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Subject: U.S. TRADEMARK APPLICATION NO. 85663950 - ALLEGIANCE STAFFING - a1047.06 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85663950

MARK: ALLEGIANCE STAFFING



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Allegiance Staffing

CORRESPONDENT'S REFERENCE/DOCKET NO:

a1047.06

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EXAMINING ATTORNEY'S APPEAL BRIEF

Facts

The applicant seeks to register its mark “ALLEGIANCE STAFFING” for the following services in Class 35: “temporary employment agency services provided to others, not including hospitals and healthcare providers”.

The examining attorney refuses registration under Trademark Act Section 2(d) based on eight registrations all owned by Allegis Group, Inc. The eight registrations feature the following marks and associated services:

U.S. Registration No. 2516311 (“ALLEGIS GROUP”)

- Class 35: Personnel placement and recruitment for temporary and permanent positions.

U.S. Registration No. 2888615 (“ALLEGIS GROUP”)

- Class 35: Personnel placement and recruitment for temporary and permanent positions.

U.S. Registration No. 3350905 (“ALLEGIS GROUP SERVICES”)

- Class 35: Business management and consultation; Employment hiring, recruiting, placement, staffing and career networking services; Human capital management outsourcing services; Temporary employment agencies

U.S. Registration No. 341335 (“ALLEGIS SERVICES INDIA”)

- Class 35: Employment hiring, recruiting, placement, staffing and career networking services; Operation of telephone call centers for others; Personnel placement and recruitment; Temporary employment agencies;
- Class 42: Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Engineering services, namely, engineering for the automotive industry; Information technology consultation; Technology consultation in the field of automotive design, namely, verification and validation for strength, noise, vibration, and manufacturing processes, and crashworthiness, safety, and occupant protection.

U.S. Registration No. 3760311 (“ALLEGIS RECRUITMENT PROCESS OUTSOURCING”)

- Class 35: Employment agency services, namely, filling the temporary and permanent staffing needs of businesses; Employment hiring, recruiting, placement, staffing and career networking services; Human capital management outsourcing services; Outsourcing in the field of temporary and permanent employment services; Outsourcing services.

U.S. Registration No. 3760312 (“ALLEGIS RPO”)

- Class 35: Employment agency services, namely, filling the temporary and permanent staffing needs of businesses; Employment hiring, recruiting, placement, staffing and career networking services; Human capital management outsourcing services; Outsourcing in the field of temporary and permanent employment services; Outsourcing services.

U.S. Registration No. 4179460 (“ALLEGIS”)

- Class 35: Employment agency services, namely, filling the temporary and permanent staffing needs of businesses; Employment hiring, recruiting, placement, staffing and career networking services; Executive recruiting services; Human capital management outsourcing services; Personnel management; Providing on-line employment information in the field of recruitment, placement, temporary staffing, permanent staffing, professional staffing, human capital outsourcing, and managed services;
- Class 42: Computer project management services; Computer technical support services, namely, 24/7 service desk/help desk services for IT infrastructure, operating systems, database systems, and web applications; Consulting in the field of information technology; Consulting in the field of IT project management; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Software design and development; Technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems.

U.S. Registration No. 4207811 (“ALLEGIS PARTNERS”)

- Class 35: Employment hiring, recruiting, placement, staffing and career networking services; Employment recruiting consultation; Personnel placement and recruitment; Professional staffing and recruiting services; Providing on-line interactive employment counseling and recruitment services.

The applicant now appeals.

Issue

- I. THE APPLICANT'S MARK CREATES A CONFUSINGLY SIMILAR COMMERCIAL IMPRESSION TO THE CITED REGISTERED MARKS, AND THE PARTIES' SERVICES ARE CLOSELY RELATED, SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(d); TMEP §§1207.01 *ET SEQ.*

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d).

In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. Among these factors are the similarity of the marks as to appearance, sound, meaning, and overall commercial impression, relatedness of the services, and similarity of trade channels of the services. *See In re Vittera Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq.* However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011).

