

7/27/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11  
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
Trademark Trial and Appeal Board  
\_\_\_\_\_

In re Set Secure Electronic Transaction LLC  
\_\_\_\_\_

Serial No. 75/326,191  
\_\_\_\_\_

David S. Fleming and Eric W. Gallender of Brinks, Hofer,  
Gilson & Lione for Set Secure Electronic Transaction LLC.

Darshini Satchi, Trademark Examining Attorney, Law Office  
111 (Craig Taylor, Managing Attorney).  
\_\_\_\_\_

Before Hohein, Wendel and Drost, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Set Secure Electronic Transaction LLC<sup>1</sup> has filed an  
application to register the mark SET SECURE ELECTRONIC  
TRANSACTION and design, as depicted below, for "computer  
consulting services regarding development and testing of  
software developed by others, in the fields of encryption

\_\_\_\_\_  
<sup>1</sup> The application was originally filed by Mastercard  
International Inc. and Visa International Service Association and  
was subsequently assigned to Set Secure Transaction LLC. The  
assignment was recorded by the Assignment Branch on August 11,  
1998 at reel 1767, frame 795.

**Ser No.** 75/326,191

and protection of information, banking, credit, debit and payment services, and funds transfers."<sup>2</sup>

Registration has been refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the SET and design mark, as depicted below, which is registered for "computer consultation, programming and software design for others; up-dating of computer software; and design of computer systems for others."<sup>3</sup>

This refusal has been appealed and applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

---

<sup>2</sup> Serial No. 75/326,191, filed July 17, 1997, based on an allegation of a bona fide intention to use the mark in commerce. A disclaimer has been made of the words SECURE ELECTRONIC TRANSACTION.

<sup>3</sup> Registration No. 1,947,418, issued January 9, 1996, claiming first use dates of January 13, 1993.

For the sake of completeness, we note that, initially, registration had also been refused under Section 2(d) on the basis of the mark SET and design, as depicted below, which is registered for "software development services."<sup>4</sup>

This refusal was withdrawn, however, by the Examining Attorney in her appeal brief.<sup>5</sup>

At the time of appeal, there was also an outstanding requirement that applicant enter a disclaimer of the wording SECURE ELECTRONIC TRANSACTION. Up until this point, applicant has agreed only to a disclaimer of ELECTRONIC TRANSACTION. Applicant in its appeal brief, however, stated that it had decided to comply with the full disclaimer requirement and entered a disclaimer of SECURE ELECTRONIC TRANSACTION. Accordingly, the only issue for our consideration is the Section 2(d) refusal based on Registration No. 1,947,418.

---

<sup>4</sup> Registration No. 1,999,165, issued September 10, 1996, claiming first use dates of August 1, 1988.

<sup>5</sup> We note that this case was reassigned to a new Examining Attorney for purposes of preparing the appeal brief.

We make our determination of likelihood of confusion on the basis of the *du Pont*<sup>6</sup> factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we are guided by the well established principle that although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a

---

<sup>6</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods and/or services and thus it is the word portion that is accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

Applying these principles, we are in agreement with the Examining Attorney that the dominant portion of both applicant's and registrant's marks is the term SET. While applicant argues that the most visually commanding portion of applicant's mark is the phrase SECURE ELECTRONIC TRANSACTION, the question is not the amount of space occupied by a portion of a mark but rather the trademark significance of this portion. Here the phrase SECURE ELECTRONIC TRANSACTION has been acknowledged by applicant to be descriptive of its services by applicant's acquiescence in a disclaimer of the phrase. As a descriptor of applicant's services, it has but minimal import to purchasers as an indication of a particular source of these services. The term SET is instead the portion which points to the source of the services, and thus functions as the dominant portion of applicant's mark.

While applicant also places great significance on the visual differences of the designs in applicant's and registrant's marks, we find the designs not to be so distinctive as to result in overall commercial impressions which will distinguish the marks in the minds of purchasers, especially over a period of time. Purchasers will still refer to the services by the term SET. In fact, the "setting sun" of registrant's mark may well serve to re-enforce the impression created by the term SET. As for applicant's design, a rectangle is a frequently used border of minimal significance and the five-sided figure around the term SET is no more than barely suggestive of a "shield device," as contended by applicant. Clearly there is no strong impact made by the design of applicant's mark, as would be remembered over time so as to distinguish applicant's mark in the minds of purchasers. Despite the obvious differences in the marks when viewed in their entireties in appearance and sound, we find the overall commercial impressions of both to be dominated by the term SET and thus to be highly similar.

