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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re InteliStaf Healthcare Management, L.P.

Serial No. 78387294

J. Charles Dougherty of Wright, Lindsey & Jennings LLP for
Intelistaf Healthcare Management, L.P.

Evelyn Bradley, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Bucher and Kuhlke, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by InteliStaf Health
Management, L.P. to register the mark INTELICASH for
services which were ultimately identified as "debit card
services, namely, the issuance of debit cards to consumers
and the extension of debit card services to consumers."¹

¹ Serial No. 78387294, filed March 19, 2004, which is based on a
bona fide intention to use the mark in commerce.

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 the identified goods, so resembles the mark INTELECASH, which is registered for "business services, namely, electronic measuring, tracking, monitoring and controlling prepayments of goods and services by the public, in connection with various account numbers as issued on debit cards, prepaid telephone calling cards, and other media,"² as to be likely to cause confusion, mistake, or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or

² Registration No. 2,042,905 issued March 11, 1997; Section 8 and 15 affidavit accepted and acknowledged, respectively.

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the respective marks. Applicant acknowledges that the difference in the marks INTELICASH and INTELECASH is slight. Nonetheless, applicant contends that:

This deceptively small distinction, however, is critically important to the connotation and commercial impression created by the marks. The applicant's mark includes the formative "inteli" as a prefix. The formative suggests to the consumer the idea of intelligence or knowledge. The registered mark, by contrast, includes the formative "tele-." The "tele" formative brings to the consumer's mind the idea of communication, distance, travel, or movement, such as used in the terms "telephone," "telegraph," "television," and "teleport." (footnotes omitted).
(Brief at 2-3).

We find that the marks are substantially similar in terms of appearance, differing only by a single letter. We also find that the marks are essentially identical in terms of sound. In terms of connotation and commercial impression, we are not convinced that purchasers and potential purchasers of the parties' respective services would scrutinize the marks so closely as to make a distinction between "inteli-" and "tele-" as applicant

argues. It must be remembered that the test is not whether marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. Even assuming, arguendo, that purchasers and potential purchasers did make the distinction argued by applicant, there is no indication in the record that either mark, INTELICASH or INTELECASH, as a whole, means anything in particular. Purchasers and potential purchasers are likely to view each mark as an arbitrary or coined mark with no apparent meaning. Given the points of similarity between the marks in terms of appearance and sound, we cannot conclude that the connotations and overall commercial impressions of the marks are so different that confusion is unlikely to result from use of the marks on similar or related goods.

Applicant argues that this case is similar to the situations in *National Distillers & Chemical Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 184 USPQ 34 (CCPA 1974) [the marks DUVET and DUET, both for alcoholic beverages, are not confusingly similar] and *Plough Inc. v. Kreis Laboratories*, 314 F.2d 635, 136 USPQ 560 (9th Cir.

1963) [the marks COPA TAN and COCOA TAN, both for suntan lotion, are not confusingly similar]. However, in the National Distillers case, the court found that the public could clearly distinguish between the foreign word DUVET and the English word DUET which has a recognized meaning. In the Plough Inc. case, the court found that the marks COPA TAN and COCOA TAN were different in appearance and sound, and that the mark COCOA TAN had a suggestive meaning when used in connection with suntan lotion. In this case, the marks INTELICASH and INTELECASH are highly similar in terms of appearance, essentially identical in terms of pronunciation, and neither mark, in its entirety, has an apparent meaning. Thus, we find that this case is distinguishable from both the National Distillers and the Plough Inc. cases.

We next turn then to a consideration of the parties' respective services, their channels of trade and purchasers. Applicant's services are identified as "debit card services, namely, the issuance of debit cards to consumers and the extension of debit card services to consumers." The services in the cited registration are set forth as "business services, namely, electronic measuring, tracking, monitoring and controlling prepayments of goods and services by the public, in connection with various

account numbers as issued on debit cards, prepaid telephone calling cards, and other media." The examining attorney argues:

The applicant's identified services are substantially related to the registrant's services. The applicant's services and registrant's services involve debit cards, and feature services related to debit cards. These services travel in the same channels of trade. Upon viewing the marks which create the same commercial impression used with such closely related services, consumers would mistakenly believe that the parties' debit card services emanate from a common source.

