

App. Serial No.: 85/622,265  
Mark: PRONTO & Design  
Applicant: Pronto, LLC



To be filed electronically

### **RESPONSE TO OFFICE ACTION**

Applicant submits the following response to the Office Action dated September 6, 2012.

#### **I. Likelihood of Confusion.**

Applicant seeks to register its mark, PRONTO & Design, in connection with the following amended identification of services: “financial services, namely, pre-paid credit cards.”

The Office has refused registration of the instant application on grounds of likely confusion with United States Registration Nos. (collectively, the “Cited Registrations”):

1. 3,842,366 (the ‘366 Mark) for the mark “PRONTO” in connection with “arranging of loans, namely, providing income tax refund advance loans.”
2. 3,842,367 (the ‘367 Mark) for the mark “PRONTO & Design” in connection with “arranging of loans, namely, providing income tax refund advance loans.”
3. 3,226,297 (the ‘297 Mark) for the mark “PRONTO COMMISSIONS & Design” in connection with “financial services, namely, real estate commissions factoring services.”
4. 3,572,429 (the ‘429 Mark) for the mark “PRONTO PAYMENT” in connection with “bill payment services.”
5. 3,572,046 (the ‘046 Mark) for the mark “PRONTO CASH CHECK CASHING & Design” in connection with “financial services, namely, check cashing services, foreign currency exchange services, money order services, money transfer services, electronic funds transfer services, consumer loan services, namely, installment loans and temporary loans, bill payment services, utility bill payment services, telephone calling card services, and automated teller machine services.”
6. 3,094,799 (the ‘799 Mark) for the mark “PRONTO CASH” in connection with “financial services, namely, check cashing services, foreign currency exchange services, money order services, money transfer services, electronic funds transfer services, consumer loan services, namely, installment loans and temporary loans, bill payment services, utility bill payment services, telephone calling card services, and automated teller machine services.”

Applicant initially notes that the ‘799 Mark was cancelled on December 28, 2012. Since the ‘799 Mark is no longer a valid registration, Applicant contends there is no likelihood of confusion between the subject application and the ‘799 Mark.

Applicant respectfully disagrees with the Office’s assessment that the each of the Cited Registrations are confusingly similar to Applicant’s mark for at least the following reasons:

- (i) The Cited Registrations are only entitled to narrow protection, because the term PRONTO is commonly used as a service mark in the field of financial services;
- (ii) The relevant consuming group is comprised of sophisticated consumers, who will exercise care in selecting a provider of financial services;
- (iii) The services of the respective parties are not sufficiently related to create a likelihood of confusion; and
- (iv) The respective marks are not sufficiently similar to create a likelihood of confusion.

*In re E.I. Dupont DeNemours & Co.* sets forth thirteen factors which, “when of record, must be considered” in testing for likelihood of confusion. 476 F.2d 1357, 1361 (C.C.P.A. 1973); *see also* TMEP § 1207.01. The four *DuPont* factors at issue in relation to this Office Action are (i) the number and nature of similar marks in use with similar goods and services, (ii) consumer sophistication, (iii) the distinction between the services offered in connection with the respective marks, and (iv) the distinctions between the marks themselves.

Application of the *DuPont* factors to the facts of the instant case demonstrates that concurrent use of Applicant’s mark and the marks in the Cited Registrations is unlikely to create consumer confusion.

**A. The Cited Registrations are only entitled to narrow protection, because the term PRONTO is commonly used as a service mark in the field of financial services.**

The term PRONTO, as used in the Cited Registrations, is a weak mark entitled only to narrow protection, because it is commonly used by third parties in the field of financial services. Where the same or similar marks are used by numerous sources in the same or similar field, each mark is reduced to a weak indicator of source, because consumers have become accustomed to distinguishing between such marks based on minute distinctions. *In re Green Bancorp, Inc.*, Serial No. 78/659,563, 2011 WL 6780735 (TTAB 2011) (non-precedential cases may be cited for persuasive value according to the USPTO Official Gazette Notices: 23 January 2007 “*Citation of Opinions to the Trademark Trial and Appeal Board*”).

In fact, it is for this reason, that the marks in the Cited Registrations (owned by four different sources) can coexist in commerce and on the US Trademark Registry without a likelihood of confusion, as well as, the following third-party registrations (owned by six different sources) incorporating the term PRONTO in connection with financial and related services:

1. U.S. Reg. No. 2,287,543 for the mark \$ PRONTO ENVIOS & Design in connection with “electronic transfer of funds,” owned by Envios R. D. Corporation, a company located in New York, New York.

2. U.S. Reg. No. 3,351,998 for the mark PRONTO PRE\$TAMOS & Design in connection with “loan financing,” owned by Community Finance Group, LLC, a company located in Elgin, Illinois.
3. U.S. Reg. No. 3,630,219 for the mark PRONTO! PASS in connection with “electronic payment services, namely, providing use of an outside payment terminal with an integrated printer owned and operated by registrant or its licensees to allow customers to pay for vehicle fuel and print receipts for such fueling transactions,” owned by TA Operating LLC, a company located in Westlake, Ohio.
4. U.S. Reg. No. 4,120,278 for the mark PRONTO INCOME TAX in connection with “income tax consultation; income tax preparation; tax advisory services; tax and taxation planning, advice, information and consultancy services,” owned by Pronto Income Tax of California, Inc., a company located in Carson, California.
5. U.S. Reg. No. 3,867,961 for the mark PRONTO in connection with “providing an online computer database in the field of real estate and insurance services, namely, providing land valuation data on the replacement costs of residential, commercial, farm and ranch real estate; providing online consultation regarding insurance claims administration,” owned by E2VALUE, Inc., a company located in Stamford, Connecticut.
6. U.S. Reg. No. 4,102,155 – PRONTO & Design in connection with “providing an online computer database in the field of real estate and insurance services, namely, providing land valuation data on the replacement costs of residential, commercial, farm and ranch real estate; providing online consultation regarding insurance claims administration,” owned by E2VALUE, Inc., a company located in Stamford, Connecticut.
7. U.S. App. Serial No. 85/672,866 for the mark PRONTO TRANSFER in connection with “electronic transfer of money; money transfer; money wiring services,” claiming use as early as September 30, 2008 by Pronto Transfer, Inc., a company located in Framingham, Massachusetts.

