

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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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 Max Briggs

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Serial No. 78493404

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Katherine M. Hoffman of Luce, Forward, Hamilton & Scripps  
for Max Briggs.

Giselle M. Agosto, Trademark Examining Attorney, Law Office  
102 (Thomas V. Shaw, Managing Attorney).

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Before Seeherman, Grendel and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Max Briggs, a Canadian citizen, seeks registration on  
the Principal Register of the mark DESERT COMMERCIAL BANK  
(in standard character form, "COMMERCIAL BANK" disclaimed)  
for "banking services" in International Class 36.<sup>1</sup>

Registration has been refused under Section 2(d) of the

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<sup>1</sup> Application Serial No. 78493404, filed October 1, 2004,  
alleging a bona fide intention to use the mark in commerce under  
Trademark Act Section 1(b), 15 U.S.C. §1051(b).

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Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with his identified services, so resembles the registered mark shown below



for "automated teller machine services" in International Class 36 as to be likely to cause confusion, mistake or deception.<sup>2</sup> The mark includes the wording DCB DESERT COMMUNITY BANK on the cashbox design and "COMMUNITY BANK" is disclaimed.

The appeal is fully briefed. We affirm the refusal to 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. 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. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544

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<sup>2</sup> Registration No. 1804747, issued November 16, 1993, renewed.

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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).

We find the services to be legally identical inasmuch as applicant's broad identification "banking services" encompasses registrant's "automated teller machine services." The evidence of record supports this finding. The examining attorney submitted several third-party use-based registrations to show that numerous entities have adopted a single mark for applicant's "banking services" and registrant's "automatic teller machine services." See, e.g., Reg. No. 1529695 (CHEVY CHASE for, inter alia, banking services, namely loan financing services, credit and loan services, savings and other interest account services, checking account services...electronic banking, namely automated teller machine services); Reg. No. 2494690 (BANK OF AMERICA for, inter alia, banking and related financial services; commercial and consumer lending and leasing services; automated teller machine services); Reg. No. 2939449 (BANKUNITED for, inter alia, banking services, namely, personal and business checking accounts, savings accounts...automated teller machine services); Reg. No. 2965009 (NORTH FORK for, inter alia, full line of commercial, personal and municipal banking services;

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automated teller machine services); Reg. No. 2695267 (OLD NATIONAL for, inter alia, banking services; automated teller machine services); Reg. No. 2801838 (WEBSTER for, inter alia, banking services; automated teller machine services); Reg. No. 2846648 (SEACOAST COMMERCE BANK for, inter alia, banking services; automated teller machine services); Reg. No. 2777978 (FIRST FEDERAL for, inter alia, banking and related financing services; automated teller machine services); and Reg. No. 2923122 (PROBIZBANK for, inter alia, banking; automated teller machine services). See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Further, inasmuch as there are no limitations in the identification of services, we must presume that the services will be offered in some of the same channels of trade, and will be used by some of the same purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In this connection, it is common knowledge that automated teller machines are frequently attached to banks, and consumers may use an automated teller machine as an alternative to going inside the bank to deposit or withdraw money. In view of the above, the du Pont factors of the similarity of the

services and the channels of trade favor a finding of likelihood of confusion as to the cited registration.

Applicant has attempted in his November 7, 2005 response to the first Office action to limit the trade channels by arguing that his services target "primarily corporate consumers who require capital funding for their businesses" and noting that automatic teller machines (ATM) are often not located inside a bank building and are used "by individuals who may be seeking to quickly obtain a small sum of money for short-term expenditures, or to deposit a personal check." Response filed November 7, 2005. However, banking services encompass ATM services and ATMs are also located inside banks. Moreover, there are no limitations as to the types of customers or trade channels in the application or registration. That is, applicant has identified his services as "banking services" generally.

With regard to the conditions of sale, we note that banking and ATM services can range from general day-to-day transactions to highly sophisticated financial transactions. Applicant argued in his November 7, 2005 response to the examining attorney's first Office action that his purchasers "are primarily corporate clients" and applicant's and registrant's consumers are "likely to be highly sophisticated...[b]ecause the services at issue

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involve finances, whether owned by an individual ATM consumer or being sought as a loan by a corporate consumer" and they will not purchase services on impulse. We first note that we must consider all potential customers, including the less sophisticated banking customers. In re Bercut-Vandervoort & Co., 229 USPQ 763, 765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion). Second, even the more sophisticated banker consumers would not be immune from source confusion. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We now consider whether applicant's mark, DESERT COMMERCIAL BANK and the mark in the cited registration, DESERT CASHBOX DCB COMMUNITY BANK (and design), are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. In making this determination we recognize that where the goods or services are virtually identical, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied 506 U.S. 1034 (1992).

Examining the marks in terms of their appearance, sound, meaning, and commercial impression, we find the marks to be similar. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). We must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Clearly, the word DESERT is the dominant element in applicant's mark given the highly descriptive nature of the other two disclaimed words COMMERCIAL BANK. There is no question that DESERT is the source-identifying element in applicant's mark. Similarly, in registrant's mark the word DESERT is in a prominent position and certainly dominates over the design and the wording DCB DESERT COMMUNITY BANK displayed in extremely small script. While the word CASHBOX could perhaps be somewhat suggestive of registrant's ATM services, it does serve a source-

identifying function. However, we believe that, coming in the first position, it is the word DESERT in registrant's mark that will leave the first and stronger impression in the consumer's mind. Further, in view of the respective services, DESERT CASHBOX could be viewed as a variant of applicant's mark DESERT COMMERCIAL BANK, serving as the mark for his ATM services. In short, because of the dominance of the word DESERT in both marks we find that the marks are similar in sound, appearance and connotation, and have the same overall commercial impression.

In making our determination we have considered applicant's argument that the term DESERT in both marks is weak and as such cannot be the dominant part of registrant's mark in view of widespread third-party use of the term DESERT. In support of his argument, applicant submitted hit list summaries from various Internet search engines and printouts of third-party registrations from the USPTO's Trademark Application and Registrations Retrieval (TARR) system. We first note that it is well settled that third-party registrations are not evidence of use in the marketplace and thus have little probative value on this issue. Second, search summaries are generally too truncated to provide sufficient information about the use of a particular term. In re Fitch IBCA, Inc., 64 USPQ2d

1058, 1060 (TTAB 2002). We further note that these search summaries and third-party registrations are for a wide variety of goods and services that have no bearing on the question of the strength of the term DESERT in connection with banking and ATM services. A review of the voluminous documents submitted by applicant reveals what appear to be a total of three third-party banks that include the word DESERT in their respective names: Palm Desert, Mohave Desert and Desert Hills.<sup>3</sup> The addition of modifying terms to the word Desert sets these examples apart from the marks before us and, moreover, the search summaries are too limited to show whether these banks are still in existence and the extent of their use of these terms.

Even assuming DESERT is suggestive of the respective locations of the services and, thus, afforded a somewhat lesser scope of protection, given that we have legally identical services which may be purchased without a high degree of care by some consumers, and a similar connotation that directs consumers to a regional source without distinguishing modifiers (e.g., Palm Desert) the protection afforded this mark certainly encompasses these

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<sup>3</sup> There are many examples that appear to reference registrant, DESERT COMMUNITY BANK, and a few reference applicant DESERT COMMERCIAL BANK.

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circumstances. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) (even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services).

In conclusion, we find that because of the legally identical services, the overlap in the trade channels, and the similarities in the marks, confusion is likely between applicant's mark and the mark in the cited registration. To the extent there are any doubts, we resolve them, as we must, in registrant's favor. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.