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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Cardinal Financial Corp.*

Serial No. 75514741

Ralph M. Tener of McCandlish & Lillard, P.C. for *Cardinal Financial Corp.*

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before *Quinn, Hohein and Zervas*, Administrative Trademark Judges.

Opinion by *Hohein*, Administrative Trademark Judge:

Cardinal Financial Corp. has filed an application to register on the Principal Register the mark "CARDINAL BANK," in standard character form, for "banking services."¹

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 applied to its services, so resembles the mark "CARDINAL FINANCIAL COMPANY" and design, as shown below,



¹ Ser. No. 75514741, filed on July 2, 1998, which is based on an allegation of a date of first use anywhere and in commerce of June 8, 1998. The word "BANK" is disclaimed.

which is registered for "banking services, namely[,] mortgage bankers,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods or services at issue and the similarity or dissimilarity of the respective marks in their entireties.³

Applicant, in its initial brief, "submits that there is no likelihood of confusion between Applicant's mark and the mark CARDINAL FINANCIAL COMPANY [and design] because: (1) the presence of distinguishing components in the two marks outweighs and

² Reg. No. 2,216,820, issued on the Principal Register on January 12, 1999, which sets forth a date of first use anywhere and in commerce of August 1, 1987; combined affidavit §§8 and 15. The words "FINANCIAL COMPANY" are disclaimed.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." 192 USPQ at 29.

overcomes the similarity between them; (2) the services for which the Applicant uses its mark are sufficiently different from the services for which the cited mark is used to negate any likelihood of confusion; and (3) the absence of actual confusion between the parties for more than five years weighs heavily against such a finding." Turning to the first of such contentions, applicant argues in particular that, when the respective marks are considered in their entirety, it is apparent that (footnote omitted; underlining in original):

[T]he Applicant's mark contains the additional component BANK, and the cited mark contains the additional components, FINANCIAL COMPANY. In light of the clear and immediately perceived differences in appearance, sound, and meaning of these components, a striking difference between the overall impressions created by the two marks arises and overcomes the similarity of the shared component.

Distinguishing components are particularly significant when the shared component is a word in common English usage, such as CARDINAL. Since the public is used to seeing the word in other contexts, the public tends to look with heightened discrimination at commercial uses of the word and the components which accompany it.

The non-shared components are unusually strong distinguishers in the instant case because they both refer to separate, regulated industries which are restricted to their respective fields. A special federal or state charter is required for a bank, and separate, special licensing is required for ... mortgage services.

Because of the longstanding regulatory separation of the functions of banks and mortgage services, the public readily distinguishes between them. Virtually all consumers are familiar with what a bank is and does--and can readily distinguish banking services from mortgage services. As a

result, the distinguishing components in the marks in question are sufficient to negate any likelihood of confusion between the marks.

The Examining Attorney, on the other hand, maintains that when applicant's mark "CARDINAL BANK" and registrant's mark "CARDINAL FINANCIAL COMPANY" are considered in their entireties, the similarities therein "are sufficient to find a likelihood of confusion." Specifically, the Examining Attorney insists that because the "dominant part of each ... mark is the word 'cardinal,'" the respective marks are not only similar in sound, appearance, meaning and commercial impression, but "[w]ith the exception of the disclaimed portions of each ... mark and the slight design element in the registrant's mark, the marks ... are identical." As to applicant's argument that the disclaimed, generic terms therein preclude any likelihood of confusion, the Examining Attorney, citing *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997), notes that it "is well settled law that disclaimed matter is typically less dominant when comparing marks." Consequently, the Examining Attorney asserts that, "[i]n the instant case, the 'cardinal' portion of [each] ... mark is more significant in creating a commercial impression" and that, "[i]n fact, the word 'cardinal' in ... each ... mark is the component that distinguishes the marks" in terms of an indication of source or affiliation.

Furthermore, with respect to applicant's contention that because the public is used to seeing the word "CARDINAL" in other contexts, it "tends to look with heightened discrimination

at commercial uses of the word and the components which accompany it," the Examining Attorney points out that:

The applicant should note that when determining whether there is a likelihood of confusion ..., the question is not whether people will confuse the marks, but rather whether the marks will confuse the people into believing that the goods they identify emanate from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall commercial impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979) In the financial industry, it is customary for a bank to use multiple entity designations to identify several different financial services. If consumers heard the marks "Cardinal Bank" and "Cardinal Financial Company" used together in one sentence, they would be likely to believe the services they identify originate from the same corporate entity. Because of the tendency of the consuming public to have a general rather than a specific recollection of trademarks, it is more conceivable that the "cardinal" portion of the mark[s] will be used in calling for the services than the words "bank" or "financial company." Therefore, the dominant part of both ... mark[s] is the word "cardinal." The similarities of the marks portend a great likelihood of confusion as to the source of the [respective] services.

