

Hearing:
October 22, 1998

Paper No. 16
PTH

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 27, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re First Citizen's Bancshares, Inc.

Serial No. 75/165,513

William J. Mason of Rhodes Coat & Bennett LLP for First
Citizen's Bancshares, Inc.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

First Citizen's Bancshares, Inc. has appealed from the
Trademark Examining Attorney's refusal to register the mark
ATLANTIC STATES BANK, with the words STATES BANK

disclaimed, for banking services.¹ Registration has been refused on the ground that applicant's mark, if used in connection with the identified services, would so resemble the marks ATLANTIC BANK and ATLANTIC ONE both registered to the same entity for banking services², as to be likely to cause confusion or mistake or to deceive.

Because the services of applicant and registrant, as listed in the application and registrations, are identical, we turn our attention to the marks. Although there are similarities between applicant's mark and the cited marks, there are also some differences in the marks when they are viewed in their entireties. Applicant's mark ATLANTIC STATES BANK, because of the inclusion of the word "STATES," has a slightly different appearance and creates a different commercial impression than either ATLANTIC BANK or ATLANTIC ONE. Applicant's mark ATLANTIC STATES BANK suggests a financial institution with specific ties to the Atlantic states, whereas the cited marks ATLANTIC BANK and ATLANTIC

¹ Application Serial No. 75/165,513 filed September 11, 1996 based on Section 1(b) of the Trademark Act (intent-to-use). We note that applicant submitted a disclaimer of STATES BANK at the request of the Trademark Examining Attorney. Applicant initially took the position that a disclaimer of STATES BANK was improper and offered to disclaim BANK. However, inasmuch as applicant subsequently submitted a disclaimer of STATES BANK, the appropriateness of this disclaimer is not an issue before us.

² Registration No. 1,533,587 issued April 4, 1989, Sections 8 & 15 affidavit filed (BANK is disclaimed); and Registration No. 2,027,538 issued December 31, 1996 respectively.

Ser No. 75/165,513

ONE suggest in a general way the Atlantic Ocean or eastern seaboard of the United States.

Moreover, there is another factor which must be considered in determining the issue of likelihood of confusion. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) lists thirteen factors which, when of record, must be considered, and cautions that no one factor is predominant, but that each may, from case to case, play a dominant role. In this case, "the extent to which applicant has a right to exclude others from use of its mark on its goods [or services]" is a significant factor in our determination of likelihood of confusion. In this regard, applicant submitted the results of a search of the Dun & Bradstreet Market Finders data base which indicates that over 300 entities are providing banking and financial services under trade names containing the word "Atlantic." In addition, applicant submitted the results of a search of the TrademarkScan data base of applications and registrations for marks which include the word "Atlantic" for banking and other financial

services.³ This search revealed several such third-party applications and registrations. While third-party registrations are incompetent by themselves to prove use of marks or that the public has become exposed to them, third-party registrations may be competent to show that a term has descriptive or suggestive significance as applied to certain goods or services. Here, the information from the Dun & Bradstreet report and the TrademarkScan data base indicates that ATLANTIC has suggestive significance as applied to banking and financial services. That is, ATLANTIC suggests the Atlantic Ocean or the eastern seaboard of the United States. The registered marks are thus weak marks, which are not entitled to a broad scope of protection.

When we combine the factor of the limited scope of protection to which the cited registrations are entitled with the differences in the marks, we find that applicant's intended use of ATLANTIC STATES BANK for banking services

³ The submission of print-outs of information taken from a private company's data base is not the proper way to make applications/registrations of record. The proper procedure to make applications/registrations of record, instead, is to submit copies of the actual applications/registrations or the electronic equivalent thereof, i.e., printouts of the applications/registrations taken from the Patent and Trademark Office's own computerized data base. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. However, inasmuch as the Examining Attorney did not object to applicant's submission, we have considered the information therein.

Ser No. 75/165,513

is not likely to cause confusion with ATLANTIC BANK and
ATLANTIC ONE.

Decision: The refusal to register is reversed.

R. F. Cissel

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Ser No. 75/165,513