

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 14, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BSB Bank & Trust

Serial No. 75/347,040

Mark Levy of Salzman & Levy for BSB Bank & Trust

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney)

Before Cissel, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

BSB Bank & Trust has filed, on August 26, 1997, an
application to register the mark shown below

for "banking services by phone." Applicant alleges a date
of first use of 1995. Applicant disclaimed the term
"TelephoneTeller" and the pictorial representation of a
telephone.

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 in connection with its services, so resembles the mark shown below

which is registered for "financial services, namely, banking services,"¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney essentially takes the position that the letters BSB are the dominant portion of both the cited registered mark and applicant's composite mark; that applicant adopted registrant's entire letter mark as a portion of applicant's mark; that the two marks, albeit somewhat visually distinguishable, nonetheless create the same overall commercial impression; that the respective services are identical or very similar; that applicant's "banking services by phone" are encompassed within the

¹ Registration No. 2,026,472, issued December 31, 1996. The claimed date of first use is April 12, 1995.

cited registrant's more general "banking services"; and that in any event, applicant's more specific banking services could be seen by purchasers as a natural expansion of a bank's services.

Applicant contends that when the marks are considered in their entireties, registrant's mark is a stylized BSB within a skewed box shape, whereas applicant's mark is a composite mark consisting of the letters BSB, along with the compound noun 'TelephneTeller,' the design of a telephone and a "prominent border" (applicant's brief, p. 5); that the design elements of applicant's mark are significant; and that the marks do not have the same sound or appearance. Applicant also argues that the letters BSB are not arbitrary, but rather are obvious acronyms based on the respective trade names, Beneficial Savings Bank (registrant's name) and Binghamton Savings Bank², and the cited registration is therefore entitled to a narrow scope of protection; that customers of banks are sophisticated in choosing a banking service; that there is no evidence that registrant provides telephone banking services or that it has the technological capability to do so; that applicant's intent in adopting its mark was not based on an attempt to

² Applicant's name is BSB Bank & Trust, but applicant is located in Binghamton, New York.

derive benefits from the reputation of the registrant's mark; and that applicant is not aware of any instances of actual confusion.

Turning first to a consideration of the respective services, we agree with the Examining Attorney that the respective services, banking services and banking services by phone, are virtually identical or very closely related. Certainly applicant's more specific services are encompassed within the broader identification in the cited registration. Likewise, the channels of trade and the prospective purchasers of both services are the same or overlapping, and include all the normal channels of trade to all the usual classes of purchasers for such services. See *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Turning to a consideration of the marks, while the marks have visual differences, both marks include the identical letters BSB.

It is generally accepted that when a composite mark incorporates the arbitrary mark of another for closely related goods or services, the addition of suggestive or descriptive words or other matter is generally insufficient to avoid a likelihood of confusion as to source. See *The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194

USPQ 419 (CCPA 1977). In fact, if one incorporates the arbitrary registered mark of another into a composite mark, even the inclusion of a significant nonsuggestive element in the composite mark does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion. See Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975); and In re West Point-Pepperell, Inc., 468 F.2d 200, 175 USPQ 558 (CCPA 1972). In the case now before us, applicant's mark encompasses registrant's letter mark BSB, and applicant's addition of descriptive terms and other matter does not alleviate the likelihood of confusion.

The portion utilized in calling for the services, in this case the letters BSB, is most likely to be impressed in the purchaser's memory and to serve as the indication of origin. See Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977).

Applicant's argument that the letters are acronyms from the respective trade names and are not arbitrary is not persuasive. There is no evidence that the combination of the letters BSB, even if derived from the initial letters of different names, have any special meaning, aside from trademark significance, to purchasers of the involved

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services. BSB is unpronounceable except as the separate letters, and would be more difficult to remember, and thus, more susceptible of confusion, or mistake. See *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (confusion found likely in contemporaneous use of TMM and TMS on computer software). See also, *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986) (confusion found likely in contemporaneous use of EB and design for all purpose gym bags and certain clothing items and EBS and EBS in stylized lettering for shoes); and *Chemetron Corp. v. N.R.G. Fuels Corp.*, 157 USPQ 111 (TTAB 1968) (confusion found likely in contemporaneous use of NCG for compressed gases and NRG for liquefied petroleum gas, etc.).

To whatever extent purchasers notice the differences in the marks, they may believe that applicant's mark is a revised version of registrant's mark, now used in connection with telephone banking services.

According to applicant, there have been no instances of actual confusion. However, 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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Based on the identity of the letters BSB in both marks, the essential identity of the services, and the identity of the trade channels and purchasers, we find that there is a likelihood that the purchasing public will be confused by applicant's use of BSB TELEPHONETELLER and design as a mark for banking services by phone. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

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

R. F. Cissel

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board