THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Mailed: March 31, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TVM Management Corp.

Serial Nos. 78758760; 78758772; and 78769828[1]

John W. Pint of Proskauer Rose LLP for TVM Management Corp.

Kathryn E. Coward, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Hairston and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applications were filed by TVM Management Corp. to register on the Principal Register the marks shown below for the following services, as amended: "financial services, namely advisory and management services for private investment funds and investments, and financial sponsorship of the formation of private investment funds and venture capital funds, namely, setting up private

---

[1] The trademark examining attorney's motion to consolidate these ex parte appeals was granted by the Board in a paralegal order issued on November 8, 2007.

investment funds and management of investment funds for others; financial services, namely, venture capital funding services for investment of funds in companies in the fields of information technology, communications technology, and life sciences" in International Class 36.

TVM

(in standard characters);[2]

TVM CAPITAL

(in standard characters);[3] and

(as displayed in stylized form).[4]

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's marks, as used in connection with its services, so resembles the following marks, previously registered on the Principal Register:

---

[2] Application Serial No. 78758760 was filed on November 21, 2005, asserting December 31, 1983 as the date of first use of the mark in commerce.

[3] Application Serial No. 78758772 was filed on November 21, 2005, with a disclaimer of "CAPITAL" and asserting March 7, 2006 as the date of first use of the mark in commerce.

[4] Application Serial No. 78769828 was filed on December 8, 2005, with a disclaimer of "CAPITAL" and asserting March 7, 2006 as the date of first use of the mark in commerce. The colors light blue and dark blue are claimed as a feature of the mark.

TVM

(in typed form) for "financial analysis and consultation services" in International Class 36;[5] and

TVM

(in typed form) for "financial services, namely, short-term lending services for professional service providers and commercial customers" in International Class 36,[6] as to be likely to cause confusion.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs on the issues under appeal. In addition, applicant filed a reply brief.

Likelihood of Confusion

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, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d

---

[5] Registration No. 2828269 issued to Stratascope Inc. on March 30, 2004. The registration recites additional services in Class 35 that are not relied upon by the examining attorney for purposes of the issue under appeal.

[6] Registration No. 2828269 issued to Dean H. Mersky on April 27, 2004. The registration recites additional services in Class 35 that are not relied upon by the examining attorney for purposes of the issue under appeal.

1201, 1203 (Fed. 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, 27 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's marks and registrants' marks are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result.

In this case, applicant's TVM mark, in its application Serial No. 78758760, is identical to the marks in the cited registrations in every respect. The fact that the marks

are identical results in this factor strongly supporting the examining attorney's position. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

Applicant's TVM CAPITAL and TVM|Capital marks, in its application Serial Nos. 78758772 and 78769828, are highly similar to registrants' TVM marks in that applicant's marks incorporate registrants' marks in their entirety as their most prominent component. It is a well-established principle that, 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 a consideration of the marks in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The significance of "TVM" in applicant's marks is reinforced by its location as the first term therein. *See Presto Products Inc. v. Nice-Pak Products, Inc.,* 9 USPQ2d 1895, 1897) TTAB 1988)("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). *See also Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)(upon encountering the marks, consumers must first notice the identical lead

word). Further, in applicant's marks, the word "CAPITAL" is disclaimed, and that term at best is highly descriptive of applicant's services and, as such, is subordinate to "TVM." Thus, "TVM," appearing first in applicant's TVM CAPITAL and TVM|Capital marks, as well as the only portion thereof that is not disclaimed, is the dominant portion thereof, and the portion that is most likely to be remembered by purchasers. The dominant TVM portion of applicant's marks is identical to registrants' marks in appearance and sound. As a result, when viewed as a whole, applicant's TVM CAPITAL and TVM|Capital marks are highly similar to registrants' TVM marks in appearance and sound.

