

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 6, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Rock Creek Group, LP

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Serial No. 85595470

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Barbara A. Barakat of Wilmer Cutler Pickering Hale and Dorr for The Rock Creek Group, LP.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Quinn, Zervas, and Kuczma.
Administrative Trademark Judges.

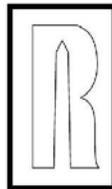
Opinion by Quinn, Administrative Trademark Judge:

The Rock Creek Group, LP (“Applicant”) filed an application to register the mark THE ROCK CREEK GROUP (in standard characters) for

individualized and personalized financial services provided to institutional investors, namely, sovereign wealth funds, state and local pension plans, multinational corporations, foundations and endowments, namely, financial management services, investment management services, investment advisory services, asset portfolio management services, securities trading services, creating portfolios of emerging fund managers for investors, developing customized portfolio solutions, providing dynamic asset allocation services, providing risk budgeting, risk aggregation and risk management services, conducting fund, manager investment and

operational due diligence, transition management services for investors restructuring portfolios and providing temporary use of non-downloadable computer programs, databases and analytical tools for use in investment and asset management, asset and risk allocation, fund and manager due diligence, portfolio construction, risk measurement, operations and investor communications, all of the foregoing excluding real estate investment, management and brokerage services (in International Class 36).¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that Applicant's mark, when used in connection with Applicant's services, so resembles the previously registered mark ROCK CREEK PROPERTY GROUP, LLC (in typed form) ("PROPERTY GROUP LLC" disclaimed),² and the mark shown below



ROCK CREEK
property group

("PROPERTY GROUP" disclaimed),³ both for "real estate investment, management, and brokerage services" in International Class 36, as to be likely to cause confusion.

¹ Application Serial No. 85595470, filed April 11, 2012 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging dates of first use anywhere and first use in commerce of January 2003.

² Registration No. 2838178, issued May 4, 2004; renewed. Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (2014).

³ Registration No. 3728263, issued December 22, 2009. The registration includes the following description of the mark: "The mark consists of a stylized 'R' located within a rectangle; the wording 'Rock Creek Property Group' is located beneath the rectangle."

The registrations are owned by a single entity, namely Rock Creek Property Group, LLC.

When the refusal was made final, Applicant appealed. Applicant subsequently requested reconsideration based on the amended recitation of services set forth above. When the request for reconsideration was denied, proceedings resumed. Applicant and the Examining Attorney filed briefs.

Applicant argues that while both marks include “ROCK CREEK,” this wording identifies a free-flowing tributary of the Potomac River in the Washington, D.C. metropolitan area where both Applicant and Registrant are located. As such, Applicant contends that “consumers are likely to look beyond that phrase to determine the nature of the source of the services.” (4 TTABVue 5). Applicant also contends that the services, trade channels and customers are different, with Applicant providing high level financial investment and management services for a specific type of customer; moreover, Applicant does not sell, manage or invest in real estate, and Applicant’s customers would not contact Registrant to handle their financial investments. To this point, Applicant asserts that there has been no actual confusion between the marks, despite over a decade of contemporaneous use of the marks. Further, according to Applicant, the services are highly specialized and expensive, so the selection and purchase of both Applicant and Registrant’s services involve a close personal contact, and individual attention to that entity’s clients. Applicant did not introduce any evidence in support of its arguments.

The Examining Attorney maintains that the marks are similar, and that the services are related. In connection with the later argument, the Examining Attorney stated that “despite the amendment to the identification of services, said amendment does not resolve the problem as applicant’s services are still closely related to registrant’s which are very broadly set out or identified.” (10 TTABVue 1). In support of the refusal the Examining Attorney submitted copies of third-party registrations showing that the same entity has registered a single mark for both financial services and real estate services.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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).

We initially turn to the first *du Pont* factor regarding the similarity between the marks. Because the design features in one of the cited marks (Reg. No. 3728263) result in additional differences with Applicant’s mark, we confine our analysis to the issue of likelihood of confusion between Applicant’s mark and the cited registration for the mark in typed form (Reg. No. 2838178), namely the stronger of the two refusals. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the cited design mark, while

if there is no likelihood of confusion between Applicant's mark and the cited mark in typed form, then there would be no likelihood of confusion with Registrant's mark with design elements. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We must compare the marks in their entireties 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 Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), *quoting In re E. I. du Pont de Nemours & Co.*, 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).

