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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BizMacs, Inc.

Serial Nos. 85652874, 85652879, 85652890 and 85652893

Matthew H. Swyers of The Trademark Company, PLLC for BizMacs, Inc.

C. Skye Young, Trademark Examining Attorney, Law Office 117 (Hellen M. Bryan-Johnson, Managing Attorney).

Before Wellington, Adlin and Masiello, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

BizMacs, Inc. (“Applicant”) seeks registration of the marks MAC SUPPORT AT WORK (with SUPPORT AT WORK disclaimed), MAC SUPPORT AT HOME (with SUPPORT AT HOME disclaimed), BIZMACS and HOMEMACS, all in standard characters, for “IT consulting services.”¹ The Examining Attorney refused registration of all four marks under Section 2(d) of the Trademark Act of 1946, 15

¹ Application Serial Nos. 85652874, 85652893, 85652879 and 85652890, respectively, each filed June 15, 2012. The application to register MAC SUPPORT AT HOME was filed based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act, while the other three applications were filed based on use under Section 1(a) of the Act.

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U.S.C. § 1052(d), on the ground that Applicant's marks so resemble five of Apple, Inc.'s previously-registered marks, as set forth below:

MAC, in typed form, for "computers; computer printers; computer monitors; computer peripherals; computer operating system software; electronic mail and message delivery apparatus; multimedia authoring computer programs for use in the fields of business, government, education, and science; CD-ROM drives," Registration No. 1964391 (the "'391 Registration");

MAC, in typed form, for "computer storage media, namely a full line of pre-recorded computer programs," Registration No. 1968965 (the "'965 Registration");

MAC OS, in typed form and with OS disclaimed, for "computers, computer operating system software, and a full line of prerecorded computer programs," Registration No. 2000282 (the "'282 Registration");

MAC, in typed form, for "leasing access time to computer databases dealing with articles of general interest and computer services, namely, providing information by means of a global computer information network dealing with articles of general interest," Registration No. 2076153 (the "'153 Registration"); and

MAC.COM, in typed form, for "telecommunication services, namely, electronic transmission of data, images and documents via local and global computer networks; electronic mail services; electronic retrieval of data, images and documents," Registration No. 2585165 (the "'165 Registration")²

that use of Applicant's marks in connection with Applicant's services is likely to cause confusion or mistake or to deceive. After the refusals became final, Applicant

² Issued March 26, April 16, September 10 and July 9, 1996, and June 25, 2002, respectively. Each registration has been renewed.

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appealed, its requests for reconsideration were denied and the Board consolidated the appeals.³ Applicant and the Examining Attorney filed briefs.

Likelihood of Confusion

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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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 services. *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 the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Turning first to the goods and services, they need not be identical or even competitive in order to support a finding of likelihood of confusion. It is enough that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used, to a mistaken belief that Applicant’s services and Registrant’s goods and services originate from or are in some way associated with the same source or that there is an association between the sources of the goods and services. *Hilson*

³ References to the record are to the file for application Serial No. 85652874, unless otherwise indicated.

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Research, Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1432 (TTAB 1993); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of the goods and services. *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

In this case, Applicant's "IT consulting services" are at least related to Registrant's "computers," "computer peripherals," "computer operating system software," "computer programs" and "software." In fact, IT (information technology) consulting services by definition relate to computers, their peripherals and computer software.

The Examining Attorney has introduced evidence that the same sources offer under the same mark both IT consulting services and one or more of the goods or services identified in the cited registrations. For example:

WOVENWARE WE BUILD SOFTWARE & Design (Reg. No. 3618778) is registered for "IT consulting services" on the one hand and computer software on the other.

PMOLINK (Reg. No. 3707953) is registered for "IT consulting services" on the one hand and computer software on the other.

SAN SOLUTIONS & Design (Reg. No. 4047378) is registered for "IT consulting services" on the one hand and computer software on the other.

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GABEWIRE (Reg. No. 4077552) is registered for “IT consulting services” on the one hand and “Computer operating software” on the other.

ACCESSAGILITY (Reg. No. 3867078) is registered for “IT consulting services” on the one hand and computer software on the other.

