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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TharpeRobbins Company, Inc.

Serial No. 85266411

Karl S. Sawyer, Jr. of K&L Gates LLP for TharpeRobbins Company, Inc.

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Before Quinn, Bucher and Lykos,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

TharpeRobbins Company, Inc. filed, on March 14, 2011, an application to register the mark THE BUTTERFLY EFFECT (in standard character form) for "providing employee recognition programs to businesses to promote and reward job quality, productivity, loyalty and longevity" in International Class 35. The application alleges first use anywhere and first use in commerce in May 2010.

The trademark examining attorney refused registration 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 applicant's services, so resembles the previously registered mark BUTTERFLY FX (in standard character form) for "business consulting services featuring professional consultations and business planning" in International Class 35,¹ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. We affirm the refusal for the reasons set forth below.

Applicant argues that the marks are different, specifically that the "FX" portion of the registered mark is distinctly different in appearance from the word "effects" and will be pronounced as two distinct letters "F" and "X," and not as the word "effects." Further, applicant urges, the letters "FX" have numerous commonly understood meanings other than "effects." Applicant also states that the services are different and, even if provided to the same company, are unlikely to be directed to or encountered by the same individuals. In any event, applicant claims that the relevant classes of purchasers of such services are sophisticated and exercise a high level of care in making their purchasing decisions.

The examining attorney maintains that both marks refer to the "butterfly effect" theory, with the abbreviation "FX"

¹Registration No. 3266140, issued July 17, 2007.

replacing "effect(s)" in registrant's mark. According to the examining attorney, the letter combination "FX" is commonly used as an abbreviation for "effects" in various contexts, including in the business field. The examining attorney also contends that the services are similar, with registrant's broadly worded recitation of business consulting services encompassing the implementation of employee recognition programs for businesses. There is a presumed overlap in purchasers, according to the examining attorney, due to the absence of any limitations relating thereto in the respective recitations of services. In support of the refusal, the examining attorney introduced dictionary evidence, excerpts of numerous third-party websites, and numerous third-party registrations.

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). In any likelihood of confusion analysis, however, 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 (CCPA 1976).

We first direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. We must compare the

marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find that applicant's mark THE BUTTERFLY EFFECT and registrant's mark BUTTERFLY FX are similar in appearance and sound. Although applicant concedes that "there may be some nominal phonetic similarity," it goes on to assert that "the presentation of the two-letter term [in registrant's mark] directs a rational person's attention away from any similarity on verbalization." (Brief, p. 4). We disagree. Both marks

begin with the identical term "BUTTERFLY,"² followed by a second portion that, although visually different, are aurally similar. Even if the letters "FX" in registrant's mark are pronounced as "F" and "X," this portion sounds virtually identical to the sound of the term "effect(s)." Any distinction in sound between "EFFECT" and "FX," even when articulated by a most careful speaker and heard by a most careful listener, is so subtle as to be likely not noticed or appreciated.

The marks as a whole are also identical in meaning. The unitary term "butterfly effect" is "[t]he idea...that something insignificant may have great ramifications, such as the beating of a butterfly's wings can transform atmospheric conditions and may cause (or even prevent) a storm thousands of miles away. Sometimes our own efforts appear futile or insignificant but may in fact have important consequences." (www.butterflyfx.net).

The "butterfly effect" is also described as follows:

In chaos theory, the butterfly effect is the sensitive dependence on initial conditions, where a small change at one place in a nonlinear system can result in large differences to a later state. The effect derives its name from the theoretical

² In saying this, we recognize, of course, that applicant's mark begins with the word "THE." The definite article "THE" at the beginning of a mark, however, does not generally affect or otherwise diminish the overall similarity between two marks. See *In re Thor Tech*, 90 USPQ2d 1634, 1635 (TTAB 2009) (the addition of the word "THE" at the beginning of the registered mark does not have any trademark significance); and *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (definite article "THE" is a non-distinctive term that adds no source-indicating significance to the mark as a whole).

example of a hurricane's formation being contingent on whether or not a distant butterfly had flapped its wings several weeks before.

The butterfly effect is a common trope in fiction when presenting scenarios...with "what if" cases where one storyline diverges at the moment of a seemingly minor event resulting in two significantly different outcomes.

The phrase refers to the idea that a butterfly's wings might create tiny changes in the atmosphere that may ultimately alter the path of a tornado or delay, accelerate or even prevent the occurrence of a tornado in another location. The flapping wing represents a small change in the initial condition of the system, which causes a chain of events leading to large-scale alterations of events (compare: domino effect). Had the butterfly not flapped its wings, the trajectory of the system might have been vastly different. While the butterfly does not "cause" the tornado in the sense of providing the energy for the tornado, it does "cause" it in the sense that the flap of its wings is an essential part of the initial conditions resulting in a tornado, and without that flap that particular tornado would not have existed.
(www.wikipedia.com)

Thus, the term "butterfly effect" has a similar meaning in the contexts of business consulting services and planning, and employee recognition programs. Applicant's specimen states the following:

Welcome to the Butterfly Effect.
Can the flap of a butterfly's wings in Brazil set off a tornado in Texas? Welcome to the Butterfly Effect, where each act of appreciation, no matter how minor, can set

off a chain of events that has the power to change the outcome of your talent's experience. When accumulated over time, these acts will make a difference by keeping your talent loyal, motivated and engaged. TharpeRobbins...where recognition changes everything.

