

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: April 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Capital Schools*  
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Serial No. 86931396  
Serial No. 87048675  
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Alan E. Schiavelli of Fitch, Even, Tabin & Flannery LLP  
for Capital Schools.

Rebecca A. Smith, Trademark Examining Attorney, Law Office 110,  
Chris A. F. Pedersen, Managing Attorney.

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Before Lykos, Masiello, and Heasley,  
Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Capital Schools DBA Capital Education (“Applicant”) filed applications for registration on the Principal Register of the two marks shown below, one in standard characters and the other in special form:

THE AUBURN SCHOOL<sup>1</sup>

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<sup>1</sup> Application Serial No. 86931396 was filed on March 7, 2016 on the basis of Applicant’s asserted use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating September 8, 2009 as the date of first use and first use in commerce. Applicant disclaimed the exclusive right to use SCHOOL apart from the mark as shown.



In each case, Applicant seeks registration of the mark for the following services:

Educational services, namely, providing courses of instruction for children at the early elementary to high school level with special needs; educational services, namely, courses of instructions in the field of math, science, language arts, social studies, foreign language, physical education, music and art for children at the early elementary to high school level with special needs; educational services, namely, providing summer camp programs for children at the early elementary to high school level with special needs, in International Class 41.

The Trademark Examining Attorney refused registration of both marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the marks, as used in connection with Applicant's services, so resemble the registered marks shown below as to be likely to cause confusion, or to cause mistake, or to deceive. The cited marks are registered in the name of a single owner for the services set forth in the table below:

Reg. No.	Mark	Services
2040157 <sup>3</sup>	AUBURN	educational services, namely university and community education, public lectures and workshops, seminars, and conferences, and

<sup>2</sup> Application Serial No. 87048675 was filed on May 24, 2016 on the basis of Applicant's asserted use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating June 27, 2011 as the date of first use and first use in commerce. Applicant disclaimed the exclusive right to use CAMP and SCHOOL apart from the mark as shown. Color is not a feature of the mark.

<sup>3</sup> Registered February 25, 1997 on the Principal Register under Trademark Act Section 2(f); Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

		entertainment services, namely sports exhibitions, theatrical productions, public lectures, art exhibitions, musical concerts, dance and ballet performances, and motion picture exhibitions, in International Class 41.
2047365 <sup>4</sup>	AUBURN UNIVERSITY	educational services, namely, university and community education, public lectures and workshops, seminars, and conferences, and entertainment services, namely, sports exhibitions, theatrical productions, public lectures, art exhibitions, musical concerts, dance and ballet performances, and motion picture exhibitions, in International Class 41.
2066511 <sup>5</sup>		educational services, namely, university and community education, public lectures and workshops, seminars, and conferences, and entertainment services, namely, sports exhibitions, theatrical productions, public lectures, art exhibitions, musical concerts, dance and ballet performances, and motion picture exhibitions, in International Class 41.
3746544 <sup>6</sup>		educational services in the nature of courses at the university level; educational services in the nature of providing community classes, seminars and workshops in the areas of arts, educational testing preparation, music, dance, computer technology, languages, horticulture, sports, personal finance, photography, real estate, health and recreation, youth programs, customized contract training and professional development, and crafts; and

<sup>4</sup> Registered March 25, 1997 on the Principal Register under Section 2(f); Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

<sup>5</sup> Registered June 3, 1997 on the Principal Register under Section 2(f), in part, as to AUBURN; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

<sup>6</sup> Registered February 9, 2010 on the Principal Register under Section 2(f), in part, as to AUBURN UNIVERSITY. No claim is made to the exclusive right to use UNIVERSITY apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

		conducting entertainment exhibitions in the nature of theatrical productions, public lectures, art exhibitions, music concerts, and dance performances, in International Class 41.
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In each case, when the refusal was made final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the requests for reconsideration and these appeals proceeded. The cases are fully briefed. We reverse the refusal of registration in each case.<sup>7</sup>

I. Refusal under Section 2(d).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). 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, 29 (CCPA 1976). In these cases, Applicant and the Examining Attorney have also submitted evidence and arguments regarding the fame of the cited marks and the number and nature of similar marks in use in connection with similar services.

