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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 Amco International Education Services, S.A.P.I. de C.V.

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Serial No. 85601701
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for Amco International Education Services, S.A.P.I. de C.V.

Zachary B. Cromer, Trademark Examining Attorney, Law Office 104 (Chris
Doninger, Managing Attorney).

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Before Kuhlke, Lykos, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Amco International Education Services, S.A.P.I. de C.V. (“Applicant”) has filed an
application to register on the Principal Register the mark BRIGHT IDEAS,
BRILLIANT FUTURE in standard characters for the goods and services set forth
below:

Printed educational publications for a variety of
disciplines in the fields of pre-school, primary and
secondary education, namely, educational learning cards,
flash cards, activity cards, workbooks, textbooks, activity
books, story books, puzzle books, teacher guides, manuals,
posters and educational booklets; books, booklets and
manual in the fields pre-school, primary and secondary

school management and administration; books, booklets and manuals in the field of teacher training and teaching skills; books and pamphlets in the field of mastering the English language, developing competitiveness for life, learning to learn, and strengthening computer capabilities; school supply kits containing various combinations of selected school supplies, namely, writing instruments, pens, pencils, mechanical pencils, erasers, markers, crayons, highlighter pens, folders, notebooks, paper, protractors, paper clips, pencil sharpeners, writing grips, glue and book marks; printed instructional, educational, and teaching materials in the fields of math, science, social studies, English, Spanish and other languages; Printed teaching activity guides in the fields of math, science, social studies, English, Spanish and other languages, in International Class 16;

Consultancy services in the fields of school management and administration; management and administration of schools; Business operation, business administration and office functions, in International Class 35;

Providing workshops, seminars and courses for the training of teachers and for providing teaching skills; providing workshops, seminars and courses in the field of school management and administration; providing workshops, courses, seminars and classes in the field of mastering the English language, developing competitiveness for life, learning to learn, and strengthening computer capabilities; educational services, namely, developing educational models for others for teaching English to children in pre-school, elementary school, junior high and high school; Educational services, namely, providing learning programs and strategies for implementation; Educational services, namely, developing educational methods for others based on pedagogic principles; educational services, namely, offering of assessments and surveys in the field of educator training and performance for the purpose of improving teaching procedures; providing information and news in the field of teaching methodology and education issues; providing information and news in the field of teaching methodology and education; teaching at elementary schools; teaching at junior high schools; teaching at high schools; educational services, namely, professional coaching of

teachers in the field of teaching methods, in International Class 41.¹

The Trademark Examining Attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with the goods and services set forth above,² so resembles the registered mark HARRY WINSTON BRILLIANT FUTURES in standard characters as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for the following services:

Educational services, namely, providing workshops, seminars, tutoring and academic mentoring to children at the pre-school, primary and secondary school levels, both in school and other community settings, to ensure successful education; providing cultural and artistic enrichment for educational purposes, in International Class 41.³

When the refusal was made final, Applicant filed a notice of appeal. Thereafter, upon Applicant's request the Board remanded the application to the Examining Attorney for consideration of additional evidence.⁴ The Examining Attorney maintained his refusal and this appeal proceeded. The case is fully briefed.

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

¹ Application Serial No. 85601701, filed April 18, 2012. The application is currently based on Sections 1(a) and 44(e) of the Trademark Act.

² The application also identifies services in International Class 38. The Examining Attorney did not issue a refusal as to the Class 38 services, and those services are not at issue in this appeal.

³ Reg. No. 4243571 issued November 13, 2012.

⁴ 5 TTABVue.

1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted arguments regarding the strength and weakness of components of the marks, trade channels, conditions of sale and sophistication of customers.

1. The goods and services.

We will first consider the similarity or dissimilarity of the goods and services as identified in the application and the services identified in the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We will consider each class of Applicant's goods and services separately.

a. The services in Class 41.

Applicant's services in Class 41 are, in part, legally identical to Registrant's services, as both include teaching at the elementary school and high school (secondary school) levels. Applicant's recitation includes:

teaching at elementary schools; teaching at junior high schools; teaching at high schools; ...

The services in the cited registration include:

Educational services, namely, providing workshops, seminars, tutoring and academic mentoring to children at the pre-school, primary and secondary school levels, both

in school and other community settings, to ensure successful education; ...

We need not address the degree of commercial relationship between each of Applicant's Class 41 services and Registrant's services. For purposes of our analysis, it is sufficient if likelihood of confusion is found with respect to use of Applicant's mark in connection with any service in a particular Class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of the services in Class 41 weighs in favor of a finding of likelihood of confusion.

b. The services in Class 35.

