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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Holland & Hart LLP

Serial No. 85709248

Darin Brown and Andrew Roppel of Holland & Hart LLP for Holland & Hart LLP.

Natalie L. Kenealy, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Zervas, Kuhlke and Gorowitz, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Holland & Hart LLP, filed an application to register on the Principal Register the standard character mark BEYOND THE OBVIOUS for services identified as “legal services,” in International Class 45.¹

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used with the identified services, so resembles the standard character mark THINKING

¹ Application Serial No. 85709248, filed on August 21, 2012, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

BEYOND THE OBVIOUS registered on the Principal Register for “business consultation services” in International Class 35,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed, and Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

SIMILARITY OF THE MARKS

We first consider the marks BEYOND THE OBVIOUS, and THINKING BEYOND THE OBVIOUS and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) *quoting du Pont*, 177 USPQ at 567.

The Examining Attorney argues that:

[B]oth marks contain the identical wording BEYOND THE OBVIOUS. The inclusion of this identical wording in each mark creates the same overall commercial impression of being related to ideas or concepts which are

² Registration No. 3916671, issued on February 8, 2011.

outside the scope of that which is readily apparent. The applied-for mark merely deletes the word THINKING from the registered mark. The deletion of this word does not distinguish the overall commercial impression because the word “thinking” emphasizes the other wording in the registered mark as relating to ideas or concepts which are outside the scope of that which is readily apparent.

Ex. Att. Br. p. 5.

In distinguishing the marks, Applicant points to the placement of the word THINKING at the beginning of Applicant’s mark, noting that consumers are inclined to focus on the first word in a mark. However, in this case, where it is part of a unitary phrase, the placement of the word THINKING is not as impactful. Similarly, because both marks are phrases, the individual first words, THINKING in Applicant’s mark and BEYOND in Registrant’s mark, are not the dominant part of the marks as Applicant proposes. Applicant also argues that:

... the term THINKING suggests that the Registrant will help a consumer think creatively about its business strategy or teach the consumer to think about ideas relating to the consumer’s business. “Thinking” immediately conveys to the consumer the specific nature of Registrant’s services – self-help and advice services for businesses-and results in a suggestive mark that connotes action. [whereas] ... BEYOND THE OBVIOUS, has no such verb or gerund and therefore neither connotes action, nor signals the nature of the services offered under the mark. Instead, Applicant’s mark simply begins with the adverb BEYOND, which connotes a state of being, namely, that Applicant’s legal services are beyond the typical and even that Applicant itself is beyond the typical law firm – that is, that Applicant is different than a “run of the mill” law firm.

App. Br. pp. 3-4.

The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010). We agree with the Examining Attorney's analysis that "[t]he addition of the term THINKING in the registered mark does not change the similar overall commercial impression created by both marks. Rather than separately focusing on the word THINKING in the registered mark, consumers would remember the overall concept of something which is outside the scope of that which is readily apparent. This is the same impression that consumers would remember from the applied-for mark." Ex. Att. Br. p. 6.

Applicant argues that the wording BEYOND THE OBVIOUS is diluted and thus, "the addition of the dominant term, 'THINKING'" differentiates the marks. App. Br. p. 6. Specifically, Applicant argues:

That there are two sources of business advice of a very similar nature coexisting in the marketplace- one under "Thinking Beyond the Obvious" and the other under "Beyond the Obvious" – should be a clear indication that "beyond the obvious" is a diluted phrase and entitled to only a narrow scope of protection.

App. Br. p. 6.

Reliance on two examples of uses of the similar wording is not strong evidence of dilution. Moreover, the evidence Applicant provides overall is not particularly probative on this issue. Many of the examples Applicant submitted are simply book titles in several different fields. These titles are not examples of trademark use by others in the relevant field. *See, e.g.*, BEYOND THE OBVIOUS BRINGING INTUITION INTO OUR AWAKENING CONSCIOUSNESS for a book

in the “psycho-spiritual field.” Many of the third-party websites do not show use of the phrase BEYOND THE OBVIOUS in connection with either legal or business consulting services, and accordingly, they do not show that the wording BEYOND THE OBVIOUS is commonly used in connection with the relevant services. The more relevant third-party websites related to business or legal services use the phrase “Beyond the Obvious” in sentences introducing a corporate message (Req. Recon. Jan. 20, 2014 p. 25-26 and p. 38). As noted by the Examining Attorney, this evidence “is not of a kind or caliber similar to that in *In re Broadway Chicken*,” wherein to establish that the word “BROADWAY” was weak, the applicant provided evidence of approximately 500 entities in the same field (restaurant/bar services) using the term BROADWAY. Ex. Att. Br. p. 7 citing *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996).

