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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Tardus America LLC

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Serial No. 76557678

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Bryce K. Earl of Santoro, Driggs, Walch, Kearney, Johnson & Thompson for Tardus America LLC.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Quinn, Drost and Cataldo, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Tardus America LLC to register the mark MONEYWISE for "computer software for use in the fields of financial, real estate and insurance management, planning and education; computer software for accessing, facilitating, conducting, analyzing, tracking, maintaining, updating or reporting banking, loan, credit line, cash flow, investment, real estate, charity and

insurance transactions, records and information; computer software for electronic funds transfer" in Class 9.<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, if used in connection with applicant's goods, would so resemble the previously registered mark MONEYWISE for "investment services, namely, asset allocation investment management" in Class 36<sup>2</sup> as to be likely to cause confusion. The examining attorney also found the identification of goods to be indefinite, and made final a requirement to submit an acceptable identification.

When the refusal and the requirement were made final, applicant appealed. Applicant and the examining attorney filed briefs.

#### **Identification of Goods**

We turn first to the examining attorney's requirement that applicant submit an acceptable identification of goods. The identification of goods, as originally worded, reads as follows:

computer software for use in the fields  
of financial, real estate and insurance  
management, planning and education;

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<sup>1</sup> Application Serial No. 76557678, filed November 5, 2003, alleging a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 2606260, issued August 13, 2002.

computer software for accessing, facilitating, conducting, analyzing, tracking, maintaining, updating or reporting banking, loan, credit line, cash flow, investment, real estate, charity and insurance transactions, records and information; computer software for electronic funds transfer.

The examining attorney states that the terminology "computer software for use in the fields of financial, real estate and insurance management, planning and education" is unacceptable as indefinite. More specifically, the examining attorney asserts, "when the identification of goods includes computer software, the applicant must specify the function of the software, e.g., for use in database management, for use as a spreadsheet, for word processing, etc. and, when software is content- or field-specific, the field of use." (Appeal Brief, unnumbered p. 5). The examining attorney also maintains that the use of "or" in the identification is indefinite.

Applicant consistently argued during prosecution that the identification was definite in all respects, highlighting several third-party registrations with identifications of goods virtually identical to applicant's identification that the examining attorney finds unacceptable. In its appeal brief, applicant maintains that the identification is acceptable. In the alternative,

however, applicant indicates its willingness to amend the identification of goods.<sup>3</sup> (Appeal Brief, p. 23). Applicant proposes the following identification (changes highlighted in bold):

computer software for **accessing, facilitating, manipulating, analyzing, tracking, maintaining, updating and reporting data** in the fields of financial, real estate and insurance management, planning and education; computer software for accessing, facilitating, conducting, analyzing, tracking, maintaining, updating **and** reporting banking, loan, credit line, cash flow, investment, real estate, charity and insurance transactions, records and information; computer software for electronic funds transfer.

The examining attorney, in her brief, is curiously silent on applicant's proposed amendment. The examining attorney merely reiterates her earlier remarks in pointing out the deficiencies in the original identification of goods. Although we recognize that applicant proposed the alternative amendment at a very late juncture, the examining attorney should have, at the very least, addressed it, especially here when the alternative

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<sup>3</sup> For future reference, applicant's attention is directed to TBMP § 1205.01 (2d ed. rev. 2004) which indicates, in relevant part, that if, at the time applicant files its appeal brief, it also wishes to amend its application in order to attempt to comply with a final requirement, the proper procedure is to file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand.

amendment responds to all of the examining attorney's concerns.<sup>4</sup>

We find that the original identification of goods is indefinite for the reasons indicated by the examining attorney. We further find, however, that the proposed identification, as set forth in the appeal brief, is acceptable.

Accordingly, applicant's amended identification of goods is accepted and entered in the application file. This amended identification will be the one used to compare applicant's goods with registrant's services.

The requirement to submit an acceptable identification of goods is moot.

