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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055460
Party	Plaintiff The Hackett Group, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 3,878,276  
For the mark "HACKETT CONSULTING"

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THE HACKETT GROUP, INC., )  
 )  
Petitioner, )  
 )  
vs. ) Cancellation No. 92055460  
 )  
HACKETT CONSULTING, LLC )  
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Registrant. )

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**PETITIONER'S REBUTTAL BRIEF**

Petitioner, the Hackett Group, Inc., ("Petitioner") hereby submits the following reply in support of its petition to cancel U.S. Registration No. 3,878,276 for "HACKETT CONSULTING" ("the HACKETT CONSULTING Registration").

**ARGUMENT**

**I. LIKELIHOOD OF CONFUSION**

The Registrant's Brief attempts to distinguish the parties' respective services by (1) focusing attention on the relative size of each party; and (2) distancing the services Registrant is currently offering from those identified in the subject registration. Even if accurate, however, these distinctions are not reflected within THE HACKETT CONSULTING Registration and, therefore, have no bearing on the Board's analysis. Registrant's narrow interpretation of Petitioner's services - which it identifies solely as "benchmarking" -- is

similarly unpersuasive. This is, as discussed below, doubly true in light of the Registrant's own concession that "benchmarking" is a function of "brand management". (A. Hackett Dep. 38) (describing the first function of brand management as "*assessing the landscape. That is where you get your benchmarking and you figure out what the trends are and what your competition is.*")

**A. Registrant's Services.**

Much of Registrant's Trial Brief is dedicated to playing down the size of Registrant's businesses and the scope of its current services. Registrant contends, for example, that its customers "are small companies with minimal budgets." Registrant's Brief at p.5. In applying to register HACKETT CONSULTING, however, the Registrant failed to limit its trade channels to "small companies with minimal budgets." It is also unlikely that the Registrant desires to retain its Federal registration solely for the purpose of enforcing these rights against businesses operating from "the basement of [a] personal residence located in Mableton, Georgia." Cf. Registrant's Brief at p.6. Rather than finding basis in the subject registration, these descriptions simply reflect the current circumstances of the Registrant's business. Consequently, it is for this reason the Board requires that determinations as to a likelihood of confusion be prefaced upon a comparison of the services recited in the challenged registration and the pleaded registration(s). Cunningham v. Laser Golf Corp., 222 F.3d 943, 55

USPQ2d 1842 (Fed. Cir. 2000); Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

The subject Registration includes the following recital of services: "*branding services, namely, consulting, development, management, and marketing of brands for businesses.*" An examination of this recitation reveals four (4) discrete categories of services, namely, (1) brand consulting; (2) brand development; (3) brand management; and (4) brand marketing. According to Registrant's principal, this recitation of services was chosen because it fell "squarely [within] what I was trying to do" and, in fact, is "exactly what I do." (A. Hackett 13:4-5, 37:18-25-38:1-5). Nevertheless, in addressing Registrant's services, the Registrant's Brief conflates all of these into one category: "brand management."

Specifically, when asked about just *one* of these four categories, the Registrant's principal stated that "brand management is a broad term". (A. Hackett Dep. 10:23-11:8). As a result, the Registrant's principal testified that he considers "brand management" as four discrete functions, only two of which he actually offers. See Registrant's Brief at 4. None of these functions, however, are addressed within the Registrant's identification of services. As a result, Registrant's belief that niches can be carved out of "brand management" is of no relevance to the Board's inquiry. See, e.g., In Katz Communications, Inc. v. Katz Marketing Solutions LLC, Opposition No. 91191178, at 30 (February 21, 2013) [not precedential] (noting that "because Registrant's services are broadly described in its

identification [they] must be deemed to overlap with the [opposer's] consulting services.")