...

In fact, applicant's services, namely, the issuance of debit cards to customers and the extension of debit card services to consumers could include the issuance of debit cards and the extension of debit card services to "business consumers." Arguably, applicant could issue [debit] cards and extend debit card services to business consumers, as well as the general public. Since the wording "extension of debit card services to consumers" is extremely broad, it is presumed that the application encompasses all types of debit card services that are normally offered to any of the various types of consumers, including those described in the registrant's identification, and that these services move in all normal channels of trade and that they are available to all potential customers. (citation omitted). Moreover, the registrant's services, namely, "controlling prepayments of goods and services by the public in connection with various account numbers as issued on debit cards" could encompass the applicant's services, namely, "the extension of debit card services to consumers." (Brief at 6-7).

Applicant, on the other hand, argues:

The channels of trade for the services at issue here are wholly distinct. Because the same persons will not be exposed to both services, there can be no likelihood of confusion. The applicant's services are directed to end consumers. The registrant's services, by contrast, are directed to businesses that serve end consumers. This distinction is made clearly and unambiguously in both descriptions: the applicant's services are debit card issuance and debit card services "to consumers," while the registrant's services are "business" services. The applicant's services do not include the issuance of debit cards to businesses, and the registrant's services do not include any services that would be of interest to, or would be marketed to, end consumers. (Brief at 4).

It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein. Moreover, the greater the

degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applying these principles in this case, we find that the examining attorney has failed to establish that applicant's and registrant's services are similar or related in such a way that would result in source confusion, even if marketed under the very similar marks herein.

Applicant's recitation of services limits the class of purchasers of its services to "consumers." The services in the cited registration are identified as "business services," and thus the class of purchasers of registrant's services is limited to businesses. We are not persuaded by the examining attorney's argument that the purchasers of applicant's and registrant's services overlap. The examining attorney argues that applicant's services could include the issuance of debit cards and the extension of debit card services to "business consumers." However, this

is not a fair reading of applicant's recitation of services. The use of "consumers" therein is understood to mean ordinary consumers. Thus, we agree with applicant that its services and registrant's services, as identified, are marketed to different classes of purchasers.

Further, although the examining attorney argues that the respective services travel in the same channels of trade, she offered no evidence to support this argument. On the contrary, applicant's and registrant's services, as identified, would appear to travel in different channels of trade. Applicant's services are in the nature of financial services that are marketed to consumers whereas registrant's services are electronic measuring, tracking, monitoring and control services that are marketed to businesses.

In addition, the examining attorney argues that registrant's services of "controlling prepayments of goods and services by the public in connection with various account numbers as issued on debit cards" could encompass applicant's services of "the extension of debit card services to consumers." However, this argument fails to consider, as discussed above, the limitations as to the classes of purchasers of applicant's and registrant's services.

Finally, the examining attorney argues that applicant's and registrant's services are related because both are debit card services. Of course, applicant's services are identified as debit card services and registrant's services of electronic measuring, tracking, monitoring and controlling prepayments of goods and services by the public, in connection with various account numbers as issued on debit cards generally may be characterized as debit card services. However, to demonstrate that goods and/or services are related, it is not sufficient that a particular term may be found which may generically describe the goods and/or services. See *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977); and *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.*, 88 USPQ 517 (TTAB 1975).

Where, as in this case, the respective services on their face, do not appear to be similar or related, it is incumbent on the examining attorney to present evidence establishing such similarity or relationship. The examining attorney's mere argument and conclusory assertions are insufficient for this purpose.

In sum, we find that there is no likelihood of confusion here. As identified, applicant's and registrant's respective services, as well as the trade

Ser No. 78387294

channels and classes of purchasers, appear to be too dissimilar and unrelated for any confusion to be likely, even if marketed under highly similar marks.

Decision: The refusal to register is reversed.