OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 76/325275

The prior pending applications have matured to registration. Likelihood of confusion has been found under section 2(d) of the Trademark Act with US Registrations 2726367 and 2690927.

The assigned examining attorney has reviewed the referenced application and determined the following.

LIKELIHOOD OF CONFUSION UNDER 2(d)

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration Nos. 2726367 and 2690927 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. In re August Storck KG, 218 USPQ 823 (TTAB 1983); In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978); Guardian Products Co., v. Scott Paper Co., 200 USPQ 738 (TTAB 1978).

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. In re DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. In re Mack, 197 USPQ 755 (TTAB 1977).

Applicant seeks to register the mark “FLAGSHIP” +design. Registration No. 2726367 is for the word mark “AA CREDIT UNION FLAGSHIP REWARDS.” Registration No. 2690927 is for the word mark “FLAGSHIP BANK.” Applicant’s mark is similar with regard to appearance, sound, meaning and commercial impression to the mark of cited registrant. The marks convey the same overall commercial impression. See: In re Ak zona Inc., 94 (TTAB 1983); In re Wm. E. Wright Co., 185 USPQ 445 (TTAB 1975).

After examining the marks, the examining attorney applies the second step of the test, whether there is a likelihood of confusion on the basis of the services identified in the application and registration. If the cited registration describes the services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. In re Elbaum, 211 USPQ 639 (TTAB 1981).
Applicant’s services are described as “investment management services and distribution related activities in respect of open end and closed end mutual funds and individually managed investment accounts designed for institutional and retail clients.” Registrant’s services are “financial services, namely providing an incentive-based checking account to its members” and “banking services.” The services of applicant are closely related to the services of registrant. The applicant’s and registrants’ services are likely to be encountered by the same purchasers in the same channel of trade. Given the confusing similarity of the marks, consumers familiar with the registrant’s services are likely to believe that applicant’s services come from the same source.

The fact that the services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular services, but likelihood of confusion as to the source of those services. See In re Resel Inc., 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP section 1207.01. Applicant’s and registrant’s services as described in the identifications noted above could be encountered by the same purchasers and if such a situation occurred, it is likely that the purchaser would be confused as to the source of the services. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

/Brett Tolpin/
Attorney-Advisor (Trademarks)
Law Office 115
Phone: (703) 308-9115 x292
Fax: (703) 872-9875
ecom115@uspto.gov

How to respond to this Office Action:

To respond formally using the Office’s Trademark Electronic Application System (TEAS), visit http://www.uspto.gov/teas/index.html and follow the instructions.

To respond formally via E-mail, visit http://www.uspto.gov/web/trademarks/tmelecresp.htm and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney’s name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office’s Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov/

For general and other useful information about trademarks, you are encouraged to visit the Office’s web site at http://www.uspto.gov/main/trademarks.htm

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.
TYPED DRAWING

Serial Number
78062130

Status
REGISTERED

Word Mark
FLAGSHIP BANK

Registration Number
2690927

Date Registered
2003/02/25

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
[1] TYPED DRAWING

Owner
Chittenden Corporation CORPORATION VERMONT Two Burlington Square
Burlington VERMONT 05402

Goods/Services

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BANK" APART FROM THE MARK AS SHOWN.

Filing Date
2001/05/04

Examining Attorney
PHAM, LANA

Attorney of Record
Timothy H. Hiebert

-1-
Filing Date
2000/11/13

Examining Attorney
FRENCH, CURTIS

Attorney of Record
Kay Lyn Schwartz
Serial Number
76164065

Status
REGISTERED

Word Mark
AA CREDIT UNION FLAGSHIP REWARDS

Registration Number
2726367

Date Registered
2003/06/17

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
[3] DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
American Airlines, Inc. CORPORATION DELAWARE M.D. 5675 P.O. Box 619616
DFW Airport TEXAS 752619616

Goods/Services

Prior Registration(s)
Z26634;2415226

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CREDIT UNION" and "REWARDS" APART FROM THE MARK AS SHOWN.
Serial Number 76/325275

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Typed Drawing

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Registration Number
2690927

Date Registered
2003/02/25

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
Chittenden Corporation CORPORATION VERMONT Two Burlington Square
Burlington VERMONT 05402

Goods/Services
Class Status -- ACTIVE. IC 036. US 100 101 102. G & S: Banking
services. First Use: 1987/12/27. First Use In Commerce: 1988/05/04.

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BANK" APART FROM THE
MARK AS SHOWN.

Filing Date
2001/05/04

Examining Attorney
PHAM, LANA

Attorney of Record
Timothy H. Hiebert
Serial Number
76164065

Status
REGISTERED

Word Mark
AA CREDIT UNION FLAGSHIP REWARDS

Registration Number
2726367

Date Registered
2003/08/17

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
American Airlines, Inc. CORPORATION DELAWARE M.D. 5675 P.O. Box 619616
DFW Airport TEXAS 752619616

Goods/Services

Prior Registration(s)
2266034-2416228

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