Applicant, in its reply brief, reiterates its assertions that because the average consumer knows the difference between a bank and a mortgage company, is aware that banks are government regulated, and is cognizant that a company which does not use the word "Bank" in its name is not a bank and is not

legally permitted to provide banking services, "the component 'Bank' in a service mark differentiates the owner very strongly from other non-bank services." Consequently, as noted previously, applicant contends that "[t]he average consumer does not expect the owner of a service mark that includes 'Financial Company' but not 'Bank' to be a bank" and, thus (underlining in original), "the non-shared components of the two marks are unusually strong distinguishers in the instant case because they both refer to separate, regulated industries which are restricted to their respective fields." In addition, applicant stresses the fact that registrant's mark "includes a bird perched in an enlarge letter 'C', horizontal lining, stylized letters, and three words, whereas the Applicant's mark is simply the two-word mark CARDINAL BANK in standard character format." Applicant urges, in view thereof, that given "the design difference and the differing textual components, the impression created by the two marks are significantly different."

We concur with the Examining Attorney, however, that when considered in their entirety, the marks at issue are so substantially similar as to be likely, if used in connection with the same or related services, to cause confusion or mistake or deception. While, as our principal reviewing court has noted, the marks at issue are to be considered in their entirety, including any design elements and/or generic matter, it is also the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less

weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is ... generic with respect to the involved ... services is one commonly accepted rationale for giving less weight to a portion of a mark" Id. Here, the dominant and distinguishing element of both applicant's "CARDINAL BANK" mark and registrant's "CARDINAL FINANCIAL COMPANY" and design mark is the arbitrary or fanciful word "CARDINAL," given the lack of source-indicative significance inherent in, respectively, the generic terms "BANK" and "FINANCIAL COMPANY," and the fact that the bird design in registrant's mark is clearly recognizable as a cardinal and thus merely serves to underscore the source-distinguishing term "CARDINAL."⁴ Moreover, although consumers would no doubt know, upon encountering applicant's mark, that the institution rendering applicant's banking services is indeed a commercial bank rather than some other kind of financial company, as could be the case with the mortgage banking services rendered under registrant's mark, it is still likely that consumers could reasonably believe, in light of the similarities in sound, appearance, connotation and overall commercial impression between the respective marks due to the shared term "CARDINAL," that the

⁴ As shown by the specimens of use, applicant likewise uses a bird design with its mark which is easily recognizable as a cardinal.

respective services have a common source or sponsorship if such services are otherwise commercially related.

Turning, therefore, to consideration of whether applicant's "banking services" are commercially related to registrant's "banking services, namely[,] mortgage bankers," applicant asserts in its initial brief that, except for "the fact that they both fall within what is generally referred to as the financial industry, there is little relationship" between such services. Specifically, as previously mentioned, applicant urges in its reply brief that:

[T]he owner of the cited mark is not legally qualified to provide the services the Applicant provides as a bank--and seeks registration for. Banking services may only be provided by chartered banks, whereas mortgage services may only be provided by licensed mortgage brokers. Thus, these separate and distinct services of the Applicant and the owner of CARDINAL FINANCIAL COMPANY would not create source confusion.

The Examining Attorney, however, contends that the services of the parties are commercially related "because 'banking services' and 'mortgage banking services' are offered by the same entities." "In fact," the Examining Attorney insists, "most banks offer mortgage banking services as a part of a wide mix of financial services." As support therefor, the Examining notes that he has made of record "several third[-]party registrations in which 'banking services' and 'mortgage banking services' appear under the same mark."

Aside from the fact that, as identified, applicant's "banking services" clearly encompass registrant's "banking

services, namely[,] mortgage bankers,"⁵ we agree with the Examining Attorney that the evidence of record supports a finding that such services are commercially related. In this regard, the Examining Attorney has made of record copies of approximately 30 use-based third-party registrations in which, in each instance, the same mark is registered for both "banking services" (or a variant thereof such as "banking and related financial services,"), on the one hand, and "mortgage banking services" (or an equivalent thereof such as "mortgage banking"), on the other. It is settled, in this regard, that while use-based third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, such registrations may nevertheless have some probative value to the extent that they serve to suggest that the goods and/or services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988). Here, the registrations introduced by the Examining Attorney serve to confirm the obvious, namely, that banking services, including mortgage banking services, are often available from the same source. Furthermore, applicant's advertising brochures, which were submitted as its specimens of use of its mark, list such mortgage banking services as "Commercial Mortgages" among the banking

⁵ While the word "bankers" in registrant's registration may be a typographical error, it is nonetheless plain that the banking services which "mortgage bankers" would offer are "mortgage banking services." Registrant's identification of services will thus be so construed.

services it offers its customers. The evidence of record thus shows that the respective services at issue herein are sufficiently related, in a commercial sense, that if rendered under the same or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

We accordingly conclude that consumers who are familiar or acquainted with registrant's "CARDINAL FINANCIAL COMPANY" and design mark for "banking services, namely[,] mortgage bankers," would be likely to believe, upon encountering applicant's substantially similar "CARDINAL BANK" mark for "banking services," that such commercially related services emanate from, or are sponsored by or affiliated with, the same source. Even those consumers, for example, who happen to notice or appreciate that applicant's mark serves to identify a commercial bank while registrant's mark identifies some other type of financial institution could reasonably believe that registrant's mortgage banking services are rendered by a subsidiary of, or other entity affiliated with, the same firm which offers applicant's banking services.

