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

Proceeding	92045081
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Money Corp.)	Petitioner
v.		
TTT Moneycorp Limited)	Registrant

Registrant's Brief on the Merits

Cancellation No. 92045081

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Registrant's Brief on the Merits

Money Corp. ("Petitioner") has petitioned to cancel registrations No. 2,463,593, No. 2,399,042 and No. 2,396,878 (the "Registrations") owned by TTT Money Corp Limited ("Registrant") for the marks MONEYCORP and TTT MONEYCORP, respectively (the "Marks"), covering "issuing travellers' cheques; commodity brokerage services; banking services and foreign currency services" ("Registrant's Services"). As its basis for the cancellation petition, Petitioner alleges a likelihood of confusion between Petitioner's mark MONEY CORP. ("Petitioner's Mark") and Registrant's Marks. For all of the following reasons, Registrant submits that confusion between Registrant's Marks and Petitioner's Marks is not likely to occur.

I. Procedural Background.

Each of Registrant's trademark registrations was issued under Section 44(e) of the Lanham Act – that is, on the basis of foreign registrations and without a showing or claim of use of the mark in U.S. commerce. 15 U.S.C. § 1126. During the course of this cancellation proceeding, registration number 2,463,593 (relating to a variety of print matter)¹ expired in

¹ MONEYCORP. Reg. No. 2463593. Class 16: printed matter, namely, maps; books and newspapers, all relating to foreign exchange, currency and related financial matters; printed periodical publications, namely, magazines, newsletters, all relating to foreign exchange, currency and related financial matters; unmounted photographs; stationery; writing instruments; traveler's checks; playing cards, greeting cards, note cards; flip charts, printed charts and score charts; blank paper tapes and cards for the recording of computer programs and data; diagrams for foreign exchange and currency information; drawing pads; envelopes; document cards and paper files; paper flags; file folders for papers, graphic art prints; graphic art reproductions; note books; writing pads; writing paper, carbon paper, computer and craft paper and packaging paper; paper for recording machines; pictures; printed

its entirety due to Registrant's decision not to file required maintenance documents, 15 U.S.C. § 1058(a)(1). Registrations no. 2,396,878 and 2,399,042, both covering "issuing travellers' cheques; commodity brokerage services; banking services and foreign currency services" were also partially cancelled for all services other than foreign currency services at Registrant's request, in connection with filing the necessary maintenance documents. In the course of this proceeding, Registrant has filed timely Section 8 affidavits and Section 8 & 9 renewal documents for each surviving trademark registration. Judgment was entered against all deleted products and services by the Trademark Trial and Appeal Board on abandonment grounds, and Petitioner has continued to pursue cancellation of each registration on the additional ground of likelihood of confusion. See Docket # 17, 22.

II. Summary of the Evidence

The evidence consists of the Petition for Cancellation, Registrant's Answer, file wrappers for the Registrations, a Notice of Reliance² filed by Registrant, a Confidential Notice of Reliance filed by Registrant, and a Notice of Reliance filed by Petitioner.

Specifically, the following are of record:

- Registrant's Interrogatories, Requests for Admission, and Requests for Production, and Petitioner's responses to each (Docket # 31, tabs 1-3);

signs of paper and cardboard; paper place mats; printed plans; postcards; posters; printed signboards of paper and cardboard; printed instructional, educational and teaching materials in the area of foreign exchange, currency and related financial matters; printed tickets; paper control tokens for foreign exchange, currency and related financial matters; writing and drawing books.

² The parties stipulated broadly to the admissibility of certain types of evidence. Docket Entry # 25.

- Petitioner's Interrogatories and Requests for Production and Registrant's Responses thereto (Docket # 26, tabs 17 – 22).
- Declaration of Matthew Cook, Solicitor for Registrant (Docket # 32, tab 4) ("Cook Decl.");
- Deposition of Gary Young (Docket # 32, tab 5, and Docket # 26, tab 1) ("Young Dep.");
- Dictionary definitions of "financial," "financial services," "money," and "corp" (Docket # 31, tabs 6-8);
- Evidence of the lack of overlap between the parties' services (Docket # 31, tab 9);
- Evidence of dilution of MONEY and CORP (Docket # 31, tabs 10-17); and
- Excerpts from Respondent's 2008 Annual Report and website Docket # 31, tabs 18-19).