Applicant notes that, although the third party registrations do not necessarily provide evidence of use of such registered marks in commerce, it is clear they do show that (i) the term PRONTO is highly suggestive of financial and related services (since it is commonly adopted and used by third parties for financial and related services) and (ii) the Office has acknowledged the weak nature of the term PRONTO and the ability for such marks to co-exist in the financial industry (implicit in the fact that ten different parties own registrations for marks comprised of the term PRONTO alone or with a descriptive term in connection with financial and related services). *See In re Green Bancorp, Inc.*, Serial No. 78/659,563, 2011 WL 6780735 (TTAB 2011); *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984); *Mead Johnson & Co. v. Eckes*, 195 USPQ 747 (TTAB 1985).

Moreover, in addition to the Office’s electronic records, the Applicant has set forth below a non-exhaustive list identifying a significant number of third parties using the term PRONTO in

connection with financial and other related services, as evidenced by telephone directory listings, Internet searches, and a search of the Dun & Bradstreet database, attached hereto as Exhibit A. See *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996) (finding that a combination of telephone directory listings, evidence from a search of a Dun & Bradstreet database, and evidence from a search of the American Business Directory was strong evidence of third-party use of a mark); see also *In re Rock Creek Cattle Co.*, Serial No. 77/044,838, 2009 WL 1741905 (TTAB 2009) (finding that a Dun & Bradstreet database search provided evidence of third-party use of a mark).

1. CHEQUE PRONTO, a financial services company located in Atlanta, Georgia.
2. PRONTO ALL INSURANCE SERVICES, a check cashing and income tax preparation services company located in Homestead, Florida.
3. PRONTO CASH, a check cashing services company located in Hialeah, Florida.
4. PRONTO CASH EXPRESS, a banking and check cashing services company located in Pico Rivera, California.
5. PRONTO CASH OF FLORIDA INC., a financial services company located in Plantation, Florida.
6. PRONTO CHECK CASHING 16, a banking and check cashing services company located in Midland, Texas.
7. PRONTO CHECK CASHING 9, a banking and check cashing services company located in Odessa, Texas.
8. PRONTO CHECK CASHING LTD, a banking and check cashing services company located in Lubbock, Texas.
9. PRONTO CHECK SERVICES, a banking and check cashing services company located in Ellensburg, Washington.
10. PRONTO CHECKS CASH & SERVICES, a banking services company located in Hidalgo, Texas.
11. PRONTO DOLLARS, a tax return preparation services company located in King City, California.
12. PRONTO DOLLARS INCOME TAX, an accounting, auditing and bookkeeping company located in Soledad, California.
13. PRONTO ENVIOS, a banking and money order services company located in Bronx, New York.
14. PRONTO FINANCIAL SERVICES, a financial services company located in Los Angeles, California.
15. PRONTO FINANCIAL SERVICES, a financial consulting services company located in Fort Myers, Florida.
16. PRONTO FINANCIAL SERVICES, a financial investment services company located in Houston, Texas.
17. PRONTO FINANCIAL SERVICES, a financial consulting services company located in Homestead, Florida.
18. PRONTO FINANCING, a financial services company located in Homestead, Florida.
19. PRONTO GIROS INC., a financial services company located in Naples, Florida.
20. PRONTO INCOME TAX, a tax return preparation services company located in Culver City, California.

21. PRONTO INCOME TAX, a tax return preparation services company located in Medina, Ohio.
22. PRONTO INCOME TAX INC, a tax return preparation services company located in Miami, Florida.
23. PRONTO INCOME TAX SERVICE, a tax return preparation services company located in Salinas, California.
24. PRONTO INCOME TAX AND INSURANCE AGENCY, a tax return preparation services company located in Rockford, Illinois.
25. PRONTO INCOME TAX OF CALIFORNIA, an accounting, auditing and bookkeeping services company located in Bell, California.
26. PRONTO INSURANCE, a financial investment consulting and insurance services company located on 5607 Uvalde Road in Houston, Texas.
27. PRONTO INSURANCE, a financial investment consulting and insurance services company located on 1550 Fry Road in Houston, Texas.
28. PRONTO INSURANCE, a financial investment consulting and insurance services company located on 1818 Ebony Lane in Houston, Texas.
29. PRONTO INSURANCE, a financial investment consulting and insurance services company located on 6102 Scott Street in Houston, Texas.
30. PRONTO INSURANCE, a financial investment consulting and insurance services company located in Port Arthur, Texas.
31. PRONTO INSURANCE & FINANCIAL SERVICES, a financial services company located in Brownsville, Texas.
32. PRONTO INSURANCE & FINANCIAL SERVICES, a financial services company located in Harlingen, Texas.
33. PRONTO INSURANCE & FINANCIAL SERVICES, a financial services and loan brokerage company located in Laredo, Texas.
34. PRONTO INSURANCE AND FINANCIAL SERVICES, an insurance and financial company located in San Antonio, Texas.
35. PRONTO INVESTMENTS INC., a financial investment services company located in Pico Rivera, California.
36. PRONTO INVESTMENTS LLC., a financial investment services company located in Marietta, Georgia.
37. PRONTO INVESTMENTS LLC., a financial investment services company located in New Orleans, Louisiana.
38. PRONTO INVESTMENTS LLC., a financial investment services company located in Orlando, Florida.
39. PRONTO MONEY, a banking and money order services company located in Houston, Texas.
40. PRONTO MONEY TRANSFER INC, a banking services company located in Manhattan Beach, California.
41. PRONTO MORTGAGE INC., a mortgage lending services company located in Prairieville, Louisiana.
42. PRONTO REFUND TAX, a tax return preparation services company located in Florence, Kentucky.
43. PRONTO REFUND TAX SERVICE, a tax return preparation services company located in Cincinnati, Ohio.

