

Oral Hearing:
August 1, 2002

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

September 30, 2002
Paper No. 15
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SmartMoney

Serial No. 75/904,311

Vincent N. Palladino and Kristen L. Fancher of Fish & Neave for SmartMoney.

Branden Richie, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Quinn, Hohein and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

SmartMoney has filed an application to register the mark "SMARTMONEY" for "computer software for providing investment, business and financial news and information via the global computer network, via local computer networks, and for use on personal computers, excluding programs designed for academic use for students."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75/904,311, filed on January 27, 2000, based on an allegation of a bona fide intention to use such mark in commerce. On December 19, 2000, applicant amended the application to identify the goods as set forth above and, by an amendment to allege use, claimed a date of first use anywhere and first use in commerce of January 25, 2000.

applicant's mark, when used in connection with its goods, so resembles the mark "SMART MONEY," which is registered for "interactive computer programs for educational use, and instructional manuals sold as a unit therewith,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), two key considerations in any likelihood of confusion analysis are the similarity of the goods and the similarity of the marks.³ Additionally, as reflected in this case by the implied consent to registration arising from the detailed provisions of a prior settlement agreement, the market interface between applicant and the owner of the mark which is the subject of the cited registration, namely, Beneficial Franchise Company, Inc. ("Beneficial"), is a factor which is entitled to "substantial weight ... as evidence that likelihood

² Reg. No. 2,095,401, issued on September 9, 1997, which sets forth a date of first use anywhere and first use in commerce of September 1991.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

of confusion does not exist." In re Four Seasons Hotels Ltd., 987 F.2d 1565, 26 USPQ2d 1071, 1074 (Fed. Cir. 1993).

Turning first to consideration of the respective marks and goods, we agree with the Examining Attorney that applicant's "SMARTMONEY" mark is identical, as a practical matter, to registrant's "SMART MONEY" mark in sound, appearance, connotation and overall commercial impression. The Examining Attorney argues, in view thereof, that the relationship between the goods at issue "need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks," citing *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981) and TMEP §1207.01(a).

In any event, as his principal argument, the Examining Attorney further contends that in light of the definition of record of the term "educational" in The American Heritage Dictionary of the English Language (3rd ed. 1992) as an adjective meaning, *inter alia*, "2. Serving to educate; instructive: *an educational film*," registrant's registration "encompasses all types of computer programs for 'educational use'" in that it "includes any type of software that serves an instructive purpose." Likewise, the Examining Attorney asserts, applicant's computer software "is instructive in nature" because it "is for *providing* investment, business and financial news and *information*" (italics in original).⁴ Thus, according to the

⁴ The Examining Attorney, in support of his position, additionally insists that the copies of 26 third-party registrations which he has made of record "show that software for educational use frequently contains informational functions." Specifically, the Examining Attorney urges that the language "computer software for providing

Examining Attorney, "[s]oftware that provides information is instructive in nature and certainly falls within the scope of the registrant's software for 'educational use.'"

As to applicant's limitation of the identification of its goods by "excluding programs designed for academic use for students," the Examining Attorney maintains that "this exclusion does not eliminate the likelihood of confusion inasmuch as:

Computer programs "for academic use for students" are only one type of educational software. The registration is not limited to any one type of educational software, but rather encompasses all computer software for any and every type of "educational use." The registrant's identification is not limited to software for academic use for students. Because software for providing business, investment and financial information is within the broad category of software for "educational use," the limitation at the end of the applicant's amended identification of goods does not overcome the likelihood of confusion.

investment, business and financial ... information" in the identification of applicant's goods "encompasses software for providing educational information about finances, investments and business" and that "[m]any of the attached third-party registrations describe the function of those software programs as ... 'for providing educational information.'" However, as applicant persuasively notes in its reply brief (*italics in original*):

[T]hird[-]party registrations which use the term "providing educational information do not show that SmartMoney's (information) programs encompass Beneficial's (educational) programs, as the Trademark Attorney contends All they show is that certain third parties have registered marks for products (some of which are not even computer programs) that provide "educational information."
....

If the "educational information" registrations show anything, it is that "information" need *not* be "educational." If all information were "educational," there would be no need to specify that the information in the registrations is "educational" information (as opposed to some other kind of information).

Applicant, on the other hand, argues among other things that (*italics in original*):

Even if the Trademark Attorney's approach were sound, it would not establish that SmartMoney's programs are identical to Beneficial's programs. Although he has supplied a dictionary definition that (i) equates "educational" with "instructive," he has not provided a dictionary definition that (ii) equates "instructive" with "information," as his own reasoning requires.

