

This Opinion is Not a
Precedent of the TTAB

Mailed: January 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Banc of California, National Association
v.
Crossfirst Bankshares, Inc.
—

Cancellation No. 92075496
—

Jonathan Kagan, Lana K. Guthrie and Josh Woods of Irell & Manella LLP
for Banc of California, National Association.

Colin W. Turner, Timothy J. Feathers and Adrianna M. Chavez of Stinson LLP
for Crossfirst Bankshares, Inc.

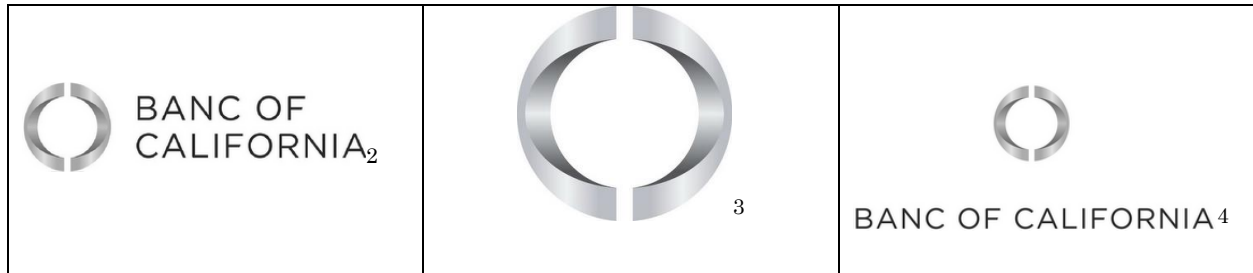
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Before Adlin, Coggins and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Respondent Crossfirst Bankshares, Inc. owns a registration for the mark shown
below



(“BANK” disclaimed) for “banking consultation; banking and financing services; equity capital investment; investment banking services; investment management,” in International Class 36 (the “Registration”).¹ Petitioner Banc of California, National Association seeks to cancel the Registration, based on its prior registrations for the three marks shown below



(“BANK OF CALIFORNIA” disclaimed in the two composite word-and-design marks), for banking and related services. Each of Petitioner’s pleaded registrations describes the mark’s design as “two stylized half circles forming a ring.” As grounds for cancellation, Petitioner alleges that use of Respondent’s mark is likely to cause confusion with Petitioner’s marks. In its answer, Respondent denies the salient allegations in the petition for cancellation, and asserts a few affirmative defenses which it did not pursue or prove at trial and which are accordingly forfeited/waived.

¹ Registration No. 5986246, issued February 11, 2020. The registration includes this description of the mark: “The mark consists of a circle with a thick border and a hollow center and split vertically in the middle by a gap at both the top and the bottom of the border centered above the stacked words ‘CROSSFIRST’ and ‘BANK’.”

² Registration No. 4728313, issued April 28, 2015; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged (the “313 Registration”).

³ Registration No. 5517261, issued July 17, 2018 (the “261 Registration”).

⁴ Registration No. 4728314, issued April 28, 2015; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged (the “314 Registration”).

In re Google Techs. Holdings, LLC, 980 F.3d 858, 2020 USPQ2d 11465 at *4 (Fed. Cir. 2020); *NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at *5 n.8 (TTAB 2021).⁵

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved Registration. In addition, Petitioner introduced:

Testimony Declaration of Samantha Haugh, its Senior Vice President of Marketing, and the exhibits thereto ("Haugh Dec."). 25-27 TTABVUE.

Notice of Reliance ("NOR") No. 1 on its pleaded registrations and a number of unpleaded registrations. ("Pet. NOR 1"). 28 TTABVUE.

NOR No. 2 on portions of its discovery deposition of Respondent and certain exhibits thereto. ("Pet. NOR 2"). 29-30 and 50 TTABVUE.⁶

NOR No. 3 on Internet printouts ("Pet. NOR 3"). 31-33 TTABVUE.

NOR No. 4 on Respondent's disclosures and discovery responses ("Pet. NOR 4"). 34 TTABVUE.

Rebuttal NOR on portions of Respondent's discovery deposition of Petitioner, submitted to prevent Respondent's submissions from the same deposition "from being misleading" ("Pet. Reb. NOR 1"). 44 TTABVUE.

⁵ Respondent had asserted a counterclaim to cancel Petitioner's pleaded '261 Registration, but withdrew the counterclaim after the trial and prior to briefing, 49 TTABVUE, and it is therefore dismissed with prejudice. Trademark Rule 2.114(c). Citations to the record are to TTABVUE, the Board's online docketing system. Specifically, the number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

⁶ Petitioner's unopposed motion to file its discovery deposition of Respondent, 50 TTABVUE, mistakenly omitted from Pet. NOR No. 2, is granted. Trademark Rule 2.127(a).

