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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Citizens Financial Group, Inc.

Serial No. 78451347

Robert M. O'Connell, Jr. of Goodwin Procter LLP for
Citizens Financial Group, Inc.

Ronald G. McMorrow, Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Walters, Drost and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 15, 2004, Citizens Financial Group, Inc.
("applicant") filed an application to register the mark
CITIZENS CIRCLE GOLD ACCOUNT on the Principal Register in
standard-character form for services identified as "banking
services" in International Class 36. Applicant has
disclaimed "ACCOUNT." Applicant claims first use of the
mark anywhere on April 15, 1996 and first use of the mark
in commerce on April 19, 1996. Applicant claimed ownership

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of prior registrations for marks which include CITIZENS BANK and CITIZENS CIRCLE, for banking services in International Class 36.

The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Reg. No. 1270229, owned by Wells Fargo & Company, for the mark GOLD ACCOUNT in standard-character form for services identified as "banking services" in International Class 36. The registration issued on March 13, 1984 and has been renewed. The registration states a date of first use anywhere and first use of the mark in commerce on January 22, 1973. The registration also includes a disclaimer of "ACCOUNT."

Applicant responded to the refusal; the Examining Attorney made the refusal final; and applicant filed this appeal. Applicant and the Examining Attorney have filed briefs. We reverse.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods [services] of the applicant, to cause confusion . . ." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177

USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Below we will discuss all factors as to which applicant or the Examining Attorney argued or presented evidence.

Comparison of the Services

The services identified in both the application and cited registration are "banking services." In fact, there is no argument in this case regarding the services. For the purposes of our consideration of the case we have assumed that the services, and the channels of trade for the services, of applicant and registrant are identical.

Comparison of the Marks

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In this case, we note, in particular, that it is appropriate to accord greater importance to the more distinctive elements in the marks than to the less distinctive elements in determining whether the marks are similar. The Court of Appeals for the Federal Circuit observed, ". . . in articulating reasons for reaching a conclusion on the issue 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 the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant argues that the Board's decisions in a number of earlier cases, most notably, the recent decision in Knight Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313 (TTAB 2005) dictate the conclusion that the marks in this case are not similar, and furthermore that there is no likelihood of confusion. The Examining Attorney, on the other hand, argues that applicant has simply added its house mark to the registered mark and that the addition is insufficient to distinguish the marks. The Examining Attorney also argues that Knight Textile and other cases discussed by applicant do not apply here.

In a request for reconsideration applicant provided a substantial body of evidence in support of its position. While the Knight Textile case sets the evidentiary bar quite high for applicants in cases such as this, we believe (1) that the facts of this case track the Knight Textile facts in nearly every respect and (2) that the evidence

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applicant has presented here meets and even exceeds the evidentiary showing in Knight Textile. For completeness, we acknowledge that the other cases applicant relies on are also generally supportive of its position. See In re Cosvetic Laboratories, Inc., 202 USPQ 842 (TTAB 1979) and Kayser-Roth Corp. v. Morris & Co., Inc., 164 USPQ 153 (TTAB 1969). See also Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 USPQ2d 1477 (TTAB 1987).

In Knight Textile the applicant sought to register NORTON MCNAUGHTON ESSENTIALS for various items of "ladies sportswear." Knight Textile, 75 USPQ2d at 1314. Knight Textile Corporation opposed registration based on its registration for the mark ESSENTIALS for various items of "women's clothing." Id. at 1314. In the opinion the Board found that the applicant's goods were "in part identical to and otherwise highly similar to the goods in opposer's pleaded registration." Id. at 1315 (emphasis provided).

In Knight Textile, the Board also concludes, as follows, with regard to the comparison of the marks, "we find that the parties' marks are dissimilar rather than similar when viewed in their entirety in terms of appearance, sound connotation and overall commercial impression." Id. at 1315. The Board explains further,

The marks obviously are similar in terms of sight, sound and meaning to the extent they both consist of or include ESSENTIALS. Just as obviously the marks are dissimilar in sight, sound and meaning to the extent that applicant's mark, but not opposer's, includes and begins with the words NORTON MCNAUGHTON, which would be perceived to be applicant's house mark. In terms of overall commercial impression, we find that although the word ESSENTIALS is the entirety of the commercial impression created by opposer's mark, in applicant's mark it contributes relatively less to the commercial impression than does the house mark NORTON MCNAUGHTON. This is because, as discussed more fully *infra*, we find that the word ESSENTIALS is highly suggestive as applied to the parties clothing items and as it appears in both parties' marks, especially in applicant's mark. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Id. at 1315

The Board observed further that, in the Knight Textile case, the addition of the house mark, was sufficient to distinguish the marks citing New England Fish Company v. The Hervin Company, 511 F.2d 562, 184 USPQ 817 (CCPA 1974) and similar cases, which reject a uniform rule in favor of a case-by-case approach in assessing the effect of the addition of a house mark in determining likelihood of confusion.