III. Petitioner bears the burden of showing rights in the mark that it claims, and that the Registrations should be cancelled.

Petitioner filed for cancellation prior to the fifth year from the registration date of each Registration. While the cancellation petition was timely filed, Registrant's registered trademarks are presumed to be valid. 15 U.S.C. § 1057(b) (registration is *prima facie* evidence "of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate"). As a result, the burden of persuasion in a cancellation proceeding rests on the

party seeking to cancel the registration. Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989). A party seeking to cancel a registration must overcome the presumption of validity accorded by virtue of the registration by a preponderance of the evidence. See, e.g., W. Fla. Seafood v. Jet Rests., 31 U.S.P.Q.2d 1660 (Fed. Cir. 1994).

IV. The evidence shows that there is no likelihood of confusion: there is no evidence of overlap in the parties' services, channels of trade, or sophisticated consumer bases, nor evidence of any actual confusion.

In determining whether there is a likelihood of confusion between two marks, the Federal Circuit considers a number of factors, when relevant on the facts of the case. In re E. I. Du Pont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973).³ The following factors are most relevant here: 1) the strength (weakness) of the prior mark, 2) the similarity or dissimilarity of the parties' marks, 3) the similarity or dissimilarity of the services of each party, 4) the similarity or dissimilarity of established, likely-to-continue trade channels and 5) purchaser sophistication.

A. Petitioner's Mark is weak and entitled only to a narrow scope of protection.

A cancellation petitioner alleging prior rights in a common-law mark bears the burden of showing, though a preponderance of the evidence, that its mark is inherently distinctive or

³ Petitioner's claims that the du Pont factors have been "more narrowly described" in the case law of the 11th Circuit or the 8th Circuit (Docket # 33 p. 10) appears to be inaccurate. More importantly, that claim is not relevant to the Board's consideration of the current cancellation proceeding, as the law of those circuits, and the cases cited, do not bind the Trademark Trial and Appeal Board.

that it has acquired distinctiveness. See, e.g., Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc., 89 U.S.P.Q.2d 1844, 1854 (T.T.A.B. 2008).

A "strong" mark is either inherently distinctive or has acquired distinctiveness through wide recognition, and is strongly protected. A "weak" mark, by contrast, is granted a more limited scope of protection. See, e.g., In re Central Soya Company, Inc., 220 U.S.P.Q. 914 (T.T.A.B. 1984). In such a case, a finding of confusion is typically limited to identical or highly similar marks with identical or closely related goods or services. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400 (C.C.P.A. 1974).

The strength or weakness of a mark may be demonstrated by evidence, including dictionary definitions that show the commonly understood meaning of the terms. See, e.g., Hancock v. American Steel & Wire Co., 203 F.2d 737 (C.C.P.A. 1953) (dictionary definitions relevant to determining meaning of a mark). A combination of two weak terms (absent some unusual or incongruous meaning) results in a mark which is itself weak, and entitled only to a limited scope of protection. See, e.g., Local Trademarks, Inc. v. Handy Boys Inc., 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) ("Little Plumber" mark "cannot be considered a strong mark" in the plumbing field).

Petitioner's Mark is a combination of the terms: "money" and "corp." "Money" is defined as "something generally accepted as a medium of exchange, a measure of value, or a means of payment." See the excerpt from Merriam-Webster's On-Line Dictionary, Docket # 31, tab 8. The term "money" relates immediately to an important aspect of Petitioner's business, in that money is a significant focus for Petitioner's customers (financial services providers). Further, the term "corp." is an abbreviation for "corporation" see id., which is an entity designator devoid of any trademark significance. See, e.g., In re Taylor & Francis

[Publishers] Inc., 55 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2000) ("PRESS," as applied to a printing or publishing establishment, "is in the nature of a generic entity designation which is incapable of serving a source-indicating function"); T.M.E.P. § 1213.03(d). Petitioner's Mark, resulting from a combination of these terms, suggests that Petitioner is an entity providing services that are of interest to customers in the financial field.

