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

Proceeding	91204456
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Intrust Financial Corporation,)	
)	
Opposer,)	
)	Opposition No. 91204456
v.)	Application Serial No.: 85/250992
)	Mark: NTRUST
nTrust Corp.,)	
)	
Applicant.)	
_____)	

**OPPOSER INTRUST FINANCIAL CORPORATION'S
BRIEF ON THE MERITS**

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Table of Contents

Table of Authorities	iii
INTRODUCTION	1
BRIEF DESCRIPTION OF THE PARTIES	1
DESCRIPTION OF THE RECORD	3
FACTUAL BACKGROUND	5
A. Trademarks Registered by Intrust	5
B. Intrust’s Advertising and Promotion of the INTRUST Marks.....	6
C. Intrust Banking Services Provided to Customers Through New Technology	8
D. nTrust’s Application to Register a Confusingly Similar Mark	10
STATEMENT OF THE ISSUE	10
POINTS AND AUTHORITIES	10
I. USE OF THE NTRUST MARK IS LIKELY TO CAUSE CONFUSION WITH RESPECT TO THE SOURCE, SPONSORSHIP, OR AFFILIATION OF THE SERVICES DESCRIBED IN THE APPLICATION	10
A. The Marks Essentially Are Identical	11
B. The Services Described In Intrust’s Registration And Ntrust’s Application Are Similar In Nature, Commercially Relatable, And Sold Through Identical Or Related Channels Of Trade	13
C. Actual Confusion Has Occurred.....	25
D. Intrust’s Marks Are Well Known And Entitled To A Broad	

Scope Of Protection.....	26
E. Intrust Has Successfully Opposed Similar Marks On Similar Services.....	28
F. Ntrust Has No Right To Exclude Others	30
G. The Extent Of Potential Confusion Is Substantial	30
II. THE <i>DUPONT</i> FACTORS THAT DO NOT FAVOR INTRUST ARE EITHER NON-APPLICABLE OR NEUTRAL	31
CONCLUSION	31
CERTIFICATE OF SERVICE	33

Table of Authorities

CASES:

<i>AMF, Inc. v. Am. Leisure Prods., Inc.</i> 474 F.2d 1403, 1406, 177 U.S.P.Q.2d (BNA) 268 (CCPA 1973).....	30
<i>Apple Computer v. TVNET.net, Inc.</i> 90 U.S.P.Q.2d 1393 (BNA), 2007 TTAB LEXIS 80 (2007).....	13
<i>Bose Corp. v. QSC Audio Prods, Inc.</i> 293 F.3d 1367, 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002)	27
<i>CAE, Inc. v. Clean Air Eng'g, Inc.</i> 60 U.S.P.Q.2d 1449, 1462 (BNA) (7 th Cir. 2001)	16
<i>Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Assoc.</i> 811 F.2d 1490, 1491 (Fed. Cir. 1987).....	14
<i>Citigroup, Inc. v. Capital City Bank Group, Inc.</i> 637 F.3d 1344, 1356, 98 U.S.P.Q.2d (BNA) 1253, 1261 (Fed. Circ. 2011)	25
<i>Corbett v. Devon Bank</i> 12 Ill. App. 3d 559, 572 (1973)	23
<i>Ecolab Inc. v. Sumecht NA Inc.</i> 2013 TTAB LEXIS 424 (July 29, 2013)	28
<i>Harry Winston, Inc. v. Bruce Winston Gem Corp.</i> 2014 TTAB LEXIS 284, *74-75, 111 U.S.P.Q.2d (BNA) 1419, 1440 (July 9, 2014)	27
<i>Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan</i> 165 U.S.P.Q. (BNA) 597, 1970 TTAB LEXIS 66, *25 (1970).....	13
<i>Imagineering, Inc. v. Van Klassens, Inc.</i> 53 F.3d 1260, 1265, 34 U.S.P.Q.2d (BNA) 1526, 1529 (Fed. Cir. 1995)	25
<i>iMedica Corp. v. Medica</i> 2007 TTAB LEXIS 140, *15-16 (June 7, 2007)	27
<i>In re Arcus Capital Partners, LLC</i> 2012 TTAB LEXIS 412, *9, *10-12, *18 and 26-27 (Oct. 26, 2012)	14, 17, 18, 19, 22

<i>In re Du Pont de Nemours & Co.</i> 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563, (C.C.P.A. 1973).	10, 11, 13, 27, 28, 30, 31
<i>In re E-Formis, LLC</i> 2014 TTAB LEXIS 127, *12 (Mar. 25, 2014)	13
<i>In re Laura Gellar Make-Up Studios, Ltd.</i> 2009 TTAB LEXIS 562, *6 (Aug. 13, 2009)	13
<i>In re Holding Co. of the Villages, Inc.</i> 2014 TTAB LEXIS 138, *21 (April 14, 2014)	29
<i>In re Hyper Shoppes (Ohio), Inc.</i> 837 F.2d 463, 464, 6 U.S.P.Q.2d (BNA) 1025 (Fed. Cir. 1988)	11
<i>In re Majestic Distilling Co.</i> 315 F.3d 1311, 1317, 65 U.S.P.Q.2d (BNA) 1201, 1205 (Fed. Cir. 2003)	25
<i>In re Mucky Duck Mustard Co., Inc.</i> 6 U.S.P.Q.2d (BNA) 1467, 1988 TTAB LEXIS 11, *9 (1988)	18
<i>In re Shell Oil Co.</i> 992 F.2d 1204, 1211, 26 U.S.P.Q. 2d (BNA) 1687, 1691 (Fed. Cir. 1993)	11
<i>In re SL&E Training Stable, Inc.</i> 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008)	11
<i>In re Smurr</i> 2013 TTAB LEXIS 533, *18 (Oct. 3, 2013)	31
<i>In re Sovena U.S.A., Inc.</i> 2009 TTAB LEXIS 635, *18 (Oct. 5, 2009)	30
<i>In re Viterra, Inc.</i> 671 F.3d 1358, 1367, 101 U.S.P.Q.2d (BNA) 1905, 1912 (Fed. Cir. 2012)	12
<i>Medica Health Plans v. Rousmaniere</i> 2008 TTAB LEXIS 620, *6 (May 7, 2008)	27
<i>O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.</i> 2012 TTAB LEXIS 70, *12 (March 8, 2012)	26
<i>Octocom Systems, Inc. v. Houston Computer Servs, Inc.</i> 918 F.3d 937, 942, 16 U.S.P.Q.2d (BNA) 1783 (Fed. Cir. 1990)	24

<i>Palm Bay v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> 396 F.3d 1369, 1371, 73 U.S.P.Q.2d (BNA) 1689, 1691 (Fed. Circ. 2005)	12
<i>Recot, Inc. v. Becton</i> 214 F.3d 1322, 1329, 54 U.S.P.Q.2d (BNA) 1894, 1898 (Fed. Circ. 2000).....	15
<i>Shen Mfg. Co., Inc. v. Ritz Hotels, Ltd.</i> 393 F.3d 1238, 1241, 73 U.S.P.Q.2d (BNA) 1350 (Fed. Cir. 2004)	11
<i>Time Warner Entertainment Co. L.P. v. Jones</i> 65 U.S.P.Q.2d 1650 (BNA), 2002 TTAB LEXIS 462, *29 (2002).....	15, 22
<i>World Carpets, Inc. v. Dick Littrell's New World Carpets</i> 438 F.2d 482, 489, 168 U.S.P.Q. (BNA) 609 (5 th Cir. 1971)	25

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**OPPOSER INTRUST FINANCIAL CORPORATION'S
BRIEF ON THE MERITS**

INTRODUCTION

The “NTRUST” mark requested by Applicant nTrust Corp. (“nTrust”) is near identical in appearance, phonetics, and meaning to the “INTRUST” marks registered and owned by Opposer Intrust Financial Corporation (“Intrust”). The products and services nTrust intends to offer under the “NTRUST” mark – e.g., Internet and mobile bill pay services that allow consumers to pay bills or transfer funds electronically and physical card products that allow consumers to make point of sale and online purchases – are near identical to the products and services that Intrust offers under its “INTRUST” marks. Because such near identicalness has caused actual confusion and is likely to cause further, Intrust’s opposition should be sustained and nTrust’s application should be denied registration.

BRIEF DESCRIPTION OF THE PARTIES

From a single branch opened in Wichita, Kansas, in 1876, Intrust Bank, N.A. (which is wholly owned by Opposer Intrust Financial Corporation)¹ has grown to become the largest independent bank in the state of Kansas. Intrust has physical branches in Kansas, Arkansas, and Oklahoma, and Intrust has customers living in all 50 states. Deposition of Lisa Elliott (“Elliott Depo.”) p. 62:7-21. Through substantial advertising and promotion, including sponsorship of the 15,000-seat Intrust Bank Arena, Intrust has developed a strong corporate identity and the marks it has registered that incorporate the INTRUST name – which it adopted in and continuously has used since 1993 – are valuable assets. Elliott Depo. pp. 28:25-29:3; 30:16-19; 79:6-16.

As a full-service bank, Intrust offers a wide variety of products and services designed to appeal to the modern consumer who demands more than just a checking account. As customers throughout the United States increasingly eschew banking at physical branches in favor of Internet and mobile banking, Intrust offers many such services, such as online billpay, Internet banking, and mobile check deposit. Deposition of Thomas Morrison (“Morrison Depo.”) pp. 7:22-9:3; 11:7-17; 12:3-11. It also offers a number of card-based products, including gift cards, reloadable payroll cards, and credit and debit cards. Morrison Depo. pp. 55:23-56:11; 57:2-11. Intrust continues to develop new electronic (or Internet-based) products and services that it plans to offer in the near future, including a way for individual customers to electronically send money to other individuals and a loadable card product designed to replace traditional traveler’s checks. Morrison Depo. pp. 69:11-22; 74:24-75:24; 79:25-80:9; 80:22-25. A key component of Intrust’s banking business therefore involves providing safe and convenient ways for customers to move their money in the Internet age.

¹ Opposer Intrust Financial Corporation is a bank holding company. Intrust Bank, N.A., is a wholly owned subsidiary of Opposer. Unless the context requires otherwise, throughout this brief both Opposer and Intrust Bank, N.A., are referred to as “Intrust.”

Applicant nTrust is a money service business that facilitates instant money transfers via the Internet and provides physical, reloadable cards for online and point of sale purchases. Deposition of Robert MacGregor (“MacGregor Depo.”) pp. 5:19-24; 8:24-9:5. Like Intrust customers, nTrust customers using a computer, smartphone, or tablet can access their accounts electronically to add money, pay bills, send money to individuals, or load money to a physical card that can be used wherever the MasterCard Acceptance Mark is displayed. Ex. A-6. nTrust advertises that it is “regulated like a bank” and provides “bank level security” for sending and spending money. Exs. A1; A-18; MacGregor Depo. pp. 100:19-102:19.

DESCRIPTION OF THE RECORD

In accordance with Rule 801.03 of the Trademark Trial and Appeal Board Manual of Procedure, 37 CFR § 2.128(b), Intrust provides the following description of the record:

- 1) The pleadings;
- 2) The prosecution files of the Opposed Application, Serial Number 85250992;
- 3) Pursuant to 37 C.F.R. § 2.122(d)(1), the following Federal Registrations:
 - a) Registration No. 1,802,917 for INTRUST;
 - b) Registration No. 2,738,638 for INTRUST MERCHANT SERVICES;
 - c) Registration No. 3,358,359 for INTRUST WEALTH MANAGEMENT (stylized);
 - d) Registration No. 3,219,237 for INTRUST VALUE PACK;
 - e) Registration No. 2,197,748 for I INTRUST BANK (stylized and design);
 - f) Registration No. 1,957,654 for INTRUST CHECK CARD;
 - g) Registration No. 1,840,083 for INTRUST BANK, N.A.;
 - h) Registration No. 1,849,586 for INTRUST FINANCIAL CORPORATION;

- i) Registration No. 1,841,487 for INTRUST BANK;
 - j) Registration No. 1,879,319 for INTRUST CARD CENTER;
 - k) Registration No. 1,832,427 for INTRUST 24 HOUR BANKING; and
 - l) Registration No. 3,711,317 for I TRUST INTRUST.
- 4) Intrust's First Notice of Reliance and Second Notice of Reliance and the accompanying exhibits, filed March 27, 2014 (Docket Nos. 17 and 18);
 - 5) Intrust's First Rebuttal Notice of Reliance, Second Rebuttal Notice of Reliance, and Third Rebuttal Notice of Reliance, filed April 17, 2015 (Docket No. 33);
 - 6) The March 25, 2014, testimony of Lisa Elliott and accompanying exhibits 1-42, 44-52, and 101-124 (Docket Nos. 37 and 38);
 - 7) The March 25, 2014, testimony of Kimberly Klocek and accompanying exhibits 8, 74, and 75 (Docket Nos. 37 and 38);
 - 8) The March 26, 2014, testimony of Linda Cullinen and accompanying exhibits 13, 58-63, 76-80, and 108 (Docket Nos. 37 and 38);
 - 9) The March 26, 2014, testimony of Thomas Morrison and accompanying exhibits 53-57, 81, 114, 117, 125, and 126 (Docket Nos. 37 and 38);
 - 10) The October 16, 2014, testimony of Geno Reed and accompanying exhibits 130-133 (Docket Nos. 37 and 38);
 - 11) The October 16, 2014, testimony of Deborah Canfarelli and accompanying exhibits 131 and 132 (Docket Nos. 37 and 38); and
 - 12) The April 24, 2015, testimony of Robert McGregor and accompanying exhibits 201-225 (Docket Nos. 37 and 38).

FACTUAL BACKGROUND

A. Trademarks Registered by Intrust

Originally chartered as Farmers & Merchants Bank in 1876 and later known as First National Bank, Intrust changed the name of its wholly owned subsidiary to Intrust Bank, N.A., in 1993 and obtained a registration for the INTRUST mark, Registration No. 1,802,917, on November 2, 1993. Elliott Depo. p. 26:9-12. In the more than two decades that have passed since that time, Intrust has continuously used the INTRUST name and mark, registering additional marks that incorporate the name for use in connection with its products and services. See Opposer’s Federal Registrations; Elliott Depo. p. 26:11-17; Deposition of Linda Cullinen (“Cullinen Depo.”) pp. 27:14-2:15. The INTRUST marks that Intrust has registered include:

Mark	U.S. Registration No.	Registration Date
INTRUST	1,802,917	November 2, 1993
INTRUST MERCHANT SERVICES	2,738,638	July 15, 2003
INTRUST WEALTH MANAGEMENT	3,358,359	December 25, 2007
INTRUST VALUE PACK	3,219,237	March 20, 2007
 INTRUST Bank	2,197,748	October 20, 1998
INTRUST CHECK CARD	1,957,654	February 20, 1996
INTRUST BANK, N.A.	1,840,083	June 14, 1994
INTRUST FINANCIAL CORPORATION	1,849,586	August 9, 1994
INTRUST BANK	1,841,487	June 21, 1994
INTRUST CARD CENTER	1,879,319	February 14, 1994
INTRUST 24 HOUR BANKING	1,832,427	April 19, 1994

I TRUST INTRUST	3,711,317	November 17, 2009
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Intrust’s registrations identify the goods and services offered in connection with its marks as follows:

- INTRUST, I INTRUST BANK (stylized), INTRUST BANK, N.A., INTRUST FINANCIAL CORPORATION, INTRUST BANK, INTRUST 24 HOUR BANKING, and I TRUST INTRUST: “banking services.”
- INTRUST CARD CENTER; “banking services, namely credit card services.”
- INTRUST CHECK CARD: “banking services, specifically on line debit card.”
- INTRUST MERCHANT SERVICES: “merchant services, namely, credit card and debit card services.”
- INTRUST WEALTH MANAGEMENT: “financial services, namely, management of trusts and investment accounts.”
- INTRUST VALUE PACK: “[n]on-commercial banking service, namely, upgraded checking account services.”

B. Intrust’s Advertising and Promotion of the INTRUST Marks

The INTRUST name conveys a message to consumers about the way Intrust does business. Elliott Depo. p. 40:15-21. Intrust has engaged in extensive promotion of the INTRUST marks, developing a valuable corporate identity. *Id.* p. 30:15-18. It has advertised using the INTRUST marks through television, radio, print ads, magazines, Internet, e-mail, and mobile applications. *Id.* p. 37:4-8; 40:9-11. Intrust also has developed a social media presence, using the INTRUST marks on Facebook, Twitter, and LinkedIn. *Id.* pp. 38:23-40:1. In 2012, Intrust had a marketing budget of \$2.6 million. *Id.* p. 63:11-16. This budget included \$800,000 for outside media, which includes the purchase of television ads, billboards, and print and radio ads, all using the INTRUST marks. *Id.* p. 64:7-12. In total, Intrust spent \$2,498,977.13 on advertising in 2010, \$2,402,058.73 in 2011, and \$2,601,835.51 in 2012. *Id.* pp. 66:10-15; 69:1-17; Ex. 8.

In 2008, Intrust purchased the naming rights to a 15,000-seat facility to be located in downtown Wichita for \$8.75 million. Elliott Depo., pp 80:22-81:1; Ex. 11. The facility is named the “Intrust Bank Arena” and it hosts events such as concerts, sporting events, family shows, and other community events. Elliott Depo. pp. 79:6-16. Opened in January of 2010, the Intrust Bank Arena has never had any other name. *Id.* pp. 80:2-13; 81:17-21.

The Intrust Bank Arena has provided a significant avenue for the promotion of the INTRUST name. Taylor Swift, Billy Joel, Elton John, Bon Jovi, Aerosmith, and many other famous musicians have performed at Intrust Bank Arena. *Id.* p. 84:11-17. Although \$8.75 is a large cost, Intrust determined that it was important to associate the INTRUST name with such a significant facility, as it provides the brand with regional and national recognition. *Id.* pp. 85:22-86:16. Intrust also has gained significant notoriety as the INTRUST logo has been on national television during televised NBA exhibition games, NCAA basketball games, and minor league hockey games. *Id.* p. 87:4-8. Intrust Bank Arena also appears on the tour schedules of the artists who have performed there. *Id.* Further, the Intrust Bank Arena and its signage are clearly visible from U.S. 54, a major highway that is adjacent to downtown Wichita. *Id.* pp. 87:4-8; 130:11-131:21; Ex. 12.

Intrust’s significant advertising campaigns include the Image campaign and the slogan “I trust INTRUST.” These campaigns were intended to convey the safety, soundness, and stability of Intrust Bank. Elliott Depo. pp. 72:20-73:8. Intrust launched these campaigns in 2008, during the economic downturn when people were concerned about the stability of banks and that year spent \$354,114 and \$330,985 on the Image campaign and “I trust INTRUST” respectively. *Id.* pp. 70:7-12; 71:21-73:21; Ex. 10. Other campaigns that Intrust has run include campaigns promoting mobile check deposit (on which Intrust spent \$95,547 in 2012) and continued promotion through the

Image campaign. *Id.* p. 70:7-12; Ex. 10. In 2013, Intrust spent \$451,134 on the Image campaign, focusing on “Moments of Trust” and customer stories on why they trust Intrust Bank. *Id.* p. 78:7-16.

In addition to advertising expenses, Intrust spends significant sums on business promotion. This includes entertainment sponsorships and corporate giving. Elliott Depo. p. 67:11-15. Intrust’s combined advertising and business promotion costs are as follows: \$5,695,111 in 2008; \$4,428,472 in 2009; \$4,681,225 in 2010; \$4,940,172 in 2011; and \$4,895,051 in 2012. *Id.* p. 69:18-22; Ex. 9.

Although Intrust was not unscathed by the economic downturn, it has developed a strong presence in the markets it serves and a strong customer base. In 2012, Intrust’s gross revenue was over \$187 million. Elliott Depo. p. 69:18-22; Ex. 9. As of August 31, 2013, 227,377 customers had active accounts. Klocek Depo. pp. 12:8-12; 15:19-24; Ex. 74. Through Intrust’s investment in the promotion of the INTRUST name, Intrust has developed a strong brand and is well-known throughout Kansas and the surrounding region.

C. Intrust Banking Services Provided to Customers Through New Technology

The expectations and demands of Intrust’s customers have evolved as computers and smartphones increasingly replace face-to-face interaction. What customers used to do in a branch, they now expect to be able to do through online banking. Morrison Depo. p. 11:7-17. To keep up with customer expectations, Intrust made a significant investment in Internet and mobile banking technology. *Id.* p. 12:3-11. Currently, Intrust offers online bill pay, mobile banking, and electronic funds transfer capabilities through the Automated Clearing House (such as direct deposit). *Id.* pp. 7:22-9:3. Intrust credit, debit, and gift cards also utilize electronic funds transfers. *Id.* pp. 55:23-56:11; 57:2-11. Intrust also provides financial fraud protection and prevention in connection with these services. *Id.* pp. 58:11-61:17.

Intrust continues to enhance its online capabilities by adding new services. Since 2010, Intrust has been in the process of developing a person-to-person payment service. Morrison Depo. pp. 69:11-22; 70:13-17. By July of 2011, Intrust had a contract with a vendor, FIS, for a service called Send Money, although concerns about the functionality of Send Money led FIS to withdraw the service. *Id.* pp. 70:18-73:5. FIS went on to develop a service called People Pay, which will allow customers to go online and send money to others using that person's cell phone number or email address. *Id.* p. 75:6-24. Intrust expects to implement this service in the future. *Id.* p. 76:17-23. Intrust also plans to roll out a product that it internally refers to as a Travel EMV card. *Id.* pp. 79:25-80:9; 80:22-25. This card is not linked to a bank account, and purchasers of the card can load funds onto it. *Id.* pp. 81:4-15.

In a testament to its continued growth and expansion in the digital age, Intrust's online and mobile banking services have significantly increased over the last 10 years. As of December 2004, Intrust had 3,912 customers who used Intrust's bill pay service to make 19,962 payments. Elliott Depo. p. 46:2-48:9; Ex. 13. By October 2013, Intrust had 11,991 customers who used Intrust's bill pay service to make 61,630 payments. *Id.* Thus, between December 2004 and October 2013,² the number of Intrust customers who used bill pay increased by more than 300 percent and the number of bills paid increased by more than 300 percent. *Id.*

D. nTrust's Application to Register a Confusingly Similar Mark

On February 24, 2011, nTrust filed an intent-to-use application in preparation for the registration of the NTRUST mark in class 36 for use in connection with "[f]inancial services conducted via electronic communications networks, namely, electronic funds transfer; bill payment services; cashless purchasing services for merchants and consumers whereby purchase monies are

² Intrust's trial period ended March 28, 2014, so much of the information available was from the fall of 2013, which is when Intrust produced the documents related to customer and transaction counts.

held and sent to merchants upon sales to consumers; stored value card services; electronic money issuance and transfer services; direct deposit of funds into customer bank accounts; and providing financial fraud protection and prevention.”

STATEMENT OF THE ISSUE

Is nTrust’s use of the NTRUST mark for bill pay and related services and for physical cards likely to cause confusion among the relevant consumers with respect to whether INTRUST, who uses its 20-year-old INTRUST marks for bill pay and related services and for physical cards, is the source or sponsor of, or affiliated with, the financial services that nTrust intends to offer?

POINTS AND AUTHORITIES

I. USE OF THE NTRUST MARK IS LIKELY TO CAUSE CONFUSION WITH RESPECT TO THE SOURCE, SPONSORSHIP, OR AFFILIATION OF THE SERVICES DESCRIBED IN THE APPLICATION

When determining whether likelihood of confusion exists between two marks, the Trademark Trial and Appeal Board most often uses the so-called “*DuPont* factors” laid out in *In re Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563, (C.C.P.A. 1973). The Board need not consider every *DuPont* factor. *Shen Mfg. Co., Inc. v. Ritz Hotels, Ltd.*, 393 F.3d 1238, 1241, 73 U.S.P.Q. 2d (BNA) 1350 (Fed. Cir. 2004). Instead, it need only consider those that are relevant. *Id.*

Generally, the key *DuPont* factors are the similarity of the marks and of the goods and services. *In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008). If there is any doubt as to whether a likelihood of confusion exists between the application and the prior registration, the doubt must be resolved in favor of the prior registration and the application denied. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464, 6 U.S.P.Q.2d (BNA) 1025 (Fed. Cir. 1988) (emphasis added).

In this case, the relevant *DuPont* factors are: (1) the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity in the nature of the goods and services described in nTrust's application and Intrust's registrations; (3) the similarity of established, likely-to-continue trade channels; (4) evidence of actual confusion; (5) the fame of Intrust's marks (sales, advertising, length of use); (6) the lack of other marks similar to Intrust's registered marks; (7) the length of time during and conditions under which there has been concurrent use without evidence of confusion; (8) the extent to which nTrust has a right to exclude others from use of its mark; and (9) the extent of potential confusion. Any doubt as to likelihood of confusion is resolved against nTrust as the newcomer. *In re Shell Oil Co.*, 992 F.2d 1204, 1211, 26 U.S.P.Q.2d (BNA) 1687, 1691(Fed. Cir. 1993) (emphasis added). As set forth below, all applicable factors weigh heavily in Intrust's favor, and nTrust's application therefore should be denied.

A. The Marks Essentially Are Identical

The *DuPont* factor focusing on the similarity of the marks weighs heavily in favor of denial of nTrust's application. The test for similarity is whether the marks, when compared in their entireties in terms of appearance, sound, and connotation, are similar or dissimilar in their overall commercial impression. *Palm Bay v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 U.S.P.Q.2d (BNA) 1689, 1691 (Fed. Cir. 2005). The NTRUST and INTRUST marks are nearly identical in appearance, differentiated only by a single letter. Consumers will, in all likelihood, pronounce them identically. *In re Viterra, Inc.*, 671 F.3d 1358, 1367, 101 U.S.P.Q.2d (BNA) 1905, 1912 (Fed. Cir. 2012) (finding that substantial evidence supported the Board's determination that any minor differences in the phonetic sound of the applicant's mark XCEED and the opposer's mark X-Seed would go undetected by consumers).

The marks also generate a similar connotation and overall commercial impression. Merriam-Webster dictionary identifies “entrust” as a variant of “intrust” and defines it as “to confer a trust on” or “to commit to another with confidence.”³ The INTRUST name is meant to convey to consumers the trust that is the foundation of their relationship with the bank. Elliott Depo. p. 40:12-21. This trust is key, given that consumers will be entrusting Intrust with their money. nTrust likewise advertises to consumers that their money will be safe. Its website advertises that nTrust will create an “iron-clad digital Vault” and promotes itself as “Secure Like a Vault” and “Regulated Like a Bank.” Exs. A-1; A-18. The “Trust” portion of the NTRUST mark was selected because nTrust was going to be an online service dealing with money, so trust would be important. MacGregor Depo. pp. 10:16-11:1.

It is well established that marks that differ by only one letter, and that are pronounced identically, or nearly identically, are more likely to be found to be confusingly similar. This is especially true where, as here, the absence of a letter in the applicant’s mark does not result in any discernible difference in pronunciation. In *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan*, 165 U.S.P.Q. (BNA) 597, 1970 TTAB LEXIS 66, *25 (1970), the Board noted that the marks “S-LON” and “ESLON” differed only by one letter and a hyphen, that “ES” is merely the phonetic spelling of “S”, and that the marks “are and would be recognized as the same mark.” See also *In re E-Formis, LLC*, 2014 TTAB LEXIS 127, *12 (Mar. 25, 2014) (finding that eMedesis and E-MEDSYS are confusingly similar); *Apple Computer v. TVNET.net, Inc.*, 90 U.S.P.Q. 2d 1393 (BNA), 2007 TTAB LEXIS 80 (2007) (finding that the dominant, distinctive portions of the ITUNES and VTUNES.NET marks differed only by one letter and that the marks are nearly identical); *In re Laura Gellar Make-Up Studios, Ltd.*, 2009 TTAB LEXIS 562, *6 (Aug.

³ <http://www.merriam-webster.com/dictionary/entrust> (last accessed July 7, 2015)

13, 2009) (concluding that the registered mark PHINOMENAL is a misspelling of the word “phenomenal” and is essentially the same as the applicant’s mark PHENOMENAL FOUNDATION).

INTRUST and NTRUST are essentially identical in appearance, pronunciation, and meaning. Accordingly, this *DuPont* factor weighs heavily in favor of the denial of nTrust’s application.

B. The Services Described in Intrust’s Registration and nTrust’s Application are Similar in Nature, Commercially Relatable, and Sold Through Identical or Related Channels of Trade

1. Summary of the Argument

nTrust has indicated that it may take the position that “banking services,” as used in Intrust’s registrations, are limited to those services that *only* can be provided by a bank and do not include services, such as bill pay and stored value cards, that may also be offered by nonbanks. nTrust’s argument, however, is not supported by the facts or the applicable law. In *In re Arcus Capital Partners, LLC*, 2012 TTAB LEXIS 412, *9 (Oct. 26, 2012), the Board agreed with the examining attorney’s definition of “banking services” as “the business of a bank.” As will be shown below, the “financial services” referenced in nTrust’s application—including bill pay, electronic funds transfer, direct deposit of funds, physical cards for purchasing goods, and financial fraud protection—are part of “the business of a bank” and therefore fall within the types of services encompassed by Intrust’s marks.

Perhaps more important, the question is not whether the services offered under the two competing marks are identical, the test is whether the services are related in the mind of the consuming public as to their origin. Thus, even if bill pay, physical cards, and the other money-moving services to be offered by nTrust are not technically “banking services,” there is no doubt

that those money-moving services are related to “banking services” in the mind of the consuming public.

2. **Customers are likely to believe that the services offered by nTrust and Intrust emanate from the same source.**

The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in the applicant’s application, compared to the services recited in the opposer’s registration, rather than what the evidence shows the goods or services to be. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Assoc.*, 811 F.2d 1490, 1491 (Fed. Cir. 1987).

As discussed above, nTrust claims the intent to use the NTRUST mark in connection with “[f]inancial services conducted via electronic communications networks, namely electronic funds transfer; bill payment services; cashless purchasing services for merchants to consumers whereby purchase monies are held and sent to merchants upon sales to consumers; stored value card services; electronic money issuance and transfer services; direct deposit of funds into customer bank accounts; and providing financial fraud protection and prevention.” These services are categorized in Class 36.

As discussed at page 6, above, Intrust’s registrations describe financial services and banking services. These services also are categorized in Class 36.

For purposes of this inquiry, it is sufficient to show that the services are related in the mind of the consuming public as to their origin. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d (BNA) 1894, 1898 (Fed. Cir. 2000) (holding that the Board erred in finding that Fido Lay dog treats were not identical or closely related to Frito-Lay human snacks). Where essentially identical marks are involved, the degree of similarity between the parties’ services that is required to support a finding of likelihood of confusion declines. *Time Warner Entertainment Co. L.P. v.*

Jones, 65 U.S.P.Q.2d 1650 (BNA), 2002 TTAB LEXIS 462, *29 (2002). Therefore, even though the services offered by the parties in this case are significantly similar, the fact that the INTRUST and NTRUST marks are nearly identical lessens the degree of similarity that must be established.

The “financial services conducted via electronic communications networks” described in nTrust’s application are a subset of the “financial services” and “banking services” described in Intrust’s registrations. Intrust offers its financial services through multiple ways, one of which is through electronic communications networks. For example, it offers electronic funds transfer in connection with its banking services. Elliott Depo. p. 16:13-18. Intrust also offers bill payment services, stored value cards, electronic money transfer services, and direct deposit. *Id.* pp. 15:20-23; 16:8-12; 17:1-9. Consumers encountering the nTrust and Intrust marks are likely to be confused as to whether the services are related in some way, and whether nTrust’s “financial services conducted via electronic communications networks” are associated with or emanate from the same source as the “financial services” and “banking services” provided by Intrust.

The banking services offered by a bank are, by their very nature, financial services. Banks, including Intrust, commonly offer such services online via electronic communications networks. Exs. K-26 through K-53. The similarity between the services offered by nTrust and the services offered by banks is evidenced on nTrust’s own website, which includes a “Frequently Asked Question” of “Is nTrust a bank?” Ex. M-3. NTrust thus feels the need to clarify that nTrust technically is not a bank, a tacit acknowledgment that its potential consumers “**frequently**” wonder whether nTrust is a bank. Further, nTrust compares itself to banks when offering its products-- nTrust advertises that it is “regulated like a bank” and provides “bank level security” for sending and spending money. Ex. A1; A-18; MacGregor Depo. pp. 100:19-102:19. The overlapping products and services offered by nTrust and Intrust demonstrate that they “would reasonably be

thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.” *CAE, Inc. v. Clean Air Eng’g, Inc.*, 60 U.S.P.Q.2d 1449, 1462 (BNA) (7th Cir. 2001) (internal quotations omitted).

3. The services described in nTrust’s registration are offered by banks.

The services described in nTrust’s application are recognized as services that banks provide. In *In re Arcus Capital Partners, LLC*, 2012 TTAB LEXIS 412, *9 (Oct. 26, 2012), the Board defined “banking services” as “the business of a bank.” The Comptroller of the Currency, which is the primary regulator of national banks, such as Intrust Bank, N.A., has determined that electronic bill presentment is part of the business of banking. Ex. K-21; Ex. K-23. The FDIC offered consumer guidance on “P2P” (person-to-person) payments, suggesting that consumers interested in using P2P payments find a bank that offers such services: “While a number of non-bank companies also offer P2P payments, there can be benefits to working with a bank, such as the opportunity to maintain a financial relationship and obtain other products and services at reasonable rates.” Ex. K-15, FDIC Consumer News, Person-to-Person (P2P) Payments Online: What to Know Before You Click and Send That Money, Spring 2014.

