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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re First Union Corporation

Serial No. 75/514,466

**Karl S. Sawyer, Jr.** of Kennedy Covington Lobdell & Hickman  
for First Union Corporation

**Michael Engel**, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney)

Before Seeherman, Walters and Chapman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

First Union Corporation has appealed from the final refusal of the Trademark Examining Attorney to register SURE PAY, with the word PAY disclaimed, as a mark for "banking services directed to corporate and business customers, namely, a security service monitoring checks deposited by such customers to detect fraudulent checks

Ser No. 75/514,466

prior to posting."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SUREPAY, previously registered for "overdraft protection and line of credit services,"<sup>2</sup> that, if used in connection with applicant's identified services, is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney filed briefs.<sup>3</sup> Applicant did not request an oral hearing.

We reverse the refusal of registration.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

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<sup>1</sup> Application Serial No. 75/514,466, filed July 7, 1998, and asserting a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,858,870, issued October 18, 1994; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>3</sup> The request from the Managing Attorney of Law Office 108 that the Examining Attorney's late-filed brief be accepted is granted.

Turning first to the services, applicant's services are a security service which monitors checks deposited by corporate and business customers to detect fraudulent checks prior to posting, while the cited registration is for overdraft protection and line of credit services. Applicant has explained that the purpose of its service is to prevent the unauthorized disbursement of funds from the account of a business or corporate customer. Although both services are offered by banks, there are significant differences between them and also in the customers for the services. Applicant's services are specifically offered to corporate and business customers, while applicant asserts that the registrant's identified services are "traditionally, if not exclusively, provided to personal checking account holders." Brief, p. 4.<sup>4</sup>

There is an overlap in the customers for applicant's and registrant's services, in that representatives of

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<sup>4</sup> The Examining Attorney contends that, "in the absence of any evidence to the contrary, it must be presumed that registrant's overdraft protection and line of credit services are offered to corporate and small business customers, as well as individuals." Brief, p. 4. However, applicant is not asserting that the registrant's services are offered only to individuals, but that the service identified in the registration is, by its very nature, a type that is offered only to individuals. Because the burden of proving likelihood of confusion is on the United States Patent and Trademark Office, it is the Examining Attorney who must show that overdraft protection services are offered to business and corporate customers, rather than applicant submitting evidence that they are not.

business and corporate customers are also individuals who could be exposed to the registrant's overdraft protection and line of credit sources. However, these customers must be deemed to be discriminating. They are not likely to assume that applicant's and registrant's services emanate from the same source solely because they both bear the mark SURE PAY/SUREPAY which, as discussed below, is highly suggestive.

With respect to the marks, they are identical in pronunciation and virtually identical in appearance. Applicant does not argue to the contrary. However, the marks are highly suggestive of the respective services, and their suggestive connotations are different. SUREPAY for the registrant's services suggests that a customer's checks will be honored even if the customer does not have funds in his account to cover them, i.e., the checks are sure to be paid. SURE PAY for applicant's services suggests that the business customer can be sure that it is paying only authorized checks.

Applicant has submitted a number of third-party SURE PAY registrations which support the position that registrant's mark SUREPAY is entitled to a limited scope of

protection.<sup>5</sup> These registrations are for SUREPAY for point-of-sale transaction-processing services for merchants;<sup>6</sup> SUREPAY and SUREPAY and design, both for disability income insurance underwriting services;<sup>7</sup> SUREPAY for automated payment processing system for insurance companies providing such companies with monthly summary reports of all vehicles processed for the insurance company and the salvage value received;<sup>8</sup> and SUREPAY and bird design for providing automatic debiting and crediting of financial accounts of businesses and their employees.<sup>9</sup>

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<sup>5</sup> During the course of prosecution applicant gave the particulars of the registrations, but did not submit copies. The Examining Attorney discussed the registrations, and never raised any objection as to their form. With its appeal brief applicant submitted copies of the registrations taken from the United States Patent and Trademark Office database. Because these copies merely evidence registrations which the Examining Attorney treated as being of record, and because the Examining Attorney did not object to their submission and discussed them in his brief, we have considered them. However, with its brief applicant also submitted copies of three pending applications which had previously not been discussed. Because they were not timely made of record, they have not been considered. In any event, third-party applications are not evidence of anything but the fact that they have been filed.

<sup>6</sup> Registration No. 2,057,647.

<sup>7</sup> Registration Nos. 1,959,987 and 1,969,570.

<sup>8</sup> Registration No. 1,794,418.

<sup>9</sup> Registration No. 1,537,636. This registration was cancelled in 1995, but was in existence at the same time as the other registrations, as well as the cited registration.

**Ser No.** 75/514,466

The Examining Attorney contends that none of these third-party registrations is for services as close to the registrant's as applicant's are. Even if we accept that this is true, what the registrations do show is that registrant's mark is entitled to a narrow ambit of protection.

Accordingly, when we consider the differences in the services, the discriminating nature of the purchasers, the highly suggestive nature of the marks and their different connotations, and the limited scope of protection to which the cited registration is entitled, we find that confusion is not likely.

Decision: The refusal of registration is reversed.