

This Opinion is not a
Precedent of the TTAB

Hearing: August 22, 2019

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Capital Automotive LLC

Serial No. 87573198

Timothy D. Pecsénye of Blank Rome LLP
for Capital Automotive LLC

Gayne G. Zimmerman, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Cataldo, Mermelstein, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Capital Automotive LLC (“Applicant”) seeks registration on the Principal Register

of the composite mark  for “Financial services provided to the automotive retail industry, namely, providing automotive dealers with real estate investment trust services, real estate investment services and financial services in

the nature of equity investing and money lending for real estate development” 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 of likelihood of confusion with four registered standard character marks, all of which are owned by a single organization, and all of which describe predominantly charitable goods and services:

CAF

for “Printed matter, namely, ... leaflets, brochures, and instructional materials about charitable fund raising” in International Class 16; and

“Charitable fund raising” in International Class 36.²

CAF

for “Electronic publications being downloadable from the Internet and CD Rom in the nature of a magazine, ... brochure, report or guide in the field of financial and advisory services which benefit charities and social enterprises” in International Class 9;

“**Business research**; provision of business information in the field of financial and advisory services for charities and social enterprises in the form of reports, statistics and accounts” in International Class 35;

“Charitable fundraising; **financial advice and consultancy services**; financial arrangements to facilitate charitable giving; ...**preparation of financial reports and analyses**; ... online financial services, namely, ... arrangements to facilitate charitable giving; grant making services,

¹ Application Serial No. 87573198 was filed on August 17, 2017, based on Applicant’s claim of first use and first use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), at least as early as May 2016. According to the description in the application, “the mark consists of the stylized letters ‘CAF’ with a stylized depiction of a road overlaying the letters ‘AF.’” Color is not claimed as a feature of the mark.

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

² Registration No. 2430263, issued on the Principal Register on Feb. 20, 2001, renewed.

namely, providing and advising on the provision of grants to charitable causes and organisations and social enterprises; ... **financial research**” in International Class 36; and

“Arranging and conducting conferences, seminars and workshops; organizing and arranging charity and financial awards programs” in International Class 41.³

CAFAMERICA

for “Printed matter, namely, ... leaflets, brochures, and instructional materials about charitable giving and fund raising” in International Class 16; and

“Charitable fundraising; financial arrangements to facilitate charitable giving and fund raising, namely, ... donor advised fund services” in International Class 36.⁴

CAF AMERICA

for “Video tapes and discs, electronic publications being downloadable from the internet and CD ROM, namely, downloadable electronic publications in the nature of PDF files, graphic works, radio transcripts, visual presentation materials, in the field of grant making and philanthropy” in International Class 9;

“Business research; provision of business information in the form of reports, statistics and accounts relating to grant making and philanthropy, namely, provision of receipts to donors for charitable donations for tax reporting purposes; providing business advice and information in the field of grant making and philanthropy” in International Class 35; and

“Charitable fundraising; **financial advice and consultancy services;** financial arrangements to facilitate charitable giving, namely, facilitating and arranging for the financing and distribution of fundraising and donations; investment trust services for philanthropic funds namely, trust services in the nature of charitable fundraising, grant making and philanthropy; deposit taking services for others, namely, establishing donor advised funds including friends funds and designated funds and donor advised gifts for others, namely, establishing funds for others; **debit card services; online financial services, namely, online business fundraising services;** fundraising and financial donation services,

³ Registration No. 3365712, issued on the Principal Register on Jan. 8, 2008, renewed. (Emphases added.)

⁴ Registration No. 2523013, issued on the Principal Register on Dec. 25, 2001, renewed.

namely, charitable fundraising services by means of providing individuals with the information and opportunity to make monetary donations to a designated charity; providing monetary grants, namely, providing financial grants to charities; organizing grant making programs for charities and others, namely, providing financial grants to charitable institutions and advisory services related thereto, namely, advisory services relating to grant making in the nature of providing grants and philanthropy; **financial research; preparation of financial reports and analyses, for others**” in International Class 36.⁵

The first three registrations were issued to Trustees of the Charities Aid Foundation, a United Kingdom trust, and were then assigned to the current Registrant, CAF Nominees Limited, also of the United Kingdom. The fourth registration, for **CAF AMERICA**, was issued directly to CAF Nominees Limited.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. Applicant’s counsel and the Examining Attorney filed briefs and appeared at a hearing before the Board.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 135, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

⁵ Registration No. 5050134 issued on September 27, 2016. Registrant disclaims the exclusive right to use “AMERICA.” (Emphases added.)

