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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re **Checquepoint Franchise Corporation**

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Serial No. 75/281,588

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**Monica L. Thompson and Linda Urbanik Johnson of Rudnick & Wolfe for Checquepoint Franchise Corporation**

**Judy Grundy**, Trademark Examining Attorney, Law Office 106  
(Mary Sparrow, Managing Attorney)

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Before Seeherman, Quinn and Hairston, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Checquepoint Franchise Corporation has appealed from the final refusal of the Trademark Examining Attorney to register WORLDCASH as a mark for "banking and financial services; namely, currency exchange and advise [sic] services; issuing and redemption of travellers cheques; electronic funds transfer; cashing of personal cheques;

[and] credit card services" in Class 36.<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 mark WORLDCASH and design, shown below,

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<sup>1</sup> Application Serial No. 75/281,588, filed April 25, 1997, asserting first use in 1990 and first use in interstate commerce in 1990. It is noted that the drawing page of the application states that "applicant has a bona fide intention to use the mark in commerce" This statement was apparently included because applicant, which is a Belgium company, asserted a Section 44(d) claim of priority based on a UK application. The Examining Attorney did consider the reference to a bona fide intention to use the mark as being inconsistent with the statement in the application, and treated the application, which was accompanied by specimens, as being based on use in commerce.

It appears that applicant has used the British spelling for its identification of services. We therefore read the word "advise" as used in the identification to mean "advice" as that word is spelled in American English, and to read "cheque" as "check." It is suggested that, should applicant prevail in its appeal, it submit an amendment of its identification to reflect the common U.S. spellings. Further, applicant must submit the serial number of the UK application on which its claim of priority is based.

The original application also included goods in Class 16, and registration was refused on a number of grounds in connection with this class. Applicant filed its notice of appeal solely with respect to the Class 36 services, stating that it was deleting Class 16 from the application.

and registered<sup>2</sup> for, inter alia,

banking services, not offered to the general consuming public, related to international cash management for clients with accounts in several countries, namely, sales credit financing and credit risk insurance, factoring, issuing of credit cards and credit card services, billing and debt collection services, recovery of debts, financial management services, brokerage and underwriting of stocks and bonds services, electronic banking, real estate management, real estate and mortgage agencies services, insurance brokerage, investment management and consulting services (Class 36)<sup>3</sup>

that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.<sup>4</sup>

Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

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<sup>2</sup> Registration No. 1,531,688, issued March 28, 1989; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>3</sup> The cited registration also includes goods and services in Classes 9, 16 and 35 for computer programs, computer program manuals and accounting, bookkeeping, management consultation and data processing services, all of which are "related to international cash management for clients with accounts in several countries." Because the Examining Attorney has discussed only the Class 36 services in the section of her brief dealing with the factor of the similarity of the goods/services, we have focused our discussion on those services as well.

<sup>4</sup> The final Office action also required a declaration pursuant to Trademark Rule 2.71(b)(1). Applicant submitted such a declaration with its appeal brief, and the Examining Attorney, in her brief, accepted the declaration. Accordingly, this issue is not before us.

With its brief applicant has submitted a printout from its website, and promotional literature. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. Applicant's submissions are manifestly untimely and, because the Examining Attorney did not discuss them in her brief or otherwise indicate that she consented to their being made of record, we have not considered them.

We affirm the refusal of registration.

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See, **Federated Food, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the marks, they convey the same commercial impression. Applicant's mark is WORLDCASH; the cited mark is WORLDCASH with the design of a globe. Although the globe is a noticeable part of the registrant's mark, it does not serve to distinguish the marks because it reinforces the connotation of the word portion. Further,

although, as both applicant and the Examining Attorney have acknowledged, marks must be compared in their entireties, 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, the word portion of the cited mark is the dominant part because it would be used by purchasers to call for the registrant's services. Thus, it would make a greater impression on purchasers, and is the portion which is more likely to be remembered. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987).

Applicant also argues that its mark differs from the registrant's mark because its mark is depicted in block letters, while the term WORLDCASH in the cited mark is shown in stylized lettering. However, applicant has applied for its mark in a typed drawing form, which means that a registration would not be limited to a particular style of lettering. If a registration were to issue for applicant's mark, the protection to be accorded it would include stylization similar to that in the cited registration.

With respect to the services, both applicant's identification of services and that of the registrant

include credit card services and electronic banking. Applicant's identification uses the phrase "electronic funds transfer," but this is clearly encompassed within the more general "electronic banking." It is true that the registrant's services are specifically limited to "banking services not offered to the general consuming public which are related to international cash management for clients with accounts in several countries." However, because applicant's services are not restricted as to customers and channels of trade, we must assume that, at least for some of the services, they would include the clients described in the cited registration. For example, the "electronic funds transfer" (i.e., electronic banking) identified in applicant's application could be used in connection with international cash management for clients with accounts in several countries.

Applicant has asserted that its mark is used in connection with currency exchange services which are directed toward individual consumers, such as travelers who need to obtain foreign currency for travel abroad, or who need to transfer funds in their personal banking accounts. However, its identification is not so limited, and it is a well established principle that the question of likelihood of confusion in an ex parte proceeding must be determined

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on the basis of the identification of goods set forth in the subject application and cited registration. **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976).

Therefore, whatever actual differences there may be between applicant's services, channels of trade, and classes of customers and those of the registrant, to the extent that these differences are not reflected in the respective identifications, they cannot be considered.

Applicant has also asserted that the consumers for applicant's and registrant's services are sophisticated. We agree that banking services are not impulse purchases and that clients for international cash management banking services are discriminating and sophisticated purchasers. However, because of the similarities of the marks and the services, even careful and sophisticated purchasers are likely to believe that these marks are variants of each other, and that both WORLDCASH per se and WORLDCASH with a globe design identify services emanating from a single source.

Finally, applicant asserts that it and the registrant have used their marks concurrently without any evidence of actual confusion, and that this shows that confusion is not likely to occur. We are not persuaded by this argument. Applicant has not provided any evidence as to the extent of

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its use, nor is there any evidence as to the registrant's use, such that we can determine whether there has been an opportunity for confusion to occur. Nor have we any information as to whether the registrant has encountered any confusion. Most importantly, it appears from applicant's assertions and evidence that it is primarily engaged in "retail-type currency exchange." However, because we must determine the question of likelihood of confusion based on the identification of services set forth in the application, applicant's experience regarding confusion with respect to its more limited activities does not indicate whether confusion is likely with respect to the broader services identified in its application.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

T. J. Quinn

P. T. Hairston  
Administrative Trademark Judges  
Trademark Trial and Appeal Board