Moreover, if his reasoning were sound, it would demonstrate that SmartMoney's computer programs are *not* identical to Beneficial's computer programs for "educational use," because SmartMoney's programs provide "news" and there is no evidence that a dictionary defines "educational" as "news." Given this, it is no wonder that the Trademark Attorney has not tried to apply this approach to the "news" aspect of SmartMoney's programs.

We are constrained to agree with the Examining Attorney that to the extent that applicant's software provides investors and others who are not students with investment, business and financial news and information which is of general educational value, there is some limited overlap between applicant's goods and the interactive computer programs for educational use offered by registrant. The definition of the term "educational" which is of record from The American Heritage Dictionary of the English Language (3rd ed. 1992) lists such word as an adjective which, we note, also means "1. Of or relating to education." In addition, we judicially notice that the same dictionary, in a later version (4th ed. 2000), defines "instructive" as an adjective meaning "[c]onveying knowledge or information; enlightening" and sets forth "academic" as an adjective signifying, in relevant part:

"1. Of, relating to, or characteristic of a school, especially one of higher learning. 2a. Relating to studies that are liberal or classical rather than technical or vocational. b. Relating to scholarly performance: *a student's academic average*. 5. Based on formal education."⁵ However, in view thereof, it is clear that while applicant's goods have some incidental educational or possibly even instructive use, they primarily provide news and information on various investment, business and financial topics and specifically exclude the kinds of pedagogical or instructive computer programs offered by registrant, which by their interactive nature are plainly designed chiefly for providing education which is academically oriented towards students. Consequently, while the respective goods are both computer programs or software, their educational purposes or uses are for the most part quite different.

This brings us to consideration of the remaining factor herein, which is, the market interface between applicant and registrant as reflected by the implied consent to registration arising from the detailed provisions of their prior settlement agreement. By way of background, applicant has made of record evidence consisting of the declaration, with an exhibit, of Sari B. Granat, who is "Counsel of Dow Jones & Company, Inc. ..., a partner in applicant partnership," and the declaration, with

⁵ It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7.

Ser. No. 75/904,311

exhibits, of Vincent N. Palladino, who is one of its attorneys herein.

The Granat declaration states, among other things, that applicant's "SMARTMONEY trademark has been used in connection with the goods covered by [the instant] application Serial No. 75/904,311 since at least as early as January 25, 2000"; that applicant "is not aware of any instance in which the use of SMARTMONEY for the goods covered by this application have [sic] given rise to any confusion"; that applicant "has not received any objection or other communication from Beneficial Franchise Company, Inc. regarding its use of SMARTMONEY for the goods covered by the application"; that applicant "previously filed an application to register SMARTMONEY, application Serial No. 74/557,947, for computer programs providing investment, business and financial news and information, the same description of goods that [originally] appeared in this application"; that "[t]he Trademark Attorney assigned to that application did not find Beneficial's application, or any other application or registration, was confusingly similar to the SMARTMONEY application"; that "Beneficial opposed the SMARTMONEY application, as well as two other SMARTMONEY applications"; that, as shown by the copy thereof attached as Exhibit 1, "Beneficial withdraw [sic] its oppositions with prejudice after applicant amended the goods covered by its applications"; and that, in particular, "[t]he goods covered by application Serial No. 74/557,947 were amended to: computer programs providing

investment, business and financial news and information, excluding programs designed for academic use for students." As evidenced by Exhibit 1, the pertinent portion of which is reproduced below, Beneficial's withdrawal of its oppositions (Opposition Nos. 99,181, 99,257 and 99,641) to applicant's involved applications was specifically conditioned upon applicant's amendment of the identification of goods therein:

Opposer, Beneficial Franchise Company, Inc., hereby withdraws with prejudice the above identified oppositions, in light of the amendments to the identification of goods filed by Applicant in the applications at issue, which has been approved and entered by the Board.

