

This Opinion is not a
Precedent of the TTAB

Mailed: January 24, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Stoxx AG

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Serial No. 79174623

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Stewart J. Bellus of Collard & Roe P.C.,
for Stoxx AG.

Xheneta Ademi, Trademark Examining Attorney, Law Office 122,¹
John Lincoski, Managing Attorney.

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Before Zervas, Ritchie, and Shaw,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Stoxx AG (“Applicant”) seeks registration on the Principal Register of the mark TRU, in standard character format, for services identified in relevant part as “provision of stock exchange information; financial services, namely, creation, development, calculation, issuing, updating and rewriting of financial instruments, securities, options, bonds, futures, forward contracts, funds and exchange traded

¹ The case was reassigned to this Examining Attorney after the appeal was filed and Request for Reconsideration was denied.

funds; provision and supply of information and data in connection with stock markets; provision and supply of financial information and information relating to securities and indexes,” in International Class 36.² The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when applied to the identified services, so resembles the previously registered mark, TRUE,³ also in standard character format, for, as relevant, “financial forecasting,” in International Class 36, as to be likely to cause confusion, mistake, or to deceive. The Examining Attorney also refused registration under Section 2(d) in view of the previously registered mark, TRUE (and design), as shown below,⁴ for, “financial services, namely ranking relative performance of investments, mutual funds and hedge funds,” in International Class 36, and which is owned by a different registrant:

TRUE α

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for

² Application Serial No. 79174623 was filed on August 17, 2015, under Section 66(a) of the Trademark Act, claiming priority from International Registration No. 1269717. Other services in other classes were not included in the final refusal to register.

³ Registration No. 3948976 issued April 19, 2011. The registration also includes services in other classes which are not relevant to the refusal.

⁴ Registration No. 3357077 issued December 18, 2007. Sections 8 and 15 affidavits accepted and acknowledged.

reconsideration, the appeal was resumed. For the reasons discussed below, we affirm the refusal to register.

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all 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 Company, 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/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). We consider the *du Pont* factors for which there were arguments and evidence. The others, we consider to be neutral.

For purposes of our likelihood of confusion analysis, we focus on the most relevant cited registration, Registration No. 3948976 (TRUE). We find this mark to be the most relevant of cited registrations for our *du Pont* analysis. Accordingly, if we find a likelihood of confusion as to this cited registration, we need not find it as to the other. On the other hand, if we do not reach that conclusion, we would not find it as to the other cited registration either. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Similarity/Dissimilarity of the Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The entirety of the mark in Registration No. 3948976 is TRUE. Applicant's mark is TRU. Although there is no correct way to pronounce a trademark, it is most likely that consumers would pronounce Applicant's mark the same way as the mark in the cited registration, with a hard "u" sound (and in the case of the mark in the cited registration, in accordance with the typical rules of American English grammar, this is followed by a silent "e."). Thus, the marks are most likely to be pronounced the same, as the word "true." They thus also give the same commercial impression of

providing “true” or accurate financial services as set forth in their respective identifications. Finally, they have the same appearance, with Applicant’s mark just deleting the final, silent, “e.” Thus the marks are substantially the same in sight and commercial impression, and identical in sound.

Applicant argues that the term “TRUE” is very weak in International Class 36, and thus the mark in the cited registration is entitled to a very narrow scope of protection. To this end, Applicant submitted over one hundred live, use-based, third-party registrations that include the term TRUE or TRU in the mark, with services in International Class 36.⁵ We observe that evidence of third-party registrations is relevant to “show the sense in which . . . a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015), citing J. Thomas McCarthy, 2 McCarthy on Trademark and Unfair Competition § 11:90 (4th ed. 2015); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

A number of the third-party registrations submitted by Applicant include the term TRUE or TRU combined with another term for financial or related services. See, for example:

TRUAMERICA (Registration No. 4512682)
TRUBANK (Registration No. 4454604)
TRUFUND (Registration No. 4464063)
TRU STONE (Registration No. 3797088)
TRUE WIND (and design) (Registration No. 4982852)

⁵ We note that some of the registrations submitted by Applicant were not use-based, and some were simply unregistered applications. We give these no consideration in our analysis.