Applicant, asserting in its initial brief that its "first use date is June 8, 1998" while, as set forth in the cited registration, registrant's alleged "first use date is August 1, 1987," argues nevertheless that confusion is not likely because, "[d]uring more than five years of concurrent use, the Applicant has not been made aware of any confusion between its services [under its mark CARDINAL BANK] and those identified under

[registrant's mark] CARDINAL FINANCIAL COMPANY." However, as the Examining Attorney correctly points out in his brief:

[T]he applicant has presented no evidence of lack of [actual] confusion. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein.

Moreover, even if, as urged by applicant in its initial and reply briefs, we were to regard as a "factual admission" by registrant the statement, in a copy made of record by applicant of an unsigned draft of a proposed consent agreement, that "[t]he parties are not aware of any instances of actual consumer confusion, mistake, or deception between their respective marks" for the services at issue herein, such would not suffice to preclude a finding of likelihood of confusion. The reason therefor is that while it is indeed the case that evidence of the absence of any instances of actual confusion over a significant period of time is a *du Pont* factor which is indicative of no likelihood of confusion, such is a meaningful factor only where the record demonstrates appreciable and continuous use by applicant of its mark in the same markets as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Here, however, there is no such evidence.

Lastly, related to the above, applicant points to its negotiations with registrant (Cardinal Financial Company, Limited Partnership, composed of Cardinal Mortgage, Inc. and Cardinal Financial Corp.) as to a possible consent agreement, arguing in its initial brief that (underlining in original):

It is significant that Cardinal Financial Company, L.P. has never objected to the Applicant's use of the mark CARDINAL BANK, but has instead requested that the Applicant change its corporate name to delete the word "Financial" from it. Thus, the concern expressed by Cardinal Financial Company, L.P. does not relate to a likelihood of confusion between the Applicant's mark CARDINAL BANK and any mark belonging to Cardinal Financial Company, L.P.

Applicant maintains that because "the owner of [the mark] CARDINAL FINANCIAL COMPANY has not objected to Applicant's use of [the mark] CARDINAL BANK," such fact "weighs heavily against a finding of likelihood of confusion."

The Examining Attorney, on the other hand, acknowledges in his brief that, "[n]ormally, consent agreements should be given great weight because they are executed by those most familiar with use of the services in the marketplace and most interested in precluding confusion." In this case, however, the Examining Attorney argues that "[t]he applicant's unexecuted consent agreement is tantamount to a naked consent and has no probative value on the issue of actual confusion." In addition, the Examining Attorney notes that "applicant concedes that its prior settlement discussions with the registrant reached an impasse"; that "to date, no consent agreement has been reached";

and that, "[i]n light of these circumstance, it is possible that the registrant may believe that source confusion is likely."

Applicant, however, further asserts in its reply brief that, "[p]erhaps even more significantly, the [proposed] consent agreement, as edited by counsel for the owner of the cited mark, also states" that "[t]he parties agree that there is no likelihood of confusion, mistake, or deception resulting from the use and registration of their respective marks." Applicant urges that "[t]he foregoing statement, which counsel for the owner of the cited mark ... offered in that form for signature by the parties, is a factual admission by the owner of the cited mark and should be afforded the same weight as if the consent agreement had been executed."

We disagree with applicant's contentions. As is clear from the affidavit of applicant's counsel and the copy of the revision to the proposed consent agreement (both of which were submitted with applicant's request for reconsideration of the final refusal), the so-called "factual admission" by registrant is expressly contingent upon applicant's agreement not only to delete the word "Financial" from its corporate name but also to amend its application "to expressly delineate that its services do not include 'mortgage banking services.'" Applicant, as the record makes plain, has declined to so change its corporate name and has not so amended its application. There consequently has been no meeting of the minds between applicant and registrant; there is no detailed consent agreement which has been executed by such parties; and there is no "factual admission" by registrant

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that contemporaneous use by applicant of its substantially similar "CARDINAL BANK" mark in connection with its commercially related "banking services" is not likely to cause confusion with registrant's use of its "CARDINAL FINANCIAL COMPANY" and design mark in connection with its "banking services, namely[,] mortgage bankers."

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