Mailed: June 6, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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First Niagara Insurance Brokers, Inc.
v.
First Niagara Financial Group, Inc.

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Opposition Nos. 91122072, 91122224, 91122193, 91122450, 91122712, 91150237[1]

ON REMAND
From
Court of Appeals for the Federal Circuit

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George Gottlieb and Barbara Loewenthal of Gottlieb, Rackman & Reisman for First Niagara Insurance Brokers, Inc.

Paul I. Perlman and David L. Principe of Hodgson Rush for Niagara Bancorp.

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Before Sams, Walters and Walsh, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

First Niagara Insurance Brokers, Inc. filed its oppositions, based on priority and likelihood of

[1] These six oppositions were consolidated by the Board's order of June 12, 2002.

confusion, to the applications of First Niagara Financial Group, Inc. listed infra. On October 21, 2005, the Board issued its decision (77 USPQ2d 1334) dismissing the oppositions and concluding that opposer had not established use of its pleaded marks on insurance brokerage services rendered in a type of commerce regulable by Congress and that, therefore, opposer could not establish its priority and could not prevail on its claim of likelihood of confusion.

Opposer sought review of the Board's decision before the Court of Appeals for the Federal Circuit (Case No. 06-1202). On January 9, 2007, the Court issued a decision (476 F.3d 867, 81 USPQ2d 1375) finding that "[t]he record unquestionably reveals more than ample use of [opposer's] marks in the United States to satisfy the use requirements of Section 2(d)"[2] (id. at 1378) and reversing and remanding the Board's decision "for further proceedings consistent with this opinion" (id.).

Applicant's Motion for Additional Briefing and Argument

Following the Court's decision, applicant filed with the Board its motion for permission for additional

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[2] The Court concluded that the Board incorrectly assumed that opposer needed to establish use of its marks in connection with services rendered in commerce lawfully regulated by Congress; rather, "a foreign opposer can present its opposition on the

briefing and oral argument regarding likelihood of confusion, and opposer filed its opposition to the motion.[3] Applicant acknowledges that the parties previously briefed the issues of priority and likelihood of confusion and contends that, at oral argument, the Board's questioning "focused almost exclusively on the first issue, whether [opposer] had established use of its mark in commerce"; that the Board did not address the issue of likelihood of confusion in its decision; and that the court "did not disturb any of the factual findings contained in the Board's decision" (motion brief at 2-3). Thus, applicant seeks further briefing "to discuss how the Board's previous factual findings … affect the application of the *du Pont* factors" (id. at 4) and requests further oral argument to allow the Board to question the parties on the issue of likelihood of confusion.

Applicant's motion is denied. We agree with opposer that there is no requirement in the Federal Rules, Board Rules or precedent for additional briefing or oral argument when the Federal Circuit reverses and remands a decision of the Board. Further, both

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merits by showing only use of its mark in the United States" (supra at 1378).

[3] Applicant also filed a reply brief, which we have considered.

parties' briefs on the case included discussion of the issue of likelihood of confusion and both parties had an opportunity to address the issue of likelihood of confusion at the oral argument on the case. Similarly, there is also no requirement in rules or precedent for briefing by the parties on the Board's factual findings from its earlier decision prior to the Board's consideration of the issues on remand from the Court. The Board, in its earlier decision, already permitted the parties to exceed the briefing page limits and we do not find additional briefing or argument to be necessary.

Priority and Likelihood of Confusion Analysis

We now proceed to a determination of the issue of priority and likelihood of confusion on the merits, based on the opinion of the Court remanding this case to the Board.

As stated in our earlier decision, the consolidated oppositions pertain to the following applications:

Application No. 75890902
Opposition No. 91122072
Mark: FIRST NIAGARA
Services:
IC 035: leasing of office equipment
IC 036: banking services; insurance services, namely, insurance brokerage, insurance agencies, insurance administration and insurance consultation, in the fields of life,

property and casualty, accident, health and other insurance; credit insurance services; financial services, namely, financial and investment consulting, management and advisory services; investment and securities brokerage services; providing information on investment and securities performance; annuities services; charitable fund raising services

IC 037: leasing of construction equipment and building machinery

IC 039: leasing of motor vehicles

Filing Date: January 7, 2000
Basis: 1b
Disclaimer: FIRST

Application No. 75891547
Opposition No. 91122224
Mark: FIRST NIAGARA FINANCIAL GROUP
Services:

