mark BOULEVARD.”¹⁴ For its

mark, Applicant submits that “[w]hen the street design and BOULEVARD elements are placed in relation to the grounding INSURANCE STRATEGIES elements, the sum of the elements take on a new combined meaning, regarding Applicant as a financial services provider using insurance investment strategies to lead consumers



down a path towards far off financial objectives.”¹⁵ For its

mark, Applicant submits that “[w]hen the street design and BOULEVARD elements are placed in relation to the grounding FAMILY WEALTH element, the sum of the elements take on a new combined meaning, regarding Applicant as a financial services provider leading consumers down a path towards far off financial and family



wealth objectives.”¹⁶ For its mark, Applicant submits that

“[w]hen combining the street design, and the BOULEVARD word itself, together with

¹³ Applicant’s brief, 8 TTABVUE 13 (Serial No. 87692255) and 8 TTABVUE 13 (Serial No. 87692259).

¹⁴ Applicant’s brief, 4 TTABVUE 12 (Serial No. 87721566).

¹⁵ Applicant’s brief, 8 TTABVUE 14 (Serial No. 87692255).

¹⁶ Applicant’s brief, 8 TTABVUE 12 (Serial No. 87692259).

the WEST and PARTNERS words, Applicant's Mark suggests to consumers that Applicant is a financial advisor [or financial partner] who will guide the consumer down the right street and towards the consumer's financial objectives."¹⁷

As with most composite word and design marks, we find the word portions of Applicant's marks are dominant and the design element in each mark is subordinate to the literal elements as the words will be used to request the services. We also find that although there are specific differences between Applicant's marks and Registrant's mark, the common features in the marks are far more significant.

Both Applicant's marks and Registrant's mark share the word BOULEVARD, which also is the dominant element of the literal portion of Applicant's marks, as the additional terms in each of Applicant's marks ("insurance strategies," "family wealth" and "west and partners") are disclaimed. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011) (when a mark consists of two or more words, some of which are disclaimed, the word not disclaimed is generally regarded as the dominant or critical term); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (finding "delta" the dominant part of the mark THE DELTA CAFE because CAFE was disclaimed). The disclaimed terms "insurance services" and "family wealth" in Applicant's marks describe the nature of Applicant's services, and the term "partner" in Applicant's mark describes an entity

¹⁷ Applicant's brief, 4 TTABVUE 12, and supplemental brief, 15 TTABVUE 7 (Serial No. 87721566).

type, while “west” describes Applicant’s partners’ geographic location.¹⁸ These disclaimed terms are less likely to be impressed upon the minds of consumers and remembered as source indicators than the more prominent term BOULEVARD in each mark. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049-50 (Fed. Cir. 2018).

The dominance of BOULEVARD in Applicant’s marks is further reinforced by its size in relation to the other wording; BOULEVARD would be read as the first and most memorable literal term in Applicant’s marks. *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 likely to be impressed upon the mind of a purchaser and remembered”). Applicant’s intent to emphasize BOULEVARD is evident from the fact that it appears in all three marks, and the other terms do not.

Applicant’s marks and Registrant’s mark are similar in appearance, sound, connotation, and commercial impression to the extent that Registrant’s BOULEVARD mark is wholly contained within Applicant’s marks. While there is no rule that likelihood of confusion automatically applies where one mark encompasses another, likelihood of confusion has often been found where the entirety of one mark is incorporated within another. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (finding ML similar to ML MARK LEES).

¹⁸ Applicant is a partnership of financial advising firms. Applicant’s brief 4 TTABVUE 6. (Serial No. 87721566).

Although Applicant argues that BOULEVARD in the cited mark is “mundane” and lacks any concrete impression, we find that the connotation and commercial impression of BOULEVARD in the cited mark is one of a road or path which is the same as the connotation and commercial impression of BOULEVARD in Applicant’s marks.¹⁹

As to the disclaimed matter in Applicant’s marks, consumers will view the different additional words in each mark as simply reflecting the different types of services with which each mark is used, or information about Applicant’s entity type, rather than as significant elements of the composite marks indicating separate sources. In addition, because purchasers do not always recall the details of composite design marks, we find the visual and other differences between Applicant’s marks and the cited standard character mark are less significant. It is the general overall commercial impression engendered by the marks that must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). The proper emphasis is thus on the recollection of

