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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

UBS AG
v.
United Bankers' Bank

Opposition No. 91168033
to application Serial No. 78524329
filed on November 30, 2004

Patrick J. Jennings, Kevin T. Kramer and Stephanie F.
Goeller of Pillsbury Winthrop Shaw Pittman LLP for UBS AG.

Andrea M. Bond and Michael M. Lafeber of Briggs and Morgan,
P.A. for United Bankers' Bank.

Before Holtzman, Kuhlke and Taylor, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, United Bankers' Bank, seeks registration of
the mark UBB in standard characters for services identified
in the application as:

Human resources advisory and management services
provided to banks; business management and
consulting services for banks, in International
Class 35;

Correspondent banking services, asset and liability management services provided to banks, securities brokerage services, investment portfolio advisory and management services, providing online information to community banks in the field of banking and finance, online banking services for community banks, in International Class 36.¹

The application also includes a claim of ownership of Registration Nos. 1789634 and 2721115.

Opposer, UBS AG, opposed registration of applicant's mark for the services in International Classes 35 and 36 on the ground that, as used in connection with applicant's services, the mark so resembles opposer's previously used and registered mark UBS in connection with banking and financial services, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

By its amended answer applicant admits that opposer "owns federal registrations incorporating 'UBS' [and that opposer is] the listed owner of Registration No. 1573828," denies the remaining salient allegations, and asserts the affirmative defense that the opposition "is precluded by the prior registration doctrine."

EVIDENTIARY ISSUES

¹ Serial No. 78524329, filed November 30, 2004. The application is based on allegations of first use and use in commerce on April 12, 1994 for the services in International Class 35 and March 27, 1991 for the services in International Class 36 under Section 1(a) of the Trademark Act, 15 U.S.C. §1151(a).

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As a preliminary matter, opposer filed a motion to strike portions of various discovery depositions submitted by applicant under its second and third notices of reliance, and portions of applicant's trial testimony provided by Cassie Orloske and Charles Hokans.

We first address the notices of reliances. By its motion, opposer seeks to strike excerpts from the discovery depositions of: William Gaine, opposer's executive director and senior vice president of the regional dealer desk; Markus Straessle, opposer's head of market development relationship management for Bank for Banks; Nadine Genet, opposer's head of global advertising; and Neil Gluckin, opposer's executive director. These depositions were taken by applicant and submitted under notice of reliance pursuant to Trademark Rule 2.120(j).

Each of the witnesses had been designated by opposer as a Fed. R. Civ. P. 30(b)(6) representative to testify as to specific topics. Opposer objects that certain excerpts from the Gaine, Straessle and Gluckin depositions exceed the scope of the specified 30(b)(6) topics and that these witnesses are not officers, directors or managing agents of opposer such that those portions that exceeded the scope of the 30(b)(6) designation could still be acceptable under

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Trademark Rule 2.120(j). Trademark Rule 2.120(j)(1)

provides:

The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party. (emphasis added)

We begin by noting that in general the Board is reluctant to surgically strike certain lines of testimony based on various objections. We find that each of these witnesses, at a minimum, fall within the meaning of "managing agent." Therefore, we will not strike the testimony that may exceed the scope of the 30(b)(6) designation. In view thereof, the motion to strike is denied. However, the Board has reviewed the testimony in conjunction with the objections and accorded it appropriate probative value (e.g., determining the level of competency a witness may or may not have for a given topic, or whether the questioning elicits a legal conclusion for which the witness is not competent to testify).

With regard to the discovery deposition excerpt of Ms. Genet, opposer argues that "the testimony should be stricken...because applicant failed to produce the documents regarding which it questioned the witness [and] because applicant had failed to produce the documents in advance of Ms. Genet's deposition, thus depriving Opposer the chance to

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educate its corporate designee on these documents, admission of this portion of Ms. Genet's testimony would be unfairly prejudicial to opposer." Br. Appx. pp. 7-8. As opposer notes, this line of questioning was the subject of a discovery dispute that was resolved in a Board order which granted opposer's motion to compel production of the subject documents and applicant's motion to compel Ms. Genet to answer questions about these documents. Ultimately, the parties agreed to a substituted witness for these questions. The order did not strike the deposition. The testimony is of little probative value and the Board will not draw an adverse inference for failure to answer, thus there is no prejudice to opposer and the Board denies the motion to strike these excerpts.

