

This Opinion is Not a
Precedent of the TTAB

Mailed: February 26, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re The Jacob D. Fuchsberg Law Firm, LLP

Serial No. 87843998

Marina A. Lewis of Lewis Kent LLP
for The Jacob D. Fuchsberg Law Firm, LLP.

Katherine S. Chang, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Mermelstein, Adlin and Heasley, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant The Jacob D. Fuchsberg Law Firm, LLP seeks a Principal Register
registration for the mark JACOB FUCHSBERG LAW FIRM in the form shown below



(LAW FIRM disclaimed) for: “legal services; legal services, namely, providing
customized documentation, information, counseling, advice and consultation services
in all areas of plaintiffs tort litigation, including medical malpractice, personal injury,
World Trade Center victim compensation fund, class actions, products liability,
construction and labor law, civil rights and prisoners' rights” in International Class

45.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the two previously registered and commonly owned marks shown below



(LAW, COLLEGE and LAW CENTER disclaimed in each), both for, *inter alia*, “legal services” in International Class 45, that use of Applicant's mark in connection with Applicant's services is likely to cause confusion. After the refusal became final,

¹ Application Serial No. 87843998, filed March 21, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use dates of June 1, 1983. The application indicates that the name shown in the mark “does not identify a particular living individual,” and includes this description of the mark: “The mark consists of the wording ‘JACOB FUCHSBERG’ above the stylized wording ‘LAW FIRM’. A horizontal line appears to the left and right of the wording ‘LAW FIRM’.”

² Registration No. 5034800, issued September 6, 2016. This registration also identifies services in Class 41, indicates that the name shown in the mark “does not identify a particular living individual,” and includes this description of the mark: “The mark consists of the words ‘TOURO LAW’ in capital letters to the right of the capitalized letter ‘T’ and above the wording ‘TOURO COLLEGE JACOB D. FUCHSBERG LAW CENTER’. ‘TOURO COLLEGE’ is above ‘JACOB D. FUCHSBERG’ which is above the wording ‘LAW CENTER’. The ‘T’ contains part of the crown, the torch, and part of the arm of the Statue of Liberty.”

³ Registration No. 5034799, issued September 6, 2016. This registration also identifies goods in Classes 6, 16, 20, 21, 22 and 25 and services in Classes 35 and 41, indicates that the name shown in the mark “does not identify a particular living individual,” and includes this description of the mark: “The mark consists of the words ‘TOURO LAW’ in capital letters to the right of the capitalized letter ‘T’ and above a shaded rectangle containing the words ‘TOURO COLLEGE JACOB D. FUCHSBERG LAW CENTER’. The ‘T’ contains part of the crown, the torch, and part of the arm of the Statue of Liberty.”

Applicant appealed and filed a request for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *duPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The Services, Channels of Trade and Classes of Consumers

The involved application and cited registrations each identify “legal services.” Where, as here, the services are identical, we presume that the channels of trade and classes of purchasers for those services are also the same. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where

there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The identity of the services and their overlapping channels of trade and classes of consumers weigh in favor of finding a likelihood of confusion. In addition, where, as here, the services are identical, the degree of similarity between the marks necessary to find a likelihood of confusion declines. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

B. The Marks

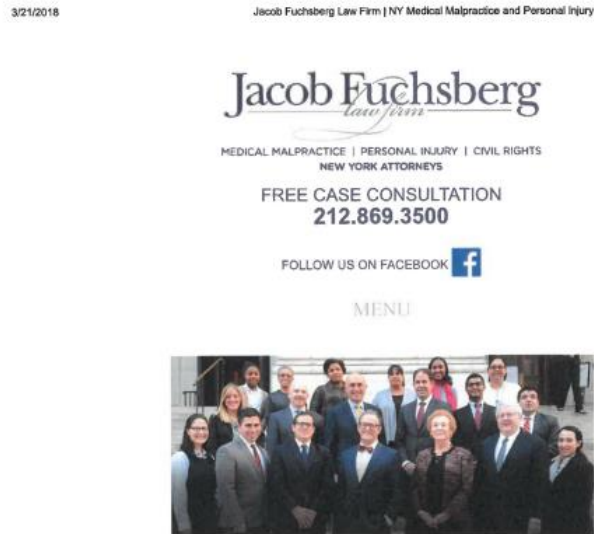
Before considering the marks we should point out that the record in this case does not include any evidence.⁴ Nonetheless, Applicant asserts in its Appeal Brief that