44. PRONTO SERVICE, a tax return preparation services company located in Forth Worth, Texas.
45. PRONTO SETTLEMENT CORP., an investment consulting services company located in Hollywood, Florida.
46. PRONTO TAX, a tax return preparation services company located in Lodi, California.
47. PRONTO TAX, a tax return preparation services company located in Palm Desert, California.
48. PRONTO TAX, a tax return preparation services company located in Hartford, Connecticut.
49. PRONTO TAX, a tax return preparation services company located in Riverside, Illinois.
50. PRONTO TAX, a tax return preparation services company located in Round Lake, Illinois.
51. PRONTO TAX, a tax return preparation services company located in Abilene, Texas.
52. PRONTO TAX CORPORATION, a tax return preparation services company located in Palatine, Illinois.
53. PRONTO TAX INC, a tax return preparation services company located in Bronx, New York.
54. PRONTO TAX SERVICE, a tax return preparation services company located in Rittman, Ohio.
55. PRONTO TAX SERVICE, a tax return preparation services company located in New Braunfels, Texas.
56. PRONTO TAX SERVICE INC, a tax return preparation services company located in Hendersonville, Tennessee.
57. PRONTO TAX SERVICES, a tax return preparation services company located in Santa Clara, California.
58. PRONTO TAX SERVICES, a tax return preparation services company located in Wasco, California.
59. PRONTO TAX SERVICES LLC, a tax return preparation services company located in Phoenix, Arizona.
60. PRONTO TAX, a tax return preparation services company located in Mundelein, Illinois.
61. PRONTO TAXES, a tax return preparation services company located in Raleigh, North Carolina.
62. PRONTO TAXES, a tax return preparation services company located in Cleveland, Ohio.
63. PRONTO TAXES INC., a tax return preparation services company located in Houston, Texas.
64. PRONTO DOLLARS, a tax return preparation services company located in Mission, Texas.

It is established trademark law that when a mark such as PRONTO is commonly used by many sellers, it is only afforded narrow protection. J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:88 (4<sup>th</sup> ed. 2011); *Royal Petroleum Corp. v. River States Oil Co.*, 136 U.S.P.Q. 79 (T.T.A.B. 1962); *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (T.T.A.B. 1976). The greater the number of identical or more or less similar marks already in use in a field, the less likely consumers will be confused between any two specific uses of the weak mark. *First Sav. Bank, FSB v. First Bank System, Inc.*, 101 F.3d 645, 653 (10<sup>th</sup> Cir. 1996).

The implication of common third party use was addressed in *King Candy Co. v. Eunice Kings Kitchen, Inc.*, wherein the court found that confusion was not likely between the mark KING'S for candy and MISS KING'S for cakes (even though the marks were virtually identical and the goods highly related) because, *inter alia*, the term KING was commonly used by third parties as a trademark causing it to be a "weak" mark. 496 F.2d 1400, 1401 (CCPA 1974). The court explained that the expressions "weak" and "entitled to limited protection" are merely another way of saying that confusion is *unlikely*, because such marks are so widely used that the public has learned (or been conditioned) to easily distinguish slight differences in the marks as well as differences in the goods to which they are applied, even when the goods of the parties may be considered similar or related. *Id.*

The Board sustained this understanding in *In re The Coca-Cola Co.* when it found confusion unlikely between the marks SPRITE QUENCH and QUENCH, both used in connection with soft drinks because, *inter alia*, the common portion of the respective marks were "highly suggestive" or weak as a result of common use by third parties. *In re The Coca-Cola Co.*, Serial No. 78/449,413, 2007 WL 3320310 (TTAB 2007). In reaching its decision the court explained that:

[i]t is settled that, unlike the case of arbitrary or unique designations, suggestive or highly suggestive terms, because of their obvious connotations and possible frequent employment in a particular trade as part of trade designations, have been considered to fall within the category of "weak" marks, and the scope of protection afforded these marks have been so limited as to permit the use and/or registration of ... a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods.

*Id.* quoting *Standard Brands, Inc. v. Peters*, 191 USPQ 168, 172 (TTAB 1975).

More recently, in a case directly on point, the Board found no likelihood of confusion in connection with concurrent use of the registrant's GREEN SAVINGS, GREEN CHECKING and GREEN BRANCH and applicant's GREEN BANK and GREEN BANCORP, INC., each in connection with identical financial services. *In re Green Bancorp, Inc.*, Serial No. 78/659,563, 2011 WL 6780735 (TTAB 2011). The Board determined that, as a result of common third party use of the term GREEN in the financial industry (evidenced by third party registrations and third party use), the cited registrations were weak and entitled to a very limited scope of protection, such that the descriptive elements in the applicant's mark were sufficient to preclude any consumer from assuming the respective banking services emanated from a single source. *Id.*

Here, the Applicant has submitted overwhelming evidence in the form of third-party registrations, telephone directory listings, Dun & Bradstreet search results and Internet search results showing that the term PRONTO is commonly used by third parties as a service mark in the field of financial services. Since the market is flooded with numerous instances of third parties using the term PRONTO in the field of financial services, it is clear that the term PRONTO, as used in the Cited Registrations, is a weak indicator of source.

