

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

Mailed: October 2, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Richard J. Eisner
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Serial No. 85593854
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Sarah Silbert of Berliner & Associates,
for Richard J. Eisner.

Deborah Meiners, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Zervas, Kuhlke, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Richard J. Eisner seeks registration on the Supplemental Register of the mark 1-888-SU-ABOGADO, in standard characters, for “legal services” in International Class 45.¹ The application includes the following translation statement: “The English translation of ‘SU ABOGADO’ in the mark is ‘YOUR LAWYER.’”

¹ Application Serial No. 85593854, filed April 10, 2012, based on Applicant’s claim of first use anywhere and in commerce since at least as early as April 7, 2012; application amended from the Principal Register to the Supplemental Register on August 29, 2012.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the services identified in the application, so resembles the following two standard character marks:

- YOURLAWYER.COM for "legal services, advice and representation of prospective clients" in International Class 42,² and
- YOURLAWYER for "legal services" in International Class 45³

as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusal final, Applicant appealed. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to

² Registration No. 3210791, registered on the Principal Register on February 20, 2007; Section 8 declaration of use accepted April 9, 2012. The owner of this registration is the Jerrold S. Parker and Herbert L. Waichman Partnership.

³ Registration No. 3510267, registered on the Supplemental Register on September 30, 2008; Section 8 declaration of use accepted August 4, 2014. The current owner of this registration is Parker Waichman LLP composed of Jerrold S. Parker and Herbert L. Waichman. Applicant does not dispute that both cited registrations have the same owner.

the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

We begin by noting that the cited mark YOURLAWYER.COM (“the ’791 Registration”) is registered on the Principal Register, while the cited mark YOURLAWYER (“the ’267 Registration”) is registered on the Supplemental Register. It has long been established that a mark registered on the Supplemental Register can be used as a basis for refusing registration to another mark under Section 2(d) of the Trademark Act. *In re Clorox*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). The same standards are applied to registrations on either register cited under Section 2(d), although “[t]he level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely.” *Id.* at 341.

We turn now to the similarity of the services and channels of trade, the second and third *du Pont* factors, respectively. Applicant’s identified services are “legal services.” We find that Applicant’s services are identical to those identified in the ’267 Registration and identical in part to those in the ’791 Registration, which are “legal services, advice and representation of prospective clients.”

Because there are no limitations as to channels of trade or classes of purchasers in the descriptions of services in the cited registrations, we presume that the registrant’s services move in all channels of trade normal for such services and are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ

639, 640 (TTAB 1981). Moreover, because the legal services described in the application and the cited registrations are identical in part, we must presume that the marketing channels of trade and targeted classes of purchasers are the same. *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues that his services and the registrant's services "are not likely to be encountered together, side-by-side."⁴ Because lawyers "offer their services through their individual law firms or offices" rather than online or "at a single retail outlet,"⁵ Applicant contends, his services and those offered by the registrant are unlikely to be encountered together in the marketplace.

Applicant's argument does not address the significance of the fact that the identified services are identical. Accepting Applicant's argument that legal services are not actually sold in the same retail establishments, we nonetheless must presume that providers of identical legal services compete for the same customers seeking those services, through all channels normal for those services.⁶ In our

⁴ Reply Brief at 8, 27 TTABVUE 12.

⁵ Appeal Brief at 15, 24 TTABVUE 20.

⁶ Applicant's Brief supports this presumption. *See id.* at 12, 24 TTABVUE 17 ("Typically, a consumer's initial contact with a lawyer is not for *purchasing* the service, but rather for *shopping* for it. Before hiring a lawyer, a consumer typically contacts numerous lawyers to find out what the lawyer can do for him or her, what the lawyer charges and, more generally, to learn 'what's involved.' An advertisement for legal services, therefore, does not induce a consumer to purchase the lawyer's service but, at most, merely to include the lawyer in the set of lawyers consulted before choosing one.").

likelihood of confusion analysis, our findings under the second and third *du Pont* factors strongly support a conclusion that confusion is likely.

We turn next to the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Because the similarity or dissimilarity of the marks is determined on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, 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 entirety. *In re Nat'l Data*, 224 USPQ at 751. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

When, as here, marks would appear in association with services that are identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

In this case, the cited marks are YOURLAWYER and YOURLAWYER.COM. Applicant’s mark is 1-888-SU-ABOGADO. To determine similarity of meaning and connotation, in order to ascertain confusing similarity with English word marks, foreign words from common languages generally are translated into English under the doctrine of foreign equivalents.⁷ *Palm Bay Imports Inc.*, 73 USPQ2d at 1696. The doctrine of foreign equivalents is not an absolute rule, however, and should be viewed merely as a guideline. *Id.* “The doctrine should be applied only when it is

