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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vault Bioventures, Inc.

Serial Nos. 85362134 and 85362228

Kathleen A. Pasulka of Procopio, Cory, Hargreaves & Savitch for  
Vault Bioventures, Inc.

Daniel F. Capshaw, Trademark Examining Attorney, Law Office 110  
(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Bucher and Ritchie,  
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Vault Bioventures, Inc. filed, on July 1, 2011, intent-to-use applications under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register the marks VAULT BIOVENTURES (in standard characters) ("BIOVENTURES" disclaimed) and



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("BIOVENTURES" disclaimed), both for the following services:

Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies (in International Class 35);

Assistance, advisory services and consultancy with regard to communications in the medical field for biopharmaceutical and biotechnology companies (in International Class 38); and

Assistance, advisory services and consultancy services with regard to clinical research and product development for biopharmaceutical and biotechnology companies (in International Class 42).<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in Class 35 in each application on the ground that applicant's mark, when used in connection with applicant's services, so resembles the following previously registered marks as to be likely to cause confusion: VAULT COMMUNICATIONS, INC. (in standard characters) ("COMMUNICATIONS, INC." disclaimed) and

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<sup>1</sup> Application Serial Nos. 85362134 and 85362228, respectively. The later application includes the following description of the mark: "The mark consists of the stylized word VAULT with cascading circles projecting from the right top side of the 'V,' with [the] word BIOVENTURES in upper case and centered on the second line and the words 'Reaching new heights together' centered underneath on the third row."



("COMMUNICATIONS, INC." disclaimed), both for "public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means" (in International Class 35).<sup>2</sup> The registrations are owned by the same entity, namely Vault Communications, Inc.

The examining attorney also refused registration under Section 2(d) in Class 35 in each application on the basis of a third previously-registered mark, namely THE VAULT (in standard characters) for "advertising, marketing and promotion services" (in International Class 35).<sup>3</sup> The registration is owned by The Vault NYC, LLC.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs. So as to be clear, and as reiterated by the examining attorney in his final refusal and brief, only registrations of applicant's marks in connection with services in Class 35 have been refused.

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<sup>2</sup> Registration Nos. 4030759 and 4030758, respectively, both issued September 27, 2011.

<sup>3</sup> Registration No. 3864144, issued October 19, 2010. This registration was cited as a Section 2(d) bar to the registrations sought by Vault Communications, Inc. In response to the refusal, the registrants entered into a consent agreement.

The two appeals involve common issues of law and fact, and the evidentiary records and arguments are essentially identical. The Board, on March 28, 2013, granted the examining attorney's request to consolidate the appeals. Accordingly, we will decide the appeals in this single opinion.

Applicant argues that the marks are different, with the presence of the word "BIOVENTURES" in its marks telling prospective purchasers that its services relate to biotechnology. Applicant also contends that the services are different, with its services specifically directed to the biotechnology and pharmaceutical fields, whereas registrants' services are general marketing and advertising. Purchasers of the services are sophisticated, applicant urges, thereby diminishing the likelihood of confusion.

The examining attorney maintains that applicant's marks are similar to each of the registered marks, and that the services are highly related. With respect to the latter contention, the examining attorney points out registrants' services are not limited, and thus their unrestricted marketing and advertising services include the specific industries to which applicant's services are directed. In support of the refusal, the examining attorney introduced excerpts of the websites of third parties, as well as of one of the registrant's website; and several third-party registrations covering both marketing/advertising

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services and business consulting services. Examples of this evidence are highlighted in the examining attorney's brief at pages 9-12.

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).

**Registration Nos. 4030758 and 4030759**

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

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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).

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

In registrant's standard character mark VAULT COMMUNICATIONS, INC., with the wording COMMUNICATIONS, INC. disclaimed, the word VAULT is dominant. The wording COMMUNICATIONS, INC. is highly descriptive/generic, and has little to no role in the source-identifying function of registrant's mark. See, e.g., *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming Board's finding that "DELTA," not the disclaimed

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generic term "CAFÉ," is the dominant portion of the mark THE DELTA CAFÉ); and *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). Further, purchasers in general are inclined to focus on the first word or portion in a trademark, especially where the first word is followed by non-source-indicating terminology (as is the case with COMMUNICATIONS, INC.). *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered"). See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692.

In registrant's logo mark, likewise the word VAULT is clearly dominant over the disclaimed and highly descriptive/generic wording COMMUNICATIONS, INC. as discussed above. Moreover, the word VAULT is in significantly larger letters, appearing above the remaining subordinate portion.

In view of the above, both of registrant's marks are dominated by the word VAULT.

With respect to applicant's standard character mark, VAULT BIOVENTURES is dominated by the word VAULT inasmuch as the remaining word BIOVENTURES is properly disclaimed in view of its

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highly descriptive/generic nature.<sup>4</sup> And, as noted above regarding registrant's standard character mark, the first word of a mark, in this case VAULT, is the portion of the mark most likely to be remembered by purchasers and used in calling for the services.

