

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 9, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Heritage Bank*

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Serial No. 88540253

Nichole T. Hayden of Nelson Mullins Riley & Scarborough LLP  
for Heritage Bank.

Max Faucette, Trademark Examining Attorney, Law Office 107  
J. Leslie Bishop, Managing Attorney.

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Before Zervas, Wolfson, and Goodman,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Heritage Bank (Applicant) seeks registration on the Principal Register of the mark HERITAGE SOUTHEAST BANK (“BANK” disclaimed) for “banking services” in International Class 36.<sup>1</sup> The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark, as applied to the services identified in the application, so resembles the registered mark

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<sup>1</sup> Serial No. 88540253 was filed on July 26, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.



(“BANK” disclaimed) for “banking services” in International Class 36, as to be likely to cause confusion, mistake or deception of relevant purchasers.<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

#### **I. Likelihood of Confusion**

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers those *DuPont* factors for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case.” *Stratus Networks, Inc. v. UBTA-UBET Communs. Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, \*7 (Fed. Cir. 2020).

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<sup>2</sup> Registration No. 4772161, issued on July 14, 2015. The description of the mark reads: “The mark consists of the words ‘SouthEast’ appearing in large upper and lower case lettering with the word ‘South’ in green and the word ‘East’ in blue, with the word ‘bank’ appearing in smaller lower case lettering in black beneath the word ‘East.’” The colors green, blue and black are claimed as features of the mark.

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Two key considerations are the similarities between the marks and the similarities between the services. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

#### **A. The Services**

We begin our analysis with a comparison of the services under the second *DuPont* factor. We base our determination on the similarity or dissimilarity of the services as identified in Applicant’s application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). Because Applicant’s and Registrant’s services are each identified as “banking services,” and are thus identical, the second *DuPont* factor favors a finding of likely confusion. *See also Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Hewlett-Packard Co.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

## **B. Trade Channels and Classes of Purchasers**

The third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. Because Applicant’s and Registrant’s services are identical, we must presume that they move through the same channels of trade and are sold to the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (where services are identical, Board is “entitled to rely on this legal presumption in determining likelihood of confusion”). *See also Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

Accordingly, the third *DuPont* factor weighs in favor of likely confusion.

## **C. Strength of Registrant’s Mark**

We examine the strength of Registrant’s mark to determine the scope of protection to which it is accorded. Applicant argues that “southeast bank” is a weak component of Registrant’s mark, and that Registrant “likely filed it in stylized form (using certain fonts, colors, capitalization, etc.) because it did not believe the simple word mark ‘south east bank’ or ‘southeast bank’ was a strong mark. Further, the owner likely filed the mark in color, using a color claim, to further create some distinctiveness in the mark due to the inherent weakness of the wording alone.” 4 TTABVUE 13.

We initially note that Registrant’s mark issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act.

Accordingly, it is entitled to a presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), and “moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.” *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).

We also note there is scant evidence of record demonstrating that third parties use marks identical or similar to the cited mark for identical or similar services. Applicant submitted a copy of a page from the Federal Deposit Insurance Corporation (FDIC) of a search of “institutions as of January 22, 2020” that lists 6 banks:<sup>3</sup>

- SouthEast Bank (Registrant)
- Heritage Southeast Bank (Applicant)
- Southeastern Bank (of Georgia)
- FIRST STATE BANK OF THE SOUTHEAST, INC. (of Kentucky)
- First Southeast Bank (of Minnesota)
- Southeast First National Bank (of Georgia)

No information is provided regarding the significance of the list. However, to the extent Applicant has provided this as evidence of weakness, it is not persuasive because of the limited information provided by the list. It is unclear whether the banks in the list are related or share common ownership. Even if the report accurately reflects market use other than Applicant and Registrant, there are only four other banks with “southeast” in their names. This small number does not show that the cited SOUTHEAST BANK mark is weakened by any third-party uses.

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<sup>3</sup> March 5, 2020 Request for Reconsideration, TSDR 8.

Applicant also submitted copies of fifteen third-party registrations for marks containing the term SOUTHEAST, SOUTHWEST, or NORTHWEST in support of its argument that the phrase “southeast bank” is weak.<sup>4</sup> The evidence is unconvincing.

Third-party registrations based on use can demonstrate “the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *Institut National Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). *See also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). However, the extent to which third-party use-based registrations bear on our determination of the cited mark’s strength depends on the number of such registrations, the level of similarity between the involved marks, and the closeness of the goods or services recited in the third-party registrations vis-à-vis those in the cited registration. *See In re i.am.symbolic*, 123 USPQ2d at 1751. Third-party registrations for unrelated goods are of limited probative value. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009).

Of the fifteen third-party registrations filed by Applicant, only six are for banking services.<sup>5</sup> Only one of these six contains the term SOUTHEAST. The others are for marks that use the terms SOUTHWEST or NORTHWEST:

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<sup>4</sup> *Id.*, TSDR 9-45.