Opposer's request that we strike certain trial testimony of Ms. Orloske and Mr. Hokans concerning third-party marks is denied. Opposer argues that certain website printouts had not been produced during discovery stating "[j]ust because applicant previously identified the third-party mark or produced an earlier version of its website or a third-party's website does not justify this unfair tactic, [s]ince companies often change the content on their websites, the nature in which the mark was used may have changed since the earlier produced document." Br. Appx. p. 8. Opposer is correct that websites are ephemeral in nature

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and subject to change and for this very reason they are limited in their probative value. However, these third-parties had been disclosed to opposer during discovery and there is no unfair surprise in the testimony whereby the witness, during testimony pulled up the website on the computer and testified as to what was on it at that point in time. The issue is the probative value of such testimony which is very limited. Opposer's remaining objections to the probative value of the witnesses' testimony have been taken into consideration in the evaluation of the testimony.

Applicant also asserted various objections. First, applicant objects to opposer's reliance on a prior opinion in another case involving opposer. While each case must be decided on its own merits, an opposer may cite to a non-precedential opinion in making its argument. In view thereof this objection is overruled.

Applicant also objects to testimony and exhibits related to various industry brand equity reports or "surveys" on the basis of foundation and hearsay. This evidence is in the category of printed publications as it was created and published by general circulation or industry publications and it is therefore self-authenticating, although Ms. Genet also is competent to authenticate and lay an adequate foundation for the documents. Furthermore as to the hearsay objection, we regard these and similar

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publications as being submitted to show that the content of the publications appeared before the public and that they are the ranking of global brands over several years. As noted by applicant certain rankings are not broken down for the United States and only show "global" ranking and there is no information as to how the ranking is derived. While these publications do add to the weight of the evidence in support of opposer's assertion that the mark is well known they are limited in their probative value. We note that the Interbrand rankings or "surveys" published in Business Week are often cited in cases before the Board, in particular by brand managers. At a minimum these rankings serve to show that the content of the publication appeared before the public, and depending on the accompanying testimony, that a brand manager may have relied on the information to better understand their brand strength. This objection is overruled.

Finally, applicant objects on the grounds of foundation and hearsay to an exhibit opposer attempted to introduce during cross examination of applicant's witness. The exhibit is apparently an email allegedly received by opposer's client and forwarded to opposer. Applicant's witness is clearly not competent to lay the foundation or authenticate an email received by opposer's client and

forwarded to opposer. Applicant's objection is sustained on the basis of lack of foundation and authentication.²

EVIDENCE OF RECORD

The evidence of record consists of the pleadings herein; the file of the opposed application; opposer's status and title copy of its Registration No. 1573828 for the mark UBS, attached to its pleading; opposer's notices of reliance on printed publications; various exhibits filed under stipulation; opposer's testimony depositions, with exhibits, of Nadine Genet, opposer's head of global advertising, and Markus Straessle, opposer's head of market development relationship management for Bank for Banks; applicant's testimony depositions, with exhibits, of Charles Hokans, applicant's senior vice president, and Cassie Orloske, applicant's marketing officer; applicant's notices of reliance on applicant's prior registrations, third-party registrations, and excerpts from the discovery depositions of Neil Gluckin, Markus Straessle, William Gaine, and Nadine Genet; and opposer's rebuttal notice of reliance on the discovery depositions of Mark Straessle, Nadine Genet and William Gaine.

PRIORITY/STANDING

Because opposer has made its pleaded registration of record and has shown that the registration is valid and

² We hasten to add the email is of virtually no probative value.

subsisting and owned by opposer, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the question of likelihood of confusion.

LIKELIHOOD OF CONFUSION

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

Opposer's pleaded registration is for the mark UBS in typed form. This registration issued on December 26, 1989 for services identified as "banking, investment banking, and securities brokerage services" in International Class 36. Opposer presented evidence and argument on the factors of the similarity of the marks, the relatedness of the services, channels of trade, classes of purchasers and the fame or strength of its mark.

