

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Mailed: August 19, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beyond Diversity Resource Center, Inc.

Serial No. 77722602

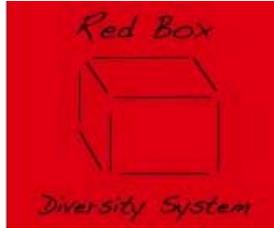
Ashok Tankha for Beyond Diversity Resource Center, Inc.

Gene V.J. Maciol, II, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Kuhlke and Taylor, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On April 27, 2009, Beyond Diversity Resource Center,
Inc. applied to register the mark shown below on the
Principal Register under Section 1(a) of the Trademark Act,
15 U.S.C. §1052(a), for services ultimately identified as
"education services, namely, providing training, by way of
classes, seminars, conferences and workshops in the field
of cultural diversity, community education and human
relations" in International Class 41.



Applicant claims the colors red and black as a feature of the mark. In response to requirements from the examining attorney, applicant disclaimed the wording "DIVERSITY SYSTEM" and provided the following description of the mark: "The mark consists of the stylized wording 'RED BOX DIVERSITY SYSTEM' and cube design separating the wording 'RED BOX' and 'DIVERSITY SYSTEM,' all in the color black superimposed over a red square background."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified services, so resembles the registered typed mark RED BOX for "books, pamphlets, brochures and journals relating to financial, legal, corporate and other business related topics," in International Class 16, as to be likely to cause confusion, mistake or deception.¹

¹ Registration No. 2673489, issued January 14, 2003, Sections 8 and 15 declarations accepted and acknowledged.

After the request for reconsideration was denied, applicant appealed the final refusal and the appeal is fully briefed.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

First, in determining the similarity between the marks, we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567. In this case, applicant's mark RED BOX DIVERSITY SYSTEM and box design incorporates the entirety of the registrant's mark RED BOX. Moreover, there is nothing in the record to indicate that RED BOX is weak. Applicant's third-party registrations do not support such a finding. Three of them are for very

Serial No. 77722602

different marks (i-qbox, Little Red Tool Box and Red Bee) and the fourth third-party registration for the mark Red Box is for completely different services (rental of DVD's and vending machines). Thus, because applicant has incorporated the entirety of registrant's mark, there is a similarity in sound, appearance, connotation and commercial impression.

Moreover, the common element RED BOX is the dominant feature in applicant's mark. It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature when evaluating the similarities of the marks. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Descriptive or disclaimed portions typically play a less significant role in a comparison of the marks. Id.; In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). While we recognize that applicant, although it ultimately acquiesced to the disclaimer requirement, continues to maintain that the additional wording DIVERSITY SYSTEM is not descriptive, it is, at a minimum, highly suggestive of applicant's services. As to the design element in applicant's mark, the box in the color red simply serves to underscore the literal element RED BOX.

Although the marks are similar, the likelihood of confusion must be evaluated in connection with the goods and services in connection with which they are used.

In considering the respective goods and services, we find that they are not so related that the use of the respective marks is likely to cause confusion. Of course we must evaluate the relatedness of the goods and services as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). However, this does not mean it is appropriate to consider all imaginable interpretations.

We agree that educational services and various types of printed matter, e.g., books, pamphlets, etc. can be related (and the various third-party registrations and web

pages support this position). However, we do not agree with the examining attorney's interpretation of the scope of the identification of goods listed in the registration, "books, pamphlets, brochures and journals relating to financial, legal, corporate and other business related topics." Specifically, the examining attorney argues that:

Applicant's diversity, community education and human relations subject matter is closely related to, if not encompassed by, Registrant's "business-related topics." For example, "human relations" is defined as, "the study of group behavior for the purpose of improving interpersonal relationships, as among employees." How one interacts with fellow employees is a quintessential business topic. ... It is integral to understand, accommodate and maximize the potential benefits employee diversity entails in order to have a successful business. Moreover, in some instances understanding and accommodating diversity in the workplace becomes a legal topic. This is clearly evident when one views Applicant's website explaining use of its training system in the workplace to "improve employee diversity skills." Applicant states, "red box not only teaches diversity skills, but how to develop those skills so they "fit" each individual's flexible unique work setting and job function." Employee skills and job functions are business-related topics.

Br. pp. 12-13.

Taken as a whole, registrant's identification is not so open-ended to include any possible service any business or organization may need. The wording, "financial, legal, corporate" provides the framework for the general scope of the identification. As such, the parameters of this

Serial No. 77722602

identification, including "other business related topics," extend only to the core aspects of a business. Applicant's training in diversity, community education and human relations is not a business-related topic except in an extremely broad sense of the term. The examining attorney's interpretation would include anything, for example, cafeteria services, where businesses provide access to meals onsite, or child care services, where businesses provide onsite daycare. Thus, we find that registrant's identification does not "encompass" applicant's services. Further, the wording in the identification, by itself, does not establish that such distinct subject matter is related to the "cultural diversity, community education and human relations" which are the subject matter of applicant's educational services. Nor is there anything in this record that would establish the relatedness between these two fields. For example, there is no evidence that shows diversity training services and printed matter on financial, legal, corporate, and other business-related topics being offered by a single source. The most relevant example is the third-party Registration No. 3033671 for the mark SHOP RITE UNIVERSITY, which lists printed educational materials and training services covering a wide range of topics, including project

Serial No. 77722602

management, career development, leadership, diversity, writing and grammar, communications, computers, software, business management, labor relations and human resources and marketing. However, this registration, which contains the subject matter of diversity and business management in the same identification as writing and grammar, computers and communications, is not sufficient to support a finding that diversity training and printed matter on financial, legal and corporate issues are related such that confusion is likely.

In view thereof, we find that applicant's services are not related to registrant's goods. Moreover, to the extent there is any overlap in the channels of trade and classes of customers, the applicant's services are sufficiently distinct from registrant's goods and would be purchased with sufficient care to preclude likely confusion. The nature of applicant's services is such that any potential consumer would be knowledgeable or discriminating and the purchasing decision would not be based on impulse but rather would be subject to a more deliberative process.²

² In making this determination, we have not considered the material attached to applicant's brief. That material is untimely, and the examining attorney's objection is sustained. Trademark Rule 2.142(d).

Serial No. 77722602

In conclusion, we find that because the goods and services are not related, confusion is not likely between applicant's mark for its identified services and the mark in the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.