

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Mailed: November 17, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bernstein

Serial No. 77743350

David Michael Bernstein pro se.

Thomas M. Manor, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Quinn, Kuhlke and Mermelstein, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

David Michael Bernstein seeks registration on the
Principal Register of the standard character mark WE THE
PEOPLE PLAN for services identified as "information about
political elections; providing an internet website
featuring news and information in the field of national and
international politics; providing information regarding
political issues, knowing how to vote and knowing how to
register to vote" in International Class 35.¹

¹ Application Serial No. 77743350, filed May 22, 2009, under
Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), based on

Serial No. 77743350

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with the identified services, so resembles the registered, typed-form mark WE THE PEOPLE for services identified as "promotion of public awareness of the need for political reform" in International Class 42.²

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With regard to the similarity or dissimilarity of the marks, we analyze the respective marks in terms of their

allegations of first use on July 2, 2005 and first use in commerce on March 7, 2009.

² Registration No. 1823942 issued February 22, 1994; renewed 2004.

Serial No. 77743350

appearance, sound, connotation and overall commercial impression. It is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important. See Kangol Ltd. v. Kangaroo U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). However, certain portions of a mark may be more dominant and, therefore, carry more weight in the analysis. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark WE THE PEOPLE PLAN incorporates the entirety of registrant's mark WE THE PEOPLE. Moreover, the WE THE PEOPLE portion of applicant's mark is a common phrase associated with the United States Constitution, and, as such, stands alone as a phrase at the beginning of applicant's mark. "[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("[T]he first word in the mark" is a "prominent feature"). Thus, we find the marks to be very similar in

appearance, sound, connotation and commercial impression. The addition of the word PLAN to applicant's mark at the end, is not sufficient to distinguish the marks. Viewing the marks in their entireties, we find that the similarities outweigh the dissimilarities.

Applicant argues that the phrase WE THE PEOPLE is "so common" that:

... it can only be that which follows that can distinguish one mark from another, ... It [is] beyond the scope of this letter to even begin to argue against the initial trademark of the sole expression "We The People", all universal expressions, be it We The People, The Declaration of Independence, LIFE, LIBERTY, and The PURSUIT OF HAPPINESS, ... should be required to ADD a follow-on qualifier (as in our case, the word PLAN). To my mind, it's akin to someone simply registering "United States" ... it should be forbidden. It should ONLY be allowed WITH a qualifier "United States X". ... As stated, the weighted emphasis shouldn't simply be on the WE THE PEOPLE, because it is common to both, ... it is vital to look at the next word or series of words keeping in mind that we make NO claim to the expression "we the people" by itself (and as I stated previously, I'm surprised that ANYONE was allowed to because this is one [of] those few expressions that I think belongs to all of us, as Americans ... what comes after "we the people" it's the first phrase in The U.S. Constitution; it's the expression that identifies ALL Americans AS Americans ... the fact, that we are having difficulty being We The People PLAN because someone was allowed to be "we the people" seems strange. Not to mention, as we will demonstrate below, the original registrant is no longer even using so there is no way to confuse the two.

Br. p. 2.

Applicant's argument then is that (1) the registration should not have issued, (2) the registrant's mark is no longer in use, and (3) the addition of PLAN is sufficient to distinguish the marks.

First, as the examining attorney states "[w]hether or not Registrant should have been permitted registration in the first instance is beyond the scope of examination of this application" and prior decisions of other examining attorneys have little evidentiary value. Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). In addition, under Section 7(b) of the Trademark Act, the cited registration must be given all presumptions of validity and we cannot consider evidence and argument regarding any possible impropriety of registration or abandonment of use. In the context of an ex parte appeal this is considered an impermissible attack on a registration. In *re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). To attack the registration, applicant would have needed to petition to cancel it under Section 14(3) of the Trademark Act.

Applicant also argues that there "are numerous 'We The People X' [marks] that have been granted registration, all

Serial No. 77743350

presumably without issue." In support of this argument applicant submitted a listing of applications from the USPTO electronic database TESS. As the examining attorney explained in his Office action, listings are not sufficient to make these applications and registrations of record. In re Promo Ink, 78 USPQ2d 1301, 1304 (TTAB 2006), In re Dos Padres Inc., 49 USPQ2d 1860, 1861 n.2 (TTAB 1998). In addition, the list does not provide sufficient information from which to make any determination as to the diluted nature of the phrase in the relevant field of use, i.e., information on politics and promotion of public awareness about politics. As stated by the examining attorney:

These arguments and evidence are not applicable to the present application, as the terms "We the People" are used by those owners on unrelated goods and/or services. In order to refuse an application pursuant to the Trademark Act Section 2(d), the goods and/or services of the relevant marks/parties must be related. Further, cancelled Registrations have no value in a Section 2(d) analysis.

Br. pp. 6-7.

The examples highlighted by applicant do not serve to limit the scope of protection to be accorded registrant's mark because they are for very different goods and services, e.g., a bike company and document preparation services.

We also find applicant's services "information about political elections; providing an internet website featuring news and information in the field of national and international politics; providing information regarding political issues, knowing how to vote and knowing how to register to vote" and registrant's services "promotion of public awareness of the need for political reform" to be closely related. Both services are in the field of politics and focus on informing the public on political issues; applicant's "political issues" encompass registrant's "political reform" and registrant's "political reform" encompass "political elections." While the services reside in different classes, this is purely an administrative determination and does not affect the analysis as to the similarity of the services. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 29 USPQ2d 1212, 1216 n.5 (TTAB 1990).

Applicant argues that its "objectives" are different from registrant's in that registrant's "organization was simply a cover for a political campaign" and applicant is "apolitical" and "dedicated to educating ALL Americans about the political process." Br. p. 3. However, the registration is not so limited and, as written, registrant's services cover promotion of the need for

Serial No. 77743350

political reform to the general public, i.e., all Americans. We must make our determination on these issues based on the identification, as written, and not on what evidence may reveal to be the actual scope of use. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (we must make our determination based on the goods as they are identified in the application and registration and not based on evidence of their actual use); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). See also *In re Thor Tech, Inc.*, 90 USPQ2d 1634 (TTAB 2009); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Further, in view of the close relationship between the services and the absence of any limitations in the identifications, we must presume that they travel in the same channels of trade and are offered to the same classes of customers. *Id.*

In view of the above, we find that the services are related and travel in the same channels of trade and are offered to the same potential consumers.

In conclusion, we find that because the marks are similar, the services are related, and the channels of trade and potential consumers overlap, confusion is likely

Serial No. 77743350

between applicant's mark WE THE PEOPLE PLAN and registrant's mark WE THE PEOPLE. To the extent there is any doubt, we resolve it, as we must, in registrant's favor. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.