

This Opinion Is Not a
Precedent of the TTAB

Mailed: November 14, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Making Connections Professional Services, LLC
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Serial Nos. 97472548 and 97472577
(consolidated)
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Thomas L. Peterson, Esq., for Making Connections Professional Services, LLC.

Davis Creef, Trademark Examining Attorney, Law Office 125,
Robin Mittler, Managing Attorney.
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Before Zervas, Dunn, and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Making Connections Professional Services, LLC (“Applicant”) seeks registration on the Principal Register of the mark MAKING CONNECTIONS PROFESSIONAL SERVICES, in standard characters, and the mark shown below,



both for:

Consulting services in the field of marketing of educational training; Business consultation in the field of education leadership development; Business consulting, management, planning and supervision; Business management consultation in the field of executive and leadership development; Business management consulting; Business management supervision; Business organization consulting; Personnel management consultation; Professional business consultation; Professional business consulting,

in International Class 35.¹ The Examining Attorney finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), finding a likelihood of confusion, based on the registered mark MAKING CONNECTIONS THAT COUNT, in standard characters, for “On-line business networking services,” in International

¹ Application Serial Nos. 97472548 (word mark) and 97472577 (word + design mark) were both filed on June 23, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The words “PROFESSIONAL SERVICES” are disclaimed in both applications.

The 97482577 application describes the applied-for word + design mark as follows: “The mark consists of the stylized word ‘MAKING,’ with the word ‘CONNECTIONS’ below, with the ‘M’ being connected to the second ‘N’ and the two ‘T’ letters also connected. The words ‘PROFESSIONAL SERVICES’ appear below and smaller. To the right of the wording, there is a fanciful left leaning figure eight.” Color is not claimed as a feature of the mark.

We consolidate the appeals and decide them in a single opinion because they involve common issues of law and fact with similar records. *See In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board sua sponte consolidated two appeals). All record references are to Serial No. 97472548 (the word mark), unless otherwise noted.

This opinion is part of a pilot and generally cites to the Federal Reporter and United States Patents Quarterly (USPQ) for decisions of the U.S. Court of Appeals for the Federal Circuit, the U.S. Court of Customs and Patent Appeals, and the Board. For post-2018 decisions of U.S. Court of Appeals for the Federal Circuit, the opinion cites only to the Federal Reporter. For post-2018 decisions of the Board, the opinion cites to the LEXIS database. *See Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 101.03 (2024)*.

Class 35.² Applicant and the Examining Attorney have filed briefs and the appeal is ready for final decision. We affirm the refusal to register.

I. Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379-80 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key

² Registration No. 3857562 issued on October 5, 2010, and has been renewed.

considerations are the similarities between the marks and the similarities between the goods or services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”).

II. Likelihood of Confusion – Analysis

A. Similarity of the Marks

To evaluate the similarity of the marks, we consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression

such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic*, 127 USPQ2d 1627, 1630 (TTAB 2018).

We begin with Applicant’s applied-for word mark MAKING CONNECTIONS PROFESSIONAL SERVICES, keeping in mind:

- “[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

- “[U]sers of language have a universal habit of shortening full names from haste or laziness or just economy of words.” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring). *See also Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant,’ it does indicate that people have called it by that name, omitting the word ‘Hamburgers.’ Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant,’ there likely would be confusion about which ‘Giant’ they were talking about.”); *Big M. Inc. v. United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks ...”).

- Applicant disclaimed the last two words, “professional services,” that are descriptive of Applicant’s business consulting services.³

³ “A disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination.” *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1160 n.11 (TTAB 2018); *see also In re Natl. Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO”). We note the disclaimer because it is consistent with our view that “professional services” are descriptive of the business consulting services identified in the Application.

