

This Opinion is
not a
Precedent of the
TTAB

Mailed: November 5, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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*In re Integrated Embedded
dba Barr Group*
—

Serial No. 86141386
—

Steven War of McNeely, Hare & War LLP,
for Integrated Embedded dba Barr Group.

April Roach, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

—
Before Seeherman, Bucher and Wellington,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Integrated Embedded, dba Barr Group, (“Applicant”) has appealed
from the final refusal of the Trademark Examining Attorney to
register the mark BG and design, as shown below, for

Expert witness services in legal matters in
the field of design of computer hardware,
integrated circuits, communications
hardware and software and computer

networks for others.” (International Class 45).¹



“The mark consists of a box including the right portion of a capital letter ‘B’ on the left and a portion of the small letter ‘g’ on the right top corner of the left section of the rectangle box.” Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration of the mark for the services in Class 45 on the ground of likelihood of confusion. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Examining Attorney’s position is that Applicant’s mark is so similar to the mark BG in the stylized form shown below, registered for “legal services,”² that as used with the expert witness services identified in Class 45, it is likely to cause confusion or mistake or to deceive.

¹ Application Serial No. 86141386, filed December 11, 2013, asserting first use and first use in commerce on March 9, 2012. The application also includes “IT training services; Training services in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others” in Class 41 and “Engineering services in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others” in Class 42; however, registration was not refused with respect to these classes and these classes and services are therefore not the subject of this appeal.

² Registration No. 3073394, issued March 28, 2006; Section 8 affidavit accepted; Section 15 affidavit received.



We reverse the refusal to register.

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).

Turning first to the *du Pont* factor of the similarity or dissimilarity of the services, the Examining Attorney has submitted evidence from various third-party websites to show that law firms offer both legal and expert witness services. The following excerpts are representative:

- Spencer Law Firm LLC
Expert Witness | Trust, Estate & Tax Matters (general heading with logo)
...
Spencer Law Firm LLC in Lancaster, Pennsylvania, is comprised of legal professionals dedicated to a single goal: meeting your estate planning and administration needs. Whether you are an individual needing to develop a complex estate plan, an attorney requiring an expert witness to aid in resolving a fiduciary dispute in court or an accountant searching for legal support to help your clients realize a strategy to minimize future tax burdens, Spencer Law Firm LLC³
- TollefsenLaw
Business Law and Litigation (general heading)
...

³ www.spencerlawfirm.com, March 20, 2014 Office action, p. 4.

We offer business law and litigation services in state and federal courts of Washington, Oregon and New York, nationwide fraud investigative services, and national expert witness services.

...

Expert Witness Services

Tollefsen Law has experienced lawyers who serve as expert witness on business law, securities law, and transportation law issues.

John J. Tollefsen

As an independent expert witness, John J. Tollefsen offers the ability to reduce complex fact situations to understandable testimony for a judge or jury.⁴

- **FORRY LAW GROUP (general heading)**
Civil & Real Estate Attorney
Expert Witness and Testimony
Plaintiff & Defendant Representation (heading)

...

Forry Law Group can provide the necessary analysis, consultation, representation or expert witness testimony for mediation, arbitration and trials in a wide variety of real estate matters and civil action.

Expert Witness (subhead)

Offering professional, effective expert witness testimony that may enhance your argument relative to your particular legal case.⁵

- **Law Offices of A. Lavar Taylor**
As accomplished attorneys in our respective fields, we are often asked to provide Expert Witness and Consultation Services for other attorneys, law firms, and their clients.⁶

The Health Law Firm (general heading)

Expert Witness Availability (subhead)

Attorneys at The Health Law Firm are also available for expert witness work. Areas in which our attorneys perform expert witness testimony include: [followed by a

⁴ www.tollefsenlaw.com, March 20, 2014 Office action, pp. 7, 8, 11.

⁵ <http://forrylaw.com>, March 20, 2014 Office action, p. 18.