We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. See *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

A. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that if the marks are considered in their entireties, its mark,

 , differs from the cited registered marks, CAF, CAF AMERICA, and CAFAMERICA, in sight, sound, and meaning. It contends:

As to appearance, the only shared component of Applicant's mark and the Cited Marks is the lettering "CAF." That is where any relevant similarity ends. The stylistic and design elements of Applicant's mark are entirely absent from the Cited Marks. The dominant portion of Applicant's mark is comprised of the stylized letters "CAF" with a stylized depiction of a road overlaying the letters "AF." In stark contrast, the Cited Marks are comprised simply of "CAF" in standard characters or a combination of the terms "CAF" and "AMERICA" – "AMERICA" being entirely absent from Applicant's mark. As in the instant case, where Applicant's mark contains design material not present in the Cited Marks, ***the marks are in fact not confusingly similar.***

...

It follows logically that "CAF" undoubtedly sounds differently than "CAF AMERICA" or "CAFAMERICA." Consequently, these marks are unquestionably aurally distinct.

...

Moreover, contrary to the Examining Attorney's position, the marks convey entirely distinct meanings, further contributing to their distinct commercial impressions and precluding any possibility of confusion. The Cited Marks, as used in connection with Registrant's services, convey to consumers the fact that the services are offered in connection with the "Charitable Aid Foundation." In stark contrast to the Cited Marks, Applicant's mark is an abbreviation for the company name "Capital Automotive Financial."⁶

We agree with the Examining Attorney, however, that the marks are similar. The literal portion of Applicant's mark is identical to Registrant's CAF marks, and encompassed in Registrant's CAF AMERICA and CAFAMERICA marks. The stylization of letters in Applicant's mark does not distinguish them, as Registrant's standard character marks may be used in any font style, size, or color. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Aquitaine Wine*

⁶ Applicant's brief, 7 TTABVUE 21-22.

USA, LLC, 126 USPQ2d 1181 (TTAB 2018); Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Nor does the road design distinguish the marks. Design features may help distinguish marks if they are prominent and eye-catching,⁷ but here, the road design in Applicant's mark blends into the letters, forming the crossbar of "A" and ending as part of "F." Consequently, the design is a subordinate feature, and the letters comprising the literal portion of Applicant's mark remain its dominant feature—the part purchasers would remember and use to request Applicant's services. "[T]he literal elements of a mark are likely to make a greater impression upon purchasers than any stylization of the words or accompanying designs, and would be remembered by them and used by them to request the services." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1747 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019). Hence, the marks are similar in appearance.

In terms of sound, we find that Applicant's mark would be pronounced identically with Registrant's **CAF** marks. It is true that Registrant's **CAF AMERICA** and **CAFAMERICA** marks would, if pronounced in their entirety, sound different from Applicant's mark, but that difference would not dispel their similarity. Marks are frequently found to be similar where one mark encompasses or incorporates the other. *See, e.g., TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1115 (TTAB 2019) ("Applicant's TIVO-formative marks (TIVOTAPE and TIVOBAR) are similar to

⁷ *See, e.g., White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) ("As to appearance, we find that the prominent design feature and the term TERZA in the registered mark serve to distinguish the registered mark visually from applicant's mark."); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (prominently displayed design considered to be dominant element of the mark because it catches the eye and engages the viewer before the viewer looks at the word portion of the mark).

Opposer's TIVO mark in appearance and pronunciation due to the shared term 'TIVO' in each mark."). **CAF** is the first, most prominent, and most distinctive feature in all of the marks. *See Palm Bay Imps.*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar..."). AMERICA is the less distinctive, geographically descriptive feature, disclaimed in one of Registrant's marks. *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1210.02(b)(iv) (Oct. 2018) ("If 'AMERICA' or 'AMERICAN' is used in a way that primarily denotes the United States origin of the goods or services, then the term is primarily geographically descriptive.").⁸ So there is nothing improper in giving more weight to **CAF**, the dominant portion of Registrant's marks, even though we compare the marks in their entireties. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018).