Banks commonly – indeed, typically – offer products and services that also may be provided by nonbanks. Banks lend money. So do cash advance companies. Banks often offer private wealth management services and investment advice. So do investment firms like Morgan Stanley and Merrill Lynch. Increasingly, banks provide their financial services online, “via electronic communications networks” as described in nTrust’s application, and provide online money transfer and peer-to-peer money transfer services. These are services described in nTrust’s application. Therefore the services described in the Intrust registrations and nTrust application are of a type that consumers likely are to believe emanate from a single source.

Third-party registrations show that banks offer the kind of services described in nTrust's application. These registrations are relevant to show that the listed goods and services are of a type that may emanate from a single source. *In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q.2d (BNA) 1467, 1988 TTAB LEXIS 11, *9 (1988). For example, in *In re Arcus*, 2012 TTAB LEXIS 412 at *18, the Board examined third-party registrations to determine that "banking services," which the examining attorney defined as "the business of a bank," included wealth management service such that a customer would expect that "capital and wealth management services," "banking services," and "administration of health savings accounts" would emanate from a single source under a common mark.

Some of the relevant third-party registrations include Registration No. 85780331 (ABC BANK YOUR COMMUNITY BANK SINCE 1981) (Ex. E-1), for "'banking and financial services, namely . . . electronic fund transfer and transaction services, electronic debit transactions, electronic cash transactions, electronic debit transactions . . . online account opening and funding . . . electronic processing and transmission of bill payment data. . . ."; Registration No. 85882170 (CTB COMMUNITY TRUST BANK) (Ex. E-4) for ". . . Banking; Banking and financing services; Electronic banking via a global computer network On-line banking services"; Registration No. 4037643 (EFREE) (Ex. E-5), for "Banking services, namely . . . electronic fund transfer services, electronic interactive banking service . . . mobile banking, namely, banking services provided by mobile telephone connections, PDA or other mobile device."; Registration No. 85488603 (HSBC AMANAH) (Ex. E-7) for "Financial and banking services, namely...electronic banking services, namely electronic banking via a global computer network, Internet banking and telephone banking; mobile phone banking services . . . automatic bill payment services . . . electronic payment card services . . . electronic funds transfer services . . . providing all

of the above services by means of computer.”; Registration No. 86162459 (SCVBANK) (Ex. E-11) for “. . . Banking; Banking and financing services . . . Banking services . . . Electronic banking via a global computer network; Financial services, namely funding online cash accounts from prepaid cash cards”; Registration No. 86011408 (STEELE STREET BANK & TRUST) (Ex. E-12) for “Banking services; financial services . . . and all of the forgoing services offered via the Internet.”; and Registration No. 86167727 (UWHARRIE BANK) (Ex. E-14) for “Banking services; financial services, namely . . . automated clearing house (ACH) services, wire transfer services, monetary transfer services . . . automated bill payment services . . . online banking services”

As further evidence that the products and services described in nTrust’s application are of a kind that emanate from entities that provide banking services, banks with registrations that associate their mark with “banking services” already offer stored value cards and electronic money issuance and transfer services similar to those described on nTrust’s website. *See In re Arcus*, 2012 TTAB LEXIS at *10-12 (bank websites relevant to show the services offered by those banks). Registration No. 0717320, for Chase Manhattan Bank, describes “Banking Services” as among the goods and services that it offers. Ex. E-3. Among the goods and services described on the Chase Manhattan Bank website are a reloadable debit card and a product called QuickPay, which Chase advertises as allowing people to “send money to nearly anyone using their email address or mobile number.” Ex. C-3. The registration for BBVA Compass, Registration No. 3940535 describes its goods and services as “banking services.” Ex. E-2. According to the website for BBVA Compass, the bank offers a reloadable prepaid debit card as well as “Pay People,” through which it is possible to send money to a person using their email address or mobile number. Ex. C-2. US Bank, Registration No. 75324898 also describes “banking services.” Ex. E-13. The US Bank website promotes prepaid card products as well as “Pay A Person,” which allows customers to send a

payment to a person using the recipient's bank account, email, or mobile phone number. Exs. C-4; C-5.

4. **Banks offer the services that nTrust proposes to provide.**

The description of these products and services shown in the referenced bank websites demonstrate that banks are promoting person-to-person money transfer services and other financial services provided via the electronic communications network such that consumers will expect nTrust's and Intrust's financial services to emanate from the same source. The broad category of "[f]inancial services conducted via electronic communications networks" described in nTrust's application certainly describes the services that banks, including Intrust, offer to consumers. Looking to the services that nTrust offers or intends to offer, it is clear that these services, including bill pay, electronic funds transfers, and peer-to-peer money transfer services, are services that banks provide. nTrust is a "money services business" that, according to founder Robert MacGregor in an interview, aims to be used "anywhere there is a cheque." MacGregor Depo. p. 5:19-24. MacGregor describes himself as someone who operates "in the world of banking." Ex. M-5. The nTrust website describes prepaid cards and sending and receiving money, and nTrust would also provide electronic bill pay services. Exs. A-1; M-1; M-2; M-3; MacGregor Depo. p. 40:10-21.

Industry observers have recognized increasing demand for mobile payment and money transfer options, and the role that banks must play in offering these services. In an article entitled "Banks Should Act Now on Mobile Payments," the authors note the dramatic rise in the percentage of customers who use their smartphones to make mobile payments, and note that no one is better than banks to provide payment solutions and digital wallets, as customers trust banks more than alternative payment providers. Ex. K-1, Karim Ahmad and Gerard du Toit, Banks Should Act Now on Mobile Payments, American Banker, May 19, 2014. Another article posits that while

“non-traditional competitors” are offering mobile wallets, bill payment, and peer-to-peer solutions, “banks will win the payments war” due to several built-in advantages. Ex. K-5, Glen Fossella, Why Banks Will Win the Payments War, American Banker, July 29, 2014.⁴

The number of banks advertising such services is increasing. A 2011 New York Times article describes the person-to-person payment services offered by Bank of America, JPMorgan Chase, and Wells Fargo. Ex. K-17, Tara Siegel Bernard, Person-to-Person Payments Get Easier at Big Banks, N.Y. Times, May 25, 2011. “Many banks already offer person-to-person payment services,” the article states, describing such services offered by ING Direct. Capital One recently announced its intentions to offer such services using the platform ClearXChange, which was created for financial institutions in order to make peer-to-peer money transfers easier. Abha Bhattarai, Capital One To Begin Offering Peer-to-Peer Money Transfers Via Email, Mobile Phone, The Washington Post, March 9, 2014.⁵ A Capital One executive was quoted as saying that as an industry, banks should make it as easy as possible to make person-to-person transfers. *Id.* On March 17, 2015, U.S. Bancorp issued a press release announcing that it was joining ClearXChange, “a bank-focused payments company” that developed solutions for financial institutions to make digital payments, including person-to-person payments, easier. Ex. K-14. Numerous banks advertise person-to-person payment services and stored value cards. Exs. K-30 through K-53. In short, banks offer, and are expected to offer, the kinds of services described in nTrust’s application.

nTrust may argue that the products and services contained in its application are not similar to those described in Intrust’s registrations because as a non-bank, nTrust cannot offer “banking

⁴ Other articles discussing evolving bank customer expectations and how smartphones have changed the financial services industry are offered in Exhibits K-2 through K-4.

⁵ Available at http://www.washingtonpost.com/business/capitalbusiness/capital-one-to-begin-offering-peer-to-peer-money-transfers-via-email-mobile-phone/2014/03/07/4768fb20-a3ec-11e3-a5fa-55f0c77bf39c_story.html.

services.” This argument ignores two key points. First, it is not necessary for the respective goods to be identical. *Time Warner Entm’t Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (BNA), 2002 TTAB LEXIS 462, *29 (2002). It is enough if they are related in some manner so as to promote a mistaken belief that they originate from or are associated with the same source. *Id.* For example, in *Time Warner*, the court found that the applicant’s good – road maps – were sufficiently similar to the registrant’s goods – motion picture, video, and television films; pre-recorded audio-video tapes, cassettes and/or discs feature animation and/or music – because they were within the opposer’s natural area of expansion. *Id.* at 1662.

Second, “financial services” is a broad category that includes the kinds of services provided by banks, and banks commonly offer a number of services that may be offered by non-banks: money lending, investment advice, and money wiring services to name a few. Yet it should come as a surprise to no one that such services emanate from the same source as the services that a bank, and only a bank, can provide. Doubtless, if someone were to open an investment advising firm and name it “Chaise Manhattan Wealth Management,” there would be confusion as to whether the firm was connected to Chase Manhattan Bank. *See, e.g., Arcus Capital Partners*, 2012 TTAB LEXIS 412, at 26-27 (holding that “applicant's marks ARCUS CAPITAL MANAGEMENT and ARCUS CAPITAL PARTNERS for the identified services is likely to cause confusion with the mark in the cited registration ARCUS FINANCIAL BANK). Thus, the fact that banks can and do offer services that non-banks also offer means that there can be confusion as to whether a bank is the source of that service.

The argument that a service is not a “banking service” simply because some non-banks can offer it defies reason. Part of the business of a bank is to move money from one place to another. *See Corbett v. Devon Bank*, 12 Ill. App. 3d 559, 572 (1973) (referring to “the ordinary and

traditional banking function of collecting and remitting funds for other parties”). Technology has changed the way that this is done, but the transaction itself is still one that is well within the traditional role of a bank. Customers who want to move their money from their own account and pay it to a merchant were once required to withdraw cash or write a check. Technology used by today’s banks simplifies the process and allows customers to accomplish this payment by swiping a debit card or paying a bill online. Similarly, technology is changing the way that people pay other people. The services described in nTrust’s application (and detailed on its website) are examples of ways that non-banks can supply person-to-person and Internet-based payment methods. QuickPay, Pay A Person, and Pay People are examples of ways that banks are using technology to supply person-to-person and Internet-based payment methods. Although the technology has changed the way it is accomplished, the core transaction of enabling a customer to move money from the customer’s account to a third party is very much a banking service.

Even nTrust’s president, Rod Hsu, has recognized that “[c]onventional banks, unable to meet evolving customer needs through traditional service offerings, are beginning to adopt new technologies to digitize transactions.” Ex. K-18, Rod Hsu, Digitally Driven Neo-Consumer Gives Rise to Innovation in Banking, TechVibes, June 13, 2014. Mr. Hsu hypothesizes that future consumers will flock to online-only banks that, presumably, will offer financial services via electronic communications networks. *Id.* He further predicts that “2015 will be the year where we see if traditional banks are able to seamlessly transition into the mobile payment space and offer their customers the latest cutting edge technology. They will need to keep working smarter to establish synergies in these market segments or they run the risk of being left behind.” Ex. K-19, Rod Hsu, Where Mobile Payments are Headed in 2015, TechVibes, Jan. 6, 2015. nTrust’s own president, therefore, recognizes that bill pay and other mobile payment services are natural

extensions of banking services. He encourages banks to respond, and recognizes that banks have already responded, to consumer demand and offer mobile payment services and “compete with companies moving into the alternative payment space. Conventional banks have already started to co-brand with tech companies to provide alternative services to their customers.” *Id.*

nTrust thus recognizes that banks are competition. This is because banks offer the same type of services offered by nTrust, and that are described in nTrust’s application. Accordingly, consumers are likely to believe that the services described in nTrust’s application and Intrust’s registrations are associated with the same source.

5. The goods and services described in Intrust’s registrations and nTrust’s application are sold through identical or related channels of trade.

The analysis of whether channels of trade are related also is based on the identification of goods and services set forth in the application, regardless of what the record may reveal as to the particular channels of trade or the class of purchasers to which sales of the goods and services are directed. *Octocom Systems, Inc. v. Houston Computer Servs, Inc.*, 918 F.2d 937, 942, 16 U.S.P.Q.2d (BNA) 1783 (Fed. Cir. 1990). nTrust offers its goods and services to the general public via its website and does not have a physical location. MacGregor Depo., pp. 22:18-23:5. The types of sales are not restricted in any way by the application, which states that the applicant intends to use the mark “in commerce on or in connection with the identified goods and/or services.” *See* Appl. No. 85250992. Therefore, the scope of nTrust’s services extends to every potential customer of Intrust. *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 U.S.P.Q.2d (BNA) 1253, 1261 (Fed. Cir. 2011) (finding that “absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”) (internal quotations omitted).

The foregoing demonstrates that the goods and services offered by nTrust and Intrust are commercially related and sold through identical or related channels of trade, resulting in a significant likelihood of consumer confusion.

C. Actual Confusion Has Occurred

Despite the fact that nTrust's products are not yet available to consumers in the United States, actual confusion of the nTrust and Intrust marks already has occurred. A showing of actual confusion is highly probative, if not conclusive, of a high likelihood of confusion. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 U.S.P.Q.2d (BNA) 1201, 1205 (Fed. Cir. 2003). “[W]hile very little proof of actual confusion is necessary to prove the likelihood of confusion, an almost overwhelming amount of proof would be necessary to refute such proof.” *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 489, 168 U.S.P.Q. (BNA) 609 (5th Cir. 1971). Evidence of non-consumer confusion is relevant to show likelihood of confusion, and confusion among industry insiders who are even more sophisticated about the origins and sources of products than average consumers is highly probative on the question of whether a likelihood of confusion exists. *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1265, 34 U.S.P.Q.2d (BNA) 1526, 1529 (Fed. Cir. 1995).

In this case, actual confusion occurred at FIS, a company that produces credit cards for financial institutions. Deposition of Gene M. Reed, pp. 2:1-6; 9:1-13. FIS Client Services Manager Deborah Canfarelli was assigned to work with Intrust, serving as its main point of contact for questions related to credit card production. Deposition of Deborah R. Canfarelli (“Canfarelli Depo.”), p. 9:17-22. As part of the process, Intrust sent to Ms. Canfarelli a data file containing the graphic that would personalize its card products, and using that image Ms. Canfarelli created a production job and reviewed the cards generated to ensure that the correct graphic appeared on the cards. Canfarelli Depo., pp. 12:5-14:12, Ex. 131.

On April 7, 2014, an email titled “Art Looking for an Owner” was sent to FIS client services employees, including Ms. Canfarelli. Canfarelli Depo. p. 22:10-23:12, Ex. 131. The email contained a screen shot of an nTrust Cloud Money Card and the message, “Design received art for the attached but we do not know to whom it belongs. Please review.” *Id.* Because the “nTrust” name was so similar to Intrust, Ms. Canfarelli was confused as to the image’s origin and believed that the art may have come from Intrust. *Id.*, pp. 22:10; 24:16-25:11; 26:16-27:7. In her deposition, Ms. Canfarelli was asked what she thinks of when she reads the line “nTrust Cloud Money Card.” She responded that “I think the name reminds me of Intrust Bank.” *Id.* at p. 38. Ms. Canfarelli’s belief that the nTrust Cloud Money Card may have been associated with Intrust, her testimony that “nTrust Cloud Money Card” makes her think of Intrust Bank, demonstrate that consumers are likely to be confused as to whether nTrust and Intrust are related entities.

D. Intrust’s Marks Are Well Known and Entitled to a Broad Scope of Protection

Intrust’s marks have become regionally renowned and are thus entitled to a heightened scope of protection. Although Intrust freely admits that it has not established the same level of fame as the nation’s biggest banks, its extensive promotion in the markets in which it has bank branches has given Intrust a regional renown that entitles it to wider scope of protection. *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 2012 TTAB LEXIS 70, *12 (March 8, 2012) (“Strength is measured in degrees and while the record evidence does not show a level of consumer exposure and recognition to warrant a finding of fame, it does establish SEACRETS as a strong mark with significant regional renown which should be accorded a wider scope of protection.”); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 2014 TTAB LEXIS 284, *74-75, 111 U.S.P.Q.2d (BNA) 1419, 1440 (July 9, 2014). National fame is not necessary, and a mark that has established notoriety in the geographic area in which it does business is entitled to benefit from the *DuPont*

factor regarding the fame of a mark. *iMedica Corp. v. Medica*, 2007 TTAB LEXIS 140, *15-16 (June 7, 2007).

The renown of a mark may be measured by the volume of sales, advertising expenditures of the goods or services traveling under the mark, and the length of time those indicia of commercial awareness have been evidence. *Bose Corp. v. QSC Audio Prods, Inc.*, 293 F.3d 1367, 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002). Intrust has used its marks since 1993. Elliott Depo. p. 26:4-14. It has expended significant sums for promotion and advertising. Since 2008, Intrust has spent an average of \$4.9 million per year on advertising and business promotion. Elliott Depo. p. 69:18-22; Ex. 9. This is far more than the Board previously has recognized as “substantial.” *Medica Health Plans v. Rousmaniere*, 2008 TTAB LEXIS 620, *6 (May 7, 2008) (finding that advertising expenditures in excess of \$1 million per year are substantial). Its advertising includes television commercials, print advertisements, billboards, mobile applications, sponsorships at college sporting events, sponsorship of the Intrust Bank Arena, and online promotion through banner ads, advertising on Pandora Internet radio, and maintaining Facebook, Twitter, and LinkedIn accounts. Elliott Depo. pp. 37:4-8; 38:17-20-39:1; 40:9-11; 77:6-78:2. Samples of these advertisements can be seen in Exhibits 12, 18, 21, 22, and 25. From June 2010 through August 2013, between 225,208 and 238,950 customers have maintained active accounts at Intrust Bank. Klocek Depo. p. 15:2-7; Ex. 74.

Since adopting the INTRUST mark, Intrust has launched new products and services, including new types of checking accounts and bill pay, and promoted its accessibility and convenience. Elliott Depo. p. 76:16-23. Thus, Intrust maintains a ubiquitous presence in the markets that it serves. Even those who are not Intrust customers are likely exposed to the marks through news stories and promotions about big acts and sporting events coming to Intrust Bank

Arena—for which Intrust paid \$8.75 million for the naming rights—or by seeing the large arena sign while driving the well-traversed U.S. Highway 54. They may have seen or heard an Intrust commercial on the television or radio, such as one of the commercials for Intrust’s “I trust Intrust” campaign. Or they may see an Intrust ad after typing one of the “adwords” selected by Intrust into the internet search engine google.com. It is growing and expanding the services it offers, and has seen a significant increase in the number of customers using its mobile and online payment services; there were just 12 mobile check deposits in May of 2012, compared to 2,477 in October of 2013, and 3,912 customers using online bill pay in December of 2012, compared to 11,991 in October of 2013. Elliott Depo. p. 46:2-48:9; Ex. 13. Through its strong presence in communities and advertising and promotional efforts, Intrust has become renowned in the markets it serves, thereby entitling it to a broad scope of protection. *Ecolab Inc. v. Sumecht NA Inc.*, 2013 TTAB LEXIS 424 (July 29, 2013) (“While the renown of opposer's mark does not rise to the level of a famous mark, we find that it is commercially strong and entitled to a broad scope of protection.”)

E. Intrust Has Successfully Opposed Similar Marks on Similar Services

The sixth *DuPont* factor focuses on third-party use of the opposer’s mark. Intrust diligently enforces its trademark rights by opposing the application for similar marks involving similar services. Intrust has successfully challenged the use or registration of marks similar to INTRUST where the mark was used in connection with financial services. For example, Intrust Corp. agreed to change its name to Trusted W&C Corp. Elliott Depo. pp. 142:21-143:15. Entrust Companies, an Arizona corporation, also agreed to change its name after Intrust sued it for continuing to use “ENTRUST BANKCARD.” *Id.* pp. 146:10-8; Ex. 42. Entrust Federal Credit Union, which was also sued by Intrust, continues to operate in Virginia, but the parties agreed that the “Entrust” name would be used only in a restricted geographic area, and the category of customers that it serves is limited to members of a certain religious community. *Id.* p. 145:11-25. Entrust Federal Credit

Union's registration was canceled as part of the parties' agreement on March 4, 2013. *Id.*, p. 144:7-14; Ex. 41.

Intrust subscribes to a monitoring service called Corsearch, which provides regular reports of potential trademark conflicts in priority categories identified by Intrust. Elliott Depo. pp. 134:17-135:1. Intrust does not challenge the registration of marks that are not likely to create confusion. Many – such as Entrust Milk, Reg. No. 85959175, and Instil Health Intrust, Reg. No. 77402778 – clearly are being used in connection with services that are not similar to those offered by Intrust. Whether Intrust ultimately decides to submit an opposition to an application to register a mark depends on a number of factors, including the type of industry or service provided, whether the applicant currently is in business or just starting out using the mark, and the applicant's geographic footprint. *Id.* 134:2-13. Over the past five years, Intrust has spent approximately \$170,000, primarily on legal fees, to enforce its trademark rights. *Id.* p. 147:9-12.

Although at least according to the Trademark Electronic Search System provided by the PTO, some marks similar to “INTRUST” or “ENTRUST” remain active, there is no evidence that the marks therein have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the basis of minor differences. *In re Holding Co. of the Villages, Inc.*, 2014 TTAB LEXIS 138, *21 (April 14, 2014). Therefore the probative value of these third party trademarks is minimal. *Id.* In short, “[t]he existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake, or to deceive.” *AMF, Inc. v. Am. Leisure Prods., Inc.*, 474 F2d 1403, 1406, 177 U.S.P.Q. (BNA) 268 (CCPA 1973). Therefore, the sixth *DuPont* factor supports denial of nTrust's application.

F. nTrust Has No Right To Exclude Others

The eleventh *DuPont* factor – the extent to which nTrust has the right to exclude others from use of its mark on its goods – also favors denial of nTrust’s application. nTrust has submitted no evidence of its “right to exclude others from use of its mark.” Intrust first applied to register the “INTRUST” mark on July 30, 1992, and has used it continuously since the mark was registered in 1993. Opposer’s Federal Registrations; Elliott Depo. p. 26:11-17; Cullinen Depo. pp. 27:14-2:15. nTrust, on the other hand, has existed only since 2010 and is not yet doing business in the United States. MacGregor Depo. pp. 4:8-12; 32:1-7. Therefore nTrust cannot establish that it has a right to exclude others from use of the mark. *In re Sovena U.S.A., Inc.*, 2009 TTAB LEXIS 635, *18 (Oct. 5, 2009).

G. The Extent of Potential Confusion Is Substantial

Confusion regarding the relationship between Intrust and nTrust already has occurred, despite the fact that nTrust has not yet even begun to market its products in the United States. The confusion that could result should nTrust be permitted to offer bill pay, electronic funds transfers, direct deposit of funds, physical cards for purchasing goods, and financial fraud protection under the NTRUST mark is substantial. These services are in direct competition with the services Intrust offers under its INTRUST mark.

Further, nTrust markets its products and services to the public at large via its website. It has no physical branch that customers can visit. MacGregor Depo. pp. 22:18-23:5; 31:12-25. Therefore nTrust’s goods and services could be purchased by virtually anyone anywhere and there is the potential to confuse a large group of people that includes Intrust’s customers and consumers in the regions in which Intrust has bank branches. *See In re Smurr*, 2013 TTAB LEXIS 533, *18 (Oct. 3, 2013) (finding that extent of potential confusion is substantial because consumers included the public at large).

In addition, once Intrust rolls out its own person-to-person payment service, the extent of potential confusion will be increased even more as the parties both will be marketing a product that facilitates the transfer of money to an individual using their email address or phone number. As nTrust and Intrust continue to compete and develop products and services in response to the needs and expectations of consumers who increasingly conduct their finances via the Internet and smartphones, the potential for confusion only will grow.

II. THE *DUPONT* FACTORS THAT DO NOT FAVOR INTRUST ARE EITHER NON-APPLICABLE OR NEUTRAL

The remaining *DuPont* factors do not weigh in favor of nTrust, but rather are either non-applicable or neutral.

CONCLUSION

The evidence in the record shows that the INTRUST and NTRUST marks are confusingly similar and will be used in connection with related goods and services that will be advertised and sold to members of the public in the same channels of trade. The NTRUST mark is not only likely to be confused with the INTRUST marks, it has already been confused even though nTrust has not yet entered the United States market. For these, and the foregoing reasons, and Intrust respectfully requests that the Board sustain its opposition and deny registration to nTrust's pending application.

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Dated: August 14, 2015

CERTIFICATE OF SERVICE

I certify that a copy of **Opposer's Brief on the Merits** was mailed U.S. Mail, first class, postage prepaid, to counsel of record as follows:

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Attorney for Applicant

on this 14th day of August, 2015.



Michael J. Norton, KS #18732



In re E-FORMIS, LLC.

Serial No. 85668043

Trademark Trial and Appeal Board

2014 TTAB LEXIS 127

March 25, 2014, Decided

DISPOSITION:

[*1]

Decision: The examining attorney's refusal to register applicant's mark under *Section 2(d)* of the Trademark Act is affirmed.

COUNSEL:

Albert Bordas of Albert Bordas, P.A. for E-FORMIS, LLC.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

JUDGES: Before Taylor, Bergsman, and Hightower, Administrative Trademark Judges.

OPINION BY: HIGHTOWER

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Hightower, Administrative Trademark Judge:

On July 3, 2012, applicant applied to register the mark shown below:

for services in International Class 42 identified after amendment as "providing temporary use of non-downloadable computer software for use in obtaining and completing documents and forms for the healthcare industry." n1 Applicant has disclaimed the words THE LEADER IN HOMECARE DOCUMENT SERVICES apart from the mark as a whole.

n1 Application Serial No. 85668043, alleging first use anywhere and first use in commerce at least as early as June 25, 2015.

[*2]

Registration has been finally refused on the ground of a likelihood of confusion pursuant to Section 2(d) of the Trademark Act, *15 U.S.C. § 1052(d)*, with the mark E-MEDSYS, registered for the following goods in International Class 9:

Computer software for tracking patient medical records information, namely, medical history, medication history and family history; Computer software for medical practice management, namely, bill processing, financial report generation and recording, collection processing, appointment scheduling and generation of user customized management reports; Computer software for providing medical patients secure Internet access to and management of information relating to their own appointments and medical profile; Computer software to facilitate communication between medical service providers and patients.

n2

n2 Registration No. 3634019, issued June 9, 2009.

Applicant timely appealed the refusal. Applicant and the examining attorney each filed a [*3] brief.

Analysis

Our determination under *Section 2(d)* is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Goods/Services, Channels of Trade, and [*4] Conditions of Sale

We first address the similarity of the goods and services, their channels of trade, and conditions of sale, the second through fourth *du Pont* factors. The goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they could be encountered by the same persons under conditions that could, because of the similarities of the marks, give rise to the mistaken belief that they originate from or are in some way associated with the same provider. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010).

Applicant's identified services are "providing temporary use of non-downloadable computer software for use in obtaining and completing documents and forms for the healthcare industry." Goods identified in the cited registration include "computer software for tracking patient medical records information, namely, medical [*5] history, medication history and family history" and "computer software for providing medical patients secure Internet access to and management of information relating to their own appointments and medical profile."

We find that applicant's services are highly related to the goods in the cited registration. Applicant offers the use of computer software for "obtaining and completing documents and forms for the healthcare industry." The cited registration covers computer software for essentially the same purpose (as well as other closely related uses): "providing medical patients secure Internet access to and management of information relating to their own appointments and medical profile." Because there are no limitations as to channels of trade or classes of purchasers in the descriptions of goods and services, we presume that the goods and services move in all normal channels of trade and are available to all potential classes of ordinary consumers. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, because the services described [*6] in the application and the goods identified in the cited registration are highly related if not identical in function, we presume the channels of trade and classes of purchasers to be the same. See *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); see also *In re Viterra Inc.*, 101 USPQ2d at 1908 (finding Board entitled to rely on this legal presumption in determining likelihood of

confusion). In other words, the same consumer may choose to use either applicant's services or registrant's goods for the same or similar purposes.

Applicant argues that its services "are limited in scope to homecare providers and specifically to provide forms for homecare providers, which are required to submit certain information to Medicaid and Medicare programs in order to get paid. Applicant's forms are only offered to home health care providers." n3 No such restriction appears in applicant's recitation of services, however. We are bound by the identifications as written in the application and cited registration and cannot limit applicant's services or registrant's goods - or their geographic territory, [*7] channels of trade, or classes of customers - to what any evidence shows them to be. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986). Therefore, applicant's arguments concerning distinctions between the goods and services actually offered by it and the owner of the cited registration are not persuasive.

n3 Appeal Brief at 7.

In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors strongly weigh in favor of finding that confusion is likely.

We next consider, under the fourth *du Pont* factor, the conditions under which and buyers to whom sales are made. Applicant argues that it "specifically targets consumers limited to the field of homecare providers within the healthcare industry, which are sophisticated customers; as are Registrant's customers being doctors to keep track of medical patient information." n4 Applicant makes no showing [*8] that consumers of its *identified* services are necessarily sophisticated, given the ubiquity of "obtaining and completing documents and forms for the healthcare industry." Moreover, we cannot conclude that the goods in the cited registration are limited to doctors; some are specifically identified as being for use by "medical patients"- the general public.

n4 *Id.* at 9.

Assuming nonetheless that consumers of the respective goods and services are sophisticated, it is well-settled that even careful, sophisticated purchasers are not immune from source confusion, especially in cases such as this involving similar marks and closely related goods and services. *See Cunningham v. Laser Golf Cop.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000); *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). We find that the similarities between the marks, discussed below, and the goods and services offered thereunder outweigh any sophisticated purchasing [*9] decision. *See HRL Assocs. Inc. v. Weiss Assocs. Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

B. Similarity of the Marks

Last, we turn to the *du Pont* likelihood of confusion factor focusing on "the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). "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." *Coach Servs. Inc.*, 101 USPQ2d at 1721 (citation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, we cannot dissect [*10] the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). On the other hand, 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.*, 224 USPQ at 751. We focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Here, applicant seeks to register the mark [redacted] and the cited registered mark is E-MEDSYS. We find the term **eMedesis** to be the dominant portion of applicant's [*11] mark, given its placement and size as the largest element of the mark, many times larger than the additional wording THE LEADER IN HOMECARE DOCUMENT SERVICES. We also note that the latter phrase is disclaimed. Disclaimed terms are typically accorded less weight, or are less significant, because they may be descriptive or generic. See *Cunningham*, 55 USPQ2d at 1846 (quoting *In re Nat'l Data*, 224 USPQ at 752). Here, the disclaimed phrase is descriptive and laudatory.

In addition, for a composite mark like applicant's comprising both a design and words, it is the wording that makes a greater impression on purchasers and is more likely to be remembered as the source-signifying portion of the mark. Purchasers will use the words, as opposed to the design, to call for the goods and services. See *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001) ("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.").

Comparing the [*12] dominant term in applicant's mark **eMedesis** with the cited registered mark E-MEDSYS, we find them to be highly similar in sight, sound, and meaning. The terms are very similar visually and aurally, with the dominant portion of applicant's mark containing only one additional letter and short syllable. With respect to meaning, the Board has recognized the prefix "e" as a shorthand for "electronic." See *In re Int'l Business Machines Corp.*, 81 USPQ2d 1677, 1679 (TTAB 2006); *In re Styleclick*, 57 USPQ2d 1445, 1447-48 (TTAB 2000). Although applicant argues that only registrant's mark has that meaning, n5 we think consumers are likely to view the prefix "e" as a reference to applicant's computer software services as well as registrant's computer software. In addition, applicant's mark incorporates a term very similar to the cited registered mark in its entirety. Likelihood of confusion has been found where the entirety of one mark is incorporated within another. See, e.g., *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner [*13] and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer); *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is likely to cause confusion with WEST POINT for woolen piece goods).

n5 See Appeal Brief at 5.

Applicant's arguments that the marks are sufficiently dissimilar to avoid confusion are not persuasive. Applicant contends that its mark is pronounced as "e" "medsees." n6 It is well-established, however, that there is no correct pronunciation of a mark, and consumers may pronounce a mark differently than intended by the brand owner. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). Although applicant's mark includes a design component, the cross within that design reinforces the shared root "med," signifying that the respective goods and services are used in the medical field. In addition, applicant's descriptive tagline [*14] THE LEADER IN HOMECARE DOCUMENT SERVICES is equally applicable to the software identified in the cited registration, which could be used in association with documents related to home medical care. Finally, because the cited mark is registered in standard character format, its display is not limited to any particular font style, size, or color, and therefore we must consider that the cited mark might be used in any stylized display or color scheme, including one that is similar or identical to the lettering style used by applicant. See *Trademark Rule 2.52(a)*. See also *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014).

n6 Appeal Brief at 4.

For all of these reasons, we find applicant's mark, considered in its entirety, to be similar to the cited registered mark in sight, sound, meaning, and overall commercial impression. The first *du Pont* [*15] factor thus supports a conclusion that confusion is likely.

Conclusion

Having carefully considered the relevant *du Pont* factors, we find that applicant's mark for its identified services is likely to cause confusion with the cited registered mark.