Rebuttal NOR on materials already introduced into evidence⁷ and Internet printouts (“Pet. Reb. NOR 2”). 45-46 TTABVUE.

Respondent introduced:

NOR No. 1 on its involved and third-party registrations (“Resp. NOR 1”). 36 TTABVUE.

NOR No. 2 on Petitioner’s discovery responses, including documents produced pursuant to Fed. R. Civ. P. 33(d). (“Resp. NOR 2”). 37-38 TTABVUE.

NOR No. 3 on portions of its discovery deposition of Petitioner and certain exhibits thereto (“Resp. NOR 3”). 39 TTABVUE

NOR No. 4 on portions of Petitioner’s discovery deposition of Respondent, submitted “so as to make not misleading what was offered by Petitioner” (“Resp. NOR 4”). 41 TTABVUE.

Testimony Declaration of Meggin Nilssen, its Chief of Staff and Managing Director, Marketing and Communications (“Nilssen Dec.”). 42 TTABVUE.⁸

Respondent objects “to any evidence of common law rights in or uses of any trademarks by either party ...,” pointing out that “Petitioner did not plead common law use of or rights in any trademarks.” 52 TTABVUE 16-17. Relatedly, Respondent argues that evidence of use of variations of the parties’ marks is “irrelevant.” *Id.* While Petitioner vaguely pled “use” of its registered marks, 1 TTABVUE 5 (Petition

⁷ “When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.” Trademark Rule 2.122(a). Thus, resubmission was unnecessary.

⁸ Respondent also filed notices of reliance on materials the parties already introduced at trial, 40 and 48 TTABVUE, but as indicated in the previous footnote, this was unnecessary. Trademark Rule 2.122(a).

for Cancellation ¶ 2), it did not plead common law rights that go beyond its registration rights, and thus Petitioner's likelihood of confusion claim is based solely on its registration rights. Nonetheless, we disagree that the parties' use of variations of their pleaded and involved marks is entirely "irrelevant," and we have considered uses of variations for whatever probative value those uses may have.

Respondent also characterizes letters Petitioner made of record as "settlement communications," and objects under Fed. R. Evid. 408 to statements in those letters being considered "as substantive evidence to prove or disprove any disputed claim." 52 TTABVUE 17 (in reference to evidence at 26 TTABVUE 17-35). While we have considered the letters generally, in accordance with Fed. R. Evid. 408(a) we have not considered them "to prove or disprove the validity or amount of a disputed claim or to impeach by a prior inconsistent statement or a contradiction."

II. The Parties and Their Marks

Petitioner "as presently constituted was formed in 2013, when PacTrust Bank, FSB converted into a national banking association and changed its name to Banc of California, National Association. Around the same time as this conversion, the Private Bank of California was merged into Banc of California, National Association." 25 TTABVUE 4 (Haugh Dec. ¶ 8). "The Banc is generally in the business of commercial and business banking, and also provides personal banking services." *Id.* at 5 (Haugh Dec. ¶ 8); 39 TTABVUE 26-27, 33 (Petitioner has "consumer clientele" but is "not focused on consumers at this time," and is instead "focused on business.")

Petitioner's "primary logo" is "known as the 'Banc of California Ring'" (the "Ring Design"). 25 TTABVUE 5 (Haugh Dec. ¶ 9). Petitioner's pleaded '313 and '314

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Registrations include the Ring Design, along with the words BANC OF CALIFORNIA, and Petitioner’s pleaded ’261 Registration is for the Ring Design by itself. According to Ms. Haugh, the Ring Design’s “split circle can be viewed as two Cs facing each other, which is meant to depict the C at the end of Banc and the C at the beginning of California. This symbolizes the symbiotic relationship between the Banc and California, each strengthening the other.” *Id.*; *see also id.* at 28 (Haugh Dec. Ex. 1) (Petitioner’s Brand Guidelines).

Sometimes Petitioner’s Ring Design “is shown with shading to give it texture and depth,” as shown below:



Id. at 8, 65 (Haugh Dec. ¶ 16 and Ex. 2). Other times “shading may be omitted from the [Ring Design] if it makes the design aesthetically unattractive or economically unfeasible,” as shown below:



Id. at 8-9, 76 (Haugh Dec. ¶¶ 17-18 and Ex. 6). In any event, based on Ms. Haugh’s testimony about, and the pictures depicting, this “shading” for “texture and depth,” it is clear that Petitioner’s pleaded ’314, ’261 and ’313 Registrations, on which its likelihood of confusion claim is based, are for a Ring Design with “shading to give it texture and depth.” Thus, the Ring Design as registered and shown in the drawing pages has a three-dimensional appearance.

