

THIS OPINION IS NOT A PRECEDENT  
OF THE TTAB

Hearing:  
October 11, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cardinal Financial Corp.

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Serial No. 75528485

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Ralph M. Tener of McCandlish & Lillard, P.C. for Cardinal  
Financial Corp.

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

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Before Seeherman, Quinn and Zervas, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Cardinal Financial Corporation has appealed from the  
final refusal of the Trademark Examining Attorney to  
register CARDINAL BANK N.A. and design, as shown below, for  
banking services.<sup>1</sup> The words BANK N.A. have been  
disclaimed.

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<sup>1</sup> Application Serial No. 75528485, filed July 22, 1998, and  
asserting first use and first use in commerce on June 8, 1998.



The drawing is lined for the colors red and blue to indicate that color is a feature of the mark.

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 CARDINAL FINANCIAL COMPANY and design, shown below, with the words FINANCIAL COMPANY disclaimed, previously registered for "banking services, namely mortgage bankers,"<sup>2</sup> that, as used in connection with applicant's services, it is likely to cause confusion or mistake or to deceive.

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<sup>2</sup> Registration No. 2216820, issued January 12, 1999; Section 8 & 15 affidavits accepted and acknowledged. While the word "bankers" in the registration may be a typographical error, it is plain that the banking services which "mortgage bankers" would offer are "mortgage banking services." Applicant appears to have acknowledged this, as it refers to the registrant's services as "mortgage services" or "mortgage banking services." See applicant's brief, p. 12. We have therefore construed registrant's identification of services to be "mortgage banking services."



The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

With its appeal brief applicant submitted three exhibits. Exhibit 1 is simply a page showing both applicant's and the cited marks, while Exhibits 2 and 3 consist of Internet evidence. The Examining Attorney has objected to this evidence as untimely. Trademark Rule 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of an appeal." We do not regard the mere placing of both applicant's and the cited marks on a single sheet of paper as new evidence; both marks are of record. Therefore, Exhibit 1 will be considered. However, the Examining Attorney's objection to Exhibits 2 and 3 is well taken. Applicant states that it is submitting this evidence pursuant to Section 1208.03 of the Trademark Trial and Appeal Board Manual of Procedure, but this section merely discusses the acceptability of Internet evidence; it does not provide that such evidence

may be submitted with an applicant's appeal brief, or otherwise contradict Trademark Rule 2.142(d).

Applicant has also asked, in the alternative, that "if the Board declines to accept such evidence at this point, the Applicant requests that the Board suspend the appeal and remand the application for further examination."

Brief, p. 3. The Board does not consider such "alternative" requests for remand. After an appeal has undergone full briefing and an oral hearing, and the Board determines that an evidentiary submission is untimely, the Board will not at that point consider a request for remand so that the untimely evidence can be made of record. To do so would be a severe waste of the Board's and the Examining Attorney's time and resources. If applicant had wished to ensure that the late-filed evidence would be of record, the proper procedure would have been to file a separately captioned request for remand, which also requested suspension of the appeal. Instead, applicant merely filed its appeal brief with the alternative request for remand literally buried in the text, in the second sentence of the second paragraph on page three.

We also point out that applicant's alternative request for remand is not supported by a showing of good cause. See TBMP §1207.02 (2d ed. rev. 2004). Applicant has

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provided no reason why it could not have made the Internet evidence of record prior to the filing of the appeal. In this connection, we note that the evidence consists of a page from the website of applicant's subsidiary, which also bears the copyright date 2002 (the appeal was filed in 2005), and a page from a Virginia state government website.

Accordingly, Exhibits 2 and 3, submitted with applicant's appeal brief, have been given no consideration.

Our determination of the issue 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). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

During the course of prosecution applicant advised the Examining Attorney that it had a previous application, Serial No. 75514741, for CARDINAL BANK in standard

character form, that this application was refused registration on the basis of the same registration at issue herein, and that that refusal was affirmed by the Board. That decision issued on July 14, 2005. Although applicant had previously requested that examination of the present application be suspended pending a decision in the appeal in Serial No. 75514741 "which is on appeal for a substantially identical issue," response filed January 14, 2005, in its brief applicant states the decision in the earlier appeal has no bearing on the instant appeal because the present CARDINAL BANKING and design mark is significantly different from its prior mark. However, we think that there are some significant similarities in the facts and issues that were discussed in the prior decision. Because it appears that many of the arguments made by applicant and the Examining Attorney in this appeal are identical to the arguments made previously, and discussed at some length in the July 14, 2005 decision, we will not repeat those arguments in detail in this opinion.

