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June 23, 1997

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Vision Group of Funds, Inc.*

Serial No. 74/575,732
Serial No. 74/575,733

Charles W. Saber of Dickstein Shapiro Morin & Oshinsky LLP for
applicant.

Angela M. Micheli, Trademark Examining Attorney, Law Office 108
(David E. Shallant, Managing Attorney).

Before Cissel, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Vision Group of Funds, Inc. has filed applications to
register the marks "VISION"¹ and "VISION" and design,² as
reproduced below,

¹ Ser. No. 74/575,732, filed on September 16, 1994, which alleges
dates of first use of June 1, 1988.

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for, in each case, "financial services, namely offering of mutual funds and money market investments".

In each case, registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the mark "VISION," which is registered in both typed form for "underwriting insurance services"³ and in the manner depicted below

VISION

for "investment management services other than insurance,"⁴ as to

² Ser. No. 74/575,733, filed on September 16, 1994, which alleges a date of first use anywhere of September 13, 1993 and a date of first use in commerce of October 1, 1993. The phrase "GROUP OF FUNDS, INC." is disclaimed.

³ Reg. No. 1,335,908, issued on May 14, 1985, which sets forth dates of first use of September 1, 1984.

⁴ Reg. No. 1,708,620, issued on August 18, 1992, which sets forth dates of first use of July 20, 1990.

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be likely to cause confusion, mistake or deception.⁵

Applicant, in each instance, has appealed. Briefs have been filed, but an oral hearing was not requested. Because the issue in each case is essentially the same, the appeals have been treated in a single opinion. We affirm, in each instance, the refusal to register on the basis of the registration for the mark "VISION" for "investment management services other than insurance," but reverse the refusal to register in light of the registration for the mark "VISION" for "underwriting insurance services".

Turning first to consideration of the respective marks, it is plain from a comparison of the word marks that applicant's "VISION" mark is identical in all respects, including commercial impression, to registrants' "VISION" marks. As to a comparison of applicant's "VISION" and design mark with registrants' "VISION" marks, it is well established that, while marks must be compared in their entireties, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular

⁵ The two cited registrations neither issued to, nor are presently owned by, the same registrant.

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feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

In the case of applicant's composite mark, we concur with the Examining Attorney that the disclaimed phrase "GROUP OF FUNDS, INC." clearly is merely descriptive of the various mutual and money market funds offered by applicant and that, since it appears in a much smaller size than either the word "VISION" or the lighthouse design, such phrase is a relatively insignificant portion of the mark. Moreover, while we also agree with the Examining Attorney that "[t]he design of the lighthouse is a prominent feature of applicant's mark," we disagree with applicant's contention that such design is *the* dominant feature of the mark. We share, instead, the Examining Attorney's view that, as a matter of degree, the lighthouse design "is less significant than the VISION portion" due to the fact that the word feature is not only likely to be impressed upon a customer's memory, but it also would be used by prospective purchasers when requesting information, either orally or in writing, about applicant's financial services.⁶ Here, the lighthouse design, which according to applicant "creates an image of guidance and provides a consumer with a sense that Applicant will guide him or her if Applicant's services are used," simply reinforces the

⁶ See, e.g., *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

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notion of foresight or discernment conveyed by the word "VISION"⁷ as used in connection with financial investments.

Thus, while the lighthouse design in applicant's "VISION" and design mark is undeniably prominent visually, due to its large size in relation to the other elements in the mark, the same is also true of the word "VISION," which in each case constitutes the entirety of registrants' marks. However, inasmuch as such design, as noted above, serves by virtue of its placement directly over the word "VISION" in applicant's composite mark to underscore or highlight the notion of financial acumen or guidance projected by that word, the prominence of the lighthouse design in applicant's composite mark does not sufficiently distinguish it from registrants' VISION" marks⁸ Accordingly, we concur with the Examining Attorney that since, respectively, applicant's marks are identical and substantially similar to registrants' marks, contemporaneous use thereof in

⁷ We judicially notice, for example, that The American Heritage Dictionary of the English Language (3d ed. 1992) at 1997 defines "vision" as, *inter alia*, "2. Unusual competence in discernment or perception; intelligent foresight: a leader of vision" and that The Random House Dictionary of the English Language (2d ed. 1987) at 2126 similarly defines such term as, among other things, "2. the act or power of anticipating that which will or may come to be: *prophetic vision; the vision of an entrepreneur*". It is well settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁸ Applicant's reliance upon the case of In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990), is misplaced since, unlike the shared term "K+" in the marks "K+EFF" and "K+" and design for dietary potassium supplements, the common term "VISION" in the marks at issue herein is not merely descriptive of any of the services in connection with which it is used.

