

10/3/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Commerce Bancorp, Inc.  
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Serial No. 75/422,600  
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Timothy D. Pecsénye for Commerce Bancorp, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

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Before Seeherman, Hanak and Quinn, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Commerce Bancorp, Inc. (applicant) seeks to register  
COMMERCE CAPITAL MARKETS for "financial services in the  
nature of financial planning and investment brokerage and  
consultation services." The intent-to-use application  
was filed on January 16, 1998.

The Examining Attorney has refused registration on  
two grounds. First, citing Section 2(d) of the Trademark  
Act, the Examining Attorney contends that applicant's  
mark, if used in connection with applicant's services, is  
likely to cause confusion with two marks previously

registered to the same entity, namely, FOR MY MONEY IT'S  
COMMERCE registered

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for "banking; financial services in the nature of  
installment, home equity, and temporary loans; investment  
brokerage; and safety deposit box services" (Registration  
No. 2,048,236) and COMMERCE FUNDS and design in the form  
shown below registered for "mutual fund services, namely  
the solicitation, sale and distribution of mutual funds"  
(Registration No. 1,975,448).

Second, citing Section 6(a) of the Trademark Act,  
the Examining Attorney has refused registration because  
applicant has not disclaimed the wording CAPITAL MARKETS  
apart from applicant's mark in its entirety. It is the  
contention of the Examining Attorney that the words  
CAPITAL MARKETS are merely descriptive of applicant's

services.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs.

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We will consider first the refusal pursuant to Section 2(d) of the Trademark Act. We note that certain of applicant's services (investment brokerage) are identical to certain of the services of the registration for FOR MY MONEY IT'S COMMERCE (again, investment brokerage). Moreover, applicant's services of financial planning and consultation are broad enough to include the recommendation that one purchase mutual funds. Obviously, the services of the second cited registration are mutual fund investment services. In short, we find that applicant's services are, in part, identical to the services of one of the cited registrations, and are extremely closely related to the services of the other cited registration. Again, it should be noted that both of the cited registrations are owned by the same entity.

Thus, if it is to be determined that there is no likelihood of confusion, it must be primarily based on

differences in the marks. As is readily apparent, the only element common to applicant's mark and the two cited marks is the word COMMERCE. However, as applied to financial services in general, the word "commerce" is extremely weak in that it is widely used in the trade names and marks of

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numerous financial institutions. In this regard, applicant has made of record a printout from the Dun & Bradstreet data base showing that there are well over 600 financial institutions whose names include the word "commerce." Given this widespread use of the word "commerce" in connection with various types of financial institutions, we find that consumers of financial services have become accustomed to distinguish between marks and trade names containing this word based upon other elements of the marks and trade names. See In re Broadway Chicken Inc., 38 USPQ2d 1559, 1565-66 (TTAB 1996) ("Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as

a means of distinguishing the source of goods or services in the field." ). Moreover, we note that in selecting financial institutions, even ordinary consumers exercise a reasonably high level of care. Amalgamated Bank v. Amalgamated Trust & Savings, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988).

In sum, given the fact that the only element common to applicant's mark and the two cited marks is the widely used,

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common term "commerce," we find that there exists no likelihood of confusion. Accordingly, the refusal to register pursuant to Section 2(d) is reversed.

Turning next to the refusal pursuant to Section 6(a) of the Trademark Act, we find that the words "capital markets" are descriptive of applicant's services, and accordingly affirm the refusal to register on this basis.

At the outset, we note that applicant has offered to disclaim the single word MARKETS. (Applicant's brief page 18). Moreover, applicant has conceded that the term CAPITAL MARKETS "may arguably be descriptive."

(Applicant's brief page 21). However, in arguing that a

disclaimer of CAPITAL MARKETS is not required, it is applicant's position that consumers, upon viewing its mark COMMERCE CAPITAL MARKETS, would find that "the phrase COMMERCE CAPITAL is unitary." (Applicant's brief page 19).

We disagree. The Examining Attorney has made of record a plethora of stories wherein the unitary phrase "capital markets" appears to describe markets where capital is exchanged or invested. Given the fact that consumers are well accustomed to seeing the term "capital markets," we believe that these consumers would view applicant's mark as

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COMMERCE ... CAPITAL MARKETS. As applied to applicant's services (financial services in the nature of financial planning and investment brokerage and consultation services), the term "capital markets" is descriptive in that in order to partake of said services, one must invest in capital markets.

Decision: The refusal to register pursuant to Section 2(d) of the Trademark Act is reversed. The refusal to register pursuant to Section 6(a) of the

Trademark Act is affirmed. However, applicant is allowed 30 days from the date of this opinion in which to submit a disclaimer of CAPITAL MARKETS. If applicant submits such a disclaimer, then this decision will be set aside and applicant's mark will be passed to publication.