

This Opinion is not a
Precedent of the TTAB

Mailed: July 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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The Hackett Group, Inc.

v.

Hackett Consulting

—
Cancellation No. 92055460

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John Cyril Malloy, III of Malloy & Malloy PL for The Hackett Group, Inc.

Matthew H. Swyers of The Trademark Company PLLC for Hackett Consulting.

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

Opinion by Wellington, Administrative Trademark Judge:

Hackett Consulting (“Respondent”) is the owner of Registration No. 3878276 for the mark **HACKETT CONSULTING** for “branding services, namely, consulting, development, management and marketing of brands for businesses” in International Class 35.¹

The Hackett Group, Inc. (“Petitioner”) has filed a petition to cancel Respondent’s registration, alleging: prior use and registration on the Principal Register of the mark **THE HACKETT GROUP** in connection with “business consultation and

¹ Issued November 16, 2010, on the Supplemental Register. The term “Consulting” has been disclaimed.

analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes”;² prior and continuous use of the mark **HACKETT PERSPECTIVE** for “newsletters featuring topics related to business consultation and analysis, including best practice analysis, survey results, case studies and management issues”;³ ownership and prior use of a **HACKETT** “family of marks associated with Petitioner and Petitioner’s goods and services” ¶¶ 7-8; and ownership of three applications for marks containing the term **HACKETT** which it asserts have been refused registration by the Office based on Respondent’s registration.

As the ground for cancellation, Petitioner alleges that “there is a likelihood of confusion between [its pleaded marks] when used on its goods and services and [Respondent’s registered mark] when used on the services set forth in Registration No. 3878276.” ¶ 12.

Respondent, in its answer, denies the allegations in the petition for cancellation.

The Record

The record consists of the pleadings and, by rule, the file of the involved registration. Trademark Rule 2.122(b)(1).

² Registration No. 3064697 issued March 7, 2006, Sections 8 and 15 affidavits accepted. The registration is based on a claim of acquired distinctiveness under Section 2(f) as to the whole mark and the term **GROUP** has been disclaimed. A copy of this registration, obtained from the Office’s electronic database (TESS), was attached to the petition.

³ Petitioner also pleaded ownership of Registration No. 3229134 for this mark for the same goods; however, that registration was canceled on November 22, 2013, under Section 8 for failure to file the required affidavit.

Petitioner filed a copy of the deposition testimony, with attached exhibits, of Brooke Anthony Snowball, responsible for “global benchmarking business” for Petitioner.⁴ Because Petitioner filed a printout from the Office’s electronic database of its pleaded registration No. 3064697 with the petition for cancellation, it is of record. Trademark Rule 2.122(d)(1). In addition, Petitioner filed notices of reliance⁵ on the following materials: status and title copies of pleaded Registrations Nos. 3064697⁶ and 3229134 (since cancelled, see footnote no. 3); Respondent’s responses to Petitioner’s first set of interrogatories; and Internet printouts consisting of pages from the parties’ respective websites, SEC filings and annual reports, business-related articles, including articles involving “benchmarking,” and a Google search.⁷

Respondent filed a copy of the deposition testimony, with attached exhibits, of its founder and owner, Aaron Hackett.⁸

Standing

Petitioner has demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and has a reasonable basis for belief of damage. Petitioner’s pleaded registration for the mark THE HACKETT GROUP is of record. In addition, the testimony of Mr. Snowball, who is responsible for Petitioner’s

⁴ 19 TTABVUE (pages designated as “confidential”) and 20 TTABVUE (redacted copy).

⁵ 11 TTABVUE at 2-622 (Exhibits 1-34) and 12 TTABVUE at 2-23 (Exhibits 35-37).

⁶ It was unnecessary for Petitioner to file this registration under a notice of reliance since, as noted, Petitioner made it of record by attaching a copy of the registration showing status and title, taken from the Office’s database.

⁷ Petitioner did not submit evidence of its three pending applications, so they are not of record.

⁸ 21 TTABVUE at 4-113.

“global benchmarking business,” corroborates and clarifies the extent of Petitioner’s use of the same mark. These established facts suffice for purposes of Petitioner’s standing in bringing this matter before the Board. *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-190 (CCPA 1982); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.”).

Priority

Petitioner must prove priority of use in order to prevail in this cancellation proceeding. *See Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281 (TTAB 1998). Because petitioner’s pleaded registration is of record, it may rely, at the very least, on the filing date of the underlying application, *i.e.*, March 3, 2003, as a constructive use date for purposes of priority. Trademark Act § 7(c). *See J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). Likewise, Respondent may rely on the filing date of the underlying application for its registration, *i.e.*, December 12, 2009. As to evidence showing earlier use, Respondent’s principal, Aaron Hackett, testified that he founded Respondent in June of 2008.⁹ Because Petitioner’s constructive use date precedes any date upon which Respondent may rely, Petitioner has priority with respect to the mark **THE HACKETT GROUP** and the services set forth in its pleaded registration.