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connection with the same or closely related services would be likely to cause confusion as to source or sponsorship.

Applicant maintains, however, that marks which consist of or feature the term "VISION" are entitled to only a narrow scope of protection since, "based on the large number of VISION marks that already exist, it is clear that such marks are relatively weak." Specifically, applicant argues that, as shown by the results of its search of the "TRADEMARKSCAN" commercial database, "there are at least 13 additional existing Federal registrations or applications for marks which include the term VISION and cover services in the financial arena."⁹ Such third-party marks, however, are entitled to little weight on the question of likelihood of confusion since the registrations and applications are not evidence of what happens in the marketplace

⁹ The Examining Attorney, in her brief in each case, has stated an objection to consideration thereof, asserting that applicant failed to make the evidence properly of record since it submitted only a list of third-party registrations and applications instead of true copies of the registrations and applications. While third-party applications, irrespective of the type of copies thereof submitted, have no evidentiary value other than showing that the applications were filed, the Examining Attorney is correct that the proper procedure for making third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations taken from the Patent and Trademark Office's own computerized data base. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Nevertheless, inasmuch as the Examining Attorney, in response to applicant's submission of such evidence, raised no objection thereto in finally refusing registration and instead treated the evidence as being of record, the objection raised for the first time in each of her briefs is deemed to have been waived and the evidence has been considered. See In re Melville Corp., supra.

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or that the public is familiar with the use of the marks.¹⁰ Moreover, while third-party registrations may be competent to establish, like dictionary definitions, that a term common to the marks involved in a proceeding is weak in the sense that it has a normally understood and well known meaning,¹¹ we agree with the Examining Attorney that the evidence furnished by applicant relates to "marks that are distinctly different and/or [to] services that are unrelated". In consequence thereof, the term "VISION" has not been demonstrated to be weak in the fields of offering mutual funds and money market investments, underwriting insurance or rendering investment management.¹²

Turning next to consideration of the respective services, applicant argues that its financial services are specifically limited to the offering of mutual and money market funds and thus do not involve either insurance underwriting or investment management advice. Applicant urges, in addition, that the coexistence of the two cited registrations "for different

¹⁰ See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983); and *National Aeronautics & Space Administration v. Record Chemical Co., Inc.*, 185 USPQ 563, 567 (TTAB 1975).

¹¹ See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); and *American Hospital Supply Corp. v. Air Products & Chemicals, Inc.*, 194 USPQ 340, 343 (TTAB 1977).

¹² Applicant also insists that "[r]egistrants' VISION marks are clearly not famous marks" and that, "[a]s a result, these marks are not likely to be widely recognized by the public and are not afforded the broader degree of protection often afforded to famous marks." However, inasmuch as there is simply no evidence as to whether registrants' marks are famous, such a factor has bearing on the issues of likelihood of confusion herein.

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services within the financial services arena" demonstrates that "the Trademark Office, itself, has already recognized that registration of Applicant's mark is appropriate."

The Examining Attorney contends, however, that "[i]nsurance and financial services are related and [that the same] companies offer both services" under the same marks. In support thereof, the Examining Attorney has made of record copies of several use-based registrations of third-party marks which broadly list, in each instance, various insurance underwriting services, on the one hand, and investment advisory services, financial services, investment counseling and trust management services, investment management services, and/or financial and investment consulting services, on the other hand.¹³ The Examining Attorney also relies upon copies of pages from a yellow pages directory which, under the heading of "INSURANCE," list a few insurance companies that advertise both insurance policies and either annuities or financial services. While conceding that such classified ads "do not specifically show money market or mutual fund investment services advertised with insurance services," the Examining Attorney nevertheless asserts that "they

¹³ The most pertinent of these is a single registration which sets forth "insurance services; namely, underwriting life, health, annuity, property and casualty insurance; [and] financial services; namely, the sale of mutual funds, money market funds, pension plans and IRA plans". It is settled that although use-based third-party registrations are not evidence that the different marks shown therein are presently in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the services or goods listed therein are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993) and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

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show the close tie between insurance and financial services and that customers are use[d] to seeing the two services offered together." Finally, with respect to applicant's argument that the coexistence of the two cited registrations should similarly entitle it to registration of its marks, the Examining Attorney insists that because the reasons for such a situation occurring are not known, "the actions of another examining attorney are not binding" on the issues of likelihood of confusion herein.