IC 035: leasing of office equipment

IC 036: banking services; insurance services, namely, insurance brokerage, insurance agencies, insurance administration and insurance consultation, in the fields of life, property and casualty, accident, health and other insurance; credit insurance services; financial services, namely, financial and investment consulting, management and advisory services; investment and securities brokerage services; providing information on investment and securities performance; annuities services; charitable fund raising services

IC 037: leasing of construction equipment and building machinery

IC 039: leasing of motor vehicles

Filing Date: January 7, 2000
Basis: 1b
Disclaimer: FIRST and FINANCIAL GROUP

Application No. 75890903
Opposition No. 91122193
Mark:

Services:
IC 035: leasing of office equipment
IC 036: banking services; insurance services, namely, insurance brokerage, insurance agencies, insurance administration and insurance consultation, in the fields of life, property and casualty, accident, health and other insurance; credit insurance services; financial services, namely, financial and investment consulting, management and advisory services; investment and securities brokerage services; providing information on investment and securities performance; annuities services; charitable fund raising services
IC 037: leasing of construction equipment and building machinery
IC 039: leasing of motor vehicles
Filing Date: January 7, 2000
Basis: 1b
Disclaimer: FIRST

Application No. 76004229
Opposition No. 91122450
Mark: FIRST NIAGARA ONLINE
Services:
IC 036: banking services, namely, providing electronic banking services to customers via a global computer network
Filing Date: March 20, 2000
Basis: 1b
Disclaimer: ONLINE

Application No. 76029614
Opposition No. 91122712
Mark: FIRST NIAGARA BANK'S CUSTOMER CONNECTION LINE
Services:
IC 036: retail banking services
Filing Date: April 18, 2000

Basis: 1b
Disclaimer: BANK'S and LINE

Application No. 76005479
Opposition No. 91150237
Mark: FIRST NIAGARA E-CD
Services:
IC 036: banking services, namely, providing electronic banking services to customers via a global computer network
Filing Date: March 20, 2000
Basis: 1b
Disclaimer: E-CD

The oppositions are based, as noted in the Board's earlier decision, on opposer's claim of likelihood of confusion with its previously used marks FIRST NIAGARA and FIRST NIAGARA INSURANCE BROKERS, in standard character format, and FIRST NIAGARA INSURANCE BROKERS INC., in the design format shown below ("FIRST NIAGARA marks"), for "insurance brokerage services and other financial services."

Applicant, in each of its answers, denied the salient allegations of the claim and, in Opposition No. 91122072 only, pertaining to the standard character mark FIRST NIAGARA, applicant admitted that "to the extent that opposer uses FIRST NIAGARA as a trademark, FIRST NIAGARA is identical to" the mark FIRST NIAGARA that applicant seeks to register. Applicant's

affirmative defense regarding opposer's use of its marks in commerce is now moot and has been given no further consideration in view of the Court's determination that such use in not necessary to support a claim of likelihood of confusion under Section 2(d) of the Trademark Act.

Findings of Fact

The findings of fact in the Board's decision of October 21, 2005, were not disturbed by the Court's decision and are incorporated by reference herein. We also make the following additional findings of fact:

- Applicant chose its mark FIRST NIAGARA for banking and financial services in December 1999 to replace Lockport Savings Bank and Niagara Bancorp, and first used it as a mark on January 7, 2000. (Applicant's Answers to Opposer's Interrogatories No. 4(a).)
- We take judicial notice of the commonly-known facts that Niagara Falls is a famous waterfall located on the U.S.-Canadian border; that the towns of Niagara Falls and Niagara-on-the-lake are located near Niagara Falls in Ontario, Canada; and that the U.S. town of Niagara Falls, New York, is located near Niagara Falls and directly opposite the town of Niagara Falls, Ontario. (See

RoadMaster Standard Road Atlas, Barnes & Noble Publishing Inc. & MapQuest.com, 2005.)

Priority

The Court, in its opinion, stated that "[t]he record unquestionably reveals more than ample use of [opposer's] marks in the United States to satisfy the use requirements of Section 2(d)." (81 USPQ2d 1375, 1378.) The Board has found that "[o]pposer adopted its present name in 1984 and has used it continuously from that date as a mark in connection with its insurance services" (77 USPQ2d 1334, 1336); and that "[I]n January 1999, applicant was acquired by Lockport Savings Bank; [and] in November 2002, applicant changed its name from Warren Hoffman Associates, Inc., to First Niagara Risk Management, Inc., for which it obtained approval from the New York Department of Insurance" and it "is licensed … to offer insurance brokerage services in New York" (id. at 1339). The earliest filing date among applicant's applications is January 1, 2000, for the mark FIRST NIAGARA for insurance services, banking and various financial services, and various leasing services. Thus, this is the earliest date upon which applicant can rely.

