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Subject: U.S. TRADEMARK APPLICATION NO. 77641462 - YOUR TRUSTED  
ADVISORS - N/A

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 77/641462

**MARK:** YOUR TRUSTED ADVISORS



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Powers Pyles Sutter & Verville PC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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Applicant Powers Pyles Sutter & Verville PC has appealed the trademark examining attorney's final refusal to register the trademark YOUR TRUSTED ADVISORS for "Providing information in the field of law by means of a global computer network; and legal services" in International Class 45. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d) because of the likelihood of confusion with the mark in U.S. Registration No. 3581306.<sup>1</sup>

## FACTS

On December 30, 2008, applicant Powers Pyles Sutter & Verville PC filed a Section 1(b) application to register YOUR TRUSTED ADVISORS on the Principal Register for services in International Class 45. Registration was refused under

Trademark Act Section 2(d) based on likelihood of confusion with U.S. Registration No. 3581306 for the mark TRUSTED ADVISORS

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<sup>1</sup> The Examining Attorney notes for the record that applicant alleges on p.2 of its brief that the examining attorney failed to identify the applicable *serial* number, however, each communication with Applicant referenced the cited *registration* number 3581306. for “legal services.” This appeal follows the examining attorney’s final refusal of May 21, 2009 and denial of a request for reconsideration on this issue, dated November 21 2009.

### ISSUE ON APPEAL

The only issue on appeal is whether there is a likelihood of confusion of the proposed mark YOUR TRUSTED ADVISORS with the mark in U.S. Registration No. 3581306.

### ARGUMENT

THE MARKS OF THE APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, AND COMMERCIAL IMPRESSION AND THE RESPECTIVE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in

determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods or services. The overriding concern is to prevent buyer confusion as to the source of the goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

## I. THE MARKS ARE SIMILAR

The marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re*

*Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS);  
*In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP  
§1207.01(b)(ii)-(iii).

In the present case, applicant is seeking to register the mark YOUR TRUSTED ADVISORS and the registrant's mark is TRUSTED ADVISORS. The marks are highly similar in sound, meaning and commercial impression because the two dominant words, TRUSTED ADVISORS, are identical. The only difference between the wording in the marks is that applicant added to the registrant's mark the term "YOUR." Applicant argued that because the term "YOUR" was the first term in the mark, that consumers would not be confused, relying on the precedent that "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered' when making purchasing decisions." See Applicant's Brief at 1. However, applicant ignores the long-standing premise that marks are compared in their entirety and that some features of a mark may be more dominant than others.

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii). In this case, clearly the terms "TRUSTED ADVISORS" are more dominant and more likely to create a commercial impression than the simple possessive "YOUR." In evaluating the

purchase of legal services, a consumer would be more likely to remember those terms which convey some type of information about the services, in this case TRUSTED ADVISORS.

Further, the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (“GASPAR’S ALE and “JOSE GASPAR GOLD”); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”); TMEP §1207.01(b)(iii).

Despite applicant’s mere addition of a term to the registrant’s marks, applicant argues that “the marks differ in sight, sound, and pronunciation.” The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. Instead, the issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179

(TTAB 1980). Thus, the primary focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks.

*Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979).

When an applicant's mark is compared to the registered mark, “the points of similarity are of greater importance than the points of difference.” *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37 (D.C. Cir.), *cert. denied*, 351 U.S. 973 (1956). In the present case, the marks are similar since the dominant terms of the applicant’s mark are identical to the registered mark.

Applicant argues that the Office has registered similar marks including the terms “TRUSTED” and “ADVISOR.” Applicant Brief, p. 3. Even if applicant has shown that the cited mark is “weak,” such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein. Moreover, third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); *National Aeronautics and Space Admin. v. Record Chem. Co.*, 185 USPQ 563 (TTAB 1975); TMEP §1207.01(d)(iii). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

In the present case, U.S. Registration No. 3581306 is entitled to protection against registration of applicant's mark because applicant's mark is confusingly similar and includes identical services. While registrations coexist that incorporate the term "TRUSTED" and "ADVISOR," only U.S. Registration No. 3581306 exists on the register in class 45. Therefore, the number of marks on the register in class 45 containing the terms "TRUSTED" and "ADVISOR" is not great.

## **II. THE SERVICES ARE IDENTICAL**

The applicant's and the registrant's services are both identical, "legal services." It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, without limitations or restrictions as to their channels of trade or classes of purchasers, the services must be deemed to be promoted in the same channels of trade and directed to the same purchasers. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). Since neither identification limits the channels of trade or class of purchasers of the identically identified services, it is presumed that these identical services travel in the same channels of trade and are available to the same consumers. Moreover, where the services of the respective parties are identical, as is the present case, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 171 (Fed. Cir.) 1992.



Applicant argues that “there is no realistic likelihood of confusion among sophisticated consumers because the mark "Trusted Advisors" is registered to a Texas law firm that does solely for-profit business law, whereas the Applicant is a D.C. firm that does solely nonprofit, healthcare and education law. These are entirely different legal services offered in entirely different areas of the country.” Applicant’s Response To Office Action, April 7, 2009. To the extent that applicant argues that its activities are geographically separate from those of registrant, applicant seeks a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of applicant’s and registrant’s activities is not relevant to a likelihood of confusion determination. It should also be noted that it is very common for law firms to maintain multiple offices in various locations across the country. In fact, registrant maintains an office in Washington D.C.

Additionally, applicant appears to argue that consumers would not be confused because it “is one of the very few law firms in the entire country to specialize in its particular type of education law,” while registrant “solely provides for-profit business law services.” Applicant’s Brief, p.3. However, this argument is inapposite as neither applicant’s application nor registrant’s registration contains any type of subject matter limitation with regard to the legal services they provide. Both applicant and registrant provide “legal services” as per the application and registration and neither identification of services are limited by the type of law practiced.

Further, applicant argues that “consumers of its services are sophisticated and thus not likely to be confused by marks that may have some overlap in their content.”

Applicant’s Brief, p. 2. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Applicant’s reference to *Bennett Law Office, P.C. v. Burrus Intellectual Property Law Group* (TTAB 2009) is not citable as legal precedent, and thus the Examining Attorney does not address this case.

When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). In this case, both applicant and registrant offer their legal services to the general public as both offer websites, able to be accessed nationwide, which describe their legal services. Further, both firms maintain offices in Washington D.C.

### **CONCLUSION**

Consumers encountering the applicant’s mark and the registered mark in the marketplace are likely to believe mistakenly that the services emanate from a common source, because the marks are highly similar, and the services as identified are identical. Accordingly, the examining attorney respectfully requests that the Section 2(d) refusal be affirmed.

Respectfully submitted,

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