As explained in the foregoing cases, since the term PRONTO is a weak mark, the Cited Registrations are only entitled to a very limited scope of protection and, under such

circumstances, minute distinctions between the respective marks or the respective services are sufficient to preclude a likelihood of confusion.

Accordingly, this factor weighs strongly in favor of finding no likelihood of confusion.

**B. The relevant consuming group is comprised of sophisticated consumers, who will exercise care in selecting financial services.**

In addition to being accustomed to common use of marks containing the term PRONTO in connection with financial services, the consumers of the respective financial services are sophisticated and, therefore, held to a higher standard of care. There is always less likelihood of confusion when the services are purchased after careful consideration. See, e.g., *Astra Pharm. Prod. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983).

Trademark law recognizes that consumers of financial services exercise a great deal of care and deliberation when choosing such services, because their choice directly affects their financial well-being. *In re Bancorp Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008); see also *Peoples Federal Savings Bank v. People's United Bank*, 99 USPQ2d 1205 (D. Mass 2011) (stating that customers ordinarily gather information before choosing financial services and make their decision based on substantive factors other than a service provider's name); *Capitol Federal Savings Bank v. Eastern Bank Corp.*, 2007 WL 7309743 (D. Mass 2007) (stating that a decision regarding where to place one's money and savings or where to obtain a home equity loan as well as assessing other financial services and loan services is a serious undertaking and one not typically engaged in lightly by the ordinary purchaser without deliberation and care); *InterState Net Bank v. Net B@nk, Inc.*, 348 F.Supp.2d 340, 355 (D.N.J.2004) ("consumers undoubtedly exercise a high degree of care in selecting banking and financial services and are likely to note difference in names"); *Chase Manhattan Bank, USA, N.A. v. Freedom Card, Inc.* 333 F.Supp.2d 239, 249 (D. Del. 2004) (finding that consumers exercise "considerable care" in selecting financial services); *First Nat'l Bank in Sioux Falls v. First Nat'l Bank South Dakota*, 153 F.3d 885, 890 (8<sup>th</sup> Cir. 1998) (concluding that "consumers tend to exercise a relatively high degree of care in selecting banking services [and a]s a result, customers are more likely to notice what, in other contexts, may be relatively minor differences in names."); *Empire Nat'l Bank of Traverse City v. Empire of Amer. FSA*, 222 U.S.P.Q. 518, 522 (W.D. Mich. 1983) (explaining that financial services are not normally subject to impulse buying and, therefore, the degree of purchaser care in the field of financial services does not promote a likelihood of confusion).

Consumers will undoubtedly exercise care in selecting a provider of financial services, because such consumers are entrusting their money and savings to such commercial businesses for safe keeping and/or investment purposes. See *InterState Net Bank*, 348 F.Supp.2d at 355. Moreover, due to the high degree of care and deliberation exercised, such consumers will take the time to educate themselves sufficiently regarding the respective services and the identity of the brands, and are more likely to notice minute distinctions in the names of such financial service providers. See *In re Bancorp Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008).

Where, as here, the consumers are sophisticated, allegations of a likelihood of confusion based on similarities between the respective marks (even when used with identical services) have



failed. *See, e.g., In re Bancorp Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding no likelihood of confusion between BANKATLANTIC and ATLANTIC BANK, each for banking services, because, *inter alia*, consumers of financial services are sophisticated).

Accordingly, this factor weighs strongly in favor of finding no likelihood of confusion.

**C. The services of the respective parties are not sufficiently related to create a likelihood of confusion.**

The services provided in connection with Applicant's mark and the services identified in the Cited Registrations are not sufficiently related to create a likelihood of confusion, and there is no evidence that consumers would consider such products to emanate from the same source.

Initially, Applicant notes that there is no rule that certain goods or services are *per se* related. TMEP § 1207.01(a)(iv). A determination of whether services are related does not revolve around the question of whether a term can be used to describe such services, or whether such services can be classified under the same general category or industry—the examining attorney must evaluate the merits of each case. *See Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992); *see also Mason Tackle Co. v. Victor United, Inc.*, 216 U.S.P.Q. 197, 203 (C.D. Cal. 1982) (finding that the fishing and golf industries are different commercial fields for purposes of trademark law, notwithstanding that both exist within the sports field).

Moreover, since the Cited Registrations consist of the weak term PRONTO alone or coupled with descriptive or generic words, the scope of protection afforded to the Cited Registrations is extremely limited. Consequently, where a comparison of services generally may take into account the degree of relatedness, in the instant matter it is only appropriate to consider whether the services of the Cited Registrations are identical or virtually identical to Applicant's services. *See Commerce Bancorp, Inc. v. Martell & Associates Financial Services Co.*, Opposition No. 91124853, 2004 WL 2368481 (TTAB 2004).

Applicant's services consist of the issuance of pre-paid credit cards to consumers. Accordingly, a consumer seeking Applicant's services will pay a certain amount of money to Applicant in exchange for a credit card containing a balance relative to the amount paid. Applicant's services will likely benefit consumers who seek to obtain a credit card, but may not have an adequate credit history or want a financial institution to review its credit history.

In contrast to Applicant's services, the services of the Cited Registrations are:

1. The '366 and '367 Marks used in connection with "arranging of loans, namely, providing income tax refund advance loans"—in other words, money lending services. These services are intended to benefit someone who requires an immediate advance of money. The very nature of these services is in contrast to the nature of Applicant's services, which can only benefit someone who has money to purchase and/or load a pre-paid credit card. Moreover, Applicant's issuance of pre-paid credit cards have nothing to do with lending services or any other extension of credit.