In Knight Textile, the critical factual issue was the strength or weakness of ESSENTIALS. In concluding that ESSENTIALS was highly suggestive the Board relied primarily on a dictionary definition for "essential-s" and "twenty-three extant ESSENTIAL registrations on the register in the

clothing field registered to twenty-one different owners.”
Knight Textile, 75 USPQ2d at 1316.

In this case applicant has not proffered and we need not rely on a dictionary definition.¹ Applicant has provided more direct evidence of the significance of GOLD ACCOUNT in the banking field, that is, evidence of actual use of GOLD ACCOUNT by twelve distinct third-party banks in relation to banking services. Specifically, with its request for reconsideration, applicant provided excerpts from Internet web pages showing each of these uses, and applicant accurately describes each of the uses in its main brief at pages 9-11. These banks include: Bank of America; Zion Bank of Salt Lake; United Bank in Griffin, Georgia; City National Bank of Florida; Walluka Bank, Florida; Bank of Nashville; Community Bank N. A. in Dewitt, New York; Bank of Astoria in Oregon; First Federal Bank in

¹ We take judicial notice of a definition from the Dictionary of Banking Terms (4th ed. 2000) for “gold card” which states, in part, “Visa or MasterCard credit card with a minimum credit line of \$5,000 and frequently higher... Sometimes called a prestige card or premium card... also the American Express Gold Card which differs from bank issued cards.” We take judicial notice of this dictionary definition under University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff’d, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). This shows either a highly suggestive or even descriptive meaning for “GOLD” in a closely related field.

Lexington, Kentucky; Sleepy Hollow Bank in New York; Exchange Bank of Alabama; and the Pacific Continental Bank in Oregon.

The web pages for each of these banks show use of GOLD ACCOUNT to identify an account or program offering a premium level of service, benefits and/or privileges -- for example, higher interest on savings or investment accounts, free checking, free safe deposit boxes or other benefits. In the aggregate, the uses demonstrate that "GOLD ACCOUNT" suggests a premium level of service or benefits in the banking field. The Examining Attorney discounts the importance of this evidence, stating, "These third-party uses of registrant's mark may indicate that the mark is somewhat suggestive of high quality services. They certainly do not show that the registrant's mark is weak. We disagree. We find these third-party uses highly probative and strong evidence that "GOLD ACCOUNT" is highly suggestive in the banking field. The examples are numerous and directly on point. They indicate extensive use of the phrase throughout the United States, including Internet use.

As in the Knight Textile case, applicant also provided numerous third-party registrations which corroborate the suggestive meaning. See In re Red Carpet Corp. v.

Johnstown American Enterprises Inc., 7 USPQ2d 1404, 1406 (TTAB 1988).

The Examining Attorney discounts this evidence also, principally because it shows use of "GOLD" and not "GOLD ACCOUNT" in relation to banking services. The Examining Attorney provided results of a USPTO search indicating that the only records which show "GOLD ACCOUNT" in sequence are the records for the application and registration at issue here. In arguing so, the Examining Attorney appears to attach great importance to the presence or absence of "ACCOUNT" in the third-party marks. We find many of the registrations relevant even though they do not include "account" in the marks. In this case both applicant and registrant have disclaimed "ACCOUNT" which is a generic term in the banking field. As such "account" is less important in the commercial impression of both marks. See In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Accordingly, we find many of the registrations applicant provided showing marks which include "GOLD" in the banking field probative, for example:

PRIMETIME GOLD for "banking services" owned by Citizens Banking Corp. (Reg. No. 2853460;

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GOLD PREFERRED for "banking services" owned by Applied Card Bank Corp. by assignment from Cross Country Bank (Reg. No. 2743905);

PEOPLES GOLD for "banking services" owned by Peoples Exchange Bank of Beattyville, Kentucky, Inc. (Reg. No. 2433628);

FLEET ONE GOLD for "banking services" owned by Bank of America Corp. by assignment from Fleet Financial Group, Inc. (Reg. No. 2271745);

PRIVILEGE MONEY MARKET GOLD for "banking services" owned by Citizens Financial Group, Inc. by assignment from Charter One Financial, Inc. (Reg. No. 2055325);