Turning to the services involved, we note that as a general principle, the issue of likelihood of confusion must be determined on the basis of the services as identified in the application and in the cited

registration, rather than on the basis of any evidence showing what the services are in actual practice. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); CBS, Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Here applicant's services have been narrowly recited as computer consulting services regarding development and testing of software of others in certain specialized fields. On the other hand, registrant's services, in relevant part, are broadly recited as "computer consultation, programming and software design for others; updating of computer software." There is no limitation as to the field or fields to which these services are directed. While applicant has introduced evidence from registrant's website which applicant claims shows that registrant sells software exclusively to ophthalmologists which is designed to act as a billing, inventory and patient-date tracking database, and further claims that it has confirmed this limitation of registrant's services by means of professional investigators, any evidence of this nature is irrelevant to our determination of a likelihood of confusion. Looking solely to the services as identified in the registration, we find no restrictions as to fields of operation or types of purchasers. Registrant's services

cover computer consulting services in general, and software design and updating of software as well. As such, the services of registrant clearly encompass the specific computer consulting services of applicant.

While applicant correctly points out that there is no per se rule in cases involving computer or software related goods, the fact remains that if computer goods or services are to be distinguished and similar marks allowed to be registered therefor, the distinctions in these goods or services must be fully set forth in the identifications thereof. Although applicant in this case may have particularly defined its services, registrant's services are not so specifically identified and thus registrant's services cannot be restricted to any particular field.<sup>7</sup>

In a similar vein, if there are no restrictions in the application or registration as to channels of trade, the parties' services must be assumed to travel in all the normal channels of trade for services of this nature. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *Canadian Imperial Bank v. Wells Fargo Bank*, *supra*. The cited registration contains no

---

<sup>7</sup> We note that applicant has a potential remedy at hand, namely, the filing of a petition to partially cancel the registration under the provisions of Section 18 of the Trademark Act.

limitations and thus registrant's services cannot be restricted to any specialized channels of trade or particular type of purchasers, but rather must be assumed to encompass those of applicant. No distinctions can be made on this basis.

Accordingly, the potential purchasers for the services of both must be assumed to be the same. Although applicant argues these would all be sophisticated customers who would be likely to exercise a high degree of care in purchasing the services, even sophisticated purchasers are not immune to source confusion when highly similar marks are used in connection with the involved services. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999). Two sources offering computer consulting services in the same field under similar SET marks would lead to a likelihood of confusion on the part of even sophisticated purchasers.

Applicant has also introduced as a factor for consideration the use by third parties of marks based on the formative SET or consisting of the term SET alone for goods or services in the same general field. While applicant has made of record copies of numerous third-party registrations, applicant has made no evidence of record of actual use of any of these marks. As has often been stated, copies of third-party registrations in themselves

carry little weight in determining likelihood of confusion. They are not evidence of use of the marks or that consumers are familiar with the marks so as to be accustomed to the existence of similar marks in the marketplace. See *Hilson Research Inc. v. Society for Human Resource Management*, *supra*, and the cases cited therein.

Even if we had evidence of actual use, the majority of these third-party marks are simply composite terms which include the letters SET and do not create the same commercial impression as the term SET alone. As such, these marks are irrelevant. Even those few marks which consist of the term SET alone (applicant points to a total of six) are of little significance, in that although these may be registered for goods in the same broad field, such as electronic devices or computer software, none is registered for services similar to those involved here.

Nor can any correlation be drawn between the various SET marks such that we might determine that the term has a commonly understood meaning in the relevant field and the marks have been chosen to convey this meaning. If this were the case, which it is not, then we might be able to conclude that marks of this nature are inherently weak and that only slight differences would be sufficient to distinguish one from another. See *In re Melville Corp.*, 18

**Ser No.** 75/326,191

USPQ2d 1386 (TTAB 1991). But applicant has clearly not shown this to be the situation here.

The only truly relevant third-party registrations are the previously cited registration which was withdrawn by the Examining Attorney on appeal and the cited registration. Here we have evidence of the registration of the mark SET by two separate entities for computer consulting services. Although applicant argues that its mark should be allowed to coexist with these two registrations, we do not agree. In the first place, we do not have the file histories before us of the two registrations and thus cannot make a full assessment of the reasons for the coexistence of these two marks. In any event, the prior decision of an Examining Attorney on the registrability of the two marks over one another is in no way controlling on our present decision. See *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882 (TTAB 1988). It is well settled that each case must be decided on its own facts. *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The other factor which applicant introduces is its evidence of the lack of any actual confusion despite the fact that there has been coexistent trademark usage of

applicant's and registrant's mark over the past four years. We can give little weight to this fact, however, under the present circumstances. In the first place, registrant has not had the opportunity to be heard from on this point. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). Second, in view of the apparent narrow scope of registrant's present use of its mark, as opposed to the scope of the services for which it is registered, the question arises whether there has been any real opportunity for confusion, at this point in time. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Whatever the case, in the final analysis, the issue is not actual confusion, but rather likelihood of confusion.

Accordingly, on the basis of the similarity of the commercial impressions created by applicant's and registrant's marks and the fact that applicant's services are fully encompassed by the "computer consultation" services of registrant, we find confusion likely with the contemporaneous use of the marks.

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

**Ser No.** 75/326,191