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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86141386

MARK: B G



CORRESPONDENT ADDRESS:

STEVEN WAR

MCNEELY HARE & WAR LLP

5335 WISCONSIN AVENUE NW SUITE 440

WASHINGTON, DC 20015-2079

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Integrated Embedded

CORRESPONDENT'S REFERENCE/DOCKET NO:

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CORRESPONDENT E-MAIL ADDRESS:

steve@miplaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant appeals the trademark examining attorney's refusal to register the applied-for mark consisting of the lowercase letters "B" and "G" in a box in International Class 45 based on

a likelihood of confusion with the mark "BG" in U.S. Registration No. 3073394 under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

FACTS

Applicant applied-to register a design of the lowercase letters "B" and "G" within a box for the services "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" in International Class 45.¹ Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on a likelihood of confusion with U.S. Registration No. 3073394 for the mark "BG" in minimally stylized type for "legal services." This appeal follows the Examining Attorney's final refusal of registration and denial of reconsideration.

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)).

The two key considerations in determining whether a likelihood of confusion exists are the similarity of the marks and similarity or relatedness of the services. *Syndicat Des*

¹ 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 International 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 International Class 42. The refusal to register is limited to International Class 45 only.

Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012).

A. Similarity of the Marks

The applied-for mark is comprised of the letter "B" followed by the letter "G" in a box and the registered mark is the letters "BG" in minimally stylized type. The marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). In this case, the marks are similar in all aspects.

Both marks include the letter "B" followed by the letter "G" and thus are nearly identical in sound, connotation, and commercial impression. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). 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. *See, e.g., In re Viterra*, 671 F.3d at 1366, 101 USPQ2d at 1911; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010).

Applicant focuses on minor differences between the marks, 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 terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective 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); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Applicant has submitted printouts of third-party registrations to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont*, 476 F.2d at 1361, 177 USPQ at 567.

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*,

90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Furthermore, the services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the services at issue. See, e.g.:

- U.S. Registration No. 0298486 is for spur gears, worm gears and worms therefor; miter gears, spiral gears, spiral miter gears, non-metallic gears, change gears, internal gears, bevel gears, racks and pinions therefor,
- U.S. Registration No. 1423371 is for food distributorship services,
- U.S. Registration No. 1542451 is for musical instruments, parts and accessories therefor, namely, ligatures for saxophones and clarinets; cords for saxophones, clarinets, guitars and other portable musical instruments, intermediate members to be disposed between the supporting cord and the body of a clarinet or of a saxophone; stands for clarinets, saxophones, trumpets, flugel horns, cornets and guitars; holders for securing a microphone to a musical instrument; music stands; cases for musical instruments; bags for carrying musical scores,
- U.S. Registration No. 2984562 is for music education and entertainment services, namely music instruction, music composition for others, music transcription for others, music production, music publishing, and providing a web site featuring pre-recorded and live musical performances,
- U.S. Registration No. 4040210 is for business risk assessment services, namely, providing business advice and evaluation of financial statements for purposes of surety bonding brokerage for contractors and construction companies; Providing surety bonding brokerage services and procuring surety bonding credit for contractors and construction companies, and
- U.S. Registration No. 4391788 is for restaurant, bar, catering, and carry-out restaurant services.

Applicant has not referenced a single registration on its list that is for the services specified in either the application or the registration. Applicant specifically lists six registration numbers as including International Class 42 services, none of which are expert witness or legal services, and two of the registrations are for goods and do not include any services in International Class 42. See the following:

- U.S. Registration No. 3893374 is for computer aided graphic design,

- U.S. Registration No. 3034480 is for architectural design services, interior planning and design services, and building site and building facilities planning services,
- U.S. Registration No. 3814849 is for testing of the efficiency of operation of appliances and the safety checking of appliances and pipework; scientific, engineering and environmental research and development services; geophysical and geological surveys services; exploration and production of gas and oil; underwater exploration; land surveying services; computer services, namely, maintaining a database pertaining to aspects of an international energy production and distribution company, namely, geophysical exploration of fuel sources; designing computer software for others, computer programming services for others; testing of gas appliances, pipework, apparatus, and instruments utilizing gas, inspection of pipelines; testing of gas appliances, pipework, apparatus and instruments utilizing gas,
- U.S. Registration No. 1887647 is for funeral home services,
- U.S. Registration No. 1878202 is for metal fastening devices; namely, nuts, bolts, studs and threaded rods in International Class 6, and
- U.S. Registration No. 1030422 is for automotive chemicals-namely, gasoline additives, automotive coolants and antifreeze, cooling system sealers, rust inhibitors, sealers for electrical wiring and electrical terminals and motor oil additives; cooling system cleaners and carburetor cleaners; automotive lubricants, motor oils, transmission and gear lubricants, and penetrating oils in International Classes 1, 3 and 4.

