

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB DEC. 28, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Sisung Investment Management Services, Inc.**

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Serial No. 75/107,548

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**Seth M. Nehrbass of Garvey, Smith, Nehrbass & Doody, LLC  
for Sisung Investment Management Services, Inc.**

**Patricia A. Horrall**, Trademark Examining Attorney, Law  
Office 106 (Mary Sparrow, Managing Attorney)

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Before Seeherman, Chapman and Holtzman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sisung Investment Management Services, Inc. has  
appealed from the refusal of the Trademark Examining  
Attorney to register EPIC as a mark for "mutual fund  
investment management services; mutual fund investment  
consultant services; and mutual fund investment advising

services."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the marks EPIC ASSET MANGEMENT (with "Asset Management" disclaimed) for "asset and investment management services, real estate and property management services, and brokerage services, namely real estate"<sup>2</sup>, owned by John Stephanus, and EPICS for "financial services in the nature of an investment security,"<sup>3</sup> owned by Bear, Stearns & Co. Inc., that if used on applicant's identified services it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs on the case. An oral hearing was not requested.

In any determination of likelihood of confusion, two key factors are the similarity of the marks and the similarity of the goods. Turning first to the marks, applicant's mark is virtually identical to the registered mark EPICS. The only difference between them is that the registered mark is the plural form of EPIC, but this slight difference is not sufficient to distinguish the marks.

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<sup>1</sup> Application Serial No. 75/107,548, filed May 21, 1996, and asserting a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,935,977, issued November 14, 1995.

<sup>3</sup> Registration No. 2,034,112, issued January 28, 1997.

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They are substantially the same in appearance, sound, and connotation, and convey the same commercial impression. As for the registered mark EPIC ASSET MANAGEMENT, again this mark conveys the same commercial impression as EPIC.

Although marks must be compared in their entireties, it is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, EPIC is the dominant part of the mark EPIC ASSET MANAGEMENT, the disclaimed term "asset management" being descriptive of the services.

Turning to the services, applicant's identified mutual fund investment management, consultant and advising services are encompassed within the "asset and investment management services" identified in the registration for EPIC ASSET MANAGEMENT. Thus, we must consider applicant's and this registrant's services to be, in part, legally identical. Moreover, the evidence of record shows that these services, even if considered to be different, are related. The Examining Attorney has made of record third-party registrations showing that a single mark has been registered for, inter alia, investment management services

and mutual fund investment services.<sup>4</sup> As for the financial services in the nature of an investment security identified in the registration for EPICS, the Examining Attorney has also submitted evidence to show that these services and those identified in applicant's application are related. Specifically, the Examining Attorney has made of record third-party registrations which show that a single mark has been registered for financial services in the nature of an investment security and for, inter alia, mutual fund investment services.<sup>5</sup> Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that the customers who utilize the services of applicant and of the owners of the cited

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<sup>4</sup> See, for example, Registration Nos. 1,972,186; 1,853,818; 1,969,379; and 2,078,379.

<sup>5</sup> See, for example, Registration Nos. 1,853,818; 2,040,086; and 2,052,150.

registrations are relatively sophisticated, and will not be confused as to the source of the services because they know the difference between these different types of services. Applicant also asserts that applicant's services are only available to customers who are able to invest \$100,000 or more.

There are several problems with applicant's position. First, the question is not whether consumers will recognize that there are differences among the services, but whether they are likely to believe that applicant's services emanate from the same source as either of those in the cited registrations. Second, although applicant may require its consumers to make a \$100,000 investment, such a requirement is not reflected in the identification of services. Thus, we must consider applicant's services to be available to anyone with a need for mutual fund investment management services, mutual fund investment consultant services, or mutual fund investment advising services. Third, although consumers of the services identified in the two registrations and the application may be said to be careful, we cannot accept applicant's position that they are sophisticated. Many Americans, such as those who are able to take advantage of employment retirement plans, invest in various financial tools,

including mutual funds; such investments are not limited to the wealthy or highly sophisticated investor.

Applicant also asserts that confusion is not likely because four registrations for marks containing the word EPIC have issued to four different entities. Applicant did not provide registration numbers for, or copies of, these registrations,<sup>6</sup> but apparently the Examining Attorney was able to locate pertinent information about them. As the Examining Attorney has pointed out, two of the registrations are the ones which have been cited against applicant's application, one has expired, and the fourth is for "brokerage services in the field of exportation of wood products," services which are very different in nature from the services identified in applicant's application and the cited registrations.

Thus, the only relevant registrations for EPIC marks are the two which have been cited against applicant's application. The fact that EPICS was registered despite the existence of the registration for EPIC ASSET MANAGEMENT

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<sup>6</sup> Ordinarily a mere listing of marks and services, as applicant has provided, would not be sufficient to make them of record. However, because the Examining Attorney did not object, but treated them of record, we will deem them to have been stipulated into the record. Nevertheless, because applicant did not provide registration numbers the Board must rely on the information provided by the Examining Attorney as to the status of the registrations.

does not prove that applicant's mark EPIC can coexist with these registrations and not be likely to cause confusion. We do not have the file of the EPICS registration before us, and therefore cannot ascertain what factors went into the Examining Attorney's decision to approve that application. For example, there may have been a consent by the owner of the EPIC ASSET MANAGEMENT registration. In any event, the fact that there are two registrations for EPIC/EPICS marks for various financial services does not persuade us that EPICS and EPIC ASSET MANAGEMENT are such weak marks that applicant's use of EPIC for mutual fund investment management services, mutual fund investment consultant services, and mutual fund investment advising services is not likely to cause confusion.

Decision: The refusal of registration is affirmed with respect to both of the cited registrations.

E. J. Seeherman

B. A. Chapman

T. E. Holtzman  
Administrative Trademark Judges  
Trademark Trial and Appeal Board