Decision: The examining attorney's refusal to register applicant's mark under *Section 2(d)* of the Trademark Act is affirmed.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawProtection of RightsRegistrationGeneral Overview



In re Laura Geller Make-Up Studios, Ltd.

Serial No. 78815030

Trademark Trial and Appeal Board

2009 TTAB LEXIS 562

August 13, 2009, Decided

DISPOSITION:

[*1]

Decision: The refusal under *Section 2(d)* of the Act is affirmed.

COUNSEL:

Jack L. Most of Goetz Fitzpatrick for Laura Geller Make-Up Studios, Ltd.

William H. Dawes, III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

JUDGES: Before Walters, Cataldo and Taylor, Administrative Trademark Judges

OPINION BY: Walters, Carlisle

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Walters, Administrative Trademark Judge:

Laura Geller Make-Up Studios, Ltd. has filed an application to register the standard character mark PHENOMENAL FOUNDATION on the Principal Register for "cosmetics," in International Class 3. n1 The application includes a disclaimer of FOUNDATION apart from the mark as a whole.

n1 Serial No. 78815030, filed February 15, 2006, based on use of the mark in commerce, alleging first use and use in commerce as of December 31, 2005.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, *15 U.S.C. 1052 (d)*, [*2] on the ground that applicant's mark so resembles the standard character mark PHINOMENAL, previously registered for "perfumes and cosmetics, namely, fragrance, perfume oil, perfume solid, cologne, toilet spray, cosmetics, makeup, lipstick," in International Class 3," n2 that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

n2 Registration No. 3313740, issued October 16, 2007. The registration is owned by Michelle Roark Hormell.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Our determination under *Section 2(d)* is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); [*3] *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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the goods, we look to the goods as identified in the involved application and cited registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's [*4] goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") Moreover, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods both in the application and registration. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). The registered mark includes in its identification of goods "... cosmetics, namely, ... cosmetics..." Thus, applicant's goods are identical to these same goods in the cited registration and it is unnecessary to consider applicant's goods in relation to the other goods identified in the cited registration.

Further, inasmuch as the identifications of goods in both the involved application and the cited registrations are not limited to any specific channels of trade, we presume that the goods would be offered in all ordinary [*5] trade channels for these goods and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In other words, with respect to these identical goods, the trade channels and classes of purchasers are identical. Applicant argues that cosmetics consumers are sophisticated purchasers. There is no evidence of this in the record and it is likely that the class of purchasers for cosmetics is the general consumer, which encompasses purchasers of all levels of sophistication.

Considering, next, the marks, we note that in determining likelihood of confusion, a lesser degree of similarity between two marks is required when the marks are applied to identical goods. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). See also *In re J.M. Originals*, 6 U.S.P.Q.2d (BNA) 1393 (1987). The issue is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side [*6] comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). See also *Nike v. WNBA Enter. LLC*, 85 USPQ2d 1187, 1199-1200 (TTAB 2007); and *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The registered mark consists of the single word PHINOMENAL which is a made-up word that differs by only one letter [*7] from, and is an obvious misspelling of, the actual word "phenomenal." Thus, registrant's mark is substantially similar to, or essentially the same as, the first and dominant word in applicant's mark, PHENOMENAL.

The additional term in applicant's mark, FOUNDATION, is merely descriptive in connection with cosmetics, and it is generic of one type of cosmetic. In a similar case involving the marks LASER and LASERSWING, the Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted).

We take judicial notice of the definition of "phenomenal" in *The American Heritage Dictionary of the English Language* (2007) as "(2) Extraordinary; outstanding: [*8] a phenomenal feat of memory." Thus, there is no question that this term is somewhat laudatory, and, thus, weak, in connection with both applicant's and registrant's identified goods. However, even weak marks are entitled to protection. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

Although the marks have certain differences, when we compare them in their entireties we find that on the whole they are similar in appearance, sound, connotation and commercial impression, and that the differences in the spelling of PHINOMENAL/PHENOMENAL and the addition of the merely descriptive word FOUNDATION to applicant's mark, are not sufficient to distinguish these marks when considered in connection with identical goods.

Applicant misdescribes the registered mark as PHI-NOMINAL, stating that this is the manner in which the mark is used by registrant. Applicant argues that the commercial impressions of the marks are quite different because the connotation of the registered mark is determined by the initial "PHI" portion of the mark, [*9] which applicant characterizes as a mathematical term meaning "the golden ratio." Applicant's argument is unpersuasive. We are bound to consider the marks as they appear in the cited registration and the application. First, the "PHI" portion of the registered mark is not separated from the remaining letters by a hyphen. If we were to consider the "PHI" portion of the word PHINOMENAL to have a unique meaning, the remaining portion of the word, "NOMENAL," is nonsensical. It is much more likely that purchasers will view the mark PHINOMENAL as a unitary term that is a purposeful misspelling of the word "phenomenal."

Applicant also argues that the marks are marketed with their respective house marks appearing on the packaging, which is sufficient to distinguish the marks. However, the respective house marks are not part of the marks involved herein and, thus, the packaging of the products and wording appearing thereon is immaterial to our analysis in this case.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial [*10] similarity in the commercial impressions of applicant's mark, PHENOMENAL FOUNDATION, and registrant's mark, PHINOMENAL, their contemporaneous use on cosmetics is likely to cause confusion as to the source or sponsorship of such goods.

Legal Topics:

For related research and practice materials, see the following legal topics:
 Trademark LawLikelihood of ConfusionGeneral OverviewTrademark LawProtection of RightsGeneral Over-
 viewTrademark LawSubject MatterFragrances



In re Arcus Capital Partners. LLC

Serial Nos. 77566329
77566330

Trademark Trial and Appeal Board

2012 TTAB LEXIS 412

October 26, 2012, Decided

DISPOSITION:

[*1]

Decision: The refusals to register under Section 2(d) in application Serial Nos. 77566329 and 77566330 are affirmed.

COUNSEL:

Michael D. Hobbs of Troutman Sanders LLP for Arcus Capital Partners, LLC.

Wendy Goodman, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

JUDGES: Before Bucher, Zervas and Taylor, Administrative Trademark Judges.

OPINION BY: Taylor, Jyll

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Taylor, Administrative Trademark Judge:

Arcus Capital Partners, LLC ("applicant") has filed applications to register on the Principal Register the standard character marks ARCUS CAPITAL MANAGEMENT (CAPITAL MANAGEMENT disclaimed) n1 and ARCUS CAPITAL PARTNERS (CAPITAL PARTNERS disclaimed), n2 both for "Financial planning and consulting, namely wealth and capital management services" in International Class 36.

n1 Application Serial No. 77566329, filed September 10, 2008, and claiming a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b), *15 U.S.C. § 1051(b)*.

n2 Application Serial No. 77566330, filed September 10, 2008, and claiming a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b), *15 U.S.C. § 1051(b)*.

[*2]

Registration has been refused in each application under Section 2(d) of the Trademark Act, *15 U.S.C. § 1052(d)*, on the ground that applicant's marks, when used on or in connection with the identified services, so resemble the mark in Registration No. 3674631, ARCUS FINANCIAL BANK (in standard character form, "FINANCIAL BANK" dis-

claimed) for "banking services; financial services, namely, administration and management of health savings accounts" in International Class 36, as to be likely to cause confusion, to cause mistake or to deceive.

When the refusal in each application was made final, applicant appealed and requested reconsideration of the final refusal. The request for reconsideration was denied in each application, and each proceeding resumed on October 24, 2011. The appeals have been fully briefed. Because they involve similar issues of law and fact and similar records, we are deciding both appeals in this single decision. n3

n3 We also note that the evidence and briefs in each application are virtually identical. Accordingly, unless otherwise stated, specific arguments and evidence are taken from the record of application Serial No. 77566329.

[*3]

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to a comparison of applicant's marks ARCUS CAPTIAL MANAGEMENT and ARCUS CAPITAL PARTNERS with registrant's mark ARCUS FINANCIAL BANK. In determining the similarity or dissimilarity of the marks, we must consider them in their entirety in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the services offered under the respective marks is likely to result.

Applicant contends that when the respective marks are compared in their entirety, its marks do not create [*4] a likelihood of confusion with the cited mark, and that it is a violation of the "anti-dissection rule" to focus upon the "prominent" feature of a mark, while ignoring all other elements of the mark. Applicant further explains that its use of the words "CAPITAL MANAGEMENT" and "CAPITAL PARTNERS" distinguishes applicant's marks (and the services offered under the marks) from the words "FINANCIAL BANK" used in the cited mark.

We agree that the similarity or dissimilarity of the marks must be determined based on the mark in their entirety, and accordingly, the analysis cannot be predicated on dissecting the marks into their various components. However, one feature of a mark may have more significance than another, and in such a case there is nothing improper in giving greater weight to the more significant feature. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). ("[T]here 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 consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable. [*5] "). For instance, "[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark...." *Id.* Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

Applying these principles to the marks at issue, we conclude that applicant's marks are highly similar to the cited mark. The term "ARCUS" is the dominant portion of the mark in the cited registration because the term "FINANCIAL BANK" is indicative of the nature of the registrant's services, i.e., banking and financial services, and would not be looked upon as a source-identifying element.

Likewise, the term "ARCUS" is the dominant portion of applicant's mark because the terms "CAPITAL MANAGEMENT" AND "CAPITAL PARTNERS" are generic and merely descriptive, and "ARCUS" is arbitrary with respect to banking and financial services. The term "CAPITAL [*6] MANAGEMENT" is indicative of the nature of applicant's services (i.e., capital management services) and the term "CAPITAL PARTNERS" is descriptive when viewed in connection with applicant's entity type. Moreover, applicant disclaimed the exclusive right to use "CAPITAL MANAGEMENT" and "CAPITAL PARTNERS" at the request of the examining attorney, thereby conceding the unregistrable and generic/descriptive nature of those terms as applied to applicant's services. n4 See, for example, *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005); *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453

F.2d 1296, 59 C.C.P.A. 764, 172 USPQ 361, 363 (CCPA 1072). Therefore, the name "ARCUS" is accorded more weight than the terms "FINANCIAL BANK," "CAPITAL MANAGEMENT" and "CAPITAL PARTNERS" in our comparison of the marks. *National Data Corp., 224 USPQ at 751*.

n4 While the disclaimers were entered by Examiner's Amendments without discussion, the examining attorney indicated in her briefs, and applicant did not state otherwise, that the terms "CAPITAL MANAGEMENT" and "CAPITAL PARTNERS" were disclaimed, respectively, as generic and merely descriptive.

[*7]

Additionally, the significance of the word "ARCUS" as the dominant element of both applicant's marks and the registered mark is further reinforced by its location as the first part of each mark. *See Presto Products Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988)* ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)* ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)* (upon encountering the marks, consumers will first notice the identical lead word).

For these reasons, even though applicant's and registrant's marks contain different wording, because of the generic or descriptive nature of the terms CAPITAL MANAGEMENT and CAPITAL PARTNERS in applicant's marks and the term FINANCIAL BANK in the registered mark, and the lesser weight [*8] to which these terms are entitled as we compare the marks in their entireties, applicant's marks and the registered mark are substantially similar in sound, appearance, connotation and commercial impression.

Thus, the factor of the similarity of the marks strongly favors a finding of likelihood of confusion.

We are not persuaded otherwise by applicant's assertion that because the cited mark is not famous, it is entitled to an "extremely" narrow scope of protection. While evidence establishing the fame of the prior registered mark would weigh heavily in support of a finding of likelihood of confusion, the absence of such evidence does not weigh against a finding of likelihood of confusion. Moreover, the fame of the cited registered mark is usually not a factor in *ex parte* cases such as this; evidence of such fame (sales and advertising figures) is not readily available to the trademark examining attorney.

In addition, there is no evidence of third-party use of ARCUS or any other evidence that would lead us to the conclusion that the cited mark is not a strong mark and thus entitled to a greater, rather than a lesser, degree of protection.

We turn then to the relationship between [*9] the services, keeping in mind that the services must be considered as they are described in the application and cited registration, rather than in light of what the services may actually be. *See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)*; *Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987)*. As identified, applicant's services are "financial planning and consulting, namely wealth and capital management services" and registrant's services are banking services; financial services, namely, administration and management of health savings accounts."

The examining attorney contends that applicant's services are related to those of the registrant, specifically maintaining that the "banking services" recited in the identification in registrant's registration and which may be defined as "the business of a bank," n5 is broad enough to include the more narrowly defined "wealth management services" recited in applicant's application. In support of her position, the examining attorney has made of record web pages from the websites of several large national banks, i. [*10] e., Citi, PNC, Wachovia, Chase and SUNTRUST BANK and smaller local banks, i.e., Sandy Spring Bank of Maryland and Burke & Herbert Bank of Virginia, demonstrating that these banking institutions offer a variety of banking services such as the traditional banking services, including checking and savings accounts and financial investment services, including "wealth management" under the same mark. In addition, the webpages from PNC, Wachovia, Chase, and Sandy Spring Bank show that, in addition to providing banking and wealth management services, they also provide management of health savings accounts.

n5 www.thefreedictionary.com/banking retrieved March 15, 2011 and attached to the Final Office Action issued March 15, 1011.

Excerpts from the web pages follow:

Banking

Banking the way it should be.

Citibank offers a wide range of checking, savings, CD and retirement products -- and all come with many free support services including online banking, convenient account access, and 24/7 support. [*11]

Citi Personal Wealth Management

Count on Citi Personal Wealth Management to help you achieve your financial goals -- whether you choose to use a personal advisor or manage your own investments with our support.

Citi Personal Wealth Management is committed to your long term financial success. That's why Citi Personal Wealth Management offers alternative ways of investing -- tailored to suit your needs. [www.online.citibank.com]

PNC's wide range of services can make banking easier, and more convenient than ever. See why PNC's the smart choice for help in meeting your financial goals.

- . Checking
- . Online Banking and Bill Paying
- . Savings
- . Mortgages, Loans & Lines of Credit
- . Credit Cards
- . Investments and Wealth Management
-

INVESTMENTS AND WEALTH MANAGEMENT

Developing and executing a comprehensive financial plan that encompasses every aspect of your financial life can be challenging, particularly when you have substantial assets and sophisticated needs.

... PNC Wealth Management and Hawthorn offer complete wealth management solutions designed for clients with significant assets and complicated financial lives. With the close [*12] cooperation and guidance of an advisor, we will work with you to develop a strategy that includes sophisticated strategies ranging from investment management and estate planning to trust administration and private foundation management.

PNC Health Savings Account

Welcome to PNC Health Savings Accounts
[www.pnc.com and https://www.smart-hsa.com/pnc/]

BANKING

Checking: An account for every lifestyle. ... Whatever you need, we can show you the right solution.
Savings & CEDs: A savings account is a building block to a solid financial future. Check Cards: Visa(R)
Check Cards add banking convenience and purchasing power to your financial life.

WEALTH MANAGEMENT CONTACTS

Wachovia Wealth Management works with individuals and families of substantial wealth. Typically, these clients face a high degree of complexity in managing their financial affairs, have complex legal structures, sophisticated wealth transfer strategies, and many different investment accounts or trusts with multiple providers. If you are faced with many of these same challenges, let Wachovia Wealth Management provide guidance and solutions customized to meet your needs.

WHY CHOOSE [*13] THE WACHOVIA HEALTHADVANTAGE HSA?

With a broad range of products and services to help you save for retirement, a child's college education or everyday savings, Wachovia has the right financial products to help you save when it comes to healthcare costs too.

[www.wachovia.com]

Personal Banking

- . Checking
- . Credit Cards
- . Savings
- . CDs
- . Debit Cards
- . Gift Cards
- . Student Center
- . Online & Mobile Banking

INVEST WHERE YOU BANK

MANAGE YOUR PERSONAL WEALTH

...

To learn more about our wealth management solutions, please email us or contact your local commercial banker for an introduction to a product specialist.

More and more people are learning that a Health Savings Account can provide a smart way to save for future healthcare needs.

The Chase HSA features:

Convenient access to funds with the HSA debit card, Online Bill Payment, ATM and more. ...

[www.chase.com]

Banking

Simply the way you bank with SunTrust's selection of banking products and services. Whether you're looking for a checking or savings account, credit card or access to online services, our solutions are designed to make banking fast and convenient. [*14]

Managing Wealth

Wealth is about much more than a privileged lifestyle. It provides the means to help you realize your life's vision and ensure the well-being of your family. SunTrust Private Wealth Management develops customized solutions for various life stages and professions.

[www.suntrust.com]

Personal Banking

popular products:

- . Online Banking
- . Checking
- . Savings
- . Health Savings Accounts (HSA's)
- . Banking for Kids
- . Mortgages and Loans
- . Investing
- . Wealth Management

Wealth Management

There's really only one way to effectively manage wealth - match it to your unique comfort level and tolerance for financial risk. That's exactly what you can expect a Sandy Spring Bank, a hands-on, approach to managing, growing and preserving your assets.

Health Savings Accounts

A Health Savings Account (HSA) is a tax-advantaged* savings plan that is owned by an individual. ... There are no restrictions on who may contribute to your HSA. Therefore, the individual, the employer, or any other person can make an HSA contribution on individual's behalf.
[www.sandyspringbank.com]

Personal Banking

Personal banking [*15] is about more than offering banking products, it's about offering personal service. ... That's why we offer a full range of products to suit your banking needs, from children's savings accounts and everyday checking accounts to retirement accounts, while offering highly competitive features, rates and rewards.

Investment Accounts & Services

Overview

Slow and steady wins the race. ... And this is based on our conservative fiscally responsible approach to financial growth and wealth management.

...

When you're ready to have your assets managed by a trusted advisor, you can trust our knowledge, discipline and foresight to help build, grow and manage your financial future.
[www.burkeandherbert.com]

In addition, the examining attorney submitted various use-based, third party registrations showing, in each instance, that the same mark has been registered for both applicant's and registrant's types of services. The registrations include, by way of example: Reg. No. 3319600 (GREEN BRANCH) for, *inter alia*, "financial services, namely, banking services featuring checking, savings and investment account services" and "financial wealth management"; Reg. No. 3091741 [*16] (CAPITAL MULTIPLIER) for, *inter alia*, "Financial investment services ... all in the fields of ... capital management" and "banking services"; Reg. No. 3306508 (THE PRIVATE BANK) for, *inter alia*, "Personal money management services, namely, checking account services, savings account services, ... on-line banking services" and "wealth management services"; Reg. No. 3473751 (NEW ANSWERS IN BANKING) for, *inter alia*, "Financial and monetary affairs in the nature of banking services" and "wealth management for individuals, corporations and others ..."; Reg. No. 3255487 (MIDDLEBURG BANK WE KNOW MONEY MATTERS.) for, *inter alia*, "banking services" and "wealth management services, namely cash and asset management services"; Reg. No. 3363763 (PHYSICIANS' FINANCIAL CARE) for "banking" and "wealth management services"; Reg. No. 3593262 TRADING CENTRAL MARKETS NEVER SLEEP) for, *inter alia*, "capital management" and "banking services"; Reg. No. 3573299 (WELLS FARGO BENEFITS) for, *inter alia*, "banking services ...administration of health savings accounts" and "investment management services"; Reg. No. 3769238 (THE POWER TO GET MORE OUT OF YOUR MONEY. THE POWER OF FIRST NIAGARA) [*17] for, *inter alia*, "Banking services" and "cash management accounts"; Reg. No. 3279515 (W (stylized)) for, *inter alia*, "banking services ...[and] providing medical savings account services, namely, administra-

tion of medical savings accounts" and "cash management services ...[and] financial management services"; and Reg. No. 3314410 (FIDELITY TOTAL HR ADVANTAGE) for, inter alia, "administration of health savings plans" and "Financial services, namely, investment management services." n6

n6 We have not relied on Registration Nos. 2970701 and 2931323 because they have been cancelled, or on Registration Nos. 3464424, 3322534, 3889110 and 3283998 because they do not show use on services of a types identified in both applicant's applications and registrant's registration.

Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and services are of a type that may emanate from a single source. *See Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) [*18] (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Based on the third-party registrations and internet materials introduced by the examining attorney, we find that the examining attorney has established that banks traditionally provide services of the types identified in both applicant's applications and the cited registration such that consumers would expect that these types of services, i.e., "capital and wealth management services," "banking services" and "administration of health savings accounts," would emanate from the same source under a common mark. We thus find the evidence sufficient to establish that applicant's and registrant's services are related for purposes of our likelihood of confusion analysis.

Applicant's arguments to the contrary are not persuasive. Notably, the gist of applicant's argument [*19] is that its marks and the cited mark identify different non-competing services. In making this argument, applicant has focused on the administration and management of health savings accounts in the cited registration, maintaining that the registrant does not appear to provide any wealth management services or any services that are not tied to healthcare plans. Pointing to registrant's website, applicant particularly contends that "the services provided by the Cited registrant were not in fact banking services or financial services, but rather should have been classified as healthcare insurance services." App. Br. P. 11. Applicant then explains that it is not a health plan provider and that its services are in no way related to health plans; instead, applicant is "an investment advisor ... serving high net worth individuals, foundations, endowments and retirement plans that seek a disciplined but innovative approach to investment management." *Id.*

In making this argument, applicant has disregarded the "banking services" recited in the cited registration. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on [*20] the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's right to use the mark in connection with the goods or services identified in the certificate. In considering the scope of the cited registration, we look to the registration itself, not to extrinsic evidence about the registrant's actual goods or services, customers, or channels of trade. *See e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence). As such, applicant's extensive arguments regarding the particular nature of both applicant's and registrant's services are irrelevant. While we agree that the services are not the same, as is often stated, the services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would [*21] give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' services. *Albert Trostel & Sons*, 29 USPQ2d at 1785.

For the reasons explained above, the *du Pont* factor of relatedness of the services favors a finding of likelihood of confusion.

Applicant makes similar arguments with respect to the channels of trade and classes of consumers. Applicant again ignores the banking services listed in the identification of the cited registration and accordingly limits registrant's services to customers seeking health plan solutions which it claims travel in trade channels with other health insurers; and further limits its own services to management of high sums of capital which it states are sold face to face. However, in the absence of any limitations to the recitation of services in applicant's applications as to channels of trade and classes

of purchasers, we must presume that applicant's capital and wealth management services move in all usual channels of trade which, as the evidence demonstrates, may include large [*22] and small banking institutions, and are offered to all normal potential purchasers, which may include ordinary consumers with modest net worth seeking capital and wealth management services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The record also reflects that services provided by banking institutions may include the administration of health savings accounts. As such, the channels of trade and classes of purchasers overlap.

Accordingly, the *du Pont* factors of the similarity of the channels of trade and classes of purchasers also favor a finding of likelihood of confusion.

Applicant next argues that consumers who purchase services identified by applicant's marks and the cited registered mark are sophisticated and will make very deliberate decisions because they are seeking services for specific purposes. Applicant particularly contends with respect to its customers that they must have amassed over \$ 5 million in liquid assets or be professional money managers, and that these "extremely sophisticated investors intimately and closely examine the financial services being provided to them." App. Br. p. 17. While that may be so, we are constrained to consider applicant's [*23] services as they are recited in its applications. As just stated, because the recitations do not so limit applicant's consumers, we must presume that applicant also provides its wealth and capital management services to consumers of modest means who would not be so sophisticated or who would not examine the financial services provided to them as closely. Nonetheless, we acknowledge that the purchasers of both applicant's and registrant's services would be somewhat sophisticated and exercise at least some degree of care in selecting the respective services. However, even careful purchasers can be confused as to source under circumstances where, as here, very similar marks are used in connection with related services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 58 C.C.P.A. 751, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible."). See also *Refreshment Machinery Inc. v. Reed Industries, Inc.*, 196 USPQ 840, 843 (TTAB 1977) (selling to a sophisticated purchaser does not automatically eliminate [*24] the likelihood of confusion because "[i]t must also be shown how the purchasers react to trademarks, how observant and discriminating they are in practice, or that the decision to purchase involves such careful consideration over a long period of time that even subtle differences are likely to result in recognition that different marks are involved"). We thus find this *du Pont* factor neutral.

It appears that applicant is also arguing that registrant has abandoned the mark in the cited registration due to non-use. To the extent applicant is challenging the validity of the cited registration, such a challenge constitutes an impermissible collateral attack on those registrations. See Section 7(b) of the Act, 15 U.S.C. § 1057(b); TMEP § 1207.01 (d)(iv). During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., applicant's claim of non-use in connection with the identified services). *In re Dixie Restaurants, Inc.* 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992). [*25] See TMEP § 1207.01(d)(iv)(5th ed. 2007).

As its last argument, applicant maintains that there has been no actual confusion between applicant's marks and the cited mark over three years of simultaneous use, despite applicant's prominent and extensive use of its applied-for marks. As applicant points out, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 14 USPQ 1840 (Fed. Cir. 1990). The lack of actual confusion carries little weight, especially in an *ex parte* context. *J.C Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960 52 C.C.P.A. 981, 1965 Dec. Comm'r Pat. 167, 144 USPQ 435, 438 (CCPA 1965). Moreover, in this *ex parte* proceeding, we have had no opportunity to hear from the registrant as to whether it has encountered any instances of confusion. As the Board previously stated in *In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992):

We recognize, of course, that the above [evidence of an absence of actual confusion] is one-sided inasmuch as it provides only applicant's experience in the marketplace and not that of registrant. Normally, in the absence [*26] of a detailed consent agreement, the registrant has no opportunity to be heard in an *ex parte* proceeding of this type and the Board, therefore, is not in a position to meaningfully assess whether the claimed period of contemporaneous use had provided ample opportunity for confusion to have arisen. ...The asserted evidence of actual confusion, especially over a relatively short period of years, has thus often been asserted to be of "limited influence" or of "dubious probative value". [citations omitted]

Thus, applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion and that *du Pont* factor is neutral.

Finally, applicant throughout its brief has relied on numerous cases to support its arguments in support of registration. We remind applicant that, as often noted by the Board and the Courts, each case must be decided on its own merits. The determination of registrability of a mark in another case cannot control the merits in the case now before us. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). *See also, In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); [*27] *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). Based on the evidence in these proceedings bearing on the relevant *du Pont* factors, we find that applicant's marks ARCUS CAPITAL MANAGEMENT and ARCUS CAPITAL PARTNERS for the identified services is likely to cause confusion with the mark in the cited registration ARCUS FINANCIAL BANK. We conclude so principally due to the similarity of the marks, the relatedness of the services, and the overlapping channels of trade and classes of consumers.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionNoncompeting ProductsGeneral OverviewTrademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawProtection of RightsGeneral Overview



Time Warner Entertainment Company L.P. v. Karen L. Jones

Opposition No. 112,409 to application Serial No. 75/352,605 filed on September 5, 1997

Trademark Trial and Appeal Board

2002 TTAB LEXIS 462; 65 U.S.P.Q.2D (BNA) 1650

January 23, 2002, Hearing

July 17, 2002, Decided

DISPOSITION:

[*1]

Decision: Opposer's Section 2(a) ground of opposition is dismissed. Opposer's Section 2(d) ground of opposition is sustained. Registration to applicant is refused.

COUNSEL:

Michael A. Grow and Christina A. Carvalho of Arent Fox Kintner Plotkin & Kahn, PLLC for Time Warner Entertainment Company L.P.

Eric B. Zimbelman of Romero Montague, P.S. for Karen L. Jones.

JUDGES: Before Bucher, Bottorff and Rogers, Administrative Trademark Judges.

OPINION BY: Bottorff, C.M.

OPINION:

[1652] THIS DISPOSITION IS CITABLE AS PRECEDENT OF THE TTAB**

Opinion by Bottorff, Administrative Trademark Judge:

In this opposition proceeding, Time Warner Entertainment Company L.P. (opposer) opposes the application of Karen L. Jones (applicant) for registration of the mark ROADRUNNER MAPS (and design), depicted below, for "road maps." n1 Applicant has disclaimed the exclusive right to use MAPS apart from the mark as shown.

[**1653] [Link to Image](#)

n1 Serial No. 75/352,605, filed September 5, 1997. The application is based on use in commerce under Trademark Act Section 1(a), *15 U.S.C. § 1051(a)*. July 28, 1988 is alleged in the application as the date of first use of the mark, and October 10, 1988 is alleged as the date of first use of the mark in commerce.

[*2]

As grounds for its opposition, opposer has alleged a likelihood of confusion claim under Trademark Act Section 2(d) based on its prior use and registration of various ROAD RUNNER marks for a variety of goods, n2 and a claim of "false suggestion of a connection" under Trademark Act Section 2(a). n3 Applicant filed an answer by which she denied the allegations in the notice of opposition which are essential to opposer's Section 2(d) and Section 2(a) claims. n4 Both parties presented testimony and other evidence at trial. The case has been fully briefed, and both parties were represented at an oral hearing before the Board.

n2 More specifically with respect to the registrations relied upon by opposer in this case, we note the following. In the notice of opposition, opposer alleged (at paragraph 2) that it "has obtained several federal registrations for its ROAD RUNNER mark, including Registration Nos. 2,000,037; 2,157,957 and 1,288,072." Thus, only three registrations were identified by number in the notice of opposition. At trial, opposer submitted (by notice of reliance) status and title copies of two of those pleaded registrations (omitting Reg. No. 2,157,957), as well as of seven additional unpleaded registrations, i.e., Registration Nos. 2,135,226, 1,946,471, 1,915,162, 950,384, 1,872,562, 1,927,458 and 1,950,585. Applicant has raised no objection to opposer's submission of and reliance upon these unpleaded registrations. In view of applicant's lack of objection, we find that the parties have tried, by implied consent, any issues which arise from those additional seven registrations, and we therefore deem the pleadings to be amended to include opposer's claim of ownership of those seven additional registrations. *See* Fed. R. Civ. P. 15(b); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, fn. 7 (TTAB 1991); *cf.* *Long John Silver's, Inc. v. Lou Scharf Incorporated*, 213 USPQ 263, 266, fn. 6 (TTAB 1982); *Boise Cascade Corp. v. Cascade Coach Company*, 168 USPQ 795, 797 (TTAB 1970). However, inasmuch as opposer's pleaded Registration No. 2,157,957 was not made of record, we have not considered it.

[*3]

n3 In the notice of opposition, opposer also alleged claims of "deceptiveness" and "disparagement" under Section 2(a), but has presented no evidence or argument in support of those grounds. Accordingly, opposer is deemed to have waived those claims. Additionally, in its order dated August 31, 2001, the Board denied opposer's motion under Fed. R. Civ. P. 15(a) for leave to amend the notice of opposition to add a claim based on applicant's alleged non-ownership of the mark for which registration is sought, and we have given no consideration to the arguments the parties have made in their briefs pertaining to that issue.

n4 In her answer, applicant also asserted, as an affirmative defense, that

Opposer's opposition to Applicant's mark is motivated by a desire to restrain trade and create a monopoly in any mark or potential mark containing the word "roadrunner" and/or using, relating to, or referring to a drawing of a roadrunner, no matter how dissimilar to Opposer's design. Opposer is asserting rights greater than those it possesses as a result of its registrations. Opposer is therefore misusing its mark and registrations.

Applicant has not presented any evidence or argument specifically directed to this defense, and therefore may be deemed to have waived it. More fundamentally, to the extent that this defense is based on an alleged violation of the antitrust laws by opposer, it will not be heard because the Board has no jurisdiction over such issues. *See Yasutomo & Co. v. Commercial Ball Pen Co., Inc.*, 184 USPQ 60 (TTAB 1974). To the extent that this defense is intended as an equitable "unclean hands" defense based on opposer's allegedly overzealous enforcement of its trademark rights, we find that applicant has failed to make out the defense. As the Board has noted in previous cases wherein such defense was asserted, "there is nothing in the record to suggest that [opposer] has done anything other than seek to protect its rights in its registered marks, and preclude the registration of what it believes to be a confusingly similar mark, a right which every trademark owner possesses under the Lanham Act." *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992); *see also Cook's Pest Control, Inc. v. Sanitas Pest Control Corporation*, 197 USPQ 265, 268 (TTAB 1977); *see generally* J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th Ed. 6/2001) at §§ 31:101-102. This is especially so in view of our decision, *see infra*, sustaining opposer's Section 2(d) claim.

[*4]

After careful consideration of the evidence in the record and the arguments of the parties, and for the reasons discussed below, we sustain **[**1654]** the opposition as to the Section 2(d) claim, but dismiss the opposition as to the Section 2(a) claim.

