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February 11, 2004  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Cross Country Bank  
v.  
Cross Country Financial Corp.

Opposition No. 91114039 to application Serial No. 75387134  
filed on November 10, 1997

Request for Reconsideration

Robert W. Whetzel and Thomas H. Kovach of Richards, Layton &  
Finger, P.A. for Cross Country Bank.

Paul A. Hoffman of Law Offices of Paul E. Greenwald &  
Associates for Cross Country Financial Corp.

Before Hohein, Walters and Bucher, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Board, on July 22, 2003, issued a decision  
dismissing the opposition by Cross Country Bank to the  
application for registration by Cross Country Financial  
Corporation of the mark "CROSS COUNTRY FINANCIAL CORPORATION"  
for the services of "lease-purchase financing and collection

of retail installment sales contracts and consumer credit transactions." Although the opposition was originally brought solely on the pleaded ground of priority of use and likelihood of confusion, the Board, as part of its decision, granted a contested motion by opposer to amend the pleadings to conform to the evidence so as to include the additional grounds of mere descriptiveness and primary geographical descriptiveness.

Opposer, on August 21, 2003, timely filed a request for reconsideration of the Board's decision with respect to the dismissal of the mere descriptiveness ground in view of opposer's failure of proof with respect thereto. Specifically, opposer requests that the Board "reconsider its decision based on the evidence of record and the prevailing authorities, and find that applicant ... ('CCFC') is not entitled to registration on the Principal Register under the Trademark Act Section 2(e)(1) ... for descriptiveness reasons." Applicant timely filed a brief in opposition to the request for reconsideration and opposer submitted a reply brief, which in our discretion we have also considered.<sup>1</sup> See TBMP §543 (2d ed. June 2003).

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<sup>1</sup> While the briefs submitted by the parties in connection with the request for reconsideration are accompanied by numerous evidentiary exhibits, only those exhibits which were properly made part of the trial record in this proceeding have been given consideration. In particular, it is pointed out that the Board does not take judicial notice of either third-party registrations or, in view thereof, the file histories of such registrations. See, e.g., In re Duofold,

Opposer, as stated in its request for reconsideration, essentially maintains that the Board "erred in its determination of the descriptiveness of CCFC's mark by not considering all of the available evidence and by misapprehending relevant authority." In particular, as to the former, opposer contends that:

[T]he Board's lengthy opinion does not reflect consideration of two critical pieces of evidence: (1) evidence in the application file reflecting the actual use of the mark, and (2) testimony by applicant regarding such use. This evidence demonstrates that CCFC's mark is descriptive. CCFC uses its "Cross Country" mark in close proximity to a map of the United States, and its President testified that he designed the brochures reflecting this use to describe the services provided by CCFC. ....

While opposer, furthermore, "respectfully notes that the Board's opinion nowhere addressed this evidence, which was the subject of considerable discussion at the oral hearing," it is telling that in neither its main brief nor its reply brief did opposer, in discussing the ground of mere descriptiveness,

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Inc., 184 USPQ 638, 640 (TTAB 1974). Nonetheless, even if certain third-party registration evidence, although not properly forming part of the trial record, were to be considered, it would not change the result herein inasmuch as it is well settled that that each case ultimately must be determined on its own merits and that allowance of prior third-party marks is not determinative of the registrability of an applicant's mark. See, e.g., *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even 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"].

make any mention of, much less offer any argument about, what opposer now characterizes as "two crucial pieces of evidence." Likewise, despite a brief reference thereto by opposer's counsel at oral hearing, the Board's opinion did not include a specific and extended discussion of such evidence inasmuch as the principal focus of opposer's arguments, both in its briefs and at the oral hearing, was based instead on one of several dictionary definitions of the term "cross-country" which it made of record by means of a notice of reliance.

Moreover, it is plain in any event that in reaching our decision, consideration was in fact given to such evidence, even though not specifically mentioned therein. In fact, all evidence of record, including (as particularly noted in footnote 8) "all evidence furnished by opposer," was considered, but the evidence made of record fails, as we found, to constitute proof of the ground of mere descriptiveness. The Board's decision, in this regard, explicitly states, following detailed discussions of certain evidence, that "[g]iven *the absence from the record of any other evidence* which serves to support opposer's descriptiveness claims, it is clear that opposer has not met its burden of proof and that the opposition must fail" (emphasis added).

