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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Information Technology, Inc.

Serial No. 74/733,860

Vincent Carney for Information Technology, Inc.
Robert Lorenzo, Trademark Examining Attorney, Law Office 101 (Ellsworth Williams, Managing Attorney).

Before Cissel, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 25, 1995, applicant filed the above-referenced application to register the mark “PCBANC” on the Principal Register for a “computer software product for the delivery of selected banking services and functions with personal computers to customers,” in Class 9. The application was based on applicant’s claim of use of the mark in commerce since August 28, 1995.

In addition to requiring amendment to the identification-of-goods clause in the application, the Examining Attorney refused registration under Sections 2(d) and 2(e)(1) of the Act. The mark was held to be merely descriptive of the goods set forth in the application, and registration was also refused because of the likelihood of confusion with two registered marks. These marks are shown below:

PC/BANKER

is registered[1] for "computer programs and program manuals all sold as a unit for the purpose of providing financial institutions with information," in Class 9; and

P.C. Banks

is registered[2] for "computer programs and instructional manuals sold as a unit for use in the finance industry," in Class 9.

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[1] Reg. No. 1,465,253, issued to Bankers Training & Consulting Co., Inc. on November 17, 1987, and now owned by Westcott Communications, Inc.; Combined affidavit under Sections 8 and 15 received.

[2] Reg. No. 1,613,577, issued to Response, Inc. on September 18, 1990 under the provisions of Section 2(f) of the Act; Affidavit under Sections 8 and 15 received.

Responsive to the first Office Action, applicant amended its application to state its goods as “computer software program for use in banking via personal computer.”

Applicant also argued against both refusals to register. Counsel contended that the mark “is not merely descriptive and it is barely suggestive” of applicant’s products, and argued that in view of the meaning of the word “BANC,” “PCBANC” would “more appropriately describe a computer program that is used for a judge’s bench.” As to the likelihood of confusion, applicant argued that the cited trademark registrations are for marks which look different; that the goods are different; that the customers and the channels of trade are different; and that the registrants’ marks and applicant’s mark are all suggestive, and therefore are not likely to cause confusion anyway.

The Examining Attorney was not persuaded to withdraw either basis for refusing registration. Accompanying the final refusal which thus issued were a copy of a dictionary listing showing that “PC” is an abbreviation for “personal computer” and a number of excerpts from articles retrieved from the Nexis® database of published articles. These excerpts clearly establish that “PC banking” is a term used for banking by means of personal computer. In addition to these references, a couple of these excerpts show use of

the term “PC bank,” to refer to banking by means of personal computer, e.g., “Citibank, which once charged as much as $15 a month for its PC bank service…” and “a PC bank transaction will cost the banks even less, analysts say…”

Applicant requested reconsideration of the refusals to register, contending that the Examining Attorney had refused registration not just on the grounds that confusion is likely with the two cited registrations and that the mark is merely descriptive, but also on the ground that the mark “is the generic or common word for some service.”

Reponsive to the reconsideration request, the Examining Attorney pointed out that genericness was never a basis for refusing registration. The Examining Attorney maintained that both refusals were proper, however, and attached still more excerpts retrieved from the Nexis® database. On the issue of the equivalency of the terms “bank” and “banc,” the articles excerpted show that “banc” is commonly used in the financial industry as the equivalent of “bank.” Also attached to the Examining Attorney’s response to the request for reconsideration were print-outs from the Patent and Trademark Office’s automated search system. This evidence shows that when the term “banc” has been used as a component of marks for banking

services, it has been disclaimed in its proper spelling as "bank." The finality of the refusals was maintained.

Applicant timely filed a notice of appeal to the Board. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing.

Based on the written record and the arguments of record in this appeal, we find that although confusion is not likely with respect to the cited registration for the mark consisting of the stylized presentation of the name "P.C. Banks," confusion is likely in view of the other cited registration, for the mark "PC/BANKER," and we also hold that applicant's mark, as applied to the goods specified in the application, is merely descriptive of them.

