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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orion Mortgage Advisors, LLC

Serial No. 76/221,175

Robert E. Marsh of Corporate Counsel Group LLP for Orion Mortgage Advisors, LLC.

Christopher Law, Trademark Examining Attorney, Law Office 111 (Kevin Peska, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has filed an application to register the mark ORION on the Principal Register for "mortgage brokerage services" in International Class 36.¹

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

¹ Application Serial No. 76/221,175, filed March 8, 2001, based on applicant's assertion of a bona fide intention to use the mark in commerce.

applicant's mark, when used in connection with its identified services, would so resemble the registered mark ORION for "commercial and residential real estate brokerage" in International Class 36 and "commercial and residential real estate development" in International Class 37² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, and applicant did not request an oral hearing.

Upon consideration of the pertinent factors set forth by the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is likely.

The marks are identical. This fact "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant weighs so heavily against the applicant that applicant's use of the mark on

² Registration No. 1,974,896, issued May 21, 1996, to Orion Partners, Inc.; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is August 1, 1989 for each class of services.

"goods...[which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

"The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likely confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

Applicant contends that the registered mark ORION is a weak mark entitled to a narrow scope of protection because the USPTO's TESS database shows that there are "176 registered and pending marks including 'ORION'...." (Applicant's brief, p. 4.) Applicant first made this argument in its response to the first Office action, but applicant submitted no evidence on this point. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Of course, even if applicant had properly made the appropriate documentation of record, applications have virtually no probative value on the issue of registrability, as they are evidence only of the fact that the applications were filed.

With regard to the weight given to third-party registrations, the Court of Appeals for the Federal Circuit stated in the case of *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992):

Under *Du Pont*, "[t]he number and nature of similar marks in use on similar goods" is a factor that must be considered in determining likelihood of confusion. 476 F.2d at 1361, 177 USPQ at 567 (factor 6). Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them. ...") (Italics emphasis in original.)

In the case now before us, there is no evidence of record regarding the existence of any third-party uses of marks consisting of or including the term ORION for the involved services or any relevant or related services; and third-party registrations cannot be given any weight with regard to the strength of the mark. Thus, even if applicant had properly made third-party registrations of record (which it did not), such evidence would not

establish that the registered mark is weak and entitled to only a narrow scope of protection.³

Even if applicant had proven third-party uses of the mark ORION for similar or related services, weak marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Turning to the similarities/dissimilarities and the nature of the involved services, the Board must determine the issue of likelihood of confusion on the basis of the goods and/or services as identified in the application and the registration. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

³ In its brief on appeal (p. 5) applicant referred for the first time to the "Trademark Office database identified 14,780 'live' applications or registrations that included 'real estate' in the services description"; and applicant explained this was its first time to respond to the Examining Attorney's final refusal. As the Examining Attorney correctly asserted, the record must be complete prior to appeal. Specifically, if applicant desired to submit evidence into the record after appeal, it should request a remand under Trademark Rule 2.142(d). See also, TBMP §1207. In any event, here applicant simply made the above statement about the USPTO records, but submitted no evidence thereon. We hasten to add that such evidence would be irrelevant as explained above.

With respect to the similarity between applicant's "mortgage brokerage services" and registrant's "commercial and residential real estate brokerage" and "commercial and residential real estate development," it is not necessary that the services be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applicant argues that the involved services are distinct and separate businesses, separately regulated and licensed by the states and are even covered by some federal regulation; that the Examining Attorney has so broadly read the "expansion of trade" doctrine as to read into registrant's services coverage of a business that registrant never intended; and that the Examining Attorney has essentially argued "reverse confusion" and that there is no evidence to support the existence of that possibility

here. Applicant also states that consumers will exercise a "high amount of care and attention" when seeking these types of services. (Brief, p. 4.)

The Examining Attorney contends that the same entities offer both real estate brokerage and/or development services as well as mortgage brokerage services; that the mortgage brokerage services applicant intends to offer are within the normal scope of expansion of registrant's real estate services; and that based thereon, consumers encountering these services offered under the identical mark, ORION, would mistakenly conclude that they are from the same source.

In support of his position, the Examining Attorney submitted photocopies of several third-party registrations, based on use in commerce, showing that one entity registered a single mark for both such services. (See, for example, Registration No. 2,408,047 issued to Secured Capital Corp. for "real estate and mortgage investment banking and brokerage services"; Registration No. 2,344,220 issued to Clifford E. Katz for "real estate brokerage services and mortgage brokerage services"; Registration No. 2,477,635 issued to Singer Organization, Inc. for "real estate brokerage, mortgage financing and mortgage brokerage services, real estate investment, real estate consultation

services"; Registration No. 2,475,357 issued to BWC Financial Corporation for "...mortgage and consumer lending services,...real estate lending, brokerage, and financing services"; and Registration No. 2,320,822 issued to Realworks, Inc. for "real estate agency services, including real estate brokerage, mortgage brokerage, and title insurance agency services.")

While third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them, nonetheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods or services emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

We find that applicant's and registrant's services are highly related and complementary, and would be offered in the same channels of trade to the same classes of purchasers. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)[plaintiff renders both real estate brokerage services and mortgage brokerage services]; *Freedom Savings and Loan*

Association v. Way, 757 F.2d 1176, 226 USPQ 123, 128 (11th Cir. 1985)[real estate sales and real estate finance are highly complementary services, although the Appellate Court affirmed a District Court decision that the plaintiff did not establish likelihood of confusion]; and In re United California Brokers, Inc., 222 USPQ 361 (TTAB 1984)[applicant offers brokerage services in several fields, including real estate and mortgages and loans].

We acknowledge that services of the type rendered by applicant and registrant might sometimes involve careful and discriminating purchases. Nonetheless, real estate brokerage services and mortgage brokerage services are offered to a wide range of consumers, many of whom are not likely to be sophisticated in the buying and financing of real estate, much less capable of distinguishing between the sources of these related services rendered under the identical mark.

We conclude that consumers familiar with registrant's commercial and residential real estate brokerage and commercial and residential real estate development services rendered under the mark ORION would be likely to believe, upon encountering applicant's mark ORION for mortgage brokerage services, that the services originated with or

were somehow associated with or sponsored by the same entity.

Although we have no doubt in this case, any doubt on the issue of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

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