Third party registrations are relevant to show the weakness of a term. H.D. Lee Co. v. Maidenform Inc., 87 U.S.P.Q.2d 1715 (T.T.A.B. 2008) (third-party registrations were highly probative to "explain the meaning of the word 'fit' in connection with clothing and to show that opposer's mark ONE TRUE FIT is a weak mark"; the Board found that mark was "highly suggestive" and weak.) As noted below, Registrant has provided ample evidence that both MONEY and CORP are highly diluted and weak terms in connection with office administration, accounting, marketing and related back-office services (Petitioner's Services).

- 124 live registrations co-exist on the federal registry using the term "corp" as part of the mark, including for administrative services similar to Petitioner's services. See Docket #32, tab 10 (pages 58 - 85).
- 83 live trademark registrations disclaim exclusive rights in "corp" in Class 35, including for administrative services similar to Petitioner's services. See Docket #32, tab 11 (pages 86 - 113).⁴
- 242 live registrations co-exist on the federal registry using the term "money" as part of the mark, including for administrative services similar to Petitioner's services. See Docket #32, tab 14 (pages 168 - 196).

⁴ The presence of a disclaimer is an admission that the term is descriptive or generic as applied to the services for which the mark is registered. See T.M.E.P. § 1201.03 and cases cited therein.

- 30 live trademark registrations disclaim exclusive rights in "money" in Class 35, including for administrative services similar to Petitioner's services. See Docket #32, tab 15 (pages 198 - 223).

Since Petitioner's Mark merely combines two terms that are weak, diluted, and arguably descriptive or generic as applied to Petitioner's services, without creating an unusual or incongruous combined meaning, Petitioner's Mark as a whole must be considered inherently weak. See Local Trademarks, Inc. v. Handy Boys Inc., supra.

Finally, Petitioner's own testimony confirms that its business is quite small: its annual gross receipts from 1996-2004 (the only years for which information was provided) average less than \$157,000 per year, and the largest year (1999) was roughly \$210,000. Docket #26, tab 11 (Ex. 10 to the Young Dep). Petitioner also testified that it spends "de minimus" (less than \$5,000 annually) amounts promoting its mark. Petitioner's Answer to Interrogatory 12, Docket # 31, tab 2). Further, Petitioner conducts its business only in Iowa and in contiguous states (Wisconsin, Illinois, Missouri, Nebraska, South Dakota and Minnesota). Young Dep., Docket #26, tab 1, pp. 51-52. Such limited geographic use and such small levels of sales and promotion provide additional evidence of the weakness of (and corresponding limited scope of protection for) Petitioner's mark. See, e.g., Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 U.S.P.Q.2d 1917 (T.T.A.B. 2006) (unsubstantiated claims of sales in the "mid or upper mid six figures" in one year, with very little evidence of advertising those services, fall "far short of establishing that [opposer's marks] have achieved any degree of strength and recognition in the consumer market" or that they were "entitled to a broad scope of protection."); Boo, Inc. v. Boo.com Group Limited, 62 U.S.P.Q.2d 1603 (D.Minn. 2002) ("Plaintiff's limited geographic identity is evidence that

Plaintiff's mark is not strong"). The self-serving declaration of Petitioner's principal, Gary Young (misleadingly described as a "representative customer" of Petitioner) that he has come to understand his own company's name to refer to "a meaning ... that is not represented by" the terms "Money" and "Corp"⁵ does nothing to counteract the overwhelming evidence that Petitioner's mark is commercially very weak.

Because Petitioner's Mark is composed of two common terms which have direct application to Petitioner's customer base, and Petitioner's sales, marketing and geographic scope are very modest, Petitioner's Mark is entitled to only a narrow scope of protection against directly competitive or substantially similar uses. See Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 U.S.P.Q.2d 1477 (T.T.A.B. 1987); In re Hunke & Jochheim, 185 U.S.P.Q. 188, 189 (T.T.A.B. 1975). As detailed below, the parties' services are simply not competitive or substantially similar.