We begin with the factor of fame because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d

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1894, 1897 (Fed. Cir. 2000). “[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Opposer has expended significant sums³ on a broad-based advertising program in a variety of media, including, print, television, radio, Internet and billboards at major airports. See generally, Genet Test. For example, opposer advertises its financial services in newspapers with a wide circulation, including the New York Times, the Wall Street Journal and the Boston Globe. Genet Test. pp. 13-15, Exh. Nos. 71, 73, 76-77. During prime time television, it runs its advertising on a regular basis on such channels as CNN and CNBC, and programming such as “Meet the Press” and “ABC College Basketball.” In addition, opposer uses its UBS mark in connection with a variety of highly visible sponsorships. For example, opposer sponsors the Players Championship, a PGA golf championship, Lincoln Center in New York City, the San Francisco Museum of Modern Art, the Boston Symphony Orchestra, and the Bay Invitational, a PGA tournament held in Florida. Genet Test. pp. 20, 21, 22, 57, 60 Exh. Nos.

³ The exact figures were submitted under seal.

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65, 67. While the record evidence does not show a level of consumer exposure and recognition to warrant a finding of fame, it does establish UBS as a strong mark which should be accorded a wider scope of protection. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) ("Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it"); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

Applicant's evidence of third-party use of similar marks is not sufficient to rebut this showing. Applicant points to eleven third-party letter marks in the financial industry that incorporate the letters U, B and/or S. However, while as the record indicates it may be common for banks and other financial institutions to utilize certain letters like B to stand for the word bank or U to stand for commonly used terms United or Union, the evidentiary showing here is not sufficient to rebut opposer's evidence of a well advertised and heavily used mark. See *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996). There is very limited evidence as to the extent of use of these other letter marks on which to make any determination as to their

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dilutive impact. In that regard we advise applicant that registrations are not evidence of use and have little probative value as to this du Pont factor. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973).

In addition, several of the examples have distinct characteristics that lessen their dilutive impact. For example, applicant points to the Royal Bank of Scotland's use and registration of the standard character mark RBS and Vanguard Group, Inc.'s use and registration of VBS. The fact that these marks begin with a different letter creates a different impact.

Further, applicant's argument that "common usage in an industry of the words underlying an abbreviation weakens [a] mark's relative strength and limits its scope of protection," is misplaced. Br. p. 19. Applicant relies on a 1972 case from the Seventh Circuit, however, the Board and its primary reviewing court the Court of Appeals for the Federal Circuit and its predecessor the Court of Customs and Patent Appeals, have long held that initials are not descriptive unless the initials themselves are recognized as synonymous with the descriptive words.

Our case law provides that an acronym or initialism is deemed to be merely descriptive of goods or services only if the wording it stands for is merely descriptive of the goods

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or services, and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents or stands for. See, e.g., *Modern Optics, Inc. v. The Univis Lens Co.*, 43 CCPA 970, 234 F.2d 504, 110 USPQ 293 (CCPA 1956) ("CV" not substantially synonymous with merely descriptive designation "continuous vision" and thus is not merely descriptive of trifocal lenses). "[A]s a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith." *Modern Optics* 110 USPQ at 295.

While a term may be the abbreviation of a full name, "it does not follow, however, that all initials or combinations of descriptive words are ipso facto unregistrable." *Id.* See also *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1836 (TTAB 1995) (the term PCA not merely descriptive even though the applicant "uses the term 'PCA' as an acronym for an organization which is presently known as the Professional Cleaners Association.") Applicant has not made such an evidentiary showing and opposer has shown its prominent use of the mark UBS without any association to descriptive wording or the former name Union Bank of Switzerland for several years now.

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We next turn to consider the marks. With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result.

We begin by noting that letter marks are more susceptible to confusion because letter combinations are likely to be inherently difficult to remember. *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1509 (TTAB 2007) citing *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) and *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990). This is true even when the prospective purchasers of the services are sophisticated purchasers. *Id.* Further, the first two letters of applicant's three-letter mark UBB are identical to the first two letters of opposer's three-letter mark UBS. *Hercules Inc. v. National Starch & Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) ("considering the marks NATROL and NATROSOL in their

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entireties, the clearly dominant aspect of both marks is that the first four letters and the final two are the same."). See also *Palm Bay Imports*, 73 USPQ2d at 1689; *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("there are also similarities between them in that both start with the term 'KID' a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). In addition, the last letters B and S have a somewhat similar appearance. Thus, the marks are very similar in sound and appearance. Moreover, both are standard character marks without any stylization or design elements that would impact the overall commercial impressions of the marks and we find the overall commercial impression to be similar.

