

**This Opinion is Not a
Precedent of the TTAB**

Mailed: July 18, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Jorge Alvarez
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Serial No. 85529354
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Matthew H. Swyers of The Trademark Company,
for Jorge Alvarez.

Esther Borsuk, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Seeherman, Taylor and Gorowitz,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Jorge Alvarez (“Applicant”) has appealed from the final refusal of the Trademark Examining Attorney to register the mark PAYITAWAY (in standard characters) for “consumer lending services” in International Class 36.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that Applicant’s mark so resembles the following marks, all owned by the same

¹ Application Serial No. 85529354 was filed on January 31, 2012, based on Section 1(a) of the Trademark Act, and asserting first use and first use in commerce since at least as early as August 2011.

individual, Steve Zeringue, that when used in connection with Applicant's services, it is likely to cause confusion or mistake or to deceive:

PAYAWAY² and PAYAWAY PRIME,³ with PRIME disclaimed, both in standard characters and both for "credit card loan services; evaluation of the credit worthiness of companies and private individuals; installment loans; loan financing.

PAYAWAY in standard characters for "credit and loan services; evaluation of credit worthiness of companies and private individuals; financial services in the nature of electronic commerce payment services, namely, establishing electronic funds transfers or authorized credit or debit agreements used to purchase goods and services on the Internet or in person for businesses and consumers.⁴

Applicant and the Examining Attorney have filed briefs. We affirm the refusal to register.

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 this case, the Examining Attorney identifies the *du Pont* factors of the similarity of the marks, similarity of the goods, and trade channels as being relevant. Applicant agrees that these three factors are relevant, and also adds the factors of conditions of purchase, number and nature of similar marks in use on similar services, and the absence of actual confusion.

² Registration No. 3726382, issued December 15, 2009.

³ Registration No. 3729507, issued December 22, 2009.

⁴ Registration No. 3939139, issued March 29, 2011.

Applicant acknowledges that the factors of the similarity of the services and channels of trade favor a finding of likelihood of confusion:

In the instant case, the services of the parties, in part, directly overlap. As such, it cannot be said that they are dissimilar. Moreover, as there are no limitations as to the channels of trade or presumed marketing channels of the goods [sic] as identified in the application and registrations, the services of the Applicant are presumed to travel in the same channels of trade and are further presumed to be marketed in the same manner of those services identified in the cited registrations.

Brief, p. 7, 4 TTABVue 8. In view of this admission, we need not recite the evidence the Examining Attorney submitted on these factors, but only note that we agree that the services are, in part, identical, and therefore are presumed to travel in the same channels of trade and be marketed in the same manner.

Applicant argues that, despite the in-part identity of the services and trade channels, confusion stemming from the use of Applicant's mark and the Registrant's marks is not likely to occur because of the differences in the marks, when the suggestiveness or descriptiveness of the common elements are considered. Applicant has submitted definitions for the words PAY and AWAY,⁵ asserting that the following two are relevant with respect to the parties' services:

PAY: to satisfy the claims of (a person, organization, etc.) as by giving money due: *He paid me for my work.*

AWAY: out of existence or notice; into extinction: *to fade away; to idle away the morning.*

⁵ Applicant included definitions of these words, taken from Dictionary.com, in his brief, and requested that we take judicial notice of them. We do so. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

One of Applicant's arguments is that these two words are descriptive in his mark, while consumers would not know what "IT" is, and therefore "the only inherently distinctive component of the Applicant's mark, the term 'IT', would be viewed by the relevant consuming public as the dominant portion of Applicant's trademark at issue and not the descriptive terms PAY or AWAY." Brief, p. 11, 4 TTABVUE 12.