⁶ <http://taylorlaw.com>, March 20, 2014 Office action, p. 21.

listing of areas, e.g., Health Law, Federal Regulations, Good Samaritan Law]⁷

- **THE KAMBER LAW GROUP**
Advancing the Law of Work (general heading)
Expert Witness Services in Social Media (heading)
In addition to representing clients in social media and related cases, we also provide assistance to lawyers, judges, and clients who already have counsel. ... We also can provide an expert witness to testify regarding social media and networking.⁸
- **SWANSON & Bratschun LLC**
Expert Witness (heading)
Swanson & Bratschun has assembled a collection of attorneys with outstanding credentials and a wealth of experience in patent and trademark prosecution, due diligence and licensing. This combination leaves our attorneys well postured to provide competent and credible expert testimony in these areas of practice. We have worked with trial counsel as co-counsel and understand the importance of honestly evaluating facts to determine our ability to provide forceful and persuasive testimony that can stand up to rigorous cross-examination.⁹

The evidence submitted by the Examining Attorney shows that a law firm may offer both legal services and expert witness services under the same mark. However, the consumers of expert witness services, by the nature of such services, are attorneys who would use such expert witnesses in the preparation and presentation of their cases. For example, as set forth in the above excerpts, the Spencer Law Firm characterizes its expert witness services as being directed to

⁷ www.thehealthlawfirm.com, October 14, 2014 Office action, p. 5.

⁸ www.kamberlawgroup.com, October 14, 2014 Office action, p. 8.

⁹ <http://sbiplaw.com>, October 14, 2014 Office action, p. 19.

attorneys: “[w]hether you are ... an attorney requiring an expert witness to aid in resolving a fiduciary dispute in court...”; Swanson & Bratschun LLC explains with respect to its expert witness services that “We have worked with trial counsel as co-counsel and understand the importance of ... evaluating facts to determine our ability to provide ... testimony that can stand up to rigorous cross-examination.” Moreover, the expert witness services offered by Applicant are of a very specific nature; they are limited to the field of “design of computer hardware, integrated circuits, communications hardware and software and computer networks for others.” The evidence of record does not show that expert witness services in this field are offered by the same entities that provide legal services; on the contrary, the law firm webpages indicate that the attorneys who provide expert witness services do so with respect to their areas of legal expertise, not the technical expertise involved in computer hardware and software.

Even if we could assume that it is typical for a law firm to provide both legal services and the specialized expert witness services identified in Applicant’s application, the only purchasers who are likely to encounter Applicant’s and the Registrant’s identified services and who would be consumers thereof would be attorneys who might have the need for an expert witness in Applicant’s field and also have a need for legal services (either as co-counsel or for assistance in an area of

practice with which they are not completely familiar). This one common class of consumers must be considered to be careful and sophisticated purchasers, who would pay attention to trademarks and notice differences between them.

With respect to the marks, the Examining Attorney points out that they both consist of the letters BG and contends that the cited mark is in minimally stylized type. Citing *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012), the Examining Attorney states that “when the word portions of marks are identical, the addition of a design element does not generally overcome the similarity as consumers often use the wording to refer to the goods and services.” Brief, 9 TTABVUE 4. Although the statement of law is correct, it is not directly applicable to the present case, because “the nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Applicant’s mark, in particular, “is in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.” *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 699 (CCPA 1980). As a result, we do not accept the Examining Attorney’s position that the marks “are nearly identical in sound, connotation, and commercial

impression.” Brief, 9 TTABVUE 4. Rather, we think that, in these particular circumstances, it is appropriate to give greater weight to the appearance of the marks in our consideration of whether the marks are similar.

Applicant goes into great detail in delineating the differences in the marks, e.g., Applicant’s mark has only incomplete letters (“a *portion* of an *uppercase* ‘B’ and a *portion* of a lower case ‘g,’” reply brief, 10 TTABVUE 2) that are separated from each other; the “G” is in lower case; and the letters appear in a box; while the cited mark has complete letters, and the “G” is capitalized.¹⁰ Although the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, *see Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012), in this case we consider many of the differences in the marks to be significant. In particular, the “B” in Applicant’s mark is very prominent; it is much larger than the lower case letter “G,” taking up the entire height of the surrounding rectangular background, while the “G,” because of its size and placement, plays a more subordinate role in

