

**This Opinion is Not a
Precedent of the TTAB**

Mailed: June 18, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Depaul International
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Serial No. 85323875
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Adam J. Bruno of Bay State IP LLC,
for Depaul International.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 118,
Thomas G. Howell, Managing Attorney.

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Before Wellington, Kuczma, and Hightower,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Depaul International (“Applicant”) seeks registration on the Principal Register
of the mark **DEPAUL** (in standard characters) for the following services:

Employment counseling; employment recruiting
consultation, charitable services, namely, organizing and
conducting volunteer programs in International Class 35;

Charitable fund raising; leasing of apartments in
International Class 36;

Educational services, namely, conducting classes,
seminars, conferences, workshops in the fields of
numeracy, literacy and life skills training and

distributing training materials in connection therewith in International Class 41;

Charitable services, namely, providing temporary shelter for the homeless; consultation in the field of providing temporary housing for people who are homeless or at risk of homelessness; consultation in the field of providing temporary housing for people who are homeless or at risk of homelessness, namely, prisoners on release; charitable services, namely, providing food to needy persons and supplying meals to the homeless or underprivileged in International Class 43;

Nursing services in International Class 44; and

Legal consultation services in International Class 45.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the following registered marks:



Registration No. 2595264

Educational services in the nature of courses, seminars, workshops, programs and conferences at the university level;²



Registration No. 2583245

¹ Application Serial No. 85323875 was filed on May 18, 2011, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act for each class of services.

² Registration No. 2595264 issued July 16, 2002; Section 8 and 15 affidavits accepted and acknowledged.

Educational services in the nature of courses, seminars, workshops, programs and conferences at the university level;³



Registration No. 2565970

Educational services in the nature of courses, seminars, workshops, programs and conferences at the university level;⁴ and



Registration No. 2582880

Educational services at the university level.⁵

³ Registration No. 2583245 issued June 18, 2002; Section 8 and 15 affidavits accepted and acknowledged.

⁴ Registration No. 2565970 issued April 30, 2002; Section 8 and 15 affidavits accepted and acknowledged.

⁵ Registration No. 2582880 issued June 18, 2002; Section 8 and 15 affidavits accepted and acknowledged.

DePaul University is the owner of all four registrations which, taken together, cover clothing items, stationery goods, entertainment and educational services. As recited above, each registration at least covers certain educational services at the university level.

The Examining Attorney also refused registration of the mark under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that Applicant's mark falsely suggests a connection with DePaul University in Chicago, Illinois.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the likelihood of confusion refusal and affirm the false suggestion of a connection refusal.

I. Evidence Attached to Applicant's Reply Brief

Applicant submitted materials with its reply brief.⁶ These materials were not submitted prior to appeal or attached to its request for reconsideration. Accordingly, they are untimely and have not been considered. Trademark Rule 2.142(d).

II. Likelihood of Confusion

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.

⁶ Reply Brief Exhibits 1-5. See TTABVue entry # 13.

2003). 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Similarity of the Marks

Of the four registrations cited as bases for the likelihood of confusion refusal to register, we focus our analysis on the following two marks:



vis-à-vis Applicant's mark, DEPAUL.

With respect to these two registered marks, the term DEPAUL is either the sole word or prominently displayed and we find it is best characterized as the dominant element. In the first mark, DEPAUL appears first when the mark is read from top to bottom in significantly larger letters than the secondary wording, BLUE DEMONS. As to the other registered mark, DEPAUL is the sole literal term and thus more likely to be used by consumers in recalling or referencing this mark than the stylized devil's head design portion. We have long observed that when a mark consists of a literal as well as a design element, consumers are generally more likely to recall the wording portion of the mark since consumers are likely to call for, or refer to, the goods or services by these terms rather than a design. *CBS Inc. v.*

Morrow, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983); *In re Dakin's Miniatures Inc.*, 59 UPSQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

Essentially, Applicant is seeking to register DEPAUL which is the dominant element of the two aforementioned registered marks. As already discussed, the additional wording and design portions of the registered marks have less significance than the identical word DEPAUL for purposes of distinguishing these marks. Moreover, because Applicant's proposed mark is in standard character format, we must consider the possibility that it will be used in the same stylized lettering, including the combination of upper and lower case lettering, employed in the registered marks.

As to the meaning or commercial impression of the marks, there appears to be no disagreement that the term derives from the name of a 17th century French Roman Catholic priest, Saint Vincent de Paul. However, it remains unclear how many persons are familiar with the priest or the origin of the term, DEPAUL. Rather, it has been shown that registrant, DePaul University, is a private "institution of higher education and research in Chicago, with a student body of over 25,000 students." As discussed further herein in the context of the false suggestion of a connection refusal, the record demonstrates that DePaul University is a big school with some renown and often referred to as "DePaul"; in contrast, there is no evidence showing any degree of public awareness of the 17th century priest or that DEPAUL is a term used to refer to that priest. Thus, consumers encountering the

respective marks will likely associate the term DEPAUL with the University rather than as a reference to the priest or some other entity.