⁹ 21 TTABVUE at 9, 11 of 113, Hackett Dep. 6:15-19, 8:15.

With regard to Petitioner's asserted common law rights in the mark **HACKETT PERSPECTIVE** for newsletters in the field of business consultation, Petitioner has not proven priority of use. Petitioner's sole witness testified to Petitioner's use of this mark, but did not specify when such use began.¹⁰

Finally, as to Petitioner's pleaded prior common law rights in a "family" of HACKETT marks, it has argued in its brief that "HACKETT" has (1) acquired distinctiveness in relation to Petitioner's services; and (2) become a recognizable common characteristic associated exclusively with Petitioner and Petitioner's services."¹¹ However, the record does not establish that such a family of marks exists, let alone that such a family of marks was created prior to the earliest priority date that Respondent may rely upon, in this case, the filing date of the application that resulted in its registration. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks") At most, Petitioner has shown that it, and others, have used "HACKETT" by itself as an abbreviated second reference to Petitioner's entire mark. Petitioner's witness testified that "it is very common" "for a third-party publication to refer to The Hackett Group as 'Hackett.'"¹² Petitioner also made of record articles in which the

¹⁰ See 20 TTABVUE at 11 of 197, Snowball Dep. 9:22-25.

¹¹ 25 TTABVUE at 15 of 28, p. 10 of Brief.

¹² 20 TTABVUE at 44 of 197, Snowball Dep. 96:10-22.

author, after once referring to “The Hackett Group,” thereafter uses the abbreviated form “Hackett” to refer to Petitioner. In any event, even if we were to find that a family of marks exists or that Petitioner has acquired rights in the term HACKETT by itself, and we do not, Petitioner has not established a priority date for such rights. Put simply, on this record, we cannot conclude that a HACKETT family of marks was created prior to 2008.

Accordingly, of Petitioner’s pleaded marks, it has demonstrated prior use only of the registered mark **THE HACKETT GROUP** for business consultation and analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes. We therefore focus solely on this mark as used in connection with those services vis-à-vis Respondent’s registered mark and the services recited in the registration for purposes of determining if there is a likelihood of confusion.

Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”).

Similarity of the Marks

We find that Petitioner’s mark, **THE HACKETT GROUP**, is highly similar to Respondent’s mark, **HACKETT CONSULTING**. Both marks share the same dominant element, HACKETT, and are accompanied by highly descriptive or generic terms, CONSULTING and GROUP, which have been disclaimed in the respective registrations. Respondent, in its brief, acknowledges that the marks consist of “surname plus generic matter,” but argues that the “additional matter, even if generic or descriptive in its own right,” is sufficient to distinguish the marks.¹³ We disagree. The disclaimed highly descriptive or generic wording has nearly no value in creating a commercial impression in either mark, nor does it help distinguish the two marks. We further point out that the two terms are equally highly descriptive or generic in the context of either party’s services; that is, both parties render “consulting” services and may be referred to as a “group,” in the sense of a business organization.¹⁴

To the extent that HACKETT is perceived as a surname, as Respondent argues and as we address in the following section involving the strength of Petitioner’s

¹³ 28 TTABVue at 22-23 of 35, pp. 15-16 of Brief.

¹⁴ We take notice that the word “group” is broadly defined as “a number of individuals assembled together or having some unifying relationship.” Merriam-Webster Collegiate Dictionary (11th ed.). In the context of business, it is defined as “a commercial organization consisting of several companies under common ownership.” The New Oxford American Dictionary (2d ed., 2005). See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

mark, this will actually increase the similarity of the marks' commercial impression or connotation.¹⁵ In other words, consumers perceiving the term HACKETT in the marks as a surname may mistakenly believe that both marks reference a single entity affiliated with the same "Hackett" family or individual with that surname. Confusion remains a concern even when the involved marks comprise a surname. *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364, 367 n.6 (TTAB 1984) ("It is a recognized principle of trademark law that when one uses a family surname as part of a trademark, registrability is subject to the same considerations, including the public interest in avoiding source confusion, as apply to other types of marks. *See Ford Motor Co. v. Ford*, 462 F.2d 1405, 174 USPQ 456 (CCPA 1972); *Lyon Metal Products, Inc. v. Lyon, Inc.*, 134 USPQ 31 (TTAB 1962).").