There are, then, three distinct⁴ reasons to expect that consumers will primarily recall and use the MAKING CONNECTIONS part of Applicant's mark. This result is important because the cited mark is MAKING CONNECTIONS THAT COUNT. Two of the three points we made above are equally applicable to the cited mark, namely that the first part of a multi-word mark is more likely to be remembered and used by consumers and that consumers tend to shorten trademarks.⁵ Here, the additional term "THAT COUNT" in the registered mark merely modifies and reinforces the primary term MAKING CONNECTIONS."⁶ All these points lead to an obvious conclusion: the most distinctive and most likely to be remembered parts of the two marks are identical. Though the marks as a whole have differences, this point of similarity is quite significant and renders the marks, as a whole, similar.

The common MAKING CONNECTIONS parts of these marks are identical in sound and appearance. The marks have a similar meaning, as both use the phrase

⁴ Lest one quibble with our counting, we acknowledge that consumers' tendency to focus on the first part of a multi-word trademark and their tendency to shorten trademarks may well be two aspects of the same general tendency. Either way, our point is the same: The first two words in Applicant's mark are the most distinctive and most likely to be remembered and used by consumers.

⁵ We consider "MAKING CONNECTIONS" as the "first part" of the cited mark. The word "making" alone could mean many things, but when taken together with "connections," a clearer image comes to mind, particularly for the online networking services identified in the cited registration.

⁶ Indeed, it is the first part of the cited mark that sets the meaning of the mark. The mark connotes, within the context of online networking services, the process and result of making positive business or professional connections. The "that counts" part of the cited mark merely confirms that the services hopefully will produce connections that count, rather than connections that do not count. We further find that the phrase "making connections," as used in the applied-for mark implies the connections made will count. It would make no sense for Applicant to help its customers make connections that are frivolous or that otherwise do not count, to use the parlance of the cited mark.

“making connections” in connection with business services, where making connections is likely a part of business. The commercial impressions created by these marks are also similar, as both marks conjure up images of making connections in the course of receiving or using the identified services. Notwithstanding the differences in the additional terms, when considered in their entirety, we find the marks MAKING CONNECTIONS PROFESSIONAL SERVICES and MAKING CONNECTIONS THAT COUNT are similar and this weighs in favor of finding likelihood of confusion.

Our analysis is similar for Applicant’s composite mark shown below:



The literal element of this mark is the same as Applicant’s word mark, the phrase “MAKING CONNECTIONS PROFESSIONAL SERVICES,” but adds a fanciful figure eight design after the literal portion of the mark. There is no design element in the cited registration. The design carries less weight than the literal part of the mark because consumers will use the literal elements to ask for the services or to tell others about the services.⁷ Moreover, in this mark, “MAKING CONNECTIONS” is

⁷ We further find the design element and the stylization of the literal element are figurative examples of connections, and thus, reinforce the meaning of the “making connections” element of the composite mark. The figure eight element also comes after the literal elements, which emphasize the “making connections” phrase.

much more prominent than “PROFESSIONAL SERVICES,” which has been disclaimed.

Considering the marks as a whole, we find this composite version of Applicant’s mark is also similar to the cited mark. When spoken or heard, the design element falls away. And when this fact is combined with consumers’ tendency to shorten marks and the emphasis on the “making connections” element, we find it likely that a substantial number of consumers will refer to this version of Applicant’s mark as simply “MAKING CONNECTIONS.” There is some stylization to the literal part of the mark, but that stylization simply connects the two literal parts of the mark, thus emphasizing the “making connections” theme even more. This mark is also similar to the cited mark.

B. Similarity or Relatedness of the Services

Our evaluation of the second *DuPont* factor is based on the services identified in the Application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A likelihood of confusion may be found if any services recited in the identification of services in a particular class in an application are related to any of the services identified in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *see also Double Coin Holdings Ltd. v. Tru Dev.*, Opp. No. 92063808, 2019 TTAB LEXIS 347, at *18; *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015).

The two appealed Applications identify the same services, so our analysis under this factor applies equally to both. We begin with the services identified in the Applications, and find the following specific, identified services are broad and important to our analysis of this *DuPont* factor:

- Business consulting, management, planning and supervision;
- Business management consulting; and,
- Business management consultation in the field of executive and leadership development.

