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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shackleton S.A.

Serial No. 85450227

Arturo Perez-Guerrero of Law Offices of Arturo Perez-Guerrero for Shackleton S.A.

Douglas M. Lee, Trademark Examining Attorney, Law Office 111 (Robert L. Lorenzo, Managing Attorney).

Before Cataldo, Wellington and Masiello,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge.

Applicant, Shackleton S.A., filed an application, as amended, to register in standard characters on the Supplemental Register the mark SHACKLETON for "advertising agencies, advertising services" in International Class 35.¹

¹ Application Serial No. 85450227 was filed on October 18, 2011, seeking registration on the Principal Register under Section 44(e) of the Trademark Act, asserting ownership of Spanish Registration No. 2574105, issued on June 2, 2004. Applicant amended its application to seek registration on the Supplemental Register on February 11, 2013. "The wording SHACKLETON has no meaning in a foreign language."

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with its services, so resembles the mark shown below,



previously registered on the Principal Register for

Business consultation; Business consultation and management regarding marketing activities and launching of new products; Business consultation services to assist non-profit organizations in planning, managing, and conducting fund raising activities via a global computer network; Business consulting and business information for enterprises; Business consulting and information services; Assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization

in International Class 35,² as to be likely to cause confusion, mistake or deception.³ When the refusal was made final, applicant appealed.

² Registration No. 3559688 issued on January 13, 2009 with a disclaimer of GROUP. "The mark consists of navy blue compass to the left and the black wording "SHACKLETON GROUP" to the right of the compass." "The color(s) navy blue and black is/are claimed as a feature of the mark."

³ The examining attorney withdrew his refusal to register under Section 2(e)(4) in light of applicant's amendment to the Supplemental Register. Applicant satisfied all outstanding requirements issued by the examining attorney.

Applicant's Motion to Suspend

As a preliminary matter, we note that on April 26, 2013, applicant filed a motion to extend by 60 days its time to file a brief on appeal in this case in light of its assertion that it is engaged in negotiations with the owner of the cited registration for a consent agreement that would obviate the outstanding refusal to register under Trademark Act Section 2(d). In a paralegal order issued on May 16, 2013, the Board granted applicant's motion.

Thereafter, on June 25, 2013, applicant filed its brief on appeal, including a second motion⁴ requesting "one last 60 day extension in order to complete the settlement discussions and requests that the merits of this brief be considered once [t]he 60 [day] extension lapses." By its motion, applicant essentially requests suspension of its appeal for an additional 60 days to allow it to conclude negotiations for a consent agreement with the owner of the cited registration.

Based upon the showing made therein, applicant's June 25, 2013 motion is granted to the extent that proceedings herein are considered to have been so suspended.

⁴ Applicant's brief, p. 1.

We observe, nonetheless, that applicant's requested 60 day suspension period passed on August 24, 2013 and there is no indication from applicant that its attempt to reach a consent agreement with registrant was successful. We further observe that the examining attorney issued his first refusal, inter alia, under Section 2(d) based upon the cited registration on February 7, 2012, and denied applicant's request for reconsideration of his final refusal on February 15, 2013. Thus, applicant has been aware of the refusal to register, and its finality, for an ample amount of time. Finally, we observe that applicant has not requested any additional extensions of time or suspension of the proceedings herein.

Accordingly, we turn to the issue on appeal.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth 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, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis two key, though not exclusive, considerations are the similarities between the marks and

the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We first turn our attention to a comparison of the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751

(Fed. Cir. 1985). See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

In this case, applicant's mark, SHACKLETON, is similar to the registered mark,



in that applicant's mark is wholly incorporated within that of registrant. SHACKLETON, the sole term comprising applicant's mark, is the first and most distinctive term in that of registrant, given that the term GROUP in registrant's mark is disclaimed and appears to merely describe a feature or characteristic of its services.

Further, in the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products [and/or services]. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

For these reasons, we find that SHACKLETON is the dominant term in registrant's mark and accordingly it is entitled to more weight in our analysis. In coming to this conclusion, we do not discount the presence of the term GROUP and compass design in registrant's mark. However, for the reasons discussed above we find that the term SHACKLETON is more prominent and more likely to be remembered by consumers.

The term SHACKLETON as it appears in both marks, is identical in sound and connotation, and nearly identical in appearance. Furthermore, applicant's mark is presented in standard characters and therefore we must consider that it may be presented in the same stylization found in registrant's mark. *See In re Viterra Inc.*, 671 F.3d 1358,

101 USPQ2d 1905, 1909 (Fed. Cir. 2012). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000). As a result, we find that, when viewed in their entireties, the marks SHACKLETON and



are more similar than they are different and, overall, convey similar commercial impressions. That is to say, the marks appear to be variations of each other that nonetheless point to a common source. As such, this *du Pont* factor favors a finding of likelihood of confusion.

