

**THIS OPINION IS NOT A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Douglas Smurr and Bret Bocook

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Serial No. 85342789

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Douglas Smurr of World's Law, LLP for Douglas Smurr and  
Bret Bocook.

Tamara Frazier, Trademark Examining Attorney, Law Office  
116 (Michael W. Baird, Managing Attorney).

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Before Seeherman, Bucher and Adlin, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Douglas Smurr and Bret Bocook, two individuals who are  
joint applicants, have appealed from the examining  
attorney's refusal to register the mark WORLD'S LAW in  
standard characters, with LAW disclaimed, for "legal  
services, namely the practice of law by licensed

attorneys."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the registered mark WORLD LAW GROUP, in typed drawing form, with LAW GROUP disclaimed, for legal services,<sup>2</sup> that, as used in connection with applicants' identified services, it is likely to cause confusion or mistake or to deceive.

We affirm the refusal of registration.

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 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*

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<sup>1</sup> Application Serial No. 85342789, filed June 10, 2011, asserting first use as early as May 15, 2006 and first use in commerce as early as June 1, 2006.

<sup>2</sup> Registration No. 2332652, issued March 21, 2000; Section 8 and 15 affidavits accepted and acknowledged, respectively; renewed. "Typed" drawings are now referred to as "standard character" drawings. See Trademark Rule 2.52(a).

*Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the *du Pont* factor of "the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The registrant's services are identified in the registration as "legal services"; applicants' services are identified as "legal services, namely the practice of law by licensed attorneys." Obviously, registrant's identification encompasses the services in applicants' identification, and therefore the services are legally identical. Applicants have discussed at some length what they call "the Citigroup presumption," referring to *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). Applicants have submitted a quote, purportedly taken from this opinion (at 637 F.3d 1356), as to what this presumption is: "[t]hat the registration encompasses all services of the type described, including those in applicant's more specific identification, and that the services move in all normal channels of trade." Although we have no quarrel with the principle set forth, we point out that this specific language does not appear in the

*Citigroup* opinion.<sup>3</sup> In any event, applicants go on to contend that this presumption can be rebutted by evidence that contradicts this "presumed fact."

Applicants are incorrect both in their supposition that the cited presumption originated with the *Citigroup* decision, and more importantly in their position that the general presumption can be rebutted by evidence as to the registrant's actual use. In the 1973 case, *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973), the predecessor to our primary reviewing court stated that "Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of [services]." This principle has been reiterated time and again. It is well-established that likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in the applicant's application vis-à-vis the services recited in the cited registration, rather than what the evidence shows the services to be. *In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1534. This is because

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<sup>3</sup> The *Citigroup* opinion also cites *Hewlett Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002), for the principle that "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers."

"[t]he certificate of registration is *prima facie* evidence of the validity of the registration and the registrant's exclusive right to use the mark in connection with the services specified." *Id.* In fact, in *Dixie* the applicant made an argument similar to that of applicants herein, namely, that the registrant was not using its mark for all of the services listed in its identification. The Court would not entertain what was in effect a collateral attack on the registration, stating that an *ex parte* proceeding is not the proper forum for such a challenge. *Id.*

Accordingly, we must determine the issue of likelihood of confusion based on the identification of services in the cited registration and in applicants' application. Because the services as identified are legally identical, in that the services identified in the registration encompass the services identified in the application, this *du Pont* factor favors a finding of likelihood of confusion.

Similarly, because the services in the cited registration are broadly described and there are no limitations in the identification as to the nature or type of the legal services, or the channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all services of the nature and type described, that the identified services move in all

channels of trade that would be normal for such services, and that the services would be purchased by all potential customers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). As a result, we must presume that applicants' and the registrant's legal services travel in the same channels of trade and are offered to the same classes of customers.

The *du Pont* factor of the channels of trade therefore also favors a finding of likelihood of confusion.

Before we turn to the *du Pont* factor of the similarity or dissimilarity of the marks, we will address, as applicants have, the factors regarding the fame of the cited mark and the number and nature of similar marks in use on similar goods or services. Applicants are correct that there is no evidence of fame of the cited mark.<sup>4</sup> Applicants are incorrect, however, that as a result we should treat this *du Pont* factor as weighing in applicants' favor. Our primary reviewing court, the Federal Circuit, has specifically stated that although the fame of a registered mark is relevant to likelihood of confusion, "we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being

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<sup>4</sup> We add that it would be very rare that there would be such evidence in an *ex parte* case, since an examining attorney would normally not have access to the type of evidence that is necessary to prove fame.

famous. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205.

We treat the factor of fame as neutral.