B. Comparison of the Parties' Marks.

Registrant acknowledges that its mark MONEYCORP and Petitioner's Mark are similar, containing the same terms and differing only regarding the addition of a space between the terms MONEY and CORP in Petitioner's Mark. However, even identical marks may coexist as long as the goods or services in question are sufficiently different to avoid a likelihood of confusion. See, e.g., In re British Bulldog, Ltd., 224 U.S.P.Q. 854 (T.T.A.B. 1984) ('PLAYERS for shoes not confusingly similar to PLAYERS for men's underwear).

Further, Registrant's Mark TTT MONEYCORP contains the additional component

⁵ Petitioner's Brief, Docket Entry # 22, p. 12.

TTT. It " is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." Barbara's Bakery Inc. v. Landesman, 82 U.S.P.Q.2d 1283 (T.T.A.B. 2007) (arbitrary term BARB'S is the dominant portion of BARB'S BUNS BAKERY, INC., since other terms were descriptive or generic). The letter string TTT is entirely arbitrary, having no inherent connection to Registrant's Services, and thus must be considered the dominant portion of the mark TTT MONEYCORP.

C. Comparison of the Parties' Services.

A trademark is not a right in gross; if the goods or services of the two parties to a trademark dispute are not related, there can be no likelihood of confusion. University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983); Sheller-Globe Corp. v. Scott Paper Co., 204 U.S.P.Q. 329 (T.T.A.B. 1979). In order to be "related," a reasonably prudent consumer must believe that goods or services are competitive or, if non-competitive, "derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner." In re Save Venice New York, Inc., 259 F.3d 1346, 59 U.S.P.Q.2d 1778 (Fed. Cir. 2001). The burden of demonstrating such a relationship "clearly rests on [challenging party]." Swingline, Inc. v. Ardco, Inc., 215 U.S.P.Q. 436 (T.T.A.B. 1982).

Petitioner repeatedly tries to blur three key facts to make it appear that the parties' services are in some way related. They are not.

First, Petitioner blurs time. From approximately 1990 to 2000, Young Dep., Docket

#26, tab 1, at p. 37. Petitioner provided insurance brokerage services under its MONEYCORP mark. From 2000 to the present, Petitioner has not provided insurance brokerage services, and has instead provided solely back-office administrative support services such as accounting, clerical, marketing support, and office management – to insurance agents. Young Dep., Docket #31, tab 5, at p. 38; Docket #31, tab 5, at p. 31. Only the administrative services have been in continuous use since prior to Registrant's filing dates, and only those services are relevant to the proceeding.

Second, Petitioner repeatedly attempts to blur the scope of its services by referring to them as "financial services" or "insurance-related." This is simply not supported by the evidence, which shows that at most Petitioner provides administrative support services to insurance agents, and that it does not provide (and has not provided since 2000) *any* financial services to any consumers. See discussion supra and infra. The fact that Petitioner's clients may provide financial or insurance services does not transform Petitioner's administrative services into financial or insurance services ""; if this logic held, every janitor who cleaned a dentist's office in the morning, a school at midday, and a casino in the evening would be a provider of "dental-related" services, "education-related" services, and "gambling-related" services – all in the same day. Neither the evidence, the law, nor common sense support this novel interpretation.

Third, Petitioner tries to blur the personal activities of its principal, Gary Young, with the activities of Petitioner. Mr. Young claims to offer insurance services through other companies in his personal capacity, but does not offer any insurance services or other financial services through Petitioner or under Petitioner's mark. Young Dep., Docket #31, tab 5, at p. 38.

(i) The Parties' services are not identical. The services of the parties are clearly not identical. Registrant's Services are purely financial services: "issuing travellers' cheques; commodity brokerage services; banking services and foreign currency services." By contrast, Petitioner provides administrative services to insurance agents and financial professionals, namely "Accounting, Clerical, Equipment, Marketing Support, Office Equipment, Office Management, Office Space, [and] Training Systems" (collectively, "Petitioner's Services"). See Young Dep., Docket #31, tab 5, p. 14 l. 15; Docket #26, tab 1, p. 43 l. 21 – p. 44 l. 2.