Like Petitioner, Respondent is a bank, and like Petitioner, Respondent “focuses more on developing business with commercial clients than with personal banking clients.” 42 TTABVUE 3 (Nilssen Dec. ¶ 5); 50 TTABVUE 177 (“We generally target – or we generally have more commercial clients ... we’re more of a commercial bank.”). Respondent’s use of its involved mark at its “new location in Phoenix, Arizona” is shown below:



50 TTABVUE 119; 30 TTABVUE 7.

In February 2022, Respondent had “nine full-service banking locations in Kansas, Missouri, Oklahoma, Texas and Arizona.” 34 TTABVUE 10 (Respondent’s response to Interrogatory No. 2). In June 2022, Respondent issued a press release about its entry into “Colorado and New Mexico markets.” 32 TTABVUE 5.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978

F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). Here, Petitioner made its pleaded registrations of record, 1 TTABVUE 10-18, and those active registrations establish both that Petitioner has a statutorily-protected interest and a reasonable belief in damage proximately caused if Respondent's involved mark remains registered. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing").

IV. Priority

Respondent has not established its date of first use of its involved mark, but both parties are entitled to rely on the filing dates of their involved and pleaded registrations to establish priority. 15 U.S.C. § 1057(c); see *Calypso Tech., Inc. v. Calypso Cap. Mgt., LP*, 100 USPQ2d 1213, 1220 (TTAB 2011). Because Respondent's filing date was in 2019 and Petitioner's filing dates were in 2013 and 2017, Petitioner has priority. Respondent does not contend otherwise.

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered); 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 between the 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.”).

Petitioner bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus our likelihood of confusion analysis on the mark in Petitioner’s pleaded ’261 Registration for the Ring Design by itself. If we find confusion likely between Respondent’s involved mark and the Ring Design alone, we need not consider the likelihood of confusion between Respondent’s mark and Petitioner’s other pleaded marks. On the other hand, if we find no likelihood of confusion between the mark in Petitioner’s pleaded ’261 Registration and Respondent’s mark, we would not find confusion likely between Respondent’s mark and Petitioner’s other pleaded marks. *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611 at *6 (TTAB 2020); *N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015).

At this point, we should point out that the parties’ focus on the extent to which Petitioner has used the Ring Design by itself is largely misplaced. The certificate of the ’261 Registration is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.” 15 U.S.C. § 1057(b). While Respondent filed a counterclaim to cancel the ’261 Registration, it withdrew that

counterclaim, 49 TTABVUE, which was dismissed with prejudice in footnote 5 above, leaving the Registration intact and the Section 7(b) presumption in place. Thus, Petitioner's pleaded '261 Registration is a basis upon which we may cancel Respondent's involved Registration in the event Petitioner establishes a likelihood of confusion under Section 2(d) of the Act. However, Petitioner's use of the Ring Design by itself is relevant to the strength of that pleaded mark, as explained below.

A. The Services and Their Channels of Trade and Classes of Consumers

Respondent's Registration identifies "banking and financing services" while Petitioner's '261 Registration identifies "banking services." Thus the services are identical in part. It is sufficient for a finding of likelihood of confusion that identity is established for any item encompassed by the identification of services in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Moreover, because the services are identical in part, we presume that the channels of trade and classes of consumers for the identical services also overlap. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Respondent does not dispute that the services and channels of trade are identical. 52 TTABVUE 40 ("It is not disputed that for

purposes of this analysis, the parties’ respective services and channels of trade should be considered the same.”)

The partial identity of the services and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed Cir. 2010).

B. Strength of Opposer’s Mark

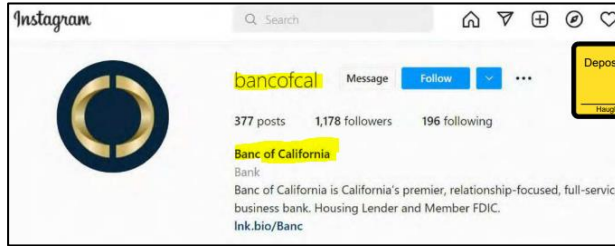
Before considering the marks themselves, we first assess how strong Petitioner’s



Ring Design mark is, to determine the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”).