In terms of connotation and commercial impression, it may be true that Applicant's "CAF" stands for "Capital Automotive Financial," and Registrant's "CAF" stands for "Charitable Aid Foundation," but their respective initials do not reveal that derivation. The Board rejected a similar argument in *Christian Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560 (TTAB 2007):

Respondent contends that the connotations engendered by the marks are not similar because the marks are acronyms or initialisms which mean different things: Christian Broadcasting Network in the case of petitioner's CBN mark; and Alto Broadcasting Network and Chronicle Broadcasting Networking in the case of respondent's ABS-CBN mark. Respondent's

⁸ *See also* American Heritage Dictionary AHDictionary.com 6/21/2018, primary definition of "America" is "The United States." June 21, 2018 Office Action at 166.

argument fails because the corporate names are not part of either party's registrations, and moreover there is no evidence that respondent uses its ABS-CBN mark in proximity to the underlying corporate name.

Id. at 1569.

It has long been recognized that “the derivations of letter marks and acronyms are of no particular significance.” *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 (TTAB 2007) (finding BHD similar to BVD, despite differing meanings); *See also Edison Bros. Stores, Inc. v. Brutting E. B. Sport-Int'l GmbH*, 230 USPQ 530, 533 (TTAB 1986) (collecting cases) (“It should be noted that the lettered marks in almost all of the cited decisions were, as in the case before us, derived from the trade or corporate names of the involved parties, but these facts had no negative influence upon the likelihood of confusion conclusions which were reached.”).⁹ Consequently, we must restrict our attention to the shared initialism CAF, and cannot distinguish the marks based on the differing words from which the initials were derived.

For these reasons, based on consideration of the marks in their entireties, taking into account their appearance, sound, connotation, and commercial impression, we find that the marks are similar, and that the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

⁹ Applicant argues that its position against likelihood of confusion is further underscored by the cited registered marks' concurrent existence with two registered word-and-design marks containing the initialism CAF, Reg. Nos. 3585302 and 4784602. Applicant's brief, 7 TTABVUE 25-26, Dec. 21, 2018 Response to Office Action at 37-51. But as the Examining Attorney correctly notes, these marks, both owned by the same registrant, incorporate not only design elements, but the wording, CHALLENGED ATHETES FOUNDATION, from which the initials CAF were derived. Examining Attorney's brief, 10 TTABVUE 10. Moreover, as the Examining Attorney observes, two registrations are insufficient in number to demonstrate that the cited registered marks are weak or diluted. *Id.* *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017).

B. The Goods and Services, Trade Channels, Purchasers, and Care and Sophistication in Purchasing

We next consider the second, third, and fourth *DuPont* factors, which concern, respectively, the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” the “similarity or dissimilarity of established, likely-to-continue trade channels,” and the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. We consider these factors together because in this case they tend to coalesce.

Applicant’s services, once again, are “Financial services provided to the automotive retail industry, namely, providing automotive dealers with real estate investment trust services, real estate investment services and financial services in the nature of equity investing and money lending for real estate development.” Applicant argues that “Applicant’s services are limited to providing automotive dealers with real estate investment services” such as buying the dealers’ lots and leasing the lots back to them, or becoming co-owners of the lots—all of which provides capital to the dealers, enabling them to expand.¹⁰ “Such services bear no relation to the charitable fundraising services for which the Cited Marks are registered; and none of the Cited Marks are registered in connection with, nor are their services in any way related to, real estate investment services,” Applicant argues.¹¹ “Applicant

¹⁰ Applicant’s brief, 7 TTABVUE 12, 17; Dec. 21, 2018 Response to Office Action at 14-15, 30-36.

