This Opinion is not a Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Korn Ferry Leadership Consulting Corporation[1]

Serial No. 85932617

Lynn M. Humpreys of Morrison & Foerster LLP,
for Korn Ferry Leadership Consulting Corporation.

Zachary R. Sparer, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

Before Kuhlke, Shaw and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Korn Ferry Leadership Consulting Corporation ("Applicant") seeks registration on the Principal Register of the mark CHOICES (in standard characters) for

> Providing temporary use of on-line non-downloadable software in the field of human resources that enables users to conduct online evaluation of leadership and managerial aptitudes, competencies, job performance and job development, learning agility, and skills for the

[1] Originally filed by Lominger Limited, Inc., which merged into Personnel Decisions International Corporation (PDIC), effective April 29, 2014. PDIC merged into Korn Ferry Leadership Consulting Corporation, effective April 29, 2014.

purpose of implementing leadership development for individuals and organizations, in International Class 42.[2]

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark CHOICES (in typed form)[3] for "computer programs recorded on magnetic media and instruction manuals sold therewith" in International Class 9[4] as to be likely to cause confusion.[5]

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Discussion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (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 and/or

[2] Application Serial No. 85932617 was filed on May 15, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

[3] Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term "typed" drawing with "standard character" drawing. Applicants who seek to register a mark without any claim as to the manner of display must submit a standard character drawing that complies with the requirements of 37 C.F.R. §2.52(a).

[4] Registration No. 1288714, issued August 7, 1984; second renewal March 29, 2014.

[5] In addition to the goods in International Class 9, the cited registration covers services in International Class 42. These services are not relevant to this proceeding.

services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also*, *In re Dixie Restaurants Inc.,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity or Dissimilarity of Marks.

We start our analysis with the first *du Pont* factor, the similarity of the marks. In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Here, the marks are identical in appearance, sound, connotation and commercial impression and therefore, the first *du Pont* factor strongly favors a finding of likelihood of confusion.

B. Similarity or dissimilarity of the goods and services.

With this in mind, we look next at the second *du Pont* factor, the similarity of the goods and services. When determining the relationship of the goods,

> [i]t is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods [and service] as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods [and services], their channels of trade and/or classes of purchasers.

In re Total Quality Group Inc., 51 USPQ 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP,* 746 F.3d 1317, 110 USPQ2d 1157, 1161 - 1162 (Fed. Cir. 2014). The services as recited in the application are:

"providing temporary use of on-line non-downloadable software in the field of human resources that enables users to conduct online evaluation of leadership and managerial aptitudes, competencies, job performance and job development, learning agility, and skills for the purpose of implementing leadership development for individuals and organizations." The relevant goods in the cited registration are identified as "computer programs[6] recorded on magnetic media," and there is no limitation as to the kind of programs or the field of use. Accordingly, we must assume that registrant's goods encompass all such computer programs including those which may be intended for use in the field of human resources. *See In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000). Thus, the only question is whether services consisting of the temporary use of on-line non-downloadable software are related to the Registrant's computer programs (software) recorded on magnetic media. The Examining Attorney has established that they are.

"Magnetic media," which is also referred to as "magnetic storage" is defined as:

> any storage medium in which different patterns of magnetization are used to represent stored bits or bytes of information, 'the hard disk in you[r] computer is magnetic storage.'