The Palladino declaration adds, in relevant part, that "[i]n the opposition Beneficial brought against applicant's application Serial No. 74/557,947, discovery showed that the goods in what became Beneficial's Registration No. 2,095,401 were actually 'an interactive computer game to help high school students learn about money management'; that "[a]ttached as Exhibit 3 is promotional material for that game"; that "[a]fter reviewing that evidence," Mr. Palladino "wrote to Beneficial's counsel on August 8, 1996," stating that, as shown by the copy thereof attached as Exhibit 4 (underlining in declaration):

... Beneficial's and SmartMoney['s] goods, services and prospective customers are different As you know, our client publishes the well known SMARTMONEY magazine, which I understand Beneficial does not consider confusingly similar to Beneficial's mark. The goods and services in the applications filed by our client are essentially extensions of the magazine. SmartMoney's prospective customers are sophisticated, financial investors who are familiar with the magazine. By contrast,

Beneficial's application is for "interactive computer programs for educational use, and instructional manuals sold as a unit therewith", and the documents produced by Beneficial show that the product is a computer program for students which teaches them how to budget money[;]

and that in such letter, Mr. Palladino also "suggested that the dispute might be resolved by an amendment of applicant's goods." In particular, besides explicitly stating applicant's view that "[t]here ... is no likelihood of confusion between Beneficial's mark and SmartMoney's mark," the August 8, 1996 letter from applicant's counsel to registrant's attorney contains the following suggestion, based upon the reality of the marketplace, as to resolution of the issue of likelihood of confusion:

Considering these differences, it would appear that there should be some way to revise the description of goods and services in the applications, which would allow the parties' marks to coexist on the Register. Although SmartMoney is confident of the outcome of these proceedings, it is raising the possibility of resolving this dispute along these lines before the parties invest more time, effort and money.

The Palladino declaration continues by stating that, "[f]ollowing a conversation with Beneficial's attorney, another attorney [for applicant] ..., Lisa Cristal, wrote to Beneficial's counsel on September 12, 1996, concerning such an amendment," as demonstrated by the copy of such letter attached as Exhibit 5; that "[o]n September 18, 1996, Beneficial's counsel replied to Ms. Cristal's letter, stating" that, as set forth in the copy thereof attached as Exhibit 6:

Our client has accepted SmartMoney's proposals for amending the description of the goods and services in its applications, as

suggested in your letter of September 12, 1996.

Accordingly, we will withdraw the oppositions to your client's applications, with prejudice, as soon as the amendment to the specifications of goods and services of your client's applications has been entered by the Trademark Office[;]

and that, "[i]n response, Ms. Cristal sent Beneficial's counsel a copy of the amendment on September 25, 1996," as shown by the copies of such documents attached as Exhibit 7. That exhibit, it is noted, indicates that Ms. Cristal's September 25, 1996 letter to Beneficial's counsel states in particular that: "Your September 18, 1996 letter set forth the terms by which the parties have agreed to resolve the ... matter."

Applicant asserts in its main brief that by its present application it has simply reapplied to register its "SMARTMONEY" mark for what are the same goods as it and registrant agreed upon as part of their settlement of the oppositions involving applicant's prior applications. Specifically, applicant insists in such brief that (footnote omitted):⁶

⁶ Although applicant also maintains in its main brief that, "[w]hen filed, SmartMoney's current application Serial No. 75/904,311 inadvertently failed to incorporate the modified description of goods that Beneficial had agreed to in dismissing its opposition," applicant accurately points out that "in prosecuting the current application, SmartMoney ... requested that its application be amended to incorporate this modified description," including the limitation "excluding programs designed for academic use for students." Moreover, while the Examining Attorney required applicant to amend the application to identify the manner or method by which its computer software provides investment, business and financial news and information, we observe that there is no contention by the Examining Attorney, nor would such an assertion be well taken, that the addition to the identification of goods of the language "via the global computer network, via local computer networks, and for use on personal computers" in any way affects the substantive merits and legal effect of the settlement agreement reached by applicant and registrant in the prior oppositions.

SmartMoney's time to file a Statement of Use in connection with application Serial No. 74/557,947 expired on January 28, 2000. Believing it could not provide evidence of use of SMARTMONEY by January 28, 2000, SmartMoney filed the current intent-to-use application Serial No. 75/904,311 to register SMARTMONEY on January 27, 2000 and allowed its earlier application Serial No. 74/557,947 to become abandoned. The description of goods in the current application paralleled the ... description in application Serial No. 74/557,947 [as amended].

In fact, SmartMoney later discovered that it had actually begun to use its mark at least as early as January 25, 2000. Had SmartMoney realized this earlier, it could have filed a Statement of Use in connection with its earlier application, which would have resulted in a registration without any need to file the current application.

