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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cullen/Frost Bankers, Inc.

Serial No. 75/199,524

Jeff A. McDaniel of Conley, Rose & Tayon, P.C. for
Cullen/Frost Bankers, Inc.

Fred Mandir, Trademark Examining Attorney, Law Office 105
(Thomas Howell, Managing Attorney).

Before Hanak, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Cullen/Frost Bankers, Inc. (applicant) seeks to register READYBANK in typed drawing form for "consumer, commercial, and mortgage banking services; automated teller machine services; and providing bank account information by telephone." The application was filed on November 18, 1996 with a claimed first use date of February 28, 1975. In its application, applicant noted that it was the owner of

Registration No. 1,376,687, which will be discussed at greater length later in this opinion.

Citing Section 2(d) of the Trademark Act, the examining attorney refused registration on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark READY BANKER, previously registered in typed drawing form for "automated banking services." This Registration No. 1,118,933 issued on May 22, 1979 with a claimed first use date of February 1, 1978. The word BANKER is disclaimed.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the examining attorney filed briefs. Applicant requested and then waived an oral hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the mark.").

Considering first the services, they are, in part, essentially identical. Registrant's services are

"automated banking services." This would encompass applicant's "automated teller machine services" and perhaps applicant's "providing banking account information by telephone." Thus, if we were to find that there exists no likelihood of confusion, such a finding must be based upon the dissimilarities of the marks.

Considering next the marks, we acknowledge that in terms of pronunciation, the two marks are quite similar. However, we find that the marks are only somewhat similar in terms of visual appearance given the fact that applicant's mark is depicted as one word, whereas registrant's mark is depicted as two words and the second word is clearly different. Finally, in terms of meaning, we find that the marks are somewhat dissimilar in that consumers would clearly distinguish between a BANK (an institution) and a BANKER (an individual).

In case it may appear that we are emphasizing the dissimilarities in the marks and minimizing their similarities, it should be made clear that the services in question are banking services. Our primary reviewing Court has held that when consumers select banking services, they exercise a very high level of care such that "it would be strange for customers of banks to be confused about whom

they were dealing with." Amalgamated Bank v. Amalgamated Trust, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988).

In sum, were it not for a mitigating circumstance to be discussed below, we would find that the issue of likelihood of confusion is a close one in this case. The services are, in part, identical and the marks are, obviously, somewhat similar. Of course, these factors are offset by the fact that when selecting banking services, consumers exercise a very high level of care.

We now turn to the mitigating circumstance in this case. As previously noted, applicant is the owner of Registration No. 1,376,687. This registration is for the identical mark READYBANK depicted in typed drawing form. Moreover, the services of this prior registration are simply "banking services." Obviously, the term "banking services" is quite broad and encompasses all of the services for which applicant currently seeks to register the mark READYBANK.

However, applicant's existing Registration No. 1,376,687 has a concurrent use limitation restricting applicant's use of the mark READYBANK to the State of Texas. This concurrent use limitation arose by virtue of a settlement in 1985 of Concurrent Use Action No. 586, which involved applicant and American Data Transfer Co., Inc.

(ADT). As a result of this settlement, ADT obtained Registration No. 1,376,686 for the mark REDIBANK for "banking services rendered by an automated teller machine." This registration, formerly owned by ADT, was also a concurrent use registration which restricted ADT's use of the mark REDIBANK to the entire United States with the exception of the State of Texas.

On August 24, 1992 Registration No. 1,376,686 owned by ADT was canceled for failure to file a Section 8 affidavit. When applicant's attorney learned of this cancellation, he filed the present trademark application for the identical mark for a more limited set of banking services to, in effect, eliminate the concurrent use restriction set forth in applicant's existing Registration No. 1,376,687.

Obviously, when applicant's and ADT's applications were published for opposition in 1985, the owner of the cited registration could have opposed either or both applications. For that matter, for a number of years thereafter the owner of the cited registration could have moved to cancel Registration Nos. 1,376,686 or 1,376,687. The cited registration is geographically unrestricted and hence overlaps both applicant's current Registration No. 1,376,687 restricted to Texas, and formerly the now cancelled Registration No. 1,376,686 owned by ADT which

covered the rest of the United States with the exception of Texas.

Our primary reviewing Court has forcefully argued for "the encouragement of registrations" and for this Board to take into account "the real life situation." Amalgamated Bank, 6 USPQ2d at 1307. While the issue of likelihood of confusion in this case may be close, we find that there exists no viable likelihood of confusion, taking into account the real life situation that the owner of the cited registration made a decision many years ago not to oppose or seek to cancel applicant's existing Registration No. 1,376,687 covering the State of Texas when the registrant's registration covered the entire United States including the State of Texas.

Decision: The refusal to register is reversed.

E. W. Hanak

B. A. Chapman

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial
and Appeal Board