There is also no evidence to suggest that consumers share the Registrant's familiarity with the number of sub-categories encapsulated by the phrase "brand management." According to the Registrant's Principal, for example, the average client is not "that versed in even defining what brand management is." (A. Hackett Dep. 39:1-14). Further, it is unclear who -- apart from the Registrant's principal -- shares his opinion about the multi-faceted nature of "brand management." Rather, as the Registrant's principal concedes, "there's different frameworks for it [and] that's how I break them out." (A. Hackett Dep. 37:10-11).

In addition to being legally inapposite, the Registrant's claims regarding the scope of its services are factually flawed. Registrant's principal, for example, previously served as the Senior Brand Manager and Senior Marketing Manager at Proctor & Gamble and ConAgra Foods, Inc., respectively.<sup>1</sup> And, while the Registrant's Brief paints a self-effacing portrait of the Registrant's services, Registrant does not shy away from highlighting his national credentials and experience with the public-at-large. Registrant's website, for example, proudly touts Registrant's affiliation and past experience with major companies and brands, such *Bounce* and *Roto-Rooter*. (A. Hackett Dep. 5:20-22; 54:21-55:6, 61:3-9 and corresponding Exhibit C).

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<sup>1</sup>ConAgra is identified as one of Petitioner's corporate clients on Petitioner's website. (Exhibit 7 to Snowball Dep., at PET 490.)

Registrant has never turned down a client because it was too large nor dropped a client because it got too big. (A. Hackett Dep. 32:10-23). Rather than reflecting any ideology, the size of Registrant's business and the nature of its clientele is imposed by and reflective of its current circumstances. (A. Hackett Dep. 34-35). Consequently, while the Registrant may currently be operating on an individual capacity, the Registrant would - like any other business - adapt to future circumstances by expanding its business and hiring additional employees. (A. Hackett Dep. 33:13-25; 34). Moreover, while Petitioner's "business is focused on preeminent brands . . . [it can] scale down to the smallest of companies." (Snowball Dep. 13:13-17). Along these same lines, the scope and depth of Petitioner's services are "customized" and "dictated" by a client. (Snowball Dep. 71:15-25-72:1-20). Accordingly, while one client might request an analysis of its entire business, another may want to narrowly evaluate "how effectively the brand is driving traffic to the website". (Snowball Dep. 12:5-14, 13:4-9, 44:12-23, 45:20-22).

Curiously, in attempting to draw a line between his *actual* services and those described in his registration, Mr. Hackett conceded that "benchmarking" is a function of "brand management." (A. Hackett Dep. 38) ("*I call those assessing the landscape. That is where you get your benchmarking and you figure out what the trends are and what your competition is.*") Similarly, Registrant's website touts the importance of "competitive point of difference reinforcement" (Exhibit C to A. Hackett Dep., at p.3). The parties are, therefore, in agreement that "benchmarking" and "brand management" are related. (A.

Hackett Dep. 12:5-11, 43:13-19) (noting that brand management involves taking "broad look at the competition [which] can tell you what trends are. It could be benchmarking.") Furthermore, despite the lip service paid to arbitrary distinctions, Registrant described his own services by relaying a scenario falling squarely within the commonly accepted notion of "benchmarking":

I would say [to the client], so who's the competition? And it's important to understand those things like that so you can figure out what message to communicate. So when we do a Facebook ad, I can talk about, hey this is how you're better than somebody else.  
(A. Hackett Dep. 43:13-19).

In short, regardless of the Registrant's "descriptions", an analysis of each parties' services reveals significant overlaps. See, e.g., (Snowball Dep. 10:16-24, 11:14-17, 12:1-2, 15:13-16, noting that "we provide an indication of whether [a client's] performance was strong or weak relative to the comparison that was used").

#### **B. Petitioner's Services.**

Petitioner's registration for "THE HACKETT GROUP" is directed to the following services: "*business consultation and analysis services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes*". The Registrant's Brief, however, omits any reference to "best practices" in its description of Petitioner's services and subsequent analysis. This permits Registrant to portray Petitioner's services as being exclusively "analytical" in nature.

