

10/31/01

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

Hearing:  
July 26, 2001

Paper No. 19  
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Palladium Company L.P.  
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Serial Nos. 75/359,288 and 75/371,972<sup>1</sup>  
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Susan J. Kohlmann of Pillsbury Winthrop LLP for Palladium Company L.P.

John M. Gartner, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney)  
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Before Seeherman, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Palladium Company L.P. has filed applications to register the mark PALLADIUM (typed drawing)<sup>2</sup> for "leasing and management of retail commercial space" in Class 36 and "development of retail commercial space" in Class 37

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<sup>1</sup> The Board, in its order of September 26, 2000 granted applicant's motion for consolidation of these two cases for purposes of appeal.

<sup>2</sup> Serial No. 75/359,288, filed September 18, 1997, claiming a first use date of as early as June 24, 1997 and a first use in commerce date of as early as June 25, 1997.

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and the mark PALLADIUM (in the stylized form shown below)<sup>3</sup>

for "leasing and management of retail commercial space, namely, entertainment-enhanced retail developments" in Class 36 and "development of retail commercial space, namely entertainment-enhanced retail developments" in Class 37.<sup>4</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark PALLADIUM INCORPORATED and design as shown below, which is registered for "services as a registered investment advisor for portfolio strategy, asset management, dispositions, acquisitions, investment restructuring, value enhancement, real estate valuation and financing for commercial and residential real estate owners and investors."<sup>5</sup>

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<sup>3</sup> Serial No. 75/371,972, filed October 14, 1997, claiming a first use date of as early as June 24, 1997 and a first use in commerce date of as early as June 25, 1997.

<sup>4</sup> Applicant amended the recitation of services in Serial No. 75/371,972 but made no similar amendment in Serial No. 75/359,288.

<sup>5</sup> Registration No. 1,893,336, issued May 9, 1995, Section 8 affidavit filed. A disclaimer has been made of the word INCORPORATED.

The refusal has been appealed. Both applicant and the Examining Attorney have filed briefs and participated in an oral hearing.<sup>6</sup>

As a preliminary matter, the Examining Attorney has objected to Exhibits A, B, and D, matter which is attached to applicant's appeal brief, as untimely presented new evidence. The objection is sustained. Pursuant to Trademark Rule 2.142(d) the record in an application should be complete prior to the filing of an appeal. Thus, as stated therein, the Board "will ordinarily not consider additional evidence filed with the Board" after the appeal has been filed. We find no reason to make any exception here. Accordingly, Exhibits A, B and D have been given no consideration.

The Examining Attorney has also objected in his appeal brief to the third-party registrations which applicant had listed in its first response in each application as being improperly submitted as evidence. The Examining Attorney in Serial No. 75/359,288 had previously objected to this list of registrations, noting that only soft copies of registrations, or the complete electronic equivalents

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<sup>6</sup> The cases were newly assigned to a third Examining Attorney for purposes of appeal. The two cases were initially handled by the same Examining Attorney, but Serial No. 75/359,288 was subsequently assigned to a second Examining Attorney.

thereof obtained from the Office automated systems, are sufficient for purposes of making third-party registrations of record. The objection is proper and thus no consideration has been given in Serial No. 75/359,288 to the registrations listed by applicant. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). While the Examining Attorney for Serial No. 75/371,972 did not object to the listing and hence we consider the objection waived in this application, we find the third-party registrations irrelevant, because they are for completely unrelated goods and/or services.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>7</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. 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).

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<sup>7</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking first to the respective marks, we are guided by the well-established principle that although the marks must be considered in their entireties, 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). 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 generally the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers because it is by the word portion that they refer 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).

Here, registrant's mark PALLADIUM INCORPORATED and design is dominated by the term PALLADIUM. The disclaimed word INCORPORATED has little or no trademark significance. The design portion is not particularly distinctive and it

is the term PALLADIUM that would be much more likely to be remembered by customers and used in referring to registrant's services. Applicant's marks consist solely of the term PALLADIUM. While the stylized version may employ the letter "V" rather than the letter "U", the commercial impression remains that of the word PALLADIUM.

Accordingly, the marks of applicant and registrant are very similar in sound and appearance, with the dominant portions being identical in sound and virtually identical in appearance, the only difference being the letter "V" in applicant's stylized version of its mark. Even the type styles employed by registrant and applicant in its stylized version are similar. Furthermore, and contrary to applicant's arguments, we find the connotation of the word PALLADIUM to be the same for both marks, whether used with the real estate development, leasing and management services of applicant or the investment advisory services of registrant. The word retains its normal dictionary meaning, regardless of the services with which it is used.<sup>8</sup> Thus, the overall commercial impressions of the marks of applicant and registrant are highly similar.

