

This Opinion is not a
Precedent of the TTAB

Oral Hearing: February 9, 2022

Mailed: March 31, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re J. Spagnuolo & Associates, P.C.
—

Serial No. 88789548
—

Dean W. Amburn of Amburn Law PLLC,
for J. Spagnuolo & Associates, P.C.

Kyle Ingram, Trademark Examining Attorney, Law Office 125,
Heather Biddulph, Managing Attorney.

—
Before Lykos, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

J. Spagnuolo & Associates, P.C. (“Applicant”) seeks registration on the Principal



Register of the mark **MACOMB LAW GROUP** (“Macomb Law Group”
disclaimed) for:

Legal services; Providing customized legal information, counseling, and advice, and litigation services in the field of tort law in International Class 45.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on likelihood of confusion with the mark MLG AUTOMOTIVE LAW (in standard characters, "automotive law" disclaimed) for:

Legal consultation services; Legal consulting services in the field of automotive related legal cases; Legal services in International Class 45.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. An oral hearing was held.

We reverse the refusal to register.

¹ Application Serial No. 88789548 was filed on February 7, 2020, based upon Applicant's claim of September 1, 2017 as its first use anywhere date and January 30, 2018 as its first use in commerce date under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). As described in the Application, "the mark consists of the stylized literal element 'MLG' overlaid by the scales of justice design with MACOMB LAW GROUP written below the scales of justice design. The letter L is positioned in the middle of M and G and it is slightly lower than M and G. The scales of justice include a horizontally curved beam that is resting on the top portion of the L as its central pivot point and it is extended over the center of the M and G. Scales are seen hanging from the ends of the curved beam proximate to the M and G. Color is not claimed as a feature of the mark."

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; after this designation are the page references, if applicable. Applicant's brief is at 6 TTABVUE. The Examining Attorney's brief is at 8 TTABVUE. Applicant's reply brief is at 9 TTABVUE.

² Registration No. 4699169, issued March 10, 2015; Section 8 accepted and Section 15 acknowledged.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address a few evidentiary matters.

The Examining Attorney objects to consideration of third-party registrations attached to Applicant's appeal brief as exhibit B. These registrations were not submitted during prosecution.

Because the third-party registrations in exhibit B were not previously submitted, the Examining Attorney's objection is sustained and the third-party registrations in exhibit B will not be considered. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (evidence "submitted with Applicant's appeal brief that Applicant did not previously submit during prosecution is untimely and will not be considered."), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019)). *See also* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.").

Applicant also submitted with its appeal brief third-party registration evidence (exhibit A) and website evidence (exhibit C) that it already provided in its October 28, 2020 Response to Office Action at TSDR 8-35. While obviously admissible, the Board discourages this practice. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) ("[T]he Board discourages attaching such material to briefs. ... [I]t is far more helpful to identify, by the date of submission and the page numbers in the Office's [TSDR] database, the material which is referred to in a brief."); *In re Thor Tech Inc.*,

85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from the record to a brief is duplicative and unnecessary).

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *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.”). These factors and others for which there is evidence and argument are discussed below.

A. Similarity or Dissimilarity of the Services

We first consider the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. *See also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d

1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). The goods or services 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, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods [or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). It is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified goods or services within that class in the application or cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

During prosecution and in its brief, Applicant argued that the legal services are different because Applicant is providing tort law services and Registrant’s legal services focus on automotive law. 6 TTABVUE 22.

Applicant’s services are identified as “Legal services; Providing customized legal information, counseling, and advice, and litigation services in the field of tort law,” and Registrant’s services are identified as “Legal consultation services; Legal consulting services in the field of automotive related legal cases; Legal services.”