Registrant also registered its mark for a variety of printed products, like travellers' checks. Petitioner notes in passing that its work product is sometimes provided on paper, but provides no evidence that consumers would view providers of administrative services like Petitioner's as the source of printed products bearing Registrant's mark. Petitioner has failed to present any evidence that meets its burden.

(ii) The Parties' services are not competitive. Both parties agree that the following financial services are not competitive with the services offered by Petitioner: travelers checks,⁶ commodity brokerage services,⁷ banking services,⁸ and currency exchange

⁶ Petitioner noted that it *could* provide training or marketing support to assist insurance agents in using travelers checks, although it *has not*. Young Dep., p. 54 l. 7-22. See also Declaration of M. Cook, Docket Entry # 31, tab 4, ¶ 10 - 12.

⁷ Young Dep., Docket Entry #32, tab 5, p. 55 l. 10-19; Declaration of M. Cook, Docket Entry # 31, tab 4, ¶ 10 - 12.

⁸ Young Dep., Docket Entry #32, tab 5, p. 56 l. 11-19; Declaration of M. Cook, Docket Entry # 31, tab 4, ¶ 10 - 12.

services⁹. Petitioner does not provide *any* financial services,¹⁰ Young Dep., Docket # 31, tab 5, p. 6 l. 10-15, 17-20, p.7 l.7, 14, p. 37-38, and does not provide any products or services to anyone other than financial service professionals. Young Dep., Docket # 26, tab 1, p. 45 l. 9-17. Likewise, Registrant's Services do not include *any* administrative services.

Petitioner's competitors are other entities that can provide support services to financial service professionals, such as traditional insurance agencies (which provide support services as part of their employment contracts with insurance agents). Young Dep., p. 52-53. Registrant's competitors are other financial service providers, which do not include the types of entities that Petitioner identified as competitors. Cook Decl., Docket #31, tab 4, ¶ 10 – 14.

The lack of overlap may be highlighted by Trademark Office records. In re Mucky Duck Mustard Co. Inc., 6 U.S.P.Q.2d 1467 (T.T.A.B. 1988); In re Digirad Corp., 45 U.S.P.Q.2d 1841 (Comm'r Pat. 1998) (evidence showing only a small number of registrations evidencing overlap between the parties' products was of minimal value to show likely confusion). There are over 25,000 live use-based registrations for marks that relate to Petitioner's administrative or clerical services, and over 900 live use-based registrations related to Registrant's currency exchange services. Of these, only thirty-eight registrations show any overlap. Docket # 31, tab 9. This number even overstates the total amount of

⁹ Young Dep., Docket Entry #32, tab 5, p. 56 l. 24 – p.57 l. 1; Declaration of M. Cook, Docket Entry # 31, tab 4, ¶ 10 - 12.

¹⁰ While Petitioner's President and Chief Executive Office, Gary Young, claims to provide insurance securities and financial planning and advice in his personal capacity, and in his capacity as president of other companies (Financial Design Services and Premier Insurance Products, LLC), Petitioner itself does not provide such services. Petitioner provided some insurance products and services until 1998-2000, when all insurance-related products and services were spun off into a new company, Premier Insurance Products. Young Dep., p. 36 l. 22-25. Petitioner has not provided insurance products or services since, and has no plans to do so in the future. Young Dep., p. 36 l. 24-25, p. 37 l. 1-4, 7-8. Petitioner's clients do not market their financial services under Petitioner's name. Young Dep., p. 50 l. 25 – p. 51 l. 2, p. 56 l. 20-23.

overlap, since there are far fewer registrants – four registrations are owned by the Dubai stock market, three are owned by Visa and Mastercard, four are owned by American International Group, and many are owned by Yuanta Financial Holding Company. These are extremely large financial titans that are not remotely like either Petitioner or Registrant.

At most, Petitioner has stated that it is "not out of the realm of possibility" that currency exchange services "might be a service topic" for which Petitioner could provide marketing support at "some time in the future." Petitioner's Responses to Registrant's First Set of Interrogatories, Response #3 (Assertion #6, at p. 6). However, even if such an expansion were to happen, it would still not create any customer overlap.

