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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Midland Mortgage Co.

Serial No. 76296698

Glen M. Burdick of Dunlap, Codding & Rogers, P.C. for Midland Mortgage Co.

Georgia Ann Carty, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Simms, Quinn and Drost, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Midland Mortgage Co. (applicant), an Oklahoma corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark MIDLAND MORTGAGE ("MORTGAGE" disclaimed) for "financial services, namely, mortgage origination and servicing of loans for others."[1] The Examining Attorney has refused registration

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[1] Application Serial No. 76296698, filed July 18, 2001, based upon allegations of use since August 31, 1950.

under Section 2(d) of the Act, 15 USC §1052(d), on the basis of two registrations owned by Midland Loan Services, L.P. for the marks MIDLAND COMMERCIAL FUNDING ("COMMERCIAL FUNDING" disclaimed) for "financial services, namely, commercial mortgage loan program the [sic] originates (via a network of mortgage bankers and brokers), purchases and aggregates mortgage loans secured by commercial and multi-family real estate for sale in securitizations using capital markets" (Reg. No. 2,213,718, issued December 29, 1998), and MIDLAND LOAN SERVICES ("LOAN SERVICES" disclaimed) for "financial services, namely, servicing mortgage loans secured by commercial and multi-family real estate, originating, purchasing and securitizing mortgage loans, and asset management for portfolios of commercial and multi-family real estate owned by third parties, namely, developing and implementing loan resolution strategies and resolving problem loans, overseeing and managing collateral condition and performance, and liquidating loans and collateral properties" (Reg. No. 2,227,075, issued March 2, 1999). Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.[2]

[2] With its brief, applicant has submitted a list of 119 applications and registrations of marks containing the word

We affirm.

Briefly, the Examining Attorney contends that the marks MIDLAND MORTGAGE, MIDLAND COMMERCIAL FUNDING and MIDLAND LOAN SERVICES are substantially similar in sound, appearance and commercial impression, because the dominant part of each mark is the word “MIDLAND,” an arbitrary term in the financial services field, and because all of these marks contain less significant descriptive or generic wording which has been disclaimed. With respect to the services, the Examining Attorney argues that both applicant’s and registrant’s services are in the financial services industry, and that some of the respective services are identical-—financial services involving mortgages and loans. Moreover, the Examining Attorney points out that applicant has not argued that the respective services are different. Also, the Examining Attorney maintains that while applicant argues that its services are offered to a certain class of purchasers, applicant’s description of services contains no restrictions. Accordingly, the Examining Attorney argues that registrant may be engaged in

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“MIDLAND.” The Examining Attorney has objected to this listing as untimely. That objection is well taken. See Trademark Rule 2.142(d)(“The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.”) and *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994).

providing services to the same mortgagors as applicant. The Examining Attorney also asks us to resolve any doubt in favor of the prior registrant.

Applicant states that it is in the business of servicing mortgage loans for large investors such as financial institutions and insurance companies as well as private investors. Applicant also refers refinancings and other services for mortgagors to other financial institutions. With respect to the marks involved in this case, it is applicant's position that all components of the respective marks must be given equal weight (brief, 5). Applicant also notes the overall differences in pronunciation and appearance of the various marks, and argues that MIDLAND MORTGAGE has a primary meaning different from the meanings of the registered marks. While applicant admits that all of these marks are used in the financial services industry, it is applicant's position that applicant does not advertise to the general public but only to sophisticated and well-informed customers such as large financial institutions and insurance companies, and that applicant's services are purchased only after careful consideration. Based upon the listings of third-party applications and registrations of MIDLAND marks (which we

have excluded as untimely), applicant also contends that the mark MIDLAND is a weak one.