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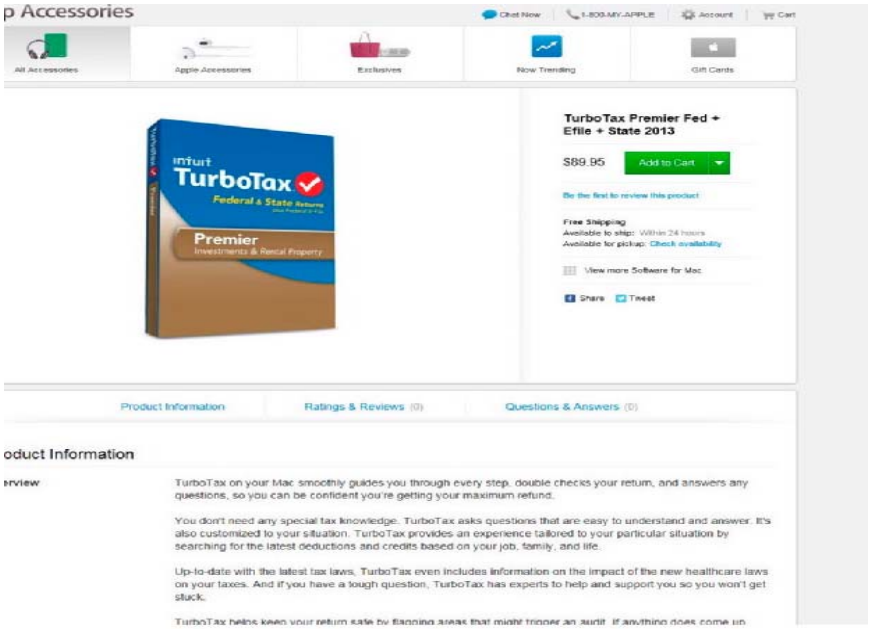
[6] "Computer programs" and "software" are synonymous. *See* definition of software from Merriam-Webster On-line Dictionary, http://www.merriam-webster.com/dictionary/software, © Merriam-Webster Incorporated.

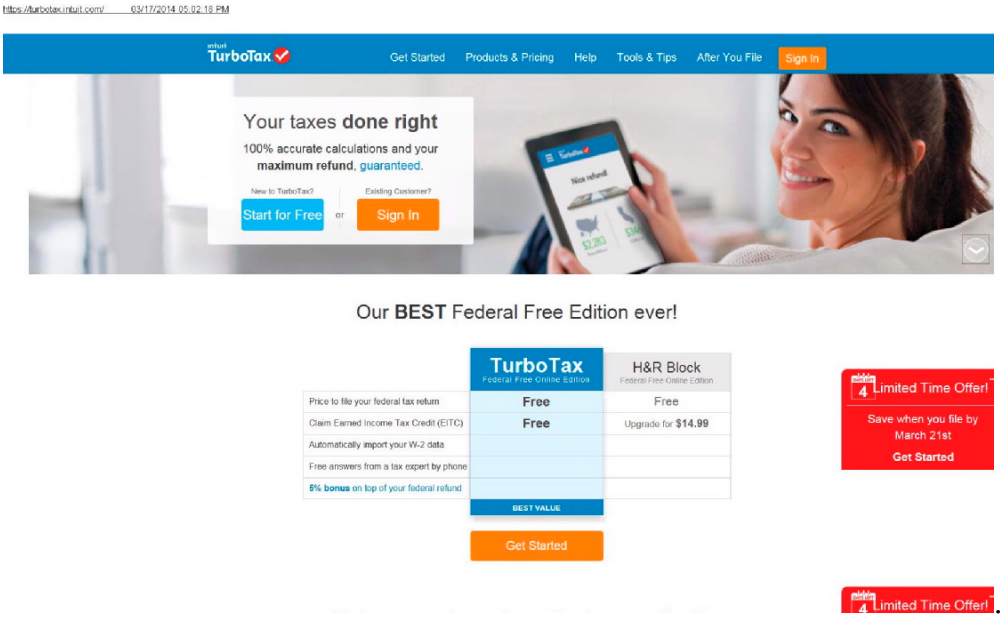
The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

The Free Dictionary by Farlex, http://www.thefreedictionary.com/ Magnetic+media, based on WordNet 3.0, © 2003-2012 Princeton University, Farlex Inc. CD-ROM disks are also magnetic storage. Chen, Peter P., Plesset, Michael, and Theis, Douglas J., "Computer Storage Technology," *AccessScience* (McGraw-Hill Education, 2014), http://www.accessscience.com/ content/computer-storage-technology/154000.[7] Accordingly, as identified, computer programs recorded on magnetic media encompass software recorded on CD-ROMs and software for downloading to hard disks. The Examining Attorney has introduced evidence that the same marks are used in connection with both software recorded on magnetic disks, e.g. CD-ROMs and non-downloadable software. The example set forth below evidences use of the mark TurboTax on software both in disk form and in non-downloadable on-line form:



and

[7] The Board may take judicial notice of information from encyclopedias. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.6 (TTAB 2011).