1. Commercial Strength

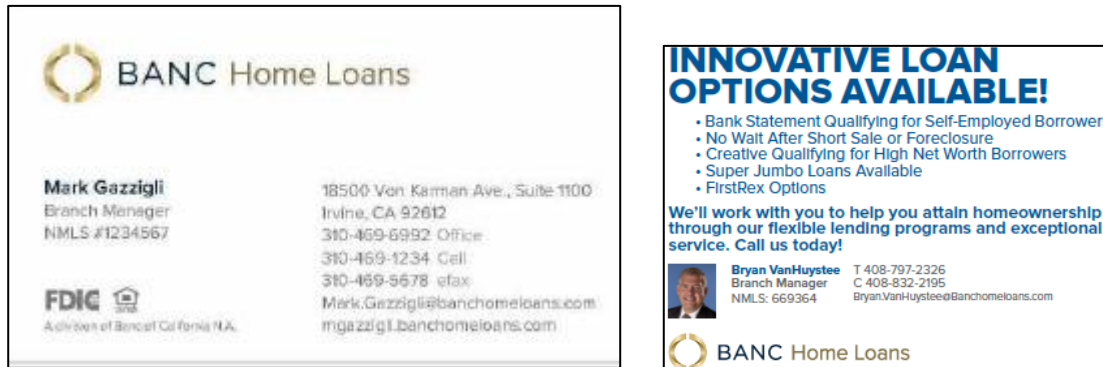
Ms. Haugh testified that Petitioner uses the Ring Design “by itself, to represent its products and services and has done so since at least July 16, 2013.” *Id.* at 9 (Haugh Dec. ¶ 21). However, the vast majority of examples Petitioner provided of alleged use of the Ring Design “by itself” in fact show “BANC OF CALIFORNIA” or “bancofcal” in close proximity to the Ring Design, as shown below:



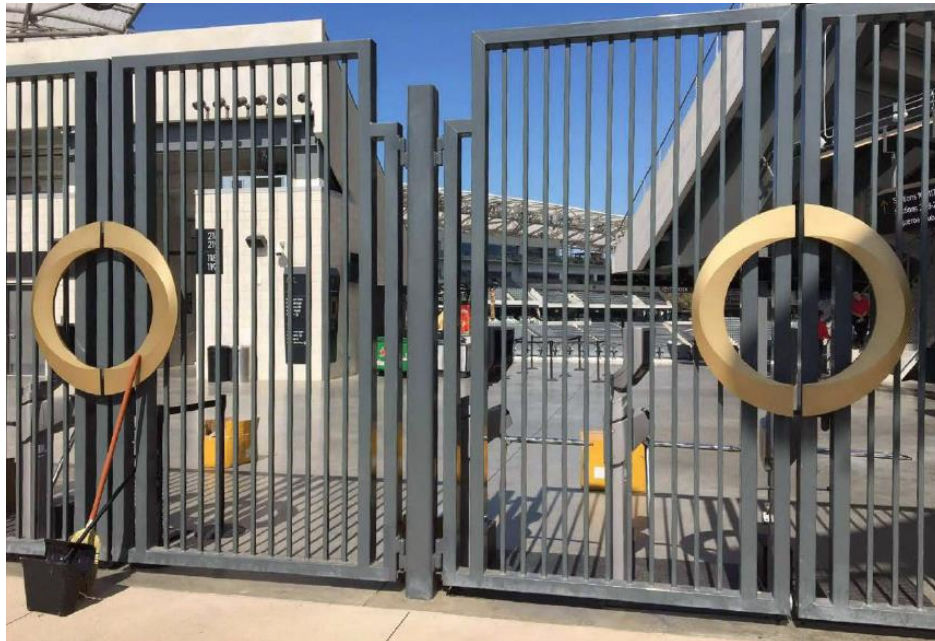
⁹ The child holding the red plaque in this photograph appears at first glance to be wearing a t-shirt bearing the Ring Design alone. But on closer inspection, it appears that the red plaque is obscuring a design on the t-shirt featuring a map of California with the words BANC OF

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Id. at 9, 74, 78, 92, 125, 163 (Haugh Dec. ¶ 21 and Exs. 5, 7-9, 13). Two examples show use of the Ring Design with “BANC Home Loans”:



Id. at 166 (Haugh Dec. Ex. 13); 27 TTABVUE 27 (Haugh Dec. Ex. 26). One example shows use of the Ring Design (alone) on the handles of a gate of a stadium with which Petitioner used to have a sponsorship deal:



CALIFORNIA appearing inside the map. This is apparent from the seemingly identical t-shirts worn by the other children in the photo. Ms. Haugh conceded as much during Respondent’s discovery deposition of Petitioner. 39 TTABVUE 51.