The record includes the pleadings and the file of the opposed application. Additionally, opposer, in support of its case-in-chief, submitted the testimony depositions (with exhibits) of its officers and/or employees David Rupert, Michael Simons, Sean Callahan, Jordan Sollitto and Denise D. Mayer, as well as the testimony deposition of Jodi Arlen, a paralegal employed by opposer's counsel. n5 Opposer also submitted, by notice of reliance, the discovery deposition of applicant Karen L. Jones (with exhibits), printouts of numerous printed publications obtained from electronic databases, and status and title copies of nine of its pleaded registrations. The eight extant registrations are summarized as follows: n6

Registration No. 2,000,037, n7 of the mark ROAD RUNNER (in typed form), for

printed matter and paper goods, namely books and magazines featuring animation, comic books, children's books, coloring books, activity books; stationery, **[*5]** writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards, lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets, chalk and chalkboard, decals, heat transfers, posters; photographs; book covers, book marks, calendars, gift wrapping paper; paper party favors and paper party decorations, namely paper doilies, crepe paper, paper hats, invitations, paper table cloths, paper cake decorations, printed transfers for embroidery or fabric appliques, printed patterns for costumes, pajamas, sweatshirts and t-shirts";

Registration No. 1,927,458, n8 of the following mark

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for "motion picture, video, and television films; prerecorded audio-video tapes, cassettes and/or discs featuring animation and/or music";

Registration No. 1,288,072, n9 of the following mark

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for "candy";

[1655]** **Registration No. 1,872,562**, n10 of the following mark

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for "clothing; namely, t-shirts and sweatshirts";

Registration No. 1,915,162, n11 of the mark ROAD RUNNER (in typed form), for "toys; namely, plush dolls, and halloween **[*6]** costumes and masks";

Registration No. 1,946,471, n12 of the mark THE ROAD RUNNER & WILE E. COYOTE (in typed form), for "series of motion picture, video and television films; series of pre-recorded audio-video tapes, cassettes and/or discs featuring animation and/or music";

Registration No. 2,135,226, n13 of the mark ROAD RUNNER AND WILE E. COYOTE (in typed form), for "video game cartridges; video and computer game programs, cartridges, and cassettes"; and

Registration No. 1,950,585, n14 of the following mark

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for "motion picture, video, and television films; prerecorded audio-video tapes, cassettes and/or discs featuring animation and/or music."

n5 Applicant's objection to opposer's testimony deposition evidence will be discussed *infra*.

n6 The ninth registration of which opposer has submitted a status and title copy is Registration No. 950,384, which is of the mark ROAD RUNNER (in typed form) for "comic books." The registration issued on January 9, 1973 from an application filed November 3, 1971. It appears from the status and title copy submitted by opposer that the registration expired in 1993. The registration therefore is not evidence of anything except that it issued. *See* TBMP § 703.02(a) and cases cited therein.

[*7]

n7 Issued September 10, 1996 from an application filed October 26, 1995. June 19, 1967 is alleged in the registration as the date of first use and date of first use in commerce. Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period (*see* TBMP § 703.02(a)) reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

n8 Issued October 17, 1995 from an application filed June 1, 1994. April 1982 is alleged in the registration as the date of first use and date of first use in commerce. Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

n9 Issued July 31, 1984 from an application filed October 1, 1982. July 1976 is alleged in the registration as the date of first use and date of first use in commerce. §§ 8 & 15 affidavits accepted and acknowledged.

n10 Issued January 10, 1995 from an application filed September 7, 1993. November 1, 1987 is alleged in the registration as the date of first use and date of first use in commerce. Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

[*8]

n11 Issued August 29, 1995, from an application filed October 26, 1993. January 16, 1989 is alleged in the registration as the date of first use and date of first use in commerce, and acquired distinctiveness is claimed pursuant to Section 2(f). Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

n12 Issued January 9, 1996 from an application filed August 4, 1994. August 12, 1992 is alleged in the registration as the date of first use and date of first use in commerce. Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

n13 Issued February 10, 1998 from an application filed January 31, 1996. November 1993 is alleged in the registration as the date of first use and date of first use in commerce.

n14 Issued January 23, 1996 from an application filed August 4, 1994. August 12, 1992 is alleged in the registration as the date of first use and date of first use in commerce. Review of the Office's automated records subsequent to opposer's submission of a status and title copy of the registration during its testimony period reveals that §§ 8 & 15 affidavits have been accepted and acknowledged.

[*9]

Applicant, during her testimony period, made of record her testimony deposition (with exhibits), and, by notice of reliance, opposer's answers to applicant's interrogatories. n15

n15 In its August 31, 2001 order, the Board (on opposer's contested motion) ordered stricken applicant's notice of reliance on documents produced during discovery by opposer in response to applicant's request for production of documents, as well as applicant's notice of reliance on a commercial search report. In the same order, the Board also denied (on the ground of untimeliness) applicant's contested motion for leave to file an amended

notice of reliance on printouts of third-party registrations obtained from the Office's automated database (offered by applicant as an amendment to or substitute for the stricken notice of reliance on the search report).

[1656]** In support of its rebuttal case, opposer submitted a notice of reliance on various printed publications and official records, as well as the rebuttal testimony depositions (with exhibits) of Felice Perry and Jodi Arlen, paralegals employed by opposer's counsel.

An evidentiary matter requires consideration prior to our discussion of the merits of **[*10]** this case. In applicant's brief (at pp. 2-4), she "objects to all deposition testimony offered by Time Warner, with the exception of the [discovery] deposition testimony of Karen Jones, for the reason that Time Warner refused to identify to Applicant witnesses and documents in response to Applicant's discovery requests." In particular, applicant cites to its "contention interrogatories" nos. 9-17, in which applicant requested opposer to "identify each and every fact, document and witness in support of your claim that..." followed by certain of the particular allegations made by opposer in the notice of opposition. n16 Opposer responded to these interrogatories by objecting on the grounds that they were vague, overbroad, unduly burdensome, oppressive, and that they were violative of attorney-client privilege, the work product doctrine, and confidentiality; opposer also stated that, although opposer "has not yet completed its investigation of the facts and circumstances surrounding the case," opposer would "provide any relevant documents that support its claims to the extent available pursuant to Fed. R. Civ. P. 33(d)." Applicant, in support **[*11]** of her objection, asserts that opposer identified no witnesses and provided no documents prior to trial, and argues that applicant therefore was deprived of the opportunity to conduct discovery or prepare for cross-examination as to the testimony and documents offered as trial evidence by opposer.

n16 Opposer's pleaded allegations, as identified in applicant's Interrogatory Nos. 9-17 and at page 3 of applicant's brief, are: that opposer's registrations "provide prima facie and conclusive evidence of Opposer's ownership of the mark ROAD RUNNER and of its exclusive right to use the mark in commerce" (Interrogatory No. 9); that the word "maps" "does not serve to distinguish Applicant's alleged mark from Opposer's well-known mark..." (Interrogatory No. 10); that the design feature of applicant's mark is "an imitation of Opposer's well-known ROAD RUNNER character design mark and copyrighted cartoon character" (Interrogatory No. 11); that "the mark which Applicant seeks to register is identical to or so resembles Opposer's mark that its use and registration is likely to cause confusion, mistake and/or deception as to the source or origin of Applicant's goods and will injure or damage Opposer" (Interrogatory No. 12); that "the goods of Applicant are so closely related to the goods and services of Opposer that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods are the goods of Opposer or that Applicant is in some way connected with and/or sponsored by or affiliated with Opposer" (Interrogatory No. 13); that "Applicant's mark so closely resembles Opposer's name and mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act" (Interrogatory No. 14); that "Applicant's mark so closely resembles Opposer's marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act" (Interrogatory No. 15); that "Applicant's mark consists of matter which disparages Opposer and its related companies and which tends to bring Opposer and its related companies into contempt and disrepute in violation of Section 2(a) of the Trademark Act" (Interrogatory No. 16); and that "use and registration of the mark ROADRUNNER and Design by Applicant, alone or in combination with the word "Maps" will deprive Opposer of the ability to protect its reputation, persona and goodwill" (Interrogatory No. 17).

[*12]

We overrule applicant's objections. It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial. *See, e.g., British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989); TBMP § 419(7). We find applicant's interrogatory requests that opposer "identify each and every fact, document and witness in support of its pleaded allegations" to be equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper.

Moreover, we disagree with applicant's contention that she was deprived of the opportunity for discovery or that opposer has engaged in "trial by ambush." We note that, despite her apparent dissatisfaction with opposer's interrogatory responses, applicant never filed a motion to compel further responses from opposer; applicant will not now be heard to complain that opposer's discovery responses were inadequate. **[*13]** *See* TBMP § 523.04 **[**1657]** and cases cited therein. Nor did applicant avail herself of the opportunity to notice and take discovery depositions under Fed. R. Civ.

P. 30(b)(6) of persons with knowledge of relevant facts. In these circumstances, applicant's claim that she was deprived of the opportunity to obtain discovery regarding opposer's case prior to trial is not persuasive.

Finally, even if applicant's interrogatories had been proper and opposer's responses thereto might be deemed to be inadequate or evasive, we find that applicant waived any objection to the testimony depositions and exhibits on that ground. Applicant did not formally or clearly raise her objection to opposer's testimony deposition evidence until she filed her brief on the case. Applicant did not object to opposer's notices of testimony depositions of its trial witnesses on the ground that the witnesses were not identified during discovery, or on any other ground. The Board's review of the testimony deposition transcripts themselves reveals that applicant made only vague objections on the record during three of the depositions, n17 and made no objection at all (as to this [*14] ground of objection) during the other five depositions.

n17 During the second session of the testimony deposition of Jodi Arlen (conducted on November 14, 2000), applicant's counsel, on cross-examination, elicited testimony from Ms. Arlen that opposer's Exhibit Nos. 65-72 are materials she obtained from an Internet search performed on November 9, 2000, and that they were not provided to applicant's counsel prior to the deposition. At page 16 of the deposition, applicant's counsel states: "Other than to object to any newly produced documents, I have no further questions of this witness." During the rebuttal testimony deposition of Felice Perry, at which opposer's Exhibit Nos. 73-77 were made of record, applicant's counsel stated: "Again, I'm reserving all objections to exhibits for trial." (Perry deposition, at 7.) Finally, during the rebuttal testimony deposition of Jodi Arlen, at which opposer's Exhibit Nos. 78-88 were made of record, applicant's counsel, at page 21, stated: "I think I'm entitled to reserve my objection for the trial, and I will do so." To the extent that applicant's counsel, in referring to "the trial," is referring to the final briefing of the case, he is incorrect. In Board proceedings, the "trial" takes place during the testimony periods assigned by the Board, and objections to testimony and/or exhibits thereto generally must be made at trial and renewed in a party's brief. *See* TBMP §§ 701 and 718.04.

[*15]

In summary, we deem applicant to have waived her objection to opposer's testimony depositions and attached exhibits, and we deem that evidence to be properly of record.

We turn now to the merits of opposer's claims. Initially, we find that opposer has established its standing to bring this proceeding. Opposer has presented evidence of its ownership of its various ROAD RUNNER registrations and of its use of its ROAD RUNNER marks on a variety of goods, as well as evidence sufficient to show that its likelihood of confusion claim is not wholly without merit. In view thereof, we find that opposer has established that it has a real interest in the outcome of this proceeding and that it has a reasonable basis for its belief that it would be damaged by registration of applicant's mark. Accordingly, we find that opposer has standing to bring this opposition. *See* Trademark Act Section 13, 15 U.S.C. § 1063; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

We sustain the opposition as to opposer's Section 2(d) ground of opposition. We find that Section 2(d) priority is not an issue in this case, in view of opposer's submission [*16] of status and title copies of its pleaded registrations. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We also find that applicant's mark, as applied to applicant's goods, so resembles the marks depicted in opposer's Registration Nos. 2,000,037 and 1,927,458 as to be likely to cause confusion, to cause mistake, or to deceive. n18 As noted above, Registration No. 2,000,037 is of the mark ROAD RUNNER [**1658] (in typed form) for various items of printed matter and paper goods, including comic books, children's books, coloring books, activity books, and stationery. Registration No. 1,927,458 is of the following mark

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for "motion picture, video, and television films; prerecorded audio-video tapes, cassettes and/or discs featuring animation and/or music."

n18 We find that opposer has failed to prove that any of its other seven pleaded registrations is a Section 2(d) bar to registration of applicant's mark, and our decision on opposer's Section 2(d) claim accordingly is not based on those registrations. Those registrations do not preclude registration of applicant's mark under Section 2(d) because they involve marks (with their references to or depictions of Wile E. Coyote) and/or goods (candy,

clothing, toys) which are too dissimilar to applicant's mark and goods to be likely to cause confusion. Likewise, we do not base our Section 2(d) decision on any alleged common law rights opposer claims in the Road Runner designation. In particular, any use by opposer of its Road Runner character on maps or in connection with online mapping services was subsequent to applicant's proven first use of her mark in 1988, and such use by opposer therefore cannot serve as the basis of its Section 2(d) claim in this case. However, we have considered opposer's other registrations and its common law rights insofar as they are relevant to our likelihood of confusion determination as between applicant's mark, as applied to applicant's goods, and the marks and goods involved in opposer's Registrations Nos. 2,000,037 and 1,927,458, e.g., to the extent that they demonstrate the fame of opposer's mark, or the relationship between the parties' respective goods. See discussion *infra*.

[*17]

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We note as well that "the fifth *du Pont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); see also *Bose Corp. v. QSC Audio Products Inc.*, No. 01-1216 (Fed. Cir. June 14, 2002); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). In view thereof, we shall consider the fifth *du Pont* factor first.

Opposer's Road Runner is [*18] one of opposer's cast of "Looney Tunes" cartoon characters. (Rupert depo. at 24.) Other Looney Tunes characters include Wile E. Coyote, Bugs Bunny, Daffy Duck, Tasmanian Devil, Tweety, Sylvester and Yosemite Sam, among others. (Opposer's Exhibit Nos. 3, 5, 17, 21, 51-52, 54, and 57.)

The Road Runner cartoon character was created in 1949 by the noted animator Chuck Jones, an employee of Warner Bros., opposer's predecessor-in-interest. (Mayer depo. at 8.) That year, the character made its first public appearance in a theatrically-released cartoon short feature, and it appeared in a series of additional theatrical short features through the 1960's. (Mayer depo. at 8-11; Opposer's Exhibit Nos. 45, 47.) The Road Runner character also appeared in a 1960's television series on CBS called The Road Runner Show, and was featured as well on the Bugs Bunny Show and, later, the Bugs Bunny-Road Runner Hour. (Mayer depo. at 8-11; Opposer's Exhibit No. 46.) Approximately forty Road Runner cartoons were produced by Warner Bros. during the character's "classic" period. (Mayer depo. at 13.) In the 1990's, the cartoons were re-released as a series of videos and laser discs. (Mayer depo. at 23; Opposer's [*19] Exhibit Nos. 58-59.) The Road Runner character had its own comic book series beginning in the late 1950's, parts of which were reprinted in the 1970's. (Mayer depo. at 10, 15-16.) In the 1960's, the Road Runner name and character were used in marketing an automobile called the Plymouth Road Runner. (Sollitto depo. at 12.)

The popularity of the Road Runner cartoon character created a demand for Road Runner merchandise, and opposer and its predecessors have licensed the character for use on a wide variety of products over the years, including apparel, accessories, automotive products, collectibles, domestics, gift and novelty items, housewares, personal care items, stationery and paper goods, sporting goods, toys and games. (Rupert depo., at 16-17.) Approximately \$ 500 million worth of Looney Tunes licensed merchandise is sold at retail every year; in 1999, sales of such merchandise totaled approximately \$ 800 million at retail. (*Id.* at 23-24.) These sales figures do not include sales of such products at opposer's own Warner Bros. Studio Stores. (*Id.* at 41.) Because many of these licensed products include more than one of the Looney Tunes characters, opposer does not break [*20] down separate sales figures for each of the characters, such as the Road Runner. (*Id.* at 24-25.) However, [**1659] in the three years prior to October 2000, opposer received over 700 requests from potential licensees seeking licenses to use the Road Runner character on various products. (*Id.* at 25-26.)

Opposer also receives thirty to forty requests every year from companies wishing to use the Road Runner character in promoting and advertising their own goods and services; of the Looney Tunes characters, only Bugs Bunny garners a greater number of such requests. (Sollitto depo. at 13.) Such licensed promotional uses of the Road Runner character have included the character's appearance in a series of commercials for the Pontiac Grand Prix automobile, in a U.S. West Cellular promotional campaign, and in a Pepsi commercial (with the professional athlete Deion Sanders) that aired during the Super Bowl. (*Id.* at 9-10, 12.) The Road Runner character also has appeared together with other of the Looney Tunes characters in third-party promotions and advertisements (Sollitto depo. at 8-9, 11), although the prominence in

those promotions of the Road Runner, per se, is not apparent from the [*21] record. The Road Runner and Wile E. Coyote, along with the other Looney Tunes characters, have been featured in a series of stamps and other products offered for sale by the U.S. Postal Service. (Rupert depo. at 46-50; Opposer's Exhibit Nos. 9-12.) Time Warner Cable, an affiliated company of opposer's, uses the Road Runner name and character in connection with the provision of a broadband Internet service which is available to and advertised to twenty percent of American households. (Callahan depo. at 5-6.)

Opposer presented no specific evidence of the dollar amounts expended on advertising its licensed Road Runner products. It appears that opposer's licensees conduct and pay for the advertising of licensed products, although opposer retains and exercises creative control over the content of the advertisements and the manner in which the Road Runner name and character are used therein. (Rupert depo. at 27-29.)

We find that this evidence suffices to establish that opposer's ROAD RUNNER mark is a famous mark, for purposes of the fifth *du Pont* likelihood of confusion factor. Although there is no direct evidence as to the amounts of opposer's sales and advertising pertaining solely [*22] to the Road Runner, opposer's indirect evidence of fame, including but not limited to the length of time in which the mark has been in use, the large number of requests for licenses of the mark, and the nationwide advertising exposure of the mark, persuades us that the mark is famous under the fifth *du Pont* factor. n19 See *Bose Corp. v. QSC Audio Products Inc.*, *supra*. In our likelihood of confusion analysis, that fame weighs heavily in opposer's favor. See *Recot, Inc. v. M.C. Becton*, *supra*, and *Kenner Parker Toys*, *supra*.

n19 In making our finding that opposer's mark is famous under the fifth *du Pont* factor, we have given no probative weight to the "survey" evidence opposer submitted as Exhibit No. 14 to the Rupert deposition. This exhibit consists of several years' worth of annually-produced documents entitled "The Appeal Of Looney Tunes Characters," all of which state that they are "Based on A National Survey Conducted by C.A. Walker & Associates, Inc." Mr. Rupert testified that opposer uses these documents to demonstrate the popularity of the Looney Tunes characters, including the Road Runner, to potential licensees. (Rupert depo. at 51-52, 62-63.) Applicant did not object to this exhibit during trial, although she has raised an objection to the exhibit at footnote 4 to her brief on the case. Even assuming that the exhibit is properly of record, however, we find that it lacks probative value. To the extent that opposer is offering this exhibit as survey evidence, we find that any probative value it might have is negated by the absence of any evidence as to the methodology and size of the universe underlying the survey. To the extent that opposer is offering these documents under the business records exception to the hearsay rule, we likewise find that they have no probative value. Essentially, these documents are not "business records," but rather are merely advertising materials opposer uses in its attempt to persuade potential licensees to take licenses of its marks. These advertising materials are not persuasive evidence of the truth of the underlying statements contained therein (regarding the popularity of the Looney Tunes characters).

[*23]

We likewise find that the sixth *du Pont* factor, i.e., the number and nature of similar marks in use on similar goods, weighs in opposer's favor. There is no evidence of third-party use of ROADRUNNER marks on similar goods. n20 We conclude therefrom that opposer's mark is strong, as well as famous.

n20 Applicant's proffered evidence of third-party registrations of ROAD RUNNER marks has been disallowed. See *supra* at footnote 15. In any event, third-party registrations are not evidence that the marks used therein are in use in commerce or that the public is familiar with them, for purposes of the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Next, we turn to a determination, under the first *du Pont* factor, of whether applicant's mark and opposer's registered marks, when [**1660] compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their [*24] overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles to the facts of this case, we find that applicant's mark is similar, rather than dissimilar, to the marks depicted in opposer's Registration Nos. 2,000,037 and 1,927,458. Both applicant's mark and opposer's marks consist, in dominant part, of the arbitrary term ROAD RUNNER or its legal equivalent, ROADRUNNER, and/or a fanciful cartoon depiction of a roadrunner bird. In terms of the marks' overall commercial impressions, these [*25] basic similarities outweigh any specific dissimilarities that might be apparent upon side-by-side comparison of the marks, whether those dissimilarities are considered alone or in combination.

Specifically, it is of little legal consequence that opposer uses the two-word formulation ROAD RUNNER, while applicant uses the single word ROADRUNNER; the two formulations sound the same, mean the same thing, and look essentially the same. Likewise, the presence in applicant's mark of the generic, disclaimed word MAPS does not distinguish the marks. Although we do not disregard the word MAPS, we find that it is entitled to less weight in our comparison of the marks. *See In re National Data, supra*. Purchasers are likely to view that word as identifying the goods themselves, rather than in any trademark sense as a means of distinguishing between different sources of ROADRUNNER (or ROAD RUNNER) products.

Finally, the differences in the details of the parties' respective cartoon depictions of a roadrunner bird do not suffice to distinguish the marks in terms of their overall commercial impressions. Regardless of the differences which might be apparent in a side-by-side comparison, [*26] both marks depict a cartoon roadrunner bird. When used as a trademark, the depiction of a cartoon roadrunner bird is no less arbitrary than the words ROAD RUNNER or ROADRUNNER are. The fact that applicant's cartoon roadrunner may not be identical to opposer's cartoon roadrunner in all details is less significant to our analysis than the basic similarity arising from the fact that both marks include a cartoon depiction of a roadrunner.

In *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988), the court stated that "the fame of a mark cuts both ways with respect to the likelihood of confusion. The better known it is, the more readily the public becomes aware of even a small difference." Citing this statement, applicant argues that the very fame of opposer's mark and the resulting purchaser familiarity with that mark will prevent purchaser confusion as to the source of goods bearing applicant's mark. (Applicant's brief at 14.) Applicant also argues that given the close control opposer exercises over the way its licensees depict its Road Runner character in order to ensure its purity and uniformity of presentation, and [*27] because the roadrunner depicted in applicant's mark does not comply with opposer's artistic standards and therefore would not be approved by opposer for use on opposer's licensed products, purchasers will not assume that applicant's mark is one of opposer's marks, or that applicant's use of her mark is authorized by opposer. (Applicant's brief at 23.)

We are not persuaded by these arguments. First, we note that the language from the *B.V.D. Licensing Corp.* case quoted above and relied on by applicant, to the effect that the fame of a mark might serve to diminish the likelihood of confusion, is not controlling precedent. "The holding of *B.V.D.*, to the extent it treats fame as a liability [to the owner of the famous mark asserting likelihood of confusion], is confined to the facts of that case." *Kenner Parker Toys Inc., supra*, 22 USPQ2d at 1457. Thus, the fame of opposer's Road Runner mark, and the familiarity of purchasers [*1661] with the details of that mark, do not weigh in applicant's favor in our likelihood of confusion analysis. Rather, as discussed above, the fame of opposer's mark necessarily weighs heavily in opposer's favor in this case.

As for applicant's [*28] second argument, there is no evidence that purchasers are aware that opposer enforces strict standards as to the manner in which its Road Runner character is depicted on or in connection with licensed products. Thus, we have no basis for concluding that purchasers would be aware that applicant's mark does not comply with opposer's artistic standards, nor for concluding that purchasers would presume, from such noncompliance, that opposer has no connection to the goods sold under applicant's mark. Regardless of the presence or absence of such evidence, however, we would reject applicant's argument because it is merely a variation on the "fame as a liability" proposition rejected by the court in *Kenner Parker Toys*. Purchasers' familiarity with licensed representations of opposer's mark cannot weigh against opposer in our likelihood of confusion analysis.

In sum, we find that applicant's mark and opposer's registered marks (in Registration Nos. 2,000,037 and 1,927,458) look and sound similar, have similar connotations, and create the same general overall commercial impression, and that the first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion [*29] in this case.

We turn next to the second *du Pont* factor, i.e., the similarity or dissimilarity of the parties' respective goods. It is not necessary that these respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their

marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's [*30] goods or services that is required to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applicant's goods are identified in the application as "road maps." We must presume that applicant's goods include all types of road maps, and not just the types of road maps applicant actually markets under the mark at this time. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 FF.2d 901, 177 USPQ 76 (CCPA 1973); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986).

The identification of goods in opposer's Registration No. 2,000,037, of the mark ROAD RUNNER in typed form, includes "children's books, coloring books, [and] activity books." Opposer has presented evidence which shows that a third party, Rand McNally, sells both maps and children's activity books under the same mark, [*31] i.e., "Rand McNally." See opposer's Exhibit No. 73. n21 This is probative evidence that purchasers are likely to assume a source connection between road maps and children's activity books which are sold under the same or similar marks. *Cf. Recot, Inc.*, *supra*; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783; *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). Additionally, it appears from the back cover of Exhibit No. 73 that that one of the children's activity books offered for sale under the "Rand-McNally" mark is entitled "Kids' U.S. Road Atlas," a fact which further supports a finding that a source relationship exists between road maps and children's books. For these reasons, [**1662] we find that, for purposes of the second *du Pont* factor, applicant's goods are related to certain of the goods identified in opposer's Registration No. 2,000,037.

n21 Opposer did not submit any actual maps bearing the Rand McNally mark, nor any registrations owned by Rand McNally which cover maps. However, opposer's Exhibit 73 (a children's activity book) was purchased at the "Rand McNally Map & Travel Store," according to the price sticker appearing thereon; it is reasonable to infer therefrom that Rand McNally also sells maps bearing the Rand McNally mark. Applicant concedes as much when, in discussing this evidence in her brief, she refers to "map maker Rand McNally." (Applicant's brief, at 26.)

[*32]

We also find that applicant's "road maps" are related to the goods identified in opposer's Registration No. 1,927,458, i.e., "motion picture, video, and television films; prerecorded audio-video tapes, cassettes and/or discs featuring animation and/or music," because road maps are within opposer's natural area of expansion. *See generally Mason Engineering & Designing Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985). The goods identified in opposer's Registration No. 1,927,458 obviously feature and/or are based upon opposer's famous Road Runner character. The evidence shows that opposer has licensed that character for use on a wide variety of goods, including automotive items such as automobile floor mats, automobile spare tire covers, automobile license plates and license plate holders (see opposer's Exhibit Nos. 5 and 24), and office stationery items (such as the office phone message book made of record as opposer's Exhibit No. 81) which would be purchased by the same businesspersons who, applicant contends, would purchase applicant's road maps. We also note that opposer apparently has already licensed its Bugs Bunny character mark to VanDam, Inc. for use [*33] on a New York City street map. See opposer's Exhibit No. 23. n22

n22 Applicant's argument that this map is "little more than a tourists [sic] brochure for Manhattan" is unpersuasive. The map is not a mere brochure, but rather is a detailed street map which, according to the price printed thereon, retails for seven dollars.

We conclude from this evidence that road maps are within the natural area of expansion of products for which opposer might license use of its Looney Tunes marks, including the Road Runner. There is no evidence in the record which suggests that opposer would not or could not license the Road Runner mark for use on maps. In view thereof, we

find that purchasers encountering a road map bearing applicant's confusingly similar road runner mark are likely to assume that opposer has licensed or approved use of such mark.

For the reasons discussed above, we find that applicant's goods are sufficiently related to opposer's goods, under the second *du Pont* factor, that confusion is likely to result from the use of the parties' similar marks thereupon. This is especially so in view of the fame of opposer's mark. See *Recot, Inc.*, *supra*.

As for [*34] the third *du Pont* factor, we find that applicant's goods and opposer's goods move in the same trade channels. There are no limitations in either applicant's or opposer's respective identifications of goods, so we must presume that the goods travel in all trade channels normal for such goods. See *Canadian Imperial Bank of Commerce*, *supra*. Furthermore, it is clear from the testimony of applicant and of opposer's witnesses that the parties' respective goods are marketed in the same trade channels and by some of the same retail chains, e.g., CostCo, Office Depot, and Barnes & Noble. For these reasons, we find that the third *du Pont* factor weighs in opposer's favor in this case.

Under the fourth *du Pont* factor (the conditions under which and buyers to whom sales are made), we find that applicant's goods and opposer's goods are marketed to the same classes of customers. Again, no restrictions as to customers are set forth in the respective identifications of goods, and applicant's attempts to limit the purchasers of its maps to professionals and business people accordingly is unavailing. As identified in the application and the registrations, the parties' respective [*35] goods are general consumer items which typically are purchased without a great degree of care or sophisticated thought. For these reasons, we find that the fourth *du Pont* factor weighs in opposer's favor in this case.

There is no evidence of actual confusion between opposer's and applicant's marks, under the seventh *du Pont* factor. However, evidence of actual confusion is notoriously difficult to come by and, in any event, such evidence is not required in order to establish likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *Block Drug v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989); and *Guardian Products Co. Inc. v. Scott Paper Co.*, 200 USPQ 738, 743 (TTAB 1978).

Additionally, the absence of evidence of actual confusion in this case is offset, under the eighth *du Pont* factor, by the absence of sufficient evidence upon which we might base a conclusion that there has been any meaningful opportunity for actual confusion to have occurred. It is true that the parties have used their respective marks concurrently for over thirteen years, and that, for an indeterminate [**1663] period [*36] of time, they have marketed their products through some of the same trade channels and retail chains, i.e., CostCo, Office Depot, and Barnes & Noble. However, we cannot conclude that applicant's sales and advertising of her maps have been so substantial that the absence of actual confusion is surprising or legally significant. n23 See *Gillette Canada Inc. v. Ranir Corp.*, *supra*. In sum, we find on this record that the seventh and eighth *du Pont* factors, which pertain to actual confusion, essentially are neutral in this case.

n23 At page 12 of her brief, applicant contends that she sold more than \$ 1 million worth of maps between 1995 and 1999. However, the testimony and evidence cited by applicant for this proposition (Jones Dep I at 188, Exh. 14, and Jones Dep II at 86, Exhibit 123) fails to bear it out. The evidence and testimony is vague as to the amount of total sales. Additionally, the figures recited appear to include applicant's sales of third-party maps as well as of her own trademarked maps. We cannot determine with certainty the amount of applicant's sales of her own maps and, in any event, we cannot conclude that applicant's maps have been distributed and advertised in such numbers that the absence of actual confusion is legally significant in this case.

[*37]

We find that the ninth *du Pont* factor (the variety of goods on which a mark is used) weighs in opposer's favor. The evidence establishes that opposer has licensed its Road Runner marks for use on a large number of diverse products.

The only remaining likelihood of confusion factor to discuss is applicant's intent in adopting her mark. n24 Opposer argues that applicant adopted her mark with knowledge of opposer's prior rights and, therefore, in bad faith. After careful review of the evidence of record, we conclude that this allegation is unfounded. Applicant's mere prior knowledge of opposer's Road Runner character does not establish that applicant adopted her mark in bad faith. See *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). Applicant has provided a plausible explanation as to why she adopted her mark, i.e., because of her ex-husband's prior "Roadrunner Produce" business and because of the aptness of the roadrunner as a mark for road maps. Opposer has presented no probative ev-

idence which contradicts applicant's explanation or which otherwise proves that applicant adopted her mark in bad faith. Accordingly, [*38] we find that this factor does not weigh in opposer's favor in this case. n25

n24 The defendant's intent is not among the specifically listed *du Pont* evidentiary factors, but evidence with respect thereto can be relevant under the catch-all thirteenth *du Pont* factor.

n25 By the same token, however, the fact that applicant apparently adopted her mark in good faith does not weigh in applicant's favor in our likelihood of confusion analysis. Lack of intent to trade on or copy another's mark will not prevent a finding of likelihood of confusion if a likelihood of confusion otherwise exists. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ 1889, 1891 (Fed. Cir. 1991); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1640 (TTAB 1988).

After careful consideration of the evidence of record pertaining to all of the relevant *du Pont* factors, we find that a likelihood of confusion exists as between applicant's mark and opposer's registered marks in Registration Nos. 2,000,037 and 1,927,458. Applicant's mark and opposer's marks are sufficiently similar, and applicant's goods and opposer's goods are sufficiently [*39] related, that the parties' use of their respective marks on their respective goods is likely to cause confusion. Moreover, opposer's mark is a famous mark which is entitled to a broad scope of protection under *Kenner Parker Toys and Recot, Inc.*, *supra*. Any doubts as to whether a likelihood of confusion exists (we have none) must be resolved against applicant and in favor of opposer. *See In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Therefore, we sustain opposer's Section 2(d) ground of opposition.

However, opposer's Section 2(a) "false suggestion of a connection" ground of opposition fails for lack of proof. Opposer has not presented evidence sufficient to establish the first element of that ground of opposition, i.e., that applicant's ROADRUNNER MAPS and design mark is the same as or a close approximation of opposer's name or identity. *See Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). Opposer owns ROAD RUNNER trademarks, but neither applicant's ROADRUNNER MAPS and design mark, nor even opposer's ROAD RUNNER mark [*40] or cartoon character, constitutes opposer's name or [**1664] identity. n26 Opposer's Section 2(a) claim accordingly is dismissed.

n26 In this respect, opposer's very pleading of this ground of opposition is insufficient to state a claim. In paragraph 16 of the notice of opposition, opposer alleges that "Applicant's mark so closely resembles Opposer's marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act." (Emphasis added.) The issue under Section 2(a) is not whether applicant's mark resembles opposer's marks, but whether applicant's mark is the same as or a close approximation of opposer's name or identity.

Legal Topics:

For related research and practice materials, see the following legal topics:
 Trademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

GRAPHIC:

Pictures 1 through 6, no caption



O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.