We find that the similarities in the marks in appearance, sound, meaning and commercial impression, outweigh the single dissimilarity, the word THINKING in Registrant’s mark. In view thereof, the *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

SIMILARITY OF THE SERVICES/CHANNELS OF TRADE/CONSUMERS

We turn then to a consideration of the services, channels of trade and classes of consumers. We must make our determinations under these factors based on the services as they are identified in the registration and application. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). See also *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d

1157 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is settled that it is not necessary that the respective services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The services need only be sufficiently related that consumers would be likely to assume, upon encountering the services under similar marks, that the services originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The Examining Attorney asserts that “these services commonly emanate from the same sources and are marketed in the same channels of trade.” Ex. Att. Br. p. 8. The evidence submitted by the Examining Attorney sufficiently demonstrates that Applicant’s “legal services” are related to Registrant’s “business consultation services” in that “it is common for the same entity to provide both legal services and business consulting services under the same mark in the same channels of trade.” *Id.* The Examining Attorney submitted printouts from several third-party websites showing a variety of companies providing both legal and

business consulting services under the same mark. A few examples highlighted by the Examining Attorney are set forth below:

SilverFreedman (p. 78 of the July 18, 2013, Final Office Action) provides labor and legal consulting, strategic and organizational planning;

Centarus (pp. 79-80) provides business consulting services including “business plan drafting, business strategy, and business consulting” and “legal services” provided by a “a team of highly skilled lawyers”;

Fraser Law, LLC (p. 81) provides “a full range of business consultation services, backed by legal knowledge” and “business consultation and legal services to clients throughout Western Oregon”;

Inlarec, LLC (p. 82-83) provides business planning & development, “strategies for financing & growing your business,” “strategies for marketing & promoting your business,” “long-range business planning and positioning” and “legal consulting”; and

The Mark Lewis Firm (pp. 86-88) provides legal services and business consulting in the Los Angeles area including general legal counsel services and business consulting services in the nature of business planning, development, management and services to attract investors to support business.

The Examining Attorney also submitted several third-party registrations for both business consulting services and legal services under the same mark. *E.g.*, Reg. No. 2297954 (pp. 8-9 of the July 18, 2013, Final Office Action) for the mark EBG plus design for “business consultation services, namely, providing direct aid in the operations or functions of commercial enterprises” and “legal services”; Reg. No. 2241610 (pp. 3-4) for the mark CRAVATH, SWAINE & MOORE for “business consultation services, namely, providing direct aid in the operations or functions of

industrial or commercial enterprises” and “legal services”; and Reg. No. 2623467 (pp. 13-15 of the December 26, 2012, First Office Action) for the mark ICE MILLER for “business consultation for private and public companies, government entities, and individuals” and “legal services for private and public companies, government entities, and individuals.” *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012) (copies of use-based, third-party registrations may serve to suggest that the services are of a type which may emanate from a single source); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Applicant argues that:

The Examining Attorney cites various third party registrations purporting to show that business consultation services and legal services often originate from a single source. However, these registrations are of low probative value because these services are not offered by stand-alone business consultation companies, such as Registrant, but are instead services offered by law firms. The fact that the same mark is used by law firms to offer both business consulting services and legal services does not support the Examining Attorney’s assertion that different marks used on such services are likely to cause consumer confusion. Instead, it only shows that law firms that have a business law practice area occasionally add “business consultation services” to a trademark application despite those services being legal in nature and more appropriately classified in Class 45. ...

Applicant’s services are offered by lawyers. The legal services industry is governed by its own ethical rules, and any provider of legal services must be licensed by the state in which he or she practices. The legal services industry is a highly specialized and regulated industry that offers its services to sophisticated individuals and businesses. Business consultation, on the other hand, operates in a different field than legal services, is not governed by a specific ethical code or licensure

requirement and is primarily concerned with improving companies by creating and implementing business solutions like helping a business reinvent itself or revamp its image, assisting businesses with acquisitions and takeovers of other businesses and/or helping small business develop a business plan.

Therefore, it is unlikely that any relationship between Applicant's services and Registrant's services might be assumed given the differences in trade channels.

App. Br. pp. 6-8.

As the Examining Attorney explains, "nothing prohibits a licensed attorney from providing business consultation services and the evidence of record clearly establishes that many do indeed offer such services in addition to their legal advice." Ex. Att. Br. p. 12. Moreover, to the extent that business services offered by law firms may be limited a subset of certain business consultation, there is nothing in Registrant's identification of "business consulting" to exclude such types of business consulting. As noted above, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue and may not be limited by extrinsic evidence. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1637 (TTAB 2009); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Considering the channels of trade and classes of purchasers, because the services are related and there are no limitations as to channels of trade or classes of consumers in the cited registration, we must presume that Applicant's and Registrant's services will be offered in the same channels of trade to the same classes of consumers. *Viterra Inc.*, 101 USPQ2d at 1908; *Hewlett-Packard Co. v.*

Packard Press Inc., 62 USPQ2d at 1005; *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In addition, the evidence submitted by the Examining Attorney in the form of third-party websites supports this conclusion.

In view of the above, the *du Pont* factors of the similarity of the services, the channels of trade and classes of consumers favor a finding of likelihood of confusion.

In conclusion, because the marks are similar, the services are related, and the channels of trade and consumers overlap, confusion is likely between Applicant's mark BEYOND THE OBVIOUS and the mark THINKING BEYOND THE OBVIOUS in the cited registration.

Decision: The refusal to register based on a likelihood of confusion under Section 2(d) of the Trademark Act is affirmed.