We are not persuaded by applicant's argument, based upon extrinsic evidence from registrants' respective Internet websites, that registrants' marks are acronyms and that such acronym significance lends registrants' marks different commercial impressions from those of applicant. First, it is not apparent from this record that consumers of registrants' services would perceive any acronym significance of the TVM marks. Second, even if registrants' marks were recognized as acronyms, such recognition would be insufficient to overcome the overall similarities between the marks. That is to say, even if registrants' marks conveyed commercial impressions that

differ from those of applicant due to the formers' significance as acronyms, registrants' TVM marks are identical to applicant's TVM mark and so highly similar to its TVM CAPITAL and TVM|Capital marks in appearance, sound and connotation that the similarities greatly outweigh the differences.

Accordingly, this d*u Pont* factor favors a finding of likelihood of confusion.

Applicant contends that by virtue of their coexistence on the Principal Register, the TVM marks in the cited registrations are weak and thus entitled to a narrow scope of protection. However, we are not privy to the facts surrounding the examination or registration of the marks in the cited registrations. As such, we do not know whether, for instance, the owners of these registrations entered into an agreement allowing for their coexistence, or any other circumstances that led to the registration of both marks. In any event, even if we were to find, based on their coexistence, that registrants' marks are weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of an identical mark or highly similar marks if the services identified thereby are related. *See In re Farah*

Manufacturing Co., Inc., 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

The Services

Turning to our consideration of the recited services, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the services at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for services of the type recited both in applicant's applications and the cited registrations. *See, for example*:

> Registration No. 2759552 for financial analysis and consultation with regard to private equity, venture capital and investment funds; financial planning; financial investments in the field of securities; financial management;
>
> Registration No. 2969880 for, *inter alia*, financial management, financial analysis, financial forecasting and consultation, financial savings and investment consulting, investment funds and mutual funds investment consultation, investment advice and investment advisory services;
>
> Registration No. 2899922 for, establishing investment funds for others; investment fund management services; consulting services in the fields of financial analysis and investing; investment fund administration;
>
> Registration No. 3169485 for, *inter alia*, commercial lending services, providing investment and financial information advice, consultation, management and brokerage services, investment advisor services, financial portfolio management services, funds investment consultation;
>
> Registration No. 3164927 for, *inter alia*, investment funds management, financial planning and management services, investment advisory management services, financial analysis and consultation services; and
>
> Registration No. 2347975 for, *inter alia*, lending services in connection with merchant banking transactions, financial and investment management services, financial advisory and consulting services.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *See In*

re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). In this case, the evidence of record supports a finding that the same marks are used to identify financial analysis and consultation, lending, funding and funds advisory and management services of the type provided by applicant and registrants. This evidence demonstrates the related nature of the services at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

Furthermore, it is settled that in making our determination regarding the relatedness of the parties' services, we must look to the services as identified in the involved applications and cited registrations. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of

likelihood of confusion must be decided on the basis of the respective descriptions of goods.") In this case, there are no restrictions in either registrants' recitation of services as to the channels of trade in which the services may be encountered, or type or class of customer to which the services are marketed. Thus, even if the language of applicant's recitation of services may be read as articulating restrictions to the channels of trade therefor, registrants' services are presumed to move in all normal channels of trade therefor and be available to all classes of potential consumers, including consumers of applicant's more narrowly defined services. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Conditions of Sale

Another d*u Pont* factor discussed by applicant and the examining attorney is that of the conditions of sale. Applicant asserts that its services are purchased by careful and sophisticated consumers. However, even if we accept that applicant's services are of a type that would normally be retained only by sophisticated purchasers, it is settled that such purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). That is especially the case where, as

here, identical or highly similar marks are being used to identify related financial services.

Actual Confusion

Applicant also argues that there is no evidence of any actual confusion and that there has been concurrent use for six years in the case of the first cited registration and four years in the case of the second. We do not accord significant weight to applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

> With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Finally, to the extent that we have doubt, we have resolved our doubt, as we must, in favor of the prior registrants and against applicant. *See Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)*; Ava Enterprises Inc. v. Audio Boss USA Inc.,* 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.,* 71 USPQ2d 1844 (TTAB 2004). It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril. *See J & J Snack Foods Corp. v. McDonald's Corp.,* 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.,* 190 USPQ 308 (TTAB 1976).

Decision: The refusals of registration are affirmed.