COREFIRE CF & Design (Reg. No. 4196779) is registered for “IT consulting services” on the one hand and computer software and “Electronic transmission of data ...” on the other.

CONTINUUM ANALYTICS & Design (Reg. No. 4325817) is registered for “IT consulting services” on the one hand and computer software on the other.

CLOUDBOLT (Reg. No. 4318943) is registered for “IT consulting services” on the one hand and computer software on the other.

IGNIFY (Reg. No. 4316429) is registered for “IT consulting services” on the one hand and computer software on the other.

ITS (Stylized) (Reg. No. 4222056) is registered for “IT consulting services” on the one hand and computer software and “Provision of access to data or documents stored electronically in central files for remote consultation” on the other.

Office Actions of October 9, 2012 and May 5, 2013. “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.” *See, In re Mucky*

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Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1998); *see also In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

More importantly, Applicant's marks and specimens of use reveal that Applicant's IT consulting services are provided to owners of Registrant's MAC computers. Specimen for MAC SUPPORT AT WORK ("invest in the most efficient and cost effective business Mac support available in the Bay Area. BizMacs has been offering enterprise-level Macintosh⁴ based technical support services to some of the largest and most demanding fortune 500 companies in the entire Bay Area ... BizMacs has the technical resources, experienced Apple® Certified technicians, and the support know-how ..."). Furthermore, printouts from Applicant's website reveal that Applicant provides "Help Desk" services to owners of Registrant's MAC computers, including phone support and a Web-based help desk. Office Action of October 9, 2012 (printout from "bizmacs.com"). In other words, Applicant assists its customers, who are by definition also Registrant's customers, in using and resolving issues with the computers and related products identified in the cited registrations. Where, as here, goods or services are complementary, they may be found to be related. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *General Mills, Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1597-98 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009).

⁴ Macintosh computers are known as MACs. Office Action of June 6, 2013 (printouts from "jimmymacsupport.com" and "macsupportx.com").

Furthermore, Applicant offers to “build” and “support” computer servers, including “Mail servers” and “Web servers,” and to assist with backing up data, networking and software procurement. Office Action of October 9, 2012 (printout from “bizmacs.com”). This reveals a close relationship between Applicant’s IT consulting services and not just Registrant’s “computers,” but also Registrant’s “electronic mail and message delivery apparatus,” “software,” “leasing access time to computer databases,” “telecommunication services, namely, electronic transmission of data, images and documents,” “electronic mail services” and “electronic storage of data, images and documents.” Applicant’s inclusion of Registrant’s cited mark MAC in its own mark and promotion of its “Apple® Certified technicians” reveals just how close the relationship is between Applicant’s services and Registrant’s goods and services. Applicant essentially concedes the point. Applicant’s Appeal Brief at 10 (“it is apparent that although the services of the Applicant are related to the goods of the registrant, they are distinct in that there is no evidence of record that would establish that the registrant has ever offered or intends to offer services of the kind offered by the Applicant”).⁵ This *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion.

⁵ Applicant also argues that consumers “are able to differentiate” between Registrant’s “product itself and independent service companies for the same.” Applicant’s Appeal Brief at 10. The record reveals, however, that Registrant promotes its own network of IT consulting service providers and that Registrant provides support for its own products. Office Action of July 6, 2013 Exs. B and C (printouts from “consultants.apple.com” and “apple.com”). Although the Examining Attorney did not originally refuse registration of Applicant’s marks BIZMACS and HOMEMACS, Registrant filed a Letter of Protest against these applications, following which the Examining Attorney issued the Section 2(d) refusals on appeal.