¹⁰ Applicant also claims that in the cited mark, “the upper portion of the *capital* G passes through the lower circular portion of the *capital* B.” Brief, 7 TTABVUE 7 (emphasis in original). Apparently Applicant’s comment was directed to the mark as it was originally registered. However, on December 3, 2011, prior to the filing date of Applicant’s application and therefore prior to anything that occurred during examination, a Section 7 amendment to the registration issued to show the mark in the form in which it appears in our decision.

the commercial impression of the mark. Contrasted with this, the capital “G” in the cited mark is larger than the “B,” being approximately twice as wide, and therefore the “G” plays a more prominent role. The result is that the marks are different in appearance, and this difference causes them to have somewhat different commercial impressions. Given the care with which Applicant’s and the Registrant’s services will be chosen by the attorneys who are the relevant purchasers of both services, we find that these differences are enough to distinguish the marks.

We also consider the *du Pont* factor of the extent of potential confusion and find it to favor Applicant’s position. The potential consumers for both Applicant’s and the Registrant’s services are rather limited, consisting of attorneys who would be in need of both legal services and expert witness services in legal matters in a very specific field (“computer hardware, integrated circuits, communications hardware and software and computer networks for others”).

With respect to the remaining *du Pont* factors for which Applicant and the Examining Attorney have submitted evidence or argument, we treat them as neutral, for the following reasons. First, we agree with Applicant that there is no evidence of fame of the Registrant’s mark.

Second, with respect to the *du Pont* factor of the number and nature of similar marks in use on similar goods/services, Applicant has

submitted a number of third-party registrations for marks described as consisting of the letters “B” and “G.” Third-party registrations are not evidence that the marks shown therein are in use. Further, some of these special form marks convey significantly different commercial impressions from Applicant’s mark and the cited mark. Moreover, most of the registrations are for goods and services that are very different from those at issue herein. (As noted, the *du Pont* factor refers to use on *similar* goods and services.) For example, Reg. No. 4486252 is for golf gloves; Reg. No. 4391788 is for restaurant services; Reg. No. 4118643 is for bail bonding. Applicant contends in its brief that “6 are in the same class” as the cited registration, 7 TTABVUE 10, but the services are quite different: Reg. No. 3893374 is for computer aided graphic design; Reg. No. 3034480 is for architectural design services, interior planning and design services, and building site and building facilities planning services; Reg. No. 3814849 is for, *inter alia*, computer services, namely, maintaining a database pertaining to aspects of an international energy production and distribution company and Reg. No. 1887647 is for funeral home services. Two of the registrations are for goods: Reg. No. 1878202 is for metal fastening devices, namely, nuts, bolts, studs and threaded rods, and Reg. No. 1030422 is for automotive chemicals, cooling system cleaners and carburetor cleaners, and automotive lubricants, motor oils, etc. In

short, even if these third-party registrations could be treated as showing use of the marks therein (which they cannot be), they do not show use of similar marks for similar goods and services, and therefore do not show that the cited registration is weak. Further, although in some instances third-party registrations can show the sense in which a mark is used in ordinary parlance, or that an element common to marks may have a normally understood and well-recognized descriptive or suggestive meaning, *see Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015), that is not the case here, since there are no third-party registrations for BG marks for similar services. Although we can assume that Applicant's mark was derived from the initials of its dba, Barr Group, and that the cited mark was derived from the initials of the Registrant, Bracewell & Giuliani, there is nothing in the record to show that "BG" has a meaning in general for legal services or expert witness services.

Third, although there is no evidence of instances of actual confusion, we cannot treat this factor as favoring Applicant. As of the close of examination, there was only a three-year period of contemporaneous use, and there is insufficient information for us to conclude that there has been an opportunity for confusion to occur, if it were likely to occur. Moreover, Applicant's uncorroborated statements

of no known instances of actual confusion are of little evidentiary value. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205.

Conclusion

Because of the care and sophistication of the purchasers of both types of services, the specific differences in the marks and their overall appearance and commercial impression, and the lack of evidence that expert witness services for the field identified in Applicant's application are also offered by entities that offer legal services, we find that the record does not support a finding of likelihood of confusion.

Decision: The refusal to register Applicant's mark BG and design is reversed.