With regard to connotation, we are not persuaded by opposer's argument that both marks on their own, or even when used in connection with the services, would connote the meaning "bank for banks." However, due to the points of similarities in sound, appearance and commercial impression, we find they outweigh the one dissimilarity of the last letter. Finally, as discussed below, at least some of applicant's identified services are identical to opposer's identified services and "when marks would appear on virtually identical goods or services, the degree of

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similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 32 USPQ2d 1698 (Fed. Cir. 1992).

This brings us then to our consideration of the similarities between opposer's and applicant's services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the services as they are recited in the application and registration, respectively. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

Applicant's services in International Class 36 are listed as "correspondent banking services, asset and liability management services provided to banks, securities brokerage services, investment portfolio advisory and management services, providing online information to community banks in the field of banking and finance, online

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banking services for community banks." Registrant's services are identified as "banking, investment banking, and securities brokerage services." The parties respective "securities brokerage services" are identical and opposer's "banking and investment banking" encompass applicant's "correspondent banking services, investment portfolio advisory and management services and online banking services for community banks." Finally, applicant's asset and liability management services provided to banks are closely related to opposer's "investment banking and securities brokerage" services.

Moreover, in view of the identical and close relationship of these services we must presume that they travel in the same channels of trade and are offered to some of the same purchasers. In fact, applicant receives securities brokerage services from opposer. Hokans Test. pp. 73-77 Exh. No. 93.

Applicant's arguments centered on the differences between its and opposer's actual services and channels of trade ignore well established case law requiring that the comparison of the services is based on how the identifications read in the involved application and opposer's registration. The identification of services in the pleaded registration is not limited by trade channel or classes of purchasers and, therefore, we must consider all

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possible, not actual, ordinary channels of trade and classes of purchasers. Further, while some of applicant's services are limited by purchaser (community banks) others are not so limited (e.g., securities brokerage services), and in any event registrant's broadly identified services encompass these purchasers.

Applicant's identification of services in International Class 35 are "human resources advisory and management services provided to banks; business management and consulting services for banks." Applicant's human advisory services are described through testimony as follows:

USOURCE is our comprehensive human resource consulting services which are designed to serve as an outsourced human resource department for community banks. Purpose being that few of our customers could afford to keep up to speed with the complexity of federal and state law changes in regard to employment and we offered those services, as well as helping them really manage their employees to the best of their ability, in essence, offering salaried administration services, offering the ability to structure job descriptions, develop salary ranges, providing a hotline service to community banks; if they had a matter, that was uncomfortable for them to deal with they had somebody to talk to who would work through that with them to determine proper direction strategy in which to take.

Hokans Test. pp. 30-31.

It would include - yes. It would include personnel management services, but in what I would describe strictly an advisory capacity. We don't direct the human resources in that particular bank. That's their responsibility, but we will advise on how they might be directed.

Hokans Test. p. 70.

The business management services include "consultant services, which I would include a credit card product that we offer to community banks. We have our BankValue services which essentially consists of strategic option analysis, stock valuations and market studies." Hokans Test. p. 21, Exh. 5 (excerpt from 1992 Annual Report "UBB's strategic planning service is designed to maximize the value of a banking franchise through the design of income enhancement techniques and market development strategies").