#### **Likelihood of Confusion**

In appealing the final refusal, applicant argues that the examining attorney restricted her likelihood of confusion analysis to the first two du Pont factors, failing to address other relevant factors. More specifically, applicant points to the following factors

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<sup>4</sup> For future reference, the examining attorney's attention is directed to TBMP § 1205.01 (2d ed. rev. 2004), which addresses the situation where an applicant includes an amendment as part of its brief. In the event that the Board does not note the amendment (as is the case herein given that the amendment was not made by a separate paper but rather was buried at the end of the brief), the examining attorney, upon reviewing applicant's brief, may consider the amendment. If the examining attorney allows it, the amendment will be entered.

that, applicant contends, are in its favor: the weakness of the cited registered mark; the sophistication of purchasers; the dissimilar trade channels; the lack of fame of the registered mark; the absence of actual confusion; and the de minimis nature of any potential confusion. In support of its arguments, applicant submitted, in pertinent part, a printout of a summary from the USPTO's TESS database; photocopies of certain third-party registrations; copies of two Board prior decisions; excerpts of registrant's website; and the declaration of one of its attorneys.

The examining attorney highlights the fact that the involved marks are identical, and that applicant's goods and registrant's services feature the field of financial investments. Thus, the examining attorney concludes, consumers familiar with registrant's services would be likely to believe that applicant's software emanates from the same source.

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. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed.

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Cir. 2003). In any likelihood of confusion analysis, however, 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).

In the present case, the marks are identical in all respects. That is, applicant's and registrant's MONEYWISE marks are identical in sound, appearance, meaning and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Use of identical marks is a fact which "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289, 1290 (Fed. Cir. 1984); see also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

In considering the involved marks, we have taken into account the third-party registrations of MONEYWISE marks. We readily recognize the suggestiveness of the term "moneywise" in relation to the involved goods and services. The third-party registration evidence, however, does not persuade us that confusion is not likely. With respect to

the TESS printout, this list does not show the goods and/or services covered by the registrations and applications. Therefore, the list, standing by itself, has extremely limited probative value, since we cannot determine whether the marks are for goods and/or services similar to those of applicant and registrant.<sup>5</sup> See TBMP § 1208.02 (2d ed. rev. 2004) ["The Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registration numbers and marks, the list will have very limited probative value."]. As indicated above, however, applicant submitted copies of certain of the third-party registrations listed in the TESS printout.

The third-party registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476

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<sup>5</sup> In this connection, even if complete copies of all of these third-party registrations had been submitted, any registrations covering goods and/or services far removed from the goods and services of applicant and registrant would be irrelevant to the present likelihood of confusion analysis. *Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 141 USPQ 249, 252 (CCPA 1964). Further, third-party applications, even if copies had been furnished, have no probative value other than as evidence that the applications were filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

F.2d 1004, 177 USPQ 462 (CCPA 1973); and Richardson-Vicks, Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982). In any event, even if we were to find, as applicant urges, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of an identical mark for related goods. See In re Farah Mfg. Co., Inc., 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

We next turn to a consideration of the goods and services. We note, at the outset of considering this du Pont factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and/or services and registrant's goods and/or services that is required to support a finding of likelihood of confusion. In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods and/or services in order to support a finding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Contrary to the gist of applicant's remarks, it is well recognized that confusion may occur from the use of the same or similar marks for goods, on the one hand, and

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for related services, on the other. See, e.g., *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) [BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture]; *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) [design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream]; and *In re Industrial Expositions, Inc.*, 194 USPQ 456 (TTAB 1977) [POLLUTION ENGINEERING EXPOSITION for programming and conducting of industrial trade shows held likely to be confused with POLLUTION ENGINEERING for a periodical magazine]. Further, applicant's argument that the different classification of the involved goods and services illustrates the goods and services are not related is irrelevant. The classification of goods and services by the USPTO is a purely administrative determination and has no bearing on the issue of likelihood of confusion. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); and *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990).