With regard to the number and nature of similar marks, applicants point to three third-party registrations. Although applicants did not properly make the registrations of record,<sup>5</sup> the examining attorney has addressed these registrations, and has listed the services for two of them. Therefore, we consider the registrations, at least insofar as information about them has been submitted.<sup>6</sup>

However, the registrations have no probative value in terms of the *du Pont* factor of the number and nature of similar marks in use in commerce. Third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).<sup>7</sup>

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<sup>5</sup> We find it odd that, from the time of their response to the first Office action, applicants have requested that the examining attorney (and later the Board) take judicial notice of these registrations, rather than making them of record, despite the fact that it is a well-established principle that the Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. *See In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

<sup>6</sup> Normally, when a party requests that judicial notice be taken, the party submits the material that it wishes to be judicially noticed. Even with their brief, applicants have not submitted copies of the registrations.

<sup>7</sup> Third-party registrations may be used in the manner of dictionary definitions, to show that a mark or a portion of a mark has a significance in a particular industry. *See Mead*

Applicants have also pointed to what they assert are "twenty-one unregistered marks currently in use for legal services in the United States." Brief, p. 19. However, applicants did not actually submit evidence of use of any such marks. They merely listed in their various responses a list of terms, e.g., "Virtual World Law," "World Law Debt," "Common Law World Review," along with a URL for each. We cannot ascertain from the mere listing whether these terms are trademarks, or if so, the goods and services with which they are used, and we do not go outside of the record by researching or even clicking on mere URL's. Applicants argue that the examining attorney "discussed these third-party use [sic] of similar marks in both of its [sic] Office Actions dated February 22, 2012 and November 8, 2012 without objecting to the marks being admitted into evidence; hence the registrations and marks should be treated as being stipulated into the record." Brief, p. 18. However, the examining attorney neither discussed the listing of the names and URLs in the Office actions, nor treated them as being of record. Further, even if the examining attorney discussed the information, it would not result in the contents of the websites

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*Johnson & Co. v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). We discuss this *infra*.



identified by the URLs being of record. As the Board stated in *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007), quoting *In re Planalytics Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004), "A mere reference to a website does not make the information of record. In order to review the facts in this case, there should be evidence in the record." The Board further pointed out in *In re Planalytics, Inc.*, 70 USPQ2d at 1458, that "information on websites is transitory and subject to change at any time at the owner's discretion." Thus, the Board cannot determine from the URLs what the various websites might have contained at the time applicants cited them in their February 22, 2012 and November 8, 2012 responses, or in their brief. Applicants have simply not provided the material from the websites on which they wish to rely, and the Board will not and cannot take judicial notice of the content of these websites.<sup>8</sup>

Thus, we consider only the specific information that applicants provided, i.e., the listing of the phrases and the respective URLs. This information has no probative value without the websites themselves to give context to

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<sup>8</sup> Even if the website material were appropriate for judicial notice, applicants have not provided the actual content from the websites.

the terms. See TBMP § 1208.03 and cases cited therein at note 5, addressing the limited probative value of search result summaries from a search engine when the text in the result summary is insufficient to show the context in which the term is used. In this case, of course, we do not even have limited text from the websites in question.

The *du Pont* factor of the number and nature of similar marks in use on similar goods or with similar services is therefore neutral.

We now turn to the first *du Pont* factor, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, keeping in mind that when marks would appear on legally identical services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224

USPQ 749, 751 (Fed. Cir. 1985). Further, 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 that confusion as to the source of the 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. *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1375 (TTAB 1999).

Applicants' mark is WORLD'S LAW, with LAW disclaimed. The cited mark is WORLD LAW GROUP, with LAW GROUP disclaimed. Interestingly, applicants argue that "The Word 'Group' is the Dominant Feature of Both Marks," brief, p. 21, despite the fact that GROUP does not even appear in applicants' mark. Applicants also contend that GROUP is the dominant part of WORLD LAW GROUP because it "is the word that clearly differentiates the two marks," *id.*, and that the registrant is what its mark implies, i.e., a group. We cannot view GROUP as the dominant part of applicants' mark, which does not even contain the word. Further, as the examining attorney has stated, descriptive matter, such as LAW in applicants' mark and LAW GROUP in the cited mark, is generally given less weight when the

marks are compared. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" (quoting *In re National Data*, 224 USPQ at 752); *In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1533-34; *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION'S, not disclaimed word ROADHOUSE, is dominant element of BINION'S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Consumers are likely to view the disclaimed word GROUP in the cited mark in the same manner as the word "firm," an indicator that this is an entity or association, but will look to other elements of the mark for their source-identifying significance. The other elements of the cited mark, WORLD LAW, are extremely similar to applicants' mark, WORLD'S LAW. Although applicants' mark uses WORLD'S in the possessive, it is unlikely that consumers will note or remember this difference, which is insignificant because it does not meaningfully alter how applicants' mark looks and sounds or the meaning it conveys. Further, consumers who are familiar with the cited mark are likely to view

