

Mailed:
July 11, 2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World Wide Financial Services, Inc.

Serial No. 76483944

Molly B. Markley of Young & Basile, P.C., for World Wide Financial Services, Inc.

Nicholas K.D. Altree, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Hairston, Chapman and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On January 17, 2003, World Wide Financial Services, Inc. (applicant) filed an application to register on the Principal Register the mark shown below for "mortgage and home equity loan services, mortgage brokerage services, first and second mortgage lending, equity financing, mortgage banking and real estate brokerage and loan financing" in International Class 36 claiming first use of

Ser No. 76483944

the mark and first use of the mark in commerce in August 2002:



Applicant has disclaimed "lending."

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that there is a likelihood of confusion between applicant's mark and the mark in current U.S. Registration No. 2,772,291, issued October 7, 2003, for GOOD FAITH, in standard character form, for "mortgage lending and real estate brokerage" in International Class 36.

The refusal was made final and applicant appealed. For the reasons set forth below, we affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent & Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. The opinion in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in

determining likelihood of confusion. In doing so the Court recognized that we must decide the issue case by case and that one factor may play a dominant role in a particular case. Id., 177 USPQ at 567. We discuss below the factors relevant here.

Comparison of the Goods and Services and Channels of Trade

Applicant has argued neither that its services nor that the channels of trade for its services differ from those of the registrant. We must consider the services as described in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). Both the application and the cited registration include mortgage lending and real estate brokerage services without any limits as to trade channels. Accordingly, we conclude that the services of the applicant and registrant and that the channels of trade for those services are, at least in part, identical.

Comparison of the Marks

The arguments and evidence in this case focus on the whether or not the marks are similar, and the "strength" of GOOD FAITH, the element common to both marks.

As to the marks, we conclude that the marks of the registrant and applicant, GOOD FAITH on the one hand, and

LENDING - GOOD FAITH and design on the other, are similar based on a comparison of the appearance, sound, connotation and commercial impression of both marks. du Pont, 177 USPQ at 567.

Applicant argues that the marks differ when viewed in their entireties. Applicant's Brief at 2. Specifically, applicant states, "However, the only similarity between the marks is the use of the term 'good faith' which is descriptive and widely used in the mortgage industry. Applicant's mark is primarily a distinctive design with the terms 'LENDING' and 'GOOD FAITH' . . . The mark in the cited registration consists of the terms 'GOOD FAITH' which are descriptive when applied to the services and are widely used in the mortgage lending industry." Id. at 3.

The examining attorney argues that the marks are highly similar. While acknowledging that marks must be viewed in their entireties he notes that one feature of a mark may be more significant and the dominant feature in determining likelihood of confusion citing In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) and other cases. Examining Attorney's Brief at 2-3. In this case he concludes that GOOD FAITH is the dominant element because it is distinctive and because LENDING is generic. He also observes that word elements, as opposed

to designs, are more likely to be remembered and to be used in calling for the goods or services citing In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987) and other cases. Id. at 3

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Appearance - We conclude that the marks are similar in appearance because GOOD FAITH is the only distinctive word element in both marks. In fact, GOOD FAITH is the only element in registrant's mark. Applicant incorporates registrant's mark in its entirety and adds the generic term LENDING which it has disclaimed. In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994). Applicant also adds a design consisting of a heart with a silhouette of a home. The generic term LENDING appears above the design and is separated from GOOD FAITH which appears beneath the design. The word elements are in similar type style and size. The separation reinforces the appearance that GOOD FAITH is distinct from LENDING. The fact that GOOD FAITH is distinctive, and LENDING is not, renders GOOD FAITH

dominant in the overall appearance of the marks. The design element does not diminish this dominance. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Accordingly, we conclude that the marks are similar in appearance.

Sound - The marks are also similar in sound, again because they share the same distinctive, and therefore dominant, word element. In considering sound, of course, we are concerned with the word elements only. In this connection, we agree with the examining attorney's observation that word elements are generally more significant because they can be recalled and used in calling for the goods or services. In re Apparel Ventures, Inc., 229 USPQ 225, 226 (TTAB 1986). Also, any variation in sound resulting from the mere addition of a generic term is not normally sufficient to distinguish the marks. That is the case here. Therefore, we conclude that the marks are similar in sound.

Connotation - The significant "connotation" in both marks derives from the words GOOD FAITH. It is evident that both marks convey that the services provided under the marks are offered earnestly and honestly. Thus the marks have highly similar connotations.

Commercial Impression - The marks likewise convey the same overall commercial impression. Again, GOOD FAITH dominates the impression. The commercial impression engendered by both marks suggests that the services are offered earnestly and honestly. The design element in applicant's mark complements the impression projected by GOOD FAITH. The combined symbolism of a heart and a home may suggest GOOD FAITH or simply that the services relate to the home. In any event, the design in no way detracts from GOOD FAITH as the dominant contributor to the commercial impression. Therefore, the commercial impression engendered by the marks is similar.

