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**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

July 28, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Financial Foundations, Inc.

Serial No. 76321086

Jenifer E. Haeckl of Mirick O'Connell for Financial Foundations, Inc.

Dawn Feldman Lehker, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Seeherman, Hohein and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Financial Foundations, Inc. has filed an application to register on the Principal Register in standard character form the mark "THE FINANCIAL FOUNDATION ASSESSMENT" for "financial planning services" in International Class 36.¹

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 "FINANCIAL FOUNDATION," which is registered on the Principal

¹ Ser. No. 76321086, filed on October 3, 2001, which is based on an allegation of a bona fide intention to use such mark in commerce. The words "FINANCIAL" and "ASSESSMENT" are disclaimed.

Register in standard character form for "financial services, in the nature of financial planning services" in International Class 36,² 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 Here, inasmuch as applicant's "financial planning services" are legally identical to registrant's "financial services, in the nature of financial planning services,"⁴ the primary focus of our inquiry is on the similarities and

² Reg. No. 2,030,060, issued on January 14, 1997, which sets forth a date of first use anywhere and in commerce of April 29, 1988; combined affidavit §§8 and 15.

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.

⁴ Applicant, we note, does not maintain otherwise in its brief.

dissimilarities in the respective marks when considered in their entireties.

Turning, therefore, to consideration of the marks at issue, we note as a preliminary matter that, "[w]hen marks would appear on virtually identical ... services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). See also *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980). Applicant, nonetheless, contends in its brief that while, among other things, the respective marks "share the term 'financial foundation', the overall sight, sound and meaning of the ... marks are otherwise dissimilar."⁵ Thus, according to applicant, because "[t]here is no other commonality between these two marks," "the remainder of the Applicant's mark

⁵ Applicant, in particular, asserts that such is "especially" the case inasmuch as the mark in a third-party's application, which had been initially cited as a possible bar to applicant's application, was withdrawn as such a bar "in the interim" and is "now Registration No. 2,715,007." Reg. No. 2,715,007, which issued on May 13, 2003 from an application filed on January 12, 2001, is for the mark "THE FINANCE FOUNDATION" and design, as shown below,



for "educational services, namely, arranging and conducting colloquia, seminars, and conferences in the financial, money exchange, and financial investment fields; [and] educational services, namely, providing classes, seminars and conferences in the fields of financial money exchanges and financial investments" in International Class 41. Such registration, besides being for a specifically different mark and distinctly different services from those at issue herein, additionally contains a disclaimer of the words "THE FINANCIAL FOUNDATION" and sets forth the following description: "The mark in part is a stylized letter 'F'."

is wholly different in terms of appearance, sound, meaning, connotation and commercial impression" from registrant's mark, such that confusion is not likely.⁶ In particular, applicant maintains that "[t]he words 'The' and 'Assessment' are as much a part of the Applicant's mark as the words 'Financial Foundation', and vice versa, and the Applicant's mark, like all marks, may not be dissected and must be considered in its entirety."

The Examining Attorney, on the other hand, argues in her brief that the marks at issue "both contain the terms 'financial foundation,'" which she asserts "is the dominant element in the mark[s], regardless of the fact that the applicant has disclaimed the term 'financial.'" Citing, *inter alia*, *In re G. D. Searle & Co.*, 360 F.2d 650, 149 USPQ 619 (CCPA 1969), she urges that because "[t]he definite article 'the' is devoid of any trademark significance," "[i]gnoring the definite article 'the'

⁶ Applicant also mentions that, as stated during the prosecution of its application, it is the owner of the following registrations:

[The] ... following is a list of other marks of the Applicant with similar services ... which have been allowed by the United States Patent and Trademark Office: THE PERSONAL FOUNDATION BUILDER, U.S. Registration No. 2,600,976, THE FINANCIAL SOLUTIONS TOOLBOX, U.S. Registration No. 2,639,159, and the PERSONAL FOUNDATION PLAN, U.S. Registration No. 2,680,186. All three registrations are for "financial planning services".

It is noted, however, that none of the above registrations is for a mark containing the expression "FINANCIAL FOUNDATION," which is the case with the marks herein. Furthermore, as our principal reviewing court observed in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991). Applicant's prior registrations, therefore, do not justify allowance of the registration which it presently seeks.

in the applicant's mark is appropriate." Moreover, inasmuch as the record contains a definition from The American Heritage Dictionary of the English Language (3rd ed. 1992) which defines "assessment" as a noun meaning, in relevant part, "1. The act of assessing; appraisal," the Examining Attorney, referring also to a definition of "assesses" which she made of record from the same dictionary, contends that (footnotes omitted):

The term "assessment" is descriptive of the applicant's services. The applicant has agreed to disclaim the term "assessment" in the proposed mark, which is evidence of the fact that the term is descriptive when used in connection with the applicant's services. In addition, the examining attorney attached a dictionary definition of the term ["assesses"] which includes the definition "to determine the value, significance, or extent of; appraise["]. The applicant must determine the value of a client's portfolio in order to do any financial planning for the client. The term describes an aspect of the applicant's services. As was discussed in the office action dated, July 29, 2005, disclaimed matter is typically less significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 1056, 224 USPQ 749 (Fed. Cir. 1985); and *in re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). . . . The examining attorney did not ignore the disclaimed portion of the proposed mark. The disclaimed portion appears to be less significant not only because the wording has been disclaimed, but also because the term "The Financial Foundation" modifies the term "assessment." In this instance it is clear that the "assessment" is provided by "The Financial Foundation."

We agree that contemporaneous use of the respective marks in connection with financial planning services is likely to cause confusion as to the source or sponsorship of such services.

Clearly, applicant's "THE FINANCIAL FOUNDATION ASSESSMENT" mark not only incorporates the entirety of registrant's "FINANCIAL FOUNDATION" mark but it does so as essentially the first, and hence most prominent, term therein, given the basic lack of any trademark significance of the definite article "THE." While the word "FINANCIAL" in both marks is obviously descriptive of financial planning services, including those rendered by a "FINANCIAL FOUNDATION," the inclusion of the term "ASSESSMENT" in applicant's mark does nothing to alter or otherwise significantly distinguish applicant's mark as a whole from registrant's mark. Rather, as the Examining Attorney notes, the term "ASSESSMENT" is descriptive of financial planning services which offer or provide an appraisal or assessment of the state of a client's portfolio or finances. When considered in their entireties, therefore, applicant's mark is substantially similar in sound, appearance, connotation and commercial impression to registrant's mark.

We accordingly conclude that customers for financial planning services, who are familiar or otherwise acquainted with registrant's "FINANCIAL FOUNDATION" mark for such services, would be likely to believe, upon encountering applicant's substantially similar "THE FINANCIAL FOUNDATION ASSESSMENT" mark for the identical services, that applicant's and registrant's financial planning services emanate from, or are otherwise sponsored by or affiliated with, the same source. In particular, consumers for such services would be likely to view applicant's "THE FINANCIAL FOUNDATION ASSESSMENT" services as specifically constituting an assessment or appraisal of their finances or portfolios for

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financial planning purposes which are part of the financial planning services offered or rendered by registrant under its "FINANCIAL FOUNDATION" mark.

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