Similarity of the Parties' Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra* at 1908; TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); TMEP §1207.01(b).

The examining attorney maintains that the applicant's mark "ALLEGIANCE STAFFING" creates a commercial source impression that is confusingly similar to the source impressions created by the cited registered marks "ALLEGIS GROUP", "ALLEGIS GROUP", "ALLEGIS GROUP SERVICES", "ALLEGIS SERVICES INDIA", "ALLEGIS RECRUITMENT PROCESS OUTSOURCING", "ALLEGIS RPO", "ALLEGIS", and "ALLEGIS PARTNERS".

The examining attorney finds that the term "ALLEGIANCE" is the sole distinctive term in the applicant's mark. "ALLEGIANCE" appears first in the mark, and is arbitrary or at least suggestive in the context of the applicant's services. The term "STAFFING" is disclaimed. The original application featured a disclaimer of all wording, but the examining attorney indicated that a disclaimer of all wording is not permitted. Finding "STAFFING" merely descriptive of the applicant's services, the examining attorney required only a disclaimer of the descriptive term, and the applicant complied in amending the disclaimer statement. For these reasons, the examining attorney finds that the term "ALLEGIANCE" dominates the source impression created by the applicant's mark.

Similarly, the examining attorney finds that the term “ALLEGIS” is the sole distinctive word in the cited registered marks. All other words in the cited marks are appropriately disclaimed. As with the applicant’s mark, “ALLEGIS” appears first in the marks, or by itself, and often in more prominent size. While marks are compared in their entirety in a likelihood of confusion analysis, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra* at 1908; TMEP §1207.01(b). Greater weight is often given to dominant features when determining whether marks are confusingly similar. See *In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751; see TMEP §1207.01(b)(iii), (c)(ii).

For these reasons, the question of whether the parties’ marks create similar source impressions turns on whether the dominant elements “ALLEGIANCE” and “ALLEGIS” are confusingly similar. The examining attorney maintains that these terms share several similarities of sound and appearance. Both words begin with the same letters “ALLEGI-” in which the “E” is likely given a long pronunciation and the “G” a soft, “J”-like pronunciation. Both terms end in syllables with a noticeable “s” sound. Finally, both are three syllables in total length. The terms thus share very similar formulations that contribute to creating similar impressions of appearance and sound.

In its brief, the applicant argues that “ALLEGIANCE” and “ALLEGIS” are not similar because it contends that the marks are only similar if one of the terms is mispronounced. This argument is not persuasive. First, for purposes of the §2(d) analysis, there is no “correct” pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark; therefore, “correct” pronunciation cannot be relied upon to avoid a likelihood of confusion. See, e.g., *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv) (acknowledging that

“there is no correct pronunciation of a trademark” and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB 1987) (“[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion.”).

Furthermore, even a completely precise pronunciation of each term reveals many similarities of sound, owing to the similarities of formulation discussed above. Moreover, the examining attorney stresses the contrary position, namely, that the similarities between the terms are so strong that even a very minor mispronunciation could lead to confusion. In other words, the similarities are so significant that the differences between the terms only become fully evident under a side-by-side comparison. However, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under applicant’s and registrant’s marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); TMEP §1207.01(b). Furthermore, the focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

The applicant next argues that the key terms in the marks have different meanings. The applicant contrasts “allegiance” with the key term in the registered marks and notes that while the former is defined in the *Merriam-Webster* online dictionary as “devotion or loyalty to a person, group or cause”, “allegis” is a fabricated word. The applicant concludes that consumers are not likely to confuse

an actual word in the English language with a “non-word created by a corporation to market its products”. This line of argument is not persuasive.