⁷ Applicant does not dispute that Spanish is a modern language widely spoken in the United States. The Examining Attorney references evidence from PewResearch.org demonstrating that Spanish is the most common language spoken in the United States other than English, but no such evidence is of record. *See* Examining Attorney’s Brief, 26 TTABVUE 9 n.7; *see also* Denial of Request for Reconsideration at 45-46, 14 TTABVUE 5-6. We note that an August 2013 American Community Survey Report issued by the U.S. Census Bureau states that more than 37 million U.S. residents age five and over spoke Spanish or Spanish Creole at home in 2011 (from <http://www.census.gov/prod/2013pubs/acs-22.pdf>, at p. 3). The Board may take judicial notice of census data. *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008). *See also In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648 (TTAB 2008) (stating “there is no question that Spanish is a common, modern language”).

likely that the ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’” *Id.* (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

The literal and direct translation of “su abogado” from Spanish to English is “your lawyer.” Applying the doctrine of foreign equivalents, we find that the English translation of Applicant’s mark, 1-888-YOUR-LAWYER, has a meaning and connotation highly similar to both of the cited marks, YOURLAWYER and YOURLAWYER.COM. As translated, each mark consists of or comprises the terms “your” and “lawyer” and no other word.⁸ Although Applicant’s mark leads with the toll-free telephone prefix 1-888 and one of the cited marks ends with the Internet generic top-level domain .COM, both are highly descriptive or generic elements of toll-free phone numbers and website addresses, respectively, that do not identify source. *See, e.g., In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (noting it was undisputed that “.com” was generic and affirming decision finding MATTRESS.COM generic for “online retail store services in the field of mattresses, beds, and bedding”); *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001) (noting that (888) “is

⁸ We find that, although the words in the cited marks are presented without a space, consumers are highly likely to view and verbalize them as “your lawyer” and “your lawyer dot com,” based on normal English pronunciation. *See, e.g., Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009).

devoid of source-indicating significance”); *In re Page*, 51 USPQ2d 1660, 1664 (TTAB 1999) (stating that the 888 prefix in the mark 888 PATENTS “does not have any source-identifying significance”). *See also 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 likelihood of confusion.’”) (quoting *In re Nat’l Data*, 224 USPQ at 752).

This is not the end of our inquiry, however. We also must compare the appearance and sound of Applicant’s untranslated mark with the two cited marks. Applicant correctly argues that there are several points of distinction in appearance and sound between his mark and the cited marks.⁹ Nonetheless, we find that for these marks, the near-identity in meaning between Applicant’s mark and the cited marks outweighs the visual and auditory differences, such that the marks create similar overall commercial impressions. “While the marks are concededly distinguishable in their appearance and pronunciation, it is our view that the equivalency in meaning or connotation is sufficient, in this case, to find likelihood of confusion.” *In re American Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987) (holding BUENOS DIAS for bar soap, and GOOD MORNING and sun design for latherless shaving cream, likely to cause confusion). *See In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (“In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone may be sufficient to support a

⁹ *See* Appeal Brief at 6, 24 TTABVUE 11, and Reply Brief at 4, 27 TTABVUE 8.

holding that the marks are confusingly similar.”) (quotation omitted); *see also, e.g., In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649-50 (TTAB 2008) (finding LA PEREGRINA and PILGRIM to be foreign equivalents with identical meanings, outweighing the differences in appearance and pronunciation); *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006) (finding that MARCHE NOIR for jewelry and BLACK MARKET MINERALS for retail jewelry and mineral store services, “while decidedly different in sound and appearance, have the same connotations”); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983) (holding EL SOL for clothing and footwear, and SUN and design for footwear, likely to cause confusion).

For all of these reasons, we find Applicant’s mark, considered in its entirety, to be similar to the cited marks. Therefore, the first *du Pont* factor also supports a finding that confusion is likely.

We turn next to the sixth *du Pont* factor, the number and nature of similar marks in use for similar services. Applicant argues that the cited marks are not only conceptually weak but also entitled to only a narrow scope of protection due to extensive use of other marks incorporating the terms “your” and “lawyer” in connection with legal services. In support, Applicant identifies the following 12 third-party registrations owned by 11 different entities:¹⁰

¹⁰ Applicant submitted copies of the registration certificates with his Request for Reconsideration, Exhibit A to the Declaration of Sarah Silbert. *Id.* at 21-49, 4 TTABVue 28-56. Two other registrations submitted by Applicant have expired.

Reg. No.	Mark	Services
4473307	DON'T MAKE YOUR LAWYER RICH	The provision, via the internet, of legal information and information relating to legal affairs
4448582	YOURLAWYERS4LESS	Legal services
4307056	YOUR NEIGHBORHOOD LAWYERS	Legal services
4055834	YOUR BUSINESS, YOUR LIFE, YOUR LAWYER.	Attorney services; legal services
3985485	I'D LIKE TO BE YOUR LAWYER	Legal services
3925721	GET GORDON! GET YOUR LAWYER!	Legal services
3925573	WHO'S YOUR LAWYER?	Legal services
3046162	"YOUR LAWYERS, YOUR NEIGHBORS, YOUR FRIENDS"	Legal services
3713009	INVEST IN YOUR BUSINESS, NOT IN YOUR LAWYER	Legal services
3647240	CALL THE LAWYER YOUR LAWYER CALLS.	Lawyer referrals; litigation services
3575395	JUDGE YOUR LAWYERS	Providing a web site where users can post ratings, reviews and recommendations on legal services
2220452	YOUR LAWYER FOR LIFE	Professional legal services

The mark in each of these registrations comprises additional verbiage and thus is distinguishable from both Applicant's mark and the cited marks, which contain only the words "your" and "lawyer" (in English or Spanish) alone or with the 1-888 phone prefix or the .com gTLD. These registrations, moreover, are not evidence that the marks therein have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the basis of minor differences.

