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Mailed 8/26/03  
Paper No. 15  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cogent Investment Operations Limited

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Serial No. 75/719,063

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Martin P. Hoffman of Hoffman, Wasson & Gitler, PC for  
Cogent Investment Operations Limited.

Toni Y. Hickey, Trademark Examining Attorney, Law Office  
115 (Tomas Vlcek, Managing Attorney).

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Before Simms, Cissel and Holtzman, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 2, 1999, applicant, a company organized under  
the laws of the United Kingdom with principal offices in  
London, England, filed the above-referenced application  
seeking registration on the Principal Register of the mark  
"COGENT" in connection with "financial administration  
services; investment administration services; fund  
management services; information and advisory services

relating thereto," in Class 36. Applicant asserted that it possessed a bona fide intention to use the mark in commerce in connection with the services and also asserted a claim of priority based on United Kingdom application No. 2186227, filed on Jan. 14, 1999.

The Examining Attorney<sup>1</sup> refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark "COGENT," which is registered<sup>2</sup> for "business consulting services," in Class 35 and for "financial consulting services," in Class 36, that confusion is likely. The Examining Attorney reasoned that this is so because the marks are identical and the services set forth in the application "are highly related to" the services identified in the cited registration. Applicant was also advised to submit a certified copy of its United Kingdom registration.

Applicant responded to the refusal to register by amending the recitation of services in the application to read as follows: "financial, investment, and fund management services provided to investment operations,

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<sup>1</sup> This application was subsequently assigned to a second Examining Attorney.

<sup>2</sup> Reg. No. 1,537,607, issued on the Principal Register to Cogent Systems, Inc. on May 2, 1989. Use since June 1, 1985 was claimed; subsequently assigned to Tele-Matic Corp.; combined affidavit under Sections 8 and 15 of the Act accepted and acknowledged.

namely, banking, settlement of transactions, custodian management, financial accounting, company secretariat, and administration of retail commercial products." Applicant argued that, as identified, its services are clearly distinguishable from the business and financial consulting services identified in the cited registration.

The Examining Attorney was not persuaded by applicant's response to withdraw the refusal to register based on Section 2(d) of the Lanham Act, and also advised applicant that the terms "custodian management," "company secretariat" and "administration of retail commercial products" in its amended recitation of services are unacceptable because the nature of these services is unclear. Applicant was advised to amend the application either to delete this wording or to properly identify these activities. In this regard, the Examining Attorney suggested acceptable recitations of services for both Class 35 and Class 36. The Examining Attorney maintained the requirement for applicant to submit a certified copy of its United Kingdom registration.

Applicant responded to the second Office Action by amending the recitation of services to read as follows:  
"financial accounting services; company secretariat services, namely, maintaining corporate records, preparing

annual returns, issuing share certificates, and preparing minutes and resolutions, all provided to investment operations, in International Class 35; and financial, investment, and fund management services provided to investment operations, namely, banking, settlement of transactions, custodian management services of financial portfolios of others; and administration and brokerage of retail financial commercial products, namely, stocks, bonds, mutual funds, consumer loans and student loans, in International Class 36." The additional filing fee for the additional class was included. Applicant argued that its services provided to investment operations are readily distinguishable from the financial consulting services set forth in the cited registration such that there is no likelihood of confusion. Additionally, applicant promised to send a certified copy of its United Kingdom registration in due course.

The Examining Attorney suspended action on this application pending receipt of a certified copy of applicant's United Kingdom registration, and the refusal to register under Section 2(d) of the Act was maintained. Applicant did submit a certified copy of its United Kingdom registration and urged the Examining Attorney to withdraw the refusal based on likelihood of confusion. Applicant

repeated its contention that its services are distinctly different from the services specified in the cited registration.

In response, the Examining Attorney considered applicant's arguments, but maintained and made final the refusal to register under Section 2(d) of the Act. He noted that the marks are identical and submitted twenty third-party registrations which list business consulting services and accounting services in Class 35 or financial consulting services and banking-related services in Class 36. The Examining Attorney contended that this evidence illustrates that it is common for businesses providing business and financial consulting services to also provide accounting and/or banking-related services. Acknowledging the truth of applicant's contention that sophisticated purchasers are frequently involved in making the types of purchases that involve the services of applicant and the owner of the cited registration, the Examining Attorney noted that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or that they are immune from source confusion.

Applicant responded with yet another amendment to the recitation of services in the application. As amended, applicant's services are now identified as "administration and brokerage of retail financial commercial products, namely, stocks, bonds, mutual funds, consumer loans, and student loans, in International Class 36." The services previously claimed in Class 35 were deleted. Applicant argued that its Class 36 services are directed at different consumers, namely sophisticated, financially adept investors, from the consumers of the services identified in the cited registration, and that differences between these services outweigh the similarities between the marks at issue.

The Examining Attorney accepted applicant's amendment to the recitation of services, but maintained the final refusal to register based on likelihood of confusion. As additional support for the refusal, the Examining Attorney submitted a sample of ten third-party registrations wherein the listed services include both financial consulting services and the administration and/or brokerage of financial products.<sup>3</sup> She argued that given the relationship between these services, it is plausible that they may be

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<sup>3</sup> The three registrations which were not based on use were not considered.

marketed in the same channels of trade to the same consumers, and that, accordingly, use of the same mark in connection with both types of services is likely to cause confusion.

Applicant timely filed a Notice of Appeal, followed by an appeal brief, and the Examining Attorney responded with her brief on appeal, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written record and the written arguments presented in this appeal.

The issue before us is whether applicant's mark so resembles the cited registered mark that if applicant were to use the mark it seeks to register in connection with the services specified in the application, as amended, confusion with the registered mark would be likely. We agree with the Examining Attorney that it would, and thus that the refusal to register is well taken.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarities between the marks as to appearance, pronunciation, meaning and commercial impression and the similarity of the goods

or services in connection with which the marks are used. In the instant case, the marks are identical in every respect. The commercial impression applicant's mark creates in connection with applicant's administration and brokerage of financial products is the same as that which is engendered by the registered mark in connection with registrant's business consulting services and financial consulting services.

When the marks at issue are identical, the relationship between the goods or services of the respective parties does not need to be as close to support a finding of likelihood of confusion as would be the case when differences exist between the marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). In the instant case, the use-based third-party registrations submitted by the Examining Attorney which list both financial brokerage services and financial consulting services have probative value to the extent that they serve to suggest that the listed services are of the type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ 2d 1783 (TTAB 1983); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988); and cases cited therein.

Applicant did not submit any evidence in support of its arguments that these services are unrelated and that the customers for each are different, so the evidence establishing that they are closely related stands un rebutted.

Applicant's contentions concerning the services actually rendered by the registrant under the registered mark are irrelevant. It is well settled that our determination of whether confusion is likely must be made based on the ways the services are identified in the application and the cited registration, respectively, without any restrictions or limitations not reflected therein. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983).

In summary, the record establishes that confusion is likely because the marks are identical and the services set forth in the application are related to those listed in the cited registration. Moreover, any doubt regarding the issue of whether confusion is likely must be resolved in favor of the prior user and registrant. In *re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). As the second comer, applicant had a duty to choose a mark which is unlikely to cause confusion with any other mark already in use in its field of commerce. Lone

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Star Manufacturing Co. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368 (CCPA 1974). By choosing a mark which was already in use and registered for commercially related financial services, applicant did not meet this obligation.

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.