Applicant argues, inter alia, that "[i]t is well settled that agreements between parties concerning one party's right to register a mark should be accorded 'great weight,'" citing *Amalgamated Bank v. Amalgamated Trust and Savings*, 842 F.2d 1270, 6 USPQ2d 1305, 1307 (Fed. Cir. 1988) and the cases cited therein.⁷ The settlement agreement reached in the prior

⁷ Applicant, in its main brief, also asserts that "[w]hen an opposition is dismissed with prejudice, [the] opposer is estopped from seeking to resurrect this claim" and that consequently "[t]hat principle would preclude Beneficial from opposing SmartMoney's current application." In particular, applicant urges in its reply brief that "Beneficial's estoppel has a direct and critical bearing on SmartMoney's right to register SMARTMONEY" and that the Examining Attorney has improperly dismissed such contention in his brief as "irrelevant" because "[w]hether or not the registrant has the right to oppose the applicant's mark has no bearing on whether the relevant consumers are likely to be confused as to the origin of the applicant's computer programs." However, applicant's "estoppel" argument, rather than meriting separate consideration under the *du Pont* factor which considers the equitable defenses of "laches and estoppel attributable to [the] owner of [a] prior mark and indicative of lack of confusion," is more properly viewed under the *du Pont* factor which, as discussed

opposition proceedings, by which "SmartMoney and Beneficial agreed that excluding 'programs designed for academic use for students' from the description of goods in SmartMoney's prior application would eliminate a likelihood of confusion and, thus, warrant dismissal with prejudice of Beneficial's opposition to that application," likewise requires a finding of no likelihood of confusion when such agreement is given proper weight, applicant contends (underlining in original). The reason why

above, deals with "agreement provisions designed to preclude confusion."

In addition, applicant contends in its main brief that "[i]t is well settled that the position a party takes regarding the likelihood of confusion between marks should weigh heavily against it if it later seeks to take a position that is inconsistent with its original position." Based upon certain other facts, as set forth in the Palladino declaration and supporting documents attached thereto, applicant maintains that (footnote omitted; underlining in original):

That principle would effectively preclude Beneficial from successfully opposing SmartMoney's current application. After Beneficial filed the application that resulted in Registration No. 2,095,401 of SMART MONEY, Security Pacific National Bank ("Security Pacific") opposed, asserting that it owned rights in its registered SMART MONEY mark for "banking services, namely checking, savings and credit reserve loan account services" and that Beneficial's mark was likely to cause confusion. In its answer, Beneficial denied that there was a likelihood of confusion, and took the position that Security Pacific was estopped from opposing Beneficial's application because Security Pacific's registration already coexisted with other SMART MONEY marks. Beneficial's Registration No. 2,095,401 was subsequently granted.

Applicant, in view thereof, concludes that Beneficial, by "[h]aving denied that its SMART MONEY mark was confusingly similar to Security Pacific's SMART MONEY mark for financial services, ... is effectively precluded from turning around and arguing that its SMART MONEY mark is confusingly similar to SMARTMONEY for SmartMoney's goods, which provide information regarding investment, business and financial news [and information]." However, even if, notwithstanding the difference between applicant's goods and Security Pacific's services, such were to be the case, suffice it to say that the Examining Attorney, who obviously was neither a party to the prior proceeding involving Security Pacific nor in privity with Beneficial, is not precluded thereby from citing Beneficial's registration as a possible bar under

such should be so, applicant explains, is that based upon discovery in the prior proceedings, it is plain that "[m]arketplace realities -- including the difference between Beneficial's and SmartMoney's goods and customers -- underlie the agreement between Beneficial and Smartmoney, which resulted in SmartMoney's amendment of the description of goods in its prior application and Beneficial's dismissal of its opposition to that application" (underlining in original). Thus, according to applicant, because the refusal to register "fails to take account of the marketplace realities" reflected by the settlement agreement, such refusal should be reversed.

The Examining Attorney, in response, takes the position that:

[N]owhere in the applicant's documents is there a statement by the registrant that it believes that there is no likelihood of confusion between the registrant's mark and the applicant's mark. In addition, there exists no consent agreement on record between the parties that clearly explains that the parties do not believe there is a likelihood of confusion. Furthermore, the fact that the registrant withdrew its opposition to the applicant's prior application does not show that the registrant does not believe that confusion is likely in the present application. For example, the registrant may have known that the applicant could not show use for the prior application and may have withdrawn [the] opposition for that reason. Because there exists no consent agreement and because there is no record of the registrant stating that confusion is not likely concerning the marks, the Examining Attorney must maintain the refusal to register the applicant's mark under Section 2(d) of the Trademark Act.