The examining attorney maintains that the fact that “ALLEGIS” is a fanciful term is in fact a key reason why consumers are likely to confuse the term with “ALLEGIANCE”. Because the key term in the registered marks has no actual meaning, it stands to reason that consumers’ impressions of the term will tend to be shaped relative to their knowledge of real terms. The most closely analogous real word to “ALLEGIS” is the word “ALLEGIANCE”. In other words, the immediate impression of “ALLEGIS” is that it is a fanciful play on the word “ALLEGIANCE”, as there are no other words in the English language that are closer in sound and appearance. The examining attorney attempted to demonstrate this using the *Merriam-Webster* online dictionary, which has a feature whereby the search field auto-suggests words as one types, and the only suggestion following entry of “ALLEGI” is the word “allegiance”. 05/13/2013 Office action at 42. While the English words “allege” and “allegation” have some similar elements to these terms, “ALLEGIANCE” and “ALLEGIS” are more similar in sound and appearance because they share the same number of syllables and – in contrast to the other terms – appear share both the long “E” sound as well as the soft “G”.

The applicant next argues that the examining attorney gives too little weight to the distinguishing nature of the term “STAFFING” in its mark. This line of argument is not persuasive. The examining attorney does not dissect the applicant’s mark, but rather merely demonstrates why “ALLEGIS” is the dominant source-indicating element in the mark, while “STAFFING” has little or no effect on the source impression created by the mark. The examining attorney also notes that “STAFFING” expressly describes the services provided by the registrant, as several of the cited

registrations include “employment...staffing” among the identified services. For example, U.S. Registration No. 4179460 features the term “ALLEGIS” by itself for “employment hiring, recruiting, placement, staffing and career networking services”. Consumers encountering “ALLEGIANCE STAFFING” in the same context as “ALLEGIS” for staffing are likely to focus on the dominant terms in forming their impressions of the marks and confuse the marks.

The applicant notes that the USPTO has not issued any other similar trademarks for similar products or services, stating that “[t]o the best of Applicant’s knowledge, Applicant and Allegis are the only trademarks that are remotely similar in the staffing industry.” This is an important point, as it acknowledges the strength of the cited registered marks for the relevant services.

For these reasons, the examining attorney maintains that the cited registered marks are dominated by the fanciful and strongly distinctive term “ALLEGIS”. This term is highly similar to “ALLEGIANCE”, the dominant source-identifying element of the applicant’s mark, as the terms share strong similarities of appearance and sound. Furthermore, the term “STAFFING” in the applicant’s mark does not significantly alter the commercial source impression created by the applicant’s mark or destroy the similarities between the parties’ marks, especially where both provide staffing services.

Relatedness of the Parties’ Services

The applicant identifies services in the nature of providing temporary employment agency services, and expressly excludes such services in the context of hospitals and healthcare providers. The cited registrant provides services that are very closely related, if not identical, as the registrations include, *inter alia*, “employment agency services, namely, filling the temporary and permanent staffing needs of businesses”, “employment hiring, recruiting, placement, staffing and career networking services”, and so forth.

The wording “employment agency services” in the application and some of the registrations is identical on its face. To further demonstrate the relatedness of the parties’ services, the examining attorney produced evidence in the form of third-party registrations and third-party websites showing that employment agency services typically include staffing, recruiting, and placement activities of the kinds specified by the registrant in this case. 05/13/2013 Office action at 30-41, 47-48. Finally, the examining attorney produced evidence from the reference site www.wikipedia.org that features an encyclopedic explanation of the activities of an employment agency. *Id.* at 49-51.

For these reasons, the examining attorney finds that the parties’ services serve the same purposes and consumer needs of finding workers for other businesses. Moreover, the applicant does not challenge the essential similarities between the parties’ activities. Therefore, absent restrictions in an application and/or registration, the identified services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011).

The applicant's identification does feature a restriction excluding the health care industry, but the registrant's identifications feature no such restrictions. Unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006). For these reasons, the registrant's services must be presumed to overlap in all fields with those served by the applicant, save for employment agency services in the health care industry.

Relying on extrinsic evidence, the applicant argues that its services are provided in markets distinct from those served by the registrant. The examining attorney finds this line of argument unpersuasive. First, when analyzing an applicant's and registrant's services for similarity and relatedness, the determination is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see TMEP §1207.01(a)(iii).