¹⁹ The Examining Attorney argues that “if BOULEVARD suggests one guiding a consumer down a street or path towards one’s objectives, then the same could be said of registrant’s full mark BOULEVARD.” Examining Attorney’s brief, 8 TTABVUE 10 (Serial No. 87692255), 8 TTABVUE 9-10 (Serial No. 87692259), and 14 TTABVUE 8 (Serial No. 87721566). We take judicial notice of the definition of boulevard, “a broad often landscaped thoroughfare.” Merriam-Webster Dictionary <https://www.merriam-webster.com/dictionary/boulevard> (accessed March 11, 2021). The Board may take judicial notice of dictionary definitions retrieved from online sources when the definitions themselves are derived from dictionaries that exist in printed form. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Id.*

In sum, when viewed in their entirety, the marks are more similar than dissimilar. While admittedly there are differences in the marks, particularly the presence of disclaimed terms, and the inclusion of a design in Applicant's marks, the presence of these elements does not offer a sufficient difference such that the marks as a whole would create separate and different commercial impressions. *See In re Dixie Restaurants*, 41 USPQ2d at 1531 (THE DELTA CAFE and design was similar to the mark DELTA, and neither the design element nor the generic term "café" offered sufficient distinctiveness to create a different commercial impression).

The first *DuPont* factor weighs in favor of likelihood of confusion.

B. Similarity or Dissimilarity of the Services, Channels of Trade and Class of Purchasers

We next consider the second and third *DuPont* factors. The second *DuPont* factor "considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration," while the third *DuPont* factor considers "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of services in the applications and the cited registration. *Id.*; *Stone Lion Capital Partners*, 110 USPQ2d at 1161-63. "It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods [or services] within a particular class in the application." *In re Aquamar, Inc.*, 115 USPQ2d 1122,

1126 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

The services in Applicant's marks are

Financial and investment services, namely, financial portfolio management services, investment advisory services, financial planning services, and investment management services for high-wealth individuals and families.

The services in Registrant's mark are

accepting, processing, and reconciling credit card, debit card, gift card and other forms of payment transactions via a global computer network; financial transaction services, namely, providing secure commercial transactions and payment options.

To support the assertion that the services are related, the Examining Attorney submitted 13 third-party registrations²⁰ based on use in commerce for services that cover both investment and financial services and processing of debit card and credit card payments and other payment processing services.²¹ Third-party registrations that individually cover a number of different services and that are based on use in commerce serve to suggest that the listed services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993). Examples include:

Registration No. 5959613 MYTAILOREDWEALTH for services including credit card payment processing services, financial planning, financial consultation and investment advice, and financial portfolio management;

²⁰ Two third-party registrants each own two of the registrations submitted by the Examining Attorney. One of the third-party registrations submitted by the Examining Attorney does not specifically list payment processing services.

²¹ January 21, 2020 Office Action at TSDR 2-40.

Registration No. 5916702 FNBO for services that include financial planning, investment management, investment advisory services, credit card and debit card processing services; electronic payment, namely electronic processing and transmission of bill payment data.

Registration No. 5918270 MAKE NEXT HAPPEN NOW for services that include investment management, investment advisory services, financial planning, financial management; processing of credit card payments; processing of debit card payments.

Registration No. 5750650 IDAHOTRUSTBANCORP and design for services that include processing of credit card and debit card payments; online bill payment; investment management; financial planning; investment portfolio analysis and advisory services;


Registration No. 5910710 for ERSTE GROUP for services that include processing of credit card payments, investment advisory services, financial asset management services, financial management and planning;

Registration No. 5865679 OLD NATIONAL BANKING WITH HEART and design for services that include credit card and debit card transaction processing services; financial planning; investment management services; financial portfolio management;

Registration No. 5313756 THIS IS BANKING A FIFTH THIRD BETTER for services that include: credit card transaction processing services, credit card payment processing services, processing of debit card payments and debit card transactions, processing electronic payments made through prepaid cards; Investment services, namely, asset acquisition, consultation, development and management services; financial asset management services, namely, investment management account services;

Registration No. 5563034 LEGACY RATE for financial planning; investment management services; credit card payment processing services;



Registration No. 5451758  for services including providing electronic processing of credit card, debit card and electronic payments; charge card and credit card payment processing, financial planning and investment advisory services.