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<sup>7</sup> The issues raised by the two appeals are highly similar. The briefs also are highly similar and the evidentiary records are virtually identical. Accordingly, we address both appeals in a single opinion. *See, e.g., In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion). Citations to the briefs and evidence refer to those filed with respect to Serial No. 86931396 unless otherwise noted.

In our analysis, we will focus on the cited standard character mark AUBURN in Reg. No. 2040157, because this mark is most similar to Applicant's marks and is registered, like the other cited marks, for university education and community education services. If confusion is found likely with respect to this mark, it will be unnecessary to consider Registrant's other marks; and if confusion is found not likely with respect to this mark, it would be unlikely with respect to the other cited marks. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The strength or weakness of Registrant's mark.

The Examining Attorney contends that Registrant's mark AUBURN UNIVERSITY is famous; and Applicant ripostes with the argument that the term AUBURN is weakened by widespread use of similar marks in the field of education. We will consider each of these contentions in turn.

(1) Fame.

Under the guidance of *du Pont*, we must consider the fame of the Registrant's mark if there is evidence of it. In *ex parte* matters, evidence of fame is usually not of record, because examining attorneys do not typically have access to the types of evidence that would demonstrate fame. *Cf. In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016) (examining attorney demonstrated fame of the mark JAWS). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214

F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

The Examining Attorney contends that the definition of “Auburn” in THE AMERICAN HERITAGE DICTIONARY indicates that Auburn is an Alabama city and “the seat of Auburn University ...” (*i.e.*, Registrant).<sup>8</sup> The Examining Attorney has attached a copy of the definition to her brief in Serial No. 87048675.<sup>9</sup> Although we often take judicial notice of dictionary definitions to determine the meanings of words, in this case, where the definition is proffered to demonstrate the important issue of fame, we decline to do so. Applicant prepared and filed its brief not knowing that it would be confronted with evidence of fame, and to present such evidence at this late stage of the proceeding necessarily puts Applicant at a disadvantage. In any event, even if we were to take judicial notice of the dictionary definition, it would not, in our view, demonstrate the fame of Auburn University. Dictionaries are full of information that is not known to members of the public; therefore, the fact that information appears in a dictionary does not necessarily show that it is a matter of “extensive public recognition and renown.” *Bose*, 63 USPQ2d at 1305.

The Examining Attorney also argues that “[Registrant] owns 111 trademark registrations ... for a wide variety of goods/services,” and lists such registrations in a footnote.<sup>10</sup> Listing registrations in a brief does not make the registrations of record,

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<sup>8</sup> Examining Attorney’s brief, 13 TTABVUE 8.

<sup>9</sup> Examining Attorney’s brief (87048675), 13 TTABVUE 21-23.

<sup>10</sup> *Id.*, n.1, 13 TTABVUE 9-13.

and the Board does not take judicial notice of USPTO registrations. *In re Olin Corporation*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1208.02 (June 2017). In any event, members of the public are not likely aware of the number of Registrant's trademark registrations; consequently, without more, such evidence indicates little with respect to Registrant's degree of renown. In sum, we find that the Examining Attorney has not demonstrated that Registrant's marks are famous.

(2) The number and nature of similar marks in use.

Applicant argues that the term AUBURN in Registrant's mark "is relatively weak and entitled to only a narrow scope of protection" because "the consuming public is exposed to third-party use of similar [marks] in connection with similar services."<sup>11</sup>

Applicant has made of record internet evidence showing a number of school districts having primary and secondary schools that operate under names that include the term AUBURN (such as "Auburn Middle School" or "Auburn Elementary School").<sup>12</sup> The evidence shows that there are such schools or school districts in Maine, Ohio, Michigan, Oregon, Kentucky, Washington, Virginia, Illinois, Wisconsin, Alabama, and New Hampshire. In all, the evidence shows approximately 20 such educational institutions, including a school district operating under the name "Auburn City Schools" in the city in which Registrant's university is located and from

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<sup>11</sup> Applicant's brief at 4-5, 11 TTABVUE 5-6.