2. The '297 Mark in connection with "financial services, namely, real estate commissions factoring services." In other words, the '297 Mark services involve an advance of money to a person, *e.g.*, a real estate broker, in exchange for the right to receive a commission fee on a real estate transaction. These services are intended to benefit a real estate broker who has brokered a transaction that may not close for thirty or sixty days, but needs an immediate advance of money. As with the '366 and '367 Marks services, the very nature of the '297 Mark services are in contrast to the nature of Applicant's services, which can only benefit someone who has money to purchase and/or load a pre-paid credit card. Furthermore, Applicant's issuance of pre-paid credit cards have nothing to do with real estate transactions, advancing money, factoring commissions, or any other extension of credit.
3. The '429 Mark in connection with "bill payment services." The '429 Mark services are intended to facilitate a transaction on behalf of a person who wants to satisfy an outstanding obligation—in essence, money transferring services. As with the previous Cited Registrations, the nature of these money transferring services are in contrast to the nature of Applicant's services, which do not involve a transfer of money, but instead only involve the purchase or loading of a pre-paid credit card.
4. The '046 Mark "financial services, namely, check cashing services, foreign currency exchange services, money order services, money transfer services, electronic funds transfer services, consumer loan services, namely, installment loans and temporary loans, bill payment services, utility bill payment services, telephone calling card services, and automated teller machine services." For the same reasons outlined above, the loan services and bill payment services are not related to the Applicant's services. Likewise, the check cashing services, currency exchange services, money order services, transfer services and ATM services are distinct from Applicant's issuance of pre-paid credit cards and serve a different customer base—Applicant's pre-paid credit cards do not involve cashing checks, exchanging currency, issuing money orders or transferring money to third parties. Finally, Applicant's issuance of pre-paid credit cards are distinct from the '046 Mark telephone calling card services and serve a completely different purpose. A telephone calling card is generally obtained for the purpose of making long distance phone calls and is functionally limited to the payment of fees associated with such phone calls. In contrast, Applicant's pre-paid credit card services are generally obtained for the purpose of facilitating consumer purchase transactions using a safe, secure and convenient alternative to cash.

It is clear from a review of the respective services that Applicant's services are not identical or virtually identical to any of the services identified in the Cited Registrations. In fact, Applicant's services are not even related to the services identified in the Cited Registrations and serve an entirely different customer base. When services are provided to two distinct customer bases, consumers are not likely to assume the services originate from the same mark. *See Checkpoint Systems, Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 288 (3<sup>rd</sup> Cir. 2001).

Moreover, it is important to note that it is the Office who bears the burden to prove and "must provide evidence showing that the goods and services are related to support a finding of

likelihood of confusion.” TMEP 1207.01(a)(iv); *see also The B.V.D. Licensing Corp. v. Florencio Rodriguez*, 83 U.S.P.Q.2d 1500, (T.T.A.B. 2007).

Considering the evidence set forth above distinguishing the respective services, the Office’s conclusory statements that the respective services are related is insufficient to satisfy the burden of proof necessary to establish even a *prima facie* case for a likelihood of confusion. *See In re Majestic Inc.*, 829 F.2d 1114, 1117–1118 (Fed. Cir. 1987) (stating that conclusory statements are insufficient without evidence supporting the conclusion).

In view of the limited scope of protection afforded to the Cited Registrations and the significant distinctions between the respective services, it is clear that this factor weighs strongly in favor of finding no likelihood of confusion.

**D. The respective marks are not sufficiently similar to create a likelihood of confusion.**

Applicant’s PRONTO & Design mark is dissimilar in appearance, sound, meaning and commercial impression when compared to each of the Cited Registrations.

Evaluating the similarity between a registered mark and an applicant’s mark requires examination of the sight, sound, meaning, and commercial impression of the two marks. *In re Coors Brewing Co.*, 343 F.3d 1340, 1346 (Fed. Cir. 2003). In particular, the evaluation “must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression,” since the impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. *Research in Motion Ltd. v. Fashionberry, Inc.*, Opposition No. 91191572, 2011 TTAB LEXIS 336 (TTAB 2011); *see also Chicago Mercantile Exchange, Inc. v. Globix Corp.*, Opposition No. 91117543, 2004 TTAB LEXIS 222 (TTAB 2004).

“Similarity of the marks in one respect—sight, sound or meaning—will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related.” TMEP § 1207.01(b)(i). Moreover, when the dominant portion of a mark has weak trademark significance, minute distinctions in the respective marks can be sufficient to avoid any likelihood of confusion, even if the underlying services are identical. *See In re Bancorp Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008); *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984).

In a controlling decision, *In re Hamilton Bank*, the Board found no likelihood of confusion between the applicant’s mark KEY & Design and the registered marks BANKEY & Design, KEYCHECK, KEY-CARD BANK, KEY-BANKER, and CB KEY, each used for banking services, based on a finding that the term “KEY” was commonly used in marks adopted in the banking field, as evidenced by twenty third party registrations. 222 USPQ 174, 179 (TTAB 1984). The Board found that the applicant’s mark was distinguishable from the cited registrations, because it incorporated a design element and omitted the other descriptive elements included in the cited registrations. *Id.* The Board explained that “the applicant’s mark is no more likely to cause confusion with the five cited registered marks than the five cited registered marks are likely to cause confusion with the fifteen other registered marks that contain the term ‘KEY.’”