Registration No. 5846681 PORTFOLIO PREMIER for services that include credit card and debit card services; financial planning and investment advisory services,

namely investment consultation, investment brokerage and investment management services.

The Examining Attorney submitted web pages for BB&T, Fifth Third Bank, Key Bank, PNC, and U.S. Bank showing that they offer personal investment services and merchant payment processing services for businesses.²² The Examining Attorney also submitted web pages from financial institutions (for example, HSBC, Wells Fargo, and Bank of America) that offer links to banking, online payments, credit cards and investment services on the same web page.²³

While Applicant is correct that the relatedness of the respective services herein cannot be presumed merely because the services represented by the marks fall into the same broad category of “having to do with finances and money,”²⁴ the Examining Attorney has done more than just show that the services at issue fall under a broad category. As the Examining Attorney points out, banking institutions offer services to a wide variety of consumers and “provide a wide array of financial services, including issuing credit cards, providing home equity lines of credit (HELOC), financing and loan services, individual retirement account services, and mutual fund investment services.”²⁵ Here, the third-party registrations and website evidence show

²² August 12, 2020 Denial of Reconsideration at TSDR 2-64. We agree with Applicant that the Internet web pages submitted by the Examining Attorney for PayPal only show payment processing services and the web pages for HSBC Bank, Barclays Bank, Wells Fargo Bank, Morgan Stanley and Bank of America do not show the offering of payment processing services. January 21, 2020 Office Action at TSDR 2-9.

²³ January 21, 2020 Office Action at TSDR 2, 3, and 6.

²⁴ Applicant’s brief, 8 TTABVUE 22 (Serial Nos. 87692255 and 87692259) and 4 TTABVUE 17 (Serial No. 87721566).

²⁵ Examining Attorney’s brief, 10 TTABVUE 15 (Serial Nos. 87692255 and 87692259) and 14 TTABVUE 13 (Serial Nos. 87721566).

the offering of Applicant's and Registrant's services by the same entities under the same or similar marks.²⁶

To rebut the Examining Attorney's third-party registration evidence, Applicant submitted 15 pairs of used-based third-party registrations of similar marks or marks with a similar element owned by different entities covering various financial and investment services, including some that list the same services as Applicant and Registrant.²⁷ These registrations are being used by Applicant to support its argument that the financial services industry is broad with separate niche corners that do not overlap and that consumers do not expect these services to be offered by the same source.

Applicants may submit sets of third-party registrations to show that the USPTO has registered the same or similar marks to different entities for the goods or services at issue. *In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1369-70 (TTAB 2009). These registrations are used to support an argument "that the third-party registrations serve to suggest that the listed goods [or services] are of a type which

²⁶ Applicant argued in its brief in Application Serial No. 87721566 that the web pages do not specifically list the exact services of the Registrant and that the nature of the services offered is unclear. Applicant's brief, 4 TTABVUE 14 and note 1. However, we find that the website evidence provided by the Examining Attorney sufficiently identifies "payment processing" or credit/debit card processing as an offered service, and that Registrant's identification also is broad enough to encompass electronic and mobile payment services as well as debit and credit card services reflected on some of the web page evidence submitted by the Examining Attorney. August 12, 2020 Denial of Reconsideration at TSDR 21, 22, 28, 37, 49, 62; July 21, 2020 Request for Reconsideration at TSDR 212; January 21, 2020 Office Action at TSDR 2-6; October 11, 2018 Office Action at 2-9.

²⁷ July 21, 2020 Request for Reconsideration at TSDR 44-185.

may emanate from different sources.” *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

However, we find these registrations unpersuasive. To have probative value, the third-party registrations being compared must be similar marks and must identify the same services as those at issue. In this case, only three of the pairs (STEWARDSHIP TECHNOLOGY and CAPITAL STEWARDSHIP PARTNERS; ELEMENT 5 and ELEMENT POINTE; and VAULT GATEWAY and G GATEWAY ADVISORY) cover services most closely similar to Applicant’s and Registrant’s services. We also find that the commercial impression is not the same for two of the pairs. A single pair of third-party registrations of similar marks offering services similar to Applicant and Registrant is insufficient to rebut the Examining Attorney’s third-party registration evidence.