Regarding priority, in order to prevail opposer must show not only that it has used its marks on its

services first but also that its marks are distinctive. *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

The NIAGARA portion of opposer's marks is, at least, highly suggestive of the location of its business. However, there is no evidence in the record that the phrase FIRST NIAGARA is merely descriptive or primarily geographically descriptive in connection with opposer's insurance services; and the record contains letters from clients showing their clear association of the pleaded marks with the source of opposer's insurance services. Additionally, applicant does not argue that opposer's marks are not inherently distinctive. Therefore, whether inherent or acquired, opposer has established the distinctiveness of its marks in connection with its services.

The same evidence clearly establishes opposer's priority of use of each of its pleaded marks in connection with its insurance services since long prior to the earliest filing date of the opposed intent-to-use applications.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Marks

We turn, first, to the marks of the parties, noting that opposer has three marks and applicant has

six marks involved herein. Opposer's three marks are FIRST NIAGARA, FIRST NIAGARA INSURANCE BROKERS INC., and 

. Applicant's six marks are FIRST NIAGARA (disclaimer of FIRST[4]), FIRST NIAGARA FINANCIAL GROUP (disclaimer of FIRST and FINANCIAL GROUP), FIRST NIAGARA ONLINE (disclaimer of ONLINE), FIRST NIAGARA BANK'S CUSTOMER CONNECTION LINE (disclaimer of BANK'S and LINE), FIRST NIAGARA E-CD (disclaimer of E-CD), and 

(disclaimer of FIRST). As discussed below, we find that the dominant portion of each of the parties' marks is FIRST NIAGARA.

In determining the commercial impressions of the marks, it is significant that each of the parties' marks begins with the term FIRST NIAGARA. *Palm Bay Imports, Inc. v. Veuve Clicquot*, supra at 1692 ("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also

[4] While three of the applications include a disclaimer of FIRST, the other three applications do not include a disclaimer of FIRST. We note that there is no other indication in the record that this term is merely descriptive in connection with the identified services and we decline to draw such a conclusion.

constitutes "the dominant feature" in the commercial impression created by Palm Bay's mark."). *See also Presto Products v. Nice-Pak Products*, 9 USPQ2d 1895, 1897 (TTAB 1998)(The fact that two marks share the same first word is generally "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

It is also significant that, except for one of applicant's marks, the additional wording in each of applicant's marks is merely descriptive and has been disclaimed. *See In re Code Consultants Inc.,* 60 USPQ2d 1699, 1702 (TTAB 2001) ("Applicant's disclaimed wording … while not ignored in the analysis, is highly descriptive of applicant's services and therefore less significant in creating the mark's commercial impression."). With regard to the undisclaimed CUSTOMER CONNECTION portion of applicant's mark FIRST NIAGARA BANK'S CUSTOMER CONNECTION LINE, the term CUSTOMER CONNECTION is part of the larger phrase CUSTOMER CONNECTION LINE and, as such, it is likely to be perceived as suggesting an important feature of the identified "retail banking services," i.e., customer service, and, thus it is less significant than the

initial term FIRST NIAGARA in creating the commercial impression of the mark.

The additional wording in opposer's marks is also merely descriptive, if not generic and, as such, it is less likely to be relied upon by prospective purchasers to distinguish the sources of the goods and services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting*, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'"). The phrase INSURANCE BROKERS INC. in opposer's mark FIRST NIAGARA INSURANCE BROKERS INC. identifies opposer as a business entity (INC.) and names the exact nature of opposer's business (INSURANCE BROKERS).

Applicant's design mark consists of the words FIRST NIAGARA in a nondistinctive script with a smaller design, in an oval, that is likely to be perceived as suggesting the waterfall at Niagara Falls, and essentially reinforces the connotation of the word NIAGARA in the mark. Design elements such as those appearing in applicant's mark are generally less important than the word portion of the mark in creating

an impression. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987), and cases cited therein.

A similar analysis applies to opposer's design mark consisting of the words FIRST NIAGARA INSURANCE BROKERS INC. in non-distinctive script with a design in an oval that also is likely to be perceived as suggesting the same waterfall, i.e., Niagara Falls. Again, the design is likely to be perceived as reinforcing the connotation of the word NIAGARA in the mark. While the word INSURANCE is the same size and font as FIRST NIAGARA, it appears below FIRST NIAGARA, which is together on one line, and INSURANCE is a generic term in connection with the insurance services rendered. FIRST NIAGARA remains the dominant portion of this mark as well.