The Examining Attorney submitted evidence showing that entities providing business consulting services of the types listed above often offer “on-line business networking services,” the services identified in the cited registration under the same mark. We provide a few samples of this evidence below. Note the first example shows a “leadership development consultant,” which we find would offer “business management consultation in the field of executive and leadership development,” one of the services identified in the Application.



What is a Leadership Development Consultant?

Healthcare is in a constant state of rapid change. Leaders face immense financial pressures, frequent regulatory shifts and unprecedented disruption from the coronavirus pandemic. All of this impacts healthcare's most important asset – its leaders.

A Leadership Development Consultant assists organizations in developing initiatives to support executive leaders and their teams. Leadership Development Consultants provide insight on retaining top talent, reducing leadership burnout, and sharing recommendations to ensure organizations are investing in leaders who can stabilize their businesses today while laying the foundation for a better tomorrow.

Business Opportunities:

The opportunities available for Leadership Development Consultants are abundant. As the general healthcare workforce has become strained during the pandemic, so has its healthcare leaders, increasing the demand for Leadership Development Consultants that can provide insightful recommendations to equip healthcare leaders.

Leadership Development Consultants have the option to work as independent consultants and start his/her own firm or be hired into an existing consulting firm.

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And below, we see the same entity offering under the same mark “virtual business networking,” services, which are effectively identical to the “on-line business networking services” identified in the cited registration.

⁸ Office Action dated April 10, 2023, at 13.



Virtual Business Networking

Your network is your net worth, and we want to network with you! Every quarter The Healthcare Consultant Network and Healthcare Consultants USA partner to host a Virtual Business Networking Event for Healthcare Consultants.

Healthcare Consultants can participate as presenter or as an audience member. Healthcare Leaders are invited to this LIVE event.

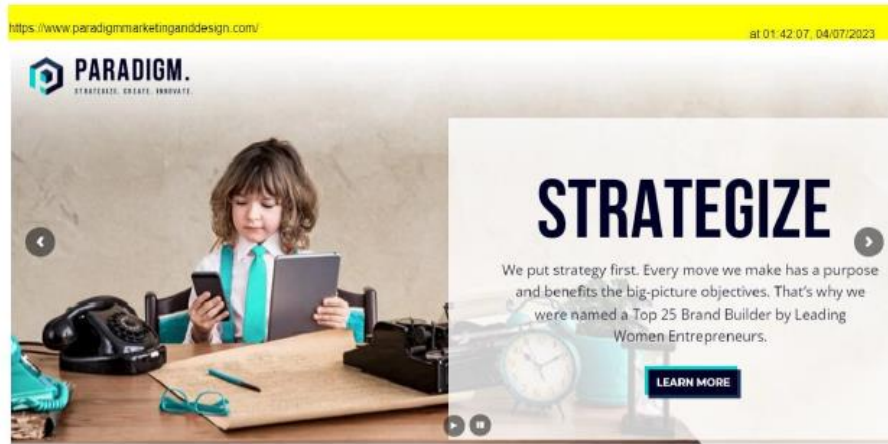
Information For Presenters

- Healthcare Consultants have 3 minutes to present their consulting business.
- Must provide B2B consulting solutions.

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Another example from the record shows Paradigm Marketing and Design providing services we find fall within the category “business consulting, management, planning and supervision” services identified in the Application under the same mark.

⁹ *Id.* at 17. *See also id.* 42-47 (Piedmont Avenue Consulting offering business management consulting and also virtual networking events, including a “virtual happy hour networking event”).



HOW CAN WE HELP?



WEB DESIGN

I want a professionally designed website that I can use as a strategic marketing tool



MESSAGE

I want to evolve my message so it resonates with my audience



MARKETING

I'd like to execute a strategic, ongoing marketing strategy that drives business goals



SOCIAL MEDIA

I want to develop and execute a purpose-driven social media strategy



BRANDING

I need to build a brand that represents the value I provide



WORKFLOW

I want to automate my marketing and sales activities

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¹⁰ *Id.* at 54.

¹¹ *Id.* at 55.

And below we see the same entity offering a “virtual networking event.”

https://www.paradigmmarketinganddesign.com/event/table-for-four-virtual-networking at 01:42:44, 04/07/2023

PARADIGM.
STRATEGIZE. CREATE. INNOVATE.