Opposer argues that these services are related to its banking services and has submitted several use-based third-party registrations to support this proposition.⁴ Albert Trostel, 29 USPQ2d at 1786 (third-party registrations may serve to suggest that the listed services are of a type which may emanate from a single source). See, e.g., Reg. No. 3314410 for the mark FIDELITY TOTAL HR ADVANTAGE for, inter alia, "business management services in the field of human resources; business consultation and analysis services in the field of human resources" and "investment management services; securities brokerage services"; Reg. No. 3325818 for the mark WIN and design for, inter alia, "providing advisory services and consultancy with regard to business

⁴ We note that several of the third-party registrations are of little probative value inasmuch as they were registered under Section 44 or 66(a), i.e., not based on use in commerce. Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

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planning, business analysis, business management, and business organization" and "serving as a human resources department for others" and "providing shared financial and insurance services to members of the wholesaling community, namely, assisting others in obtaining loans; providing working bank line capital"; Reg. No. 3004905 for a design mark for, inter alia, "business management; professional business consultancy" and "stock brokerage services; savings and loan association services and banking services"; Reg. No. 2710428 for INLEAGUE for, inter alia, "business management and business consultation in the field of human resources" and "banking services"; Reg. No. 2606575 for FINETRICS for, inter alia, "business management, planning and consultation" and "banking"; Reg. No. 2656261 for PLYMOUTH SAVINGS BANK for, inter alia, "administration of business payroll for others" and "banking, investment brokerage"; Reg. No. 3318058 for NEWTEK for, inter alia, "business consultation" "business management planning" "business planning" "business management consultation and management consultation services; consulting services in the field of business management, management, and human resources" and "online financial and banking services" and "business brokerage"; and Reg. No. 3086799 for INVESTING IN THE ENTREPRENEURIAL ECONOMY for, inter alia, "business

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management and consultation in the fields of corporate finance, merger and acquisition, executive recruitment and human resources, and marketing strategic planning" and "investment advisor services" and "investment fund management and investment of funds for others."

We find, at a minimum, applicant's business management and consulting services for banks to be sufficiently related to opposer's banking, investment banking and securities brokerage services such that confusion as to source is likely. These services, as identified, include the same potential consumers, namely, banks. In addition, potential consumers have been exposed to business management services and banking services being offered under the same mark, as is evidenced by the third-party registrations and applicant itself. We also note that at least some of applicant's business management services address the financial health of the client bank, bringing it closer to opposer's investment banking and securities brokerage services. To establish this du Pont factor, i.e., that the services are related, it is sufficient that any item encompassed by the identifications of services is identical or related. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Again, inasmuch as registrant's services are not limited we must presume that they include the same trade

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channels and purchasers as applicant's banks. Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom, 16 USPQ2d at 1783.

Applicant argues that the involved services are "rather high end financial services intended for professional buyers...in the banking industry who will not be confused as to any relationship between the parties." Br p. 24.

Opposer responds that the services in the application are not so limited and include "any member of the general public." Further, opposer relies on In re Decombe, 9 USPQ2d 1812 (TTAB 1988) arguing that even sophisticated buyers are not immune from confusion. Reply Br. p. 13. First, while certain of applicant's services are unlimited (e.g., securities brokerage services), others are limited by class of customer, either explicitly (e.g., business management and consultation for banks) or implicitly (e.g., correspondent banking services implies banks as customers). Therefore, the overlap in class of customers for the services overall, as identified, include the general public in addition to all banks and in some cases specifically community banks. Thus, as to the general public, while these are not impulse transactions, the sophistication of the consumer is not very high. With regard to the professional banking consumers, while we may infer a higher level of scrutiny in the their purchasing, there is not

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sufficient evidence of record upon which to make a determination that this factor would outweigh the other du Pont factors. In view thereof, we find this factor to be neutral.

As to applicant's argument that there is no evidence of actual confusion between opposer's mark and applicant's mark, there is not sufficient testimony on this point from which to draw any conclusions. While applicant has offered its services under the mark UBB since 1991 its actual use has been limited to smaller banks and, while opposer's registration is not limited by classes of purchasers and a few of its customers have been smaller banks, it is not clear from the record the extent to which actual market overlap has occurred up to this point. In addition, based on the record applicant primarily uses UBB next to its full name United Banker's Bank which may serve to obviate potential confusion. Therefore, based on this record we do not accord this factor much weight.