Applicant's Class 35 services are business administration, management, and consultation services in the field of schools and school administration. Such services are not listed in the cited registration. In order to demonstrate that the services of Applicant and Registrant are related, the Examining Attorney has submitted excerpts of websites of businesses in the education field. However, none of them relates to the provision of business administration, management or consultation.

The Examining Attorney has also submitted three use-based, third-party registrations that cover both educational instruction services, similar to those listed in the cited registration, and business management and administration consulting services in the field of education, as listed among Applicant's Class 35 services.⁵

⁵ These are Reg. Nos. 3170939, 4028381, and 4220342. See Office Action of December 1, 2013 at 23-25 and 32-38.

Third-party registrations that are based on use in commerce and that individually cover a number of different services may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). However, these three third-party registrations standing alone are not sufficient to persuade us that customers would be likely to believe that substantive educational instruction of students is likely to emanate from the same source as consulting, management, and business administration services for others, despite being in the same general field of education. Accordingly, for the Class 35 services, this *du Pont* factor weighs against a finding of likelihood of confusion.

c. The goods in Class 16.

Applicant's Class 16 goods include educational publications "for a variety of disciplines," including "workbooks, textbooks, activity books, story books, and puzzle books"; books on the subjects of "mastering the English language, developing competitiveness for life, learning to learn, and strengthening computer capabilities"; books about school management and administration; and "school supply kits" containing requisites like pens, pencils and paper. The cited registration does not cover publications or school supply kits. The question is whether Registrant's educational services for children (pre-school through secondary school) are related to Applicant's educational publications and school supply kits.

The Examining Attorney's internet evidence includes one example of a business that offers both educational instruction and books, *i.e.*, the website of K¹² Store.⁶ The website of Annenberg Learner refers to printed materials, but the educational services are offered to educational professionals rather than to children, so they are different from Registrant's services. Similarly, the website of SDE Staff Development for Educators offers books, but its educational services are directed to educators, not children.

The Examining Attorney has also submitted the following five use-based, third-party registrations that cover both educational instruction services and books:

3366941	KAPLAN
3690688	PREPSKILLS
4189725	SCHOLAR'S STATION
4382627	MIGHTY GIRLS
4314924	GOLD STANDARD MULTIMEDIA EDUCATION ⁷

Given that the purposes of printed educational materials and educational services are highly similar and interconnected, we find the evidence of record sufficient to show a commercial relationship between Applicant's Class 16 goods and Registrant's services.

⁶ Office Action of December 1, 2013 at 12-17. The business offers online educational programs and "boxes of traditional materials, including award-winning textbooks, CDs, videos, and hands-on materials...."

⁷ Office Action of December 1, 2013 at 26-31 and 39-44. We note that the internet evidence indicates that the registered marks KAPLAN and SCHOLAR'S STATION are in actual use for educational services, but not for books.

2. Trade channels; Customers.

As Applicant's services in Class 41 are, in part, legally identical to those of Registrant, we must presume that those legally identical services of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

There is no evidence of record relating to the ordinary trade channels and customers for Applicant's goods and services in Classes 16 and 35. Thus, for those Classes we consider this *du Pont* factor to be neutral.

3. Conditions of purchase; Sophistication of customers.

Applicant argues that, in general, "consumers of educational services are more sophisticated than the average consumer."⁸ However, both Applicant and Registrant provide education at the elementary and high-school level, where the class of customers would include children and other relatively young persons. There is no actual evidence of record as to the sophistication of these (or other) types of customers. Applicant has submitted evidence to show that Registrant provides its services "through 'leading nonprofit organizations,'" suggesting that Registrant's customers are not students, but administrators. However, this argument depends upon a characterization of Registrant's services as a charitable program that is

⁸ Applicant's brief at 24, 10 TTABVUE 25.

funded by Registrant to be carried out by others, a limitation that is not present in the recitation of services in the registration. We must base our analysis on the nature of the services identified in the application and registration at issue. *Stone Lion Capital Partners*, 110 USPQ2d at 1161-1162. In the absence of actual evidence that educational services at the elementary and high-school level are subject to particular conditions of purchase or are offered to sophisticated customers, we treat this *du Pont* factor as neutral.