Petitioner has existed since the mid-1980s without any expansion of the services it offers,¹¹ has no definite expansion plans into these administrative services, and would not offer the service of currency exchange in any event. Id. Such speculative plans for potential expansion, which contrast with the sedentary and contracting scope of Petitioner's actual business, presented in the absence of any evidence that consumers believe that the parties will actually compete in the same markets, are not legally relevant to the likelihood of confusion analysis. See, e.g., Matrix Motor Co., Inc. v. Toyota Jidosha Kabushiki Kaisha, 290 F.Supp.2d 1083 (C.D.Cal. 2003) (holding that "speculative or unrealistic plans cannot be considered" in determining whether a likelihood of confusion exists); Racetrac Petroleum, Inc. v. ETW Corp., 2004 WL 1195625 (T.T.A.B. 2004) (holding that "vague claims to have some long-range plans" for expansion are "simply too speculative to demonstrate that an expansion into those areas would be likely or that consumers would view the respective

¹¹ Indeed, Petitioner reduced the services it offers between 1998 and 2000, dropping insurance services to focus on its core administrative and clerical services. Young Dep., Docket Entry # 26, tab 1, p. 36 l. 20-25; Docket Entry # 31, tab 5, p. 37, l. 1-4.

goods and services as being related in a commercial sense").

Finally, Petitioner has submitted several pages from Registrant's United Kingdom website, www.moneycorp.com, to support its arguments that TTT Moneycorp coordinates "risk management and insurances services" through its currency exchange services. Decl. of V. Squires, Docket # 26, tab 23, p. 166 – 177. Any "risk management" offered by Registrant offers solely to foreign currency exchange risk management services (i.e. hedging strategies against risks from currency fluctuation) offered to large, sophisticated U.K. corporate clients; these services are not offered in the U.S. market or to U.S. customers. The example pages showing these services are, on their face, offered solely to Registrant's U.K. customers – the pages refer to trade in "sterling" and note that Registrant is licensed by the U.K.'s Financial Services Authority to provide those services. Registrant also does not offer insurance services. There is no evidence of record that Registrant provides or has at any time provided these services in U.S. commerce. Further, these services are also outside the scope of Registrant's trademark registrations, and irrelevant to this proceeding in any event.

(iii) The Parties' services are not complimentary or otherwise related.

Finally, the parties' services are simply not related, let alone substantially related. For example, there is no evidence that the goods are complementary, in the sense that they are likely to be used together by a group of purchasers. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565 (Fed. Cir. 1984) (bread and cheese related). Indeed, the record contains substantial evidence that the services of the parties are not complimentary. Cook Decl., Docket # 31, tab 4, ¶ 10-14. Nor is there any evidence that consumers would expect both parties' services to emanate from the same source; nothing in the record shows that the

same types of entities typically provide the services of both parties. Indeed, as noted in the excerpt from the *Wikipedia* on-line encyclopedia (Docket # 32, tabs 6 – 7) "financial services" providers include banks, investment banks, insurance companies, credit card companies and stock brokerages. Absent from this list are any of the entities that Petitioner has identified as its competitors.¹²

(iv) Numerous cases support the conclusion that the Parties' services are unrelated. A key distinction between the services offered by the parties in this case relates to the lack of any consumer overlap. Petitioner offers its services to financial service providers (insurance agents) seeking administrative support, while Registrant is a financial service provider whose customers seek financial services.

The Board has consistently found a lack of confusing similarity in cases with highly similar facts. For example, in Local Trademarks, Inc. v. Handy Boys Inc., 16 U.S.P.Q.2d at 1156, applicant filed for the mark LITTLE PLUMBER for liquid drain openers. The opposer opposed on the basis of its prior registration for the mark LITTLE PLUMBER for the formulation and preparation of advertising copy and literature in the plumbing field. The Board held that the opposer's providing of an administrative marketing service to plumbers, without any evidence that it provided any sort of plumbing services itself, was "so different" that there could be no likelihood of confusion. Id. at 1157-58.