These principals have been recognized in the following analogous cases: (i) *In re BankAtlantic Bancorp, Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding the registrant's mark ATLANTIC BANK and the applicant's marks BANKATLANTIC and BANKATLANTIC & Design, each in connection with banking services, sufficiently distinct to avoid a likelihood of confusion, since the term ATLANTIC was commonly used in the marks of financial institutions and the applicant's mark included); (ii) *In re Green Bancorp, Inc.*, Serial No. 78/659,563, 2011 WL 6780735 (TTAB 2011) (finding the registrant's marks GREEN SAVINGS, GREEN CHECKING and GREEN BRANCH and the applicant's marks GREEN BANK and GREEN BANCORP, INC., each in connection with identical financial services, were sufficiently distinct to avoid a likelihood of confusion, since the dominant portion of each mark—the term GREEN—was commonly used in the field of financial services); (iii) *First Savings Bank, F.S.B. v. First Bank System, Inc.*, 101 F.3d 645, 653 (10th Cir.1996) (finding the plaintiff's mark FIRST BANK & Design and the defendant's mark FIRST BANK SYSTEM & Design, each in connection with banking services, sufficiently distinct to avoid a likelihood of confusion, since the dominant portion of each mark—FIRST BANK—was commonly used in the field of financial services and the parties' logos were visually distinct); and (iv) *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan*, 651 F.2d 311, 319 (5th Cir.1981) (finding the plaintiff's mark SUNBANKS & Design and the defendant's mark SUN FEDERAL SAVINGS & Design, each used for financial services, were sufficiently distinct to avoid a likelihood of confusion, since the dominant portion of each mark—SUN—was in common use in the field of financial services and the respective marks each contained distinguishing descriptive elements and design elements).

When the Cited Registrations are compared to Applicant's mark PRONTO & Design (set forth below), it is clear that the respective marks are sufficiently distinct to avoid a likelihood of confusion.



1. The '366 Mark for PRONTO in connection with loan services.

Applicant's mark and the '366 Mark are sufficiently distinct in appearance and commercial impression weighing against a finding of likelihood of confusion.

Applicant notes that the respective marks are similar only to the extent that they each incorporate the commonly used and weak term PRONTO. Under the circumstances, however, this similarity alone is insufficient to support a finding of likely confusion. As the aforementioned cases explain, even minute distinctions between the marks can be sufficient to avoid a likelihood of confusion. Here, the appearance of Applicant's mark is obviously distinguished from the '366 Mark by the inclusion of a prominently sized (almost equal in size to the literal element of the mark) and stylized depiction of a bird. Since the '366 Mark is comprised only of the common term PRONTO, the inclusion of the design feature in Applicant's mark is a significant factor eliminating any likelihood of confusion. See *In re BankAtlantic Bancorp, Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding that a simple design element, which would not normally mitigate potential confusion, becomes a significant factor when weak marks are compared for similarity).

Although Applicant’s mark and the ‘366 Mark may have the same connotation, derived from the common term PRONTO which is defined as “at once or promptly,” they are distinguished in the commercial impression conveyed by each mark. See Exhibit B.

In *In re Force Technology*, a case controlling on this analysis, the Board found that the different impressions conveyed by the marks SEASENSE, used in connection with marine navigational instruments, and SEA SENSE, used in connection with marine hardware and parts, militated against a finding a likelihood of confusion. Serial No. 79/040,079, 2009 WL 1896058 (TTAB 2009). Notwithstanding the identical sound and visual appearance of the respective marks and the fact both marks were used in connection with the nautical or marine industry, the mark SEASENSE when applied to marine navigational instruments suggests that the goods “sense” or detect marine conditions (*e.g.*, heavy seas or meteorological events), whereas SEA SENSE when applied to marine hardware and parts conveys the idea of “good sense” or “common sense”—the use of the marine hardware makes “good sea sense.” *Id.*

When applied to the registered loan services, the ‘366 Mark imparts a commercial impression of immediate cash. In contrast, Applicant’s mark when applied to the identified pre-paid credit card services conveys a commercial impression of a credit card issued without the hassle and delay of a financial institution credit check.

Applicant submits that in view of (i) the common third party use of the term PRONTO, (ii) the sophistication of the relevant consumers, (iii) the lack of similarity or relationship between Applicant’s pre-paid credit card services and the ‘366 Mark loan services, and (iv) the distinctions between the respective marks, there is no evidence to support a finding of likelihood of confusion.

2. The ‘367 Mark for PRONTO & Design (shown below) in connection with loan services.



Applicant’s mark and the ‘367 Mark are sufficiently distinct in appearance and commercial impression, weighing against a finding of likelihood of confusion.

As with the ‘366 Mark, the respective marks here are similar only to the extent that they each incorporate the weak term PRONTO. However, as explained above, since the term PRONTO is commonly used in service marks for the financial industry, this sole similarity is insufficient to support a finding of likely confusion. Instead, under the circumstances, the obvious distinctions between the respective marks—the font style and additional design elements—are sufficient to avoid a likelihood of confusion.

In particular, it is clear that each mark exhibits the term PRONTO in a different stylized font. The ‘367 Mark exhibits the term PRONTO in all capitalized letters in a slanted font style that implies forward movement and speed. In contrast, the Applicant’s mark is exhibited in all lower case letters in a distinct font style with standard vertical text positioning. See *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984) (finding that the stylization of the literal mark further

reduced the likelihood of confusion). Additionally, each mark incorporates a distinct design element. The ‘367 Mark incorporates a depiction of a bird after the term PRONTO, that is proportionate in size to the letters in the mark and is somewhat militaristic in design. Although Applicant’s mark also includes a depiction of a bird, it is clearly distinct in comparison to the ‘367 Mark’s bird design. The bird depicted in Applicant’s mark is disproportionately large (almost as big as the literal element of the mark), placed above the second half of the literal elements, and is composed of a patchwork-like design. In view of the common use of the term PRONTO, these distinct design elements and stylized features are clearly sufficient to preclude any likelihood of confusion. *See In re BankAtlantic Bancorp, Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding that a simple design element, which would not normally mitigate potential confusion, becomes a significant factor when weak marks are compared for similarity).