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25 TTABVUE 15 (Haugh Dec. ¶ 35); 26 TTABVUE 7 (Haugh Dec. Ex. 53). Finally, a “statue” of the Ring Design by itself appears outside Petitioner’s headquarters, though the building immediately behind the statue prominently displays a “BANC OF CALIFORNIA” sign:



25 TTABVUE 11-12 (Haugh Dec. ¶ 21) (“[F]rom March 27, 2017 to November 16, 2018, the Banc’s corporate headquarters housed a full branch that offered the complete set of services available at other branch locations. Even after that branch closed on November 16, 2018, business customers continue to come to headquarters for meetings.”); 27 TTABVUE 34 (Haugh Dec. Ex. 29). Other uses of the Ring Design alone include a belt buckle, a lapel pin and internal uses within Petitioner’s branches or headquarters:



27 TTABVUE 19, 32, 50, 52 (Haugh Dec. Exs. 23, 28, 33, 34).¹⁰ Petitioner “encourages employees to wear the pins, especially when providing services to a client.” 25 TTABVUE 10 (Haugh Dec. ¶ 21). However, it appears that there may not be much if any current consumer exposure to the belt buckles, even if there was some minimal consumer exposure to the buckles years ago. *Id.* (“These belt buckles were produced in association with a recurring company retreat to a ranch sometime before 2015 through 2017. In certain cases, the belt buckles were provided to clients as well.”); 39

¹⁰ At least the belt buckle does not depict the same Ring Design for which Petitioner’s pleaded marks are registered, because it does not include the “shading” in the pleaded registrations’ drawings.

TTABVUE 39-40 (the belt buckles, which are silver and gold and cost “almost a thousand dollars apiece” were given to Petitioner’s “executive and top salespeople ... as kind of a president’s award,” as well as to “some chosen clients” that “receive[d] this as a gift”). Ms. Haugh was unaware whether the belt buckles were “used to advertise and promote the bank’s services.” 39 TTABVUE 41. Thus, we can count on one hand the examples of Petitioner’s use of the Ring Design completely apart from any literal elements.¹¹

In any event, Petitioner appears to be fairly well known. Its website “typically generates more than 1.5 million page views each year from over 500,000 users.” 25 TTABVUE 13 (Haugh Dec. ¶ 30); 27 TTABVUE 73-79 (Haugh Dec. Exs. 42-44). Petitioner has more than 11,500 Facebook followers, 1,200 Instagram followers, 2,900 Twitter/X followers and 11,000 LinkedIn followers. 25 TTABVUE 14 (Haugh Dec. ¶ 32).

In 2017, Petitioner “acquired the naming rights to the Banc of California Stadium, a soccer stadium that is home to both the Major League Soccer team Los Angeles FC and the National Women’s Soccer League team Angel City FC, initially for \$100 million over 15 years.” *Id.* (Haugh Dec. ¶ 34). While Petitioner’s sponsorship deal with the stadium terminated in 2020, the stadium “will continue to bear the [Ring Design]

¹¹ Respondent’s position is that “the only use of the design component of [Petitioner’s] mark, separate and apart from the words BANC OF CALIFORNIA, was in conjunction with the sculpture” in front of Petitioner’s headquarters, but that “the sculpture as presented is perceived by the public as a work of art and/or ornamentation, and not as a source identifier, and thus does not serve a trademark function.” 34 TTABVUE 11-13, 18-19 (Respondent’s response to Interrogatory Nos. 4-6 and 13).

and the Banc Marks until a new sponsorship deal is concluded.” *Id.* at 14-15 (Haugh Dec. ¶ 34).

Petitioner “has spent millions annually advertising and promoting its banking services under the [Ring Design] and the Asserted Registrations. Its recent spending on advertising has ranged from \$3.1 million in 2021 to \$13 million in 2019.” *Id.* at 15-16 (Haugh Dec. ¶ 38).

Petitioner argues that the Ring Design is commercially strong based on its “significant investment in and promotion of the” mark, as well as its naming rights in what from 2017-2020 was known as “Banc of California Stadium,” a stadium which at the time of trial continued to “bear” Petitioner’s marks, including the Ring Design. 51 TTABVUE 45-46; 25 TTABVUE 14-15 (Haugh Dec. ¶ 34). We are not convinced.

The problem is that Petitioner’s evidence is limited to advertising expenses and the stadium sponsorship, and does not reveal how the advertising and sponsorship deal relate to the Ring Design specifically. Nor does Petitioner’s evidence bear on the relevant consuming public’s (consumers of banking services) perception of the Ring Design specifically. Indeed, Ms. Haugh merely testified that Petitioner “spent millions annually advertising and promoting its banking services under the [Ring Design] **and the Asserted Registrations**,” two of which include the wording BANC OF CALIFORNIA. 25 TTABVUE 15-16 (Haugh Dec. ¶ 38) (emphasis added). There is no way to determine the extent to which, or even if, consumers of banking services associate the Ring Design alone with Petitioner. The record shows precious little use of the Ring Design by itself, and there is no evidence that consumers focus on the

Ring Design when they encounter it together with the words “BANC OF CALIFORNIA.” Moreover, even though we can safely assume that many soccer fans saw the stadium’s gate handles that form the Ring Design, there is no evidence that they associated the handles with Petitioner as opposed to opening the stadium gate, even when the gate was closed resulting in formation of the Ring Design in its entirety.