Applicant also contends that the Examining Attorney’s website evidence is insufficient to establish that Applicant’s and Registrant’s services are related because the website evidence shows²⁸ banks outsource these services to third-party providers and that the outsourced services are offered under different marks.²⁹ However, the

²⁸ January 21, 2020 Office Action at TSDR 41-48; July 21, 2020 Request for Reconsideration at TSDR 186-217 (Serial Nos. 87692259 and 87721566). In the request for reconsideration, Applicant submitted supplemental evidence from the same websites submitted by the Examining Attorney to support its argument that the websites do not establish relatedness of the services. In the request for reconsideration filed in Application Serial No. 87692255, some of the exhibit pages are blank.

²⁹ The Wells Fargo web pages show that it provides its merchant payment processing services in connection with Clover hardware and software and that merchant payment processing services may allow acceptance of payment options such as Apple Pay, Google Pay and Samsung Pay, among others. July 21, 2020 Request for Reconsideration at TSDR 212-213.

fact that payment processing services are offered in partnership with another entity or that some of the functions related to these services are outsourced to third-parties (that use different trademarks) does not undercut the value of the website and registration evidence showing that the services are offered and may be obtained through the same-named financial institution. For example, the web pages for Wells Fargo, HSBC, Morgan Stanley, Fifth Third Bank and Capital One prominently display the financial institution's name in connection with these services so that the consumer is well aware of the source of these services even if the some portion of the services are provided by third-parties.³⁰

Applicant also argues that consumers will not confuse Applicant's and Registrant's services because payment processing services are offered by financial institutions under different marks than their investment services. However, the third-party websites the Examining Attorney made of record show the use of relatively similar marks, e.g., the bank name with the addition of a generic term such as "wealth" or "merchant services" e.g., (BB&T Wealth and BB&T Merchant Services; Fifth Third Merchant Services and Fifth Third Wealth Management). Therefore, these uses do not lessen the source relationship between the services. *See In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) ("It is clear that consumers would be likely to believe that jewelry on the one hand and retail stores selling jewelry on the

³⁰ July 21, 2020 Request for Reconsideration at TSDR 212; August 12, 2020 Denial of Reconsideration at TSDR 14, 21; July 21, 2020 Request for Reconsideration at TSDR 207 and 214 (Serial Nos. 87692259 and 87721566).

other emanate from or are sponsored by the same source if such goods and services are sold under the same or similar marks.”).

Applicant further argues that the services have different purposes, require special skill and experience, and target different consumers,³¹ and that because of these differences, the Examining Attorney’s evidence does not demonstrate relatedness.³² However, the respective services need not be identical or directly competitive in order for there to be likelihood of confusion. The respective services need only be related in some manner, or the circumstances or conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the respective services come from the same source. *See Coach Servs.*, 101 USPQ2d at 1722. *See e.g., Bear Mfg. Company v. Norton Co.*, 157 USPQ 634, 636 (TTAB 1968), *aff’d Norton Co. v. Bear Mfg. Co.*, 438 F.2d 620, 169 USPQ 44 (CCPA 1971) (mineral oil, namely, a general-purpose lubricating and sharpening oil found related to oil and grease because “while the products of the parties are specifically different and are intended for different purposes they are nevertheless both lubricating oils of a type which would be marketed by the same producer and could conceivably be used by some of the same persons.”). Although the services identified by the application and the cited registration may be intended for different purposes, it is apparent from the

³¹ Applicant’s brief, 8 TTABVUE 8, 16, 21-22, and reply brief 11 TTABVUE 6. (Serial Nos. 87692255 and 87692259); Applicant’s brief, 4 TTABVUE 16 (Serial No. 87721566).

³² Applicant’s brief, 8 TTABVUE 24 (Serial Nos. 87692255 and 87692259) and 4 TTABVUE 18 (Serial No. 87721566).

third-party registration and website evidence that consumers may assume that the services offered by Applicant and Registrant emanate from the same source.

