

No Likelihood of Confusion or Dilution Between CITIBANK and CAPITAL CITY BANK

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Although the majority of the relevant **likelihood of confusion factors** favored an opposer, the U.S. Court of Appeals for the Federal Circuit affirmed the Trademark Trial and Appeal Board's denial of an opposition filed by opposer Citigroup Inc. against four service mark applications filed by Capital City Bank (CCB). **Citigroup Inc. v. Capital City Bank Grp., Inc.**, Case No. 10-1369 (Fed. Cir., March 28, 2011) (Gajarsa, J.)

Citigroup began using the mark CITIBANK in 1897 and adopted "Citibank" as its official company name in 1967. Citigroup owns multiple federally registered trademarks for financial services containing the CITI prefix, including CITI, CITICORP and CITIBANK. Many of Citigroup's registrations have become "incontestable," and the CITIBANK brand has been recognized as one of the most valuable brands in the world. Capital City Bank Group offers banking services through 69 branches in three U.S. states. Capital City Bank Group applied to register four marks, including CAPITAL CITY BANK, CAPITAL CITY BANK INVESTMENTS, CAPITAL CITY BANK GROWING BUSINESS and CAPITAL CITY BANC INVESTMENTS. As standard character marks, the applications were not limited to a particular font style, size, color or design element.

Citigroup filed a notice of opposition with the **TTAB** against each of CCB's applications, alleging **likelihood of confusion with and likelihood of dilution** of its CITIBANK marks. The TTAB treated all four applications as one for evaluating likelihood of confusion under the **DuPont factors**. The TTAB found that four of the six relevant factors favored Citigroup, namely, the fame of the CITIBANK marks, the similarity of the parties' financial products and services, the similarity of the parties' trade channels and the similarity of the parties' target customers. However, the TTAB determined that no likelihood of confusion or dilution would result from registration of CCB's marks because the two remaining DuPont factors, i.e., the nature and extent of any actual confusion and the similarity of the marks, favored applicant CCB.

On appeal, Citigroup challenged the TTAB's factual determinations concerning **actual confusion** and the similarity of the parties' marks. The Federal Circuit affirmed the TTAB's finding that the similarity of the marks factor favored applicant CCB, as the record detailed the distinctive spellings of the parties' marks and common third-party usage of the phrase "City Bank" within the banking industry. Concerning actual confusion, the Court found again that substantial evidence, namely the concurrent use of the respective marks in the same geographic markets since 1975,

supported the TTAB's finding of an absence of actual confusion. Finally, the Court also rejected Citigroup's approach of "mechanically tallying" the DuPont factors as improper, holding in accordance with Federal Circuit precedent, that not all of the DuPont factors are necessarily relevant in every case and that any one of these factors may control.

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