The probative value of third-party trademarks depends entirely on their usage. *Palm Bay Imports Inc.*, 73 USPQ2d at 1693. Where, as here, the record includes no evidence about the extent of use by third-party registrants, the probative value of this evidence is minimal. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). “The existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.” *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). We also note that one of the registrations is for a web site for users to rate legal services, which is different from legal services and therefore not relevant here.

Applicant argues that Internet printouts submitted by the Examining Attorney identify examples of actual third-party use of toll-free phone numbers and domain names incorporating the terms “law” or “lawyer” for legal services. These include www.lemonlaw.com and 1-800-LEMON-LAW,¹¹ as well as 1-800-THELAWYER and 1800THELAWYER.COM.¹² Notably, none of the third-party examples include both “your” and “lawyer,” and, as such, do not serve to limit the scope of protection of the combined term “YOUR LAWYER.” In addition, the evidence regarding these uses is

¹¹ See Denial of Request for Reconsideration at 21-23, 9 TTABVue 2-4.

¹² *Id.* at 26. This site also displays the phone number 1-800-ELAbogado.

limited,¹³ and the website printouts of record do not establish how many relevant customers may have encountered them. *In re Thomas*, 79 USPQ2d at 1026 (stating that, “without evidence as to the extent of third-party use, such as how long the websites have been operational or the extent of public exposure to the sites, the probative value of this evidence is minimal”). Given the limitations of the record evidence as to the extent of third-party use, we find the sixth *du Pont* factor neutral.

We agree with Applicant that the cited marks are highly suggestive. However, the '791 Registration is registered on the Principal Register and entitled to a presumption of validity under Section 7(b) of the Trademark Act; only the '267 Registration is on the Supplemental Register, an implied admission that the registered term was descriptive at least at the time of the registrant's first use of the term. *Perma Ceram Enters. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992). Furthermore, even “weak” marks are entitled to protection from registration by a subsequent user of a confusingly similar mark for related goods or services. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). Registration of Applicant's mark with its nearly identical commercial

¹³ Applicant also cited two other uses. The first is 1-800-LAWYERS from the website www.attorneysonlineinc.com/abogado.html, *id.* at 24-25, 9 TTABVUE 5-6. However, that website appears to be dedicated not to offering legal services, but rather to marketing to lawyers the vanity phone numbers 1-800-LAWYERS and 1-800-ABOGADO, as well as 1-888-LAWYERS and 1-888-ABOGADO, in “a limited number of metro areas throughout the United States.” The second use is 1-800-YOURLAWYER from the website www.yourlawyer.com, *id.* at 33-44, 11 TTABVUE 2 through 14 TTABVUE 4. The latter uses are by the Parker Waichman LLP law firm, owner of the cited '267 Registration.

impression for identical services would intrude into even the circumscribed sphere of protection for the cited marks.

Finally, we consider Applicant's arguments under the fourth *du Pont* factor: the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing. *Du Pont*, 177 USPQ at 567. Applicant argues that this factor weighs against a likelihood of confusion because "the parties' legal services are not the type of services consumers typically purchase on impulse or without care."¹⁴

Our precedent requires that we base our decision on the least sophisticated potential purchasers of the identified services. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). The purchasers of legal services are the general public, which necessarily encompasses consumers with limited experience seeking legal advice. Even if ordinary consumers exercise care when shopping for legal services, they are not immune from source confusion where highly similar marks are used in connection with identical services. *See id.* at 1163-64; *see also In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). We find the fourth *du Pont* factor to be neutral.

We have considered all arguments and evidence of record pertaining to the *du Pont* likelihood of confusion factors. In sum, we have found that the first *du Pont* factor weighs in favor, and the second and third factors weigh strongly in favor, of a finding that confusion is likely. The fourth and sixth *du Pont* factors are neutral. To

¹⁴ Appeal Brief at 10, 24 TTABVue 15.

the extent that any other *du Pont* factors for which no evidence was presented by Applicant or the Examining Attorney may be applicable, we also treat them as neutral. Even if the cited marks are weak, because the marks are highly similar in meaning and commercial impression and the services are identical and move in the same channels of trade to the same customers, we find that Applicant's mark is likely to cause confusion with the marks in cited Registration Nos. 3210791 and 3510267 when used in association with legal services.

Decision: The refusal to register Applicant's mark is affirmed.