The Services

We turn now to our consideration of the identified services, noting that it is not necessary that the services at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's services are "advertising agencies, advertising services" and registrant's services are various business consultation, management, information and advisory services. Applicant devotes the majority of its brief to arguing that its services are neither similar nor complementary to those of registrant. The following arguments are illustrative:⁵

In other words, the cited registration covers in essence services related to how to run a company, be it a big company, a medium size company or a small company. None of these services are related, directly or indirectly with advertising services. These are simply different fields of expertise and companies constantly require advice in both of them. But again, there are services that are never provided by the same providers because managing a company and advertising its services and products are entirely different aspects of doing business. Advertising agencies do not give advice on how to internally organize and run a company, on how to distribute or allocate financial and human resources. Advertising companies are hired to sell a company's goods and services to potential clients and consumers. Advertising companies assist their clients in creating perceptions in the public's mind about their clients' goods and services.

Applicant's services relate to the advertising of a company's goods and services to the consuming public. There is nothing complementary about these activities. They are simply different, unrelated and non-competing. Accordingly, a client seeking advice in how to manage his or her company more efficiently would most certainly know that these services have nothing to do with

⁵ Applicant's brief, p. 3-5.

advertising services and would not believe that these services come from the same source, even if distinguished by the same mark, particularly when these are costly, not every day "purchases" and the time and effort deciding that [sic] service provider to engage will certainly be substantial and intensely thought of and analyzed.

In support of the refusal to register, the examining attorney has made of record evidence from six informational and commercial internet websites suggesting that firms providing advertising services also provide marketing services.⁶ While this evidence suggests that entities providing applicant's advertising agencies and advertising services also provide marketing services, it does not establish that such entities also provide registrant's recited "business consultation and management regarding marketing activities and launching of new products" or any other business-related services identified in the cited registration. As such the internet evidence made of record by the examining attorney only suggests a tangential relation between applicant's services and those of registrant. Nonetheless, we perceive a close logical relationship between consultation regarding marketing and

⁶ These include bohanideas.com and insightcubed.com, submitted with the February 7, 2012 Office action; as well as agenyppja.com, smallbusinessmarketingconsultant.com, smallbusinesschron.com and mdimarketing.com, submitted with the August 10, 2012 Office action.

product launches, on the one hand, and applicant's advertising services on the other. Advertising is a component of the marketing process; and it would not seem unusual for an advertising firm to consult with its customers as to this aspect of the customers' marketing activities.

In addition, the examining attorney has made of record numerous use-based third-party registrations, of which the following show that various entities have adopted a single mark for services identified in the involved application and cited registration:

Registration No. 3677609 for, *inter alia*, advertising and business management consultancy, advertising and business services, namely, securing airtime on all forms of media communications stations, systems, networks, and services for the purpose of promoting the goods and services of others, advice in the field of business management and marketing, business consultation and management regarding marketing activities and launching of new products;

Registration No. 3162190 for, *inter alia*, advertising consultation, business administration consultancy, business advisory services, consultancy and information, business management consulting with relation to strategy, marketing, production, personnel and retail sale matters;

Registration No. 4008420 for, *inter alia*, advertising, business and retail services, namely, business consultation in the field of revenue cycle management, advertising, business management, business consulting services;

Registration No. 4186242 for, *inter alia*, advertising and marketing services, business marketing consultation, business advertising and marketing consultancy;

Registration No. 4186318 for, *inter alia*, advertising and marketing, business consultation and management regarding marketing activities and launching of new products; and

Registration No. 4186681 for, *inter alia*, advertising and marketing, business consultation services.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). The evidence of record establishes that applicant's services are related to the services identified in the cited registration, and further may be identified under the same mark. As such, this *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

In making our determination regarding the relatedness of the parties' channels of trade, we look as we must to the services as identified in the involved application and cited registration. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Paula Payne Products v. Johnson*

Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

It is presumed that applicant's advertising and advertising agency services as well as registrant's business consultation, management, information and advisory services at issue move in all channels of trade normal for such services, and that they are purchased by all of the usual consumers for such services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958). Here, the examining attorney's third-party evidence clearly suggests that the services are related. Furthermore, neither recitation of services recites any restrictions as to the channels of trade in which they may be encountered. As such, this *du Pont* factor is, at worst, neutral.

Sophistication of Purchasers

Neither the application nor the cited registration includes any limitation on the customers to whom the respective services are rendered so we must consider the relevant purchasers to include all of the usual customers for the recited services. *See In re Elbaum*, 211 USPQ at 640.

While both advertising and business management, information and advisory services suggest that the relevant customers for the services at issue include businesses

exercising a degree of care, we note that small businesses (including sole proprietorships) and entrepreneurships advertise and seek business management and information services. While some of these customers are undoubtedly sophisticated in such matters, the potential purchasers for these services also include those of modest means and no more than an ordinary level of sophistication.

Even if we accept, in considering the fourth *du Pont* factor, applicant's assertion that the involved services may be the subject of sophisticated purchases, even careful purchasers are likely to be confused by highly similar marks used in connection with related services. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970).

Therefore, even if it is true in this case, the fact that the purchasers may exercise care before purchasing these services does not mean there can be no likelihood of

confusion. In the present case, the similarity between the marks and the similarity between the services as identified outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). As such, this *du Pont* factor is, at best, neutral or slightly favors a finding of no likelihood of confusion.

Summary

In light of the foregoing, we conclude that consumers familiar with registrant's services sold under its above-referenced mark would be likely to believe, upon encountering applicant's services rendered under its mark, that the services originate with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant and not, as urged by applicant, in its favor. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous*

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Pastry Shoppe, Inc., 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal under Section 2(d) of the Act is affirmed.