The evidence shows, however, that Petitioner's services are utilized by companies seeking "to optimize cost or improve overall

performance.” (Snowball Dep. 15:2-16). These goals are accomplished by identifying the company’s current practices, determining how well these practices are performing, and then measuring this data against a “defined set of metrics”. (Snowball Dep. 10:13-16). Once “the optimal way” to execute a process has been identified, Petitioner can thereafter be engaged to “fix” the problem and implement the “best practice.” (Snowball Dep. 10:16-24, 11:14-17, 12:1-2, 13:13-24, 15:13-16, 56:20-25 - 58:1-25). If a website’s “usability” is identified as a weakness, for instance, Petitioner’s consultants will work directly with the “VP of website design [and] their project team” to develop and improve that website. (Snowball Dep. 11:9-11, 57:24-58:16). Thus, both Petitioner and Registrant are in the business of, for example: evaluating how effectively a client is driving traffic to its website, (Snowball Dep. 45:20-22), and working with clients to develop and improve websites. (Snowball Dep. 57:24-58:16).

**C. The Acclaim of Petitioner’s Marks.**

Though conceding that Petitioner’s clients include some of the world’s largest companies, Registrant asserts “Petitioner submitted no evidence of brand recognition by the executives within these companies of whom they claim to have this acclaim.” See Registrant’s Brief, p. 18. This ignores Petitioner’s testimony and evidence regarding the lengths taken by Petitioner to ensure the continued recognition of its brand. The HACKETT GROUP Mark, for example, is prominently featured on (1) all reports sent to clients, (Snowball Dep. 79:18-25-80:1-12 and corresponding Exhibit 5); and (2) any all communication sent to a client and/or its employees. (Snowball Dep. 21:20-25 - 22:1-5, 23:13-

21). In 2003, Petitioner also began circulating a newsletter -- THE HACKETT PERSPECTIVE -- to Petitioner's current and prospective clients, attendees of Petitioner's conferences, and Petitioner's employees. (Snowball Dep. 9:15-18, 10:3-9); Pet. Ex. 2. Petitioner has also made long-standing use of the HACKETT Marks on its website, press releases, and publicly distributed materials. Pet. Ex. 4-7; Pet. Ex. 17. As a result, it is no surprise that the media now frequently uses the term "HACKETT" to identify Petitioner and/or the source of Petitioner's services. Pet. Exs. 18-28.

#### **CONCLUSION**

As discussed above, both Petitioner and Registrant are in the business of identifying weaknesses and implementing solutions. Compare (Snowball Dep. 57:24-58:16) with (A. Hackett Dep. 55:7-18). See also In Katz Communications Opposition No. 91191178, at 30 ("[m]arketing consulting services are . . . very broad, and include product promotion."; see also Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d at 1265, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (finding "data and information process" similar to "consulting services, whether for data processing or for data processing products.") Consequently, applying the DuPont factors to the present facts reveals a strong likelihood that the HACKETT CONSULTING Registration, when used in connection with Registrant's services, will create consumer confusion relative to THE HACKETT GROUP Registration and the HACKETT Marks.

For these reasons, Petitioner submits that U.S. Registration No. 3,878,276 for "HACKETT CONSULTING" should be cancelled as it is likely to cause confusion, mistake or deception as to the source of

Registrant's services, as to Registrant's affiliation, connection, or association with Petitioner, and as to Petitioner's sponsorship or approval of Registrant's services.

Respectfully submitted,

Dated: April 7, 2014

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**CERTIFICATE OF FILING**

I HEREBY CERTIFY that the foregoing document was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board, web site, www.uspto.gov, this 7th day of April 2014.

By: Francisco J. Ferreiro/  
Francisco J. Ferreiro

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing document was sent by via E-mail and First Class Mail to the following on April 7, 2014:

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