

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 24, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **First National Bank of Omaha**

Serial Nos. 75/069,804
75/069,805
75/069,810
75/069,999
75/074,218

Denise C. Mazour of Zarley, McKee, Thomte, Voorhees & Sease
for First National Bank of Omaha

Raul F. Cordova, Trademark Examining Attorney, Law Office
108 (**David Shallant**, Managing Attorney)

Before **Hanak**, **Hohein** and **Chapman**, Administrative Trademark
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

First National Bank of Omaha (applicant) seeks to
register five marks (words underlined have been
disclaimed): (1) PLATINUM EDITION SAVINGS BOND for "banking
services, namely, providing savings account services to
credit card holders" (75/069,804 filed March 11, 1996 with

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a claimed first use date of February 1996); (2) PLATINUM PASSBOOK SAVINGS for "banking services, namely, providing savings account services to credit card holders" (75/069,805 filed March 11, 1996 with a claimed first use date of November 1990); (3) PLATINUM FUND SAVINGS for "banking services, namely, providing money market savings account services to credit card holders" (75/069,810 filed on March 11, 1986 with a claimed first use date of May 1987); (4) PLATINUM for "banking services, namely, providing certificates of deposit and individual retirement account services to credit card holders" (75/069,999 filed on March 11, 1986 with a claimed first use date of June 1985); and (5) PLATINUM CERTIFICATE OF DEPOSIT for "banking services in the nature of certificates of deposit" (75/074,218 filed March 18, 1996 with a claimed first use date of June 1985).

The same Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Act on the basis that each of applicant's five marks as applied to its respective services is likely to cause confusion with the mark PLATINUM ADVANTAGE, previously registered for "banking services." Registration No. 1,906,759 issued on July 18, 1995 with a claimed first use date of July 2, 1993.

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When the refusals to register were made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We reverse for two reasons.

First, as applied to goods and services in general and banking services in particular, the word "platinum" is quite laudatory and hence descriptive. In this regard, we note that the Examining Attorney has conceded that the term "platinum" as applied to both registrant's and applicant's services is laudatory. (Examining Attorney's brief page 3). Moreover, it has been held that as applied to financial services, the word "'platinum' describes the quality of [said] services" in that it indicates "a superior service." Platinum Home Mortgage v. Platinum Financial Group, 149 F.3d 722, 47 USPQ2d 1587, 1591 (7 Cir. 1998). As such, the word "platinum" per se would not be entitled to trademark status absent of showing a secondary meaning, and even then it would be "a weak mark." 47 USPQ2d at 1591.

Obviously, the only element common to the registered mark and applicant's five marks is the word "platinum." It is long been held that "the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion." Tektronix,

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Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976). Of course, if the common word or portion is not just highly suggestive but instead is descriptive, likelihood of confusion is rarely found. See In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)(The marks BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL, when used on virtually identical services, were held not to be confusingly similar given the fact that the common portion "bed & breakfast" was held to be descriptive.).

To be perfectly clear, in finding that word "platinum" is descriptive of various financial services, including banking services, we are not attacking the registered mark PLATINUM ADVANTAGE. As our primary reviewing Court has noted, "registration affords prima facie rights in the mark as a whole, not in any component. Thus, a showing of descriptiveness or genericness of a part of a mark does not constitute an attack on the registration." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) (original emphasis).

Our second reason for reversal is the fact that the Examining Attorney has never taken issue with the contention of applicant that the selection of banking services "is not done on impulse." (Applicant's brief page

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4). It is common knowledge that to open a bank account, invest in a certificate of deposit, obtain a credit card, etc., various disclosure statements must be read and agreed to, and various contracts must be signed. Thus, banking services are simply not "purchased" absent at least some degree of study. Such study significantly reduces the chances for likelihood of confusion to occur. Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).¹

Decision: The five refusals to register are reversed.

E. W. Hanak

G. D. Hohein

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

¹ The Examining Attorney is to be commended for bringing to the Board's attention the Platinum Home Mortgage case. Because the Examining Attorney was aware that the Court found the word "platinum" to be descriptive of financial services and yet the Examining Attorney did not issue a mere descriptive refusal in any of the five applications, we find it inappropriate to remand any or all of the five applications for consideration of such a refusal. In re United States Tobacco, 1 USPQ2d 1502, 1505 (TTAB 1986).

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