

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

9/18/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Transterra Co.

Serial No. 74/715,228

G. Brian Pingel of Shearer, Templer & Pingel for applicant.

Matthew C. Kline, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Hanak and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Transterra Co. has filed a trademark application to register the mark UPSIDE for "electronic brokerage services, namely, providing computer instructional services for the electronic processing of stock brokerage transactions via a global computer information network."¹

¹ Serial No. 74/715,228, in International Class 36, filed August 14, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark UPSIDE CD, as shown below, previously registered for "banking and financial services in the nature of issuing certificates of deposit,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Upside CD

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Turning, first, to the marks, we note that the registrant's mark contains a minor design element consisting of the lettering typestyle and the presentation of the term "Upside" with an initial capital letter followed by lower case letters. Registrant's mark

² Registration No. 1,967,860 issued April 16, 1996, to Old National Bank in Evansville, in International Class 36. The registration includes a

includes the term CD, which, as acknowledged by applicant, is a well-recognized abbreviation for a certificate of deposit and is the subject of registrant's banking and financial services. Clearly, the term UPSIDE is the dominant portion of registrant's mark. While UPSIDE may be suggestive of a positive outlook, it is, on this record, an arbitrary term in connection with the identified services. Applicant's mark is identical to the dominant portion of registrant's mark. We conclude that the marks are substantially similar in sight, sound, appearance and overall commercial impression.

Thus, the significant question in this case is whether, in view of the substantial similarity of the marks, applicant's and registrant's respective services are sufficiently different to avoid likelihood of confusion. In deciding cases such as this, we are required to determine the issue of likelihood of confusion on the basis of the goods as set forth in the application and the cited registration. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Further, "if the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding

disclaimer of the term CD apart from the mark as a whole.

of likelihood of confusion." *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

We agree with the Examining Attorney's contentions that registrant's services are broadly identified and do, in fact, encompass the providing of its services via "a global computer information network"³; and that "stock brokers commonly provide services with respect to stocks, bonds and certificates of deposit." The Examining Attorney has submitted copies of third-party registrations wherein the identified banking services include both providing certificates of deposit and providing brokerage services in connection with stocks and bonds; and wherein the identified services include brokerage services involving certificates of deposits, mutual funds and securities.⁴ Additionally, the Examining Attorney has submitted excerpts of articles from the LEXIS/NEXIS database, several of which

³ While the record contains no evidence regarding whether certificates of deposit can be, or are, sold electronically via the Internet, it is not unreasonable to assume that certificates of deposit may be advertised and offered for sale electronically via the Internet even if the transaction must be completed in person or via regular mail.

⁴ Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

indicate both that brokerage firms deal in certificates of deposit and banks provide brokerage services.⁵

Therefore, we conclude that, although applicant's and registrant's services are not the same, the services are sufficiently related that, when sold under substantially identical marks, purchasers are likely to believe that the source or sponsorship of the services is the same or related. See, *Charles Schwab & Co. Inc. v. The Hibernia Bank*, 3 USPQ2d 1561, 1566 (N.D.CA. 1987); *In re United California Brokers, Inc.*, 222 UPSQ 361 (TTAB 1984); and *Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736 (TTAB 1983).

Further, applicant's instructional services are broadly identified so as to include the rendering of such services to either, or both, the broker offering the stock electronically and/or the individual purchasing the stock electronically. The latter class of customers is likely to be the same class of customers for registrant's services.

⁵ For example, "Brokerage firms do deal in certificates of deposit. Yields on broker-sold CDs are generally higher than CDs from your local bank, with interest rates that are close to the rates on the same-maturity ..." [*Sacramento Bee*, May 23, 1996]; "By yearend, Internet surfers should be able to open certificate-of-deposit, money market, and brokerage accounts through Huntington's Web site as well as apply for Visa and Mastercard accounts." [*The American Banker*, June 3, 1996]; "The [bank] branch offers mortgage and home equity loans, certificates of deposit, and trust, investment and brokerage services ..." [*The Cincinnati Enquirer*, May 29, 1996]; "Callable CDs are basically bank certificates of deposit sold through brokers. That's

Thus, the record supports the conclusion that the services of applicant and registrant may be offered to the same class of customers through the same channels of trade.

We are not convinced otherwise by applicant's contentions that its services differ from those of registrant because applicant's services "are actually provided over the Internet to applicant's customers"; and that applicant's services do not involve the sale of a product, rather, applicant's services involve "the providing of instructions for completing brokerage transactions over the Internet." These are, essentially, insignificant and immaterial distinctions.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, UPSIDE, and registrant's mark, UPSIDE CD and design, their contemporaneous use on the related services involved in this case is likely to cause confusion as to the source or sponsorship of such services. To the extent that we may have any doubt concerning our conclusion that confusion is likely, we are obligated to resolve such doubt in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

how they get the FDIC insurance. Most are 15-year CDs, although some banks are offering 5-year ..." [St. Louis Post-Dispatch, May 27, 1996].

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Decision: The refusal under Section 2(d) of the Act
is affirmed.

R. L. Simms

E. W. Hanak

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board