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Mailed:  
April 12, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Fona International Inc.*

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Serial No. 85344795

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Scott W. Smilie of Patzik, Frank & Samotny Ltd. for Fona International, Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102 (Mitchell Front, Managing Attorney).

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Before Seeherman, Ritchie and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Fona International, Inc. (applicant) has appealed the final refusal of its application for the mark CONSIDER IT DONE for “business consulting services related to the development and use of flavors”<sup>1</sup> pursuant to Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark CONSIDER IT DONE for “business consultation services, namely consultation relating to business strategy, including assessing a company's existing operations, and advising on the development of technology-related

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<sup>1</sup> Application Serial No. 85344795, filed June 13, 2011, based on Section 1(b) of the Trademark Act (intent-to-use).

methodologies in the field of project management; consultation relating to outsourcing of computerized business functions; business consultation relating to the fields of electronic commerce and electronic business; business consultation relating to the field of on-line business transactions, namely marketing, order processing, and order fulfillment; customer relationship management; and employee leasing services, namely, providing information technology professionals to others.”<sup>2</sup>

Before addressing the substantive refusal, we note applicant’s contention that the examining attorney, in denying applicant’s request for reconsideration on January 18, 2012, should have issued a “subsequent final refusal” with a six-month-response clause because, according to applicant, applicant’s request for reconsideration presented new evidence. Applicant’s complaint is not proper subject matter for this appeal. If applicant believed that there was a procedural error in examination, its recourse was to file a petition to the Commissioner. Further, any objection that applicant had to this point of examination was waived by applicant’s not pursuing the objection at the proper time, but proceeding with the filing of its notice of appeal on May 21, 2012.<sup>3</sup>

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<sup>2</sup> Reg. No. 2718991, issued May 27, 2003; Section 8 accepted and Section 15 acknowledged. The registration also includes services in Class 42, however the refusal was not based on the services in this class.

<sup>3</sup> It is noted that applicant stated in its brief that its attorney had spoken with someone in the examining attorney’s law office, but did not receive any further correspondence from that person. However, the onus was on applicant to take appropriate further action. We also point out that, if applicant believed that it should have been able to submit evidence in response to the denial of the request for reconsideration, it could have filed a request for remand with the Board at the time it filed its notice of appeal.

Turning next to the substantive refusal, 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 Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the du Pont factor of the similarity and nature of the goods. As set forth in the *Dixie Restaurants* case:

“Likelihood of confusion must be determined based on an analysis of the mark as applied to the ... services recited in applicant's application vis-a-vis the ... services recited in [a] ... registration, rather than what the evidence shows the...services to be.” *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1534, quoting *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Applicant's services are identified as “business consulting services related to the development and use of flavors.” The services in the cited registration are, inter alia, “business consultation services, namely consultation relating to business strategy, including assessing a company's existing operations, and advising on the development of technology-related methodologies in the field of project management.”

Contrary to applicant's assertion, the registrant's services are not restricted to "custom information technology." Appeal Brief, p. 8. The services are identified as "business consultation services, namely consultation relating to business strategy including assessing a company's existing operations, and advising on the development of technology-related methodologies in the field of project management." The specific services set forth after the word "including," i.e., "assessing a company's existing operations, and advising on the development of technology-related methodologies in the field of project management," are examples of the business consultation services, rather than limitations thereof.

The registrant's identified "business consultation services, namely consultation relating to business strategy" encompasses the "business consulting services related to the development and use of flavors" identified in the application. The determination of the specific flavors to be developed and the use thereof is a decision that can be part of consultation relating to business strategy. Therefore, business strategy consultation in the flavor industry necessarily includes consultation related to the development and use of flavors and thus these services are encompassed by the identification in the cited registration.

Accordingly, we find that applicant's services, as identified, are in part legally identical to the services identified in the cited registration.

"It is well established that absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same

channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d, 1905, 1908 (Fed. Cir. 2012). Because the services are in part legally identical, they are presumed to travel in the same channels of trade to the same classes of purchasers.

As for the du Pont factor of the similarity of the marks, the marks are identical. Accordingly, this factor favors a finding of likelihood of confusion.

Applicant contends that its “customers are business professionals in the flavor industry who are very knowledgeable about the industry.” Appeal Brief p. 9. We agree that purchasers of business consulting services are likely to be sophisticated and that it is possible that the sophistication of purchasers can minimize a likelihood of confusion. However, even sophisticated purchasers are likely to be confused when identical marks are used for legally identical services. *In re Cynosure Inc.*, 90 USPQ2d 1644, 1647 (TTAB 2009). *See also In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986).

Applicant also contends that the cited mark is relatively weak and entitled to a narrow scope of protection.

Applicant submitted evidence regarding third-party use and registration of the phrase CONSIDER IT DONE, consisting of five registrations and pages from nine websites, for various services, i.e., “property management, including accounting,” “aviation support,” “marketing assistance for real estate agents,” “event planning,” “professional errand and personal assistance services” and “junk removal and cleanouts.” The registrations correspond to five of the

websites. In addition, we take judicial notice that the slogan CONSIDER IT DONE means “you will do a particular task immediately.”<sup>4</sup> Accordingly, we agree with applicant that the mark has some suggestive significance with regard to business consultation services. However, even if we treat the cited mark as not being entitled to the same degree of protection as an arbitrary mark, the scope of protection due the cited registration still extends to prevent the registration of the identical mark in connection with legally identical services. See *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

Having considered all the evidence and argument on the relevant du Pont factors, we find that applicant’s mark CONSIDER IT DONE for “business consulting services related to the development and use of flavors” is likely to cause confusion with the cited registration for the mark CONSIDER IT DONE for “business consultation services, namely consultation relating to business strategy.”

*Decision:* The refusal to register the mark is affirmed.

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<sup>4</sup> We take judicial notice of the meaning of the phrase, CONSIDER IT DONE, which was obtained from the *Cambridge Advanced Learner’s Dictionary and Thesaurus*, © Cambridge University Press, located online at <http://dictionary.cambridge.org>.

The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).