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<sup>8</sup> We take judicial notice of the following definition for the word "palladium"

something that affords effectual protection or security : SAFEGUARD  
*Webster's Third New International Dictionary* (1993).

Applicant argues that, as used in connection with registrant's services, the term PALLADIUM is a weak mark with highly suggestive references to the safe and secure investment advice which registrant provides to its customers. While the term PALLADIUM may imply some degree of security or protection afforded by the services with which it is being used, whether registrant's or applicant's, we do not believe the suggestive significance of the term would be any more than minimal to prospective customers. We certainly do not find any such degree of suggestiveness in the term as would require that a limited scope of protection be given to registrant's mark. Applicant has failed to make any evidence of record which might lead us to conclude otherwise.

Applicant's further contention that the mark PALLADIUM is widely used by others in the real estate, personal finance and related fields is wholly unsubstantiated by any evidence properly made of record. Thus, the factor of the use by others of similar marks for similar services plays no part in our decision here.

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 applications and in the cited

registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). It is not necessary that the services of the applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Applicant argues that the services of applicant are marketed very differently from those of registrant. Applicant's services are said to be offered only from its New York office and only to real estate investment funds, large corporations, corporate, government and union pension funds, banks and the wealthiest individuals. Applicant's typical investor is said to invest tens to hundreds of millions of dollars. Registrant, according to applicant, offers its services out of its Denver office to individual customers in a lower socioeconomic class who are seeking

investment advice with regard to a wide range of investment vehicles.

In the first place, both the cited registration and the registrations sought by applicant are geographically unrestricted. Whether or not the services of either applicant or registrant are presently being offered out of a single office is irrelevant to our determination of likelihood of confusion. Furthermore, there are no limitations or restrictions in the identification of the services of either applicant or registrant that would reflect the difference in customers which applicant is stressing. The real estate services of applicant as set forth in its applications are available to all types of commercial real estate owners and investors. The investment advisory services of registrant are similarly available to all classes of investors, with particular application of its investment advisory services for real estate valuation and financing for commercial real estate owners and investors. No viable distinctions can be drawn between the marketing styles or classes of customers when the services are considered as identified in the applications and the cited registration. There is no reason why the same commercial real estate investor who invests in one of applicant's developments or leases real

estate from applicant might not turn to registrant for investment advice, and specifically with respect to these real estate investments.

Considering the services themselves, we agree with applicant that the services are not identical. The issue, however, is whether an interrelationship exists between the services such that they might be encountered by the same investors or real estate owners who would have reason to believe that the services emanate from the same source, if similar marks are used in connection therewith. For the reasons given above, we find that such a relationship exists.

In addition, in Serial No. 75/359,288, the Examining Attorney, in his action of February 22, 2000, has made of record copies of several third-party registrations showing registration of the same mark by a single entity for both real estate development and/or leasing and management services and for investment advisory services, including real estate investment counseling, financial advisory services and the like. While these registrations are admittedly not evidence of use of the marks in commerce, they are sufficient to suggest that these are services which may be offered by a single entity and marketed under the same mark. See *In re Albert Trostel & Sons Co.*, *supra*,

In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988). The Examining Attorney has also made of record a few excerpts of articles from the NEXIS database in which reference is made to companies which offer both investment advisory services and real estate development and management services. Not only does this evidence demonstrate that a relationship exists between the services and that the services of both applicant and registrant may well be offered in the same channels of trade, but also that the services might well be mistakenly believed to emanate from the same source, if highly similar marks are used therewith.

We also find applicant's arguments as to the sophistication of both its and registrant's customers to be to no avail. Even sophisticated customers are not immune to source confusion. This is especially true when the marks are substantially identical in commercial impression, as is the case here, and the services are closely related. See In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999).

As a final factor to be considered, applicant raises the lack of evidence of any actual confusion, even though applicant has been using its marks since October 1997. We can give little weight to this fact, however, under the

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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 geographical scope of applicant's and registrant's present use of their marks, as opposed to the unlimited scope of the applications and registration, the question arises as to 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, the issue is not actual confusion, but rather likelihood of confusion.

Accordingly, upon the basis of the highly similar commercial impressions created by the respective marks, the interrelationship which has been shown to exist between the respective services, and the common channels of trade, we find that confusion is likely.

Decision: The refusal to register under Section 2(d) is affirmed in both Serial Nos. 75/359,288 and 75/371,972.

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