Applicant’s and Registrant’s “legal services” are legally identical. Registrant’s “legal consultation services” encompass Applicant’s more narrowly defined

“customized legal information, counseling and advice” services in the field of tort law. Additionally, as the Examining Attorney argues, and the website evidence shows, tort law includes personal injury law, and this type of law addresses automobile accidents that have resulted in injury. November 25, 2020 Office Action at TSDR 2-139. Thus, Applicant’s legal counseling and advice in the field of tort law encompass Registrant’s more narrowly defined automotive law legal consulting services. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein). Because we find the services are legally identical, the second *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Similarity or Dissimilarity of the Trade Channels

We next turn to the third *DuPont* factor which requires us to consider “the similarity or dissimilarity of established, likely-to-continue trade channels.” We compare the trade channels and classes of consumers for the services as identified in the involved application and cited registration. *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Because Applicant’s and Registrant’s legal services are legally identical, we presume that these services will move in the same trade channels to the same classes of purchasers, namely, consumers of legal services. *See In re Viterra Inc.*, 671 F.3d

1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *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).

In view of the overlapping trade channels and classes of purchasers, the third *DuPont* factor weighs in favor of a finding of likelihood of confusion.

C. Strength of the Mark

Because the strength or weakness of the cited mark informs our comparison of the marks, we address Applicant's arguments that MLG in the cited mark is weak and entitled to a narrow scope of protection.

In determining the strength of a mark, we first consider its inherent strength, based on the nature of the mark itself. *New Era Cap. Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011). Suggestive, arbitrary and fanciful marks are deemed inherently distinctive. *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992). Inherent distinctiveness does not extend to disclaimed, and therefore, admittedly descriptive, components of the registered mark. *See In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1275 (TTAB 2016) (there is no inherent or acquired distinctiveness in a disclaimed term in a registered mark). The cited mark issued on the Principal Register without a showing of acquired distinctiveness in part under Section 2(f) of the Trademark Act. Accordingly, we must presume that the MLG portion of the mark is inherently distinctive. *See New Era Cap Co.*, 2020 USPQ2d 10596, at *10 ("Opposer's mark is inherently distinctive as

evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.”).

Applicant argues that the cited mark is weak because MLG is commonly used, referencing third-party registrations, and citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) as support for the point that when there is widespread third-party use of similar marks in the marketplace, “customers have been educated to distinguish between different such marks on the bases of minute distinctions.” 6 TTABVUE 14. We note that third-party registration evidence goes to conceptual weakness, while third-party use evidence goes to commercial weakness. See *Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017). Third-party registrations are not evidence of use in the marketplace or public familiarity with the third-party marks. See *AMF Inc. v. Am. Leisure Prod., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). In this case, Applicant did not submit any evidence of third-party use in the marketplace.

This leaves us with evaluating the cited mark’s conceptual strength. Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d at 1674-75. In other words, “[t]hird party registrations are

relevant to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.* at 1675 (internal quotation marks omitted). *See also Jack Wolfskin*, 116 USPQ2d at 1136.

Applicant points to “several prior registrations [that] include the letters ‘MLG’ for goods and services and are not limited to legal services.” 6 TTABVUE 14. However, as we stated above, we have excluded this evidence because it was not timely submitted. In any event, third-party registrations for non-legal services have very little, if any, probative value on the issue of the weakness of the cited mark. *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”).

Applicant also relies on third-party registrations for marks that do not contain MLG as evidence that “[t]he USPTO has routinely registered overlapping use-based registrations in Class 45 featuring initials of a law firm’s partners, or geographic place or location with a term or terms disclaimed.” 6 TTABVUE 11. October 28, 2020 Response to Office Action at TSDR 9-29 (e.g., FLG and FLG FILIPINO LAW GROUP; PATHFINDER INJURY LAW and PATH LAW GROUP; SHE LAW and SHE WINS LAW; M LAW, M MESH LAW, M MOSTYN LAW; LAW LIONS, 1-800-LION-LAW). Applicant argues that “[t]he third-party registrations are relevant and provide evidence of the USPTO’s pattern and practice of registering marks for legal services

on the Principal Register where the mark[s] share three non-disclaimed letters.” 6 TTABVUE 14.