With respect to the goods and services, applicant's computer software may be used for analyzing, tracking and maintaining data in the financial field, including

accessing investment information. Registrant's services feature asset allocation investment management. Thus, the goods and services both involve financial investments, and may be utilized by the same classes of purchasers. It is easy to envision the same individual using applicant's software at home to keep track of his/her investments, while at the same time utilizing registrant for professional investment management.

Applicant attempts to draw distinctions between the trade channels and the classes of purchasers for the goods and services. Although we recognize that the goods and services, in all likelihood, move in somewhat different trade channels, the goods and services ultimately make their way to, and are used by the same classes of purchasers. Applicant contends that its goods are targeted primarily to individuals interested in reducing their debt whereas registrant's services are directed to individuals and/or businesses seeking banking and investment services. The problem with applicant's argument is that the involved identifications of goods and services include no limitation as to the classes of purchasers. Thus, it is presumed that the goods and services would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). As indicated above, there is an overlap in

purchasers who might avail themselves of both applicant's software in tracking investments and registrant's investment services.

Applicant urges us to find that a high degree of care is taken in purchasing computer software dealing with financial matters and in selecting banking and investment services. In support of this proposition, applicant relies on reported decisions in two civil actions, one involving financial services and the other involving computer software for financial applications.

Although many customers of applicant's software and registrant's investment services may be sophisticated, we see no reason to assume that the potential customers could not include ordinary individuals who are dealing with their finances and investments. Even assuming that the financial aspect of applicant's goods and registrant's services demands a discerning purchase, even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving identical marks and closely related good and services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are

not infallible."]. See also *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the identity of the marks and the relatedness of the goods and services outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods].

Applicant's contention that the cited mark is not famous is not persuasive. The lack of fame of the cited mark is not dispositive in an *ex parte* proceeding. Although fame of a registered mark is relevant to likelihood of confusion, there is no converse rule that likelihood of confusion is precluded by a registered mark's not being famous. *In re Majestic Drilling Co., Inc.*, 65 USPQ2d at 1205.

The absence of actual confusion, as reported by applicant's attorney, is of little moment. There is no evidence that there has been an opportunity for confusion to occur between the marks. Although applicant contends that there can be no actual confusion due to registrant's abandonment of the registered mark, this assertion is improper and may not be considered (see discussion, *infra*).

In any event, particularly in an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." In re Majestic Drilling Co., 65 USPQ2d at 1205. See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Moreover, it is unnecessary to show actual confusion in establishing a likelihood of confusion. Weiss Associates Inc. v. HRL Associates Inc., 14 USPQ2d at 1842.

Applicant's reliance on the nonprecedential dispositions in two prior Board opposition proceedings is of no moment. Neither proceeding involved applicant or registrant; and different marks and goods/services were at issue in those cases that were not the subjects of a final decision on the merits (both oppositions were dismissed prior to trial pursuant to withdrawals filed by the opposers).

Applicant contends that registrant has abandoned, or at a minimum, is not presently using the registered mark. In support of its contention, applicant submitted the declaration of Steven Gibson, one of applicant's attorneys, and excerpts from registrant's website. To the extent that applicant is asserting that the registered mark has been abandoned, no consideration has been given to applicant's argument in this specific regard. Applicant's allegation

constitutes an impermissible collateral attack on registrant's registration. Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). In *re* Dixie Restaurants, 41 USPQ2d at 1534; and In *re* Peebles Inc., 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (4<sup>th</sup> ed. 2004).

We conclude that consumers familiar with registrant's investment services rendered under its mark MONEYWISE would be likely to believe, upon encountering applicant's computer software for use in certain fields, including financial investments, sold under the mark MONEYWISE, that the goods and services originate with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior

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registrant. In re Hyper Shoppes (Ohio), Inc., 6 USPQ2d at 1026; and In re Martin's Famous Pastry Shoppe, Inc., 223 USPQ at 1290.

**Decision:** The requirement to submit an acceptable identification of goods is moot. The refusal to register under Section 2(d) is affirmed.