Petitioner did not provide other types of evidence that typically support a finding of commercial strength, such as revenue figures, unsolicited media attention or other indicia of consumer perception of the mark in question. Nor did Petitioner put its advertising expenses “in context,” such as by showing “how the figures for [services bearing Petitioner’s Ring Design mark] compare with that for other brands” in the banking industry. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1831 (TTAB 2012), *citing Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) (“some context in which to place raw statistics is reasonable”). In short, being a successful or heavily promoted business does not by itself establish that any specific mark the business owns is commercially strong.

Respondent relies on several third-party registrations for marks containing circle or oval designs, 36 TTABVUE 13-34, claiming that they demonstrate “the ubiquitous **use** of split circle designs ... by banks or financial service firms.” 52 TTABVUE 38 (emphasis added). Respondent is mistaken. In fact, the cited “third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor.” *In re Davey Prods. Pty Ltd.*, 92

USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The 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.”). Moreover, third-party Registration Nos. 4817767 and 2544859,¹ 36 TTABVUE 13-14 and 24-26, were cancelled prior to their introduction into evidence and are thus evidence of nothing other than that they once issued. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). We cannot consider them.

Even if there was evidence of use of these third-party marks, which there is not, and we could consider all of them, which we cannot, none of these marks are registered for the “banking services” at issue in this case, reducing their probative value. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-95 (Fed. Cir. 2018); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017) (“Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on *similar goods*’ ... It is less relevant that ‘Century is used on unrelated goods or

services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”) (quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)); *In re Inn at St. Johns, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018).

2. Conceptual Strength

Respondent is correct, however, that live third-party registrations may show that “some segment” of Petitioner’s mark “has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak,” *Juice Generation, Inc. v. GS Enters., LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (citation omitted), and thus may go to conceptual strength, which we turn to now. Here, one problem for Respondent is that the third-party registrations it relies on are not for a term in “ordinary parlance,” but instead a design. While some consumers could refer to some of these registered third-party marks as “circles,” “split circles,” “ovals” or the like, and could refer to Petitioner’s Ring Design as, for example, a “circle” or “split circle,” we are not persuaded that this by itself makes Petitioner’s mark “conceptually weak.”

On the other hand, we recognize that circles, like other basic shapes featured in trademarks or service marks, are not generally considered particularly distinctive. *Cf. In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1073 (TTAB 2018) (pointing out, in context of assessing acquired distinctiveness, that “[m]ost common geometric shapes, such as circles, squares, triangles, ovals, and rectangles, when used as backgrounds for the display of word marks, are not considered inherently distinctive ...”) (citations omitted); *In re Am. Acad. of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002) (“However, ordinary geometric shapes such as circles, ovals,

squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof of acquired distinctiveness.”); *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804, 1805 (TTAB 1990); J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:33 (5th ed. Dec. 2023 update) (“Ordinary geometric shapes such as circles, ovals, squares, etc., **even when not used as a background for other marks**, are regarded as nondistinctive and protectable only upon proof of secondary meaning.”) (emphasis added).

Ultimately, we must presume that Petitioner’s Ring Design is inherently distinctive because it is registered on the Principal Register, by itself, in the ’261 Registration, without a claim of acquired distinctiveness. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”). *See also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). We also acknowledge that the Ring Design is not just a plain circle, but includes some at least minimally distinctive features. Nonetheless, circle designs, even when formed by “two stylized half circles forming a ring” such as Petitioner’s, are in essence basic shapes that may be encountered in a variety of commercial and other contexts and are unlikely to be perceived as highly distinctive, arbitrary or fanciful. Ultimately, given Petitioner’s failure to show that the Ring Design is commercially strong, and Respondent’s failure to overcome the presumption that the mark is inherently

distinctive, we accord the mark in Petitioner's pleaded '261 Registration the typical scope of protection afforded marks registered on the Principal Register.

C. The Marks

The marks are similar in their entireties as to appearance, connotation and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). While they do not sound alike, “[w]here, as here, we are dealing with a mark consisting of a design only,” specifically the mark in the '261 Registration, “our deliberations are limited primarily to appearance.” *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983).