Comparing the parties' marks, applicant accurately concedes that the mark FIRST NIAGARA in its Application Serial No. 75890902 is identical to opposer's FIRST NIAGARA mark. We also find that applicant's mark FIRST NIAGARA is substantially similar to opposer's marks FIRST NIAGARA INSURANCE BROKERS INC., both as a word mark and in its design format, in view of the dominance of FIRST NIAGARA in opposer's marks. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) "([M]inor design features do not necessarily

obviate likelihood of confusion arising from consideration of the marks in their entireties. Moreover, in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed").

We reach the same conclusion with regard to applicant's additional five marks. We find that the dominant portion, FIRST NIAGARA, of opposer's marks is identical to the dominant portion, FIRST NIAGARA, of applicant's marks; that the overall commercial impressions of the marks are substantially similar; and that, as discussed above, the additional wording and/or design element in each party's marks does not mitigate this similarity. Moreover, under actual marketing conditions, the public does not necessarily have the opportunity to make side-by-side comparisons between marks and, thus, minor differences between marks will not be discerned or remembered. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980).

We find that, with respect to each of the opposed applications, the factor of the similarities of the marks weighs strongly in opposer's favor. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

The Services

1. Application Serial Nos. 75890902, 75891547, 75890903 ("the insurance and leasing services applications").

First, we consider the three applications containing numerous services in International Class 36 and various leasing services in other International Classes. The record establishes that both parties render insurance brokerage, agency, administration and consultation services across a full range of personal and commercial insurance products. We find that the parties' insurance-related services are identical. Having found identity with one of applicant's services recited in International Class 36 in the insurance and leasing services applications, it is not necessary to consider the relationship, if any, of opposer's services to the other services identified in International Class 36 in these applications. Thus, this factor weighs strongly in opposer's favor with respect to the identified services in International Class 36 in these three applications.

The identifications of services in these same three applications also include the leasing of office equipment in International Class 35, the leasing of construction equipment and building machinery in

International Class 37, and the leasing of motor vehicles in International Class 39. There is no evidence in the record that opposer renders such services or that the insurance services opposer does render are sufficiently related to these identified leasing services that confusion as to source would be likely if these services of the respective parties were identified by similar marks. In fact, there is no evidence at all with respect to any relationship between insurance services and the identified leasing services. Thus, this factor weighs in applicant's favor for the identified services in International Classes 35, 37 and 39 in these three applications.

2. Application Serial Nos. 76029614, 76004229 and 76005479 ("the banking services applications").

Next, we consider the services in the remaining three applications, which include only banking services in International Class 36. Application Serial No. 76029614 identifies services in International Class 36 that are broadly worded and, thus, pertain to all "retail banking services." Application Serial Nos. 76004229 and 76005479 identify services in International Class 36 that are broadly worded and, thus, pertain to all "… electronic banking services to

customers via a global computer network." To the extent that opposer renders "other financial services" as pleaded, the record indicates that such services are essentially aspects of its insurance services, such as the sale of annuities contracts.

Regarding the banking services applications, opposer contends that "it is well established that 'banking services' are related to insurance services," (brief, p. 37), citing *In re United California Brokers, Inc.*, 222 USPQ 361 (TTAB 1984) and *John Hancock Mutual Life Insurance Co. v. John Hancock Mortgage of Ill.*, 219 USPQ 91 (N.D. Ill. 1982). Neither case is directly analogous to the cases herein, nor do these cited cases establish a per se rule that banking services are related to insurance services. Rather, we must consider the specific banking services recited in each of the banking services applications and the services in connection with which opposer has shown use of its marks.

In the *United California Brokers* case cited by opposer, the Board affirmed a Section 2(d) refusal, finding a relationship between applicant's services, identified as "brokerage services in the field of real estate, insurance, agricultural commodities, stocks and bonds, mortgages and loans and other personal property"

and the registrant's "banking services." The Board noted that "while bank services do differ in many respects from those provided by applicant, we find the common involvement of banks and of applicant's type of brokerage enterprise with mortgages and loans to be a sufficient area of overlap to permit characterization of the services of applicant and registrant as so related that use of identical or highly similar marks in connection therewith would be likely to generate confusion." (222 USPQ 361 at 362.) Opposer has not established an analogous "common involvement" between its insurance services and the banking services identified in the three applications herein.