<sup>5</sup> Five of the remaining registrations cover unrelated services such as real estate brokerage services and charitable fundraising. Four registrations are for various financial services;

- Reg. No. 4933862 – SOUTHEAST WEALTH MANAGEMENT (of Tennessee)
- Reg. No. 3534890 – SOUTHWEST BANK (of Texas)
- Reg. No. 2773674 – FIRST NATIONAL BANK SOUTHWEST (of Nebraska)
- Reg. No. 5223498 – NORTHWEST BANK (of Pennsylvania)
- Reg. No. 4788788 – NORTHWEST BANK (of Oregon)
- Reg. No. 4884952 – NORTHWEST FARM CREDIT SERVICES

Based on this record, the cited SOUTHEAST BANK mark does not demonstrate weakness. *Compare Citigroup*, 98 USPQ2d at 1257 (Board considered forty different websites for banking entities whose names contained the term “City Bank”; no likelihood of confusion was found) *with Guild Mortg. Co.*, 2020 USPQ2d 10279, \*10 (TTAB 2020) (Board considered six third-party registrations for financial services; likelihood of confusion found).<sup>6</sup>

#### **D. Similarity of the Marks**

Under the first *DuPont* factor, we determine the similarity or dissimilarity of the marks “by focusing on the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Stone Lion*, 110 USPQ2d at 1160 (internal citations omitted). *See also Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). Where, as here, the Applicant’s and Registrant’s marks appear on identical services, “the degree of similarity necessary to support a conclusion of likely confusion

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these marks contain additional wording or design elements that distinguish them from the cited mark.


<sup>6</sup> Moreover, the third-party registrations here are far fewer in number than that in *Jack Wolfskin* and *Juice Generation*, the latter case which addressed over twenty uses or registrations of the same phrase for restaurant services. *Juice Generation*, 115 USPQ2d at 1673 n.1.

declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Although “our analysis cannot be predicated on dissecting the marks into their various components,” *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, \*4 (TTAB 2020), “in articulating reasons for reaching a conclusion on the issue 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 Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant’s mark is HERITAGE SOUTHEAST BANK. The cited mark is SOUTHEAST BANK in a stylized format, with a green, blue and black color scheme. Likelihood of confusion has frequently been found where one mark incorporates the



entirety of another mark. *See, e.g., In re Chatham Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (JOSE GASPAR GOLD for tequila confusingly similar to GASPAR'S ALE for beer and ale); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL for gin confusingly similar to the mark  (BENGAL LANCER and design) for nonalcoholic club soda, quinine water and ginger ale); *In re SL&E Training Stable, Inc.* 88 USPQ2d 1216, 1219 (TTAB 2008) (SAM EDELMAN for luggage and handbags confusingly similar to EDELMAN for handbags). Here, Applicant's mark incorporates the entire literal portion of Registrant's mark, and the remainder of Registrant's mark is simply a common lettering style in a particular color scheme.

This difference in lettering style and color scheme is immaterial because Applicant has applied to register its mark in standard characters. It is not limited to any particular font style, size, or color. 37 C.F.R. § 2.52(a). Applicant may display its mark in a script similar to Registrant's, and in a green, blue and black color scheme. *See, e.g., Viterra*, 101 USPQ2d at 1908 (holding that the specific font style of a mark cannot serve as the basis to distinguish it from a mark in standard character form); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citing *Citigroup*, 98 USPQ2d at 1259).

Applicant argues that the term HERITAGE is the “dominant element” in its mark, capable of distinguishing it from the cited mark. 4 TTABVUE 11.<sup>7</sup> We agree that as the first term in the mark, HERITAGE is visually prominent. Nonetheless, in evaluating the similarity of the marks, we must regard them as a whole. The marks share the term SOUTHEAST BANK. The disclaimer of “bank” does not remove the term from the marks. *See, e.g., Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 70 F.2d 1565, 218 UPSQ2d 390, 392 (Fed. Cir. 1983) (“[I]t is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion.”). We evaluate the overall impressions of the marks from the perspective of the purchasing public, which “is not aware that certain words or phrases have been disclaimed.” *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004). Comparing the marks in their entireties, we find them to be more similar than dissimilar in appearance, pronunciation, connotation and commercial impression.

In sum, we find that the non-literal components (the lettering style and color scheme) of Registrant’s mark visually distinguishes it only slightly from Applicant’s mark. Moreover, and more importantly, we find the sight, sound, connotation, and overall commercial impression of the two marks considered as a whole to be more similar than dissimilar. The first *DuPont* factor, similarity of the marks, favors a finding that confusion is likely.

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<sup>7</sup> Citations to the record are to the Trademark Status and Document Retrieval (TSDR) page in the prosecution history of Applicant’s application, and to TTABVUE, the docket history system for the Trademark Trial and Appeal Board.

## II. Balancing the Factors

After considering all of the arguments and evidence of record as they pertain to the relevant *DuPont* factors, we find that the marks are substantially similar in sight, sound, connotation and commercial impression. We further find that the services are identical and will travel through identical channels of trade to the same classes of consumers. Applicant has not demonstrated any particular weakness of SOUTHEAST BANK as a source indicator. Accordingly, we find that there is a likelihood of confusion between Applicant's mark HERITAGE SOUTHEAST BANK

and the cited mark  for banking services.

**Decision:** The refusal to register Applicant's mark under Trademark Act Section 2(d) is affirmed.