Although Applicant’s marks and the ‘367 Mark may have the same connotation, derived from the common term PRONTO which is defined as “at once or promptly,” they are distinguished in the commercial impression conveyed by each mark. As with the ‘366 Mark, the analysis and comparison of the commercial impression between the ‘367 Mark and Applicant’s mark is controlled by *In re Force Technology*, Serial No. 79/040,079, 2009 WL 1896058 (TTAB 2009).

When applied to the registered loan services, the ‘367 Mark imparts a commercial impression of immediate cash. In contrast, Applicant’s mark when applied to the identified pre-paid credit card services conveys a commercial impression of a credit card issued without the hassle and delay of a financial institution credit check

Applicant submits that in view of (i) the common third party use of the term PRONTO, (ii) the sophistication of the relevant consumers, (iii) the lack of similarity or relationship between Applicant’s pre-paid credit cards and the ‘367 Mark loan services, and (iv) the distinctions between the respective marks, there is no evidence to support a finding of likelihood of confusion.

3. The ‘297 Mark for PRONTO COMMISSIONS & Design (shown below) in connection with real estate commissions factoring services.



Upon taking into account the entireties of the respective marks, Applicant’s mark and the ‘297 Mark are completely distinct in appearance, sound, meaning a commercial impression, weighing against a finding of likelihood of confusion.

The ‘297 Mark consists of two words, PRONTO COMMISSIONS, and a disproportionately large, stylized depiction of a man running with a banknote in hand. In contrast, Applicant’s mark consists of a single word, PRONTO, and a disproportionately large, stylized depiction of a bird, which in no way resembles or is comparable to the ‘297 Mark design feature. In view of the common use of the term PRONTO, the distinct design elements in the respective marks and the ‘297 Mark’s incorporation of the term COMMISSIONS is clearly sufficient to distinguish the

appearance of the marks and preclude any likelihood of confusion. *See In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (finding that the applicant's mark KEY was distinct in comparison to the cited registrations for BANKEY & Design, KEYCHECK, KEY-CARD BANK, KEY-BANKER, and CB KEY, because it was presented in a stylized manner and, in contrast to the cited registrations, no other descriptive element was used in combination with the applicant's KEY mark); *see also In re BankAtlantic Bancorp, Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding that a simple design element, which would not normally mitigate potential confusion, becomes a significant factor when weak marks are compared for similarity).

The respective marks are further distinguished in their aural characteristics. Since the '297 Mark contains two words, PRONTO COMMISSIONS, and Applicant's mark consists solely of the term PRONTO, consumers will include a second distinct element when pronouncing the '297 Mark, thereby distinguishing the sound of respective marks.

Furthermore, the respective marks have different meanings. As mentioned above, the term PRONTO means "at once or promptly." The term COMMISSIONS means "a fee allocated to an agent for services rendered." *See Exhibit B*. Accordingly, while the meaning of Applicant's mark is "at once or promptly" in general terms, the words of the composite '297 Mark connote an image of immediate receipt of a commissions fee.

The distinct meaning afforded to each mark is enhanced by examination of the highly distinct commercial impressions created when the marks are applied to the underlying services. The analysis and comparison of the commercial impression between the '297 Mark and Applicant's mark is controlled by *In re Force Technology* where, as mentioned above, the Board found that virtually identical marks SEASENSE and SEA SENCE conveyed distinct commercial impressions when applied to the respective nautical industry goods. Serial No. 79/040,079, 2009 WL 1896058 (TTAB 2009).

The rationale in *Force Technology* argues even more forcefully against a finding of confusing similarity in the present case, because here the marks are not identical (as they were in *Force Technology*), and the difference in commercial impression is even more pronounced.

When applied to the registered commissions advance services, the '297 Mark imparts a commercial impression of immediate payment of future commissions. In contrast, Applicant's mark when applied to the identified pre-paid credit card services conveys a commercial impression of a credit card issued without the hassle and delay of a financial institution credit check.

Applicant submits that, in view of (i) the common third party use of the term PRONTO, (ii) the sophistication of the relevant consumers, (iii) the lack of similarity or relationship between Applicant's pre-paid credit card services and the '297 Mark commissions advance services, and (iv) the distinctions between the respective marks, there is no evidence to support a finding of likelihood of confusion.

4. The '429 Mark for PRONTO PAYMENT & Design (shown below) in connection with bill payment services.

**Pronto**  
PAYMENT

As with the '297 Mark, when taking into account the entireties of the respective marks, Applicant's mark and the '429 Mark are completely distinct in appearance, sound, meaning and commercial impression, weighing against a finding of likelihood of confusion.

The '429 Mark consists of two words, PRONTO PAYMENT, and exhibits the term PRONTO in a stylized and slanted font that incorporates a line through the "P" and each "O" of the term, all conveying the impression of forward movement and speed. In contrast, Applicant's mark consists of a single word, PRONTO, exhibited in lower case letters in a distinct font style with standard vertical text positioning and a disproportionately large, stylized depiction of a bird. In view of the common use of the term PRONTO, the distinct design elements in the respective marks and the '429 Mark's incorporation of the term PAYMENT, it is clear that the marks are sufficiently distinct in appearance to preclude any likelihood of confusion. *See In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (finding that the applicant's mark KEY was distinct in comparison to the cited registrations for BANKEY & Design, KEYCHECK, KEY-CARD BANK, KEY-BANKER, and CB KEY, because it was presented in a stylized manner and, in contrast to the cited registrations, no other descriptive element was used in combination with the applicant's KEY mark); *see also In re BankAtlantic Bancorp, Inc.*, Serial No. 75/618,643, 2008 WL 4674561 (TTAB 2008) (finding that a simple design element, which would not normally mitigate potential confusion, becomes a significant factor when weak marks are compared for similarity).