In the *John Hancock* case cited by opposer, the court found defendant's intent to trade on plaintiff's well known mark to be most significant, stating that "in conjunction with its insurance business plaintiff has made first mortgages throughout this country since at least 1953, … [with] its most prominent mortgage venture here [being] the John Hancock building in Chicago" (219 USPQ 91 at 92); and that "the evidence suggests that the name was adopted [by defendant] deliberately to obtain some advantage from the goodwill plaintiff had created, and that any future competitive use will occur in the context of plaintiff's

substantial mortgage activities in Illinois" (id. at 93). Opposer has established neither the renown of its mark comparable to the John Hancock mark in the cited case, nor an intent of applicant to trade on any goodwill that opposer may have developed in its marks in connection with insurance services in the United States.

Opposer also argues that "it is irrelevant that, in addition to providing insurance services, [applicant] lists additional financial services in some of its applications … [because] so long as the junior user's description of goods or services overlaps with the senior user's goods or services as it does here, the goods' similarity will weigh in favor of finding likelihood of confusion" (id.), citing *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 USPQ 269, 272 (TTAB 1980). Opposer's attempt to apply this principle to the leasing services in the insurance and leasing services applications, or to the banking services applications is misplaced. The principle enunciated in the *Jay-Zee* case is inapplicable either to the leasing services, which are in different International Classes and which are treated as being legally separate applications, from the insurance services in the insurance and

leasing services applications, or to the services identified in the banking services applications.

The *Jay-Zee* case was a cancellation proceeding wherein petitioner established use of its mark in connection with various clothing items, including sport shirts for young and teenaged boys; and the goods identified in respondent's registration were "men's and boys' sport shirts." The Board found that there was a likelihood of confusion due to the similarities between the marks and the overlapping nature of "boys sport shirts," in respondent's registration, and "young and teenaged boys" sport shirts manufactured by petitioner; and that it was irrelevant that respondent's goods included, in the same class, "men's" sport shirts (which petitioner did not manufacture). In the case before us, opposer must prove a relationship between its insurance services and applicant's identified leasing services in the insurance and banking services applications and applicant's identified banking services in the banking services applications, which do not include insurance services in the recitations.

Regarding the banking services in these three applications, we find insufficient evidence in the record to establish a connection between opposer's insurance services and either applicant's retail

banking services or its "… electronic banking services to customers via a global computer network." Opposer's testimony that it sells annuity contracts as part of its insurance business was vague, with no details as to the number of such contracts, the percentage of its business devoted to such sales, or whether or to what extent sales of annuity contracts would be related in any manner to applicant's identified banking services. Nor does the fact that applicant seeks to register its mark for both insurance and banking services require, without more evidence, a conclusion that the services are related such that confusion would be likely. Thus, this factor weighs in applicant's favor for the identified banking services in International Class 36 in these three applications.

Actual Confusion

Opposer asserts that the record contains significant evidence of actual confusion with respect to the source of the parties' insurance services, noting that from July 2000 to July 2002 opposer received 2600 emails intended for applicant; and that this actual confusion weighs strongly in its favor.

Applicant admitted that it was aware that its clients, believing that opposer was applicant, had mistakeningly sent emails to opposer. (Opposer's

notice of reliance on applicant's response to opposer's request for admissions, no. 81.) However, applicant contends that the misdirected emails are explained by the similarities in the parties email addresses rather than any confusion as to the source of the parties' insurance services, i.e., opposer's domain name and address is "firstniagara.com" and applicant's domain name and address is "first-niagara.com."

While concurrent use of confusingly similar marks over a period of time in the same geographic area without any evidence of actual confusion may weigh against a holding of likelihood of confusion, *see, G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990), "[a] showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion." *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317, 65 U.S.P.Q.2d 1201, 1205 (Fed. Cir. 2003). *See also* 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition,* Section 23:13 at 23-35.

Facts characterized as evidencing actual confusion must be viewed in the context of the entire factual record. In some cases the proposed instances of actual confusion may be de minimis, vague, or represent confusion due to some factor other than any

similarities in the marks. See, *e.g., Nautilus Group Inc. v. ICON Health and Fitness Inc.*, 372 F3d 1330, 71 USPQ2d 1173, 1179-1180 (Fed. Cir. 2004)[number of misdirected phone calls too small and too many ambiguities as to cause of confusion, i.e., similarity of marks versus similarity of products, to establish actual confusion]; and *Lang v. Retirement Living Publishing Co.,* 949 F. 2d 576, 21 U.S.P.Q.2d 1041, 1046 (2d Cir. 1991), [actual confusion demonstrated in record, i.e., 400 misdirected phone calls, was not material in view of the factual circumstances; and no evidence that this confusion could inflict commercial injury in the form of either a diversion of sales, damage to goodwill, or loss of control over reputation].