Turning first to the du Pont factor of the similarity of the services, applicant asserts that "banking services may only be provided by chartered banks, whereas mortgage services may only be provided by licensed mortgage bankers." Brief, p. 11. However, applicant also concedes

that "entities that offer 'banking services' also offer 'mortgage banking services.'" Id. We find it difficult to reconcile both of these statements. All we can assume is that applicant is referring, in its first statement, to either a technical interpretation of banking services, or restrictions with regard to banking services in a particular state or states.

In any event, we must determine the question of the similarity of the services as they are identified in applicant's application and the cited registration. In re Big Pig Inc., 81 USPQ2d 1436, 1438 (TTAB 2006) (the issue of likelihood of confusion is determined on the basis of the goods [or services] as identified in the involved application and cited registration, regardless of what the record may reveal as to the particular nature of the goods [or services], their actual trade channels or the class of purchasers to which they are in fact directed and sold). Applicant has identified its services as "banking services." The cited registration is for "banking services, namely mortgage bankers." Clearly mortgage banking services is a subset of banking services, and is thus encompassed by applicant's identification of goods.<sup>3</sup>

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<sup>3</sup> The registrant, during negotiations for a consent agreement, discussed infra, also treated applicant's identified "banking

To this extent, we must consider the services to be legally identical.

Moreover, we note that applicant's own brochure, which it submitted as a specimen, lists, under the heading "Consumer Loan Products and Services, "residential real estate loans." Because applicant also lists "home equity loans and home improvement loans in the same section, a consumer would reasonably consider "residential real estate loans" to be another term for home mortgages, and that providing mortgages is one of applicant's banking services.

In addition, the Examining Attorney has made of record a number of third-party registrations, based on use in commerce, which show that a single mark has been registered for, inter alia, banking services and mortgage banking services. See, for example, Registration No. 2659389 for MORTGAGE BY MORNING; Registration No. 2655443 for ALPINE BANK and design; Registration No. 2654093 for "FACES YOU KNOW...PEOPLE YOU TRUST."; and Registration No. 2623458 for HORIZON BANK. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods

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services" as encompassing "mortgage banking," since one of the registrant's requirements for the agreement was that applicant amend its identification to exclude "mortgage banking services."

and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

In view of the identifications of the services in applicant's application and the cited registration, and the evidence that banking services and mortgage banking may be offered by the same entity under a single mark, we find that applicant's services are identical in part and otherwise closely related to the registrant's identified services, and also that they are offered through the same channels of trade. Thus, the du Pont factors of similarity of the goods/services and similarity of trade channels favor a finding of likelihood of confusion.

This brings us to a consideration of the marks. Applicant's primary argument regarding the difference between its present mark and the cited mark goes to the appearance of the marks themselves.<sup>4</sup> Applicant points out that its mark is lined for the colors red and blue, as opposed to the cited mark which makes no claim to color, and that in its mark these "bright contrasting colors make the mark extremely forceful and distinctive." Brief, p. 5.

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<sup>4</sup> As noted previously, the Board found likelihood of confusion between applicant's mark CARDINAL BANK, N.A. and the cited mark in its decision in Serial No. 75514741. The only difference between that case and the present case is that applicant's mark herein is in special form and contains a design element.

Applicant also notes the different type font in which the words are shown, the differences in the depictions of the bird design, and the different meanings of the words BANK, N.A. and FINANCIAL COMPANY in the respective marks.