Opposition No. 91190886 to application Serial No. 79048720 filed on November 22,
2007

Trademark Trial and Appeal Board

2012 TTAB LEXIS 70

March 8, 2012, Decided

PRIOR HISTORY:

O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A., 2010 TTAB LEXIS 228 (Trademark Trial & App. Bd., June 7, 2010)

DISPOSITION:

[*1]

Decision: The opposition is sustained as to opposer's claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act. Registration is refused as to the goods and services in International Classes 16, 35, 39, 41 and 43. The application will proceed to registration in International Classes 36 and 38.

COUNSEL:

Barth X. deRosa and Melissa A. Alcantara of Dickson Wright LLC for O.C. Seacrets.

Mark Lebow of Young & Thompson for Hotelplan Italia S.p.A.

JUDGES: Before Kuhlke, Cataldo, and Mermelstein, Administrative Trademark Judges.

OPINION BY: Kuhlke, Karen

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Hotelplan Italia S.p.A., seeks registration of the mark SECRETS LINE in standard characters on the Principal Register for goods and services identified in the application as:

Travel books, travel magazines, travel pamphlets, printed matter, namely, travel brochures, maps and travel guides, in International Class 16;

Advertising and promotional campaigns for third parties; business administration of hotels, restaurants, pensions, residences, villas, holiday homes, hostels, camping sites for third [*2] parties; providing office functions; study, plan, realization, managing and organizing of fidelity programs for customers, namely, promoting the goods and services of others by means of a preferred customer benefit program featuring supporter fidelity cards that contain the personal data of the owner for use in conjunction with traveling; conducting incentive bonus schemes in the field of business administration, promotional and advertising campaigns for third parties through the distribution of prepaid stored value cards for the pur-

pose of promoting and rewarding loyalty; market research and analysis services, in International Class 35;

Monetary and financial affairs, namely, issuing of travel checks and letters of credit from brokers or travel agencies, in International Class 36;

Telecommunications services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions; transmission of messages, images, information, sounds and data by internet, by satellite and by cable, in International Class 38;

Travel agencies and tour operators services, namely, organization and reservations of travel [*3] arrangement and travel tickets booking; arranging of cruises and excursions; escorting of travelers and tour conducting; organization and arrangement of sight-seeing tours; consultancy and information relating to travels, transportation and tourism, namely, timetables, airlines tariffs and organizing and cruises; organizing and rental of transportation services, namely, making reservations and bookings for transportation and transportation services by air, road, rail and sea, in International Class 39;

Education services, namely, providing seminars, workshops and training courses in the fields of tourism and hotel trade; organization of sporting and cultural activities, namely, triathlons, and sporting events pertaining to tennis, swimming, golf, gymnastics, volleyball, ski and painting; organizing educational courses, congresses, conventions, exhibitions and meetings, featuring the subject matter of tourism for training staff involved in tourist activities; organizing of sports competitions and sports events in the field of football, tennis, volleyball, swimming, golf, gymnastics and skiing for the entertainment of staff involved in tourist activities; recreation and entertainment [*4] services, namely, organizing sports competitions, sports competitions with prizes, conducting parties featuring party games, planning arrangement of showing movies, shows, plays or musical performances, organization of dancing events and organization of games for children; publication of books, magazines, travel magazines and travel guides, in International Class 41; and

Reservation of hotel rooms for travelers, booking of campground facilities, hostels, arranging temporary housing accommodations, reservations of holiday villages for travelers, reservation of restaurants, in International Class 43.

The application was filed on November 22, 2007, under Section 66 of the Trademark Act, *15 U.S.C. § 1141*, with a foreign priority date of September 17, 2007. The application includes a disclaimer for the word LINE.

Opposer, O.C. Seacrets, Inc., has opposed registration of applicant's mark on the ground that, as applied to applicant's goods and services in International Classes 16, 35, 39, 41 and 43, the mark so resembles opposer's previously used and registered mark SEACRETS for, inter alia, restaurant, bar, hotel, nightclub and live entertainment services, [*5] and a wide variety of collateral goods and services (e.g., a "credit card" for use on the property to encourage customer loyalty and cross-promotion campaigns for travel and hotel stays in Jamaica) as to be likely to cause confusion under Section 2(d) of the Trademark Act, *15 U.S.C. § 1052(d)*. In addition, opposer asserts the ground that applicant's mark falsely suggests a connection with opposer under Section 2(a) of the Trademark Act, *15 U.S.C. § 1052(a)*. n1

n1 The opposition was not brought against the services listed in International Classes 36 and 38. On April 2, 2010, the Board entered judgment in favor of applicant on the fraud claim and denied opposer's motion to add the claim of no bona fide intent to use the mark.

Applicant has filed an answer admitting that "it has not yet used its mark in the United States with respect to the goods and services identified in its application" and denying the remaining salient allegations.

The Record

By operation [*6] of the Trademark Rules, the pleadings herein and the file of the opposed application are of record. Opposer submitted the testimony, with accompanying exhibits, of Leighton Moore, opposer's President and Owner,

and Gary Figgs, opposer's Vice President and Chief Financial Officer. In addition, opposer submitted, under 17 notices of reliance: (1) title and status copies of opposer's pleaded registration for the mark SEACRETS for restaurant and bar services and several other registrations and applications owned by opposer for SEACRET-formative marks for a variety of goods and services; (2) certain of opposer's discovery requests and applicant's responses thereto; (3) printed publications; (4) samples of opposer's print advertising; (5) third-party registrations; (6) dictionary definitions; and (7) a prior Board decision involving opposer.

Applicant submitted, under a notice of reliance, various documents (applicant's brochures, invoices, photographs of promotional articles, etc.) described as "corresponding in part to Opposer's Trial Exhibit No. 147," which consists of applicant's documentary response to opposer's Interrogatory Nos. 8 and 9. Opposer, in its brief, did not object to the [*7] documents submitted under applicant's notice of reliance. It is not clear if applicant intended to submit these documents under Trademark *Rule 2.120(j)(5)*, wherein a party may submit its discovery responses "which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party." Many of the documents appear simply to be duplicates of those submitted by opposer under its notice of reliance. We have considered these documents for whatever probative value they may have.

Applicant did not take any testimony, cross examine opposer's witnesses or file a brief. However, opposer in its brief, states that the parties "stipulated to Applicant having a 'continuing objection to the introduction of evidence related to the mark SEACRET DESTINATIONS on the grounds that this mark, its registration and common law use was not pleaded by Opposer as a basis for opposing Applicant's application.'" Br. p. 11. In general, because applicant did not file a brief, the objections would be considered waived; however, in view of the stipulation we consider the objection to be maintained. The mark SEACRET DESTINATIONS was not pleaded and applicant's objection [*8] is sustained to the extent that we have not considered use of this mark. However, we have considered the evidence pertaining to applicant's provision of travel agency services, albeit under a different mark, to the extent it shows that such services are related to opposer's other services (restaurant, bar, hotel, travel promotion and entertainment services) and the complementary nature of these services.

Standing and Priority

Opposer has made its pleaded registration properly of record. Registration No. 2102604 is for the mark SEACRETS in typed form for "restaurant and bar services." The registration issued on October 7, 1997, based on an application filed on October 31, 1995. Section 8 and 15 affidavits have been accepted and acknowledged, and the registration has been renewed. In view thereof, opposer has established its standing to oppose registration of applicant's mark. In addition, its priority is not in issue as to its restaurant and bar services. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Moreover, opposer has established prior use of its mark SEACRETS in connection with various other goods and services, [*9] in particular, hotel services. Applicant has admitted that it has not begun use of the mark in the United States. n2 Therefore, the date of first use upon which applicant may rely is September 17, 2007. Opposer has established that it has used the mark SEACRETS in connection with the provision of nightclub and entertainment services since 1988, n3 hotel services since at least as early as the spring of 1999, n4 and promoting travel to other destinations since approximately 1994. n5

n2 Answer P 2; Opp. Trial Exh. 142 (Applicant's Response to Admission Request No. 6).

n3 Moore Test. pp. 12, 87.

n4 Moore Test. p. 92.

n5 Figgs Test. pp. 166-169; Moore Test. pp. 76-77.

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

[*10]

We begin with the factor of fame because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Opposer has expended significant sums on a broad-based advertising program in a variety of media, including, print, cable television (e.g., ESPN, USA, MTV, CNN, TNT), radio (approximately 5000 radio spots per year), Internet and billboards. See Moore Test. pp. 154-171, and Figgs Test. pp. 105-124. The advertising, other than on the Internet, is only regional and not national in scale. For example, the print advertising only appears in publications circulated in the Delmarva (Delaware, Maryland, Virginia) Peninsula. In addition, the radio spots are limited to the same region. In keeping with this localized strategy, opposer also [*11] routinely uses banner pulls on airplanes that traverse the beach and "bus wraps" on Ocean City, Maryland buses where the entire bus is dedicated solely to the promotion of the SEACRETS resort.

Opposer has used its mark for more than 22 years and has generated significant income, hosting nearly one million people per year at its complex. It has received numerous awards, including, in 2010, being recognized as the 8th largest nightclub in the entire United States. We note, however, that its restaurants, bars, nightclub and hotel are in one location, on the Mid-Atlantic coast in Ocean City, Maryland. In addition, the record shows that opposer's promotion and marketing of its services under this mark, is concentrated in the region around Ocean City, Maryland. However, by seeking a geographically unrestricted mark, we must consider that applicant seeks to market its goods and services throughout the United States, including in Ocean City, Maryland, and the surrounding region. Thus, while this evidence falls short of demonstrating nationwide fame, it does demonstrate that opposer has attained a substantial degree of renown in the Mid-Atlantic region surrounding Ocean City, Maryland. See [*12] *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007). Strength is measured in degrees and while the record evidence does not show a level of consumer exposure and recognition to warrant a finding of fame, it does establish SEACRETS as a strong mark with significant regional renown which should be accorded a wider scope of protection. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) ("Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it"); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

We now consider the similarity or dissimilarity of the marks when compared in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The points of similarity between opposer's mark SEACRETS and [*13] applicant's mark SECRETS LINE are greater than the points of dissimilarity. The dominant portion of applicant's mark is the first term SECRETS. Applicant has disclaimed the word LINE and the record shows that LINE is merely descriptive of applicant's hotel related services wherein it "distributes hotel stays of affiliated hotels all over the world," n6 because it immediately describes a feature of applicant's services, namely, the provision of a line of hotels. n7

n6 Opp. Trial Exh. 143 (Answer to Interrogatory No. 7 wherein applicant defines LINE as "selection or collection of exclusive hotel properties").

n7 Opp. Trial Exhs. 171 (third-party registrations with LINE disclaimed) and 356 (definitions for the word LINE).

Opposer's mark SEACRETS is phonetically identical to the SECRETS portion of applicant's mark. The only difference in appearance of the common term is the addition of the letter "A" to opposer's mark, which merely serves as a play on its location near the ocean. While opposer's mark, [*14] when viewed, has the additional connotation of the "sea," it retains the connotation of "secrets" which is the same as applicant's mark SECRETS. We note that opposer presented evidence to support this conclusion. Opposer conducted a study of the visitors to its website and found that 27% of them used the natural spelling "secrets" to locate SEACRETS. Figgs Test. pp. 145-150. The overall commercial impressions of SEACRETS and SECRETS LINE is very similar.

Thus, we find the marks to be similar in appearance, sound, connotation and commercial impression and this factor weighs in favor of a likelihood of confusion.

We turn then to a consideration of the goods and services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods and services as they are recited in the registration and application. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The goods and services need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods and services need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered [*15] by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

As noted above, the opposition has been brought against the goods and services in International Classes 16, 35, 39, 41 and 43. It is opposer's position that applicant's goods and services are essentially hotel services that also include goods and services commonly associated with hotel, bar and restaurant services. The evidence of record shows that applicant "distributes hotel stays" by advertising and promoting third-party hotels or villas and taking reservations through its website. n8

n8 App. Trial Exhs. 4 and 5; Opp. Trial Exh. 142.

In addition to its registered restaurant and bar services, opposer provides entertainment and hotel services under the SEACRETS mark. Opposer also uses its SEACRETS mark in connection with a variety of ancillary goods and services [*16] relevant to each of the opposed classes. While opposer does not actually publish travel maps and brochures, it sponsors such publications and it places its advertisements in such publications which are distributed in the same channels as applicant's identified travel maps and brochures in International Class 16.

Opposer has for over a decade engaged in cooperative advertising with other companies such as Air Jamaica and Couples Resort and has promoted its own "Gold Card" to promote customer loyalty on its property. These services are similar to the "advertising and promotional campaigns for third parties" and "distribution of prepaid stored value cards for the purpose of promoting and rewarding loyalty" in International Class 35 of the application.

With regard to applicant's International Class 39 services, opposer submitted several third-party use-based registrations that include both restaurant, bar and/or hotel services, and the arranging of various types of transportation services to support a finding that opposer's restaurant and bar services are related to applicant's various travel arranging services. n9 Third-party registrations which individually cover the services in issue [*17] and are based on use in commerce may serve to suggest that the listed services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). We find the third-party registrations probative on this issue. Moreover, we observe that in 2003, opposer, through a sister company, began offering its travel agency services which include making bookings for transportation. n10

n9 Opp. Trial Exh. 172 (e.g., Reg. No. 3002499 for making reservations and bookings for transportation, arranging of cruises, hotel, restaurant and bar services; Reg. No. 3182547 for making reservations and bookings for transportation, booking seats for travel and escorting of travelers and restaurant services; Reg. No. 1866988 for arranging of excursions for others and hotel, restaurant and bar services; and Reg. No. 3021969 for travel reservation services, escorting of travelers, hotel and restaurant services)

n10 Moore Test. pp. 54-57.

As to applicant's services [*18] in International Classes 41 and 43, opposer has used its SEACRETS mark in connection with a multitude of entertainment services (hosting nightly concerts, parties, fireworks, beauty pageants, etc.) and has provided reservation services for its hotel services. n11

n11 While taking reservations for its own hotel would not be registrable as a separate service, it supports the close relationship between the provision of hotel accommodations and a hotel reservation service.

In view thereof, we find opposer's restaurant, bar, nightclub, hotel and affiliated services to be related to applicant's goods and services in each of the opposed classes. At a minimum, all of applicant's goods and services are related to opposer's restaurant, bar and hotel services as to be likely to cause confusion as to sponsorship. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1594 (TTAB 2011), quoting *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1429 (TTAB 1993) [*19] (likelihood of confusion encompasses confusion of sponsorship, affiliation or connection). See also *Visa International Service Ass'n v. Visa Hotel Group, Inc.*, 561 F. Supp. 984, 218 USPQ 261 (D.C.Nev. 1983) ("Although these financial and hotel services are different and non-competitive, they exist as complementary products in the same general industry, i.e., the travel and entertainment industry, and they are definitely related.")

Moreover, because there are no limitations as to channels of trade or classes of purchasers in the application, we must consider all ordinary channels of trade and classes of purchasers for such goods and services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Thus, applicant's channels of trade and classes of customers encompass opposer's presumed and established channels of trade and classes of customers.

In view of the above, the du Pont [*20] factors of the similarity of the goods and services, the channels of trade and classes of purchasers favor a finding of likelihood of confusion.

On balance, the relevant du Pont factors weigh in favor of a likelihood of confusion. In view of the strength of opposer's mark, the similarity of the marks, the related nature of the goods and services, and the overlap in the channels of trade and classes of customers, we conclude that there is a likelihood of confusion between opposer's mark SEACRETS and applicant's standard character mark SECRETS LINE such that registration of applicant's mark is barred under Trademark Act Section 2(d). As noted above, applicant submitted very limited evidence, did not take any testimony or present any legal argument to rebut opposer's showing.

To the extent there is any doubt, we must resolve that doubt in favor of opposer as the prior user and registrant. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

In view of our decision on opposer's claim of likelihood of confusion, we do not reach the claim of false suggestion of a connection.

Legal Topics:

For related research and practice materials, see the following legal topics:
 Trademark Law Likelihood of Confusion Consumer Confusion Circuit Court Factors Federal Circuit Court Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions Grounds Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions Standing



iMedica Corporation v. Medica Health Plans
Medica Health Plans v. iMedica Corporation

Opposition No. 91159617
Cancellation No. 92043288

Trademark Trial and Appeal Board

2007 TTAB LEXIS 140

July 25, 2006, Oral Hearing

June 7, 2007, Decided

DISPOSITION:

[*1]

DECISION: The petition for cancellation is granted and iMedica's Registration No. 2834742 shall be cancelled in due course. iMedica's opposition to MHP's application Serial No. 76370729 is dismissed with prejudice.

COUNSEL:

Eric D. Paulsrud of Leonard, Street and Deinard for Medica Health Plans.

Mark R. Leonard of Davis & Leonard, LLP for Imedica Corporation.

JUDGES: Before Quinn, Holtzman and Zervas, Administrative Trademark Judges

OPINION BY: Zervas, Albert

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Opinion by Zervas, Administrative Trademark Judge:

This consolidated case involves (i) an opposition proceeding brought by iMedica Corporation ("iMedica") against the registration of application Ser. No. 76370729 ("the '729 application") filed by Medica Health Plans ("MHP"); and (ii) a cancellation proceeding brought by MHP against the continued registration of Registration No. 2834742 ("the '742 registration") owned by iMedica.

In the opposition, iMedica has opposed registration of the mark IMEDICA (in typed form) in the '729 application, filed February 13, 2002 under Section 1(b) of the Trademark Act, *15 U.S.C. § 1051(b)*, for the following services, as [*2] amended:

"physician, hospital, clinic and pharmacy referral services provided via a global computer network" in International Class 35;

"providing on-line messaging among computer users concerning health and medical information; transmission of secure messaging between doctors, nurses, medical staff and patients and other computer users; providing on-line transmission of medical and insurance records" in International Class 38; and

"providing a web site on a global computer network featuring medical, drug and health information, namely, diagnostic advice, symptoms, conditions, treatment, prevention, medical news, tips and advice on health topics, health risks, nutrition and immunization; health care in the nature of a health maintenance organization via a global computer network" in International Class 44. n1

In the notice of opposition, iMedica claims ownership of application Serial No. 75774749 ("the '749 application") for the mark IMEDICA (in typed form), which ultimately registered as the '742 registration and which is the subject of MHP's petition to cancel. n2 iMedica filed the '749 application on August 13, 1999, and the mark registered on April 20, 2004 for [*3] the following services:

"online ordering of medical supplies; providing information in the field of medical office management via a global computer network; providing medical office administrative records via a global computer network" in International Class 35; and

"providing information in the fields of medicine, clinical practice and patient care to others via a global computer network; providing medical and patient records to others via a global computer network" in International Class 42.

The registration claims first use anywhere and first use in commerce on February 8, 2001 for the services in both International Classes. iMedica further asserts in the notice of opposition that it has used the mark IMEDICA in interstate commerce at least as early as February 15, 2000, which is prior to the filing date of MHP's application; and that MHP's use and registration of its mark is likely to cause confusion, mistake or deception that MHP's services are those of iMedica or are otherwise endorsed, sponsored or approved by iMedica under Sections 2(a) and 2(d) of the Trademark Act, 15 U.S.C. §§ 1052(a) and 1052(d). MHP has filed an answer admitting [*4] that the parties' marks are identical, answer at P 6, but denying other salient allegations of the notice of opposition.

n1 iMedica has not opposed the International Class 36 services in the '729 application, i.e., "administration of prepaid healthcare plans, healthcare plan administration services, underwriting healthcare plan[s]; underwriting insurance for prepaid healthcare."

n2 We deem the notice of opposition to have been amended to allege the '742 registration.

In the cancellation proceeding in which MHP seeks to cancel the '742 registration for IMEDICA, MHP has asserted ownership of numerous registrations and applications consisting of, or containing the term MEDICA for various services; that it has a family of MEDICA marks; that it has prior use since at least as early as February 12, 1991; and that confusion is likely to be caused by iMedica's use of its registered mark. n3 MHP filed status and title copies of various registrations with its petition to cancel. iMedica, in its answer, has [*5] denied the salient allegations of the petition to cancel, but has admitted that the trade channels of MHP's IMEDICA mark which is the subject of the opposition are identical to those of its mark.

n3 Because neither party has briefed the Section 2(a) claim, the Section 2(a) claim is moot.

MHP also alleged dilution under the Federal Dilution Act, 15 U.S.C. § 1125(c), in the petition to cancel, but withdrew its claim at p. 7 of its first brief. We hence give MHP's dilution claim no further consideration.

Further, MHP has alleged that iMedica filed false requests for extension of time to file a statement of use on five separate occasions. Petition to cancel at P 14. To the extent that MHP is alleging fraud, because the parties have not briefed MHP's fraud claim, we consider it to have been waived by MHP.

Both parties have filed briefs in both the opposition and the cancellation. The Board held an oral hearing on July 25, 2006.

Background

MHP is both an insurance company and a managed [*6] care organization that does business in Minnesota, western Wisconsin, North Dakota and South Dakota. Its customer membership is approximately 1.2 million members and it has about 50 percent market share in the Minneapolis/St. Paul metropolitan area.

iMedica is a technology company that provides electronic record management products and services for physicians to better manage their practices. iMedica's sole product is PhysicianSuite, comprised of software and hardware that allows physicians to work more efficiently by allowing patient records to be prepared and managed electronically instead of with pen and paper. With PhysicianSuite, medical staff within an office may communicate via instant messaging and allow doctors to access information via the Internet and review referral letters. iMedica has had fewer than 25 customers and those customers are located in several states in the United States including Minnesota, but not Wisconsin, Iowa and North and South Dakota.

The Record

In addition to the pleadings and the status and title copies of the pleaded registrations submitted with the petition to cancel, the record contains MHP's first and second notices of reliance which include, [*7] inter alia, iMedica's discovery responses; and iMedica's first notice of reliance which includes, inter alia, MHP's discovery responses. The record also contains the testimony, with exhibits, of (i) iMedica's two witnesses, namely, Dr. Charles Koo, iMedica's founder, former president and CEO, and current chief technology officer; and Dr. Michael Sullivan of Freeman Sullivan and Company, iMedica's expert witness; and (ii) MHP's three witnesses, namely, John A. Bunge, president of Legal Market Research, Inc., MHP's expert witness; Robert Longendyke, MHP's senior vice president of marketing and communications; and Scott Booher, MHP's chief information officer ("CIO") and senior vicepresident. Additionally, the parties have stipulated to the admission of certain evidence, namely, TARR copies of certain registrations and an advertisement for iMedica's services.

Preliminary Matters

Motion to Amend Notice of Opposition

On August 10, 2005, the Board denied iMedica's contested motion (filed May 23, 2005) to amend its notice of opposition to add a claim of no bona fide intent to use MHP's mark in commerce to the extent that the motion seeks relief under *Fed. R. Civ. P. 15(a)*, [*8] but deferred consideration of the motion to the extent that it seeks relief under *Fed. R. Civ. P. 15(b)*. Approximately three months after the Board's order, i.e., on November 1, 2005, MHP questioned its witness Mr. Booher in his testimonial deposition regarding MHP's bona fide intent to use the mark in commerce, asking among other questions "... at the time the IMEDICA trademark application was filed on February 13, 2002, did Medica Health Plans have a bona fide intent to use the mark in commerce in the United States ...?" Booher dep. at p. 12. In view of MHP's questioning of Mr. Booher, which occurred after the Board's August 10, 2005 order, we find that the issue of no bona fide intent to use the mark in commerce was tried by the implied consent of the parties. We accordingly grant iMedica's motion to amend and consider the notice of opposition amended to include a claim of no bona fide intent to use the mark in commerce.

Evidentiary objections

Both parties have raised objections to some of the evidence submitted by the other party. Each objection is discussed below.

1. MHP objects to iMedica's attempted "correction" of Dr. Koo's testimony. Dr. Koo testified as follows: [*9]

Q. Okay, sitting here today, do you know if there, in your opinion, would be any confusion if Medical Health Plans was to use the name iMedica as part of their business?

Mr. Leonard: Object to the extent that it calls for a legal conclusion. You can answer, Charlie.

The Witness: No.

Mr. Paulsrud: Q. You don't have any opinion?

A. No, I don't think it causes any confusion.

Koo dep. at pp. 59-60. iMedica has filed a "correction sheet" to the deposition transcript in which Mr. Koo sought to change his answer to the first question above from "no" to "yes" and the second question from "No, I don't" to "Yes, I do." The Board does not permit any changes to a testimony deposition which are substantive in nature and which, in effect, changes the testimony after the fact. *See Marshall Field & Co. v. Mrs. Field's Cookies*, 25 USPQ2d 1321 (TTAB 1992), citing *Cadence Industries Corp. v. Kerr*, 225 USPQ 331 (TTAB 1985); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982). Because iMedica's proposed changes are substantive, MHP's objection is well taken and is sustained. Dr. Koo's testimony remains [*10] as he originally stated in his testimonial deposition.

2. iMedica has objected under *Fed. R. Evid. 602* to Mr. Booher's testimony on the ground that he does not have personal knowledge of the subject matter of his testimony as it concerns MHP's contention that it has a bona fide intention to use IMEDICA in commerce; and that "the testimony improperly calls for a legal conclusion." iMedica's opposition brief at p. 7. According to iMedica, Mr. Booher testified that he was not responsible for the decision to file an application and is not aware of the status of MHP's trademark. Booher dep. at pp. 27, 28 and 33. However, Mr. Longendyke testified that the ultimate decision to adopt IMEDICA as a trademark was made by a team consisting primarily of Mr. Longendyke and the CIO. Longendyke dep. at p. 37. Mr. Booher testified that he was the CIO; that he was involved, although "on the periphery"; and further that he "was part of that decision [but] not the ultimate decisionmaker." Booher dep. at pp. 27 and 33. In view of this testimony, we find that iMedica's objection on the basis that Mr. Booher did not have personal knowledge is not well taken and overrule its objection on this basis. [*11]

With respect to iMedica's objection that the questioning of Mr. Booher was conclusory in that Mr. Booher merely repeated "Yes, we do" in response to leading questions on bona fide intent, and that the questions asked for a legal conclusion, we overrule these objections. We construe the questions as asking "did MHP intend to use the mark in commerce when it filed its application?" Also, iMedica's attorney only objected to one of such questions at trial, and did not object at all to the leading nature of the questions during trial.

However, mindful of iMedica's objections, we give Mr. Booher's testimony the weight it is due on the question of MHP's bona fide intent to use IMEDICA in commerce.

3. iMedica objects to Mr. Bunge's expert report (Exhibit A to Mr. Bunge's deposition) involving a likelihood of confusion survey based on the *Eveready* protocol that Mr. Bunge conducted and his opinion testimony regarding the survey. iMedica maintains that the survey is unreliable and inadmissible and that Mr. Bunge's testimony fails to meet the standards required by *Fed. R. Evid. 702*. In the survey, Mr. Bunge identified the relevant universe for his survey as "medical professionals in medical [*12] offices who are responsible for making decisions on which medical services to purchase for their practices," and contacted all 917 physician offices in the Minneapolis/St. Paul, Minnesota area. Fifty-seven respondents participated in his survey. They were shown "a packet of two advertising materials for iMedica Corporation, obtained from iMedica's internet web site, (a two page, 4-color piece titled iMedica PhysicianSuite(R) describing iMedica Corporation and an 8 page, color piece that describes PhysicianSuite)" Exhibit A to Bunge dep. at p. 2. Eight respondents, or about 14 percent, indicated "that the company that puts out those products or services also puts out insurance products, or that the company that puts out those products or services is associated with Medica Health Plans or that the company was authorized by Medica Health Plans to put out the products or services." *Id.*

We find that the small number of survey participants, i.e., slightly greater than six percent, raises a question as to the overall validity of the survey results. Mr. Bunge has acknowledged that the number of participants was small. However, MHP maintains that the survey is proper because Mr. Bunge [*13] took the effort to verify that the sample size was representative of the population surveyed. n4 According to his testimony, the respondents represented sixteen different medical fields; and Mr. Bunge had "no reason to believe that any other specialty would perceive these issues any

differently than those we surveyed." Bunge dep. at p. 24. For this reason, we do not find that the survey has no probative value in view of the small number of survey participants; rather, we find that it is not entitled to great weight. See R. Leighton, *Using Daubert-Kumho Gatekeeping to Admit and Exclude Surveys in Lanham Act Advertising and Trademark Cases*, 92 TMR 743, 777 (200) ("In the end, however, there is no magic minimum number of respondents that will make a sample per se reliable with respect to any particular survey. Sample sizes as low as 32 respondents have been found to have some probity, but not 'great weight.'")

n4 According to Dr. Sullivan, the guidelines set forth at p. 245 in the Federal Judicial Center's *Reference Manual on Scientific Evidence* (2d ed. 2000) recommends that researchers "describe the actions they took to attempt to verify that the completed sample was representative of the population under study" if response rates are lower than 90 percent. Sullivan report at unnumbered p. 3.

[*14]

We also find that the survey results are questionable because the survey did not fairly sample the universe of possible respondents and is biased in MHP's favor. See 3A *Callman on Unfair Competition, Trademarks & Monopolies*, Section 21.67 (4th ed. 1983) ("The universe cannot be chosen in such a way as to bias the results in favor of either party."). Mr. Bunge only sampled medical practices in the Minneapolis/St. Paul metropolitan area, an area in which MHP maintains that it has a fifty-percent market share and where it would likely be well-known. It appears, therefore, that MHP sought to obtain responses from those respondents who knew of MHP and its business, or even who were part of medical practice groups that were providers for MHP. We reasonably conclude that such respondents would be more likely to believe that iMedica's services under the IMEDICA mark are connected to or sponsored by MHP.

Thus, iMedica's objections to Exhibit A and Mr. Bunge's testimony regarding the survey are overruled. n5 However, we do not accord the survey and Mr. Bunge's testimony regarding the survey great weight.

n5 The parties have discussed confidence intervals as they concern the estimated "'confusion' rate." We are persuaded that such intervals do not apply here in light of the statement in the Federal Judicial Center's *Reference Manual on Scientific Evidence* (2d ed. 2000) at p. 244 that "[c]onfidence intervals should not be computed" in the case of a convenience sample.

[*15]

4. iMedica has objected to Exhibit B to Mr. Bunge's testimonial deposition, i.e., a report concerning a 1997 survey in which Mr. Bunge participated, and Mr. Bunge's testimony on the report. The survey was conducted in connection with a claim of likelihood of confusion between MEDICA and DATAMEDICA, a third-party's mark. The purpose of the survey was "to find out whether Medica would be considered a famous name or not among health care providers." Bunge dep. at pp. 32 - 33. According to Mr. Bunge, the survey concluded that "almost nine out of every 10 respondents, were aware of Medica in 1997"; and that there is a "total level of awareness of 86 percent." Bunge dep. at pp. 33 and 116.

iMedica maintains that MHP did not include any documentation relating to or supporting the analysis and conclusions of the report on the 1997 survey with Mr. Bunge's expert report in this proceeding, as required under *Fed. R. Civ. P. 26(a)(2)*. Additionally, iMedica maintains that Mr. Bunge's testimony does not lay a foundation to determine the reasonableness of the methodology or results of the 1997 survey which are needed to determine whether the 1997 survey is sufficiently reliable to allow it to be [*16] admitted.

Federal *Rule 26(a)(2)* is not applicable in Board proceedings. See TBMP §401 (2d ed. rev. 2004). Thus, we overrule iMedica's objection to Exhibit B and Mr. Bunge's testimony regarding Exhibit B. We also overrule any objection that iMedica has to Mr. Bunge's testimony regarding fame because he has relied on Exhibit B in determining that MEDICA is a famous mark. However, we do consider that there is no evidence about the reasonableness of the methodology or results of the report for determining whether the results of the 1997 survey are sufficiently reliable, and hence give Exhibit B, and Mr. Bunge's testimony regarding Exhibit B, limited weight in connection with MHP's contention that its mark is famous.

5. iMedica has objected to Exhibit C to Mr. Bunge's testimonial deposition, dated September 1993 and entitled "Twin Cities Employer Health Care Study"; and Mr. Bunge's testimony regarding Exhibit C. The "Study" - which MHP maintains was another survey - was prepared by a third party for MHP without Mr. Bunge's involvement. Because MHP has not offered any testimony of anyone with first-hand knowledge of the survey, including any testimony as to the mechanics of how the "Study" [*17] was conducted, we sustain iMedica's objection. See *Fed. R. Evid. 703*. We have not considered the 1993 "Study" and Mr. Bunge's testimony on the "Study."

6. iMedica has objected to Mr. Booher's testimony regarding the meaning of the letter "i" as a term in trademarks generally and the admission of Exhibits P (search results for "i" from *AbbreviationZ*) and Exhibit Q (search results for "i" from acronymfinder.com). Because Mr. Booher has testified that he located and downloaded the web pages which are the subjects of Exhibits P and Q, they have been sufficiently authenticated and hence are in the record as evidence of the definition of "i" in *AbbreviationsZ* and acronymfinder.com. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). As far as Mr. Booher's testimony regarding the meaning of "i" based on his experience, that testimony is admissible as to his personal definition of the term "i." However, it is not admissible to the extent that it is submitted to show how the consuming public in general regards the term "i" because Mr. Booher has not been qualified to provide testimony on how the consuming public in general regards the term "i" or on the definition [*18] of "i." Thus, iMedica's objection is overruled in part and sustained in part. See *Fed. R. Evid. 701*.

