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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re First Union Corporation

Serial Nos. 76142267 and 76142450

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

Dorritt Carroll, Trademark Examining Attorney, Law Office 116 (M. L. Hershkowitz, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

First Union Corporation has filed applications to register the marks COMPASS ADVISORY PROGRAM[1] and COMPASS PORTFOLIO PROGRAM[2] for, in each case, "investment advice,

[1] Serial No. 76142267, filed on October 6, 2000, which alleges a date of first use anywhere and date of first use in commerce of June 1, 2000. The words ADVISORY PROGRAM have been disclaimed apart from the mark as shown.

[2] Serial No. 76142450, filed on October 6, 2000, which alleges a date of first use anywhere and a date of first use in commerce of June 1, 2000. The words PORTFOLIO PROGRAM have been disclaimed apart from the mark as shown.

namely, annuity counseling, mutual fund counseling and investment counseling."

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that each of applicant's marks, when applied to its services, so resembles the previously registered marks shown below,

COMPASS-G

for "managing group annuity funds for qualified and non-qualified retirement plans,"[3] and

Compass Brokerage

for "financial services, namely stock and mutual fund brokerage services, investment banking services, financial planning services and asset management services,"[4] as to be likely to cause confusion. The cited registrations are owned by different entities.

[3] Registration No. 1,560,125 issued October 10, 1989; Section 8 and 15 affidavits accepted and acknowledged, respectively.
[4] Registration No. 1,910,414 issued August 8, 1995; renewed. The word BROKERAGE is disclaimed apart from the mark as shown.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. Because both cases involve similar records and similar issues, we will consider them in a single opinion.

Insofar as the marks are concerned, the examining attorney argues that applicant's marks and the cited marks are highly similar due to the shared term COMPASS. It is the examining attorney's position that the term COMPASS is the dominant portion of each of the applicant's marks and each of the cited marks, and this term is entitled to more weight in our likelihood of confusion determination.

With respect to the services, it is the examining attorney's position that the "annuity counseling" services in applicant's applications are related to the services in Registration No. 1,560,125, i.e., "managing group annuity funds for qualified and non-qualified retirement plans." Further, it is the examining attorney's position that the "mutual fund counseling and investment counseling" services in applicant's applications overlap with the services in Registration No. 1,910,414, i.e., "financial services, namely stock and mutual fund brokerage services, investment banking services, financial planning services, and asset management services." In support of her position with respect to the relatedness of the services, the examining

attorney submitted Internet printouts which she maintains show: a) that a single entity offers annuity counseling services and other services relating to annuities under a single mark, and b) that a single entity offers mutual fund brokerage services and investment counseling services under a single mark.

Applicant does not take issue with the examining attorney's position with respect to the related and overlapping nature of applicant's and registrants' services. Rather, applicant's arguments are directed to the marks. Applicant contends that there are specific differences in its marks and each of the cited marks, namely, its marks includes the words ADVISORY PROGRAM and PORTFOLIO PROGRAM, respectively, whereas the mark in Registration No. 1,560,125 includes the letter "G" and a design, and the mark in Registration No. 1,910,414 includes the letter "C", a design and the word BROKERAGE. Further, with respect to the marks, applicant argues that:

> Applicant respectfully submits that the refusal of registration on the grounds that there would be a likelihood of confusion is contradictory to the fact that the two cited Registrations, owned by differing and unrelated parties, co-exist with one another. Specifically, the Office Action explains the refusal of registration as being basically grounded on the single similarity between the present mark and the cited registered marks as sharing the common terms "COMPASS" and as having related services, but the Office action

> fails to acknowledge and reconcile the fact that the cited Registrations owned by differing and unrelated parties, themselves have precisely the same similarities between their respective marks and services for which the present mark is being refused registration. If, as asserted in the Office Action, Applicant's mark is likely to be confused with the cited marks for these reasons, then it would necessarily follow that the cited marks are confusingly similar with one another. However, such cannot be the case inasmuch as the Trademark Act provides that the cited registrations must be presumed valid and, as a necessary corollary, it must be presumed that the registered marks are not confusing with one another. Since the present Applicant's mark and services under the current application have no greater similarities to the cited marks and their respective services than such marks and services are similar to one another, the only logical and legally supportable conclusion is that Applicant's mark is no more likely to cause confusion with the cited marks than they are likely to be confused with one another. In turn, the Applicant's mark must be equally entitled to registration.

