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Paper No. 16
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Castle BancGroup, Inc.

Serial Nos. 75/279,939, 75/301,727 and 75/301,730

Stuart I. Graff, Chris L. Bollinger and Clay A. Tillack of Schiff Hardin & Waite for Castle BancGroup, Inc.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law Office 115 (Thomas Vlcek, Managing Attorney).

Before Bucher, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant filed three applications seeking registration of three different marks for services described as follows:

CASTLE BANK

"Retail, commercial and trust banking services, namely savings account services, checking account services, certificates of deposit, electronic funds transfer, electronic debit transactions and automated teller services," in Int. Class 36, with the word "Bank" disclaimed¹

¹ Serial No. 75/279,939 filed on April 23, 1997, in which applicant asserts a *bona fide* intention to use the mark in commerce.

CASTLE FINANCE

"Financial planning services;
consumer lending services in the
field of auto loans and unsecured
consumer loans; and financial
management services," in
International Class 36,
with the word "Finance"
disclaimed²

and,

CASTLE BANCGROUP

"Retail, commercial and trust
banking services, namely savings
account services, checking
account services, certificates of
deposit, electronic funds
transfer, electronic debit
transactions and automated teller
services; financial planning
services; and financial
management services," in
International Class 36,
with the word "BancGroup"
disclaimed³

The Trademark Examining Attorney has refused
registration under Trademark Act Section 2(d), 15 U.S.C.
§1052(d), citing Registration No. 1,758,732, which is for
the mark CASTLE MORTGAGE CORPORATION and design, as shown
below,

² Serial No. 75/301,727 filed on June 2, 1997. The application is based upon first use of the mark during October 1994 and first use in commerce during July 1995.

³ Serial No. 75/301,730 filed on June 2, 1997. The application is based upon asserted dates of first use and first use in commerce in November 1994.



for services recited as "mortgage brokerage services," as a bar to registration of applicant's marks.⁴

When the refusals were each made final, applicant filed separate appeals on each. At the request of the Trademark Examining Attorney, these three appeals have been consolidated for purposes of this decision.

Applicant and the Trademark Examining Attorney have filed main briefs in each case, and applicant has filed a reply brief in each application. Applicant did not request an oral hearing. We affirm the refusals to register.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Upon careful consideration of the evidence of record pertaining to these factors, we find as follows.

⁴ Reg. No. 1,758,732 issued March 16, 1993; §8 affidavit accepted and §15 affidavit received.

Turning first to a consideration of the registrant's and applicant's respective services, we find that applicant's banking services, financial services, financial planning services and financial management services, are closely related to the services recited in the cited registration, "mortgage brokerage services." Applicant argues that consumers know the difference between mortgage corporations and full-service banks, and that these differences are sufficient to eliminate any likelihood of source confusion.

The Board disagrees. Neither the mortgage services in the cited registration nor the related banking and financial services in these three applications contain any limitations as to channels of trade or classes of customers. Therefore, we must presume that they are marketed in all normal trade channels and to all normal classes of customers for such services. See In re Elbaum, 211 USPQ 639 (TTAB 1981). In fact, as noted by the Trademark Examining Attorney, one of applicant's own federal trademark registrations claims use of its tower ramparts design on this full array of services.⁵ This is

⁵ Reg. No. 2,141,144 covers retail, commercial and trust banking services; mortgage banking services; mortgage lending services; mortgage brokerage services; financial services, namely, financial planning services, insurance brokerage services, financial portfolio management services, financing

consistent with dozens of third-party registrations where the same entity offers full-service banking and mortgage services. Hence, while the respective services of applicant and registrant as recited are distinct, they are nonetheless closely related, and in many cases will be offered by a single entity. Hence, this fact weighs against applicant in our likelihood of confusion analysis.

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, while we agree with applicant that consumers may well exercise a greater degree of care in selecting financial services than is the case with routine consumer items, we also agree with the Trademark Examining Attorney that purchasers of financial and mortgage services are not necessarily deemed to be "sophisticated."