The marks look similar because Petitioner's mark and the design element of Respondent's mark are circles, with the involved Registration describing Respondent's mark as a “circle” and the pleaded '261 Registration describing Petitioner's mark as a “ring.”¹² The design element in each mark is formed by two half circles, described in the involved Registration as a “thick border” with a “hollow center,” and in the pleaded '261 Registration as “stylized half circles forming a ring.” Both marks have a gap between the half circles, described in the involved Registration as a “gap at both the top and the bottom of the border.” A virtually

¹² We take judicial notice that a “ring” is a “a circular line, figure or object.” merriam-webster.com/dictionary/ring. The Board may take judicial notice of dictionary definitions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

identical “gap” is depicted, in the same vertical position, in the drawing of the ’261 Registration.

To be sure, there are also differences between the marks. Specifically, Respondent’s mark includes the words CROSSFIRST BANK, while the mark in Petitioner’s ’261 Registration consists solely of the “two stylized half circles forming a ring,” and the half circles are shaded and have other minor features absent from Respondent’s mark. The parties’ ring/circle designs do not look exactly the same, even though they feature the same shapes and are constructed similarly. But for two primary reasons, the similarities between the parties’ ring/circle designs are sufficient to cause confusion despite the relatively minor differences between the marks.

First, not only are the marks used for identical services, but we must also keep in mind: (1) “the fallibility of memory over a period of time;” and (2) that the “average” purchaser “normally retains a general rather than a specific impression of trademarks.” *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of memory”) (citation, internal quotation marks, and ellipsis omitted). This is why “[t]he 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. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)

(quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). In other words, consumers will not focus on subtle distinctions between the circle/ring designs, but instead the main takeaway from each circle/ring design is a circle formed by, and inside, two half circles.

Second, and relatedly, the literal element of Respondent's mark – CROSSFIRST BANK – is only partially distinctive and minimally distinguishing. In fact, the descriptive or generic and disclaimed term "BANK" is entitled to less weight in our analysis because it merely names the services the parties offer. *Cunningham*, 55 USPQ2d at 1846 ("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 Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); see also *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ).

Here, the generic or descriptive term "BANK" also names the services Petitioner offers, which may make confusion more likely among consumers familiar with the mark in Petitioner's '261 Registration, because that mark does not include Petitioner's name. Here, where Petitioner is entitled to use the Ring Design nationwide, unaccompanied by the name "BANC OF CALIFORNIA," the likelihood of confusion increases because consumers will not have Petitioner's name to go by. In other words, the absence of Petitioner's trade name from the mark in the '261 Registration will leave consumers encountering both parties' marks to differentiate

the sources of identical banking services based solely on the minor differences between the parties' ring/circle designs.¹³ This is a bridge too far, as consumers familiar with Petitioner's Ring Design may mistakenly perceive Respondent's mark as a version thereof, with "CROSSFIRST BANK" identifying the previously anonymous source of Petitioner's banking services. *Cf. In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (in a word mark case, refusing registration of VANTAGE TITAN based on a registration for TITAN, stating "Applicant has taken registrant's mark and added its 'product mark' to it. It is not clear why the addition of the word VANTAGE would avoid confusion. It is more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices.").

In some ways, this case calls to mind *Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973), in which the opposer based its challenge to registration of the applicant's "figure of an elderly man" mark (below on the right) on its own registrations and use of a figure of an elderly man with the words "GRANDPA PIDGEON" for identical services (below on the left):

¹³ We neither have nor offer any opinion on the extent to which the "BANC OF CALIFORNIA" name in the '313 and '314 Registrations may be sufficient to distinguish those marks from Respondent's involved mark.



vs.



The Court found the marks' overall commercial impressions "sufficiently similar" and confusion likely.

That one figure is upright and apparently spry while the other is slightly stooped is, we believe, a difference not likely to be recalled by purchasers seeing the marks at spaced intervals. Purchasers of retail services do not engage in trademark dissection. Legal surgery, in which trademarks have parts enhanced or discarded, is of little aid in determining the effect of design marks on purchasers who merely recollect. The scalpel is employed by lawyers, not purchasers.

177 USPQ at 574. While the elderly man designs at issue in *Grandpa Pidgeon's* are significantly more distinctive than the circle designs at issue in this case, at the same time we find that consumers would be unlikely to recall the minor differences between the parties' circle/ring designs, which are less significant than the differences between the elderly man designs in *Grandpa Pidgeon's*. See also *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990) (when "marks are seen at different times on such similar goods, the recollection of the first viewed mark will be a general impression most likely devoid of the details noted by applicant"); *In re United Serv. Distribs., Inc.*, 229 USPQ 237, 239 (TTAB 1986); *Puma-Sportschuhfabriken Rudolf*

Dassler KG v. Garan, Inc., 224 USPQ 1064, 1066 (TTAB 1984); *In re Steury Corp.*, 189 USPQ 353, 355 (TTAB 1975).