We must determine whether applicant's mark and the registered mark, when compared in terms of appearance, pronunciation, connotation and commercial impression, are similar or dissimilar. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In analyzing whether the marks are similar or dissimilar, we are guided by the following principles. First, it is well-established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Second, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the

respective marks is likely to result. Centraz Industries Inc. v. Spartan Chemical Co., 77 USPQ2d 1698 (TTAB 2006). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). Third, when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Considering the appearance of the marks, they are overall very similar. Both contain the identical word CARDINAL, followed by generic wording for the services (BANK, N.A. and FINANCIAL COMPANY). Although the generic wording differs, it does not serve to distinguish the marks because consumers will look to and refer to CARDINAL as the source-indicating element of the marks. In saying this, we have considered applicant's argument that the presence of the words BANK, N.A. and FINANCIAL COMPANY in the respective marks does, in this particular case, serve to distinguish them because "the longstanding regulatory separation of the functions of banks and mortgage bankers"

has caused the public to distinguish banking services from mortgage banking services. Brief, p. 9. In support of this position, applicant asserts that under Pennsylvania state law a bank must have the word "bank" or "banking" in its name, while a mortgage banker which is not a bank is prohibited from using a name which implies that it is a bank. Thus, it appears to be applicant's position that consumers would regard the different generic terms in the respective marks as pointing to different sources of the services because they would understand the different meanings of these words, and that applicant's mark indicates a chartered bank, while the registrant would not be a chartered bank because the word BANK does not appear in its mark. We are not persuaded by this argument. It is not clear what familiarity consumers have with various state laws as to when the term BANK may be used in a trademark, or whether they would ascribe any significance to the presence or absence of this word in a mark, since the same entities offer banking services and mortgage banking services. As the Board stated in its July 14, 2005 opinion, "it is still likely that consumers could reasonably believe, in light of the similarities in sound, appearance, connotation and overall commercial impression between the respective marks due to the shared term

'CARDINAL,' that the respective services have a common source or sponsorship if such services are otherwise commercially related." Slip op. pp. 7-8.<sup>5</sup>

The marks are also similar in that they contain a drawing of a bird. Although there are certain differences in the way the bird is depicted, in each mark it is obviously a cardinal and, thus, the design element in each mark reinforces the meaning of the word CARDINAL. As noted above, applicant relies heavily on the fact that its mark is lined for the colors red and blue. However, although the cited registration does not claim color as a part of the mark, this does not mean that the mark may only be depicted in black and white. On the contrary, the cited mark may, for example, be depicted in the same color red that is used in applicant's mark, or it may use red for the same parts of its mark that are colored red in applicant's mark. We have also taken note of applicant's argument that

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<sup>5</sup> Applicant also argues, in its reply brief, that in *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988), the Court found that the generic components BANK OF NEW YORK and TRUST & SAVINGS BANK were deemed by the parties and the Federal Circuit to adequately distinguish the two marks. As the applicant apparently recognizes, a key component of that decision was the consent agreement by the parties, i.e., that the parties themselves concluded that confusion was not likely. That key component is not present in the instant case, and we do not read Amalgamated as in any way standing for the proposition that the inclusion of different generic terms in an otherwise identical mark is sufficient to distinguish the marks.

the marks use different type fonts, but again, we do not consider these differences to be distinguishing. The fonts in neither mark are so unusual that they would make a particular impression, or cause consumers to distinguish the marks on this basis.

We acknowledge that there are specific differences in the appearance of the marks that can be pointed out when the marks are compared side-by-side. However, as noted above, this is not the appropriate method for comparison. Overall, the marks are very similar in appearance, consisting of the dominant word CARDINAL followed by the generic names for the services, a design of a cardinal bird, and even lining that emphasizes the words (CARDINAL is underlined in applicant's mark, and there are lines above and below the words in the cited mark).<sup>6</sup> Consumers,

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<sup>6</sup> Applicant argues in its brief that the dominant part of the cited mark is the capital C with a bird perched on it, while as for its own mark, it states, variously, that the most prominent, noticeable component is the word CARDINAL (brief, p. 5), the dominant part of its mark is either the red bird or the word CARDINAL (brief, p. 8), and CARDINAL is "unquestionably the dominant component in the Applicant's mark" (reply brief, p. 2). At the oral hearing, applicant acknowledged that the word CARDINAL is the dominant part of both marks. We note that in the July 14, 2005 decision the Board found CARDINAL to be the dominant element of the registrant's mark and of applicant's word mark CARDINAL BANK, N.A. Suffice it to say that, because of the prominent appearance of the word in both marks, the fact that the services would be referred to by the words, rather than the design, and the fact that the other wording in both marks is generic, we have no doubt that CARDINAL is the dominant element of both marks.