We turn next to the issue of whether applicant's marks, CASTLE BANK, CASTLE FINANCE and CASTLE BANCGROUP, and the cited registered mark, CASTLE MORTGAGE CORPORATION and design, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison,

services, financial management services, providing financial information by electronic means (emphasis supplied).

but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

As applicant argues, the marks at issue must be considered in their entireties. However, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we find that the dominant feature of all three of applicant's marks as well as the registered mark is the word CASTLE, an arbitrary term as applied to registrant's and applicant's respective services. The other wording in the marks, i.e., BANK, FINANCE, BANCGROUP and MORTGAGE CORPORATION, comprises generic matter that has been disclaimed by applicant and registrant, respectively. These generic designations contribute very little to the commercial impression created by each of

these marks. Accordingly, any dissimilarity in the marks that might result from their use of different generic wording is greatly outweighed by the marks' basic similarity, i.e., their shared use of the arbitrary term CASTLE.

In short, when we consider the marks in their entirety, we find them to be similar rather than dissimilar. This similarity of the marks weighs in favor of a finding of likelihood of confusion in this case.

Applicant argues that the word CASTLE is a weak and diluted term in the financial services field, and that consumers accordingly are accustomed to distinguishing among CASTLE marks. Although "the number and nature of similar marks in use on similar goods" is one of the du Pont likelihood of confusion factors to be considered when evidence pertaining thereto is of record, there is no such evidence of record in this case, and hence we give no weight to this factor in our likelihood of confusion analysis in this case.⁶

⁶ In its responses to the initial Office actions refusing registration in each of the three files, applicant recited a list of third parties who allegedly provide financial services in commerce under trade names containing the word CASTLE, arguing that such registrations were evidence of the weakness of the word CASTLE in this field. If applicant intended to assert and rely on the existence of third party uses of CASTLE marks in connection with financial services, it was incumbent upon applicant to properly and timely make evidence of such third

As to the du Pont factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, applicant points to six years of coexistence without any actual confusion. However, we have no evidence that the marks CASTLE BANK, CASTLE FINANCE and CASTLE BANCGROUP, on the one hand, and the cited registered mark, CASTLE MORTGAGE CORPORATION and design, on the other hand, have ever been used contemporaneously in the same geographical area. As to whether there has been sufficient opportunity for confusion to occur, in addition to the geographical divide between Alabama and Illinois, the record contains no indication of the level of sales or advertising by applicant. Yet the absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of

party uses of record. However, as noted by the Trademark Examining Attorney, the purported existence of these common law and trade name uses of the word CASTLE in connection with financial services has not been properly made of record, and we therefore have given them no evidentiary consideration whatsoever. See In re Duofold, Inc., 184 USPQ 638 (TTAB 1974).

one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur as we have not had opportunity to hear from the registrant on this point.⁷ All of these factors materially reduce the probative value of applicant's argument on the matter of actual confusion. Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

In summary, we find that applicant's services are closely related to the services identified in the cited registration, and that they accordingly are presumed to be

⁷ Applicant notes that registrant has been aware of applicant's use of its CASTLE marks "and has expressed no reservation or complaint." (applicant's reply brief, p. 3). However, if applicant had obtained and submitted to the Office a credible consent agreement between applicant and registrant - a signed agreement consenting to applicant's use and registration of its marks and containing detailed reasons why no likelihood of confusion exists and/or arrangements undertaken by the parties to avoid confusion of the public, that certainly would have been relevant to a balanced review of the du Pont factors by the Trademark Examining Attorney and/or by this Board.

marketed in the same trade channels and to the same classes of customers. We further find that applicant's marks and the registered mark are sufficiently similar that, when used in connection with the closely related financial and mortgage services involved in this case, source confusion is likely to result. Specifically, customers and prospective customers are likely to mistakenly assume the existence of a source connection between banking services offered under the mark CASTLE BANK, consumer lending services offered under the mark CASTLE FINANCE, and an array of banking and financial services offered under CASTLE BANCGROUP, on the one hand, and mortgage brokerage services offered under the mark CASTLE MORTGAGE CORPORATION and design, on the other hand. We conclude that the Trademark Examining Attorney's Section 2(d) refusal was appropriate as to each of applicant's three marks.

Decision: The refusals to register are affirmed.