Applicant also points to unpublished Board decisions as supportive of its position that Applicant's and Registrant's services are unrelated.³³ However, in those cases, the Board found the Examining Attorney's evidence of relatedness (third-party registration and website evidence, when provided) insufficient. Those circumstances are not present in this case, as here, the Examining Attorney's third-party registration and website evidence establishes that the services are related and could emanate from the same source. In any event, it is well established that each case must stand on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). "[P]rior decisions in trademark cases, where the issue is a likelihood of confusion, furnish meager assistance in the resolution of that issue. Each case must be decided on the basis of the factual situation thereby presented." *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419, 421 (CCPA 1965).

As to classes of purchasers, in the identification, Applicant has restricted its purchasers to "high wealth individuals and families" while Registrant's services have no such restriction. We note that when the services are unrestricted to any particular classes of consumers, it is assumed that they are sold to all potential purchasers. As

³³ Six unpublished cases were mentioned in the briefs in Serial Nos. 87692255 and 87692259, and nine unpublished cases were mentioned in the briefs in Serial No. 87721566. Although parties are permitted to cite to any Board decision, citation to non-precedential decisions is not encouraged and such decisions are not binding on the Board. *See In re Soc'y of Health & Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018) ("Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold.").

indicated above, Applicant argues that its services target different consumers than those of the Registrant. Specifically, Applicant argues that its services are directed to high wealth individuals looking for wealth management while Registrant's services would be directed to a small businesses.³⁴

However, we note that Registrant's services include "financial transaction services, namely, providing secure commercial transactions and payment options," which would include credit and debit card services and electronic and mobile payment services that can be offered to general consumers, including high wealth individuals seeking Applicant's services.³⁵ We further note that while the website evidence submitted by the Examining Attorney does show that Registrant's payment processing services would be directed to businesses, including small businesses, business owners may also be "high wealth individuals" that would seek Applicant's wealth management services. *See e.g., Volkswagenwerk Aktiengesellschaft v. Ridewell Corp. Aktiengesellschaft v. Corp.*, 201 USPQ 404, 408 (TTAB 1978) (applicant's

³⁴ Applicant's reply brief, 11 TTABVUE 9 (Serial Nos. 87692255 and 87692259); Applicant's supplemental brief, 15 TTABVUE 9 (Serial No. 87721566).

³⁵ In its brief, Applicant references Registrant's specimens that it made of record in its July 21, 2020 Request for Reconsideration, at TSDR 34-37, and states that Registrant's commercial transaction and secure payment services allow Registrant's customers (salons, spas and beauticians) "to store customers' credit card information and charge the customer for their appointment automatically once the appointment is over." Applicant's brief, 8 TTABVUE 6-7 (Serial Nos. 87692255 and 87692259) and 4 TTABVUE 6-7 (Serial No. 87721566).

The problem with this argument and extrinsic evidence is that these details are not reflected in Registrant's identification of services. In fact, Applicant's extrinsic evidence is irrelevant, because we must base our decision on the services identified in the involved applications and cited registration, rather than what the extrinsic evidence shows the scope of those services to be. *Octocom Sys., Inc. v. Houston Comps. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

arguments to the effect that the parties' trade channels and classes of purchasers are wholly distinct ignores the probability that people in the trucking business as manufacturers, dealers, distributors and operators may also be or have been purchasers of opposer's automobiles, buses and trucks). Therefore, we find that the prospective customers of Applicant's and Registrant's services are not completely different. Instead, we find that there is an overlap between Applicant's and Registrant's potential customers, and these include high net worth individuals.

As to trade channels, neither the applications nor the cited registration contain restrictions as to trade channels, and therefore the services must be assumed to travel in all the normal channels of trade for services of this nature. *See Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). The only evidence relating to the trade channels through which the services at issue travel is the third-party website evidence submitted by the Examining Attorney, discussed above.

Applicant argues that the website evidence provided by the Examining Attorney does not show that the services are related, or marketed in ways to cause confusion as to source because the web pages are from national and international banks that "offer every financial service under the sun" or a "laundry list" of services and "are like the big box stores or department stores of the financial services industry."³⁶ Applicant points to the listing of the services on separate sub-sites (e.g., Business or

³⁶ Applicant's brief, 8 TTABVUE 23-24, and reply brief 11 TTABVUE 10 (Serial Nos. 87692259 and 87721566); Applicant's supplemental brief, 15 TTABVUE 5 (Serial No. 87721566).