As for channels of trade, neither Applicant's nor Registrant's identifications of goods and services include any limitations as to channels of trade, and therefore Applicant's and Registrants' goods and services are presumed to move in all normal channels of trade for those goods and services and to be available to all classes of consumers. *Citigroup Inc. v. Capital City Bank Grp., 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). In this case, those channels of trade include Applicant's and Registrant's websites. Office Action Response of April 8, 2013 Ex. 4 (Affidavit of Ron James ("James Aff.") ¶¶ 6, 8).⁶ Perhaps more importantly, as revealed by Applicant's marks and website, Applicant specifically targets consumers who purchase Registrant's MAC computers and other products, and therefore the consumers of Applicant's and Registrant's products and services are by definition identical. *See* James Aff. ¶ 4 ("The Macintosh, Mac, and Apple brand names are the same that are referenced in our mark). This factor also weighs in favor of finding a likelihood of confusion.⁷

Turning to the marks, we must compare them "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). That is,

⁶ While Mr. James is unidentified, he testifies that "[i]n the course and scope of my work I have become familiar with the services offered" under Applicant's mark, and we therefore assume that he is somehow affiliated with Applicant.

⁷ To the extent that Applicant argues that there is no likelihood of confusion because its services are offered only in the San Francisco Bay area, this is irrelevant because Applicant seeks a geographically unrestricted registration.

we may not dissect the marks into their various components. *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). At the same time, however, one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature of a mark in determining its commercial impression. *In re Nat'l. Data Corp.*, 224 USPQ at 751 (“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 entirety. Indeed, this type of analysis appears to be unavoidable.”).

Here, Applicant’s marks all include Registrant’s MAC mark in its entirety, along with merely descriptive wording. Indeed, SUPPORT AT WORK from MAC SUPPORT AT WORK and BIZ from BIZMACS directly convey that Applicant’s services are directed to Registrant’s computers used for work or business,⁸ while SUPPORT AT HOME from MAC SUPPORT AT HOME and HOME from HOMEMACS directly convey that Applicant’s services are directed to Registrant’s computers used in the home.⁹ *See James Aff.* ¶ 4 (“The Macintosh, Mac, and Apple

⁸ “Biz” is defined as “business.” Office Action of June 6, 2013 in application Serial No. 85652879 Ex. A (Merriam-Webster Dictionary). And MAC computers used for business purposes are known as “business Macs.” *Id.* (articles from San Jose Business Journal, TechBeat and InfoWorld).

⁹ The evidence also reveals that MAC computers may be used in homes, and when they are may be called “home MACs.” Office Action of June 6, 2013 in application Serial No. 85652890 (printouts from The Seattle Times, St. Paul Pioneer Press, The Biloxi Sun Herald, The New York Times, Marin Independent Journal, Chicago Sun Times, The Washington Times and San Antonio Express-News).

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brand names are the same that are referenced in our mark”). This makes confusion likely. *See, e.g., Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958) (recognizing and applying general rule “that one may not appropriate the entire mark of another and avoid a likelihood of confusion by the addition thereto of descriptive or otherwise subordinate matter”); *see also, Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL and BENGAL LANCER & Design for related goods are confusingly similar); *International Paper Co. v. Valley Paper Co.*, 468 F.2d 937, 175 USPQ 704 (CCPA 1972) (DATA for “writing, typewriter and printing paper” confusingly similar to DATA-SPEED for “paper sold in bulk rolls or bulk reams for conversion only into business forms”); *In re Fiesta Palms LLC*, 85 USPQ2d 1360 (TTAB 2007) (CLUB PALMS MVP for casino services confusingly similar to MVP for casino services offered to preferred customers identified by special identification cards); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984) (“we are firmly of the opinion that purchasers who encounter applicant’s ‘LITTLE GOLIATH’ stapler kits and registrant’s ‘GOLIATH’ large diameter woodcased pencils are likely to believe ... that both products emanate from or are in some way associated with the same source”); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155 (TTAB 1982) (EBONY for cosmetics confusingly similar to EBONY DRUM for hairdressing and conditioner).

It is settled that descriptive wording such as SUPPORT AT WORK and SUPPORT AT HOME (both of which are disclaimed), and BIZ and HOME, is

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entitled to less weight than arbitrary wording such as MAC. *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 the likelihood of confusion.’”) (quoting *In re Nat’l Data*, 224 USPQ at 752); *In re Dixie Rests., Inc.*, 105 F.3d at 1405, 41 USPQ2d at 1533-34; *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (BINION’S, not disclaimed word ROADHOUSE, is dominant element of BINION’S ROADHOUSE); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).¹⁰

Applicant argues that Registrant’s marks are entitled to only a narrow scope of protection based a number of third-party registrations including the term MAC. We disagree for several reasons. First, it is settled that third-party registrations are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). In other words, because there is no evidence that any of the marks in

¹⁰ As the Examining Attorney points out, while the marks in the ‘282 and ‘165 Registrations include additional elements, those elements, OS (which is an acronym for “operating system” and disclaimed), and .COM (which is a generic top-level domain and has no source identifying significance) are themselves descriptive and entitled to less weight in our analysis.

