

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

OCT. 5, 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 Republic New York Corporation

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Serial No. 75/191,403

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Dickerson M. Downing of Morgan & Finnegan, L.L.P for  
Republic New York Corporation.

James A. Rauhen, Trademark Examining Attorney, Law Office  
103 (Michael A. Szoke, Managing Attorney)

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Before Walters, Chapman and Wendel, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Republic New York Corporation has filed an application  
to register the mark NEW HORIZONS for "educational  
services, namely a program for teller training and general

job search skills designed for economically deprived and unemployed individuals."<sup>1</sup>

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 used on its services, so resembles two registered marks, NEW HORIZONS for "educational services, namely, conducting courses in the operation of computer systems"<sup>2</sup>; and the mark shown below

for "educational services, namely, conducting classes dealing with computer operations,"<sup>3</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed. Applicant requested an oral hearing, but later withdrew that request.

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<sup>1</sup> Application Serial No. 75/191,403, filed November 1, 1996. The claimed date of first use and first use in commerce is October 3, 1996.

<sup>2</sup> Reg. No. 1,337,233, issued May 21, 1985, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce is December 26, 1983. (The Class 42 retail store services were cancelled under Section 8.)

<sup>3</sup> Reg. No. 2,064,665, issued May 27, 1997. The claimed date of first use and first use in commerce is November 15, 1995. The registration includes the following statement: "The mark consists of the wording 'NEW HORIZONS' with a line segment and partial design of a globe."

Turning first to a consideration of the marks, applicant's mark and one of the registered marks are identical. When analyzing applicant's mark and the registered composite word and design mark, it is not improper to give more weight to a dominant feature of a mark, in this instance, the word portion of the registered mark. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). This portion is also identical to applicant's mark. Thus, applicant's mark and both cited marks are, respectively, the same and substantially similar, in appearance, pronunciation, connotation and commercial impression.

Applicant argues that NEW HORIZONS is weak and not entitled to a broad scope of protection because of what applicant characterizes as the existence of third-party registrations. Specifically, applicant argues that the two cited registrations are not owned by the same party and

that a third registration for the mark NEW HORIZONS IN HEALTH CARE is owned by yet another party.<sup>4</sup>

However, applicant's contention is not well taken. The two currently cited registrations are owned, respectively, by New Horizons Computer Learning Centers, Inc. (by assignment), and New Horizons Education Corp., both at the same street address in Santa Ana, California. It appears highly likely that these registrants are related in some manner, rather than being competitors. The other registration cited but withdrawn by the Examining Attorney is owned by a third party, Bill Communications, Inc. in New York. This is insufficient to demonstrate NEW HORIZONS is a weak mark in the field of educational services even if the two cited registrations are owned by unrelated entities.

Turning next to a consideration of the respective services, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this case, both registered marks are for educational services,

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<sup>4</sup> The Examining Attorney originally based his refusal under Section 2(d) on this registration also, but subsequently withdrew

namely, conducting classes in computer operation, while applicant provides educational services, namely, bank teller training and general job search skills for economically deprived and unemployed persons. Applicant's teller training and general job skills program as identified is sufficiently broad to include computer classes, and thus, applicant's services fall, at least in part, within those services identified in the cited registrations. In fact, the record is clear that applicant's services do include an "eight-week computer initiative program" (brief, p. 2); and applicant's brochures refer to "NEW HORIZONS Computer Program."

Moreover, it is well settled that services need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992).

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this cite.

Regarding the respective trade channels and purchasers, applicant's arguments that its educational services are offered to a very narrow class of customers, and are promoted through very narrow channels of trade, and that these are "non-traditional" trade channels (reply brief, p. 2) are not persuasive. While applicant's identification of services is limited in that applicant's services are "designed for economically deprived and unemployed individuals," nonetheless, the services identified in the cited registrations are not so limited and thus, would encompass that narrower segment of the population targeted by applicant. The Board must consider that the parties' respective services could be offered and sold to the same class of purchasers through all normal channels of trade for those services and class of purchasers. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

We find that upon seeing the same and/or substantially similar marks NEW HORIZONS and NEW HORIZONS and design for the respective services, prospective purchasers are likely to believe the services emanate from or are otherwise sponsored by or affiliated with the same source.

According to applicant, there have been no instances

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of actual confusion. However, there is no information of record regarding the respective sales, nor is there any information from the registrants. In any event, the test is likelihood of confusion, not actual confusion. See *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

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Decision: The refusal to register under Section 2(d)  
is affirmed.

C. E. Walters

B. A. Chapman

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board