Section 2(d) of the Trademark Act to the registration which applicant seeks.

TMEP §1207(d)(viii), which is entitled "Consent Agreements," sets forth the following basic guidelines:

The term "consent agreement" generally refers to an agreement in which a party (e.g., a prior registrant) consents to the use and/or registration of a mark by another party (e.g., an applicant for registration of the same mark or a similar mark), or in which each party consents to the use and/or registration of the same mark or a similar mark by the other party.

A consent agreement may be submitted by the applicant to overcome a refusal of registration under §2(d) of the Act When a consent agreement is submitted, the examining attorney will consider the agreement, and all other evidence in the record, to determine likelihood of confusion.

Consents come in different forms and under circumstances in infinite variety. They are, however, but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in §2(d). *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

....

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

....

The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion.

Contrary to the Examining Attorney's unsupported position that, in this case, "there exists no consent agreement on record between the parties that clearly explains that the parties do not believe there is a likelihood of confusion," we find that the settlement agreement entered into between applicant and registrant in resolution of the prior oppositions plainly constitutes the kind of detailed settlement agreement which, because it is based upon marketplace realities and is designed to avoid a likelihood of confusion, is entitled to great weight. As the documented circumstances surrounding the settlement agreement plainly demonstrate, discovery in the opposition proceedings revealed that the "interactive computer programs for educational use, and instructional manuals sold as a unit therewith," with which registrant was actually using its "SMART MONEY" mark were limited to an interactive computer game and associated workbooks to help high school students learn about money management. In view thereof, one of applicant's attorneys wrote a letter to registrant's counsel and, after noting that applicant considered the goods and services set forth in its opposed applications to be "essentially extensions" of applicant's "well known SMARTMONEY magazine, which ... Beneficial *does not consider confusingly similar to* Beneficial's mark" (emphasis added), pointed out the

differences in purchasers and their level of sophistication as to the goods and services at issue in the oppositions. "*Considering these differences,*" it was also suggested in such letter that "*it would appear that there should be some way to revise the description of goods and services in the applications, which would allow the parties' marks to coexist on the Register*" (emphasis added). Plainly, counsel for applicant was endeavoring to reach a settlement, in light of marketplace realities, by which the parties would agree to the use and registration of their respective marks and which concomitantly would avoid a likelihood of confusion from the contemporaneous use thereof.

Ultimately, insofar as the issue of likelihood of confusion herein is concerned, applicant offered to amend its prior application to register its "SMARTMONEY" mark for "computer programs providing investment, business and financial news and information" by adding to the identification of such goods the restriction "excluding programs designed for academic use for students." Registrant, as the opposer and owner of the mark "SMART MONEY" for "interactive computer programs for educational use, and instructional manuals sold as a unit therewith," accepted such offer and agreed, in consideration for applicant's amendments to the involved applications, to withdraw the oppositions with prejudice once such amendments were entered. Clearly, there was a meeting of the minds of the parties to avoid a likelihood of confusion, resulting in, as memorialized by their exchange of letters, a legally binding settlement agreement.

While, as argued by the Examining Attorney, it is true that "nowhere in the applicant's documents is there a statement by the registrant that it believes that there is no likelihood of confusion between registrant's mark and the applicant's mark," it is plain from the parties' actions in resolving their differences that they mutually believed that, by such actions, there would be no likelihood of confusion from contemporaneous use of their respective marks in connection with the goods and services at issue; applicant would receive the registrations which, as amended, it was seeking; registrant, as the opposer, would retain its registration without any amendment thereto; and the oppositions would be dismissed with prejudice. Furthermore, by registrant's agreement that, among other things, applicant is entitled to use and register the mark "SMARTMONEY" for goods identified in its prior application as "computer programs providing investment, business and financial news and information, excluding programs designed for academic use for students," registrant implicitly consented to the use and registration by applicant of the same mark for the legally identical goods set forth in applicant's present application, namely, "computer software for providing investment, business and financial news and information via the global computer network, via local computer networks, and for use on personal computers, excluding programs designed for academic use for students."

Moreover, we find untenable the Examining Attorney's assertion that "the fact that the registrant withdrew its opposition to the applicant's prior application does not show

that the registrant does not believe that confusion is likely in the present application." It is clear from the evidence submitted by applicant that registrant's action was predicated on the belief that there would be no likelihood of confusion if applicant amended its prior application as provided in the parties' settlement agreement and applicant's present application is fully in accord with the provisions of such agreement. That it must be the case that registrant continues to believe that there is no likelihood of confusion herein and considers itself bound by the parties' settlement agreement is evidenced by the fact that the Granat declaration, filed almost 11 months after applicant commenced actual use of its "SMARTMONEY" mark for the goods identified in the present application, states that applicant "has not received any objection or other communication from Beneficial ... regarding its use of SMARTMONEY for the goods covered by the [present] application."