Finally, opposer argues that applicant's knowledge of opposer's UBS mark "should raise a presumption that Applicant intends to cause confusion in the marketplace with the UBB mark" and, in addition, progressive encroachment is considered as evidence of a planned or contrived intent to deceive. Opposer points to applicant's prior registrations to show such "progressive encroachment" noting that the

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first one includes a design element with the full name of the company, the second one includes only the descriptive word SECURITIES with the design element and now applicant seeks a standard character mark without additional wording. Opposer adds that the timing of these changes in registration occur in conjunction with the development of applicant's business relationship with opposer. Intent is a difficult element to prove and this highly circumstantial evidence is insufficient from which to draw an inference of intent to confuse.

On balance, the relevant du Pont factors weigh in favor of a likelihood of confusion. In view of the strength of opposer's mark, the similarity of the marks, the identical and related nature of the services as identified in the application and registration, and the overlap in the channels of trade and classes of customers, we conclude that there is a likelihood of confusion between applicant's standard character mark UBB and opposer's typed mark UBS. To the extent there is any doubt, we must resolve that doubt in favor of opposer as the prior user and registrant. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

PRIOR REGISTRATION DEFENSE

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Applicant asserts as an affirmative defense that its "prior registrations are legally equivalent and cover the same services as the mark Opposer now opposes," therefore, "the Morehouse or prior registration defense bars Opposer's claims." Br. pp. 26-27. Applicant's prior registrations are set forth below:

Registration No. 1789634 for the mark



UNITED BANKERS' BANK

for "banking services for community banks and bankers" in International Class 36; and

Registration No. 2721115 for the mark



Securities

For "securities brokerage services" in International Class 36.

The Morehouse defense is an equitable doctrine which is applied when an applicant owns a prior registration for essentially the same mark identifying essentially the same goods or services that are the subject mark and goods of the proposed application. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). In such a case, "the opposer cannot be further injured because there already exists an injurious registration," and therefore the additional registration does not add to the injury. *O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (Olympic and Olympic Kids not

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essentially the same). "Ultimately, we must determine if the marks at issue here are 'essentially the same' mark." *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd*, 86 USPQ2d 1283 (TTAB 2008) *quoting* *Morehouse*, 181 USPQ at 717.

Regardless of whether the services in the prior registrations are essentially the same International Class 36 services listed in the application, the marks in applicant's prior registrations are not "essentially the same" as the standard character mark in the subject application. The addition of the logo design in the prior registrations is sufficiently distinct such that these marks are not essentially the same for purposes of the *Morehouse* defense. In addition, the mark in Registration No. 1789634 includes the wording United Bankers' Bank associating the abbreviation UBB with the full name of the company, substantially affecting its connotation and commercial impression. Therefore, application of the *Morehouse* defense is not appropriate in this case.

Applicant's argument that the marks cannot simultaneously be sufficiently dissimilar to prohibit application of the *Morehouse* defense but sufficiently similar to create a likelihood of confusion, is misplaced. In fact, the standard for similarity is different for these separate purposes. The standard of similarity for

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application of the Morehouse defense is more strict. The marks must be "substantially" or "essentially" the same. Put another way "[w]hether marks are 'different' is a less stringent criterion than whether the marks are likely to cause confusion." O-M Bread, 36 USPQ2d at 1045.

Further, the cases upon which applicant relies are distinguishable by their facts. In Place for Vision, Inc. v. Pearle Vision Ctr., Inc., 218 USPQ 1022 (TTAB 1983), applicant applied for the mark PEARLE VISION CENTER and design and had previously registered the mark VISION CENTER for essentially the same services. The Board applied the Morehouse defense stating that "opposer's claim of damage relates only to the VISION CENTER portion of applicant's mark and not to the PEARLE and design portions of the mark." Place for Vision, 218 USPQ at 1023. The facts of that case are the reverse of those before us, inasmuch as the mark in the application had additional matter whereas here it is the marks in the registration that contain additional matter and the mark in the application is only the typed mark with all other matter stripped away. In National Bakers Services, Inc. v. Hain Pure Food Co., Inc., 207 USPQ 701 (TTAB 1980), the Board found applicant's prior registered mark HOLLYWOOD HEALTH FOODS to be "in essence the legal equivalent of [HOLLYWOOD]." The prior registration in that case did not include a design element.

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In view of the above, the opposer has proven its claim of likelihood of confusion under Section 2(d) of the Trademark Act.

Decision: The opposition is sustained, and registration to applicant in Classes 35 and 36 is refused.