applicants' mark as a shortened form of WORLD LAW GROUP, such that the absence of GROUP from applicants' mark is not sufficient to distinguish it from the cited mark. Thus, despite the additional word GROUP in the cited mark, and its absence in applicants' mark, the marks are similar in overall appearance, pronunciation, connotation and commercial impression. Although WORLD LAW GROUP has a suggestive connotation, the connotation is the same as that for WORLD'S LAW. This *du Pont* factor also favors a finding of likelihood of confusion.

We reach this conclusion despite applicants' arguments that the purchasers of applicants' and registrant's services are sophisticated and careful, which arguments go to the fourth *du Pont* factor (conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing). First, legal services may be needed by the public in general, including unsophisticated legal consumers who wish to write a will, or who suddenly find themselves in trouble and require legal help. Such persons are not necessarily careful or knowledgeable about choosing legal services, and may obtain services without investigation of the services. In such circumstances, the small differences between applicants' mark and the cited mark, as discussed above, are insufficient to apprise

consumers that these trademarks identify legal services emanating from separate sources. Applicants further assert that all states require a written retainer agreement; even if applicants are correct, those entering into a retainer or other contract for services are not likely to note that applicants' mark is different from the registrant's.

Further, the consumer can be confused at the time he or she decides to contact applicants, i.e., well before the signing of the retainer agreement. Accordingly, although we agree that legal services are not the subject of an impulse purchase, even careful consumers are not likely to recognize that applicants' mark is different from the registrant's, or, if they do, they are not likely to understand that this difference represents different sources of the services.

Applicants argue that the seventh and eighth *du Pont* factors – the nature and extent of any actual confusion, and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion – favor applicants' position. Applicants base their argument that there has been no actual confusion on their claim that the address for registrant on its website is in Washington, DC, and applicants maintained their main office in Washington, DC between 2006 and 2008. As a

preliminary matter, we note that applicants have not made the registrant's website of record. Further, even if we accept applicants' statement, concurrent use for two years some time ago, and without any evidence of the extent of either applicants' or the registrant's sales or advertising or public recognition, is hardly persuasive that confusion is not likely.

More importantly, the Federal Circuit has found that an applicant's uncorroborated statements of no known instances of actual confusion are of little evidentiary value:

A showing of actual confusion would of course be highly probative, if not conclusive of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, especially in an *ex parte* context.

*In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (internal citations omitted). We therefore treat the seventh and eighth *du Pont* factors as neutral.

With respect to the twelfth *du Pont* factor, the extent of potential confusion, i.e., whether de minimis or substantial, because the consumers for legal services

include the public at large, the extent of potential confusion is substantial.<sup>9</sup>

Finally, applicants argue that the eleventh *du Pont* factor favors their position because they "are the only known seller of similar services (legal services, namely the practice of law by licensed attorneys) under this mark, or any similar mark. That being the case, Applicants have the legal right to exclude others from using WORLD'S LAW on competing or related goods or services." Brief, p. 21. This argument seems to be at odds with applicants' claim that there is evidence of widespread third-party use, as well as applicants' acceptance (in their argument regarding the *du Pont* factor of the lack of actual confusion) that the registrant has been using its mark since 1988, far earlier than applicants' claimed date of first use in 2006. In any event, we are not persuaded by applicants' argument.

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<sup>9</sup> In connection with this factor, applicants have argued that the registrant does not actually practice law, and therefore applicants' and the registrant's services would not be encountered by consumers in situations that would create the incorrect assumption that they originate from the same source. We have already explained that we must determine likelihood of confusion on the basis of the services identified in the cited registration, and that this identification cannot be limited by extrinsic evidence. Therefore, we give no weight to this argument. Similarly, applicants' argument that registrant "is actively promoting the fact that it does not practice law," brief, p. 17, is not persuasive. The identification in the cited registration is for "legal services," and "legal services" encompasses the practice of law.



Applicants are the latecomers, and on this record they do not have the right to exclude registrant from using its mark for its identified services.

After reviewing all the evidence and arguments, including those not specifically discussed herein,<sup>10</sup> we find that applicants' mark as used in connection with their identified services is likely to cause confusion with the mark and the services identified in the cited registration.

Decision: The refusal of registration is affirmed.

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<sup>10</sup> To the extent that any other *du Pont* factors are relevant, we treat them as neutral.