retaining a general impression of the marks, are likely to misremember the slight differences in the marks, and to view the marks as the same. Moreover, even if some consumers would note that applicant's mark contains the generic words BANK, N.A., and the registered mark has the generic words FINANCIAL COMPANY, such consumers are likely to think the services still emanate from a single source which is using variations of a single mark to represent different services that it offers.<sup>7</sup>

Applicant's special form drawing does not change the pronunciation of its previous mark, CARDINAL BANK, N.A. in standard character form, which was the subject of its previous application. Again, we find that the marks are extremely similar in pronunciation, the dominant word CARDINAL being pronounced identically in both marks. For the reasons already stated, the difference in pronunciation

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<sup>7</sup> Applicant makes the argument that because of the concept of branding, a company creates a single consistent identity for its family of products or services. Applicant further contends that consumers are aware of this principle, and would think it unusual for a company to adopt two different logos, which do not follow a consistent approach. Applicant has not submitted any evidence in support of this position and, for the reasons we have given in finding the marks to be similar, we are not persuaded that consumers would think the two marks in question are so different that they do not identify a single source. We also note from the consent agreement that applicant uses a variety of marks containing the element CARDINAL, but not all have the words CARDINAL BANK, N.A, e.g., CARDINAL BANK, CARDINAL ONLINE BANKING, CARDINAL ONLINE BUSINESS BANKING.

of the generic wording BANK, N.A. and FINANCIAL COMPANY does not serve to distinguish the marks. Nor, for the same reasons, do the differences in these words serve to distinguish the marks in their connotation. Both marks convey the meaning of the cardinal bird, a meaning that is emphasized by the inclusion of the design of the bird in both marks. Overall, the marks are very similar in appearance, pronunciation and connotation, and they convey very similar commercial impressions.

The du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

Applicant asserts that the factor of the conditions of purchase (the 4<sup>th</sup> du Pont factor) favors applicant.

Applicant argues that because consumers are entrusting their money to a bank they will give heightened scrutiny to banks while, because the acquisition of a home mortgage is the largest financial commitment most people make, and the relationship typically lasts for many years, potential customers exercise heightened scrutiny in selecting their mortgage companies. Although the decision to open a bank account or obtain a mortgage is not made on impulse, we do not agree with applicant that the prospective consumer acts

with more than ordinary care.<sup>8</sup> Ordinary consumers, who are not familiar with the peculiarities of banking laws in different states, are not likely to accord any significance to whether a generic term in a bank or mortgage lenders' mark is BANK or FINANCIAL COMPANY. Accordingly, although this du Pont factor favors applicant to the extent that we accept that the purchasing decision will not be made on impulse, it does not outweigh the similarities in the marks, or cause us to find that consumers will note the slight dissimilarities in the marks and therefore not be confused.

Applicant also argues that, because the banking industry is replete with business names and marks that use the same components, such as FIRST, NATIONAL, FEDERAL, TRUST and SAVINGS, the public is more conditioned to look carefully at the names of banks and note the differences between them. We make no comment on the use of such terms as FIRST, NATIONAL, etc., as there is no evidence of such

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<sup>8</sup> For example, although one may have a mortgage for decades, the institution that owns the financial paper may change many times during this period. Once a homeowner has received the mortgage, so that the money can be used to purchase the home, the name of the company that holds the paper is largely irrelevant to him. As the Court stated in *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, supra, 842 F.2d at 1274, 6 USPQ2d at 1308, quoted by applicant in its brief: "Others do not even know that they will be customers of a bank until they discover that they are, i.e., when paper they have signed, payable to someone else, is assigned to a bank."

use in the record. As for third-party marks which contain the word CARDINAL, there are two registrations which are of record, No. 2131555 for CARDINAL CA\$H for debit card services and No. 2436074 for CARDINAL CAPITAL MANAGEMENT, INC. for investment counseling and portfolio management services, both of which were cited against the applicant's application and later withdrawn as a result of applicant's submission of consent agreements. The consent agreements provide evidence of the use of these marks.<sup>9</sup> Thus, there is evidence of three companies using the term CARDINAL for services in the financial field. However, the number of third-party uses is so limited, and the services for which those third-party marks are used are sufficiently different from each other and from the cited registrant's "mortgage banker services," that we cannot conclude that the public is so accustomed to seeing CARDINAL marks for financial services that they will distinguish applicant's mark and the mark in the cited registration on the basis of the very slight differences between applicant's and the registrant's mark, where the services are legally identical.