In comparing the marks in their entireties, we find them to be much more similar than dissimilar. Thus, this du Pont factor weighs in favor of finding a likelihood of confusion.

Similarity of the Services Described in the Application and Registrations

We turn now to the du Pont factor involving the relatedness of the services. It is settled that in making our determination, we must look to the services as identified in the applications vis-à-vis those recited in the cited registrations. *See Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

At the outset, we note that the examining attorney has limited the likelihood of confusion refusal to only Applicant's educational services in International Class 41. Indeed, throughout the prosecution the examining attorney has described the relevant services to be considered in the likelihood of confusion analysis in the following manner:

The applicant's services are, *in pertinent part*, 'Educational services, namely, conducting classes, seminars, conferences, workshops in the fields of numeracy, literacy and life skills training and distributing training materials in connection therewith' and the registrant's services are 'educational services in the nature of courses, seminars, workshops, programs and conferences at the university level' and 'educational services at the University level.'

Brief at p. 7, italics added for emphasis. Thus, we limit our decision to Applicant's Class 41 services and make no finding of a likelihood of confusion with respect to the other classes of services identified in the application.

As to the educational services of Applicant and Registrant, we agree with the Examining Attorney that they are legally identical inasmuch as Applicant's educational services are encompassed by the Registrant's broader description of services. In other words, registrant's recitation of services is broadly worded and must be read to include Applicant's "conducting classes, seminars, conferences, workshops in the fields of numeracy, literacy and life skills training." Although Registrant's services are at the "university level," the evidence submitted by the examining attorney establishes that these subjects, *i.e.*, numeracy, literacy and life skills training, are of the type that may be taught at universities.⁷ For example, New York University offers a course in "Science Literacy & Numeracy."⁸ There are also several registrations for marks covering services that include these subjects being offered at a university level.

Because the recited educational services in the application and cited registrations are legally identical, this factor also weighs in favor of finding a likelihood of confusion.

The Channels of Trade and Classes of Purchasers for the Services

In view of the respective services being legally identical in part, we must assume that the purchasers and channels of trade for such services would also be the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any



⁷ The Examining Attorney attached Internet printouts to the Office Action dated October 21, 2012 and the Office Action denying the request for reconsideration dated October 20, 2013.

⁸ Printout attached to Office Action dated October 21, 2012.

restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade.”); *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.”). Again, although Registrant’s services are offered at the “university level,” Applicant’s education services may also be offered to university students. We must likewise assume that these services will be advertised in the normal trade channels for university-level educational services. We acknowledge Applicant’s position that the respective services are different in reality and would be offered to a different clientele; however, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in Applicant’s application vis-à-vis the services recited in the cited registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Because the marks are very similar, the services are legally identical and we presume that the services move in the same channels of trade and are offered to the same classes of consumers, we find that applicant’s mark DEPAUL, if used in association with the services identified in Class 41 of the application, is likely to



cause confusion with the cited registered marks,  and , as used in association with the services identified in the registrations.

III. False Suggestion of a Connection

Having found a likelihood of confusion with respect to applicant's Class 41 services, we now turn to the finding that applicant's mark falsely suggests a connection with DePaul University under Section 2(a). In contrast to the likelihood of confusion ground, the Examining Attorney expressly asserted that Section 2(a) prohibits registration of Applicant's mark with respect to all of the classes of services in the application.⁹

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols.

To establish that a proposed mark falsely suggests a connection with a person or an institution, it is the Examining Attorney's burden to show:

- (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and

⁹ Examining Attorney's Brief at p. 12 ("[C]onsumers seeing the name DEPAUL on *all* of the applicant's services would believe that there is a connection with DePaul University in Chicago, Illinois." Italics provided for emphasis.).

- (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

In re Kent Pedersen, 109 USPQ2d 1185 (TTAB 2013); *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 509 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used by the Board to determine the existence of a false connection).

As to the first and third elements, there is no dispute that Applicant has no connection with DePaul University nor is there any real dispute that Applicant's mark, DEPAUL, is nearly identical to "DePaul University." The term "university" is clearly generic for educational services and the record shows that the "DePaul," by itself, is used to identify the University.

Applicant has instead focused its arguments with respect to the remaining two elements and, in doing so, asserts that the proposed mark does not 'point uniquely' to DePaul University and that the University's notoriety or fame does not reach the necessary level. We address these issues in turn.

Will the Proposed Mark Be Perceived as Pointing Uniquely to DePaul University?

Applicant correctly notes that DePaul University is named after Saint Vincent de Paul. Applicant contends that because "[t]he recognition of the name 'DePaul' stems from the [saint]...The use of St. Vincent's name and likeness is so

overwhelmingly present that ‘DePaul’ has gone beyond a name recognition and has become assimilated with service work, Catholic good will, and community dedication.” Brief, p. 15. Applicant, in its brief, points to a handful of institutions containing the name “DePaul.” Applicant also cites to the *Univ. of Notre Dame* decision to support this position.