TRUE RATE (Registration No. 4830191) with “rate” disclaimed
TRUCOIN (Registration No. 4754576)
TRUWEST CREDIT UNION (and design) (Registration No. 4695589) with “credit union” disclaimed
TRUECONNECT (Registration No. 4634293)
TRUECAST (Registration No. 4622552)
TRUBRIDGE (Registration No. 4404668)
TRUE VARIABLE ANNUITY (Registration No. 4256231) with “variable annuity” disclaimed
TRUE BLUE (Registration No. 4576849)
TRUE HEDGE (Registration No. 4540281) with “hedge” disclaimed
TRUVISTA (Registration No. 4459104)
TRUFUND FINANCIAL SERVICES (Registration No. 4467823) with “financial services” disclaimed
TRUFUND (Registration No. 4464063)
TRUE BALANCE (Registration No. 4464053)
TRUE LOCAL. TRUE BANKING (Registration No. 4291850) with “banking” disclaimed
TRUE CREATIVE UNSTOPPABLE (Registration No. 4269630)
TRUE REWARDS (Registration No. 4228757) with “rewards” disclaimed
TRUPOINT (Registration No. 3916581)
TRUE GREEN CAPITAL (Registration No. 3913416) with “green capital” disclaimed
TRUMARK FINANCIAL (Registration No. 3082473) with “financial” disclaimed
TRUE MAIL (Registration No. 3490584) with “mail” disclaimed
TRUE VENTURES (Registration No. 3292050) with “ventures” disclaimed
TRUWEST (Registration No. 2867852)
TRUE EARNINGS (Registration No. 3225581)
TRUENORTH (Registration No. 3149332)
TRUELOAN (Registration No. 4526012)
TRUE TO YOUR MONEY (Registration No. 3867416)
TRUEPATH (Registration No. 3968551)
THE SEARCH FOR TRUE ADVISORS (Registration No. 3831882) with “advisors” disclaimed
TRUE ADVISOR (Registration No. 3831739) with “advisor” disclaimed
TRUE PRICE (Registration No. 3846495) with “price” disclaimed
TRUE DIVERSIFICATION (Registration No. 3812954) with “diversification” disclaimed
TRUE TO YOU (Registration No. 3768874)
TRUE FINANCIAL WEALTH MANAGEMENT FIRM (Registration No. 3373630) with “financial wealth management firm” disclaimed

Applicant further points out that Applicant itself was allowed to register STOXX TRU⁶ for effectively the same services at issue in the current refusal. Finally, Applicant notes the third-party registration for the stylized  for payment processing services (Registration No. 4357737). We find, based on the evidence of record, that the term TRUE or TRU is suggestive of financial services in that consumers will indeed likely look to other distinguishing terms. That said, there is little to distinguish Applicant's "TRU" from the mark "TRUE" in the cited Registration No. 3948976. The sole absence of the final, silent letter "e" is insufficient to distinguish the sight, sound or commercial impression. Indeed, absent the inclusion of any other terms, design, or even stylization, Applicant's mark TRU is more similar to the mark in the cited Registration No. 3948976, TRUE, than are any of the marks in the third-party registrations. In this regard, we keep in mind that even weak marks are entitled to the presumptions of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), and are entitled to protection against registration of confusingly similar marks, especially where, as here, the evidence shows that the marks are substantially similar and nearly identical. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Thus we find the marks overall to be substantially similar in sight, sound, and commercial impression, and this first *du Pont* factor favors finding a likelihood of confusion.

⁶ Registration No. 4962119, issued May 24, 2016, with a Section 2(f) claim as to "STOXX."

Services/Channels of Trade/Classes of Purchasers

We consider next the relatedness of the services. The cited Registration No. 3948976 identifies “financial forecasting.” Applicant identifies “provision of stock exchange information; financial services, namely, creation, development, calculation, issuing, updating and rewriting of financial instruments, securities, options, bonds, futures, forward contracts, funds and exchange traded funds; provision and supply of information and data in connection with stock markets; provision and supply of financial information and information relating to securities and indexes,” which would seem by its plain language meaning to include and incorporate “financial forecasting.”

Applicant argues that there is no “per se” rule that the services are related.⁷ While correct, we look to see if the services are of a type that consumers will believe they emanate from a common source. In this regard, the Examining Attorney submitted copies of use-based third-party registrations that include services of the type identified in the application on the one hand, and services of the type identified in the cited registration on the other hand. These include Registration No. 3124972 (Valleystone Credit Union (and design)); Registration No. 3522689 (T TENNESSEE STATE BANK “YOUR KIND OF BANK” MEMBER FDIC (and design)); Registration No. 4093031 (AMERICA’S WATCHDOG); Registration No. 428516 (BMO HARRIS); Registration No. 4295127 (CONWAY MAKENZIE); Registration No. 4361323 (design mark); Registration No. 4529525 (FINANCIAL SMARTNESS); Registration No.

⁷ 7 TTABVUE 8.

4611245 (DOMEYARD); Registration No. 4616693 (DREAMSPACE); Registration No. 4628268 (CFOTODAY); Registration No. 4741099 (FINANCIAL HEALTH INDEX); Registration No. 4803855 (MAKING COMMUNITIES GREAT); and Registration No. 4963458 (EMPOWERING FINANCIAL WELLNESS). Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). Also, as noted, we find that Applicant’s “provision and supply of information and data in connection with stock markets.” by its plain language meaning includes and incorporates “financial forecasting.”

With regard to the channels of trade, in the absence of specific limitations in the cited registration, we must presume that Registrant’s services will travel in all normal and usual channels of trade and methods of distribution. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *see also In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the services in the registration and the application move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services). Since there are no limitations on the channels of trade in Applicant’s identification of services either, we must make the same presumption with regard to Applicant’s services. There is no evidence of record to dispute these presumptions. These *du Pont* factors favor a finding of likelihood of confusion.

II. Conclusion on Likelihood of Confusion

On balance, after considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that despite suggestiveness of the term “TRU,” the marks are substantially similar in sight and commercial impression and identical in sound, and that the services are related and overlapping and would be expected to travel through some of the same channels of trade to some of the same consumers. We therefore find that Applicant’s mark TRU for the applied-for services in International Class 36 is likely to cause confusion with the cited mark TRUE in Registration No. 3948976 for “financial forecasting.”

Decision: The refusal to register Applicant’s mark for the services in International Class 36 is affirmed.

The application will proceed to publication for the services in International Classes 35, 41, and 42.