4. The marks.

Finally, we consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we consider each mark in its entirety, 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 that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). With respect to Applicant's Class 41 services, we are mindful that "[w]hen marks would appear on virtually identical goods or services, 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); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The two marks at issue are clearly not identical, but they are *in part* similar in sound, appearance and meaning because each includes the term BRILLIANT FUTURE. Registrant's mark presents this term in the plural form BRILLIANT FUTURES, but this is a very minor distinction that does not meaningfully distinguish the marks, at least in terms of appearance and sound. *See Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (CCPA 1957); *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962). The Examining Attorney contends that the fact that both marks contain wording other than their common element does not obviate a finding of likelihood of confusion.⁹

Applicant argues that “[t]he marks are distinguished by [Registrant’s] famous HARRY WINSTON house mark and the words BRIGHT IDEAS in [Applicant’s] mark.”¹⁰ Applicant argues that HARRY WINSTON is the dominant element of Registrant’s mark,¹¹ and that the words BRILLIANT FUTURE(S) “are highly suggestive and commonly used.”¹²

Applicant has submitted a substantial amount of evidence to show that HARRY WINSTON is a strong and well-known mark in the field of jewelry.¹³ Considering its position as the initial element in Registrant’s mark, we agree that customers are likely to perceive it as the dominant source-indicating element in Registrant’s mark.

⁹ Examining Attorney’s brief, 12 TTABVUE 5.

¹⁰ Applicant’s brief at 13, 10 TTABVUE 14.

¹¹ *Id.*, 10 TTABVUE 11.

¹² *Id.*, 10 TTABVUE 14.

¹³ Response of October 23, 2013, Exhibits 1-18, pp. 31-189.

See Palm Bay Imports, 73 USPQ2d at 1693. The Examining Attorney appears to agree that HARRY WINSTON may be viewed as a house mark “separable from BRILLIANT FUTURES,” and argues that “BRILLIANT FUTURES would be viewed as a separate sub-brand in the eyes of consumers, which is highly similar to the BRILLIANT FUTURE portion of the applied-for mark.”¹⁴

It is true, as the Examining Attorney argues, that likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks by the addition of a house mark. *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (CORAZON and CORAZON BY CHICA confusingly similar); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (SPARKS and SPARKS BY SASSAFRAS confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985 (CACHET and LE CACHET DE DIOR confusingly similar). However, we note that Registrant’s mark differs from Applicant’s mark not only by the addition of the term HARRY WINSTON but also by the deletion of the wording BRIGHT IDEAS.

Considering Applicant’s mark as a whole, we note a correspondence between the words BRIGHT and BRILLIANT, both in terms of their related meanings and their BR- alliteration. This correspondence promotes perception of the four-word phrase as a unitary mark. The meanings that arise from this correspondence are not present in Registrant’s mark.

Applicant argues moreover that, because the phrase BRILLIANT FUTURE is commonly used and suggestive of academic success, it has lesser importance in

¹⁴ Examining Attorney’s brief, 12 TTABVUE 6.

Registrant's mark as a source indicator. Applicant has submitted substantial evidence of the use of the phrase "brilliant future" in ordinary text, illustrating that the term is commonly understood to indicate aspirations of success.¹⁵ Although this meaning does not render the phrase nondistinctive in the field of educational services, it does affect the conceptual strength of the phrase as a source indicator. *See Palm Bay Imports*, 73 USPQ2d at 1693 (laudatory term ROYALE of lesser source-indicating strength than VEUVE in the mark VEUVE ROYALE). In Applicant's mark, this suggestiveness reduces the likelihood that customers would view BRILLIANT FUTURE as a discrete source indicator, separable from the BRIGHT IDEAS component. In Registrant's mark, this suggestiveness reduces the source-indicating importance of BRILLIANT FUTURES, making it more likely that customers will give greater weight to the HARRY WINSTON portion of the mark. *See Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1174 ("[T]he Board has frequently determined that additional distinctive elements, such as [the] ZIG ZAG house mark, may avoid likely confusion where the marks in their entirety convey significantly different commercial impressions or the matter common to the marks is so suggestive or weak that any source-indicating value it has is overwhelmed by the addition of an arbitrary, distinctive element.")

Even though the two marks at issue have obvious similarities, we find that they create different commercial impressions when they are considered in their entirety. Applicant's mark would be perceived as a unitary slogan indicating that

¹⁵ Applicant's response of October 23, 2013, Ex. 19, pp. 190-252.

good ideas will lead to good prospects for success. Registrant's mark would be perceived as an indicator that HARRY WINSTON is the source of a project under the subsidiary mark BRILLIANT FUTURES. We find these differences sufficient to distinguish the goods and services of Applicant and Registrant, including their identical Class 41 services. Accordingly, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

5. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In view of the different commercial impressions created by the marks at issue when considered in the context of the identified goods and services, and the conceptual weakness of the common element, we find that Applicant's mark is not likely to cause confusion, mistake or deception as to the source of Applicant's goods and services vis à vis the cited registered mark.

Decision: The refusal to register is reversed.