We disagree. First, the consuming public is likely to view Applicant's mark PAYITAWAY as a unitary phrase, and when it is viewed in connection with consumer lending services, IT would have the meaning of a loan. The presence of IT does not distinguish Applicant's mark from the cited PAYAWAY marks; rather, the addition of the pronoun merely makes PAYITAWAY a somewhat more grammatical or complete phrase than PAYAWAY. Both marks, however, convey the same meaning and commercial impression. Further, the addition of IT to Applicant's mark does not serve to distinguish the marks in appearance. The word IT is "buried" in Applicant's mark, between the words PAY and AWAY. Many consumers would not notice this difference even if the marks were displayed side-by-side. And, of course, a side-by-side comparison is not the appropriate test: Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). Consumers familiar with the Registrant's mark PAYAWAY may misremember it when they encounter Applicant's PAYITAWAY mark used in

connection with identical services, and view it as the same mark. For this reason, the difference in pronunciation that the word IT creates by making Applicant's a three-syllable mark is also not sufficient to distinguish the marks. As for the cited mark PAYAWAY PRIME, although it contains the additional word PRIME, this disclaimed term is descriptive for loan services, and therefore this difference is not sufficient to distinguish the marks.

Although in this case Applicant's mark is extremely similar to the cited marks, we point out that, in general, when marks would appear on virtually identical goods or 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).

The second argument Applicant makes in terms of the asserted descriptive meanings of the words PAY and AWAY is that the cited marks "are highly suggestive if not merely descriptive of the recited services for which they are registered and, as a result, are only entitled to a very narrow scope of protection under the Act." Brief, p. 9, 4 TTABVUE 10.

The cited registrations issued on the Principal Register, and therefore the certificates of registration are prima facie evidence of the validity of the registered marks. See Section 7(b) of the Trademark Act. Applicant may not collaterally attack the registrations by asserting that the marks are merely descriptive. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531,1535-36 (Fed. Cir. 1997). We agree, however, that the cited marks are highly suggestive, and therefore Applicant

is correct in asserting that they are entitled to a more limited scope of protection than a strong mark would be. However, the services are in part identical, and as discussed above, the marks are extremely similar. The scope of protection accorded to the cited registrations therefore is sufficient to prevent the registration of Applicant's mark.

Finally, as previously noted, Applicant claimed at page 6 of his brief that, in addition to the *du Pont* factors of the similarity of the marks, goods and channels of trade, discussed above, the factors of conditions of purchase, number and nature of similar marks in use on similar services, and absence of actual confusion are also relevant. However, apart from listing them as being relevant, Applicant did not again mention them in his brief, let alone discuss them. We will nevertheless address them because Applicant did bring up these points in its Response filed June 4, 2013, and submitted evidence, in the form of his affidavit, with respect to two of them.

With respect to the conditions of purchase, the services, which are identified as "consumer lending," are by definition offered to consumers, i.e., the general public. The fact that in practice Applicant's services are directed to "businesses who want to be able to accept clients who can only afford to pay in monthly installments," e.g., "in home service providers such as plumbers and contractors,"⁶ is irrelevant; we must consider the services as they are identified in the application. Further, the "clients" of these businesses who would take advantage of the loan

⁶ Alvarez Affidavit, Exhibit 5 to Response filed June 4, 2013.

services would be the general public, and they cannot be assumed to have any particular expertise or sophistication about such loan services.

As for the *du Pont* factor of the number and nature of similar marks in use on similar goods [or services], Applicant has not submitted any evidence of such use. The third-party registrations submitted by Applicant are not evidence of use of the marks shown therein. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Therefore, this factor is neutral.

Finally, Applicant has asserted that he has experienced no instances of actual confusion with the cited marks since he began using his mark PAYITAWAY in January 2011.⁷ However, as the Court stated in *In re Majestic Distilling Co.*, 65 USPQ2d at 1205:

uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). 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, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context.

Accordingly, we treat this factor as neutral.

⁷ In his application Applicant asserted first use and first use in commerce *as early as* August 2011. He signed his affidavit attesting to no instances of actual confusion in June 2013.

After having reviewed all the evidence and arguments, we find that Applicant's use of PAYITAWAY for "consumer lending services" is likely to cause confusion with the three cited registered marks.

Decision: The refusal to register Applicant's mark PAYITAWAY is affirmed.