¹¹ Applicant’s brief, 7 TTABVUE 12.

and Registrant occupy and operate in indisputably discrete industries and market sectors,” Applicant concludes, “The chances of confusion between Registrant’s mark and Applicant’s mark is extremely unlikely given the fact that the two entities operate in completely distinct spheres.”¹²

The Examining Attorney counters that “To clarify, the refusal is, and has always been, based upon not only the registrant’s identified ‘charitable fundraising’ services but also several other of its identified financial services...,” such as “financial advice and consultancy services” and “financial research.”¹³ According to the Examining Attorney:

Financial institutions regularly offer investment, financing, and financial consulting services to automobile dealerships under the same marks as they offer charitable fundraising, nonprofit financial investment management and consulting, financial research, and related financial services. Accordingly, consumers would believe such services offered under the applicant[‘s] and registrant’s marks are likely to come from the same source.¹⁴

In support of this contention, the Examining Attorney adduces evidence of nine third-party financial institutions that have offered financial services to automobile dealerships and charitable fundraising under the same or similar marks:

Wells Fargo	
<ul style="list-style-type: none"> • Provides “Dealer Support” as “one of the nation’s leading auto lenders,” providing consumers with auto financing that meets their needs, thus helping dealers serve their customers. 	<ul style="list-style-type: none"> • Provides business banking services, retirement plans, investment management, and philanthropic services to nonprofit organizations. • “Wells Fargo Philanthropic Services provides a full array of services to private and family foundations across the country, including

¹² Applicant’s brief, 7 TTABVUE 17.
¹³ Examining Attorney’s brief, 10 TTABVUE 12.
¹⁴ Examining Attorney’s brief, 10 TTABVUE 20.

<ul style="list-style-type: none"> • Offers “our full spectrum of services... customized for the commercial real estate industry.” • Provides financing for real estate investment trusts. “Wells Fargo Real Estate Investment Corporation, a real estate investment trust, engages in acquiring, holding, and managing mortgage assets and other authorized investments in the United States.” 	<p>fiduciary administration, investment management, grant-making support, and consulting services.”</p> <ul style="list-style-type: none"> • “We support thousands of national and community-based nonprofits annually to help revitalize and strengthen communities. We are among the top corporate cash donors among U.S. companies....”¹⁵
<p>Fidelity</p>	
<ul style="list-style-type: none"> • Provides real estate investment trust services. “The Real Estate sector is primarily made up of companies that own commercial real estate properties. A large portion of the companies are structured as Real Estate Investment Trusts (REITs).” 	<ul style="list-style-type: none"> • Describes “Fidelity Charitable” as an independent charity facilitating donations, with tax benefits for the donors, for the benefit of charities. Recognized as “the top nonprofit fundraiser in the US.”¹⁶
<p>Cushman & Wakefield</p>	
<ul style="list-style-type: none"> • Launches automotive specialty practice group in 2016. • “The Automobile Dealership Practice Group is comprised of professionals with specialized training and experience in the valuation of automobile dealerships.” • “Our highly experienced, full spectrum financial services platform provides investors with unsurpassed customized advisory and integrated capital solutions for all assets classes including office, multifamily, retail, lodging and leisure, healthcare and senior housing facilities, industrial and land.” 	<ul style="list-style-type: none"> • Under the heading “community involvement,” lists efforts of its members supporting various charities throughout the country. • Supports charitable events raising funds for diabetes research and gathering clothing for the underprivileged.¹⁷
<p>SunTrust</p>	
<ul style="list-style-type: none"> • Offers “Auto Dealer Services” and “Auto Dealer Financial Services,” including “Secure the funding you need to upgrade or expand your dealership property with your choice of 	<ul style="list-style-type: none"> • Assists community fundraising programs.

¹⁵ WellsFargo.com 11/28/2017, Bloomberg.com 11/28/2017, Nov. 28, 2017 Office Action at 27-32, June 21, 2018 Office Action at 29-40, 182-187.

¹⁶ Fidelity.com 11/28/2017, 6/21/2018, FidelityCharitable.org 11/28/2017, Philanthropy.com 6/21/2018, Nov. 28, 2017 Office Action at 33-35, June 21, 2018 Office Action at 122-132.

¹⁷ CushmanWakefield.us 11/28/2017, CushmanWakefield.com 6/21/2018, CushWakeSouthFl.com 6/21/2018, TheUndergroundChicago.com 6/21/2018, Nov. 28, 2017 Office Action at 36-40, June 21, 2018 Office Action at 139-148.