<sup>12</sup> Applicant's response of August 23, 2017 at 11-89.

which its mark is derived (*i.e.*, Auburn, Alabama).<sup>13</sup> Most, but not all, of the schools are in geographic locations named “Auburn.”

The Examining Attorney seeks to minimize the probative impact of the evidence of third-party use, arguing:

These local schools are located in geographical places that include the term Auburn. For example, Auburn, WA, Auburn, ME and Auburn Hills, MI. None of these schools or school districts have applications or registrations for the use of the term Auburn. They are simply local geographic references to these cities. The Applicant is applying for a national registration for a mark including the term Auburn and is not located in a locale that is named Auburn as a geographic place.<sup>14</sup>

The evidence and arguments raise issues of both inherent strength (based on the nature of the term AUBURN itself) and its commercial strength (based on use in the marketplace). *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). The fact that AUBURN has been used repeatedly as the name of various geographic locations (including the city in which Registrant is located) indicates an inherent weakness in the term, because members of the public may perceive it as a geographic indicator, rather than as a source-indicator. In addition, evidence of extensive use of a term by others may reflect commercial weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Of course,

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<sup>13</sup> *Id.* at 77-78.

<sup>14</sup> Examining Attorney’s brief, 13 TTABVUE 13.

because Registrant's mark AUBURN is registered, the mark is presumptively valid and distinctive for its specified services. Trademark Act Sections 7(b) and 33(a), 15 U.S.C. §§ 1057(b), 1115(a); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007). Nonetheless, we may acknowledge the weakness of a registered mark in the course of a *du Pont* analysis. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016). We are not persuaded that Registrant's mark suffers commercial weakness as a result of third-party use. However, the fact that AUBURN is a geographic indicator lessens the term's inherent strength, affects the way customers would perceive different marks that contain the term AUBURN, and reduces the degree to which it would be perceived as an indicator of a single source.

B. The services.

We next consider the similarity or dissimilarity of the services as identified in the application and the cited registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We will focus our attention on Registrant's "university and community education" services, as these are the services that are most similar to Applicant's. While Applicant and Registrant both provide educational services (which would include "courses of instruction"), Applicant's services are directed only to "children at the early elementary to high school level with special needs."

In order to demonstrate that university services are related to educational courses for elementary and high school students, the Examining Attorney has submitted

evidence from the internet showing that colleges and universities offer educational programs for younger students.<sup>15</sup> In particular, the evidence shows the following youth services offered by colleges and universities:

University of California – Berkeley	“social skills camps for children with Nonverbal Learning Disabilities, High Functioning Autism, Asperger’s Syndrome, and children with similar social skills deficits.”
The University of Southern Mississippi	“Educational Outreach ... Deaf-blind resources ... providing family support and cost-effective technical assistance to families and service providers of children/young adults with deaf-blindness ... Gifted studies ... Language disorders ... designed to serve children with severe language-speech disorders ... Summer Camps ... programming that teaches high school students about the finer points of government and citizenship.”
Montgomery College	“Summer Youth Programs have dozens of classes for teens and High School students too.”
Duke University	“Duke Youth Programs is a part of Duke University Continuing Studies and has provided summer academic enrichment for academically motivated youth for over 30 years. ...All programs seek to engage learners in innovative, interactive, transformative learning experiences.”
Purchase College – State University of New York	“Summer Youth Programs in the Arts ... The summer youth programs in the arts at Purchase College provide a unique opportunity to spend the

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<sup>15</sup> Office Action of September 13, 2017 at 4-67.