Similarly, in In re Shipp, 4 U.S.P.Q.2d 1174 (T.T.A.B. 1987), the Board found no likelihood of confusion between the marks PURITAN and PURITAN & Design, as used with

¹² Insurance *companies*, which are included in this list, are very different from insurance *agencies*, which Petitioner lists among potential competitors.

laundry and dry cleaning services, on the one hand, and commercial dry cleaning machine filters and parts therefor, on the other. The Board recognized that the dry cleaning machine filters would be sold to the providers of laundry and dry cleaning services, rather than to the customers of such services, and specifically rejected the examiner's argument that the existence of a group (providers of laundry and dry cleaning services) aware of both services equated to a relationship between the goods and services. Id., at 1176.

Indeed, the Board has previously applied this same insight to financial services and held that there was no likelihood of confusion between similar marks for general banking services (including foreign exchange and traveler's checks) and specialized retirement home management services. The Chase Manhattan Bank, N.A. v. Life Care Services Corporation, 227 U.S.P.Q. 389 (T.T.A.B. 1985). In particular, the Board found "little evidence of record to support opposer's claim that the respective services are related," after determining that "it is clear from [the evidence] that opposer is not engaged in the service of managing retirement communities. The record is also clear that applicant does not provide any financial or banking services" to any relevant consumer group. Id., at 393.

D. Comparison of the Relevant Trade Channels and Purchasers.

The consumer market and channels of trade used by the parties are especially relevant when the parties' services are "specifically different and noncompetitive." Electronic Design & Sales, Inc., 954 F.2d 713, 716-17. Even where two parties "conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of

trade channels or overlap of customers." Id. at 717 (holding that there was no overlap in trade channels where one party sold general computer services and the other sold battery chargers and power supplies to the same hospital clients).

Registrant provides four different specifically identified financial services, in addition to its print material: issuing travellers' cheques; banking services; foreign currency services; and commodity brokerage services. The potential consumers of the services covered by the Registrations include both the general public (banking services and travellers' cheques (now deleted from the registrations) and some types of foreign currency services) and financial professionals (some types of foreign currency services and commodity brokerage services). Cook Decl., Docket # 31, tab 4, ¶ 8-9. Registrant's currency conversion services in the U.S. are actually provided via real estate professionals to help the real estate professionals' clients convert non-U.S. currency into dollars as part of real estate transactions. Cook Decl., Docket # 31, tab 4, ¶ 9.

As discussed above, Petitioner's administrative and clerical services are provided exclusively to insurance agents, a class of financial services professionals. Petitioner's brief obfuscates this crucial detail, claiming that "consumers of financial products" are a relevant consumer audience. Docket # 33, p. 15. They are not – Petitioner's services are provided solely to insurance agents, providers of financial services, and not to consumers of financial services. See Young Dep., Docket # 26, tab 1, p. 27 l. 1-8 (Since 2000, Petitioner has provided only " training, infrastructure, and creative marketing systems for [insurance agent] professionals.")

Thus, the only possible overlap between the parties' customer bases consists of sophisticated financial professionals. These circumstances are very similar to those noted in

the Shipp and Handy Boys cases discussed above. In each case, one party's goods or services were offered exclusively to professional customers in a specific industry, while the other party's goods or services were offered to the general public (individual and commercial customers not focused on a specific industry), including potentially overlapping customers of the first party.

As the Handy Boys court noted, "as far as the general public is concerned confusion would not be likely because the goods and services are sold through different channels of trade to different classes of consumers. That is, the general public does not purchase advertising services which are marketed to plumbing contractors." Local Trademarks, Inc. v. The Handy Boys Inc., 16 U.S.P.Q.2d at 1158. Similarly the Board in Shipp found that "Applicant's services are offered to the general public while the pertinent goods of the cited registrations are for use by owners or operators of laundries or dry cleaning establishments." In re Shipp, 4 U.S.P.Q.2d at 1176.

E. The only group that will be aware of both parties' services is highly sophisticated.

Purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713 (Fed. Cir. 1992). This factor is relevant even where the marks in question are identical. See, e.g., Dynamics Research Corp. v. Langenau Mfg. Co., 704 F.2d 1575 (Fed. Cir. 1983) (each party used the mark DRC).