Taking this last contention first, it is true that the file history of the most recent of the cited registrations (like that of the earlier one) is not of record. It is also the case that, as a general proposition, the issuance of such registration over the other cited registration is not determinative of the issue of likelihood of confusion herein since prior determinations by other Examining Attorneys have no precedential effect and that each case must, instead, be resolved on its own merits.¹⁴ Nevertheless, in the appeals before us, it is plain that the coexistence of the cited registrations is due primarily, if not exclusively, to the specifically stated exclusion of all forms of insurance services, including underwriting, from the investment management services listed in the most recent of the cited registrations. In view thereof, it was determined that contemporaneous use of the identical marks "VISION" for underwriting insurance services and "VISION" for financial

¹⁴ See, e.g., *In re Citibank, N.A.*, 225 USPQ 612, 616 (TTAB 1985) and *In re Hunter Publishing Co.*, 204 USPQ 957, 961 (TTAB 1979).

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services consisting of investment management services other than insurance would not be likely to cause confusion.

Similarly, in these appeals, the evidentiary record furnished by the Examining Attorney is not sufficiently probative to lead us to conclude that contemporaneous use of the mark "VISION" by one registrant for underwriting insurance services and applicant's "VISION" marks for its financial services of offering mutual funds and money market investments is likely to cause confusion. The Examining Attorney concedes, as noted previously, that the yellow pages excerpts "do not specifically show money market or mutual fund investment services advertised with insurance services". Thus, contrary to the Examining Attorney's assertion, the excerpts simply do not "show the close tie between insurance and financial services and that customers are use[d] to seeing the two services offered together." Furthermore, although such excerpts indicate that some insurance underwriters also offer annuities, which are admittedly a type of financial investment, only one of the third-party registrations introduced by the Examining Attorney specifically sets forth both insurance underwriting services, including annuities, and financial services which involve the sale of mutual funds and money market funds. In light of this meager showing, we are not persuaded that the purchasing public would expect that providers of insurance underwriting services would also offer mutual funds and money market investments, or vice versa, even when such "financial services" are offered by different entities under marks which consist of or prominently feature the word

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"VISION".¹⁵ Confusion, in such circumstances, has therefore not been demonstrated to be likely to occur.

We reach a different conclusion, however, with respect to contemporaneous use of the cited mark "VISION" for investment management services other than insurance and applicant's "VISION" marks for its financial services of offering mutual funds and money market investments. It is settled, as the Examining Attorney correctly observes, that services or goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services or goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same provider or producer.¹⁶ Moreover, it is also well established that the issue of likelihood of confusion must be determined in light of the services or goods set forth in the involved application and cited registration and, in the absence of any specific limitations

¹⁵ The mere fact, however, that a term such as "financial services" may be found which encompasses both a registrant's and an applicant's services or goods does not mean that customers will view the particular services or goods as related in the sense that they will assume that they emanate from or are associated with a common source. See, e.g., *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977) and *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975).

¹⁶ See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

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therein, on the basis of all normal and usual channels of trade and methods of distribution for such services or goods.¹⁷

Here, it is common knowledge that providers of financial investment services, such as securities brokers, offer recommendations or advice about mutual funds and money market investments and also sell money market investments and other mutual funds, including those of their own creation, in connection with the rendering of investment management services to their clients. Given this close relationship, customers who are familiar or otherwise acquainted with investment management services (other than insurance) which are sold under the mark "VISION" would be likely to believe, upon encountering the mutual funds and money market investments provided by applicant under its "VISION" marks, that the respective services emanate from or are affiliated or associated with the same source. While undoubtedly, as applicant argues, actual and prospective customers for investment management services, mutual funds and money market investments are careful, deliberate and discriminating in their purchasing decisions given the expense typically associated therewith, the fact that such consumers may be knowledgeable or sophisticated in the investment management and mutual fund securities fields does not necessarily mean that

¹⁷ See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1993); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

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they are immune from confusion relating to source or sponsorship.¹⁸

Applicant, nevertheless, further insists that "despite contemporaneous use ... for at least three years, Applicant knows of no instance of actual confusion between the use of its mark[s] and those of the Registrants," including the cited "VISION" mark for investment management services other than insurance. The record, however, contains no evidence as to the nature and extent of the alleged contemporaneous use of the respective "VISION" marks in the same geographical areas. The asserted absence of any instances of actual confusion, therefore, is not a meaningful factor.¹⁹

Decision: In each instance, the refusal under Section 2(d) on the basis of the registration for the mark "VISION" for "investment management services other than insurance" is affirmed, but the refusal under Section 2(d) in light of the registration for the mark "VISION" for "underwriting insurance services" is reversed.

R. F. Cissel

E. W. Hanak

¹⁸ See, e.g., *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

¹⁹ Compare *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) with *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-71 (TTAB 1992).

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