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<sup>9</sup> Another application, Serial No. 74671304 for CARDINAL MERCHANT SERVICES, was also cited as a potential bar, but this application was abandoned. Therefore, the application is not evidence that the mark was ever used.

Applicant also argues that there have been "nearly eight years of concurrent use" without any instances of actual confusion. Brief, p. 13. Applicant bases its statement on the June 8, 1998 first use dates claimed in its application and the August 1, 1987 first use dates claimed in the cited registration. (Applicant's appeal brief was filed in March, 2006.) We give little probative weight to this statement, since we have no information about whether the companies are engaged in business in the same geographic areas, or the extent of their activities and advertising should they be in overlapping areas.<sup>10</sup> We also note applicant's statement that, during negotiations with the registrant to obtain a consent agreement, registrant never asserted it was aware of any actual confusion. However, because there is no evidence of the amount or extent of applicant's and the registrant's use, we cannot conclude that there has been an opportunity for confusion to occur, if it were likely to occur. Thus, we treat the du Pont factor of "concurrent use without

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<sup>10</sup> We note that applicant asserts that the registrant has been licensed to engage in mortgage lending in Virginia since June 15, 2000, and that applicant has its headquarters in Virginia. However, applicant bases its statement about registrant's activities on evidence that is not properly of record (Exhibit 3) and, moreover, having a license to do business is not the same as evidence that a company is engaging in business on a meaningful level.

evidence of actual confusion," as well as the factor of instances of actual confusion, as neutral.

Finally, applicant points to a consent agreement that was drafted during negotiations with the registrant. This agreement was never signed, and we therefore cannot treat it as a consent by registrant to the registration of applicant's mark, or otherwise give it the deference that is normally accorded to the views of the parties who would best know the marketplace and be in the best position to determine whether confusion is likely. See *In re du Pont*, supra. Applicant argues that we may look to certain language in the agreement, specifically the statement in paragraph 2: "The parties agree that there is no likelihood of confusion, mistake or deception resulting from the use and registration of their respective marks, as identified in Registrant's U.S. Registration No. 2,216,820 (hereinafter 'Registrant's Federal Registration') and Applicant's Amended Applications and as described in this Agreement." Applicant asserts that despite the registrant's redlining of much of the agreement, this paragraph, stating that there is no likelihood of

confusion, was retained, and that this reflects the registrant's view of the marketplace.<sup>11</sup>

However, this paragraph is only part of the agreement, which also provides, in paragraph 1, that applicant will amend the identification of services in its application to expressly exclude "mortgage banking services." We cannot read paragraph 2 without paragraph 1; registrant's agreement that there is no likelihood of confusion is clearly contingent on the deletion of mortgage banking services from applicant's application. Thus, even if the agreement had been executed, we could not view it as a consent to register applicant's mark with its present identification of services. Accordingly, we give this unsigned agreement no probative weight.

We also give no persuasive value to applicant's statement that the registrant has been aware of applicant's use of its mark since 2001 but has never demanded that applicant cease using its mark. The fact that the registrant has not yet taken any action against applicant cannot be regarded as a consent to applicant's registration of the mark. See *National Cable Television Ass'n, Inc. v.*

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<sup>11</sup> Applicant has explained that the consent agreement was not finalized because the registrant wanted applicant to change its trade name to remove the component FINANCIAL.

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American Cinema Editors, Inc., 937 F.2d 1572, 1581, 19 USPQ2d 1424 (Fed. Cir. 1991) (laches cannot begin to run until a mark is published for opposition).

Because applicant's and the registrant's services, as identified, are legally identical in part and are otherwise closely related; because the marks are very similar in appearance, pronunciation, connotation and commercial impression, the differences between them being insignificant in terms of differentiating source; and because the services are purchased by the public at large, exercising ordinary care, we find that applicant's use of CARDINAL BANK N.A. and design in connection with banking services is likely to cause confusion with the mark CARDINAL FINANCIAL COMPANY and design for the identified "banking services, namely mortgage banker."

Decision: The refusal of registration is affirmed.