The respective marks are further distinguished in their aural characteristics. Since the '429 Mark contains two words, PRONTO PAYMENT, and Applicant's mark consists solely of the term PRONTO, consumers will include a second distinct element when pronouncing the '429 Mark, thereby distinguishing the sound of respective marks.

Furthermore, the respective marks have different meanings. As mentioned above, the term PRONTO means "at once or promptly." The term PAYMENT means "the act of paying." *See Exhibit B*. Accordingly, while the meaning of Applicant's mark is "at once or promptly" in general terms, the words of the composite '429 Mark connote an image of paying immediately.

The distinct meaning afforded to each mark is enhanced by examination of the highly distinct commercial impressions created when the marks are applied to the underlying services. The analysis and comparison of the commercial impression between the '429 Mark and Applicant's mark is also controlled by the *In re Force Technology* Board decision. Serial No. 79/040,079, 2009 WL 1896058 (TTAB 2009).

Furthermore, as with the '297 Mark, the *Force Technology* rationale argues more forcefully against a finding of confusing similarity between Applicant's mark and the '429 Mark, because here the marks are not identical (as they were in *Force Technology*), and the difference in commercial impression is more pronounced.



When applied to the registered bill payment services, the ‘429 Mark imparts a commercial impression of a service that will immediately pay outstanding third party bills. In contrast, Applicant’s mark when applied to the identified pre-paid credit card services conveys a commercial impression of a credit card issued without the hassle and delay of a financial institution credit check.

Applicant submits that, in view of (i) the common third party use of the term PRONTO, (ii) the sophistication of the relevant consumers, (iii) the lack of similarity or relationship between Applicant’s pre-paid credit card services and the ‘429 Mark bill payment services, and (iv) the distinctions between the respective marks, there is no evidence to support a finding of likelihood of confusion.

5. The ‘046 Mark for PRONTO CASH CHECK CASHING & Design (shown below) in connection with check cashing services, foreign currency exchange services, money order services, money transfer services, electronic funds transfer services, consumer loan services, namely, installment loans and temporary loans, bill payment services, utility bill payment services, telephone calling card services, and automated teller machine services.



When taking into account the entireties of the respective marks, Applicant’s mark and the ‘046 Mark are completely distinct in appearance, sound, meaning and commercial impression.

The ‘046 Mark consists of four words, PRONTO CASH CHECK CASHING, and a depiction of a stylized sunburst all inside a dark rectangular box. In contrast, Applicant’s mark consists of a single word, PRONTO, in lower cased font and a disproportionately large, stylized depiction of a bird. In view of the common use of the term PRONTO, the distinct design elements in the respective marks and the ‘046 Mark’s incorporation of the words CASH CHECK CASHING, it is clear that the marks are sufficiently distinct in appearance to preclude any likelihood of confusion. *See In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984) (finding that the applicant’s mark KEY was distinct in comparison to the cited registrations for BANKEY & Design, KEYCHECK, KEY-CARD BANK, KEY-BANKER, and CB KEY, because it was presented in a stylized manner and, in contrast to the cited registrations, no other descriptive element was used in combination with the applicant’s KEY mark); *see First Sav. Bank, FSB v. First Bank Sys., Inc.*, 1010 F.3d 645, 653 (10<sup>th</sup> Cir. 1996) (finding that that the defendant’s mark FIRST BANK & Design was sufficiently distinct from the plaintiff’s mark FIRST BANK SYSTEM & Design, because the font of the respective marks was different, the arrangement of words was different, each incorporated a different design feature and the plaintiff’s composite mark appeared against a black square shaped background).

The respective marks are further distinguished in their aural characteristics. Since the ‘046 Mark contains four words, PRONTO CASH CHECK CASHING, and Applicant’s mark consists solely of the term PRONTO, consumers will incorporate an additional three distinct elements when pronouncing the ‘046 Mark, thereby greatly distinguishing the sound of respective marks.

Furthermore, the respective marks have different meanings. As mentioned above, the term PRONTO means “at once or promptly”. The term CASH means “money or a money equivalent;” CHECK means “a written order directing a bank to pay money;” and CASHING means “to give or obtain cash in exchange for a check or money order.” See Exhibit B. Accordingly, while the meaning of Applicant’s mark is “at once or promptly” in general terms, the words of the composite ‘046 Mark connote an image of immediate cash payment in exchange for a bank check.

The distinct meaning afforded to each mark is enhanced by examination of the highly distinct commercial impressions created when the marks are applied to the underlying services. The analysis and comparison of the commercial impression between the ‘046 Mark and Applicant’s mark is controlled by the *In re Force Technology* Board decision, which under the instant facts argues strongly against a finding of confusing similarity, because the several distinct elements of the composite ‘046 Mark pronounce a completely different commercial impression than that conveyed by Applicant’s mark. Serial No. 79/040,079, 2009 WL 1896058 (TTAB 2009).

When applied to the various financial services identified in the ‘046 Mark registration, the ‘046 Mark imparts a commercial impression of immediate cash payments in exchange for bank checks. In contrast, Applicant’s mark when applied to the identified pre-paid credit card services conveys a commercial impression of a credit card issued without the hassle and delay of a financial institution credit check.

Applicant submits that, in view of (i) the common third party use of the term PRONTO, (ii) the sophistication of the relevant consumers, (iii) the lack of similarity or relationship between Applicant’s pre-paid credit card services and the ‘046 Mark services, and (iv) the distinctions between the respective marks, there is no evidence to support a finding of likelihood of confusion.