Thus, the third party registrations have no probative value as to the dilution or weakness of the use of the letters "BG" in connection with the services of applicant or registrant in this case.

B. Relatedness of the Services

Applicant's "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" are related to the "legal services" in the registration as shown by the third party website evidence of record. Services are related if the evidence of record shows that they are provided in a manner that could give rise to the mistaken belief that they come from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

The evidence of record shows that legal services and expert witness are commonly offered together by the same entity, under the same mark, and in the same channels of trade. Evidence of relatedness includes material showing the services advertised and provided together by the same source. *In re Davey Prods.*, 92 USPQ2d at 1202 (TTAB 2009). The following evidence of record shows legal and expert witness services provided together:

- <http://www.spencerlawfirm.com>: firm providing expert witness services and attorney services (attached to the March 20, 2014 office action),
- <http://www.tollefsenlaw.com>: offering "Legal, investigative, and Expert Witness Services" (attached to the March 20, 2014 office action),
- <http://forrylaw.com>: law group providing legal services and expert witness services in civil matters (attached to the March 20, 2014 office action),
- <http://taylorlaw.com>: law office providing expert witness and legal services (attached to the March 20, 2014 office action),
- <http://www.thehealthlawfirm.com>: attorneys providing legal services and expert witness testimony in a variety of fields (attached to the October 14, 2014 office action),
- <http://www.kamberlawgroup.com>: social media and internet legal services and expert witness services (attached to the October 14, 2014 office action),
- <http://www.milesstockbridge.com>: intellectual property and technology attorneys also providing expert witness services (attached to the October 14, 2014 office action),
- <http://sbiplaw.com>: electrical and computer technology legal services and expert witness services (attached to the October 14, 2014 office action),
- <http://www.pattishall.com> litigation attorneys and expert witness services in intellectual property matters (attached to the October 14, 2014 office action), and
- <http://adlerlawgroup.com>: expert witness and legal services in the insurance field (attached to the October 14, 2014 office action).

This evidence shows the services of applicant and registrant are related as they are of a type that originate from the same source, are used by the same consumers, and serve complimentary purposes. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Applicant contends that its review of registrant's website does not show that registrant provides expert witness services. As set forth in the May 11, 2015 denial of reconsideration, applicant has failed to make any evidence to support this contention properly of record, and thus it should not be considered. *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012).²

C. Other Factors in Evaluating Likelihood of Confusion

1. Sophisticated Consumers are not Immune from Source Confusion

Applicant argues that it is "beyond dispute" that purchasers are sophisticated, however, 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, especially in a case of very similar marks and related goods and services. *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986).

2. Evidence of Fame Not Relevant

Applicant contends the USPTO has not offered evidence of fame of the registered mark. No such evidence is required. Fame of a registered mark is not generally considered significant in an ex parte proceeding, nor is an examining attorney expected to submit such evidence. *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006).

3. Evidence of Actual Confusion Not Relevant

Applicant's statement that it is unaware of any actual confusion is not relevant. 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.*

² Even if such evidence was properly of record, it is well established that the services of the parties need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). The issue is whether the services are related, and the evidence of record establishes such relatedness.

Kappa Books, Inc., 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). In an ex parte proceeding there is no evidence from which to ascertain whether there has been opportunity for confusion to arise, and the registrant does not have an opportunity to be heard on the issue. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Thus, given the similarity between the registered mark BG, and the applied-for mark "B" and "G" in a box for related services, there is a likelihood of confusion as to the source of the services and the refusal to register should be affirmed.

CONCLUSION

For the foregoing reasons, the refusal to register in International Class 45 because of a likelihood of confusion with U.S. Registration No. 3073394 under Trademark Act Section 2(d) should be affirmed

Respectfully submitted,

/April Roach/

Trademark Examining Attorney

Law Office 115

(571) 272-1092

april.roach@uspto.gov

John Lincoski

Managing Attorney

Law Office 115