<p>renovation, construction and commercial mortgage loans.”</p>	<p>•“Our onUp Together Volunteerism program empowers and inspires our teammates to give back to our communities.”¹⁸</p>
<p>BB&T</p>	
<ul style="list-style-type: none"> • Provides “Dealer Financial Services” with “quality financing options to automobile dealers” and “a full range of retail and dealer financial services.” 	<ul style="list-style-type: none"> • “The BB&T Institutional Services Philanthropic Services Group partners with endowments, foundations and nonprofit organizations to address challenges, build capacity and create a lasting legacy.” • BB&T associates participate in an annual, company-wide community service effort. • Sponsors charitable, fundraising activities, e.g., for United Way or the Maryland Zoo.¹⁹
<p>Bank of America</p>	
<ul style="list-style-type: none"> • Provides “Dealer Financial Services” “deliver[ing] specialized auto industry expertise and solutions” to help auto dealers—services such as “comprehensive lending solutions, including lines of credit, real estate and construction financing, acquisition financing and equipment financing” and competitive interest rates in loans for new and used vehicles. 	<ul style="list-style-type: none"> • Offers “not for profit banking” services such as grant funding programs, event sponsorships, and matching gifts.²⁰
<p>PNC</p>	
<ul style="list-style-type: none"> • Provides “Financial services for Car Dealerships” including “an array of financial services to franchised, new automobile dealers” • Offers “Real Estate Market Analysis & Webinars” 	<ul style="list-style-type: none"> • The “PNC Foundation” “form[s] partnerships with community-based nonprofit organizations in order to enhance educational opportunities, with an emphasis on early childhood education, and to promote the growth of communities through economic development initiatives.” • Provides sponsorships to educational programs, arts and cultural programs, and economic development organizations.²¹

¹⁸ SunTrust.com 6/21/2018, June 21, 2018 Office Action at 12-28.

¹⁹ BBT.com, 6/21/2018 June 21, 2018 Office Action at 44-49.

²⁰ BofAml.com 6/21/2018 June 21, 2018 Office Action at 64-74, 83-84.

²¹ PNC.com 6/21/2018, June 21, 2018 Office Action at 87-103, 172.

M&T Bank	
<ul style="list-style-type: none"> • Provides “Dealer Financial Services” furnishing “a wide variety of lending products to meet your retail and wholesale dealership financing needs.” 	<ul style="list-style-type: none"> • Provides “support for a diverse range of civic, cultural, health and human service organizations through grants, employee volunteerism and in-kind services.” Has raised money for the United Way.²²
Capital One	
<ul style="list-style-type: none"> • Provides “Commercial Dealer Services” including “Dealer-Focused Commercial Banking Solutions,” “Floorplan, Mortgage and Acquisition Financing,” “Dealership Acquisition and Partner Buyout Financing” and “Real Estate Financing.” • Provides Commercial Banking Solutions, including commercial lending. 	<ul style="list-style-type: none"> • Provides sponsorships to charitable organizations for charitable fundraising purposes. • Launched a bank card program by which all rewards earned on the cards are donated directly to the nonprofit organizations.²³

The Examining Attorney concludes:

This evidence establishes that financial institutions commonly provide the relevant financing, investment management, charitable fundraising, financial research, and financial consulting services identified in the application and the cited registrations, and markets those services under the same mark. ... The relevant services likewise are sold or provided through the same trade channels, namely, through financial institutions familiar with complex financial structures and business financing needs.²⁴

Applicant responds that “only *one out of the nine* third-party financial institutions relied upon by the Examining Attorney arguably offers both Applicant’s services and Registrant’s services under a single mark. The remainder of the evidence consists of companies that either do not offer charitable fundraising services or real estate investment services, or fail altogether to show these services *as emanating*

²² MTB.com 6/21/2018, June 21, 2018 Office Action at 104-121, 149-151.

²³ CapitalOne.com 6/21/2018, BGCCC.org 6/21/2018, MaurerFoundation.org/capital-one-to-sponsor-flamingo-bowl 6/21/2018, CreditCards.com/credit-card-news/capital-one-launched-non-profit-card-program 6/21/2018, PhilanthropyNewsDigest.org 6/21/2018, June 21, 2018 Office Action at 152-165, 168-170.

²⁴ Examining Attorney’s brief, 10 TTABVUE 17-18.