With respect to applicant's logo mark, where both words and a design comprise the mark, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In applicant's logo mark, the literal portion of the mark, namely the words VAULT BIOVENTURES REACHING NEW HEIGHTS TOGETHER, is the dominant portion; and, in turn, due to the large font size

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<sup>4</sup> Applicant states that "[o]n a scale from one to ten, with one being the most descriptive, BIOVENTURES would definitely be much closer to a one or two." (Brief, p. 6). Indeed, as shown by the examining attorney's evidence, the wording is commonly used for firms that work in the biotechnology venture capital field.

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of the word VAULT relative to the remaining words, as well as to the highly descriptive/generic nature of the word BIOVENTURES, the literal portion is dominated by the word VAULT. Thus, the word VAULT in applicant's logo mark is the dominant feature. *See, e.g., In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1533-34; and *In re Binion*, 93 USPQ2d at 1534.

As is evident from the above discussion, each of applicant's marks and each of registrant's marks are dominated by the identical word VAULT. When the logo marks are compared, the flowing letter "V" design further contributes to the marks' similarities. In comparing each of the marks, we are aware, of course, that the marks must be compared in their entirety, including any disclaimed portions. To be sure, we have considered the marks in their entirety, and find that the similarities between them in terms of sound, appearance and meaning outweigh the differences. Thus, the marks engender similar overall commercial impressions.

The similarity between each of the marks is a factor that 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 applicant and registrant need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood

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of confusion. It is sufficient that the respective services of applicant and registrant 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 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 applications and cited registrations, respectively. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant's services in Class 35 are identified as follows: "Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and

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biotechnology companies." Registrant's recitation of services in Class 35 reads as follows: "public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means."

Both applicant's and registrant's services include business services involving marketing. Because registrant's recitation includes no restrictions as to trade channels or classes of purchasers, the recited services must be presumed to travel through all normal trade channels and be marketed to all possible classes of relevant purchasers. See *Interstate Brand Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1913 (TTAB 2000). Accordingly, registrant's services are deemed to include marketing and advertising services for biopharmaceutical and biotechnology companies.<sup>5</sup>

The examining attorney introduced several use-based, third-party registrations showing the same entity often offers both business consulting and marketing services under the same mark. "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

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<sup>5</sup> In this connection we note that, as shown by registrant's website, registrant's customers actually include pharmaceutical companies.

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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 submitted excerpts of third-party websites showing that marketing and advertising entities often provide their services to multiple industries; the examples include firms that serve the pharmaceutical and healthcare industries, as well as diverse industries like travel, real estate and automotive, as well as the government. Other websites show that it is common for the same entity to offer both business consulting services, in addition to marketing and advertising services, often under the same mark.

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

Applicant argues, without any supporting evidence, that purchasers of the involved services are sophisticated. Even assuming that a careful selection is involved, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and related services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing*

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*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 similarity between the marks and the relatedness of the services offered 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 decisions, and expensive goods).

We conclude that the pertinent *du Pont* factors bearing on likelihood of confusion weigh in favor of an affirmance of the refusal to register.

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).

The refusal to register in Class 35 is affirmed.

**Registration No. 3864144**

To state the obvious, the above-noted legal principles that govern our likelihood of confusion analysis apply equally with respect to this refusal, and we will not unnecessarily repeat them here.

We first turn to the similarity between the marks, and compare applicant's marks to registrant's standard character mark THE VAULT. As discussed above, the dominant portion of each of applicant's marks is the word VAULT, which is virtually identical to registrant's mark. The definite article "THE" at the beginning of registrant's mark does not affect or otherwise diminish the overall similarity between the 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).

The marks are similar in sound, appearance and meaning, and engender similar overall commercial impressions.

With respect to the services, we reiterate that the comparison is controlled by the recitations in the respective applications and cited registration. Applicant's services in Class 35 are identified as follows: "Assistance, advisory

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services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies." Registrant's recitation of services in Class 35 reads as follows: "advertising, marketing and promotion services."

For the same reasons as discussed above, applicant's and registrant's services overlap; both involve marketing. As shown by the examining attorney's third-party registrations and websites evidence, it is common for both business consulting services and marketing services to be rendered by the same entity under the same mark.

The similarities between the services, and the overlap in trade channels and purchasers are factors that weigh in favor of a finding of likelihood of confusion.

Even assuming that purchasers may be careful in making their buying decisions, this factor is outweighed by the similarities between the marks and services rendered thereunder.

We find that the pertinent *du Pont* factors weigh in favor of a finding of a likelihood of confusion.

As was noted earlier, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion,

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that doubt is required to be resolved in favor of the prior registrant.

**Decision:** The refusal to register in Class 35 in each application is affirmed. The applications will proceed forward in Classes 38 and 42.