Finally, we regard as unwarranted speculation the Examining Attorney's contention that, "[f]or example, the registrant may have known that the applicant could not show use for the prior application and may have withdrawn [the] opposition for that reason." How registrant could be reasonably certain that, following withdrawal of the opposition to applicant's prior application and issuance of a notice of allowance, applicant would not commence use of its mark and file a statement of use within the maximum possible three years time is not explained. In any event, it would have been exceedingly risky for registrant to have counted on such an assumption. This is because, as

asserted by applicant in its main brief, even though its time for filing a statement of use expired on January 28, 2000, had it not later realized that it had indeed begun use of its "SMARTMONEY" mark for the goods identified in its prior application as of January 25, 2000, there would have been no reason to have filed the present application if it had submitted a statement of such use by the January 28, 2000 deadline.

Accordingly, in the absence of any other *du Pont* factors which on balance clearly dictates a finding of likelihood of confusion, it is our view that the parties' settlement agreement, with the implied consent therein by registrant to the use and registration of the mark applicant seeks to register herein, is sufficient to tilt the scales of evidence in favor of registration. As set forth in *du Pont*, supra at 568 (emphasis by the court):

The weight to be given more detailed agreements of the type presented here should be substantial. It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in causing public confusion.

Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

Likewise, as set forth in *In re Four Seasons Hotels Ltd.*, supra:

The parties themselves have determined that confusion of the public by concurrent use of their marks is unlikely and intend to abide

by their contractual agreement. There is no reason to ignore their assessment of likelihood of confusion and not give substantial weight to their agreement as evidence that likelihood of confusion does not exist.

While, as noted previously, the marks "SMARTMONEY" and "SMART MONEY" are identical as a practical matter, we further observe that when respectively used in connection with applicant's and registrant's goods, it is obvious that the marks nevertheless are highly suggestive of products which relate to intelligent monetary management.⁸ As such the marks are considered "weak" marks which, generally speaking, are entitled only to a narrow scope of protection. Although, as the Examining Attorney correctly points out, it is also generally the case that, as set forth for instance in *In re Textron Inc.*, 180 USPQ 341 (TTAB 1973), "even 'weak' or highly suggestive marks are entitled to protection against the identical mark for goods used for related purposes," here the goods at issue are computer software or programs which, as we have previously found, have quite different educational purposes or uses. Applicant's goods specifically exclude "programs designed for academic use for students," which is the field in which registrant's goods are principally sold and used.

⁸ In addition to the previously noted registration by Security Pacific for the mark "SMART MONEY" for "banking services, namely checking, savings and credit reserve loan account services," the record contains several other third-party registrations for marks which consist of or include the term "SMART MONEY" for various financial and/or banking services. These registrations, while not evidence of actual use of the subject marks, nonetheless may properly be given some weight to show the meaning of a mark in the same way that dictionaries definitions would be so used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

Thus, while there is still some limited overlap with registrant's interactive computer programs and instructional manuals for educational use in that, as noted earlier, the investment, business and financial news and information provided by applicant's goods have some incidental educational or possibly even instructive use, it is also the case that, as in *du Pont*, supra at 568: "The fact that the goods of one party 'could be used' in the field of the other is too conjectural and too widely applicable to form the sole basis of decision, particularly where, as here, the parties have agreed to avoid ... such cross-use." Moreover, as our principal reviewing court has repeatedly cautioned:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969).

We therefore conclude that, on this record, there are no other *du Pont* factors which on balance are indicative of a likelihood of confusion and that the implied consent of registrant, as reflected in the detailed provisions of a prior settlement between applicant and registrant, to the registration applicant seeks is entitled to controlling weight. Confusion is accordingly not likely to occur from the contemporaneous use by

applicant of the mark "SMARTMONEY" for "computer software for providing investment, business and financial news and information via the global computer network, via local computer networks, and for use on personal computers, excluding programs designed for academic use for students," and the use by registrant of the mark "SMART MONEY" for "interactive computer programs for educational use, and instructional manuals sold as a unit therewith."

Decision: The refusal under Section 2(d) is reversed.