The Examining Attorney also submitted copies of five third-party registrations, each of which includes both downloadable software (Registrant's goods) and non-downloadable software (Applicant's services). While not an extensive display, these registrations serve to suggest that both Applicant's services and the goods in the cited registration are of a kind that emanate from a single source. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1934-1935 (TTAB 2012); *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Based on goods and services as identified in the application and registration, and the evidence, we find that the goods and services are closely related. This finding is consistent with Applicant's position. Applicant does not contend that computer programs recorded on magnetic media and non-downloadable software are not closely related, rather Applicant contends that the subject matter and the purposes

of the parties' software differ. However, since Registrant's goods are broadly identified and there is no restriction as to either subject matter or purpose, the second *du Pont* factor strongly favors a finding of likelihood of confusion.

C. Channels of trade/Sophistication of customers.

Focusing on extrinsic evidence, Applicant argues both that its services and Registrant's goods travel in different channels of trade and that the purchasers are sophisticated. However, as discussed we can only rely on the goods as identified and not on what "any evidence may show as to the actual nature of the goods [and services], their channels of trade and/or classes of purchasers." *In re Total Quality Group Inc.*, 51 USPQ at 1476; *Stone Lion Capital Partners, LP v. Lion Capital LLP,* 110 USPQ2d at 1161 – 1162. The same issue was decided in *In re N.A.D. Inc.*, 57 USPQ2d 1872 (TTAB 2000) wherein Applicant's goods were identified as "computer software for recording anesthesia-related data" and Registrant's goods were identified as "prerecorded computed programs recorded on tape, cards, or disks." Relying on the identifications of goods, the Board found that because there was no limitation as to the kind of programs or the field of use, the assumption must be made that

> Registrant's goods encompass all such computer programs, including those which may be intended for the medical field. As such, they may travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods. When the goods are so viewed, we believe that confusion is likely. Purchasers, even sophisticated purchasers, aware of [R]egistrant's SATURN software (presumed to be in the same field), who then encounter [A]pplicant's SATURN

> INFORMATION SYSTEM software are likely to believe that these goods come from the same source."

In re N.A.D. Inc., 57 USPQ2d at 1874 (internal citations omitted). Following our findings in the *N.A.D.* case, we find that Applicant's services and Registrant's goods (presumed to be in the same field) may also travel in the same channels of trade to the same class of customers. Moreover, when so viewed, even sophisticated customers are likely to be confused by Applicant and Registrant's use of the identical mark.

Accordingly, the third and fourth *du Pont* factors favor a finding of likelihood of confusion.

D. Actual Confusion.

Finally, Applicant contends that it has been using the marks CHOICES ARCHITECT and ECHOICES in connection with the services in the current application or goods and services related thereto for fifteen years without any instances of confusion. Applicant's argument is not persuasive. "In an ex parte appeal, the focus of the likelihood-of-confusion analysis must be the mark applicant seeks to register, not other marks applicant may have used or registered." *In re Cynosure Inc.,* 90 USPQ2d 1644, 1645 (TTAB 2009). The current application was based on an intent-to-use and Applicant has neither argued prior use of the mark CHOICES nor provided evidence thereof.

Moreover, the contemporaneous use of Applicant's and Registrant's marks without actual confusion is entitled to little weight, particularly in an ex parte context, where there is no opportunity for Registrant to indicate whether it has

experienced instances of actual confusion and because there is no indication that Registrant's and Applicant's goods have been offered in the same geographic areas. *See Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Accordingly, the seventh *du Pont* factor is neutral.

E. Conclusion.

We conclude, after considering all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, that there is a likelihood of confusion between Applicant's mark CHOICES for "providing temporary use of on-line non-downloadable software in the field of human resources that enables users to conduct online evaluation of leadership and managerial aptitudes, competencies, job performance and job development, learning agility, and skills for the purpose of implementing leadership development for individuals and organizations" and Registrant's mark CHOICES for "computer programs recorded on magnetic media."

Decision: The refusal to register Applicant's mark CHOICES is affirmed.