We turn first to the likelihood of confusion with the mark "P.C. Banks," which was originally registered by Bankers Training and Consulting Co., Inc., for "computer programs and program manuals all sold as a unit for the purpose of providing financial institutions with information." We agree with applicant that confusion is not likely because applicant's mark creates a different commercial impression from the one created by this mark, and the services specified in this registration are distinct from those which applicant renders under its mark.

As to the first point, we note that the commercial impression of the cited mark is that of a signature of a person named “Banks” whose first and middle initials are “P” and “C,” respectively. The style of the script in which the mark is presented is consistent with this impression, which is quite different from that created by applicant’s mark, “PCBANC.” At first blush, applicant’s mark appears to be some sort of an abbreviation or truncated combination of “PC” and the phonetic equivalent of the word “BANK.”

In addition to the differences in the appearances and commercial impressions of these two marks, the differences in the goods set forth in the application and the cited registration bolster our conclusion that confusion is not likely. Applicant’s software is used by bank customers to allow them to bank by using their personal computers. The programs specified in the cited registration, however, are used by financial institutions to provide themselves with information. The original registrant was a banking consulting and training business. Its customers were not the ordinary consumers who want to be able to bank by PC. Rather, the customers for the programs sold under the registered “P.C. Banks” mark are the banks themselves. As applicant points out, the channels of trade through which

these products move, the customers who purchase and use them, and the purposes for which they are used are all different. Because of the differences in these two marks and the differences in the products with which they are used, confusion is unlikely.

Confusion is likely, however, with respect to the other registered mark cited by the Examining Attorney,

which is registered for “computer programs and instructional manuals sold as a unit for use in the finance industry.” Applicant’s mark is similar in sound, connotation, and overall commercial impression to this registered mark, and the identification-of-goods clause in this registration encompasses the goods identified in the application.

Taking up the later point first, we note that these goods are legally identical because computer programs for banking by personal computer are part of the larger category of “computer programs for use in the finance industry.”

Turning, then, to the similarity of the marks, we note that the rectangular border around the cited mark is not

particularly unusual. It is of far less source-indicating significance than the term “PC/BANKER” is. The record establishes the equivalency of the words “bank” and “banc.” Although distinctions can be made between applicant’s mark, which is the equivalent of “PCBANK,” and the registered mark, “PC/BANKER,” the similarities between “PCBANC” and “PC/BANKER” far outweigh their differences. Both of these marks connote banking by personal computer. This explains why the “PC/BANKER” mark was registered under the provisions of Section 2(f) of the Act. We will explain in our discussion of the descriptiveness refusal the fact that applicant’s “PCBANC” mark conveys the idea that applicant’s software allows customers to bank by PC. Confusion is likely because these two marks are similar in sound, connotation, and commercial impression, and applicant’s products are encompassed within the goods identified in the registration. The refusal under Section 2(d) is therefore affirmed with respect to Registration No. 1,613,577.

We also affirm the refusal to register under Section 2(e)(1) of the Act. A mark is merely descriptive of the goods with which it is used if it conveys information about a characteristic, feature, or purpose of the goods. In re Bright-Crest, Ltd., 204 USPQ 591(TTAB 1979). The evidence made of record by the Examining Attorney shows that “PC

banking" and "PC bank" are terms which are used in the financial field to refer to banking by personal computer, and that "banc" is the equivalent of "bank." Applicant's mark, "PCBANC," is merely descriptive of applicant's computer programs because the purpose or central characteristic of the programs is that they allow people to PC bank, i.e., bank by PC.

Applicant's contention that purchasers of its software would understand the mark "PCBANC" to refer to a PC for a judge's bench is not well taken. As applied to programs used for PC banking, the mark clearly refers to the nature of the goods.

In summary, we reverse the refusal to register based on the likelihood of confusion with the stylized signature of "P.C. Banks," but we affirm the refusal to register under Section 2(d) based on the registration of the "PC/BANKER" and design mark, and we affirm the refusal to

register because the mark is merely descriptive under Section 2(e)(1) of the Act.

R. F. Cissel

E. W. Hanak

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial & Appeal Board