PRIVILEGE 50 GOLD for "banking services" owned by Citizens Financial Group, Inc. by assignment from Charter One Financial, Inc. (Reg. No. 2068033);

GOLD BANC for "banking services, ..." owned by Gold Banc Corp. (Reg. No. 2367612);

GOLD 24 and Design for "banking services ..." owned by Extraco Corp. (Reg. No. 2541097);

SPECIAL CONNECTIONS GOLD for "banking and credit card services" owned by Commerce Bankshares Inc. (Reg. No. 1871567);

CITIGOLD for "banking services, ..." owned by Citigroup, Inc. by assignment from Citicorp Corp. (Reg. No. 1824600);

PACIFIC GOLD for "banking services" owned by Comerica Bank-California by merger with Pacific Western Bank (Reg. No. 1506344);

ONE ACCOUNT GOLD and Design for "banking services" owned by Fifth Third Bank (Reg. No. 1503236); and

FIRST CHICAGO GOLD PASSPORT ACCOUNT for "banking services ..." owned by First Chicago Corp. (Reg. No. 1155058).

The registrations corroborate our conclusion that "GOLD ACCOUNT" is highly suggestive, and therefore weak, as used in the banking field.

The specimen in this case shows applicant's use of CITIZENS as a house mark. Applicant also indicates that it uses CIRCLE, "to identify its premiere relationship account products." Thus, in this case CITIZENS CIRCLE functions like NORTON MCNAUGHTON in the Knight Textile case. Here too the house mark, CITIZENS, along with CIRCLE, is dominant to the near exclusion of GOLD ACCOUNT in forming the commercial impression of applicant's mark. As the Board said in Knight Textile, "Based on this evidence, we find that purchasers are able to distinguish among various ESSENTIALS marks by looking to other elements of the marks. In this case that other element is the presence of applicant's house mark NORTON MCNAUGHTON." Knight Textile, 75 USPQ2d at 1316 (footnote omitted). In the case before us, purchasers would look to CITIZENS CIRCLE to distinguish applicant's mark from other GOLD and GOLD ACCOUNT marks, including the mark in the cited registration.

Accordingly, in view of the highly suggestive character of GOLD ACCOUNT we conclude that the marks of applicant and registrant are not similar when viewed in their entireties.

Other Factors

Applicant also argues that the Examining Attorney failed to consider certain other du Pont factors, specifically, the sophistication of the purchasers, the lack of fame and the absence of actual confusion.

With regard to the sophistication of potential purchasers, applicant argue that people take particular care in the selection of banking services. The Examining Attorney disagrees. Neither applicant nor the Examining Attorney offered any evidence related to this factor. We can safely say that the clientele for banking services are generally no less careful than the purchasers of women's apparel, the potential purchasers in the Knight Textile case. Accordingly, we have no reason, based on the sophistication of the purchasers here, to depart from the analysis in the Knight Textile case. We do not view this factor as significant in this case.

With regard to fame, in the absence of any evidence regarding the fame or lack of fame of the registered mark, we do not consider that fame is a relevant factor in this case. In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (" . . . we decline to establish that the converse rule that likelihood of confusion is precluded by a registered mark's not being

famous."). Indeed, the evidence of third-party uses of GOLD ACCOUNT suggests indirectly that the registered mark is not famous, but we cannot and need not determine so for the purposes of our ultimate decision here. We regard fame as a neutral factor here.

Also, with regard to actual confusion, we also do not consider this factor to be significant in this case. In an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." In re Majestic Distilling Co., 65 USPQ2d at 1205. See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Lastly, although applicant has not explicitly argued that the Internet evidence is relevant to the sixth du Pont factor, "the number and nature of similar marks in use on similar goods [services]," we could consider that evidence under that factor. In this respect this case is unlike the Knight Textile case where the Board specifically declined to consider the sixth du Pont factor because the record included only third-party registrations and no evidence of actual use by third parties. Knight Textile, 75 USPQ2d at 1315. In this respect the record here goes beyond Knight Textile. Although we need not and do not rely on the evidence of actual use by others under the sixth du Pont

factor, we note that the record here related to the sixth du Pont would lend still further support to our conclusion.

CONCLUSION

In conclusion, we have considered all evidence bearing on the du Pont factors in this case and conclude that confusion is not likely. We conclude so principally because the marks of applicant and registrant, when viewed in their entirety, are not similar and not likely to be confused and because the lack of similarity between the marks outweighs all other factors in this case. Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545, 1550 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The refusal to register the mark under Section 2(d) of the Act is reversed.