Although marks must be considered in their entireties, it is 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 mark, the generic wording "PROPERTY GROUP LLC" (serving to identify the entity type and general subject matter of Registrant's services) is disclaimed.⁴ Thus, this wording has no source-indicating capacity. *See In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522 (TTAB 2006). *See generally* TMEP § 1213.03(d) (2014). Accordingly, we view "ROCK CREEK" in Registrant's mark to be the dominant portion. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE). Moreover, purchasers in general are inclined to focus on the first word or portion in a trademark; in Registrant's mark, "ROCK CREEK" is the first portion. *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 Fondee En 1772*, 73 USPQ2d at 1692.

In Applicant's mark, the presence of the word "THE" at the beginning of the mark does not have any trademark significance. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (WAVE and THE WAVE are "virtually identical" and likely to be confused). Although the word "GROUP" is not disclaimed, it is the last word in the mark, and is in the nature of an entity designation. As such, the

⁴ The word "group" is defined, in relevant part, as "a number of people who are connected by some shared activity, interest or quality." (<m-w.com>). The Board may take judicial notice of entries in standard reference works, *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). *See In re Thomas White Int'l Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013).

word clearly plays a subordinate source-indicating role relative to the wording “ROCK CREEK” in Applicant’s mark.

Thus, both marks are dominated by the identical wording, namely ROCK CREEK. We recognize, however, that the marks must be considered in their entireties, including disclaimed wording and/or wording that lacks source-indicating capability. The commonality of the wording ROCK CREEK in the marks THE ROCK CREEK GROUP and ROCK CREEK PROPERTY GROUP, LLC results in marks that are similar in sound and appearance. The presence of additional, subordinate words in the later portion of each mark is insufficient to distinguish the marks. As to meaning, both marks convey the same suggestion, that is, Applicant and Registrant are located and offer their services in the Washington metropolitan area.⁵ Given the similarities in sound, appearance and meaning, the marks engender similar overall commercial impressions.

The similarity between the marks in their entireties weighs in favor of finding a likelihood of confusion.

We next direct our attention to 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 be offered

⁵ “Rock Creek” is the name of a creek that flows through Maryland and Washington, DC. Rock Creek Park, through which the creek flows, is located in Washington, DC, and is one of the largest urban parks in the nation. (<columbiagazetteer.com>). As noted earlier, the Board may take judicial notice of entries in standard reference works. These works include online gazetteers that exist in printed format or have regular fixed editions. *See In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (judicial notice taken of The Columbia Gazetteer of North America and Merriam-Webster’s Geographical Dictionary).

through the same channels of trade, to support a holding of likelihood 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). The issue here, of course, is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of these services. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

It is settled that in making our determination regarding the relatedness of the services, we must look to the services as identified in the application and the cited registration. *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).

In comparing the services, we initially note two limitations in Applicant's recitation: 1) the "individualized and personalized financial services" are specifically provided to "institutional investors, namely, sovereign wealth funds, state and local pension plans, multinational corporations, foundations and endowments"; and 2) "real estate investment, management and brokerage services" are specifically excluded.

Registrant's services on the other hand are broadly worded. Because Registrant's "real estate investment, management, and brokerage services" have no limitations or restrictions, it is presumed that Registrant's services encompass all services of the type identified, move in all trade channels normal for those services, and are available to all classes of purchasers for those services. *See Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Thus, Registrant's services are construed to encompass real estate investment, management, and brokerage services directed to institutional investors, including the specific types of institutional investors identified in Applicant's recitation of services.⁶

Given the limitation of prospective purchasers in Applicant's recitation of services to institutional investors, coupled with the construction of Registrant's recitation to include the same class of purchasers, this class comprises the relevant purchasers for purposes of our analysis because they are the only ones who theoretically could be exposed to both marks. Accordingly, the second *du Pont* factor in this case involves a comparison of financial management and investment services rendered to institutional investors on the one hand, and real estate investment, management and brokerage services offered to institutional investors on the other.

⁶ Applicant, in its brief, points to Registrant's website in an attempt to restrict the scope of Registrant's services. The referenced excerpts of the website were not submitted, but even if they were, such submission would be untimely. Trademark Rule 2.142(d). Moreover, and in any event, an applicant may not restrict the scope of the services covered in the cited registration by argument or extrinsic evidence. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ2d 763, 764 (TTAB 1986).

