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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Forte Solutions Group, LLC

Serial No. 76699385

Kay Lyn Schwartz of Gardere Wynne Sewell LLP for Forte Solutions Group, LLC.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

Before Grendel, Mermelstein and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Forte Solutions Group, LLC ("applicant") filed a use-based application to register the mark PLAN4, in standard character form, for services ultimately identified as "business planning services," in Class 35.

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark is likely to cause confusion with the previously

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registered mark PLAN4DEMAND, in typed drawing form, for "business consulting services," in Class 35.¹

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

- A. The similarity or dissimilarity and nature of the services described in the application and registration, the likely-to-continue channels of trade and classes of consumers.

Because the scope of the registration applicant seeks

¹ Registration No. 2558639, issued April 9, 2002; renewed. Registrant deleted "information technology consulting services," in Class 42, when it filed its combined declaration of use and renewal application.

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is defined by its application (and not by its actual use) it is the recitation of services in its application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

By the same token, in considering the scope of the cited registration, we look to the recitation of services in the registration itself, and not to extrinsic evidence about the registrant's actual services, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Applicant is seeking to register its mark for "business planning services" and the cited registration is for "business consulting services."

"Consulting" is defined as "employed or involved in giving professional advice to the public or to those practicing a profession."²

"Planning" is defined as "the act or process of making a plan or plans."³

By definition, business consulting is broad enough to encompass business planning because a company rendering business consulting services could be consulting about business planning. This finding of fact is corroborated by the third-party websites excerpts attached to the August 29, 2011 Office action. The third-party websites include the following:

1. Maruya Associates (maruyaassociates.com)

In touting its business consultation services, Maruya Associates explains that it provides "Customized Business Plans."

Our business plan consultants work side-by with you and your team to prepare a full-length plan that begins with your aimed audience in psyche. We facilitate wide-ranging business planning process over several weeks that result in a well-organized, written and fully customized plan ready

² The Random House Dictionary of the English Language (Unabridged), p. 437 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ *Id.* at 1481.

for presentation to investors, lenders
and other strategic third parties.

2. Z Intro (zintro.com) is a website directory for
"4 'Business Planning, Coaching & Consultation.'"

3. Cole Gavlas, PC (colegavlas.com) advertises tax
and business advisory services. Cole Gavlas identifies
"business planning" as part of its "business consultation."

4. Bon-Wine Consulting (bon-wine.com) is a company
specializing the China wine market. It advertises that its
business consultation includes planning.

5. Creative Business Adventures
(creativebusinessadventures.com) advertises that its
business planning services includes "consult and help
establish short term priorities" and "business consulting
in person or by telephone."

6. Williams Teusink Larsen (williamsteusink.com) is
a law firm that advertises "business planning and
operations" services, including "business consultation."

7. Reginald Singh, CPA, MBA advertises in the
BusinessHelp.com website that he provides "business
consulting" and "strategic business planning."

8. Hicks, Hicks, & Braun (hhbtaxes.com) advertise
that they provide small business consultation and strategic
business planning.

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In addition, the examining attorney submitted numerous third-party registrations for marks that include both business planning and business consulting services (e.g., Registration No. 3934653 for the mark DEEP INTELLIGENCE, Registration No. 3773798 for the mark DELIVERABLES BASED PLANNING, and Registration No. 3875709 for the mark PLAYSTUDIO). Third-party registrations which individually cover a number of different services that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

In view of the foregoing, we find that applicant's "business planning services" are closely related to registrant's "business consulting services." Furthermore, the evidence noted above demonstrates that business planning services and business consulting services move in the same channels of trade and are sold to the same classes of consumers.⁴

⁴ In addition, because business consulting encompasses business planning, we must presume that the channels of trade and classes of purchasers are the same. See *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d

Applicant argues that the markets for applicant's services and registrant's services are distinctly different (*i.e.*, applicant's services are related to business planning and registrant's services for supply chain consulting).⁵ However, because there are no relevant limitations as to channels of trade or classes of purchasers in the recitation of services in the application or the cited registration, it is presumed that applicant's business planning services and registrant's business consulting services move in all channels of trade normal for those services, and that they are available to all classes of purchasers for those services. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Under these circumstances, we cannot resort to extrinsic evidence to restrict the channels of trade for applicant's or registrant's services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions

1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

⁵ Applicant's Brief, pp. 11-12.