Accordingly, we find the marks at issue to be highly similar in appearance, sound, meaning and commercial impression, and the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Strength of and Scope of Protection for Petitioner's Mark

One of Respondent's main arguments in asserting there is no likelihood of confusion rests on its contention that "Hackett" is merely a surname and thus Petitioner's mark is inherently weak. Specifically, Respondent requests the Board to

¹⁵ Materials attached to an Office action in the prosecution of the application underlying Respondent's registration show a number of individuals with this surname. *See* Office Action dated March 15, 2010. *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009) (evidence submitted during *ex parte* prosecution of underlying application or registration is of record in subsequent *inter partes* proceeding involving that application or registration).

“take notice of the common surname significance of the term HACKETT and afford Petitioner only a narrow scope of protection for its surname mark.”¹⁶

There is no dispute that both parties’ marks were initially refused registration during their prosecution, in each case on the basis that the mark was primarily merely a surname. Respondent was able to secure a registration on the Supplemental Register; thus, it did not make a showing that its mark had acquired distinctiveness. Petitioner, on the other hand, was issued a registration on the Principal Register under Section 2(f) on the basis that its mark had acquired distinctiveness.

Because Petitioner’s pleaded registered mark is on the Principal Register it is entitled to protection and the presumption of validity set forth in Trademark Act § 7(b), 15 U.S.C. § 1057(b). Moreover, the fact that HACKETT may be a surname does not mean that Petitioner’s mark is automatically weak or otherwise entitled to a narrower scope of protection. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, n.20 (TTAB 2007) (“The fact that ARDEN is a surname does not automatically render the mark weak or entitled to only a narrow scope of protection.”). “Section 2(d) ... does not set forth special rules regarding the registration of marks involving surnames in determining the issue of likelihood of confusion.” *Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 151 USPQ 350, 352 (CCPA 1966). We know of no reason why surnames cannot become strong marks through use in connection with services or on goods.

¹⁶ 28 TTABVUE, p. 16 of Brief.

In this case, Petitioner has used its mark for at least eleven years. Petitioner maintains several offices around the United States and worldwide and its THE HACKETT GROUP mark has been featured in mainstream and business media, including The New York Times, CNBC and Yahoo! Finance. Further, there is no evidence of third-party use of marks containing the term HACKETT. In short, in addition to the statutory presumption of validity of Petitioner's mark, there is evidence corroborating the distinctiveness of this mark as a source identifier for Petitioner's business consultation services.

We therefore cannot agree with Respondent's assertion that Petitioner's mark is entitled to a narrower scope of protection. Even if we were to find some inherent weakness in Petitioner's mark due to HACKETT being a surname, we have long held that a likelihood of confusion should be avoided as much between "weak" marks as between "strong" marks, or as between a "weak" and a "strong" mark. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

Similarity of the Services, Their Channels of Trade and Classes of Consumers

Respondent's services are described in the registration as "branding services, namely, consulting, development, management and marketing of brands for businesses." Respondent's principal has testified that "brand management is a broad term that talks about the value that you have in your name versus competition."¹⁷ He further breaks "brand management" services into four functions:

¹⁷ 21 TTABVUE at 13-14 of 113, Hackett Dep. 10:23-25 and 11:1-21.

assessing the landscape and competition; deciding how to position your brand in this landscape; looking at the strategy or how to “drive this positioning”; and actual execution of strategy.¹⁸ Of these four functions, he testifies that Respondent’s service “falls squarely” on the third and fourth functions, namely, “lay out the strategies of the execution, but [Respondent] typically execute[s] also.”¹⁹ Respondent’s registration, however, covers brand management services in general and it is not limited in this regard. Thus, the registration must be considered as covering all functions or specific services encompassed by the wording “brand management.”

The recitation of services in Petitioner’s registration covers “business consultation and analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes.”²⁰ Essentially, petitioner’s services involve analyzing the work processes or practices of a client business, measuring the client’s performance in relation to industry leaders, and determining the optimal practice for the client to execute. These services are not limited in applicability to any one business sector and may involve specific business processes performed by the client. For example, and pertinent to this proceeding, “marketing” is considered a business function and underlying this

¹⁸ *Id.* at 14, 11:1-21.

¹⁹ *Id.* at 14-15, 11:24-12:1.