Furthermore, even an examination of extrinsic evidence reveals that the parties' serve overlapping fields. The applicant's website lists among its specialized fields light industry, fulfillment, hospitality, clerical, logistics, and skilled trades. 04/15/2013 Response at 31. The registrant's website lists similar fields, including "technical, professional and industrial staffing," "construction staffing," "administrative staffing", "accounting and financing staffing," and "manufacturing staffing". *Id.* at 33-34, 45. Light industry staffing and industrial staffing clearly overlap, skilled trades staffing and construction staffing likely overlap, manufacturing staffing may include the fields of fulfillment and logistics, and clerical staffing likely overlaps with staffing in the fields of administrative, accounting, and finance.

For these reasons, the plain wording of the parties' identifications shows the services to be closely-related, if not identical and directly competitive. The restriction in the applicant's identification to exclude the health care industry does not encompass a significant portion of the registrant's services. Thus, the parties are likely to market their services in many related fields, as further illustrated by the extrinsic evidence.

The applicant next argues that the relevant consumers are discriminating purchasers. This argument is not persuasive. The applicant provides no evidence to support this position, and there is no inherent reason why the businesses or individual job-seekers having need of the parties' services would be particularly sophisticated or discriminating. In any case, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995).

The applicant next argues that the parties' operate, or at least use the relevant marks, in distinct geographic regions. The applicant indicates that it operates in select states, but argues that the registrant does not operate under the mark in the selected states. The examining attorney notes that the applicant's brief erroneously attributes the evidence of the parties' geographic scope to evidence in the record dated October 18, 2012, when in fact the evidence is from the applicant's response dated April 15, 2013. 04/15/2013 Response at 36-43. In any case, the applicant's argument is not persuasive. The evidence expressly indicates that the registrant uses "ALLEGIS" marks in the United States, and features no geographic restriction. *Id.* at 42. Furthermore, the applicant seeks a geographically

unrestricted registration, and the owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). The applicant seeks nationwide protection, and the registrant enjoys nationwide protection; therefore, the geographical extent of applicant's and registrant's activities is not relevant to a likelihood of confusion determination.

For these reasons, the examining attorney maintains that the parties' services are very closely related in nature, purpose, and intended consumers. The services are thus likely to appear in similar market channels and be marketed to overlapping groups.

Other Considerations

The applicant also argues that its mark and the cited marks have co-existed for many years without any actual confusion. This argument is not persuasive. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Furthermore, the applicant notes that it previously owned U.S. Registration No. 2507546, for the same mark for the same services, which expired for failure to file registration maintenance documents. The applicant argues that the dead registration serves as additional evidence that the parties' operated concurrently without confusion of their respective marks. Additionally, the applicant expresses confusion at how the marks cited in this case could have all been allowed over its prior registration, only for the present examiner to now refuse registration. The examining attorney responds that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). Therefore, the suggestion that other examining attorneys did not find confusion likely between the registered marks and the applicant's prior registration is not relevant to these proceedings.

Furthermore, to the extent that the applicant's arguments challenge the validity of the cited registrations, a claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

Conclusion

For these reasons, the examining attorney maintains that the applicant's mark "ALLEGIANCE STAFFING" creates a source impression that is very similar to the impressions created by the eight cited registered marks featuring the term "ALLEGIS". Furthermore, the services identified in the application and registrations are very closely related in nature and purpose, if not identical, such that consumers in the same fields are likely to encounter the marks in the same market channels and commercial contexts.

The examining attorney notes that where the services of an applicant and registrant are identical or virtually identical, as is the case here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *See In re Viterra* at 1908; TMEP §1207.01(b). Furthermore, any doubt regarding a likelihood of confusion

determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

Consumers are likely to encounter the parties' services in the same commercial contexts. Given the similarities between the marks, especially as to their dominant source-identifying elements, consumers encountering the marks in use for such closely-related services are likely to confuse the marks and mistake the underlying source of the services. Therefore, in order to prevent such confusion, the examining attorney respectfully requests that the Board affirm the refusal to register under Trademark Act Section 2(d).

Respectfully submitted,

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