

Hearing:
May 12, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Riskwise L.L.C.

Serial No. 76007040

Carla C. Calcagno of Rothwell, Figg, Ernst & Manbeck.

Catherine Pace Cain, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Hanak, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Riskwise L.L.C. (applicant) seeks to register in typed
drawing form CHARGEBACK DEFENDER for "providing credit
verification and risk assessment services, namely,
providing information on the likelihood of a credit card
transaction being charged back to a merchant." The
application was filed on March 22, 2000 with a claimed
first use date of January 1, 1999.

Citing Section 2(d) of the Trademark Act, the
Examining Attorney refused registration on the basis that

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applicant's mark, as applied to applicant's services, is likely to cause confusion with three marks owned by the same entity. The first is BANKRUPTCY DEFENDER (2,352,406) registered for "financial forecasting services, financial research services and providing financial information regarding the likelihood of individuals declaring bankruptcy." The second is COLLECTIONS DEFENDER (2,379,978) registered for "financial forecasting, financial research, and financial information services to card issuers regarding the likelihood of future payments on delinquent accounts." The third is ATTRITION DEFENDER (2,496,603) registered for "providing financial forecasting, financial research, and financial information services by electronic means to card issuers regarding the likelihood that particular card holders will drop from the issuer's portfolio."

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and were present at a hearing held on May 12, 2004.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d

1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the marks, obviously there is some similarity in that all four marks contain the word DEFENDER. However, this is the only point of similarity. Each of the four marks begin with words which are very different in terms of visual appearance, pronunciation and meaning. This is "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1897 (TTAB 1988). In short, there is only limited similarity between applicant's mark and the three registered marks.

At pages 11 and 12 of her brief, the Examining Attorney makes the following comments: "It is assumed that consumers of the services provided under the mark COLLECTIONS DEFENDER would also be aware of the services under ATTRITION DEFENDER and vice versa ... [and that] it is also assumed that these consumers would be aware of the services provided with BANKRUPTCY DEFENDER." (emphasis added). Continuing, the Examining Attorney surmises that because registrant owns registrations for three marks each

containing the word DEFENDER that "therefore consumers are likely to think that [applicant's] mark CHARGEBACK DEFENDER, for financial forecasting services, is used by the registrant to target another market sector." (Examining Attorney's brief page 12). (emphasis added). While never using these words, the Examining Attorney is in essence making a "family of marks" argument. This doctrine holds that "even though [an applicant's] mark may not be that close to any one member of the [registrant's] family, it [applicant] may have used the distinguishing [registrant's] family 'surname' or characteristic so as to be likely to cause confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 23:61 at page 23-137 (4th ed. 2002). However, in order to prove the existence of registrant's purported family of marks, the Examining Attorney would have to establish that registrant's family members have been so extensively used and advertised together such that the family surname, in this case DEFENDER, "is recognized by consumers as an identifying trademark [or service mark] in and of itself when it appears in a composite." Id. In this case, the Examining Attorney has utterly failed to prove that registrant has a family of marks. Examining Attorney has not proven that any one of registrant's three marks is in use. Moreover,

the Examining Attorney has certainly not proven that any one of registrant's three marks has been extensively used and advertised. Finally, the Examining Attorney has most certainly not proven that registrant's three marks have been extensively used and advertised together such that the family surname DEFENDER is recognized as a service mark in and of itself. Indeed, the Examining Attorney concedes this total failure of proof when in her argument she merely states that it is assumed that consumers would be aware of all of registrant's three marks.

We now turn to a consideration of the relationship between applicant's services and registrant's services. The record reflects that the users of registrant's services are credit card issuers who seek information on the likelihood of individuals declaring bankruptcy, being delinquent in payments or discontinuing use of issuers' cards. Indeed, the registrations for COLLECTIONS DEFENDER and ATTRITION DEFENDER specifically state that the services are provided "to card issuers."

On the other hand, applicant's customers are not card issuers, but rather are merchants who accept credit cards. Applicant provides to merchants information regarding the likelihood of whether a credit card holder will charge back to the merchant a credit card purchase.

In short, there is little if any overlap between registrant's customers and applicant's customers. Without any meaningful overlap, there simply can be no likelihood of confusion. Indeed, our primary reviewing Court found that there was no likelihood when the virtually identical marks (EDS and E.D.S.) were used on goods and services that were marketed to the very same companies because opposer had failed to prove that the same individuals in these companies purchased both opposer's goods and applicant's services. Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1391. ("Thus, although the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers."). To the extent that the registration for BANKRUPTCY DEFENDER does not contain explicit language limiting the users of the services to credit card issuers, by the same token, the Examining Attorney has failed to prove that there is customer overlap between providing financial information regarding the likelihood of individuals declaring bankruptcy (BANKRUPTCY DEFENDER) and providing information on the likelihood of a credit card transaction being

charged back to a merchant (CHARGEBACK DEFENDER). To the extent that there may be some slight customer overlap involving the services associated with these two marks, we note that our primary reviewing Court has stated that "we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." Electronic Design, 21 USPQ2d at 1391 (emphasis added).

Given the fact that applicant's mark is only slightly similar to registrant's three marks, and the fact that there is little if any customer overlap, we find that there exists no likelihood of confusion. This is particularly true given the fact that both registrant's services and applicant's services are not provided to ordinary consumers, but rather are provided to sophisticated credit card issuers and merchants. As has been said repeatedly, purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design, 21 USPQ2d at 1392.

Decision: The refusal to register is reversed.

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