Our determination of likelihood of confusion under Section 2(d) of the Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re Majestic Distilling Co., Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the marks and 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 of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, it is well settled, of course, that marks must be considered and compared in their entireties, not dissected or split into component parts so that parts are compared with other parts. This is because it is the entire mark which is perceived by the purchasing public and, therefore, it is the entire mark that must be compared to any other mark. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.,* 667

F.2d 1005, 212 USPQ 233 (CCPA 1981). However, although the marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)("On the other hand, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.").

Here, the marks MIDLAND MORTGAGE, MIDLAND COMMERCIAL FUNDING and MIDLAND LOAN SERVICES all prominently include the word MIDLAND, and all contain additional descriptive or generic terms, which would be less significant in creating a commercial impression and in indicating origin. Moreover, these descriptive and generic words have similar connotations in the sense that they all identify lending services. Accordingly, if these marks were used in connection with related services, confusion would be likely.

Turning then to a consideration of the respective services, it is well settled that the registrability of

applicant's mark must be determined on the basis of the identification of services set forth in the involved application and the identification of the services in the cited registrations. See *Octocom Systems Inc. v. Houston Computer Services Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Also, it is settled that, absent any specific limitations in applicant's or registrant's identifications of goods or services, the issue of likelihood of confusion must be determined by looking at all the usual or normal channels of trade for the respective goods or services. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and *Squirtco v. Tomy Corp.,* 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). See also *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

It is also true that the respective services need not be identical or competitive. They need only be related in some manner or the circumstances surrounding their marketing be such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.,*

23 USPQ2d 1795 (TTAB 1992); and *Chemical New York Corp. v. Conmar Form Systems Inc.,* 1 USPQ2d 1139 (TTAB 1986).

Here, there are no restrictions in the identification of services in applicant's application, and it would be improper to read limitations into that identification of services. Because there are no limitations in the application relating to the channels of trade or classes of purchasers, we must presume that applicant's and registrant's services encompass all services of the type described, and that they move in all normal channels of trade to all potential customers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra.*

Here, applicant's services are mortgage origination and servicing of loans for others, while registrant's services include commercial mortgage loan services and servicing mortgage loans secured by commercial and multi-family real estate. The services of both applicant and registrant could (and, according to applicant, do) involve the servicing of loans for large financial institutions and insurance companies. While it is true that these purchasers may be expected to be sophisticated and knowledgeable about the purchases they make, we agree with the Examining Attorney that even sophisticated purchasers will not be able to distinguish source when the marks

involved are as close as MIDLAND MORTGAGE, MIDLAND COMMERCIAL FUNDING and MIDLAND LOAN SERVICES. Even if these purchasers realize that applicant's mark is slightly different from the other marks, these purchasers are likely to believe, in view of the similarities of the marks, that all of these services are being offered by the same company, but under slightly different names.

As noted, applicant's mere listing of third-party registrations cannot be considered because it was submitted untimely, and because such a listing does not make the registrations and applications of record. See *JT Tobacconists,* 59 USPQ2d 1080, 1081 n.2 (TTAB 2001); and *In re Duofold Inc.,* 184 USPQ 638 (TTAB 1974). As the Examining Attorney noted, copies of those registrations or the electronic equivalent should have been made of record. TMEP §710.03. Furthermore, the listing of third-party registrations which include the word MIDLAND does not specify the particular goods or services in connection with which this mark is registered. Also, this listing is not evidence of use of those registered marks in the marketplace, and it does not show that the public is familiar with those marks. See *Olde Tyme Foods Inc. v. Roundy's Inc*., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *AMF Inc. v. American Leisure Products,*

Inc., 474 F.2d 1403, 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..."). Accordingly, the registered marks have not been shown to be weak. Even if we deem the protection to be accorded the cited registered marks as being more limited than that for a totally arbitrary mark, it still extends to prevent the registration of a mark which conveys the same commercial impression and which is used for services which may emanate from a single source.

Finally, any doubt with respect to the issue of likelihood of confusion must be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio) Inc.,* 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.,* 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration under Section 2(d) is affirmed on the basis of the cited registrations.