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in the application or registration). Because business consulting encompasses business planning, the services move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of the mark in the cited registration.

Applicant references seven registrations owned by five entities for "Plan4" or "Planfor" marks for different services and argues that "Plan4" is a weak term that is entitled to a narrow scope of protection.⁶ Applicant references the following registrations:

1. Registration No. 3433876 for the mark PLANFORTOMORROW for financial planning services, namely, estate planning, financial planning for retirement, and investment consultation and investment management;

2. Registration No. 3429354 for the mark CAREPLAN4LIFE for consulting and legal services, namely, providing parents of children afflicted with cerebral palsy, erbs palsy and other special needs with a comprehensive program and plan to guide them in medical, educational and financial planning for their children;

3. Registration No. 2410136 for the mark PLAN4EVER.COM for providing information via the global

⁶ Applicant's Brief, pp. 9-10.

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computer network in the field of retail goods for the death care industry, namely, books, cards, flowers, urns, caskets and monuments; and for providing information via the global computer network in the field of funeral and legal services;

4. Registration No. 2862187 for the mark PLAN4HEALTH for educational services, namely, lectures on the subject of health and diet; and

5. Registration No. 2881196 for the mark PLAN4TEN, Registration No. 2800385 for the mark PLAN4MOST, and Registration No. 2821214 for the mark PLAN4ONE all for the administration of employee benefit plans.

The third-party registrations submitted by applicant are of limited probative value because they do not cover the same services in cited registration. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue). See also *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, (CCPA 1972) ("Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word "KEY". The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are

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in continued use. We, therefore, can give them but little weight in the circumstances present here").

Also, third-party registrations do not prove that PLAN4DEMAND is a weak term. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). See also *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party [sic] registrations are still in use. Because of this doubt, third party [sic] registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286. See also *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given any weight").

Nevertheless, third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of services because a term has a recognized meaning. In this case, PLAN4 means "to make plans for." Accordingly, we find that registrant's mark PLAN4DEMAND is a suggestive mark that informs consumers that registrant's services are focused on planning for increased consumer demand.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the services are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d

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874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Moreover, in comparing the marks, 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 goods and 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 unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

The marks are similar in appearance, sound, meaning and commercial impression because they share the term "Plan4," suggesting that the services are rendered to assist businesses in planning something: in applicant's case, planning for anything, in registrant's case, planning for increased consumer demand. In fact, registrant's mark incorporates applicant's entire PLAN4 mark which may lead consumers to mistakenly believe that PLAN4DEMAND is a version of applicant's PLAN4 business planning services

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that focuses on consumer demand. In this case, the presence the word "Demand" in the registrant's mark does not eliminate the likelihood of confusion. See, *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709. As indicated above, PLAN4DEMAND is likely to be perceived as a particular version of PLAN4 when used in connection with registrant's closely related business consulting services.

In view of the foregoing, we find that applicant's mark PLAN4 is similar to registrant's mark PLAN4DEMAND in terms of appearance, sound, meaning and commercial impression.

D. Degree of consumer care.

Applicant argues, without any supporting evidence, that

Applicant's and Registrant's services are directed to a specific consumer. Therefore, the ultimate consumers are relatively sophisticated due to the nature of the specialized services. Another factor to consider is the price involved with the services. Both the services of the applicant and registrant would not be considered inexpensive by the average consumer's standard. This means that great care would be taken in selecting these services. As such, the purchasers are careful."⁷

We acknowledge that the business owners will exercise a relatively high degree of care when acquiring or using business consulting or business planning services. However, on this record, we cannot find that the degree of the care exercised by business owners outweighs the similarity of the marks and the similarity of the services.

E. Balancing the factors.

In view of the facts that the marks are similar, the services are closely related and move in the same channels of trade and are available to the same classes of consumers, we find that applicant's mark PLAN4 for "business planning services" is likely to cause confusion

⁷ Applicant's Brief, p. 12.

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with the mark PLAN4DEMAND for "business consulting services."

Decision: The refusal to register is affirmed.