In the cases before us, in view of the fact that both parties are relatively small local businesses, the number of misdirected emails is significant. However, this problem occurred during a two-year period commencing shortly after opposer implemented its new email system using the "firstniagara.com" domain name (Exh. 55 to Michael Maves Testimony), and it is clear that the parties have substantially similar domain names and addresses. There is only one keystroke difference in these addresses, so at least some of the

errors are likely to be attributable to typing error. A review of the sample emails (Exh. 56 to Michael Maves Testimony) shows that all were addressed to specific individuals within applicant's company and the text of the emails referenced, for example, follow-ups to meetings that occurred between the email sender and applicant or inquiries about job openings advertised by applicant. None were individuals or businesses in search of insurance policies.

Both parties acknowledge that no policies were actually written as a result of any confusion that has occurred. Moreover, opposer is not licensed to render insurance services in New York State or any of the United States, nor is applicant licensed to render insurance services in Canada. Thus, although the parties offer the identical insurance services, the geographic scope of those services is not overlapping, and the opportunity for more than even initial interest confusion is extremely limited.[5] This lack of commercial injury or opportunity for such is not dispositive per se, but it is a significant factor in this particular highly regulated industry.

[5] We note that such an opportunity is not entirely absent because opposer, upon being mistakenly contacted by applicant's potential client, could refer this client to a New York licensed insurance broker other than applicant for an insurance policy on persons or property with a nexus in New York state, or vice versa with respect to applicant.

Thus, while we find that the actual confusion shown in the record weighs in opposer's favor, the mitigating facts involved, as discussed herein, render this factor of limited probative value.

Intent

Opposer would have us conclude that the similarities in the marks and the geographic proximity of the parties' businesses to each other establish applicant's intent to trade on opposer's good will. However, as noted above, there is no evidence indicating that applicant had such an intent, nor will we draw this conclusion from the mere facts of both businesses using marks strongly suggestive of their respective geographic locations, especially where neither party is legally authorized to do business in the other's territory.

Trade Channels and Classes of Purchasers

With respect to the parties' insurance services, we must presume that the services of opposer and applicant are rendered in all of the normal channels of trade to all of the usual purchasers for such services. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the insurance services of opposer and applicant are rendered through the same channels of

trade to the same classes of purchasers. This factor favors opposer.

There is no evidence regarding the specific channels of trade for applicant's leasing and banking services. Therefore, we draw no conclusions in this regard.

With respect to all of the services involved, there is no indication in the record that the relevant public is more limited than the general public and businesses of all types, i.e., those persons and businesses looking for insurance, leasing and/or banking services. Thus, the classes of purchasers encompass persons and businesses of all levels of sophistication. This factor weighs in favor of a finding of likelihood of confusion. However, these types of services are likely to be utilized with some degree of care in view of the relative expense of insurance, the items to be leased and banking and the need to understand, for example, the type of insurance or banking product one will purchase. The care with which insurance, leasing and banking services are likely to be purchased mitigates against likelihood of confusion.

Conclusion

Balancing the relevant *du Pont* factors discussed herein, we conclude that the *du Pont* factors of the similarities or dissimilarities of the respective marks and services are most compelling. We conclude that, in view of the substantial similarities in the commercial impressions of opposer's and applicant's FIRST NIAGARA marks, their contemporaneous use on the identical insurance services involved in the three insurance and leasing services applications, with the same trade channels and classes of purchasers, is likely to cause confusion as to the source or sponsorship of such insurance services.

We also conclude that, despite the substantial similarities in the commercial impressions of the parties' marks, opposer has not established that its insurance services are sufficiently related to applicant's recited leasing and/or banking services that confusion as to source or affiliation is likely.

Decision: Opposition Nos. 91122072, 91122224 and 91122193 to, respectively, Application Nos. 75890902, 75891547 and 75890903 ("the insurance and leasing services applications") are each sustained as to the services in International Class 36, but dismissed as to the services in International Classes 35, 37 and 39.

Opposition Nos. 91122450, 91122712 and 91150237 to, respectively, Application Nos. 76004229, 76029614 and 76005479 ("the banking services applications") are dismissed.