*from the same source under a single mark.*²⁵ For example, Applicant points out, Cushman & Wakefield employees may participate in supporting various charities, but **participation** in a fundraising activity does not equate to **offering** charitable fundraising services.²⁶ Capital One has also supported charitable organizations, and launched a now-discontinued credit card program designed to direct rewards to charitable organizations.²⁷ And in most of the Examining Attorney’s examples, Applicant notes, the financial institutions offered the financial and charitable services under different marks:

Financial	Charitable
	
WELLS FARGO DEALER SERVICES	WELLS FARGO PHILANTHROPIC WELLS FARGO FOUNDATION
M&T BANK	THE M&T CHARITABLE FOUNDATION
CAPITAL ONE	FUTURE EDGE CARD LAB CONNECT
SUNTRUST DEALER FINANCIAL SERVICES	THE SUNTRUST FOUNDATION OUR ONUP TOGETHER VOLUNTEERISM PROGRAM
PNC	PNC FOUNDATION PNC CHARITABLE TRUSTS PNC GROW UP GREAT
BB&T	THE BB&T INSTITUTIONAL SERVICES PHILANTHROPIC SERVICES GROUP ²⁸

²⁵ Applicant’s brief, 7 TTABVUE 12.

²⁶ Applicant’s brief, 7 TTABVUE 13.

²⁷ Applicant’s brief, 7 TTABVUE 14.

²⁸ Applicant’s brief, 7 TTABVUE 13-15.

The Examining Attorney responds that financial institutions often use the same house mark, and add generic terms and variations in connection with different lines of services. In the majority of the third-party examples, she argues, the primary house brand appears prominently on the excerpted webpages.²⁹ Furthermore, she maintains, Applicant's arguments distinguishing the services provided by the third party financial institutions from those provided by Applicant and Registrant "rely on alleged actual use by applicant and registrant, which is not relevant where, as here, no such limitations exist in the identified services of either the application or the registrations."³⁰

We find the third-party evidence insufficient. It is true that evidence that "a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis." *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). And in some cases, based on third-party evidence, we can find that "consumers would readily perceive these types of services as being sufficiently related as to be offered by a single business." *In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (TTAB 2016). In this case, though, we find the third-party evidence relevant but not sufficient to show that Applicant's and Registrant's goods and services would be perceived as emanating from the same source. The nine third-party examples posited in this case all involve banks and other large, full-service financial institutions, whom the general public would naturally

²⁹ Examining Attorney's brief, 10 TTABVUE 18-19.

³⁰ Examining Attorney's brief, 10 TTABVUE 19.

expect to provide diverse and varied lines of services. Those third-party examples do not apply here, given the specialized nature of the involved services; neither Applicant nor Registrant is a large commercial bank or a full-service financial institution, nor would they be regarded as such. One is a charitable foundation, and the other a niche provider of specialized real estate investment trust services to automotive dealers. There is no evidence that the relevant class of purchasers Applicant serves, automotive dealers, would readily perceive Applicant or Registrant as having the same breadth of services as a large, full service bank or financial institution. The third-party banks and financial institutions are simply different in kind.

We find that the second, third, and fourth *DuPont* factors weigh against a likelihood of confusion, based on the identification of goods and services in the Application and cited registrations. *See generally Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (look to the services as identified in the application vis-à-vis those recited in the cited registration). Limitations in those identifications may be considered in analyzing the applicable *DuPont* factors. *See In re i.am.symbolic*, 123 USPQ2d at 1748.

The plain wording of Applicant's recitation of services strictly limits its services to a well-defined, industry-specific class of purchasers, "automotive dealers." The services it furnishes to those dealers are expressly limited to "real estate investment trust services, real estate investment services, and financial services in the nature of equity investing and money lending for real estate development." These complex and sophisticated financial services, by their very nature, could be furnished to the

dealers only after a deliberate process of negotiating and executing legally binding agreements concerning real estate. The dealers would, in consequence, exercise more than ordinary care in their purchasing decisions.

Although the cited registrations predominantly identify charitable fundraising goods and services, two of the cited registrations contain clauses set off by semicolons (emphasized above in **boldface**) reciting services that are not limited to charities:

“Business research; ...“financial advice and consultancy services;” ... “preparation of financial reports and analyses;” ... “financial research” ... “arranging and conducting conferences, seminars and workshops” identified in Registration No. 3365712 for CAF; and

“Business research; ... “financial advice and consultancy services;” ... debit card services; online financial services, namely, online business fundraising services;” and “financial research; preparation of financial reports and analyses, for others” identified in Registration No. 5050134 for CAF AMERICA.