... the name Jacob Fuchsberg – as shown in both Applicant’s Mark and the Cited Marks – is a reference to the late Jacob D. Fuchsberg. Mr. Fuchsberg was a, [sic] prominent New York attorney, national trial attorney, and Judge of the Court of Appeals of the State of New York, as well as a founder of the Jacob Fuchsberg Law Firm since approximately 1980. In addition, the late Mr. Fuchsberg assisted in the establishment of the law school at Touro College, which was named in his honor as “Touro College Jacob D. Fuchsberg Law Center.”

6 TTABVUE 4. We accept this representation in part because the Examining Attorney does not dispute it. Furthermore, it is supported, at least to some extent, by

⁴ Applicant of course submitted a specimen, but that is not particularly illuminative for our purposes.

Applicant's specimen, which reveals promotion by a law firm using the involved mark:



And as explained in more detail below, Applicant's representations are supported by the involved and cited marks themselves. In any event, even if we did not accept Applicant's representations, our ultimate decision in this case would be no different.

We consider the marks "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Here, the marks are similar because they both contain the name Jacob Fuchsberg,⁵ and different because, unlike Applicant's mark, Registrant's includes a large and distinctive statue of liberty design within a large capitalized "T," the words TOURO LAW presented above and in much larger letters

⁵ While Registrant's mark includes the middle initial "D" and Applicant's mark does not, this minor difference is insignificant, especially in the absence of any evidence that other marks used for legal services or related goods or services include the name Jacob Fuchsberg.

than the name Jacob D. Fuchsberg, and the words “Touro College” and “Law Center” all of which are absent from Applicant’s mark. The marks are also different because Applicant’s mark includes the stylized words “Law Firm” in the center of a horizontal line, features which are absent from Registrant’s mark. We conclude that these differences outweigh the relatively minor similarities.

Most significantly, both of Registrant’s marks are dominated by the large Statue of Liberty design within an even larger solid black “T,” with the “T” clearly referencing the “t” in TOURO LAW, which also appears in large letters first and at the top of Registrant’s marks. These words, the initial “T” and the Statue of Liberty design immediately catch the eye and directly convey the essence of the mark (“TOURO LAW”). Thus, consumers encountering Registrant’s marks would be significantly more impressed by and likely to remember “TOURO LAW” than any of the marks’ other features, including “JACOB D. FUCHSBERG.”

Indeed, it is clear from the marks’ context and presentation that Mr. Fuchsberg was a founder or supporter of, or prominent donor or contributor to, Touro College’s Law Center. That is, it is both well-known and common sense that formulations such as “Touro College Jacob D. Fuchsberg Law Center” are primarily intended to identify the Law Center as Touro College’s, and Mr. Fuchsberg as one of the Law Center’s honorees. For consumers or potential consumers of Registrant’s legal services, however, the takeaway is that Touro College’s Law Center will provide the legal services rather than Mr. Fuchsberg. In fact, even consumers who are aware that Mr. Fuchsberg was a prominent lawyer would be likely to believe this, because of the

dominance of TOURO LAW in the mark. That dominance reveals Touro Law as the source of the services, while “Touro College Jacob D. Fuchsberg Law Center” (in small print and a subordinate position) reveals that Touro chose to honor Mr. Fuchsberg by naming its Law Center, which provides the services, after him. The record provides no reason to assume that consumers would expect Mr. Fuchsberg to provide Registrant’s identified legal services himself, any more than they would expect Leland Stanford Jr. to provide Stanford University’s educational services. This is true even of consumers who know Mr. Fuchsberg as a lawyer. In other words, it is the mark itself, its context and how it is presented that conveys that the Touro College Law Center provides the identified legal services.