²⁰ The term “benchmarking” is defined as “a standard of excellence, achievement, etc., against which similar things must be measured or judged.” We take notice of this definition taken from Random House Dictionary (Random House, Inc. 2014). See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

function are several processes, including “brand and product management.”²¹ In this regard, Petitioner’s services will be directed to the client’s “brand management,” by looking at “how effectively the brand is driving traffic to the [client’s] website.”²² Once Petitioner’s analysis of the client’s performance has been completed, it is not uncommon for clients to seek further consultation on how to execute changes so that they can improve their performance as measured against benchmarks.²³

In comparing the services of the parties, we initially note that they may be categorized as “business-to-business” inasmuch as both parties render their services to other businesses. The similarity does not end here. Petitioner’s services are fairly extensive, but one key area involves projects for clients with the purpose of assessing their marketing, sales, and service performance. As described above, a project may include a benchmark exercise whereby Petitioner looks at improving the client’s “Brand & Product [Management].”²⁴ Petitioner’s witness described how its benchmarking services enable its clients to measure their performance vis-à-vis industry best practices so that they can ultimately become more efficient, and that this includes improving brand awareness. Similarly, Respondent’s principal has

²¹ 20 TTABVue at 15 of 113, Snowball Dep. 12:5-10.

²² *Id.* at 48 of 113, 45:20-22.

²³ *Id.* at 61-62 of 113, 58:20-59:2.

²⁴ Snowball Dep., 19 TTABVue, pp. 29:4-30:10 discussing Exhibit 3. Both the testimony and exhibit (comprising what Mr. Snowball identifies as “a representation of a deliverable that would present as a sample of marketing, sales and service benchmark”) were designated as “confidential.” We therefore keep our discussion involving all testimony and exhibits designated as “confidential” in general terms.

acknowledged that its “brand management” services involve the use of a very similar, if not the same, approach or methodology for assisting its clients. For example, the function of “assessing the landscape” for brand management purposes involves looking at “what the competition is doing ...[to] tell you what trends are. It could be benchmarking.”²⁵ Respondent’s brand management services entail asking the client, “Who’s the competition? How are you different from the competition?” and then Respondent uses this information to “figure out exactly what message to communicate.”²⁶

The recipients of both parties’ services may thus, in effect, be receiving the same type of information from Respondent and Petitioner and for the same purposes. A company seeking to increase its brand(s) awareness may engage the services of either company, which will look at competitors to determine what successful solutions are available for the client. While Respondent’s services are exclusively focused on brand consultation services, Petitioner’s business consultation and analytical services are broad enough to include advising clients on the best practices regarding improving brand awareness. And, while Petitioner’s services rely heavily on benchmarking and best practices analyses, a client may seek to use this process to obtain the same result that the client could obtain by using Respondent’s services, namely, to optimize its brand awareness and management. Put simply, business clients may choose either party’s services to reach the same goal.

²⁵ 21 TTABVUE at 15 of 113, Hackett Dep. 12:5-7.

²⁶ *Id.* at 17-20 of 113, Hackett Dep. pp. 14-17.

Neither party's services, as described in the registrations, are limited with respect to their trade channels or classes of consumers. We therefore presume that the services are found in all normal channels of trade and are offered to all potential classes of consumers. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). Here, the consumers of both parties' services, as identified, would be the same to the extent they are businesses seeking to improve their brand awareness. There is no limit on the size of these businesses or their field or industry. Accordingly, we presume the trade channels and classes of customers to be the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this presumption). The record also confirms that consumers learn of both parties' services through referrals.²⁷ This method of potential consumers becoming acquainted with the party's services is particularly susceptible to confusion because it is possible that the referring individual will not mention or emphasize the entire mark. The recipient of the referral is more likely to recall the more distinctive shared element HACKETT.

It may be presumed that business consultation services are not the subject of impulse purchasing decisions and will be selected by business owners or employees entrusted to make such a decision on behalf of the business. However, the fact that

²⁷ See 21 TTABVUE at 19 of 113, Hackett Dep. 16:17 (Respondent's services are marketed "strictly by word of mouth") and 20 TTABVUE at 17 of 197, Snowball Dep. 14:5-12 (Petitioner comes "into contact" with new customers "by and large" through "referrals.")

the parties' customers may be sophisticated in their respective fields does not mean they are knowledgeable with regard to differentiating between two "Hackett" marks or that they are immune from mistakenly believing that there is some kind of business relationship or affiliation based on this similarity. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible."). *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Conclusion

We have carefully considered all of the probative evidence pertaining to the relevant issues in this case, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion and/or designated as confidential.

We conclude that consumers familiar with Petitioner's "business consultation and analysis services, namely providing surveys and analysis reports in the nature of best practices and benchmarking of business processes" rendered under the mark **THE HACKETT GROUP** would be likely to mistakenly believe, upon encountering Respondent's similar mark **HACKETT CONSULTING** in connection with "branding services, namely, consulting, development, management and marketing of brands for businesses," that the services originate with or are somehow associated with or sponsored by the same entity.

Decision: The petition for cancellation is granted based on Section 2(d) of the Trademark Act. Respondent's Registration No. 3878276 will be cancelled in due course.