EVENTS

Home » Events » Table for Four Virtual Networking Event

« All Events

TABLE FOR FOUR VIRTUAL NETWORKING EVENT

DATE: APRIL 24TH AT 12PM EST
EVERY 4TH MONDAY AT 12PM
PRICE: THIS IS A FREE EVENT
LOCATION: ONLINE – ZOOM

Register Today!

- Do you want to fill your pipeline?
- Are you looking for new partners to collaborate with this year?
- Are you excited to expand your network in 2022?

Make even more connections with DOUBLE TABLE TALKS

- Increase referrals
- Connect with like-minded professionals
- Expand your professional network

Join us at Table for Four, a monthly virtual business networking luncheon.

WHO SHOULD ATTEND?

This event is ideal for professionals who want to expand their network and collaborate with like-minded professionals.

- Give and get referrals
- Make new connections
- Widen your network

MULTIPLE DATES AVAILABLE

PRESENTED BY

PARADIGM.
STRATEGIZE. CREATE. INNOVATE.

EVENT SPONSOR

NJBIA
New Jersey Business & Industry Association

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There is ample evidence in the record to show that the same entities offer, under a single entity mark, the services identified in the Application and the cited registration.¹³ This type of connection increases the likelihood of confusion because

¹² *Id.* at 59.

¹³ The Examining Attorney provided additional evidence with the Final Office Action dated July 31, 2023. *See, e.g., Id.* at 17, 19, 21 (Women’s Millionaire offering a “business networking event – online live” and providing various type of business consulting services), 30-32 (W3 consulting offering a range of business consulting and an online networking event). There is similar evidence from at least three other consulting businesses with the Final Office Action.

consumers become accustomed to seeing both sets of services provided under a single mark. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (a key inquiry under this factor is whether the evidence “suggests that consumers are accustomed to seeing a single mark associated with a source that sells both” types of services); *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007).

Applicant argues the “two services are in no way related or similar,” but does not address any of the evidence submitted by the Examining Attorney, and Applicant submitted no evidence.¹⁴ While it is true that Applicant’s list of consulting services does not include virtual networking services, it is quite clear from the record that other consulting businesses offers such services. That matters because when consumers of these services see this practice within the market, they become accustomed to seeing both types of services provided by a single entity under a single mark. The relatedness of the services makes confusion more likely.

C. Other *DuPont* Factors

Applicant presented arguments under three other *DuPont* factors: whether purchasing conditions alter the likelihood of confusion (the fourth factor); whether the prior mark is famous (the fifth factor); and, the absence of actual confusion (the eighth factor).¹⁵ There is no evidence in the record relating to these factors.

As to the purchasing conditions, neither Applicant nor the Examining Attorney submitted evidence of such conditions. Without any basis to evaluate the purchasing

¹⁴ 8 TTABVUE 8.

¹⁵ *Id.*

conditions beyond the identifications found in the Applications and the cited registration, we find this factor is neutral.

This is an ex parte appeal, so there is no way for the owner of the cited registration to submit evidence regarding the fame of its mark. As there is no evidence in the record relating to the fame or market strength of the cited mark, we find this factor neutral.

Finally, Applicant argues that it has received no reports of actual confusion, despite that it has begun some marketing under its applied-for marks.¹⁶ This is purely argument, as Applicant submitted no evidence. Moreover, without the owner of the cited registration involved, we cannot know if it has received reports of actual confusion. Perhaps most importantly, Applicant admits it is not yet offered its services in commerce. We treat this factor as neutral.

D. Conclusion: Weighing the Factors

The marks are similar and the services are related. We have no evidence relevant to any of the other *DuPont* factors, but find the remaining factors raised by Applicant are neutral. The only two factors fully addressed by Applicant and the Examining Attorney point toward a likelihood of confusion. For all the reasons given above, we affirm the Section 2(d) refusals as to both Applications.

Decision: The Section 2(d) refusals are **affirmed**.

¹⁶ *Id.*