The meaning conveyed by Registrants’ marks is quite different than the meaning conveyed by Applicant’s mark. In Applicant’s mark, the provider of the identified legal services is a “LAW FIRM” called the JACOB FUCHSBERG LAW FIRM.⁶ It is widely known that law firms are often named for one or more of their partners, and this convention is not just limited to the law. Many businesses are named for owners or founders, and this is so often the case that consumers would understand that when a personal name is used as a business name, the named person is or was likely

⁶ While the terms LAW, COLLEGE and LAW CENTER are descriptive and disclaimed, we may not ignore them, and they still factor into our likelihood of confusion analysis. *See In re Vittera*, 101 USPQ2d at 1912 (citations omitted) (“we previously have found that the dominant portion of a composite word and design mark is the literal portion, even where the literal portion has been disclaimed”); *In re Shell Oil Co.*, 992 F.2d 11204, 26 USPQ2d 1687 (Fed. Cir. 1993) (“Shell’s argument that the only consideration is the ‘design form’ of the words ‘Right-A-Way’, omitting the words ‘right-a-way’ because they were disclaimed, was correctly rejected by the Board.”).

affiliated with the business. In this case, there is really no other conclusion to draw, because JACOB FUCHSBERG has no meaning other than as a personal name, and the law firm in question could not be found or identified by any means other than the name JACOB FUCHSBERG. Thus, consumers would perceive that Mr. Fuchsberg provides, or at one time provided, legal services on the law firm's behalf, or that he otherwise played a principal role in providing those services.

While we would fully expect many consumers exposed to both Applicant's and Registrant's marks to believe that they identify the same Jacob Fuchsberg, that would not lead to confusion under these circumstances. Instead, these consumers would understand, from the marks alone, that Mr. Fuchsberg founded or is or was otherwise affiliated with a law firm that provides legal services, that he also contributed in some way to Touro's Law Center, and that those contributions were so valuable that the school honored him by naming its Law Center after him.

The marks do not only differ in meaning. As alluded to above in our finding that the large, solid "T" surrounding the Statue of Liberty design and the words TOURO LAW are the dominant features of Registrants' marks, the marks look completely different. In addition to the appearance and presentation of the cited marks' dominant portions, Registrant's marks each contain five words, which Applicant's mark does not. And while the most noticeable portion of Applicant's mark is JACOB FUCHSBERG, the most noticeable portion of Registrant's marks is TOURO LAW and the T and Statue of Liberty design.

The marks also sound completely different, notwithstanding that they each include JACOB, FUCHSBERG and LAW. In fact, the first and source identifying portion of Applicant's mark is pronounced "JACOB FUCHSBERG," while the first and source identifying portion of Registrant's marks is "TOURO LAW," followed immediately by "TOURO COLLEGE."

Finally, the marks' commercial impressions are different. Although both marks are used to identify legal services, consumers will immediately perceive Applicant's mark as identifying a law firm, and Registrants' marks as identifying a law school. While the "Jacob D. Fuchsberg Law Center" portion of Registrants' marks could, standing alone, perhaps identify an organization akin to a law firm, that portion of the mark does not stand alone. It is instead part of the whole, and a small part at that, subordinate to the essence of the mark, TOURO LAW and design. In this context, where it is apparent that the TOURO LAW identified prominently in the mark is part of TOURO COLLEGE, also identified in the mark, the phrase "Touro College Jacob D. Fuchsberg Law Center" appears to be merely the name of Touro College's law school, also known as TOURO LAW. Consumers are likely to perceive it as the more complete or formal name of the entity commonly or more informally known as TOURO LAW. As Applicant indicates, "Mr. Fuchsberg assisted in the establishment of the law school at Touro College, which was named in his honor as 'Touro College Jacob D. Fuchsberg Law Center.'" 6 TTABVUE 4.⁷

⁷ The Examining Attorney's argument that TOURO LAW and TOURO COLLEGE "are essentially house marks," 8 TTABVUE 7, is unsupported by any evidence. Moreover, even if

II. Conclusion

The essence of Applicant's mark is JACOB FUCHSBERG while the essence of Registrants' marks is TOURO LAW. When considered in their entirety, the marks look and sound different, convey different meanings and create different commercial impressions. The marks are so different that confusion is unlikely even though the marks are used for identical services which travel in the same channels of trade to the same consumers. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.").

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is reversed.

we agreed that these are house marks, that would not change the appearance, sound, meaning or commercial impression of Registrants' marks, or our conclusion that the marks are dissimilar.