D. Consumer Sophistication and Care

According to Respondent, “[i]t is a textbook reality that financial services customers are exceedingly careful about who they work with.” 52 TTABVUE 29. While this argument has some superficial appeal, it is unsupported by evidence, and is therefore unpersuasive. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel).

Moreover, the involved and pleaded registrations identify “banking services,” without limitation, and banking services are consumed by not just the largest and most sophisticated Wall Street firms, but also by ordinary workers, senior citizens and students, for example. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014). Indeed, the parties both provide banking services to ordinary consumers. 25 TTABVUE 5 (Haugh Dec. ¶ 8); 42 TTABVUE 3 (Nilssen Dec. ¶ 5).

[A]pplicant seeks registration of the “COMMCASH” mark for banking services with no restrictions whatsoever. Similarly, the services covered by opposer's pleaded registration for “COMMUNICASH” include banking services, per se. Therefore, applicant's banking services as well as those of opposer are presumed to be all services that would ordinarily be considered to fall under the heading of

banking services, including not only electronic banking services to institutional customers but also electronic as well as other types of banking services offered to individual customers. Accordingly, the relevant universe of customers must be considered to include the great majority of the general public who are recipients in one form or another of banking services. For this reason, applicant's testimony and evidence regarding the sophistication of corporate banking customers is irrelevant to a determination of the question presented in this proceeding.

Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce, 228 USPQ 689, 690 (TTAB 1986), *aff'd Canadian Imperial Bank of Com. v. Wells Fargo Bank, Nat. Ass'n.*, 811 F.2d 1490 (Fed. Cir. 1987); *see also In re 1st USA Realty Prof., Inc.*, 84 USPQ2d 1581, 1587 (TTAB 2007) ("The consumers for both applicant's and the registrant's identified services are the public at large, insofar as the public includes people who wish to buy or sell homes, or to have bank accounts or credit cards, and therefore we do not regard them as being particularly sophisticated ... Because banks are federally insured, consumers do not have to investigate the financial stability of a particular bank to be sure that their money is secure.").

This factor is neutral.

E. Absence of Actual Confusion

Respondent argues that "[t]he absence of any reported instances of confusion is meaningful because the record indicates appreciable and continuous use by [Respondent] of [Respondent's involved mark] for a significant period of time in the same markets as those served by Petitioner under Petitioner's Registered Marks." 52 TTABVUE 18-19. The record, in fact, indicates the exact opposite.

Petitioner, the Banc of California, which operates under the slogan “We are California’s Business Banc,” unsurprisingly offers its banking services in California. 25 TTABVUE 5, 12 (Haugh Dec. ¶¶ 10, 11, 23). Respondent offers its banking services in Kansas, Missouri, Oklahoma, Texas and Arizona, and perhaps Colorado and New Mexico. 34 TTABVUE 10 (Respondent’s response to Interrogatory No. 2); 32 TTABVUE 5. In other words, the parties are not “in the same markets.” Nor has Respondent used its involved mark for “a significant period of time.” To the contrary, Respondent has not established any use of its mark prior to April 2019. 50 TTABVUE 39.

“[T]he absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Here, Respondent has not introduced evidence showing the extent of its use of its involved mark for a significant period of time in the same markets Petitioner serves (primarily or exclusively California). We therefore cannot gauge whether there has been a meaningful opportunity for confusion to occur. *See also Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF’s use of the

VITTORIO RICCI mark on the merchandise in question in prior years”); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). This factor is neutral.¹⁴

VI. Conclusion

Petitioner has established its priority of use, as well as the identity of the services, their trade channels and classes of consumers, and that the marks are more similar than dissimilar. To the extent that Respondent has shown that the mark in Petitioner’s pleaded ’261 Registration is conceptually somewhat weak, that is not enough to ameliorate the likelihood of confusion. In fact, likelihood of confusion “is to be avoided as much between weak marks as between strong marks,” *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982), and we find confusion likely here.

Decision: The petition for cancellation under Trademark Act Section 2(d) is granted.

¹⁴ Petitioner’s argument that its alleged offering of a “wide variety of banking and financing services” weighs in favor of finding a likelihood of confusion, 51 TTABVUE 48-49, is not well taken. Petitioner has not established use of its Ring Design alone for a variety of services, and all of Petitioner’s services are in the same general field and most or all fall within the identified “banking services.”