

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Investment Technology Group, Inc.

Serial No. 76/069,908

G. Franklin Rothwell, Esq. for applicant.

Karen K. Bush, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Hanak, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Investment Technology Group, Inc. (applicant) seeks to register in typed drawing form INFERENCE GROUP for "financial services, namely, securities, brokerage, trading services, financial portfolio management, and financial research." The intent-to-use application was filed on June 14, 2000. In the first Office Action, the Examining Attorney required a disclaimer of the descriptive word GROUP. In response, applicant disclaimed the word GROUP apart from the mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis

that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark INFERENCE, previously registered in typed drawing form for "electronic payment, namely, electronic processing and transmission of bill payment data." Registration No. 2,379,030.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Initially, applicant requested an oral hearing, but later cancelled this request.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect on differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the marks, we note that applicant has adopted the registered mark in its entirety and merely added to it the descriptive word GROUP. We acknowledge that "the basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used." In re National

Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, "on the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in saying that, for rational reasons, more or less weight has been given to a particular feature of the mark ... That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark." National Data, 224 USPQ at 751.

The dominant portion of applicant's mark is identical to the registered mark INFERENCE. Moreover, as applied to applicant's services and registrant's services the term INFERENCE is totally arbitrary. Indeed, based on this record, there is no evidence indicating that any third parties are using marks consisting of or containing the word INFERENCE. We believe that in considering the two marks in their entirety, the only conclusion is that they are extremely similar. A consumer familiar with the mark INFERENCE for one type of financial services, upon seeing the mark INFERENCE GROUP for a related set of financial services, would assume that the latter mark was but a mere derivation of the former mark in that the word GROUP merely describes the individuals or components constituting the

INFERENCE financial institution. Moreover, both marks begin with the identical, arbitrary word INFERENCE. This is "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Presto Products v. Nice-Pak Products, 9 USPQ2d 1825, 1897 (TTAB 1988).

Turning to a consideration of applicant's services and registrant's services, we note that the Examining Attorney has made of record a plethora of stories from the Internet showing that the same financial institutions offer one or more of applicant's financial services as well as registrant's financial services, namely, the electronic payment of bills. At page 5 of its brief, applicant describes the Examining Attorney's evidence as follows:

"The Examining Attorney relied on evidence consisting of print-outs from web pages of various banking institutions that offer on-line bill payment/processing and brokering/trade services which [according to the Examining Attorney] 'overwhelmingly demonstrates that such services are more often than not offered by the same institution to the same customers via a website.'" Continuing in the next sentence on page 5 of its brief, applicant states that it "does not dispute the relevance of this evidence."

However, continuing later at page 5, applicant argues that

there is no confusion because "the Internet has become the 21st century equivalent of the supermarket, where consumers expect to immediately access and obtain a wide variety of goods and services using a few clicks of the mouse, not necessarily from the same source. It is well-established that goods or services cannot be deemed related for purposes of likelihood of confusion simply because they are sold in (or in this case through) the same establishments."

We agree with applicant that merely because a supermarket and an Internet retailer both offer, for example, fish and brooms, that this fact would not demonstrate that the two types of goods are related. However, here all of the services are related in that they are financial services, and the plethora of evidence made of record by the Examining Attorney clearly demonstrates that consumers have become accustomed to having the same source (a financial institution) offer brokerage services and the like as well as electronic bill payment services.

In an effort to demonstrate that there is no likelihood of confusion, applicant argues at page 6 of its brief that "applicant's services are marketed to highly sophisticated, high net worth customers." Not only has applicant offered no evidence to support this argument, but moreover, this argument is legally irrelevant. It is well

settled that in Board proceedings, "the question of likelihood of confusion must be determining based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Neither the cited registration nor the application contain any restrictions limiting their respective financial services to sophisticated individuals or to transactions involving large amounts of money.

Given the fact that applicant's financial services and registrant's financial services are very closely related in that numerous financial institutions provide both types of services, and given the fact that the two marks are extremely similar, we find that there exists a likelihood of confusion.

Decision: The refusal to register is affirmed.