Petitioner's potential clients are insurance agents and related financial service professionals. While Registrant's Services could be provided to professional financial

services providers and to retail customers, the only group that would even potentially be aware of both parties' services would be Petitioner's customers, who are financial services professionals. As a result, that is the only group relevant in determining the extent of purchaser sophistication. See, e.g., In re Shipp, 4 U.S.P.Q.2d at 1176 (finding that the only group to be aware of both parties' goods and services is "a class of purchasers relatively sophisticated and discriminating in matters pertaining to the dry cleaning industry").

Clearly, financial services professionals are professional business people and highly sophisticated. See Cook Decl., Docket #31, tab 4, ¶ 9; see also, e.g., Electronic Design & Sales v. Electronic Data Systems, 954 F.2d at 718 (corporate customers found to be sophisticated); In re Pioneer Investment Management, Inc., 2005 WL 847407 (T.T.A.B. 2005) (unpublished) (financial institutions and other financial service providers are "highly sophisticated").¹³ As such, this factor further reduces the possibility of confusion between the parties' marks as used with their respective services.

F. Other relevant factors.

Petitioner misleadingly claims that the record contains an "admission from TTT Moneycorp's own in-house legal counsel that confusion is likely." TTT Moneycorp's letter to Petitioner never alleges any likelihood of confusion between the parties' *marks*; it simply noted that use of Petitioner's *domain name* could be problematic: "... by owning a domain name which is our registered trade mark ('Moneycorp') you will, in contravention of our legal

¹³ The law is directly contrary to Petitioner's unsupported claim that the only possibly overlapping consumers, financial professionals (insurance agents), are unsophisticated. Petitioner's Brief, Docket # 33, at 17.

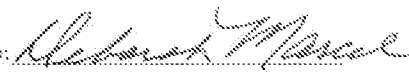
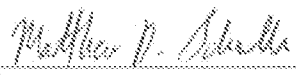
rights, cause confusion in the minds of the public as to whether you are connected with our business...". Docket # 31, tab 3, p. 57 (Bates numbered "Moneycorp 12"). As a result, that communication has no bearing on the Board's consideration of this cancellation action.

G. Conclusion: There is no likelihood of confusion between the parties' marks as used with their respective services.

The evidence shows that Petitioner provides administrative services to insurance agents and other financial service professionals. Petitioner does not provide financial services. In contrast, Registrant provides currency conversion and related financial services *only* to consumers of financial services. The only Du Pont factor which (weakly) favors Petitioner is the similarity between the parties' marks (and only for Registrant's MONEYCORP mark; Petitioner's Money Corp. mark is significantly different from Registrant's TTT MONEYCORP mark). No other factor favors finding a likelihood of confusion, and the most relevant factors clearly show that consumer confusion is not likely. As admitted by Petitioner, Young Dep., p. 55-57, Registrant's financial services simply are not competitive with Petitioner's business administration services, and the services are sold and marketed through entirely different channels of trade. The customers of each party's services are different, and the only possible overlapping relevant customer base (insurance agents seeking both back-office administrative support from Petitioner and currency exchange services from Registrant) is highly sophisticated. Balancing the Du Pont factors, it is evident that there is no likelihood of consumer confusion. The Board should deny Petitioner's request that registrations No. 2,463,593, No. 2,399,042 and No. 2,396,878 be cancelled, in whole or in part, on the ground of a likelihood of confusion, and dismiss the

petition for cancellation.

DATED: December 23, 2010.

<p>CERTIFICATE OF SERVICE</p> <p>I hereby certify that this, Registrant's Brief on the Merits, is being deposited with the United States Postal Service with sufficient postage as first class mail on December 23, 2010 in an envelope addressed to Vernon P. Squires at Bradley & Biley PC, 2007 First Avenue SE, P. O. Box 2804, Cedar Rapids, IA 52406-2804.</p> <p>Signature: </p> <p>Printed Name: <u>Deborah Marcel</u></p>	<p>PERKINS COIE LLP</p> <p>By </p> <p>James L. Vana Matthew D. Schneller Perkins Coie LLP 1201 Third Avenue, 40th Floor Seattle, Washington 98101-3099 (206) 359-8000 Attorneys for TTT Moneycorp Limited</p>
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