Nonetheless, to lay opposer's contentions to rest, suffice to say that the evidence pointed to by opposer in its request for reconsideration fails to constitute proof of mere descriptiveness of applicant's mark. Specifically, as to the specimens of use in the file of the involved application, we disagree with opposer's assertion that the utilization of "CCFC's mark in immediate or close proximity to a map of the country of the United States" constitutes "uncontroverted evidence that CCFC's use of its 'Cross Country' mark is descriptive." Aside from the fact that, as correctly observed by applicant, the specimens of use in the file of its application are not evidence on behalf of applicant and were not otherwise properly introduced into the record, see Trademark Rule 2.122(b)(2) and TBMP §704.03(a) (2d ed. June 2003), to the extent that such specimens may be used as evidence against applicant as admissions against interest, see TBMP §704.04 (2d ed. June 2003), they fail to show that the connotation of applicant's mark, as we found in our decision, is anything more than at most suggestive of the nationwide availability or scope of operation of applicant's services.

With respect to the testimony presented by applicant concerning the two specimens of use which it introduced as its Exhibit 6,<sup>2</sup> opposer insists that (bold type in original):

CCFC offered two of the same specimens as exhibits to the deposition testimony of its President, Christopher Lank. The two specimens, Exhibit 6 to the Lank deposition, were explained by Mr. Lank as "two examples of marketing fliers that I designed which **describe** the company's sales financing services. We've been distributing fliers like this since 1991. (Lank Dep. at 15:7-10 (emphasis added). . . . Both of the fliers introduced by CCFC, which were designed to "describe [CCFC's] sales financing services," utilize the term "Cross Country" in conjunction with a map of the U.S.--describing the geographic range of the company's services.

The use of the term "Cross Country" mark, in connection with advertising CCFC's services, in immediate or close proximity to a map of the United States, reveals the descriptiveness of the mark--through which CCFC characterizes its services as available across the country or from one side of the country to the other. After consideration of this evidence of the use of CCFC's mark, applicant's mark should be refused registration on the Principal Register under the Trademark Act Section 2(e)(1) as merely descriptive.

Opposer's contentions mischaracterize the evidence offered by applicant. The testimony by applicant's president,

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<sup>2</sup> Although counsel for opposer attended the deposition by telephone and, among other things, objected "to the use and entry of" the documents which comprise Exhibit 6 "to the extent they were requested in discovery and not produced" (Lank dep. at 15), opposer waived such objection by failing to preserve it in its main brief on the case. See TBMP §707.04 (2d ed. June 2003).

as the following excerpt makes absolutely clear, was in response to a request that he identify the two pages of documents which comprise applicant's Exhibit 6:

Q Mr. Lank, I'm going to hand you two documents that I'm going to mark collectively as Exhibit 6. Can you identify these documents for the record, beginning with the first page.

A These are two examples of marketing fliers that I designed which describe the company's sales financing services. We've been distributing fliers like these since 1991.

Plainly, Mr. Lank is referring to marketing fliers which explain the services offered by applicant; he is not testifying that applicant's mark describes its services. Moreover, contrary to opposer's statement, neither of the one-sided marketing fliers which comprise Exhibit 6 has a map or other depiction of the United States anywhere thereon. Consequently, neither the above quoted testimony by applicant's witness nor the associated exhibits has any probative value with respect to demonstrating the alleged mere descriptiveness of applicant's mark.

Finally, as to opposer's assertion that the Board erred by "misapprehending relevant authority," we discern no error in our decision. Opposer's arguments are essentially a rehash of those previously asserted in its main brief and

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reply brief. Such arguments remain unpersuasive, however, for the reasons set forth in our decision.

Accordingly, inasmuch as opposer has failed to show that, based on the evidence properly of record and the applicable law, the Board's decision on the issue of mere descriptiveness is in error and requires change, the request for reconsideration is denied.