7. iMedica has objected to the introduction of the *Dechert Annual Reports on Trends in Trademarks* from the years 2000, 2001 and 2002, submitted with MHP's second notice of reliance. iMedica maintains that they are not printed publications or official records, and there is no indication that they are available to the general public in libraries or of general circulation among members of the public. Because there is no indication that these 7 to 11-page reports are available to the general public in libraries or of general circulation among members of the public, or that segment of the general public which is relevant under an issue in this proceeding, the reports are not properly the subject of a notice of reliance. Because MHP has not attempted to introduce these reports through the testimony of any witnesses, iMedica's objection is sustained and these reports are not given further consideration. Trademark Rule 2.122(e), 37 CFR § 2.122(e).

8. iMedica has objected to an amicus curiae brief submitted by the International Trademark Association in *JSL Corp. v. Visa International* [*19] *Services Ass'n, No. 02-1753, 90 Fed. Appx. 484 (9th Cir.)*, and MHP has stated that it does not contest its exclusion from the record. We therefore have given the amicus curiae letter brief no further consideration.

We now turn to the merits of this case, considering first MHP's petition to cancel Registration No. 2834742 pleaded by iMedica in the opposition.

Priority

As noted above, iMedica filed the '749 application for IMEDICA on August 13, 1999. This date is earlier than iMedica's November 2000 first use date of IMEDICA. See Koo dep. at pp. 15 - 21. Thus, iMedica is confined to its application filing date as the earliest date on which it can rely for priority purposes.

MHP asserts ownership of numerous registrations and applications for marks consisting of or containing the term MEDICA. Four of such registrations were filed earlier than the August 13, 1999 filing date of iMedica's '749 application. The four MHP registrations are:

Registration No. 1761828 (renewed) for the mark MEDICA (in typed form), issued on March 30, 1993 from an application filed on October 21, 1991, for "comprehensive health care plans and health plan management services" in International Class 42;

Registration [*20] No. 2113265 for the mark MEDICA (in typed form), issued on November 18, 1997 from an application filed on October 31, 1994, for "administration of prepaid healthcare plans, healthcare plan administration services, underwriting healthcare plans; underwriting insurance for prepaid healthcare" in International Class 36; and "healthcare in the nature of health maintenance organization" in International Class 42, with Section 8 affidavit accepted and Section 15 acknowledged;

Registration No. 2239358 for the mark MEDICA CALLLINK (stylized), issued on April 13, 1999 from an application filed on December 3, 1996, for "medical consulting services, medical information services

and medical resources services available via telephone" in International Class 42, with Section 8 affidavit accepted and Section 15 acknowledged; and

Registration No. 2392584 for the mark MEDICA ELECT (in typed form), issued on October 10, 2000 from an application filed on June 11, 1998, for "administration of prepaid healthcare plans; health care plan administration services; underwriting healthcare plans; underwriting insurance for prepaid healthcare" in International Class 36; and "medical services; hospitals; [*21] and health maintenance organization" in International Class 42, with Section 8 affidavit accepted and Section 15 acknowledged.

MHP has entered a status and title copy of each of these four registrations into the record.

Because the filing dates of the applications underlying MHP's pleaded registrations for the MEDICA, MEDICA CALLINK and MEDICA ELECT marks are prior to the earliest date of use on which iMedica is entitled to rely, that is the August 13, 1999 filing date of the '749 application, MHP's priority has been established. See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998) (plaintiff must show that it was the first to use the mark or, if no evidence of prior use is presented by a defendant and the plaintiff owns a registration, that the plaintiff has the earliest filing date of the application which matured into the registration).

iMedica has argued that MHP cannot claim prior rights in the IMEDICA mark based on use of the mark MEDICA with insurance related services because those services are unrelated to iMedica's services. We reject iMedica's argument - the question of the relationship of the parties' services arises in the [*22] likelihood of confusion analysis, not in connection with issues regarding priority.

Likelihood of Confusion

Our determination under *Section 2(d)* is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Fame

The *du Pont* factor concerning the fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); [*23] *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). That is, we look to the class of customers and potential customers of a product or service, and not the general public. Here, the relevant consuming public comprises prospective and actual purchasers or users of healthcare insurance services. See *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas*, 77 USPQ2d 1492 (TTAB 2005), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

MHP has established that it has a substantial number of members and substantial revenue and that its revenue and membership has been increasing; in 2000 MHP had 1,027,886 individual members with \$ 1,458,394,000 in revenue, and in 2003 MHP had 1,102,921 members with \$ 1,852,322,000 in revenue. Longendyke Dep. at p. 12; Exhibit H. Additionally, MHP has established [*24] that its advertising expenditures are substantial, amounting to millions of dollars per year, with such expenditures rising each year. Further, Mr. Longendyke has testified that MHP has a 50 percent market share in the Minneapolis/St. Paul metro area. Longendyke Dep. at p. 28. Mr. Booher has testified that MHP "is very well known in the upper Midwest and has a very deep penetration with the [health care] provider community" Booher dep. at p. 20. We find that this evidence strongly indicates that a significant portion of the relevant consuming public associates MEDICA with MHP's business activities. The results of the 1997 survey, i.e., that 9 out of 10 respondents were aware of Medica and that there is a "total level of awareness of 86 percent," and Mr. Bunge's testimony regarding the 1997 survey, which we have given limited weight to, provide some further support for our finding.

iMedica's challenges to MHP's evidence of fame do not persuade us otherwise. Specifically, iMedica maintains that MHP's 50 percent market share is only in one metropolitan area; that MHP's advertising expenditures are well below the amounts spent in cases such as *Bose, supra* (annual [*25] nationwide advertising expenses in excess of \$ 30 million) and *Recot, supra* (\$ 80 million in annual national advertising); that MHP does business in a limited geographic area; and that the advertising expenditures of record do not show expenditures by mark. Even though MHP's advertising expenditures are below those of *Bose* and *Recot*, they are not insignificant in amount. Also, although MHP has introduced evidence of its market share only in one market, that market includes a major U.S. metropolitan area and spans all or part of four states. Moreover, the total number of MHP's members is significant, and so are its revenues. As far as MHP's advertising expenditures, we accept such expenditures as advertising figures for the mark MEDICA because they are consistent in amount, and MEDICA appears on virtually all of the promotional materials of record, is part of MHP's corporate name and forms a part of most of the MHP marks in MHP's promotional materials of record.

Thus, we find that MHP is an extremely well known mark in the geographic area in which it does business, especially in Minnesota, and is entitled to benefit from the *du Pont* factor regarding the [*26] fame of the mark. We acknowledge that Medica is not known nationally, but national fame is not necessary. See, e.g., *Karl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995) (opposer had established notoriety in a specific area of operation); *Berghoff Restaurant Co. v. Washington Forge, Inc.*, 225 USPQ 603 (TTAB 1985) (opposer's proof of fame of its mark within a limited geographic area sufficient to find its mark famous for purposes of the likelihood of confusion analysis). This factor therefore weighs heavily in favor of finding a likelihood of confusion.

The Marks

We next consider the similarity or dissimilarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). [*27]

The marks MEDICA and IMEDICA only differ by iMedica's addition of the letter "i" before MEDICA, which is MHP's entire mark. The evidence from acronymfinder.com and *AbbreviationZ* shows that among the meanings of "i" is "Internet." See also *In re Zanova, Inc.*, 59 USPQ2d 1300, 1304 (TTAB 2000) ("When we consider the possible significance of 'I' in ITOOL to prospective purchasers of applicant's goods or services, we find that they will readily accept 'I' as meaning 'Internet'...."). Thus, the addition of the letter "i" to MEDICA does not create a different commercial impression from MEDICA, but merely indicates that there is an Internet feature to the services. This is particularly true in the context of iMedica's computer-related services, which iMedica's identification of services specifies are rendered via the Internet. n6 Moreover, we find that the addition of the "i" to MEDICA does not significantly change the meaning of the mark, given that the record does not show any English language definition for "imedica" or for MEDICA.

n6 We therefore reject iMedica's contention that the "i" signifies "information."

[*28]

Further, iMedica has admitted that it uses the element "i" in a lower case and the letter "m" in upper case letters. iMedica's responses to requests for admissions nos. 38 and 39. The marks hence are similar in appearance, with the capital "m" causing the purchaser to focus on the "medica" portion of the mark. In terms of sound, the marks are similar too, with the "medica" portion of iMedica's mark pronounced identically to MHP's mark.

MEDICA ELECT and MEDICA CALLINK are also similar in sound, meaning, appearance and commercial impression to IMEDICA due to the shared component MEDICA. MEDICA is positioned first in each of MHP's marks. It accordingly is the term in each of MHP's marks most likely to be remembered by purchasers. In iMedica's mark, because of the visual separation caused by the lower case "i" and the upper case "m," the association of the letter "i" with the Internet, and the fact that the MEDICA portion begins with a capital letter, MEDICA dominates in the mark IMEDICA. While there are apparent differences between iMedica's mark and MEDICA ELECT and MEDICA CALLINK, the similarities between the marks in light of the shared term MEDICA outweigh the differences between [*29] IMEDICA and these marks.

iMedica has made of record numerous registrations containing the term "medica," and argues that they show that "medica" is not a unique, dominant, coined term but rather is a fairly common term suggestive of medical services and medical technology fields. n7 Several of the registrations state that an English language translation of "medica" is "doctor" or "medical" and/or include disclaimers of "medica." Many of such registrations recite goods and/or services that have a connection to the healthcare field.

n7 In support of its argument, iMedica also made several applications of record. Third-party applications are only proof that the applications have been filed and thus are without probative value to the likelihood of confusion issue. See *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973).

Also, of the registrations made of record, we have not considered those registrations that (i) claim goods or services that are significantly different from MHP's services, or (ii) claim *Section 44* of the Trademark Act as a basis for registration.

[*30]

Third-party registrations are not evidence of use of the marks shown therein. Without evidence of use, the third-party registrations prove nothing about the impact of the third-party marks on purchasers in terms of conditioning consumers as to the existence of similar marks in the marketplace. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). They may, however, be relied on to show that a word common to each mark has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel, Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466 (TTAB 1990). In this case, the third-party registrations for marks including MEDICA for medical products, medical clinics, healthcare consultation and healthcare educational services show that those in the healthcare industry use MEDICA in a manner intending to connote "medical." Such use tends to show that MEDICA is slightly suggestive. However, this does not appreciably weaken the strength of MHP's marks.

As far as policing of the marks, MHP has offered only limited evidence of its policing activities. The record contains one [*31] cease and desist letter directed to one thirdparty and one consent agreement between MHP and another third-party. Longendyke dep. at pp. 29 - 31; Exhibits K and L. Because there is no evidence of third-party uses of related marks which MHP has tolerated, MHP's limited enforcement activities do not indicate a willingness by MHP to tolerate third-party uses of MEDICA.

In view of the foregoing, the *du Pont* factor regarding the similarity or dissimilarity of the marks weighs heavily in MHP's favor.

The Services

In arguing that the *du Pont* factor regarding the similarity or dissimilarity of the services should be resolved in its favor, MHP maintains that some of MHP's services described in its four registrations "overlap or encompass many of the services described in iMedica's registration." MHP reply brief at p. 15. According to MHP, "health maintenance organization" (see Registration No. 2113265 for MEDICA and the registration for MEDICA ELECT) would naturally include the International Class 42 services of "providing information in the fields of medicine, clinical practice and patient care to others ... ; [and] providing medical and patient records to others . [*32] ..." MHP reply brief at p. 16. "These services are part of what an HMO [health maintenance organization] does." *Id.* Mr. Longendyke has testified that MHP currently provides information in the fields of medicine, clinical practice and patient care to members, providers and visitors via the Internet, and that it provides member access to patient records over the Internet to the extent those patient records are claims records. Longendyke dep. p. 23. He has also stated that physician claims may be submitted electronically; and that those submitting claims may obtain information from MHP's website regarding claim submissions, including "why there is a holdup and explanations." Longendyke dep. at p. 16. Further, he testified that a managed care organization, or health maintenance organization is "much more than an insurance company." Longendyke dep. at 20.

A health maintenance organization or health insurer certainly provides information in the fields of medicine, clinical practice and patient care to others and provides medical and patient records to others. Such services are integral to those services which a health maintenance organization and a health insurer provide to or for [*33] their members and

MHP currently provides such services. Thus, we find that iMedica's International Class 42 services are encompassed within MHP's health maintenance organization and/or health insurance services.

iMedica's International Class 35 services are similar to MHP's services. iMedica has admitted in its response to request for admissions no. 36 that "iMedica's customers consist primarily of out-patient healthcare providers ranging from 1 to 2 physician clinics up to 150+ physician groups" and has stated at p. 25 of its main brief in the cancellation that a physician who provides services to an MHP customer is potentially a user, implying that the physician would come in contact with iMedica's mark. n8 Also, Mr. Longendyke has testified that MHP's customers include anyone in its geographic market in the market for healthcare insurance; that these customers include employers as well as individuals; and that MHP markets its services to the same customers to which iMedica markets its services. Longendyke dep. at p. 26 - 27. We therefore find that the physician clinics and physician groups which purchase iMedica's services are also the employer groups which purchase MHP's services. [*34] Thus, there is an overlap in purchasing entities.

n8 iMedica adds, however, that there is no evidence that a physician purchases MHP's services or that an employer group purchases iMedica's services. This is not correct. Mr. Longendyke has testified that MHP's customers include anyone in its geographic market in the market for healthcare insurance; and that these customers include employers as well as individuals. Longendyke dep. at pp. 25 - 26. Also, medical practice groups - which are employer groups - to which iMedica markets its goods are included as potential purchasers of MHP's services.

iMedica, however, has argued that those who make purchasing decisions for its services and MHP's services differ, even though they may be working in the same overall healthcare field. iMedica cites to the Federal Circuit's decision in *Electronic Design and Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), for the proposition that only those who make purchasing [*35] decisions could be considered relevant persons, and that not all users are necessarily relevant persons for determining likelihood of confusion, especially where the parties' respective goods and services are non-competitive.

We are not persuaded by iMedica's argument. First, Mr. Longendyke has testified that MHP markets its services to the same customers to which iMedica markets its services. Longendyke dep. at p. 26 - 27. This is to be expected in this case because iMedica has admitted that its customers include "out-patient healthcare providers ranging from 1 to 2 physician clinics," and it can be expected that physicians in smaller clinics would make purchasing decisions involving services of the nature of those provided by MHP and by iMedica. Thus, unlike in *Electronic Design*, there is evidence that both parties market to the same individuals. n9

n9 iMedica maintains that its "sales efforts are directed to the Chief Medical Officer, Medical Director, Medical Informatics Officer, Chairman of IT committee, Administrator and/or chief executive officer of outpatient clinics." Brief at p. 32. MHP responds that "[t]hese are the same individuals Medica is trying to reach both to sell its health plan and HMO services, and also to enlist as providers within its HMO network." MHP reply brief at p. 19; Longendyke dep. at pp. 25 - 26; Booher dep. at pp. 8 - 9.

[*36]

Second, even in larger clinics where it is not the physician who is placing the order for iMedica's services but rather is a non-physician purchasing specialist, we view skeptically any suggestion that a non-physician purchaser of iMedica's services, which are intended to be used by physicians in running virtually every aspect of their practices, would not have significant input from physicians. Such physicians would likely be the same physicians who are MHP providers.

Because physicians are involved in purchasing decisions for both services, especially when the physician is an employer and requires medical insurance for his or her practice group, the marketing of the parties' respective services is such that both services could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from a common source. Hence we find that iMedica's International Class 35 services are related to MHP's health maintenance organization and health insurance services. n10 *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

n10 iMedica's argument that there is a lack of overlap between relevant purchasers of each parties' services because iMedica is a technology company that provides electronic record management products and services for physicians to better manage their practices and MHP is a health maintenance organization that provides its insurance products and services to employer groups, and its reliance on *Electronic Design, supra*, are misplaced for the reasons mentioned above.

[*37]

The parties have argued extensively as to whether iMedica's services are within the zone of expansion of MHP's services under the doctrine of expansion. Because we have found the services to overlap or to be related on other grounds, we need not reach their arguments regarding the zone of expansion.

Trade Channels

We have found earlier in our decision that iMedica's International Class 42 services are encompassed within MHP's services. There are no specific trade channel limitations in the parties' respective identifications of services. When there are no such limitations or restrictions in the identification of goods and/or services as listed in the subject registration and in the identification of goods and/or services as set forth in any of a plaintiff's registration(s), the issue of likelihood of confusion is determined in light of a consideration of all normal and usual channels of trade and methods of distribution for the respective goods and/or services. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). [*38] Thus, we find that the International Class 42 services are related.

With regard to the International Class 35 services, neither party has submitted evidence on the exact nature of the trade channels for their respective services. n11

n11 MHP relies on iMedica's allegation in its original notice of opposition that MHP's International Class 35, 38 and 44 services are within the same trade channels as the services of iMedica's registration. Because iMedica sought to remove that allegation in its amended notice of opposition, we do not hold iMedica to its allegation.

Thus, we find that with respect to the International Class 42 services, this *du Pont* factor must be resolved in MHP's favor, and that with respect to the International Class 35 services, this factor is neutral.

Conditions of Sale and Sophistication of Purchasers

iMedica maintains that its customers include physicians seeking electronic record management products and services to better manage their practices; and that its customers [*39] are sophisticated. MHP has acknowledged that iMedica's purchasers are sophisticated, but is silent regarding the level of sophistication of MHP's purchasers. iMedica has pointed out that the Board, in *Carefirst of Maryland, supra*, addressed the level of purchaser sophistication of purchasers of healthcare and health insurance services. In that case, the Board found that ordinary consumers are prospective and actual purchasers or users of healthcare insurance plans or programs; and stated that, even ordinary consumers exercise some sophistication when it comes to decisions relating to healthcare and healthcare insurance services. The Board recognized the substantial financial commitment of such insurance and services; that decisions to purchase healthcare insurance and related services are important; and that purchasers will proceed cautiously and deliberately in making their decisions. The Board also considered non-purchasing users of healthcare and healthcare insurance services, noting that a small business, for example, might purchase coverage for its employees from a single provider; and that in this situation, the employees are not involved in the purchasing [*40] decision. According to the Board, such non-purchasing users of healthcare and healthcare insurance are also sophisticated. We know of no reason why the same would not apply in this case with respect to MHP's services when MHP's customers are employer groups, and find that the purchasers of both parties' services are sophisticated.

With respect to the conditions of purchase, the record shows that the sales process for both parties' services is lengthy and involves repeated contact with either iMedica or MHP by the prospective purchaser. iMedica's answer to interrogatory no. 7b. Further, both parties' services are expensive, with MHP's services provided on a monthly subscription or flat fee basis to its customers which can cost thousands of dollars even for a small office. We therefore find that the services are made with deliberation and care.

While both parties' purchasers may be sophisticated or knowledgeable in a particular field, and even deliberate in their purchasing decisions, they are not immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). In view of the substantial [*41] similarity of the parties' marks, and particularly the descriptive nature of the letter "i" located at the beginning of iMedica's mark which is otherwise identical to MHP's mark, we find that the factors regarding the sophistication of purchasers and conditions of sale weigh only slightly in iMedica's favor.

Actual Confusion

There are no reports in the record of any instances of actual confusion in the marketplace between the parties' marks as used in connection with their services. This, of course, may be attributable to the slight overlap where the parties have been doing business and the relatively small number of iMedica customers thus far.

The record does contain, however, a likelihood of confusion survey in which several respondents expressed confusion as to the source of iMedica's services. As discussed previously in this decision, MHP commissioned a likelihood of confusion survey, using a universe of 917 physician offices with fifty-seven respondents participating in the survey. Eight respondents, or about 14 percent, indicated some source confusion. Courts have accepted surveys showing similar rates of confusion. See *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 5 USPQ2d 1314 (8th Cir. 1987) [*42] (declining to find that district court erred in its decision after a trial on the merits to give evidence of approximately ten percent of confusion "significant weight"); *Humble Oil & Refining Co. v. American Oil Co.*, 405 F.2d 803, 160 USPQ 289 (8th Cir. 1969) (finding that in evaluating an application to modify an injunctive decree an eleven percent rate of actual confusion "may not [be] dismiss[ed] as de minimis"); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf v. Steinway & Sons*, 365 F.Supp. 707, 180 USPQ 506 (S.D.N.Y. 1973) (concluding after a bench trial that survey results that twenty-three recent purchasers had some confusion of origin, 7.7 percent of 520 people canvassed perceived a business connection between the two companies and 8.5 percent confused the names was "strong evidence of the likelihood of confusion"). In view of the manner in which the survey was conducted, however, the survey and Mr. Bunge's testimony regarding the survey are not entitled to great weight. Nonetheless, they have some probative value on the question of likelihood of confusion, to wit, the survey indicates that a sufficient number of respondents believed [*43] that there was a connection between iMedica and MHP upon reviewing certain promotional material from iMedica. This evidence reinforces MHP's position that there is a likelihood of confusion between the marks.

Family of Marks

The family of marks doctrine applies in situations where the plaintiff has established a group of marks characterized by a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar goods or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to defendant's first use of its challenged mark, the various marks said to constitute the family, or at least a good number of them, were used and promoted together in such a manner [*44] as to create among purchasers an association of common ownership based upon the family characteristic. *Id.*, 18 USPQ2d at 1891. See also *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); *Cambridge Filter Corp. v. Senvodyne Corp.*, 189 USPQ 99 (TTAB 1975).

In this case, the record does not show that MHP's MEDICA marks were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. Thus, MHP has not met its burden of establishing that a family of marks exists in this case. Simply using a series of similar marks does not of itself establish the existence of a family.

Length of Time During and Conditions Under Which the Marks of the Parties Have Been in Use

Mr. Koo has testified that iMedica has only completed one sale in the common geographic areas in which MHP and iMedica have been doing business; and that iMedica has had fewer than 25 customers. Koo dep. at pp. 39 and 42. In view thereof, we find this factor neutral, even though both marks have been used concurrently for at least five years without any reported instances [*45] of actual confusion.

Conclusion

MHP has established it has priority by virtue of its registrations for the marks MEDICA, MEDICA ELECT and MEDICA CALLLINK. In balancing the above factors, and particularly considering the regional fame of MEDICA and Federal Circuit precedent providing that the fame of the mark is a dominant factor in questions of likelihood of confusion, we find that MHP has established by a preponderance of the evidence that there is a likelihood of confusion between its mark and MHP's marks. Accordingly, the petition to cancel is granted and Registration No. 2834742 will be cancelled in due course.

Imedica's Claim of No Bona Fide Intent to Use the Mark in Commerce

We now turn to iMedica's claim in the opposition that MHP did not have a bona fide intent to use its IMEDICA mark in commerce. iMedica has based its claim on the testimony of Mr. Longendyke that it was MHP's normal practice to generate an advertising plan, product literature, pamphlets, and brochures once a new mark enters the trademark registration process; and that MHP did not follow that practice with regard to the IMEDICA mark because it has no plans to use the mark. Further, iMedica [*46] points out that MHP produced no documents related to its alleged planned use of IMEDICA. Longendyke dep. at pp. 36, 38 and 39.

We are not persuaded by iMedica's arguments. Mr. Longendyke's testimony is as follows:

Q. Are there any current advertising plans for the IMEDICA mark?

A. No, there aren't.

Q. Can you tell me why that is?

A. Because we think it's a confused mark right now and we don't think it's wise for us to use it.

Q. And no materials have been prepared using the IMEDIA mark?

A. No, they have not.

Q. So there are no current plans to use IMEDICA as a trademark for Medica Health Plans?

A. Not currently.

Mr. Longendyke's testimony was not that MHP had no plans to use the mark; his testimony was that it did not have current plans to use the mark. Also, Mr. Longendyke explained why MHP had no current plans, and that was because it is a "confused mark," i.e., that it placed any plans to use the mark aside until the conflict between the parties is resolved. This explanation as to why it did not have documents is reasonable and one that we accept, despite the fact that MHP learned of iMedica and its imedica.com website in November [*47] 2000 and filed its application over one year later. MHP's answer to interrogatory no. 3. Thus, we find that iMedica has not shown by a preponderance of the evidence that MHP lacked the necessary bona fide intention to use the mark in commerce at the time of the filing of its application for the IMEDICA mark.

iMedica has argued that there is no conflict over MHP's use of IMEDICA in connection with the International Class 36 services related to the administration of health care plans, services which iMedica did not oppose, and that MHP still did not create any documents or plans related to the use of IMEDICA in connection with such International Class 36 services. MHP can hardly be faulted for suspending its plans to use a mark on services identified in one International Class in an application, after iMedica opposed three other International Classes in its application. MHP may reasonably have viewed the services identified in the IMEDICA application as complimentary, and hence may have

reasonably intended to use one mark on all four services, rather than possibly using a different mark on the three opposed services, if it did not prevail in the opposition. Also, we are not persuaded [*48] by iMedica's argument that MHP filed its application for tactical purposes because six days prior to the filing date of MHP's application, MHP filed an opposition against another application for IMEDICA by iMedica. It certainly is reasonable for MHP to want to use IMEDICA as an adjunct mark to its primary mark MEDICA, especially for services which have a connection to the Internet. Also, it is particularly telling that MHP filed an application for EMEDICA, i.e., application Serial No. 76370965, on the same date that it filed its application for IMEDICA. The filing of these two marks on the same date suggests a business strategy in eventually using certain mark(s) rather than a legal strategy in a dispute with another party.

iMedica's Claim of Likelihood of Confusion in the Opposition

iMedica has alleged priority and likelihood of confusion based both on the '742 registration and on its use of IMEDICA in commerce. Because we have found above that the '742 registration should be cancelled, iMedica's opposition on the basis of the '742 registration is dismissed. To the extent that iMedica bases its opposition on its common law rights to IMEDICA, we have determined that MHP has priority, [*49] not iMedica. Thus, to the extent that iMedica opposes registration on the basis of its common law rights, iMedica's claim is dismissed.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionSurveysTrademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGeneral Overview



Medica Health Plans v. Sharon Rousmaniere

Opposition No. 91172089

Trademark Trial and Appeal Board

2008 TTAB LEXIS 620

May 7, 2008, Decided

DISPOSITION:

[*1]

DECISION: The opposition is sustained and registration to applicant is refused.

COUNSEL:

Eric D. Paulsrud of Leonard, Street and Deinard for Medica Health Plans.

Jon A. Schiffrin, Esq. for Sharon Rousmaniere.

JUDGES: Before Drost, Zervas and Taylor, Administrative Trademark Judges.

OPINION BY: Zervas, Albert

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Opinion by Zervas, Administrative Trademark Judge:

On October 28, 2005, Sharon Rousmaniere ("applicant") filed an application (Serial No. 78742277) for the mark GOMEDICA (in standard character form) for "on-line business directories featuring medical providers; providing on-line directory information services also featuring hyperlinks to other web sites" in International Class 35. The application claims a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), *15 U.S.C. § 1051(b)*.

Medica Health Plans ("opposer") has opposed registration of applicant's mark. In the notice of opposition, opposer claims ownership of numerous registrations for marks comprising the term MEDICA alone or MEDICA and other terms, including the following registrations:

Registration No. 1761828 (renewed [*2] November 24, 2003) for the mark MEDICA (in typed form) for "comprehensive health care plans and health plan management services" in International Class 42;

Registration No. 2113265 (renewed September 2, 2007) for the mark MEDICA (in typed form) for "administration of prepaid healthcare plans; healthcare plan administration services; underwriting healthcare plans; underwriting insurance for prepaid healthcare" in International Class 36, and "healthcare in the nature of health maintenance organizations (HMO)" in International Class 42; and

Registration No. 2851516 (issued June 8, 2004) for the mark MEDICA (in typed form) for, inter alia, "physician, dental, hospital, clinic and pharmacy referral services provided via a global computer network" in International Class 35.

Applicant has also alleged that it has a family of marks, that it has priority and that confusion, mistake and deception are likely to be caused by applicant's use of its mark on the services described in its application. Further, opposer has alleged that its marks are "both well-known and famous in Registrant's geographic market area and elsewhere throughout the United States." Notice of opposition [*3] at paragraph 20.

Applicant has filed an answer denying the salient allegations of the notice of opposition. The opposition has been fully briefed.

The Record

In addition to the pleadings and the status and title copies of the pleaded registrations submitted with the notice of opposition, see Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d), the record contains the file history of applicant's application, opposer's notice of reliance, opposer's supplemental notice of reliance, the testimony, with exhibits, of Robert Longendyke, opposer's senior vice president of marketing and communications, and applicant's notice of reliance.

Standing/Priority

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, priority is not an issue in this case because (i) applicant has admitted that opposer is the prior user of the mark MEDICA on the services listed in each of the pleaded registrations, opposer's notice of reliance, ex. 18, [*4] response to request for admission no. 4, and (ii) opposer's pleaded registrations are of record. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Fame

The *du Pont* factor concerning the fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); [*5] *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). That is, we look to the class of customers and potential customers of a product or service, and not the general public. Here, the relevant consuming public includes prospective and actual purchasers or users of healthcare providers. See *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas*, 77 USPQ2d 1492 (TTAB 2005), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

Opposer has established that it has a substantial number of members and substantial revenue and that its revenue and membership has been increasing; in 2001 opposer had 954,075 individual members with \$ 1,520,601,000 in revenue, and in 2005 opposer had 1,238,486 members with \$ 2,219,177,000 [*6] in revenue. Longendyke dep. at p. 38; ex. 1 at p. 31. Additionally, opposer has established that its advertising expenditures are substantial, amounting to "in excess of a million dollars a year" since 2001. Longendyke dep. at p. 40. Further, opposer has "about a 40 percent" market share in Minneapolis and "about 25 percent" market share in the state of Minnesota. *Id.* Opposer also offers healthcare services to consumers in three additional states, i.e., North Dakota, South Dakota and Wisconsin. n1 Longendyke dep. at p. 7; ex. 6 to Longendyke dep.

n1 Mr. Longendyke has testified that "Medica is going beyond the four-state region ... pretty much spanning the United States." Longendyke dep. at pp. 11 - 12. It is not clear which of opposer's services Mr. Longendyke is referring to in his testimony. Thus, we do not find that opposer offers its services nationally - his testimony in this regard has limited probative value.

We find that this evidence strongly indicates that a significant portion of the relevant [*7] consuming public associates MEDICA with opposer's business activities. Opposer has a significant market share in a major U.S. city and does business in four states. Its revenues, membership and advertising expenditures are significant in size. Opposer's website and advertising material of record prominently feature the MEDICA mark for a variety of healthcare related services. Longendyke dep. ex. 2 - 4. Thus, we find that MEDICA is an extremely well known mark in the geographic area in which it does business, especially in Minnesota, and that opposer is entitled to benefit from the *du Pont* factor regarding the fame of the mark. We acknowledge that MEDICA is not known nationally, but national fame is not necessary. See, e.g., *Karl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995) (opposer had established notoriety in a specific area of operation); *Berghoff Restaurant Co. v. Washington Forge, Inc.*, 225 USPQ 603 (TTAB 1985) (opposer's proof of fame of its mark within a limited geographic area sufficient to find its mark famous for purposes of the likelihood of confusion analysis). This factor therefore weighs heavily in [*8] favor of finding a likelihood of confusion.

The Services

We turn next to the *du Pont* factor regarding the similarity or dissimilarity of opposer's and applicant's services, beginning with opposer's services recited in Registration No. 2851516. Opposer's services are "physician, dental, hospital, clinic and pharmacy referral services provided via a global computer network" and Applicant's services are "on-line business directories featuring medical providers; providing on-line directory information services also featuring hyperlinks to other web sites." Opposer maintains that the services are "not merely highly related, but identical." Applicant's response is that this is "speculation," but has not offered any specifics or evidence on how the services differ. Rather, applicant maintains that in view of the differences in the marks, confusion is not likely, and that this *du Pont* factor does not favor either party. Brief at p. 14.

A page from applicant's website explains applicant's services:

People Seeking Healthcare Consult GoMedica TM

Through extensive key word marketing, search engine optimization, links on key sites, traditional advertising [*9] and more, we position GoMedica TM and you to be seen by people searching for healthcare providers.

When a person searches for your specialty - or the diagnostic procedures or treatments you offer - in your geographic area, your profile appears. Only after someone reads about you and then goes on to contact you do we charge a fee.

Longendyke ex. 11 at p. 1. Additionally, the following statements appear in a "demo" on applicant's website:

GoMedica helps people take control of their health by letting them search a wide range of healthcare options.

People can search for Physicians, Psychologists, Naturopaths, Acupuncturists, Dentists, Optometrists and many other practitioners.

They can also use GoMedica's keyword option to search by treatment or condition.

This step allows users to refine their search by choosing the type of specialist and distance they are willing to travel.

They can also use this page to search for specific treatments or insurance coverage among other things.

From this listing, the user can click through to the Provider Profile Page of a practitioner to learn more about him or her.

Longengdyke dep. ex. 11 at pp. 4 [*10] - 10. With regards to opposer's services, Mr. Longengdyke has testified that "we help people to find providers within [our] network, physicians, facilities, hospitals." Longengdyke dep. at p. 10.

Because both opposer's and applicant's services encompass locating medical providers via a global computer network, we find that opposer's and applicant's services are legally identical.

