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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re W.T. Adams & Co.

Serial No. 85015200

Albert A. Chapar, Jr. of The Chapar Firm, LLC for W.T. Adams & Co.

Jenny Park, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Zervas, Cataldo and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

W.T. Adams & Co. (“applicant”) seeks registration under Section 2(f) of the Act of the mark ADAMS, in standard characters, for “Commercial and residential real estate agency services.”¹

The examining attorney refused registration of the mark under Section 2(d) of the Act, on the ground that applicant’s mark, when used in connection with applicant’s services, so resembles the previously-registered mark SMITH ADAMS,

¹ Application Serial No. 85015200, filed April 15, 2010 based on claimed first use dates of August 10, 1979. William T. Adams provided his consent to registration of the mark.

in standard characters, for, *inter alia*, “real estate brokerage services; consulting services in the field of assisting and preparing individuals and entities to buy and sell residential real estate; real estate appraisal and valuation services,”² as to be likely to cause confusion.

After the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. We affirm the refusal to register.

Analysis

Our determination under Section 2(d) is based on an analysis of all 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 goods and/or 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.”). We discuss each of the *du Pont* factors concerning which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no

² Registration No. 3737832, issued January 12, 2010. The registration is also for services in International Class 42, and includes the following statement: “The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.”

evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

Turning first to the services, applicant concedes that “[i]t is undisputed that the services provided by the Applicant and Registrant are closely related.” Applicant’s Reply Brief at 2. We find, however, that applicant’s and registrant’s services are not merely “closely related,” but are in fact legally identical. Indeed, the examining attorney introduced dictionary definitions which reveal that a “real estate broker”³ is “An intermediary who receives a commission for arranging and facilitating the sale of a property for a buyer or a seller,” while a “real estate agent” is “A person who facilitates the sale of real estate ... A real estate agent receives a commission for his/her services ... A real estate agent is an employee of a real estate broker.”⁴ Office Action of April 12, 2011. In other words, registrant’s “real estate brokerage services” and its services which assist in the buying and selling of real estate encompass applicant’s “real estate agency services,” and both applicant and registrant specifically identify services related to residential real estate. Moreover, registrant’s and applicant’s websites both make clear that their services are essentially identical, because both applicant and registrant offer to assist in the buying and selling of real estate. *Id.*

Because the services are legally identical, and neither applicant’s nor registrant’s identification of services includes any limitation with respect to

³ <http://financial-dictionary.thefreedictionary.com/Real+estate+brokerage>

⁴ <http://financial-dictionary.thefreedictionary.com/Real+estate+agency>

consumers or channels of trade, we presume that the services move in the same channels of trade and are sold to the same classes of consumers. *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 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.”); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *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). These factors therefore both weigh heavily in favor of a finding of likelihood of confusion.⁵

As for the marks, we must compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). The test is not whether the marks can be distinguished when subjected to a side-by-side

⁵ Applicant’s argument that confusion is unlikely because applicant and registrant operate in distinct geographic areas is unavailing, because neither applicant’s application nor the cited registration contains any geographic restriction. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983).

comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). The focus is on the recollection of the average purchaser (in this case a real estate buyer or seller), who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In this case, registrant's mark SMITH ADAMS is comprised of two extremely common surnames. In fact, applicant introduced evidence that SMITH is the most common surname in the United States while ADAMS is the 36th most common surname in the United States, falling in between "Green" and "Baker." Office Action response of January 24, 2011 Ex. A. We therefore disagree with the examining attorney's position that ADAMS is the dominant portion of registrant's mark. We find instead that there is no dominant component of registrant's mark, because both SMITH and ADAMS will likely be construed as surnames, perhaps the surnames of certain firm founders or partners. Moreover, because the entire mark is in standard character format without emphasis on either name, both of which are comprised of five letters, there is no basis upon which to find that one name is more dominant than the other. As for applicant's mark, the evidence establishes that ADAMS is the surname of applicant's President William T. (Bill) Adams, as made

clear by applicant's website and Mr. Adams's consent to registration of his surname. Office Action of April 12, 2011.

The question is how these marks will be perceived by the "average purchaser," many (and perhaps most) of whom will be unfamiliar with who the surnames in the respective marks identify, if anyone. We agree with the examining attorney that these average purchasers could very well believe that the ADAMS firm is a division, subsidiary or affiliate of SMITH ADAMS, or perhaps that ADAMS is a reconstituted SMITH ADAMS firm following the departure of a partner named SMITH. Alternatively, average purchasers may believe that ADAMS is a shortened or re-branded version of or nickname for SMITH ADAMS. Indeed, the examining attorney introduced two articles concerning the current marketing trend of shortening entity names. One of the articles provides examples such as YMCA rebranding itself as "The Y," Pizza Hut rebranding itself as "The Hut" and Radio Shack rebranding itself as "The Shack." Office Action of April 12, 2011. The other article addresses law firms shortening their names, and is perhaps more analogous to the real estate firms at issue in this proceeding, because law firm names are often comprised of the surnames of firm partners. According to this article, there is sometimes a desire for firm names to reflect how a firm is known "on the street," and firms may not want to convey the impression of several partners simply sharing office space, but instead the impression of a single, integrated firm. *Id.* This evidence supports the examining attorney's position that average purchasers could believe that ADAMS is affiliated in some way with SMITH

ADAMS, because consumers are becoming more accustomed to firm names being abbreviated. In short, we find that the similarity of the marks weighs in favor of a finding of likelihood of confusion.

Finally, applicant argues that “[r]eal estate transactions are high value transactions, where buyers are particularly careful.” Applicant’s Appeal Brief at 8. While the record is devoid of any evidence supporting this argument, even if we were to agree with applicant on this point, it is settled that even sophisticated purchasers are not immune from source confusion. This is especially true where, as here, they are faced with similar marks and identical services. *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *see also*, *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff’d*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). This factor therefore does not outweigh the similarity of the parties’ marks, legally identical services and overlapping channels of trade.

Conclusion

While we are not free of any doubt regarding whether there is a likelihood of confusion, two factors compel us to conclude that the refusal of registration was appropriate. First, where, as here, the services recited in the application are legally

identical to those in the cited registration, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse services. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); *Century 21*, 970 F.2d at 874, 23 USPQ2d at 1701; *Jansen Enterprises, Inc. v. Rind and Stone*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). Second, to the extent that applicant's arguments raise any doubt concerning the likelihood of confusion, we must resolve it in registrant's favor. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe*, 223 USPQ at 1290.⁶

With these principles in mind, we have considered all of the evidence of record as it pertains to the relevant *du Pont* factors, including applicant's arguments and evidence, even if not specifically discussed herein. In view of our findings that the services and channels of trade are legally identical and the marks are similar, we find that use of applicant's mark would be likely to cause confusion with the cited registered mark as applied to registrant's services, notwithstanding any presumed sophistication of the relevant purchasers.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Act is affirmed.

⁶ A different record, containing for example evidence of third-party uses of SMITH and/or ADAMS for related services, might have yielded a different result.