The same connotation would apply to registrant's marks as used in connection with business consultation services, namely that implementation of small changes may create large effects.

We are not persuaded in the least by applicant's argument that the letters "FX" have a variety of meanings and, thus, consumers would not view the letters as the phonetic equivalent of "effect(s)." Applicant relies on meanings such as "foreign exchange," "navigational fix" and "field exercise." As pointed out by the examining attorney, however, there is evidence showing that "FX" is an abbreviation for "effects," especially as used with "sound" and "special."

(www.acronyms.thefreedictionary.com). Further, the record shows actual use of "FX" as an alternative for "effect(s)" in various contexts. More significantly, applicant's argument ignores the fact that the cited mark is not "FX" standing alone. Rather, the unitary mark BUTTERFLY FX has its own unique meaning (namely, "butterfly effect(s)") when the mark is considered in its entirety. Given the meaning of "butterfly effect" relating to small changes that eventually lead to large effects, consumers are likely to view registrant's mark BUTTERFLY FX as a

variation of "butterfly effect(s)," and not attribute any other far less relevant meaning to the "FX" portion of registrant's mark.

When the marks THE BUTTERFLY EFFECT and BUTTERFLY FX are compared in their entireties, we find that the marks are similar in sound, appearance and meaning. Because of the similarities between the marks, the marks engender similar overall commercial impressions. The similarity between the marks weighs in favor of a finding of likelihood of confusion.

We next turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the services. It is well settled that the services of the parties need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers

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would confuse the services, but rather whether there is a likelihood of confusion as to the source of the services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

We make our determination regarding the similarities between the services, channels of trade and classes of purchasers based on the services as they are identified in the application and registration, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Where the services in a cited registration are broadly identified as to their nature and type, as is the case herein, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the recitation of services encompasses all the services of the nature and type described therein, that the identified services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Registrant's broadly worded recitation, that is, "business consulting services featuring professional consultations and business planning," is construed to encompass all such types of

consultations and planning, including those involving employee recognition programs. Applicant's and registrant's recitations are presumed to be rendered through the same trade channels to similar classes of purchasers, namely businesses, both large and small. The evidence showing that business consulting services routinely cover employee recognition employee programs (see *infra*), coupled with the absence of any limitations in the respective recitation of services, diminish applicant's argument that its services are directed predominantly to human resources departments within companies, whereas registrant's services are targeted to management level individuals in the companies. We agree with the examining attorney's assessment that human resource issues are a major part of business planning, and it is no surprise that business planning consultations include consulting related to human resources.

The examining attorney submitted, in an attempt to show that the services are related, numerous use-based third-party registrations showing that the same entity has registered the same mark for the types of services involved in this appeal, namely business consulting services and human resource services such as employee recognition programs to promote loyalty, longevity and productivity. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks

shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The examining attorney also introduced numerous excerpts of third-party websites showing that the same entities commonly offer business consultation services and, as part and parcel thereof, offer the implementation of employee recognition programs to foster employee loyalty, career growth, productivity, etc. This evidence further supports a finding that consumers are likely to believe that applicant's and registrant's services emanate from the same source.

Thus, the factors of the similarity between the services, and the overlap in trade channels and classes of purchasers weigh in favor of a finding of likelihood of confusion.

Applicant argues that the purchase of applicant's and registrant's services "involve careful, long-term planning and forethought by an informed business customer," and that "relevant consumers make informed decisions after careful study and deliberation and therefore are unlikely to be confused by

any similarity between the [marks]." (Brief, p. 7). First, applicant has failed to support this argument with any evidence. Second, the recitations of services are broad enough to cover one-time consultations, short term programs and otherwise relatively inexpensive consultations that may be offered to small enterprises. In any event, even assuming that businesses are discriminating when it comes to management planning and human resources decisions, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving very similar marks and closely related services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible."). *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarities between the marks and the services sold thereunder outweigh any presumed sophisticated purchasing decision. *See 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). Thus, this factor is neutral.

We conclude that consumers familiar with registrant's "business consulting services featuring professional consultations and business planning" offered under the mark BUTTERFLY FX would be likely to believe, upon encountering applicant's mark THE BUTTERFLY EFFECT for "providing employee recognition programs to businesses to promote and reward job quality, productivity, loyalty and longevity," that the services originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.