As for opposer's comprehensive health care plans and HMO services recited in its two other registrations, we find that applicant's services are similar to those services. The Board has found services to be similar when they are related in some manner or the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same provider. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Here, applicant's services may be used to locate a provider of health care services within opposer's health [*11] care plans or HMOs. In other words, applicant's GoMedica services may be used to find Medica health care providers. Hence, there is a relationship between such services.

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity of the services in opposer's favor.

Classes of Consumers and Trade Channels

Applicant has admitted that "one intended group of users" of its services is "individuals seeking a physician or other health care." Opposer's notice of reliance, ex. 18, response to request for admissions no. 16. Such "users" include consumers of opposer's services recited in all three of the registrations mentioned above. Thus, the classes of purchasers overlap.

Additionally, because neither party further limits its trade channels beyond the Internet, we consider the parties' respective services to be offered in all of the normal and usual channels of trade and methods of distribution for such on-line services. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). [*12] In view thereof, we find too that the trade channels overlap or are otherwise related to one another.

The *du Pont* factors regarding the classes of consumers and trade channels are therefore resolved in opposer's favor.

The Marks

We next consider the similarity or dissimilarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1691. While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We keep in mind that when marks would appear on identical services, as they partially do here, the degree of similarity necessary to support a conclusion of likely confusion declines with respect to that class of services (in this case, the International Class 35 services). *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's [*13] mark GOMEDICA only differs from opposer's mark MEDICA in that applicant's mark includes the word GO before MEDICA. The connotation of GOMEDICA is to go with, or to go to, MEDICA, both of which encourage the consumer to use the service offered by a provider known as MEDICA. See *Malarkey-Taylor Assocs. v.*

Cellular Telecommunications Indus. Assn., 929 F. Supp. 473, 40 USPQ2d 1136 (D.D.C. 1996) ("The Court finds several confusing similarities between WirelessNOW and Go Wireless Now! ... Defendant precedes those words with 'Go' and completes its mark with an exclamation point, but each of these additions can easily be read as flourishes added to encourage people to use a product with a name composed of 'wireless' and 'now' in conjunction with each other."). Because GO is a directive to the consumer, we give more weight to MEDICA in applicant's mark and find that the marks are highly similar in connotation and commercial impression.

The marks are similar in appearance too. Both marks include the term MEDICA. Further, as opposer correctly points out, applicant's mark is in standard character form, and hence applicant is not limited to displaying its mark in a particular [*14] manner or style. Applicant may depict its mark with GO in substantially smaller lettering than MEDICA, or in a different font or color shade than MEDICA. See *Phillips Petroleum Co. v. C.J. Webb Inc.*, 442 F.2d 1376, 58 C.C.P.A. 1255, 170 USPQ 35 (CCPA 1971). In fact, applicant has admitted that "a proposed use of GO-MEDICA will be the use of a capital letter 'G' and a capital letter 'M'"; and that "a proposed use of GOMEDICA will be using the word 'Go' in a lighter shade of blue and the word 'Medica' in a darker shade of blue." Longendyke dep. ex. 18, response to request for admissions nos. 7 and 8. Also, in response to opposer's request for admissions no. 6, applicant admitted that it intends to use its mark in the following form:

Link to Image

We therefore find that MEDICA in applicant's mark will create a greater impression on purchasers than GO. With respect to the sound of the marks, the addition of GO to MEDICA is a minor addition; the pronunciation of MEDICA is not affected by the addition of GO.

Applicant has made of record numerous third-party usebased registrations for marks containing the term "medica" in the health and healthcare fields. According to applicant, [*15] they show that "medica" is "diluted"; that "all of these marks coexist on the Principal Register, even with the shared use of 'medica'"; that "this portion of the underlying marks ought to be given a narrow scope of protection"; and that "'medica' translates to 'medical,' and is so commonly used that the public will look to other elements to distinguish the source of the goods, including but not limited to, the other different letters that compose GOMEDICA" Brief at p. 12.

We first make it clear that we reject any suggestion by applicant that MEDICA is a descriptive term. MEDICA is the subject of several registrations which are entitled to the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), and applicant's suggestion that MEDICA is descriptive is a collateral attack on such registrations, which are not the subject of a counterclaim or a separate petition. See *Countour Chain-Lounge Co., Inc. v. The Englander Co., Inc.*, 324 F.2d 186, 51 C.C.P.A. 833, 1964 Dec. Comm'r Pat. 57, 139 USPQ 285 (CCPA 1963); Trademark Rule 2.106(b)(2)(ii), 37 C.F.R. § 2.106(b)(2)(ii).

We next point out that the third-party registrations submitted by applicant are not evidence of [*16] use of the marks shown therein. Without evidence of use, the third-party registrations prove nothing about the impact of the third-party marks on purchasers in terms of conditioning consumers as to the existence of similar marks in the marketplace. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). They may, however, be relied on to show that a word common to each mark has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel, Ltd. v. Ritz Closet Seat Corp.*, 17 U.S.P.Q.2d (BNA) 1466 (TTAB 1990). In this case, the record does not show that there is any English language definition of "medica." The third-party registrations for marks including MEDICA for goods or services related to the healthcare field establish that those in the healthcare field use MEDICA in a manner intending to connote "medical." Such use tends to show that MEDICA is suggestive. However, this does not appreciably weaken the strength of opposer's mark.

Applicant has also argued that "medica" can be translated to "doctor" or "medical" and cites to several third-party registrations which [*17] include a translation statement identifying "medica" as "doctor" or "medical," and an entry from *Cassell's Spanish & English Dictionary* (1969) submitted with applicant's notice of reliance. We are not persuaded by applicant's argument. Simply because a translation exists does not persuade us that consumers of opposer's services would "stop and translate" opposer's mark. *Palm Bay*, 73 USPQ2d at 1696 ("The doctrine [of foreign equivalents]

should be applied only when it is likely that the ordinary American purchaser would "stop and translate [the word] into its English equivalent," citing *In re Pan Tex Hotel Corp.*, 190 USPQ 109 (TTAB 1976)).

Additionally, applicant has submitted third-party registrations "showing 'GO' used with other words for similar services ... in which none of them found 'go' to be descriptive in any way such as GO LOCAL, GO NANNIES, GO HWY, and GO SMART, which are all involved with online information services." Applicant's brief at p. 6. She has also submitted third-party registrations in support of her contention that "'go' coexists with a stand alone mark, such as TIME and GOTIME for online magazines and travel information [*18] services, PORT and GOPORT for software for interfacing a global computer network and providing access to a global computer network, and PAN and GOPAN for online database retrieval and removing information from computer networks" *Id.* at p. 7. According to applicant, "'go,' which has not been found descriptive in the past for similar services, should be given more weight due to the descriptive or suggestive nature of the term 'medica.'" Brief at p. 7.

Applicant's argument is not persuasive. Some of the marks comprise slogans which the assigned examining attorney may have considered unitary and for this reason did not require a disclaimer of GO. Others are for services that are unrelated to applicant's and registrant's services. See Registration No. 3238889 for "educational services, namely, instructing youngsters and women in the fundamentals of running, track and field and cross country by organizing and conducting running clubs and training programs." Also, each case must be decided on its own merits, and previous decisions by examining attorneys are not binding on the Board. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); [*19] *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity or dissimilarity of the marks in opposer's favor.

Conditions of Sale and Sophistication of Purchasers

Applicant maintains that this factor "is of minimal importance." This factor hence does not favor either party.

Variety of Goods/Services on Which the Mark is Used

As mentioned at the beginning of this decision, opposer has pleaded that it owns a family of marks. It has not specified the members of its alleged family of marks, and has not even sought to establish that it has advertised and promoted the family in a manner designed to create an association of common origin for all marks containing the family formative or "surname." See generally, 4 *McCarthy on Trademarks and Unfair Competition* § 23:61 (4th ed. 2007).

Additionally, opposer has not specified what "health plan products and services" it would like us to consider under this *du Pont* factor, and we will not cull through the record to locate evidence of use of such marks on "health plan products and services" which opposer [*20] could be referring to in arguing that this factor be resolved in its favor. We therefore find that this factor does not favor either party.

Remaining du Pont Factors

We have also considered the limited discussion of the remaining *du Pont* factors which the parties have provided in their briefs and any evidence pertaining thereto. Such factors either are not relevant or are neutral in our analysis. n2

n2 Applicant, in her discussion regarding her right to exclude others from the use of her mark, has requested that we take judicial notice of opposer's failure to oppose an earlier application, since abandoned, for the mark GO-MEDICA. Applicant's request is denied as being outside the scope of matters for which the Board takes judicial notice. See TBMP § 704.12(a) (2d ed. rev. 2004).

Conclusion

In balancing the above factors, and particularly considering the regional fame of MEDICA and Federal Circuit precedent providing that the fame of the mark is a dominant factor in questions [*21] of likelihood of confusion, we

find that opposer has established by a preponderance of the evidence that there is a likelihood of confusion between its marks and applicant's mark.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

GRAPHIC:

Picture, no caption



Ecolab Inc. v. Sumecht NA Inc. dba Sumer North America, Inc.

Opposition No. 91198851

Trademark Trial and Appeal Board

2013 TTAB LEXIS 424

July 29, 2013, Decided

DISPOSITION:

[*1]

Decision: The opposition is sustained and registration to applicant is refused.

COUNSEL:

Scott W. Johnston of Merchant Gould PC for Ecolab Inc.

Kenneth H. Johnson, Esq. for Sumecht NA Inc.

JUDGES: Before Zervas, Bergsman and Greenbaum, Administrative Trademark Judges.

OPINION BY: Greenbaum, Cindy B.

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Greenbaum, Administrative Trademark Judge:

Applicant, Sumecht NA Inc. dba Sumer North America, Inc., seeks registration on the Principal Register of the standard character mark CLEANFORCE for "electric pressure washers" in International Class 7. n1 Opposer, Ecolab Inc., opposes registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered mark CLEAN FORCE for a wide array of janitorial supplies, including cleaning preparations and related dispensers, as to be likely to cause confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Opposer pleaded ownership of Registration No. 2719458 for the standard character mark CLEAN FORCE (CLEAN disclaimed) for:

Cleaning preparations; namely, hand soaps, hand lotions, bathroom [*2] cleaners, drain cleaners, tile cleaners, all-purpose cleaners, glass cleaners, oven cleaners, degreasers and descalers; Floor finishing preparations; namely, floor cleaners, strippers, rejuvenators, sealers, finishes and buffing compounds; Laundry products; namely, detergents, bleaches, fabric softeners, water softeners and laundry sours; Detergents, rinse additives, and presoaks for use in manual and automatic ware washing machines, in International Class 3;

Sanitizers for use in manual and automatic warewashing machines, in International Class 5; and

Soap dispensers and dispensers for commercial and institutional cleaning and sanitizing products, in International Class 21.

n1 Application Serial No. 76703357, filed June 14, 2010, claiming first use and first use in commerce in June 2009.

Applicant, in its answer, denied the salient allegations in the notice of opposition, and asserted several "affirmative defenses" which were not pursued at trial. The "affirmative defenses" are deemed to have [*3] been waived and are given no further consideration.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant's application file. Opposer submitted, with its notice of opposition, a printout of its pleaded registration from the USPTO Trademark Electronic Search System (TESS) which shows that the registration is valid, subsisting and owned by opposer. n2 Opposer also submitted a notice of reliance on third party registrations, applicant's answers to opposer's first set of requests for admissions, and excerpts from applicant's answers to opposer's first set of interrogatories. In addition, opposer submitted the testimony depositions, with accompanying exhibits, of Mary Pellegrum, opposer's Marketing Director, and Keith Backhaus, opposer's Senior Marketing Manager in the Institutional Division. n3

n2 Pleadings may be made of record by attaching "a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration." Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

[*4]

n3 Certain testimony and exhibits were designated as confidential, and we will discuss those portions of the record in general terms. In addition, while we only discuss certain portions of the record in the decision, we have considered the entire record in arriving at our determination.

Applicant did not take any testimony or file a brief. However, applicant submitted a notice of reliance on printouts from opposer's website, The Power Washer Advisor website and the Global Sources website. n4

n4 The January 3, 2013 Board order struck the remaining materials that applicant submitted under the same notice of reliance.

The Parties

With more than \$ 6 billion in global sales, and more than 26,000 associates worldwide, opposer provides cleaning, sanitizing, food safety and infection control products and services to industries including the food, energy, healthcare, institutional and hospitality markets in more than [*5] 160 countries. App. Notice of Reliance (NOR) . Since 1999, opposer has manufactured and sold a line of cleaning products under the mark CLEAN FORCE. Backhaus Dep., p. 10. These products generally are used to clean kitchens, restrooms, living areas and laundry. Backhaus Dep. Exh. 2. Since their introduction in 1999, the number of different cleaning products sold under the CLEAN FORCE mark has grown from approximately 8 to 12 to more than 150. Backhaus Dep., pp. 9-10, Exh. 2; Pellegrum Dep. Exh. 37. Opposer also manufactures and sells pressure washers under the RABURN and PORTA-WASHER marks. Backhaus Dep., pp. 21-22, Exhs. 8-9; App. NOR. In conjunction with its distribution partner, U.S. Foodservice, opposer provides CLEAN FORCE cleaning products and related equipment to between three and four hundred thousand customers nationwide each year. Backhaus Dep., p. 13.

Applicant has used the mark CLEANFORCE on electric pressure washers since June 2009. Applicant's Response to Interrogatory No. 4. Applicant first used the mark in commerce in May 2010, when it shipped an electric pressure washer from China to The Home Depot in Arizona. Applicant's Response to Interrogatory No. 5. Applicant [*6] only uses the CLEANFORCE mark in the United States in connection with electric pressure washers, and only sells them at The Home Depot and Northern Tools & Equipment. Applicant's Responses to Interrogatory Nos. 22 and 18, respectively.

Standing/Priority

Because opposer has made the pleaded registration properly of record, opposer has established its standing to oppose registration of applicant's mark, and its priority is not in issue as to the goods in the registration. *See Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the issue of likelihood of confusion under Section 2(d).

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). [*7] *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We begin with the strength of opposer's CLEAN FORCE mark in order to determine the scope of protection to be accorded opposer's mark. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Although opposer did not plead or argue that the CLEAN FORCE mark is famous, opposer contends that the mark is well known, and that "[t]he strength of the CLEAN FORCE mark is derived, in part, from its suggestive nature as well as from the extensive goodwill cultivated by Ecolab." Br., p. 14. In making this argument, opposer acknowledges that CLEAN FORCE is suggestive as to applicant's goods. As such, CLEAN FORCE would not be viewed as inherently strong. However, the record shows that opposer's mark is commercially strong due to opposer's extensive use on various cleaning products, and in connection with the sale of those products since 1999. *See generally* Backhaus and Pellegrom Deps.

The commercial strength of a mark "may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling [*8] under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). In addition, some context in which to place raw statistics may be necessary. *Id. at 1309*. To this end, Ms. Pellegrom's testimony confirms the sales success of CLEAN FORCE brand cleaning products, which she describes as "significant" (Pellegrom Dep., p. 13), and Mr. Backhaus testified as to the growth of the number of such products from 8 to 12 in 1999 to more than 100 currently. n5 Backhaus Dep. p. 9. While the advertising figures are not substantial, Mr. Backhaus testified that much of the promotion is done in conjunction with U.S. Foodservice (U.S. Foods), opposer's distributor partner, through which opposer provides CLEAN FORCE cleaning products and related equipment to approximately 300,000 to 400,000 customers throughout the United States each year. Backhaus Dep., p. 13. Mr. Backhaus also testified that he was unaware of any other third-party uses of CLEAN FORCE for cleaning preparations or cleaning equipment. *Id.*, pp. 14-15.

n5 Opposer's confidential "US Foods/Clean Force Product Offering", submitted as Pellegrom Dep. Exh. 37, displays approximately 150 cleaning products.

[*9]

While the renown of opposer's mark does not rise to the level of a famous mark, we find that it is commercially strong and entitled to a broad scope of protection.

We now turn to the similarity or dissimilarity of the marks CLEAN FORCE and CLEANFORCE when compared in their entireties in terms of appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Applicant admits that the involved marks are identical in sound. n6 The marks also are nearly identical in appearance and structure in that

both begin with the word CLEAN followed by the word FORCE, and differ only by the space between the words in opposer's mark. Given the overall similarities in appearance and identity in sound, the presence or absence of a space between the words is insignificant, and does not distinguish the marks in meaning or commercial impression. The record confirms the insignificance of the presence or absence of the space in the parties' marks -- both parties actually display the marks in almost identical fashion, with the word CLEAN stacked over the word FORCE, and [*10] the word FORCE appearing in a slanted font. Backhaus Dep. Exh. 3.; Pellegrum Dep. Exh. 34. We therefore consider the marks to be virtually identical, and resolve this issue in favor of a finding of likelihood of confusion.

n6 Applicant's Response to Opposer's Request for Admission No. 24.

We now consider the goods, channels of trade and classes of purchasers. We must make our determination under these factors based on the goods as they are identified in the application and registration. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). The goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some 6 Applicant's Response to Opposer's Request for Admission No. 24. manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken [*11] belief that the goods come from a common source. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010). Finally, where, as here, the respective marks are virtually identical, the relationship between the goods need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

The record clearly shows that electric pressure washers and cleaning preparations are complementary items which consumers often use together. Backhaus Dep., pp. 13, 15-17, Exhs. 5-6. If similar marks appear on complementary goods, then there is a strong likelihood that buyers will think that there is some connection between the sources of such goods. See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567 (Fed. Cir. 1994); *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 511 (TTAB 1984).

In response to Request for Admission No. 13, applicant admitted that "electric pressure washers are used with cleaning preparations at times." Similarly, in response to [*12] Interrogatory No. 22, which asks applicant to "describe with specificity the features of Applicant's CLEANFORCE products and whether they can be used with cleaning detergents", applicant states "the Applicant's CLEANFORCE products are electric pressure washers which can be used with cleaning detergents."

Many pressure washers, including applicant's, are designed with detergent bottle assemblies for dispensing cleaning solutions while the product is in use. Backhaus Dep., pp. 13, 26, 27, Exhs. 3 and 4. Products such as opposer's CLEAN FORCE cleaning preparations and PROFORCE n7 heavy degreasers can be used with applicant's CLEANFORCE pressure washers. Backhaus Dep., p. 13; App. NOR. Similarly, opposer's RABURN and PORTA-WASHER pressure washers, which are marketed in conjunction with the ECOLAB brand name, can be used with any type of pressure washer cleaning solution. Backhaus Dep., pp. 21-22, Exhs. 8-9; App. NOR.

n7 Although opposer did not plead a family of FORCE marks, Mr. Backhaus testified as to opposer's ORANGE FORCE cleaning products. Backhaus Dep., p. 20. In addition, applicant's NOR includes printouts from Sam's Club displaying opposer's PURE FORCE cleaning products.

[*13]

Although applicant does not recommend a particular brand of cleaning product for use with its CLEANFORCE power washers, most companies that sell pressure washers also sell associated cleaning products in "kind of a razor blade/razor combination." Backhaus Dep., p. 27. The third-party registrations and internet materials of record, substantiated by Mr. Backhaus' testimony, further support that both types of products commonly are sold by the same company under the same mark. Mr. Backhaus testified as to 22 marks, including opposer's ECOLAB house mark, and third-party marks such as DIRT DEVIL, SIMONIZ, KARCHER and HOMELITE, that currently are used and/or registered in connection with pressure washers and cleaning preparations. Backhaus Dep., pp. 26-38, Exhs. 12-32. In this vein, op-

poser's ECOLAB CLEANING CADDY pressure washer system includes a spray wand for pressure washing and a lock-and-key product dispenser, which guarantees that consumers only use ECOLAB cleaning products in connection therewith. Backhaus Dep. pp. 16, 18, Exhs 5-7.

Because the goods are closely related and because there are no limitations in either the registrations or the subject application, we must presume that [*14] applicant's and opposer's goods will be sold in the same channels of trade that are normal for such items, such as hardware stores, home improvement stores, specialty tool stores and general merchandise stores (Backhaus Dep., pp. 23-25, Exhs. 10-13), and that they will be bought by the same classes of purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The record confirms this presumption: Home Depot, Northern Tool & Equipment and Menards all display pressure washers and cleaning preparations in the same section and/or next to each other. Backhaus Dep., 15, 24, 25 and 40, Exhs. 10 and 11.

In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade and class of purchasers favor a finding of likelihood of confusion.

In conclusion, because opposer's mark is commercially strong, the marks are virtually identical, the goods are commercially related, complementary items, and the channels of trade and classes of consumers overlap, confusion is likely between opposer's mark CLEAN FORCE and applicant's mark CLEANFORCE.

Decision: The opposition is sustained and registration [*15] to applicant is refused.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding



In re Holding Company of the Villages, Inc.

Serial No. 85596280

Trademark Trial and Appeal Board

2014 TTAB LEXIS 138

April 14, 2014, Decided

DISPOSITION:

[*1]

Decision: The examining attorney's refusal to register applicant's mark under *Section 2(d)* of the Trademark Act is reversed as to Registration No. 3407926 and affirmed as to Registration Nos. 3425159, 3779495, 3758353, 3779494, 3758496, and 4016256.

COUNSEL:

Lori T. Milvain of Latham, Shuker, Eden & Beaudine, LLP for Holding Company of the Villages, Inc.

Jonathan R. Falk, Trademark Examining Attorney, Law Office 111 (Robert L. Lorenzo, Managing Attorney).

JUDGES: Before Bergsman, Masiello, and Hightower, Administrative Trademark Judges.

OPINION BY: HIGHTOWER

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Hightower, Administrative Trademark Judge:

On April 12, 2012, applicant applied to register the mark **The Villages Health** on the Principal Register for:

. "Real estate consultancy; real estate listing; real estate management services" in International Class 36;

. "Education services, namely, providing classes, seminars, and workshops in the field of medicine and medical related services; physical fitness training services; providing fitness and exercise facilities" in International Class 41; and

. "Hospitals; medical clinics; medical services; medical [*2] testing services, namely, fitness evaluation; providing assistance, fitness evaluation and consultation to individuals to help them make health, wellness and nutritional changes in their daily living to improve health" in International Class 44. n1

During prosecution, applicant complied with a requirement to disclaim the word HEALTH apart from the mark as shown. Applicant also claims acquired distinctiveness in part under Section 2(f) of the Trademark Act, *15 U.S.C. § 1052(f)*, as to the wording THE VILLAGES based on at least five years' use and on prior U.S. Registration Nos. 2339401 and 3915348.

n1 Application Serial No. 85596280, filed based on a bona fide intention to use the mark in commerce pursuant to Section 1(b) of the Trademark Act, *15 U.S.C. § 1051(b)*. The color green is claimed as a feature of the mark. The description of the mark states: "The mark consists of the stylized green words 'The Villages Health.'"

Registration of applicant's services [*3] in International Classes 41 and 44 has been refused pursuant to Section 2(d) of the Trademark Act, *15 U.S.C. § 1052(d)*, on the ground of a likelihood of confusion with the following seven registered marks, grouped by owner:

A. DMB Sports Clubs Limited Partnership

VILLAGE HEALTH CLUB & SPA (HEALTH CLUB & SPA disclaimed) for "health club services, namely, providing instruction and equipment in the field of physical exercise; physical fitness instruction; tennis facilities and instruction" in International Class 41. n2

n2 Registration No. 3407926, issued April 8, 2008.

B. Village Health, Inc.

(VILLAGE HEALTH HOLISTIC disclaimed) for "acupuncture services; chiropractic services; health care services, namely, wellness programs; massage and therapeutic shiatsu massage; medical counseling; midwife services; nutrition counseling" in International Class 44. n3

n3 Registration No. 3425159, issued May 13, 2008.

[*4]

C. DaVita Inc.

[*4]

C. DaVita Inc.

(DISEASE MANAGEMENT disclaimed) for "health care services, namely, kidney disease management programs" in International Class 44. n4

n4 Registration No. 3779495, issued April 20, 2010.

D. DaVita Healthcare Partners Inc.

1. VILLAGEHEALTH for "health care services, namely, kidney disease management programs" in International Class 44; n5
2. VILLAGEHEALTH DISEASE MANAGEMENT (DISEASE MANAGEMENT disclaimed) for "health care services, namely, kidney disease management programs" in International Class 44; n6
3. for "health care services, namely, kidney disease management programs" in International Class 44; n7 and
4. DAVITA VILLAGEHEALTH for "health care services, namely, kidney disease management programs" in International Class 44. n8

Goods and services in classes other than 41 and 44 are omitted from the above list.

n5 Registration No. 3758353, issued March 9, 2010.

[*5]

n6 Registration No. 3779494, issued April 20, 2010.
 n7 Registration No. 3758496, issued March 9, 2010.
 n8 Registration No. 4016256, issued August 23, 2011.

On July 15, 2013, at applicant's request, its real estate services in International Class 36 were divided into a child application, which is not before us. n9

n9 Application Serial No. 85979735.

Applicant timely appealed the refusal, and the appeal has been fully briefed.

Proposed Amendment

In its reply brief, applicant proposes to amend its identification of services to add the wording "for senior citizens in retirement communities," as shown in bold red type below:

. "Education services, namely, providing classes, seminars, and workshops in the field of medicine and medical related services **for senior citizens in retirement communities**; physical fitness training services **for senior citizens in retirement communities** [*6] ; providing fitness and exercise facilities **for senior citizens in retirement communities**" in International Class 41; and

. "Hospitals **for senior citizens in retirement communities**; medical clinics **for senior citizens in retirement communities**; medical services **for senior citizens in retirement communities**; medical testing services, namely, fitness evaluation **for senior citizens in retirement communities**; providing assistance, fitness evaluation and consultation to individuals to help them make health, wellness and nutritional changes in their daily living to improve health **for senior citizens in retirement communities**" in International Class 44.

An analysis of likelihood of confusion under Section 2(d) includes a comparison of the goods or services in the re-simulated application and cited registrations. We therefore must first address these proposed amendments to applicant's identification of services. *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1662 (TTAB 2007).

It is improper to request amendment in a reply brief rather than by filing a separate request for remand that includes a showing of good cause. *See In re Thomas White Int'l Ltd.*, 106 USPQ2d 1158, 1160 n.2 (TTAB 2013) [*7] (noting, with respect to applicant's proposed amendment in its appeal brief, that "at this late juncture applicant would not be able to show good cause"); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 1205.01, 1209.04 (3d ed. rev. 2 June 2013). In any event, because the services identified in each of the cited registrations could be offered to "senior citizens in retirement communities," it is clear that applicant's proffered amendment would not overcome the Section 2(d) refusal. Applicant's request to amend its recitation of services therefore is denied.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities [*8] between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted evidence. To the extent that any other *du Pont* factors for which no evidence was presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Services and Channels of Trade

We first consider the similarity of the services and channels of trade, the second and third *du Pont* factors. The relevant services recited in the application and the cited registrations are summarized in the following chart:

Applicant's services are identical in part to the services identified in each cited registration. With respect to the first cited registration, for example, applicant offers "physical fitness training services" and the cited registered services include "physical fitness [*9] instruction." For the remaining registrations, applicant's broadly worded "medical services" encompass the more narrowly worded services identified in the second cited registration (including "medical counseling") and third through seventh cited registrations ("health care services, namely, kidney disease management programs"). Therefore, we presume that the services are offered in all normal channels of trade and are available to all potential classes of ordinary consumers, and that the channels of trade and classes of purchasers are the same. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, F.3d , 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) [*10] (finding Board entitled to rely on this presumption in determining likelihood of confusion).

Applicant's broadly identified educational services in International Class 41 - "providing classes, seminars, and workshops in the field of medicine and medical related services" - are related on their face to the medical and health care services identified in the second through seventh cited registrations. The examining attorney also submitted third-party registrations and websites showing that some entities offering medical and health care services also offer similar educational services. n10

n10 See June 7, 2012 Office action at 22-59; January 4, 2013 final Office action at 35-44.

For these reasons, we find that applicant's services in International Classes 41 and 44 are identical in part and otherwise closely related to services identified in each of the seven cited registrations. Therefore, the second and third *du Pont* factors - the similarity of the services and channels of trade - weigh strongly in [*11] favor of a likelihood of confusion.

B. Similarity of the Marks

We turn next to the *du Pont* likelihood of confusion factor focusing on "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether they are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods Inc., v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*, 972 F.2d 1353 (Fed. Cir. 1992).

Because similarity or dissimilarity is determined based on the marks in their entireties, our analysis [*12] cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Capital Partners, LP*, 110 USPQ2d at 1161; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). On the other hand, 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.*, 224 USPQ at 751. We focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Applicant's mark is **The Villages Health**, with HEALTH disclaimed. The seven cited [*13] registered marks are:

1. VILLAGE HEALTH CLUB & SPA

2.

VILLAGEHEALTH

5. VILLAGEHEALTH DISEASE MANAGEMENT

6.

7. DAVITA VILLAGEHEALTH

We find that the dominant portion of applicant's mark is the phrase VILLAGES HEALTH. The only other term in applicant's mark is the definite article THE, which is insignificant as a source-identifier. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) ("The addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods., Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (noting the insignificance of the word "the" in comparison of THE MUSIC MAKERS and MUSICMAKERS); *Conde Nast Publ'ns Inc. v. Redbook Publ'g Co.*, 217 USPQ 356, 357 (TTAB 1983) (noting that the word "the" cannot serve as an indication of origin). In addition, applicant's mark has only minimal design aspects: the color green and curled, exaggerated serifs on certain letters.

1. Registered Marks Owned by Village Health, [*14] Inc., DaVita Inc., and DaVita Healthcare Partners Inc.

We find that the phrase VILLAGE HEALTH is the dominant portion of the second through sixth cited marks: , , VILLAGEHEALTH, VILLAGEHEALTH DISEASE MANAGEMENT, and . Each of these five marks either uses the phrase VILLAGE HEALTH alone, or combines it with one or more of the following: a design element, wording that is merely descriptive in association with the identified services (i.e., DISEASE MANAGEMENT), or much smaller subsidiary wording (i.e., HOLISTIC REALISTIC). Presentation in two of the marks of the phrase VILLAGEHEALTH without a space does not change their commercial impression; based on normal English pronunciation we find that consumers would view and verbalize VILAGEHEALTH as the two words VILLAGE HEALTH. *See, e.g., In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB 2011) (finding "Person2Person Payment" generic despite deletion of spaces); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that DESIGNED TO SELL does not create a distinct commercial [*15] impression from DESIGNED2SELL). In addition, the wording in composite word and design marks normally is accorded greater weight in the likelihood of confusion analysis because consumers use the words to call for the services. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In the composite cited marks and , furthermore, the design appears to depict a stylized representation of a village, reinforcing the meaning of the term VILLAGE, which is common to applicant's mark and the cited marks. We also note that there is no material difference between singular and plural forms of the same term. *See, e.g., In re Belgrade Shoe Co.*, 411 F.2d 1352, 56 C.C.P.A. 1298, 162 USPQ 227 (CCPA 1969); *Wilson v. Delaunay*, 245 F.2d 877, 44 C.C.P.A. 1019, 1957 Dec. Comm'r Pat. 399, 114 USPQ 339, 341 (CCPA 1957); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962).

Because the dominant portions of applicant's mark and each of the cited marks are nearly identical, we find that applicant's mark [*16] **The Villages Health** is similar in sight, sound, and meaning and makes a very similar commercial impression to five of the cited marks: , , VILLAGEHEALTH, VILLAGEHEALTH DISEASE MANAGEMENT, and .

We separately address the seventh cited registration, DAVITA VILLAGEHEALTH. The mark in this registration combines the term VILLAGEHEALTH with DAVITA, which appears to be a trade name of the owners of five of the cited registrations. There is no per se rule that if two marks are confusingly similar, the addition of a house mark is not sufficient to differentiate them. *New England Fish Co. v. Hervin Co.*, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975). Nonetheless, it has often been said that likelihood of confusion will not be avoided when trade names and house marks are added to otherwise identical terms. "[S]uch addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion." *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (citations omitted) (finding [*17] applicant's LE CACHET DE DIOR confusingly similar to CACHET). *See also In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558, 559 (CCPA 1972) (stating that the addition of a trade name will make consumers think that the products have a common origin or that the companies merged); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1201-02 (TTAB 2007) (applying principle that "the addition of a trade name or house mark or other such matter to one of two otherwise similar marks will not serve to avoid a likelihood of confusion"). Here, the shared terms VILLAGES HEALTH and VILLAGEHEALTH are virtually identical in both marks and not highly suggestive or merely descriptive. We find that the addition of the term DAVITA does not serve to make confusion unlikely by distinguishing applicant's mark **The Villages Health** from the cited mark DAVITA VILLAGEHEALTH.

For all of the reasons discussed above, we find applicant's mark to be similar in commercial impression to all of the cited marks owned by Village Health, Inc., DaVita Inc., and DaVita Healthcare Partners Inc. Both have essentially the same dominant terms as applicant's mark and are similar in [*18] sight, sound, and connotation. The first *du Pont* factor thus weighs in favor of a likelihood of confusion between applicant's mark and these six cited registrations.