However, the Board previously has found this type of third-party registration evidence is not probative. *In re Joel Embiid*, 2021 USPQ2d 577, at * 35-38 (TTAB 2021) (third-party registrations used to show current peaceful coexistence of registrations for identical or substantially similar marks by separate entities for shoes and clothing for “paired” COBRA and SOLE marks were so different from the involved marks TRUST THE PROCESS that the Board found the evidence has no probative value); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (evidence that six pairs of similar marks for MRI and ultrasound equipment registered that are “so different” from the marks at issue found not relevant.). As the third-party registrations Applicant submitted do not include the initialism MLG, we do not find them probative.

Because Applicant’s evidence does not establish commercial or conceptual weakness of the MLG portion of the cited registration, we accord it “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

D. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor that requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691

(Fed. Cir. 2005) (quoting *Dupont*, 177 USPQ at 567). The test, under the first *DuPont* factor, is not whether the marks can be distinguished when subjected to 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 services offered under the respective marks is likely to result. See *Coach Servs.*, 101 USPQ2d at 1721. While the marks must be considered in their entirety, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 224 USPQ at 751.



Applicant’s mark is **MACOMB LAW GROUP** (“law group” disclaimed). Registrant’s mark is **MLG AUTOMOTIVE LAW** (“automotive law” disclaimed).

We find that MLG is the dominant portion of Registrant’s mark because MLG is the first term in the mark and the wording that follows is at least highly descriptive

of the services and has been disclaimed. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018). As to Applicant's mark, we find that although MACOMB LAW GROUP is disclaimed, it is the dominant portion of Applicant's mark, with this wording reinforced by the scales of justice design, symbolizing the law. The MLG element, although somewhat larger, is partially obscured by the design, with the bold letters "M" and "G" being more prominent than the not bold letter "L," which has been placed in a lower position than "M" and "G," as it is being used as the central pivot point and base for the scales of justice, making it less likely that consumers will recall the MLG element. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (finding GIANT dominant part of mark GIANT HAMBURGERS and design even where GIANT disclaimed).

The marks are similar in appearance to the extent that they both share the initialism MLG and the term LAW. The marks otherwise are different in appearance as Applicant's mark has a design and the additional terms MACOMB and GROUP, while Registrant's mark includes the term AUTOMOTIVE. We find the marks are more dissimilar than similar in appearance.

As to sound, the marks are similar to the extent that both include the letters MLG and the term LAW but are otherwise different in sound due to the additional words used with them. For the reasons previously stated, in calling for the services, consumers are more likely to remember MACOMB LAW GROUP than MLG. We find the marks are dissimilar in sound.

In terms of connotation, we find the marks are dissimilar when viewed in their entirety. The letters MLG in Applicant's mark clearly connote MACOMB LAW GROUP due to the presence in the mark of that wording; customers viewing the mark as a whole will readily understand MLG to be an abbreviation or initialism of MACOMB LAW GROUP. In Registrant's mark, MLG likely references the initials of an unknown attorney or attorneys, and AUTOMOTIVE LAW identifies the type of law practiced. Therefore, the marks have different connotations.

In terms of overall commercial impression, we find that Applicant's mark MLG MACOMB LAW GROUP and design gives the impression of a law group in a particular geographic location, Macomb county, Michigan. The cited registered mark, on the other hand, gives the impression of a law firm practicing automotive law.

We find that the marks are dissimilar when viewed in their entirety as to appearance, sound, connotation and overall commercial impression. The first *DuPont* factor weighs heavily against a finding of likelihood of confusion.

III. Conclusion

Any of the *DuPont* factors may play a dominant role in assessing likelihood of confusion. *DuPont*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) stating that “[w]e know of no reason why, in a particular case, a single [*DuPont*] factor may not be dispositive” and holding that “substantial and undisputed differences” between two competing marks justified a conclusion of no likelihood of confusion on summary judgment).

Notwithstanding the legal identity of the services and the overlapping trade channels and consumers, we find that in view of the dissimilarities of the marks confusion is unlikely. Considering and weighing all of the relevant *DuPont* factors for which there has been evidence and argument, we find that the dissimilarity of the marks under the first *DuPont* factor simply outweighs the other relevant *DuPont* factors, and we conclude that there is no likelihood of confusion.

Decision: The Section 2(d) refusal to register Applicant's mark


MACOMB LAW GROUP is reversed.