THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Mailed:
Jan. 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Primary Business Services, Inc.

Serial No. 78824329

Kit M. Stetina of Stetina Brunda Garred & Brucker for Primary Business Services, Inc.

Ingrid Eulin, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Hairston, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Primary Business Services, Inc., applicant herein, seeks registration on the Principal Register of the mark PRIMARY PAY CARD (in standard character form; PAY CARD disclaimed) for services recited in the application as "credit card/debit card financial services."[1]

---

[1] Serial No. 78824329, filed on February 27, 2006. The application is based on applicant's asserted bona fide intention

The Trademark Examining Attorney has issued a final refusal to register applicant's mark, on the ground that the mark, as used in connection with the recited services, so resembles the mark PRIMARY, previously registered on the Principal Register (in standard character form) for services recited in the registration as "financial services, namely issuing stored-value cards,"[2] as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir.

---

to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

[2] Registration No. 3104977, issued on June 13, 2006 to American Express Incentive Services, L.L.C.

2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. 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 goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re Chatam International Inc.,* 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find as follows. First, we find that the dominant feature in the commercial impression created by both applicant's mark and the cited registered mark is the word PRIMARY. PRIMARY is the whole of the cited registered mark. It is dominant in the commercial impression created by applicant's mark because it appears first, and because the additional wording, PAY CARD, is highly descriptive and is disclaimed. For these reasons, we find that the dominant feature in the source-indicating significance of applicant's mark is the word PRIMARY. We therefore give that word more weight in our comparison of the respective marks. *See In re Chatam International Inc., supra; In re National Data Corp., supra.*

In terms of appearance and sound, we find that the marks are identical to the extent that the word PRIMARY appears in both marks. The marks look and sound different to the extent that applicant's mark also includes the words PAY CARD. However, on balance we find that the similarity in appearance and sound which results from the presence of PRIMARY in both marks outweighs any dissimilarity which results from the presence of PAY CARD in applicant's mark. In terms of connotation, we find that the marks are essentially identical. The word PRIMARY has the same

meaning in both marks. As applied to applicant's services, the additional highly descriptive words PAY CARD in applicant's mark do not add anything significant to the meaning of applicant's mark. On balance, we find that the marks are similar in terms of connotation. In terms of overall commercial impression, we find that the marks are essentially identical. Applicant's mark consists of the cited registered mark in its entirety, i.e., PRIMARY, and merely adds the highly descriptive words PAY CARD, which contribute little if anything to the source-indicating commercial impression of the mark.

Considering the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that the marks are similar. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the services as identified in the application and in the cited registration. It is settled that it is not necessary that the respective services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the services themselves, but rather

whether they would be confused as to the source of the services. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applying these principles in the present case, we find that applicant's services are closely related to the services recited in the cited registration. The Trademark Examining Attorney has made of record over twenty use-based third-party registrations in which the recitations of services include both credit and debit cards like applicant's and stored-value cards like registrant's. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the

extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Applicant does not rebut this evidence of source-relatedness. Instead, applicant argues essentially that because stored-value cards like registrant's are not exactly the same thing as applicant's credit/debit cards in terms of how they are obtained and used, the respective services are not similar or related. This argument is unpersuasive. As noted above, the issue is not whether consumers would confuse the services, but rather whether they would confuse the source of the services. In this case, we find that such source confusion is likely, given the evidence of the relatedness of the services. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Applicant argues that purchasers of applicant's services are sophisticated and are careful in making their decision to purchase and use applicant's credit and debit cards. As the Trademark Examining Attorney notes, however, this argument is unsupported by any evidence in the record, and we find it to be wholly unpersuasive in any event. Credit/debit cards and stored-value cards are marketed to

ordinary consumers who would exercise nothing more than ordinary care in purchasing the services. The fourth *du Pont* factor (conditions of purchase) is neutral in this case.

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists, and that Section 2(d) therefore bars registration of applicant's mark.

Decision: The refusal to register is affirmed.