(Brief at 3-4 in both applications).

Also, applicant argues that there is an additional co-existing registration, namely its own Registration No. 2,280,592 for the mark WHEAT FIRST COMPASS PORTFOLIO PROGRAM for "annuities counseling, mutual fund counseling and investment counseling." Again, applicant places significant weight on the fact that three "COMPASS" registrations have been issued to three different entities and that they have co-existed on the register.

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. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, 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).

Turning first to the relatedness of the services, we deem applicant’s silence on this factor as a concession of the examining attorney’s contention that applicant’s services are related to and overlap with the services in the cited registrations. Moreover, the evidence submitted by the examining attorney establishes that the involved services are related/overlapping. In view of the related/overlapping nature of the services, we must presume that such services would be offered in the same channels of trade to the same classes of purchasers. Thus, confusion as to source or sponsorship of the services would be likely

to occur if such services were to be sold under the same or similar marks.

Turning then to a consideration of the marks, we must determine whether applicant's marks and the cited marks, when compared in their entireties are similar or dissimilar, in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, 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 commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

We first compare applicant's marks COMPASS ADVISORY PROGRAM and COMPASS PORTFOLIO PROGRAM with the mark shown below.

COMPASS-G

Applicant's marks are clearly dominated by the word COMPASS. The words ADVISORY PROGRAM and PORTFOLIO PROGRAM are descriptive of applicant's services and thus entitled to less weight in our likelihood of confusion analysis. Similarly, registrant's mark is dominated by the word COMPASS. The compass design simply reinforces the word COMPASS and the additional letter "G" is insufficient to distinguish the marks.

We next compare applicant's marks and the mark in Registration No. 1,910,414 shown below.

Compass Brokerage

Again, for the reasons stated above, COMPASS is the dominant portion of applicant's marks. Also, we find that COMPASS is the dominant portion of registrant's mark. The word BROKERAGE is descriptive/generic of registrant's services and thus is entitled to less weight in our

likelihood of confusion determination. Further, the letter "C" and compass design simply reinforce the word COMPASS, particularly since registrant's name is also Compass Brokerage.

In view of the foregoing, we find that applicant's marks and each of the cited marks is similar in sound, appearance, meaning and commercial impression.

The co-existence on the register of the two cited marks and applicant's registered mark, although a factor in this case, does not compel us to reach a different result here. We think that applicant's registered mark WHEAT FIRST COMPASS PORTFOLIO PROGRAM engenders a different commercial from each of the cited marks COMPASS-G and design and C COMPASS BROKERAGE and design. Also, the services covered by each of the cited marks are somewhat different from one another. Further, while the USPTO strives for consistency of examination, as often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the other registrations, and moreover, the determination of the registrability of different marks by a trademark examining attorney cannot control the results in the case now before use. See In re Nett Designs Inc., 236 F.2d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

In sum, we find that purchasers familiar with the registrant's COMPASS-G and design mark for managing group annuity funds for qualified and non-qualified retirement plans, would be likely to believe, upon encountering either applicant's COMPASS ADVISORY PROGRAM mark or its COMPASS PORTFOLIO PROGRAM mark for annuity counseling services, in particular, that such related services emanate from or are otherwise sponsored by or associated with a common source. In addition, we find that purchasers familiar with the registrant's C COMPASS BROKERAGE and design mark for financial services, namely stock and mutual fund brokerage services, investment banking services, financial planning services and asset management services, would be likely to believe, upon encountering either of applicant's marks for mutual fund counseling and investment counseling, in particular, that such services emanate from or are otherwise sponsored by or associated with a common source.

Decision: The refusal to register under Section 2(d) is affirmed in each case.