2. Registration Owned by DMB Sports Clubs Limited Partnership

We reach a different conclusion with respect to the first cited registration, VILLAGE HEALTH CLUB & SPA, with HEALTH CLUB & SPA disclaimed. We find that consumers would view VILLAGE in this cited registered mark as a modifier for the common descriptive phrase HEALTH CLUB & SPA, rather than reading the terms VILLAGE HEALTH together. Therefore, we find that applicant's mark **The Villages Health** has a different meaning and makes a different overall commercial impression from VILLAGE HEALTH CLUB & SPA, and the first *du Pont* factor does not weigh in favor of a likelihood of confusion between applicant's mark and this cited registration.

C. The Number and Nature of Similar Marks in Use on Similar Services

The sixth *du Pont* factor is the number and nature of similar marks in use for similar goods or services. Applicant argues that third-party use renders VILLAGE a weak mark entitled to only a narrow scope of protection in association [*19] with goods or services related to healthcare. n11 In support, applicant points to the seven cited registered marks owned by four different entities, as well as printouts from websites that appear to be associated with the cited marks and third-party sites for services incorporating the phrase VILLAGE HEALTH. The third-party sites are:

- . The Village Health Care Center, a skilled nursing facility in Missoula, Montana (villagehealthcare.com);
- . Village Health Care in Portland, Oregon (villagehc.com), services not specified;
- . The Village Health Care Center, a full-service health care facility in Broken Arrow, Oklahoma (villagehealthcare.net);
- . Village Health Wellness Spa in Smyrna, Georgia (villagehealth.net);
- . Village Healthcare and Rehabilitation (villagecarecenter.com), location and services not specified;
- . Village Health Care Services, Inc. in West Orange, New Jersey, a non-profit organization "dedicated to providing health, nutrition, and social services to disadvantaged people living in the country of Nigeria in West Africa" (villagehealthcareservices.com); and
- . Village Health Partners, family doctors in Plano, Texas (villagehealthpartners. [*20] com). n12

n11 See Applicant's Brief at 14-16.

n12 July 3, 2013 Request for Reconsideration at 26-31, 38-40.

While the evidence indicates some third-party use of the phrase VILLAGE HEALTH, the examples and information provided about the use are limited. The probative value of this evidence also is limited because the website printouts do not establish how many relevant customers may have encountered the various third-party uses. In particular, the printouts alone do not establish that potential consumers have been so exposed to the phrase VILLAGE HEALTH that they have become accustomed to it and look to other elements for source identification in the healthcare field. See *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (stating that, "without evidence as to the extent of third-party use, such as how long the websites have been operational or the extent of public exposure to the sites, the probative value of this evidence is minimal").

In addition, applicant included in its [*21] brief a chart listing six registered marks incorporating the term VILLAGE but not VILLAGE HEALTH. Not only is evidence submitted with an appeal brief untimely under Trademark Rule § 2.142(d), 37 C.F.R. § 2.142(d), but a mere list of registrations does not make the listed registrations of record. *In re Jump Designs LLC*, 80 USPQ2d at 1372; TBMP § 1208.02. Notwithstanding these evidentiary problems, such regis-

trations are not evidence that the marks therein have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the basis of minor differences. The probative value of third-party trademarks depends entirely on their usage. *Palm Bay Imports Inc.*, 73 USPQ2d at 1693. Where, as here, the record includes no evidence about the extent of third-party uses, the probative value of this evidence is minimal. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). "The existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them [*22] nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).

On the record in this case, we find insufficient support for applicant's argument that the phrase VILLAGE HEALTH in the cited registrations is weak in the field of healthcare services and entitled to only a narrow scope of protection.

Conclusion

For the foregoing reasons, we find that, on balance, the relevant *du Pont* factors weigh in favor of a finding of likelihood of confusion between applicant's mark and the marks in all cited registrations except VILLAGE HEALTH CLUB & SPA. With respect to that mark only, we find that the dissimilarity of the marks is dispositive. See *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is reversed as to Registration No. 3407926 and affirmed as to Registration Nos. 3425159, 3779495, 3758353, 3779494, 3758496, [*23] and 4016256.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawProtection of RightsRegistrationDegree of ProtectionTrademark LawProtection of RightsRegistrationDisclaimer of Unregistrable Matter



In re Sovena U.S.A. Inc.

Serial No. 76599644

Trademark Trial and Appeal Board

2009 TTAB LEXIS 635

October 5, 2009, Decided

SUBSEQUENT HISTORY:

Reconsideration denied by *In re Sovena U.S.A., 2009 TTAB LEXIS 686 (Trademark Trial & App. Bd., Dec. 8, 2009)*

DISPOSITION:

[*1]

Decision: The refusal to register is affirmed.

COUNSEL:

Mary Helen Sears for Sovena U.S.A. Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office 117 (Loretta C. Beck, Managing Attorney).

JUDGES: Before Hairston, Grendel and Holtzman, Administrative Trademark Judges

OPINION BY: Grendel, Charles

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Grendel, Administrative Trademark Judge:

Sovena U.S.A. Inc., (applicant) seeks registration on the Principal Register of the mark PARADISE (in standard character form) for goods identified in the application as "imported and domestic olive oil and vegetable oils," in Class 29. n1

n1 Serial No. 76599644, filed on June 29, 2004. The application is based on use in commerce under Trademark Act Section 1(a), *15 U.S.C. § 1051(a)*. May 18, 1950 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

The Trademark Examining Attorney has issued a final refusal of [*2] registration on the ground that applicant's mark, as applied to the goods identified in the application, so resembles the mark CHEF'S PARADISE depicted below,

[Link to Image](#)

previously registered on the Principal Register for numerous goods specifically including "olive oil" in Class 29, n2 as to be likely to cause confusion. Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

n2 Reg. No. 2685700, issued on February 11, 2003 from an application filed on October 10, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

Applicant has appealed the final refusal. Applicant filed an appeal brief and, with the Board's permission, a supplemental appeal brief. The Trademark Examining Attorney then filed her brief.

After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Initially, we sustain the Trademark Examining Attorney's objection, made in her brief, to the evidence submitted by applicant for [*3] the first time with its appeal brief and its supplemental brief. This evidence is untimely and shall not be considered. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). If applicant wished to submit additional evidence after the filing of the notice of appeal, applicant should have requested that the Board suspend the appeal and remand the application for consideration of the additional evidence. *Id.* n3

n3 It appears from applicant's arguments that much of the untimely evidence consists of printouts from its own website and the registrant's website which, according to applicant, demonstrate the differences in which the respective marks are actually used in the marketplace on labels etc. We note generally that this evidence would have been irrelevant even if properly submitted, because our likelihood of confusion determination in this case determining the registrability of applicant's mark must be based solely on the marks as they are set forth in the application and the registration, respectively. *See Kimberly-Clark Corporation v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 55 C.C.P.A. 858, 156 USPQ 340 (CCPA 1968); *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244 (TTAB 1984).

[*4]

We turn now to the Section 2(d) refusal. Our likelihood of confusion determination under *Section 2(d)* is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See 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 Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In each case, we need consider and weigh only those factors as to which there is pertinent evidence of record. *See In re Majestic Distilling Co.*, 315 F.3d at 1315, 65 USPQ2d at 1204 ("Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case,'" quoting *In re Dixie Restaurants, Inc.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533; *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). [*5]

In this case, we note that applicant has discussed essentially all of the *du Pont* factors, so we shall do likewise, albeit summarily as to some of the factors.

Because applicant's arguments on several of the *du Pont* factors are based in part on the alleged dealings between applicant and registrant, we shall begin our analysis with the tenth *du Pont* factor regarding the market interface between applicant and registrant. We note that this appeal was suspended by the Board on August 7, 2006 on applicant's motion, pending the outcome of a cancellation proceeding (Cancellation No. 92046118) applicant had filed against the registration cited by the Trademark Examining Attorney in this appeal as a Section 2(d) bar to registration of applicant's mark. Applicant's petition to cancel was dismissed with prejudice on January 2, 2009, and this appeal was resumed by order of the Board dated January 26, 2009.

Applicant, in its supplemental appeal brief filed after resumption of the appeal, contends (without timely proof, as noted above) that during the course of the cancellation proceeding, applicant and registrant had arrived at a final draft of a coexistence agreement to settle the [*6] proceeding in which the parties agreed, inter alia, that there had been no actual confusion between the marks, that confusion was unlikely to occur, that the parties would undertake measures that would preclude any such confusion, and that registrant would consent to applicant's registration of its mark. However, the agreement was never finalized because, according to applicant, the parties could not agree on the issue of attorneys' fees.

However, applicant contends that the parties' final draft agreement on the merits of the dispute shows that registrant believes that there is no likelihood of confusion between the parties' marks. We are not persuaded. We note that when applicant attempted to withdraw the petition to cancel without prejudice subject to registrant's future compliance with the substantive provisions of the draft agreement, registrant did not consent to such withdrawal. In view of that lack of consent from registrant, the Board dismissed the cancellation with prejudice pursuant to Trademark Rule 2.114(c), 37 C.F.R. § 2.114(c).

In short, we find that these facts do not support a finding that registrant has admitted or believes that there is no likelihood of confusion, [*7] or that registrant has consented to the issuance to applicant of the unrestricted registration applicant seeks. We will not assume such belief or consent on registrant's part. See *In re Association of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

For these reasons, we find that the tenth *du Pont* factor regarding the market interface between the applicant and registrant is neutral in this case. We also reject as unfounded applicant's stated reliance, with respect to other of the *du Pont* factors discussed below, on registrant's alleged belief that confusion is unlikely.

We turn now to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc.*, *supra*. The test, under the first *du Pont* 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 [*8] to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this (see discussion below), where the applicant's goods are identical to the goods in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). [*9]

Applying these principles in the present case, we find as follows. First, we find that the only significant difference between applicant's mark PARADISE (in standard character form) and the cited registered mark CHEF'S PARADISE (in slightly stylized form) is the presence of the word CHEF'S in the cited registered mark. The stylization of the cited registered mark (i.e., the basic script font and the simple rectangular black background element) is too slight to significantly distinguish the marks. Moreover, because applicant seeks to register its mark in standard character form, any such registration would entitle applicant to display the mark in any reasonable manner, including the slightly stylized manner in which the registered mark is displayed. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Next, we find that the word PARADISE in both marks is highly distinctive as applied to the goods at issue here, being at best only slightly suggestive of the high quality of the goods. PARADISE comprises the whole of applicant's mark, and we find that it is the dominant feature in the commercial impression created by the cited registered [*10] mark. This is because, as applied to food products, the word CHEF'S would be seen as merely a highly suggestive modifier of the distinctive word PARADISE. For this reason, we accord more weight to the word PARADISE in the registered mark in our comparison of applicant's and registrant's marks. See *In re Chatam International Inc.*, *supra*.

Comparing the marks in terms of appearance, we find that they are differentiated only by the presence of the word CHEF'S in the cited registered mark. As noted above, the slight stylization of the cited registered mark does not signifi-

cantly distinguish the marks in terms of appearance. Thus, although the marks are not identical in terms of appearance, we find that they are similar due to the presence of the word PARADISE in both of them.

In terms of sound, the only difference between the marks is the presence of the word CHEF'S in the cited registered mark. Although the marks thus are not identical in terms of sound, we find them to be similar due to the presence in both marks of the word PARADISE.

In terms of connotation, we find that the presence of the possessive modifier CHEF'S in the cited registered mark lends a slightly different [*11] connotation to the cited registered mark, in that it suggests a paradise inhabited or enjoyed by a chef, i.e., a "chef's paradise." However, we find that the similarity in connotation resulting from the presence of the highly distinctive word PARADISE outweighs any difference in connotation resulting from the presence of the word CHEF'S in the cited registered mark, a word which is highly suggestive as applied to the goods. Both marks connote a "paradise."

In terms of overall commercial impression, we find, again, that the marks are similar because they both evoke the distinctive concept "paradise." This fundamental similarity in the source-indicating commercial impression created by both marks is not altered by the presence in the cited registered mark of the highly suggestive word CHEF'S. Even if purchasers, with their imperfect recollections, notice and recall that one of the marks includes the word CHEF'S as a possessive modifier of PARADISE, they certainly will recall that both marks include the distinctive word PARADISE.

For all of these reasons, we find that applicant's mark PARADISE and the cited registered mark CHEF'S PARADISE are similar when viewed in their entireties. [*12] As noted above, in cases where the goods are identical (as they are here; see below), the degree of similarity between the marks which is required to support a finding that the marks are similar under the first *du Pont* factor declines. We find that applicant's mark and the cited registered mark, when applied to identical goods, are sufficiently similar that the first *du Pont* factor clearly weighs in favor of a finding of likelihood of confusion in this case.

We turn next to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the goods as identified in the application and in the cited registration, respectively. "Likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application and registration." *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008). In comparing the goods identified in the application and in the cited registration, respectively, "...it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods. ... An applicant may not restrict the scope of the goods covered in the cited [*13] registration by argument or extrinsic evidence." *Id.*, 86 USPQ2d at 1646.

Applicant's goods as identified in the registration are "imported and domestic olive oil and vegetable oils." The goods identified in the cited registration include "olive oil." We find that these respective goods are identical. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion in this case.

Under the third *du Pont* factor, we consider evidence pertaining to the trade channels in which the respective goods, as identified, are marketed. Because applicant's "olive oil" and registrant's "olive oil" are identical goods, we presume that they are or could be marketed in identical trade channels. *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Moreover, there are no trade channel restrictions or limitations in either applicant's identification of goods or registrant's identification of goods as to "olive oil," and we therefore must presume that the goods are or could be marketed in all normal trade channels for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Applicant's argument that it actually or currently markets its [*14] olive oil only in bulk to wholesalers or to large institutional food service customers, while registrant currently markets its goods only through a single retail store in Los Angeles, California, is unavailing. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion in this case.

Under the fourth *du Pont* factor, we consider evidence pertaining to the conditions under which the goods are purchased. We find that olive oil is an ordinary consumer item sold at supermarkets or other food retailers, which is purchased by ordinary consumers without a great deal of care which might mitigate the likelihood of confusion. Applicant's contention that its actual customers are wholesalers and institutions which would be knowledgeable and careful purchasers is unavailing, given the absence of any such purchaser restrictions in applicant's identification of goods. Moreover, it is well-settled that even sophisticated purchasers who are knowledgeable as to the goods are not necessarily knowledgeable in the field of trademarks or immune to source confusion arising from the use of confusingly similar marks on or in connection with identical goods. See *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020 (TTAB 2009); [*15] *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). For these reasons, we find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion in this case.

Under the fifth *du Pont* factor regarding fame of the prior mark, applicant notes that there is no evidence that the cited registered mark is famous. However, it is settled that the absence of such evidence is not particularly significant in the context of an ex parte proceeding. See *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). Moreover, "[i]t is not necessary that a registered mark be famous to be entitled to protection against a confusingly similar mark." *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439 (TTAB 2006). We find that the fifth *du Pont* factor is neutral in this case.

Under the sixth *du Pont* factor, as applicant notes, there is no evidence of any use by third parties of similar marks on similar goods. We find that the sixth *du Pont* factor therefore is neutral in this case.

We consider next the seventh *du Pont* factor (nature and extent of any actual confusion) and the [*16] related eighth *du Pont* factor (extent of the opportunity for actual confusion). Applicant asserts that it is not aware of any instances of actual confusion in the marketplace between applicant's mark and registrant's mark despite fifteen years of contemporaneous use. However, "[t]he fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion..." *In re Opus One Inc.*, 60 USPQ2d at 1817. n4 Moreover, "[i]t should also be noted that competent evidence of actual confusion is difficult to come by where as here both applicant and registrant may be performing their respective activities in a commendable or exemplary fashion." *In re Opus One*, 60 USPQ2d at 1818, quoting from *In re Richard Bertram & Co.*, 203 USPQ 286, 291 (TTAB 1979).

n4 As noted above in connection with the tenth *du Pont* factor, we reject as unfounded on this record applicant's assumption that registrant necessarily is unaware of any instances of actual confusion.

[*17]

In any event, even if there is no evidence of actual confusion under the seventh *du Pont* factor, there likewise is no basis on this record for finding, under the related eighth *du Pont* factor, that there has been a significant opportunity for actual confusion to have occurred. That is, there is no competent evidence that the nature and extent of applicant's and registrant's actual use of their marks in the marketplace, including the extent of geographical overlap, has been so substantial as to render the apparent absence of actual confusion legally significant. See *In re Thomas*, 79 USPQ2d at 1028; *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999); *Gillette Canada, Inc. v. Ranir*, 23 USPQ2d 1768 (TTAB 1992). Applicant itself contends that there has been no such actual overlap in the marketplace.

In short, the fact (under the seventh *du Pont* factor) that there apparently has been no actual confusion must be considered together with the fact (under the eighth *du Pont* factor) that there apparently has been no significant opportunity for actual confusion to have occurred. In these circumstances, we find that [*18] the seventh and eighth *du Pont* factors pertaining to the issue of actual confusion are essentially neutral in this case.

There is no evidence in the record pertaining to the ninth *du Pont* factor, i.e., the variety of goods. We find that the ninth *du Pont* factor is neutral in this case.

Under the eleventh *du Pont* factor, we consider evidence pertaining to the extent to which applicant has a right to exclude others from use of its mark on its goods. Applicant argues (again, without timely proof) that its predecessor in interest first began using the mark on the goods in 1950 and that the mark has been used continuously since then. Applicant argues that respondent's predecessor also owned a registration (Reg. No. 1962751, issued on March 19, 1996), of the same PARADISE mark for the same goods covered in applicant's current application, which was cancelled on December 21, 2002 due to an allegedly inadvertent failure to file a Section 8 affidavit. Based on these facts, applicant states that it "believes that as a matter of law ... it has the right to exclude others from using 'Paradise' alone as a trademark for edible oil products." (Applicant's supplemental brief at 9.) [*19]

Contrary to applicant's argument, applicant's predecessor's ownership of a now-cancelled registration of the mark does not establish applicant's right to exclude others from use of the mark. A cancelled registration is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act, including the presumption of an exclusive right to use the mark. See *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re Hunter Publishing Co.*, 204 USPQ 957 (TTAB 1979). n5 Nor does applicant's assertion of a long period of common-law use of its mark suffice in itself to establish in this case that applicant has any significant right to exclude others from use of the mark. For these reasons, we find that the eleventh *du Pont* factor is neutral in this case.

n5 Several times in its brief, applicant contends that by filing its current application it is seeking merely to "re-register" its mark. However, as the Board stated in *In re Ginc Uk Ltd.*, 90 USPQ2d at 1480:

Nor does applicant's cancelled registration justify registration of its current application. A cancelled registration is not entitled to any of the statutory presumptions of *Section 7(b)* of the Trademark Act. See, e.g., *In re Hunter Publishing Company*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought.").

[*20]

Under the twelfth *du Pont* factor (the potential for confusion, i.e., whether de minimis or substantial), we find that the goods involved here are the type of goods that would be marketed to and purchased by significant numbers of ordinary purchasers, and that the potential for confusion therefore cannot be deemed to be de minimis. The twelfth *du Pont* factor is neutral, at best.

Having considered all of the evidence of record as it pertains to the *du Pont* likelihood of confusion factors, we conclude that a likelihood of confusion exists. In particular, we conclude that applicant's mark is similar to the cited registered mark, such that confusion is likely to result from contemporaneous use of the marks on the legally identical goods identified in the application and registration ("olive oil"), which we presume to be marketed in legally identical trade channels and to the same classes of purchasers, including to ordinary consumers shopping for this inexpensive food product.

We have considered applicant's arguments to the contrary (including any arguments not specifically discussed in this opinion), but we find them to be unpersuasive. To the extent that any doubts might [*21] exist as to the correctness of our conclusion that confusion is likely, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Legal Topics:

For related research and practice materials, see the following legal topics:
 Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundMeaningTrademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsGeneral Overview

GRAPHIC:

Logo, no caption



In re Douglas Smurr and Bret Bocook

Serial No. 85342789

Trademark Trial and Appeal Board

2013 TTAB LEXIS 533

October 3, 2013, Decided

DISPOSITION:

[*1]

Decision: The refusal of registration is affirmed.

COUNSEL:

Douglas Smurr of World's Law, LLP for Douglas Smurr and Bret Bocook.

Tamara Frazier, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

JUDGES: Before Seeherman, Bucher and Adlin, Administrative Trademark Judges.

OPINION BY: Seeherman, Ellen

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Opinion by Seeherman, Administrative Trademark Judge: Douglas Smurr and Bret Bocook, two individuals who are joint applicants, have appealed from the examining attorney's refusal to register the mark WORLD'S LAW in standard characters, with LAW disclaimed, for "legal services, namely the practice of law by licensed attorneys." n1 Registration has been refused pursuant to Section 2(d) of the Trademark Act, *15 U.S.C. § 1052(d)*, on the ground that applicant's mark so resembles the registered mark WORLD LAW GROUP, in typed drawing form, with LAW GROUP disclaimed, for legal services, n2 that, as used in connection with applicants' identified services, it is likely to cause confusion or mistake or to deceive.

n1 Application Serial No. 85342789, filed June 10, 2011, asserting first use as early as May 15, 2006 and first use in commerce as early as June 1, 2006.

[*2]

n2 Registration No. 2332652, issued March 21, 2000; Section 8 and 15 affidavits accepted and acknowledged, respectively; renewed. "Typed" drawings are now referred to as "standard character" drawings. *See Trademark Rule 2.52(a)*.

We affirm the refusal of registration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the *du Pont* factor of "the similarity or dissimilarity and [*3] nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The registrant's services are identified in the registration as "legal services"; applicants' services are identified as "legal services, namely the practice of law by licensed attorneys." Obviously, registrant's identification encompasses the services in applicants' identification, and therefore the services are legally identical. Applicants have discussed at some length what they call "the *Citigroup* presumption," referring to *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). Applicants have submitted a quote, purportedly taken from this opinion (at 637 F.3d 1356), as to what this presumption is: "[t]hat the registration encompasses all services of the type described, including those in applicant's more specific identification, and that the services move in all normal channels of trade." Although we have no quarrel with the principle set forth, we point out that this specific language does not appear [*4] in the *Citigroup* opinion. n3 In any event, applicants go on to contend that this presumption can be rebutted by evidence that contradicts this "presumed fact."

n3 The *Citigroup* opinion also cites *Hewlett Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002), for the principle that "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers."

Applicants are incorrect both in their supposition that the cited presumption originated with the *Citigroup* decision, and more importantly in their position that the general presumption can be rebutted by evidence as to the registrant's actual use. In the 1973 case, *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973), the predecessor to our primary reviewing court stated that "Trademark cases involving the issue of likelihood of confusion must be [*5] decided on the basis of the respective descriptions of [services]." This principle has been reiterated time and again. It is well-established that likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in the applicant's application vis-a-vis the services recited in the cited registration, rather than what the evidence shows the services to be. *In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1534. This is because "[t]he certificate of registration is *prima facie* evidence of the validity of the registration and the registrant's exclusive right to use the mark in connection with the services specified." *Id.* In fact, in *Dixie* the applicant made an argument similar to that of applicants herein, namely, that the registrant was not using its mark for all of the services listed in its identification. The Court would not entertain what was in effect a collateral attack on the registration, stating that an *ex parte* proceeding is not the proper forum for such a challenge. *Id.*

Accordingly, we must determine the issue of likelihood of confusion based on the identification of services in the cited registration [*6] and in applicants' application. Because the services as identified are legally identical, in that the services identified in the registration encompass the services identified in the application, this *du Pont* factor favors a finding of likelihood of confusion.

Similarly, because the services in the cited registration are broadly described and there are no limitations in the identification as to the nature or type of the legal services, or the channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all services of the nature and type described, that the identified services move in all channels of trade that would be normal for such services, and that the services would be purchased by all potential customers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). As a result, we must presume that applicants' and the registrant's legal services travel in the same channels of trade and are offered to the same classes of customers.

The *du Pont* factor of the channels of trade therefore also favors a finding of likelihood of confusion.

Before we turn to the *du Pont* factor of the similarity or dissimilarity of the [*7] marks, we will address, as applicants have, the factors regarding the fame of the cited mark and the number and nature of similar marks in use on simi-

lar goods or services. Applicants are correct that there is no evidence of fame of the cited mark. n4 Applicants are incorrect, however, that as a result we should treat this *du Pont* factor as weighing in applicants' favor. Our primary reviewing court, the Federal Circuit, has specifically stated that although the fame of a registered mark is relevant to likelihood of confusion, "we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205. We treat the factor of fame as neutral.

n4 We add that it would be very rare that there would be such evidence in an ex parte case, since an examining attorney would normally not have access to the type of evidence that is necessary to prove fame.

With regard to the number and nature of similar [*8] marks, applicants point to three third-party registrations. Although applicants did not properly make the registrations of record, n5 the examining attorney has addressed these registrations, and has listed the services for two of them. Therefore, we consider the registrations, at least insofar as information about them has been submitted. n6

n5 We find it odd that, from the time of their response to the first Office action, applicants have requested that the examining attorney (and later the Board) take judicial notice of these registrations, rather than making them of record, despite the fact that it is a well-established principle that the Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. *See In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

n6 Normally, when a party requests that judicial notice be taken, the party submits the material that it wishes to be judicially noticed. Even with their brief, applicants have not submitted copies of the registrations.

[*9]

However, the registrations have no probative value in terms of the *du Pont* factor of the number and nature of similar marks in use in commerce. Third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). n7

n7 Third-party registrations may be used in the manner of dictionary definitions, to show that a mark or a portion of a mark has a significance in a particular industry. *See Mead Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). We discuss this *infra*.

Applicants have also pointed to what they assert are "twenty-one unregistered marks currently in use for legal services in the United States." Brief, p. 19. However, applicants did not actually submit evidence of use of any such marks. They merely listed in their various responses a list of terms, e.g., "Virtual World Law," "World Law Debt," "Common Law World [*10] Review," along with a URL for each. We cannot ascertain from the mere listing whether these terms are trademarks, or if so, the goods and services with which they are used, and we do not go outside of the record by researching or even clicking on mere URL's. Applicants argue that the examining attorney "discussed these third-party use [sic] of similar marks in both of its [sic] Office Actions dated February 22, 2012 and November 8, 2012 without objecting to the marks being admitted into evidence; hence the registrations and marks should be treated as being stipulated into the record." Brief, p. 18. However, the examining attorney neither discussed the listing of the names and URLs in the Office actions, nor treated them as being of record. Further, even if the examining attorney discussed the information, it would not result in the contents of the websites identified by the URLs being of record. As the Board stated in *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007), quoting *In re Planalytics Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004), "A mere reference to a website does not make the information of record. In order to review the facts in this [*11] case, there should be evidence in the record." The Board further pointed out in *In re Planalytics, Inc.*, 70 USPQ2d at 1458, that "information on websites is transitory and subject to change at any time at the owner's discretion." Thus, the Board cannot determine from the URLs what the various websites might have contained at the

time applicants cited them in their February 22, 2012 and November 8, 2012 responses, or in their brief. Applicants have simply not provided the material from the websites on which they wish to rely, and the Board will not and cannot take judicial notice of the content of these websites. n8

n8 Even if the website material were appropriate for judicial notice, applicants have not provided the actual content from the websites.

Thus, we consider only the specific information that applicants provided, i.e., the listing of the phrases and the respective URLs. This information has no probative value without the websites themselves to give context to the terms. See TBMP § 1208.03 [*12] and cases cited therein at note 5, addressing the limited probative value of search result summaries from a search engine when the text in the result summary is insufficient to show the context in which the term is used. In this case, of course, we do not even have limited text from the websites in question.

The *du Pont* factor of the number and nature of similar marks in use on similar goods or with similar services is therefore neutral.

We now turn to the first *du Pont* factor, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, keeping in mind that when marks would appear on legally identical services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion [*13] rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Further, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1375 (TTAB 1999).

Applicants' mark is WORLD'S LAW, with LAW disclaimed. The cited mark is WORLD LAW GROUP, with LAW GROUP disclaimed. Interestingly, applicants argue that "The Word 'Group' is the Dominant Feature of Both Marks," brief, p. 21, despite the fact that GROUP does not even appear in applicants' mark. Applicants also contend that GROUP is the dominant part of WORLD LAW GROUP because it "is the word that clearly differentiates the two marks," *id.*, and that the registrant is what its mark implies, i.e., a group. [*14] We cannot view GROUP as the dominant part of applicants' mark, which does not even contain the word. Further, as the examining attorney has stated, descriptive matter, such as LAW in applicants' mark and LAW GROUP in the cited mark, is generally given less weight when the marks are compared. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("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.'" (quoting *In re National Data*, 224 USPQ at 752); *In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1533-34; *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION'S, not disclaimed word ROADHOUSE, is dominant element of BINION'S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Consumers are likely to view the disclaimed word GROUP in the cited mark in the same manner as the word "firm," an indicator that this is an entity or association, but [*15] will look to other elements of the mark for their source-identifying significance. The other elements of the cited mark, WORLD LAW, are extremely similar to applicants' mark, WORLD'S LAW. Although applicants' mark uses WORLD'S in the possessive, it is unlikely that consumers will note or remember this difference, which is insignificant because it does not meaningfully alter how applicants' mark looks and sounds or the meaning it conveys. Further, consumers who are familiar with the cited mark are likely to view applicants' mark as a shortened form of WORLD LAW GROUP, such that the absence of GROUP from applicants' mark is not sufficient to distinguish it from the cited mark. Thus, despite the additional word GROUP in the cited mark, and its absence in applicants' mark, the marks are similar in overall appearance, pronunciation, connotation and commercial impression. Although WORLD LAW GROUP has a suggestive connotation, the connotation is the same as that for WORLD'S LAW. This *du Pont* factor also favors a finding of likelihood of confusion.

We reach this conclusion despite applicants' arguments that the purchasers of applicants' and registrant's services are sophisticated and [*16] careful, which arguments go to the fourth *du Pont* factor (conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing). First, legal services may be needed by the public in general, including unsophisticated legal consumers who wish to write a will, or who suddenly find themselves in trouble and require legal help. Such persons are not necessarily careful or knowledgeable about choosing legal services, and may obtain services without investigation of the services. In such circumstances, the small differences between applicants' mark and the cited mark, as discussed above, are insufficient to apprise consumers that these trademarks identify legal services emanating from separate sources. Applicants further assert that all states require a written retainer agreement; even if applicants are correct, those entering into a retainer or other contract for services are not likely to note that applicants' mark is different from the registrant's. Further, the consumer can be confused at the time he or she decides to contact applicants, i.e., well before the signing of the retainer agreement. Accordingly, although we agree that legal services [*17] are not the subject of an impulse purchase, even careful consumers are not likely to recognize that applicants' mark is different from the registrant's, or, if they do, they are not likely to understand that this difference represents different sources of the services.

Applicants argue that the seventh and eighth *du Pont* factors -- the nature and extent of any actual confusion, and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion -- favor applicants' position. Applicants base their argument that there has been no actual confusion on their claim that the address for registrant on its website is in Washington, DC, and applicants maintained their main office in Washington, DC between 2006 and 2008. As a preliminary matter, we note that applicants have not made the registrant's website of record. Further, even if we accept applicants' statement, concurrent use for two years some time ago, and without any evidence of the extent of either applicants' or the registrant's sales or advertising or public recognition, is hardly persuasive that confusion is not likely.

More importantly, the Federal Circuit has found that [*18] an applicant's uncorroborated statements of no known instances of actual confusion are of little evidentiary value:

A showing of actual confusion would of course be highly probative, if not conclusive of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, especially in an *ex parte* context.

In re Majestic Distilling Co., 65 USPQ2d at 1205 (internal citations omitted). We therefore treat the seventh and eighth *du Pont* factors as neutral.

With respect to the twelfth *du Pont* factor, the extent of potential confusion, i.e., whether de minimis or substantial, because the consumers for legal services include the public at large, the extent of potential confusion is substantial. n9

n9 In connection with this factor, applicants have argued that the registrant does not actually practice law, and therefore applicants' and the registrant's services would not be encountered by consumers in situations that would create the incorrect assumption that they originate from the same source. We have already explained that we must determine likelihood of confusion on the basis of the services identified in the cited registration, and that this identification cannot be limited by extrinsic evidence. Therefore, we give no weight to this argument. Similarly, applicants' argument that registrant "is actively promoting the fact that it does not practice law," brief, p. 17, is not persuasive. The identification in the cited registration is for "legal services," and "legal services" encompasses the practice of law.

[*19]

Finally, applicants argue that the eleventh *du Pont* factor favors their position because they "are the only known seller of similar services (legal services, namely the practice of law by licensed attorneys) under this mark, or any similar mark. That being the case, Applicants have the legal right to exclude others from using WORLD'S LAW on competing or related goods or services." Brief, p. 21. This argument seems to be at odds with applicants' claim that there is evidence of widespread third-party use, as well as applicants' acceptance (in their argument regarding the *du Pont* factor

of the lack of actual confusion) that the registrant has been using its mark since 1988, far earlier than applicants' claimed date of first use in 2006. In any event, we are not persuaded by applicants' argument. Applicants are the latecomers, and on this record they do not have the right to exclude registrant from using its mark for its identified services.

After reviewing all the evidence and arguments, including those not specifically discussed herein, n10 we find that applicants' mark as used in connection with their identified services is likely to cause confusion with the mark and the services [*20] identified in the cited registration.

n10 To the extent that any other *du Pont* factors are relevant, we treat them as neutral.

Decision: The refusal of registration is affirmed.

Legal Topics:

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