Small Business vs. Personal or Investment Management or Wealth) and directed to different consumers i.e., individuals in need of financial advice versus business owners in need of merchant services.³⁷

Applicant submits that the sub-sites for these services on the banking websites are “the digital equivalent of separating out related goods into isles in a supermarket or departments in a department store.”³⁸ Applicant argues that the website evidence demonstrates that it is unlikely consumers from one consumer group will explore the other sub-sites offering different services.³⁹

Applicant focuses on the merchant payment processing web page evidence submitted by the Examining Attorney. We note, however, that the Examining Attorney also submitted web pages featuring links to investing and credit/debit card and electronic payment services on the same web page; even Applicant submitted evidence of a financial institution featuring mobile payments and links to investment services on the same web page. For example, the HSBC web page evidence shows links for “bank accounts” and “cards” and “investing and retiring” on one page, and another page for mobile payments also has links to “investing.”⁴⁰ The Wells Fargo website shows links for “checking and credit cards,” “investment and retirement,” and

³⁷ Applicant’s brief, 8 TTABVUE 23, and reply brief, 11 TTABVUE 8 (Serial Nos. 87692255 and 87692259); Applicant’s supplemental brief, 15 TTABVUE 10 (Serial No. 87721566).

³⁸ Applicant’s reply brief, 11 TTABVUE 8 (Serial Nos. 87692259 and 8772156); Applicant’s supplemental brief, 15 TTABVUE 10 (Serial No. 87721566).

³⁹ Applicant’s brief, 8 TTABVUE 23 and reply brief 11 TTABVUE 9 ((Serial Nos. 87692255 and 87692259); Applicant’s reply brief, 11 TTABVUE 9, and supplemental brief, 15 TTABVUE 10 (Serial No. 87721566).

⁴⁰ January 21, 2020 Office Action at TSDR 2; Request for Reconsideration July 21, 2020 at TSDR 214 (Serial Nos. 87692259 and 8772156).

“wealth management” on the same web page.⁴¹ Bank of America shows “banking and credit cards” and “investment” links on the same web page.⁴² Charles Schwab shows links to credit cards and investment services on the same web page.⁴³ Citibank shows “online bill pay,” payments made through PopMoney and Zelle, and links to credit cards and investing on the same web page.⁴⁴ The Chase private banking web page includes links to banking, credit cards and investing, and the Chase bank website includes links to credit cards, prepaid cards, investing and checking accounts.⁴⁵ Other than the investment services, the types of services listed on these web pages fall under Registrant’s broadly identified services of “providing secure commercial transactions and payment options.” Further, the financial institution name is prominently displayed on all web pages for the services, including merchant payment processing services.

As shown by the website evidence, and as argued by the Examining Attorney, many financial institutions offer a variety of banking, payment, and investment services, and prospective consumers will be accustomed to seeing the offering of these services by the same financial institution under the same or similar marks.⁴⁶

⁴¹ January Office Action 21, 2020 at TSDR at 3.

⁴² *Id.* at TSDR 6.

⁴³ October 11, 2018 Office Action at TSDR 3.

⁴⁴ *Id.* at TSDR 7.

⁴⁵ *Id.* at TSDR 8-9.

⁴⁶ October 11, 2018 Office Action at TSDR 4-5, 9-12; January 21, 2020 Office Action at TSDR 2, 3, 6; October 6, 2020 Denial of Reconsideration at TSDR 7, 35, 37, 62.

Therefore, the website evidence represents a relationship stronger than Applicant suggests to those of unrelated goods offered within a large department store, and shows that financial institution websites feature the services of both Applicant and Registrant under similar designations and links on the same web page. *See Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (in considering whether pet and human food are related, the Board erred in not considering evidence that “several large [third-party] companies produce and sell both pet and human food”).

We find that services are related, and the channels of trade and classes of consumers may overlap. Accordingly, the second and third *DuPont* factors weigh in favor of a finding of likelihood of confusion.

II. Conclusion

We find the marks are similar, the services are related and the channels of trade and classes of consumers overlap. Therefore, we find confusion likely.

Decision: The refusals to register Applicant’s



, and



marks on the ground of

likelihood of confusion pursuant to Trademark Act Section 2(d) are affirmed.