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these third-party registrations are currently in use, the third-party registrations standing alone are not particularly relevant. Second, “[n]either the Trademark Examining Attorney nor the Board is bound to approve for registration an Applicant’s mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also, In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits ... Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”). Third, we agree with the Examining Attorney that most of the cited third-party registrations are irrelevant in any event, because, for example, they contain arbitrary terms or otherwise create a different overall commercial impression than Applicant’s and Registrant’s marks (MacPaw Reg. No. 3968494, DMACS Reg. No. 1805911, EMACS & Design Reg. No. 1852270, EZMAC Reg. No. 3241397, O!macworms Reg. No. 4287917, FLIP4MAC Reg. No. 3122483, OMEGAMAC Reg. No. 1885903, SCHEMACS Reg. No. 4373491, INFIMACS II Reg. No. 3403198), consist of unitary terms in which MAC is not separable (PRIMAC Reg. No. 2963956, VMACS-PLUS Reg. No. 1775782, TELEMAC COST CONTROL Reg. No. 2725670, HUMAC Reg. No. 1328133, INMAC Reg. No. 1224630, PMAC-LITE Reg. No. 1764208, RMACS Reg. No. 3362444, TARMAC Reg. No. 3984181, etc.) and/or predate the cited marks (MACDRAFT Reg. No. 1414771, MACUSER Reg. No. 1437982, MACSUB Reg. No.

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1456229, MACWAREHOUSE Reg. No. 1616162, MACLINK Reg. No. 1433606, MAC & Design Reg. No. 1441835, etc.).

Applicant argues that the relevant consumers have a “high level of sophistication” because Applicant’s marks “are used to attract a very specific consumer, namely, men and women of all ages who use Macintosh products in their business and occasionally need to hire an IT professional who specializes in Macintosh products.” Applicant’s Appeal Briefs at 13. Furthermore, Applicant points out that its services range in price from \$95-180 per hour while Registrant’s products “are priced at about \$300.00 for software up to \$3000.00 for some computer systems.” James Aff. ¶ 9. While Applicant’s services and Registrant’s goods are not inexpensive, they are not so costly that we can presume that consumers will exercise heightened care. Furthermore, “men and women of all ages who use Macintosh products in their business” is a broad category encompassing both sophisticated and unsophisticated consumers, while consumers who only “occasionally need to hire an IT professional who specializes in Macintosh products” are likely to be *less* sophisticated than, for example, IT professionals who routinely purchase services such as those Applicant offers under its marks. Where, as here, the relevant consumers include both professionals and the general public, we apply the standard of care of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). Furthermore, there is no evidence or even argument that home computer users are sophisticated and there is no reason to assume that they are. Finally, even if we assume that consumers may

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exercise at least some care in purchasing Applicant's services and Registrant's goods and services, even careful purchasers can be confused as to source where substantially similar marks are used on highly related and/or complementary goods. *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."). This factor does not outweigh the similarity of the goods and services, the channels of trade and the marks.

Finally, Applicant argues that confusion is unlikely because there is no evidence of actual confusion. However, this is not relevant because there is also no evidence that there have been any meaningful opportunities for confusion to have occurred. *See Cunningham*, 55 USPQ2d at 1847; *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Moreover, the lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving 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).

Conclusion

After considering all of the evidence of record as it pertains to the relevant *du Pont* factors, including all of Applicant's arguments and evidence, even if not

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specifically discussed herein, we find that confusion is likely because the goods and services are similar, they are marketed to the same class of purchasers, the channels of trade overlap and the marks are similar.

Decision: The Section 2(d) refusals to register Applicant's marks are affirmed.