See In re Midwest Gaming & Entm’t LLC, 106 USPQ2d 1163, 1166 (TTAB 2013) (clauses separated by a semicolon in registrant’s identification are discrete categories of services that stand alone and independently in likelihood-of-confusion analysis). Furthermore, unlike the subject Application, these services quoted above are not limited to a particular class of purchasers, and could encompass automotive dealers.

Nonetheless, the overlap of services and purchasers is insignificant. As the Federal Circuit has made clear, “our concern is directed primarily toward the likelihood of confusion among actual and potential purchasers. The essential inquiry in this appeal then is whether there is likely to be sufficient overlap of the respective purchasers of the parties’ goods and services to confuse actual and potential purchasers.” *Elec.*

Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992), *quoted in Palm Bay Imps.*, 73 USPQ2d at 1695.

Actual purchasers of Applicant's services are not likely to be confused. The automotive dealers who have, at length, negotiated and entered into contracts with Applicant to finance their development would have established long-term business-to-business relationships with Applicant, and would know their service provider quite well, thus negating a likelihood of confusion as to source.

Potential purchasers of Applicant's services are not likely to be confused, either, for several reasons. First, any overlap in purchasers—automotive dealers who have not dealt with Applicant and who might receive solicitations from Registrant—“would involve at most only a de minimis number of sophisticated purchasers. In other words, any overlap in customers is too small to be significant much less dispositive.” *Elec. Design & Sales*, 21 USPQ2d at 1392. Second, the services identified in Registrant's two registrations—such as “business research” or “financial advice and consultancy services”—are related to Applicant's services only in the sense that both are in the general field of finance. *See Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“the issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.”); *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983) (“The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is

insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.”). In other words, the services are generally related, but not substantially so.

Third, the class of automotive dealers who have not dealt with Applicant is likely to be aware of practices in the industry; and if such dealers desire to acquire financing to expand their real estate holdings, they are much more likely to seek the services of Applicant, a niche provider of services tailored to their particular needs, than Registrant. Thus, any overlap in purchasers would be mitigated by the care and sophistication of these purchasers, who are unlikely to hurriedly mistake one source of services for the other. *See Elec. Design & Sales*, 21 USPQ2d at 1392 (“Thus, it is evident that both [registrant’s] services and applicant’s goods are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source.”); *Sports Authority Mich., Inc. v. PC Auth., Inc.*, 63 USPQ2d 1782, 1794 (TTAB 2002) (“The other services each party provides ... would more uniformly require some degree of deliberation before purchase.”); *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) (“The goods and services would not likely be encountered by applicant’s customers and to the extent that they are encountered ..., this narrow group is believed to be sufficiently sophisticated such that confusion is unlikely.”).

In sum, the marks are not likely to be encountered by the same persons in circumstances that would create the incorrect assumption that they emanate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

For these reasons, the second, third, and fourth *DuPont* factors weigh against a likelihood of confusion.

C. The Extent of Potential Confusion

Even though Applicant's and Registrant's marks are similar, the difference in the nature of the goods and services, the channels of trade, and the classes of purchasers, as well as the high degree of care likely to be exercised by the relevant automotive dealer purchasers, supports the conclusion that there is no more than a theoretical possibility of confusion between the marks. *See In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (no likelihood of confusion despite identical marks).

Language by our primary reviewing court is helpful: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Elec. Design & Sales*, 21 USPQ2d at 1391 (quoting *Witco Chem. Co. v. Whitfield Chem. Co., Inc.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969)), *quoted in Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1478 (TTAB 2016), and *Primrose Ret. Comm., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1040 (TTAB 2016).

Thus, the twelfth *DuPont* factor, concerning the extent of potential confusion—de minimis or substantial—weighs against a finding of likelihood of confusion.

II. Conclusion

When we consider all of the arguments and evidence relating to the relevant likelihood of confusion factors, we conclude, on balance, that confusion is not likely

between Applicant's mark  and the cited registered marks. We find so principally because the similarity between the marks is outweighed by the distinct goods and services, channels of trade, classes of customers, and the sophistication and care that will be exercised by purchasers of Applicant's services, all of which render the likelihood of confusion de minimis.

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