The Examining Attorney's evidence bearing on the relatedness of the services comprises copies of several use-based third-party registrations which individually cover, under the same mark, both types of services involved herein. "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 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 registrations include the following:

Reg. No. 2747945 of the mark FOG CUTTER for "real estate brokerage services; real estate investment services; real estate appraisal services; real estate listing services; real estate management and leasing services; financial investment services in the fields of securities, commodities, mutual funds, and real estate; financial management services; and consultation services in the fields of financial and real estate investment advice, analysis and management";

Reg. No. 2789326 of the mark LIFE SCIENCE HOTEL for "financial services, namely, financial consultation, financial analysis, financial planning, financial management, providing debt and equity capital, and tangible and intangible asset financing; business incubator services, namely providing equity and debt financing to emerging and start-up companies; real estate services, namely real estate brokerage, acquisition, maintenance, rental, leasing, and management";

Reg. No. 2872017 of the mark ONE GOOD INVESTMENT IS WORTH A LIFETIME OF LABOR for

“investment and real estate services, namely, real estate brokerage, management and investment services, financial management services, and investment advice and consultation services”;

Reg. No. 4054017 of the mark DURASPACE for “real estate management; financial services, namely, financial consultation, financial analysis, financial planning, financial management, financing services, providing working capital, namely, debt and equity capital, tangible and intangible asset financing, and financial portfolio management; business incubator services, namely, providing debt and equity financing to emerging and start-up companies”;

Reg. No. 4171286 of the mark RELIABILITY, TRUST, RESULTS for “providing real estate investment services, real estate management services and financial portfolio management services”;

Reg. No. 4174799 of the mark AG LOAN FUND for “financial analysis and consultation services; real estate consultancy and real estate management services”; and

Reg. No. 4195577 of the mark SUNGATE and design for “financial services and monetary affairs, namely, investment advice, financial information, financial management and real estate management consultation and real estate investment assessment.”

We recognize that none of the recitations in the registrations specifically limits the services to institutional investors. However, just as in the case of Registrant’s registration, the recitations of services are worded broadly enough to encompass institutional investors as a prospective class of purchasers. This third-party registration evidence supports the Examining Attorney’s position that the services are related.

As for the exclusion of Registrant's services in Applicant's recitation of services, this constitutes an ineffective attempt to avoid a finding that the involved services are similar. As indicated above, the services need not be identical to support a finding of likelihood of confusion. In this case, both types of services fall under the general category of investment services (albeit financial vs. real estate), and they may emanate from the same source.

The similarity between the services, and the similarities in trade channels (e.g., investment advisors) and prospective purchasers (institutional investors), weigh in favor of a finding of likelihood of confusion.

Applicant claims that customers for Applicant's and Registrant's services are sophisticated buyers who exercise due diligence prior to retention of financial or real estate investment advisors. Despite the fact that Applicant did not introduce any evidence regarding the degree of care exercised by customers in selecting an investment advisor and the role played by the advisor's service mark, we are willing to acknowledge, based on the type of services involved herein, that institutional investors seeking financial and real estate investment services may, in fact, be fairly sophisticated purchasers. In view thereof, we find this factor to favor Applicant. However, even assuming that Applicant's and Registrant's services may involve a careful purchase after exercising due diligence, 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*

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 Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarity between the marks and the relatedness of the services rendered 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 decision, and expensive goods). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014).

With respect to the eighth *du Pont* factor, Applicant states that it is unaware of any instances of actual confusion between its mark and Registrant’s mark, despite over a decade of contemporaneous use. It is not necessary to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 14 USPQ2d at 1842-43. Applicant’s assertion, particularly in this *ex parte* proceeding, is entitled to little weight. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that testimony of applicant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual

confusion did not exist or that there was no likelihood of confusion); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1588 (TTAB 2007); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, the record is devoid of evidence relating to the extent of use of Applicant's and Registrant's marks that would enable us to determine whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use of the marks without evidence of actual confusion is considered neutral.

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude that purchasers familiar with Registrant's real estate investment, management, and brokerage services rendered under the mark ROCK CREEK PROPERTY GROUP, LLC would be likely to mistakenly believe, upon encountering Applicant's mark THE ROCK CREEK GROUP for individualized and personalized financial services provided to institutional investors, namely, sovereign wealth funds, state and local pension plans, multinational corporations, foundations and endowments, that the services originate from or are associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.