In the *Univ. of Notre Dame* decision, the Court of Appeals for the Federal Circuit affirmed the Board’s decision dismissing an opposition based on the false suggestion of a connection under Section 2(a).¹⁰ In the underlying Board proceeding, applicant sought registration of the mark NOTRE DAME (with a church design element) for cheese and was opposed by the University of Notre Dame on the basis that applicant’s mark created a false suggestion of a connection with the University. In affirming the Board’s decision, the Federal Circuit stated that a “critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or ‘persona.’” 217 USPQ at 509. In emphasizing the ‘unique association’ requirement, the Court rejected any argument that fame, by itself, would suffice. *Id.* (“Nor is it sufficient, as urged by the University, that the fame of the name of an institution provides the basis for protection in itself.”). The Federal Circuit ultimately agreed with the Board’s finding that, based on the record, NOTRE DAME is not a name solely associated with the university but also “serves to identify a famous and

¹⁰ The Board also dismissed the University’s likelihood of confusion ground for opposition and, likewise, was affirmed by the Federal Circuit. 703 F.2d at 1374.

sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France.” *Id.*

While the circumstances of this proceeding are similar to those in *University of Notre Dame* to the extent that both involve false suggestion of a connection with a university, there are significant differences in the records. In *University of Notre Dame*, the Board was able to rely on a record establishing public recognition of the term NOTRE DAME for places or figures unrelated to the university. In this case, we have little to no evidence showing DEPAUL being used in connection with any entity or person other than DePaul University.¹¹ Specifically, applicant has not submitted evidence to support the assertion in its brief regarding other entities adopting the term DEPAUL (or “DePaul”) in the names of their organizations. Rather, the only evidence presenting possible third-party use of this term was submitted by the Examining Attorney in the form of Google search printouts.¹² Although the bulk of the Google search results for the term “depaul” appear to show links or make reference to DePaul University, including its programs and sports teams, there is one result for a “DePaul School” that purportedly offers an “educational experience for children with learning disabilities...in the Tampa Bay Area.” Another result identifies a “St. Vincent de Paul Parish” located in Lincoln Park (Chicago). However, it remains unclear whether persons are familiar with

¹¹ A review of [The American Heritage Dictionary of the English Language](#) (4th ed. 2000, updated 2009) reflects there is no defined meaning or reference for the term “Depaul”; however, there is an entry in the dictionary for “Vincent de Paul” who is described as “Saint 1581-1660. French ecclesiastic who founded the Congregation of the Mission (1625) and the Daughters of Charity (1663).”

¹² Attached to Office Action dated October 21, 2012.

them. Furthermore, we cannot rule out the possibility that the latter entity, a church, may be associated with DePaul University, a private Catholic university.

In sum, the record in this proceeding shows that the term DEPAUL is understood as a unique reference to DePaul University.

Is DePaul University so famous that, when DEPAUL is used with the applicant's services, a connection with the University would be presumed?

DePaul University was founded in 1898 and now has several campuses in the Chicago region with approximately 25,000 students enrolled, making it “one of the 10 largest private universities in the United States.”¹³ It is the largest private university in Illinois and the largest Catholic university in the country.¹⁴ US News and World Report ranked the university 132nd nationally and placed it in the “Top Tier” of national colleges and universities for 2011 and 2012. DePaul’s sports teams compete in NCAA Division I and it is a member of the Big East Conference. DePaul offers university housing to all students, including a selection of university-owned residence halls, lofts, townhouses, and apartments.¹⁵

DePaul University comprises colleges of commerce, communication, law, computing and digital media, liberal arts & social sciences, school of new learning, education, music, theatre, science and health, and continuing and professional education. The university is also described as placing “a primary focus on pedagogy

¹³ From Wikipedia online encyclopedia, printouts attached to Office Action dated October 21, 2012.

¹⁴ Id.

¹⁵ From U.S. News Education Colleges, Best Colleges 2012 (www.colleges.usnews.rankingsandreviews.com); attached to Office Action dated March 25, 2012.

and ha[s] been recognized for excellence in experiential and service-based learning. Since 2004, US News & World Report has recognized DePaul as one of the top schools in the nation for service learning in which community-based volunteer work is utilized as an instructional strategy.”¹⁶ The university also offers various student services, including non-remedial tutoring, a women’s center, placement service, health service, and health insurance.

The record in this proceeding demonstrates that DePaul University enjoys a degree of fame in offering an array of educational services and is also known to place an emphasis on community outreach. In view thereof, we find that consumers who view Applicant’s use of DEPAUL in connection with its recited services for each class in the application will incorrectly believe there is a connection with the university. That is, Applicant’s use of DEPAUL in connection with services that include “employment counseling...leasing of apartments...educational services...[and] charitable services such as providing temporary housing...” will falsely suggest a connection with the University and must be refused registration under Section 2(a).

Decision: The likelihood of confusion refusal to register Applicant’s mark DEPAUL is affirmed with respect to the services in International Class 41. In addition, the false suggestion of a connection refusal is affirmed with respect to all recited classes of services in the application.

¹⁶ *Id.* from www.wikipedia.com.