Accordingly, we conclude that the marks are similar in appearance, sound, connotation and commercial impression.

Similar Marks In Use on Similar Goods/Services

Applicant argues strenuously that GOOD FAITH is descriptive or suggestive and that there is "enormous third party use" of GOOD FAITH rendering it weak. Applicant's Brief at 2. These arguments address the du Pont factor concerned with the "strength" of the cited mark, that is, "The number and nature of similar marks in use on similar goods." du Pont, 177 USPQ at 567. In support of this contention, applicant provided listings of results from two search engines. First, with its response to the examining

attorney's first action, applicant provided a partial listing of results from the Netscape® (Google®) search engine from searches for "good faith estimate" (110 of an unspecified total number of results) and "good faith lending" (200 of an unspecified total number of results). Also, with its appeal brief, applicant provided a partial listing of results from the Yahoo® search engine from a search for "good faith mortgage" (150 of 873,000 results).

First, with regard to the evidence submitted from the Yahoo® search engine with applicant's brief, the examining attorney points out that this evidence is untimely and should be excluded under Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). We agree. In the absence of a timely request for remand to offer new evidence and a proper showing of good cause, we must exclude the evidence submitted with applicant's appeal brief from consideration. See TBMP §§ 1207.01 and 1207.02 (2d ed. rev. 2004).

Furthermore, applicant argues both that GOOD FAITH is descriptive and also that it is suggestive, and in either event that it is weak and should be accorded limited protection. Applicant's Brief at 3. The examining attorney has objected to applicant's arguments that GOOD FAITH is descriptive as a collateral attack on the validity of the cited registration. Again, we agree with the

examining attorney. The cited Principal Register registration for GOOD FAITH is entitled to all of the attendant presumptions under Section 7 of the Trademark Act, 15 U.S.C. § 1057, including the presumption that the mark is valid. To the extent applicant argues that the cited mark is descriptive we reject those arguments. In re Peebles, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). Applicant cannot attack the validity of a registration in an ex parte appeal, but only through a cancellation proceeding. See In re Dixie Restaurants, Inc., 41 USPQ2d at 1434.

We have considered applicant's arguments that GOOD FAITH is suggestive, and therefore weak, and in particular applicant's evidence submitted with its response to the first office action. As indicated above, that evidence consists of a partial listing of results from the Netscape® search engine from searches for both "good faith estimate" and "good faith lending."

Applicant has argued generally that "good faith" is frequently used in the mortgage industry because "'good faith' is something that is actually required by federal law in performing the services that are offered by both the Applicant and the owner of the mark in the cited registration." Applicant's Response, dated March 16, 2004 at 4. In discussing applicant's evidence, the examining

attorney points out that the evidence refers to the requirement of a good faith estimate of settlement costs under the Real Estate Settlement Procedures Act. Examining Attorney's Brief at 3.

The evidence consists of listings of results from a search engine, specifically, extremely brief, often truncated bits of text intended to provide links to relevant sites. There is little, if any, context. This severely limits the probative value of this evidence. It does not show how GOOD FAITH is used on actual sites or even whether these links would actually connect to an active site. The listings indirectly suggest that federal law requires a good faith estimate of closing costs, as the examining attorney has stated. Only one of the 310 results shows what could arguably be trademark or trade name use of GOOD FAITH. Result 58 from the "good faith lending" search indicates: "Good Faith Mortgage, Inc. - . . . Why choose us for your lending needs? . . . At Good Faith Mortgage you get the wholesale rate, the same rate I would get if I was doing - <http://www.goodfaithhomeloans.com/>." On this record, we do not know whether this link connects to a working site, whether the site includes trademark use of GOOD FAITH, or whether if it does, it is a site connected with the registrant. The du Pont factor focuses on

"similar marks in use." du Pont, 177 USPQ at 567 (emphasis provided). There is simply no minimally probative evidence of third-party trademark use of GOOD FAITH here, and certainly not enough to conclude that GOOD FAITH is a weak mark. Therefore we reject applicant's argument that the registered GOOD FAITH mark is weak as a result of third-party use.

In conclusion, after considering all evidence bearing on the du Pont factors in this record, we conclude that there is a likelihood of confusion between applicant's mark and the cited registered mark. Applicant's and registrant's services and the channels of trade for those services are identical. The marks are similar in appearance, sound, connotation and commercial impression - the dominant and only distinctive word element in each of the marks is GOOD FAITH. Furthermore, there is insufficient evidence of trademark use of GOOD FAITH by third parties to find that GOOD FAITH is a weak mark for relevant services. Furthermore, we must resolve any doubt in favor of the prior registrant. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Decision: The refusal to register applicant's mark on the ground of likelihood of confusion is affirmed.