	summer exploring the visual and performing arts – and more – under the guidance of experienced instructors and practicing artists.”
Delaware Technical Community College	“Youth Programs. We offer a variety of pre-college activities through the Workforce Development and Community Education Division. Our staff members provide education, enrichment, mentoring, and motivation to youth through a variety of educational and fun programs and camps.”
Purdue College of Education	“Summer Residential Camp. ... Fifth through twelfth grade students live in campus residence halls, take challenging courses, and participate in engaging recreational activities.”
St. Norbert College	“Opening Our Doors to Young Learners ... Children’s Center ... Music Camps and Festivals ... Girls Leadership and Development (GLAD) Summer Camp ... Boys Overall Leadership and Development (BOLD) Summer Camp ...Dual Credit Programs: Highly motivated high school students who are seeking a rigorous academic experience can take St. Norbert College courses for credit.”
Hudson County Community College	“Summer Youth Program 2017 ... both middle school and high school students can experience a variety of engaging and enriching programs.”
Massachusetts College of Art and Design	“We offer affordable, diverse programs for students in grades 3-12 ... PORTFOLIO DEVELOPMENT For students in Grades 9-12 ... DUAL ENROLLMENT For students in Grades

	11-12 ... SATURDAY STUDIOS For students in Grades 3-12 ...”
St. Louis Community College	“Youth Programs. The Continuing Education office offers a wide variety of programs and classes for kids of all ages at all four campuses: ....”
University of Wisconsin Marathon County	“Youth Programs ... College for Kids is a special summer enrichment program for children grades K-6.”
Rutgers	“Youth Programs. The Division of Continuing Studies offers a variety of youth educational opportunities and programs for diverse ages and interests. Pre-College Summer Academies. Choose from three intensive one-week certificate programs focused on engineering, STEM, and Leadership: ...”
Rowan College at Burlington County	“Summer Youth Programs and Clinics ... We look forward to sharing an educational and enriching summer program experience with your child or children.”
Clemson University	“Camps and Youth Programs. Academic Camps/Programs. ... Clemson University Summer Scholars ...Summer Science Camps ... USA Computing Olympiad ... Upstate Writing Project Day Camp ... “
Southeastern Louisiana University	“SUMMER PROGRAMS AND ACTIVITIES ... summer programs for young musicians includes a middle school band camp ... program for academically gifted and advanced children ... Summer Enhancement Camp is designed to assist campers in maintaining their reading and math skills during the summer.”

Oakland University	“Check out Oakland University’s 2017 Summer Career Camps for high school teens!”
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The Examining Attorney’s evidence demonstrates that many colleges and universities provide, as an adjunct to their university-level education services, education services directed to elementary and high school students. Such services appear to be what is contemplated by the identification “community education,” which appears in Registrant’s registrations. Accordingly, members of the public would likely believe that university services and educational services for elementary and high-school students might emanate from a single source. We note, however, that only two of the universities shown in the evidence (U.C. Berkeley and the University of Southern Mississippi) appear to offer services to children with special needs. Applicant argues that such special needs services “are highly specialized and different than general ‘community education ...’ sponsored by a university.”<sup>16</sup> As there is little evidence showing that universities offer such services, we question whether members of the public would readily expect that university services and special needs education services would emanate from the same source.

The Examining Attorney has also made of record numerous third-party registrations to demonstrate that the services of Applicant and Registrant are related. Third-party registrations that are based on use in commerce and that individually cover various different goods or services may have some probative value

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<sup>16</sup> Applicant’s brief at 4, 11 TTABVUE 5.

to suggest that the listed goods or services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The probative value of this type of evidence can vary, depending on the circumstances. In this case, although the evidence is voluminous, we do not find it particularly persuasive. Very many of the registrations have extremely lengthy identifications of services, suggesting that the registrants may be atypical. Many of the registrations are owned by individuals, who are necessarily different from the types of entities that provide university education; and few of the registrations are, in fact, owned by universities. Moreover, the evidence is not focused on demonstrating a connection between Registrant's services and special needs education. Overall, we do not find it persuasive with respect to the services at issue.

Although the services of Applicant and Registrant fall under the broad category of education, on this record we cannot conclude that special needs education at the elementary and high school levels is sufficiently related to Registrant's services to engender a likelihood of confusion among relevant consumers.

C. The marks.

We next consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "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). Moreover, marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

First, comparing the cited mark AUBURN with Applicant's standard character mark THE AUBURN SCHOOL, we find the marks highly similar in appearance, sound, and meaning, inasmuch as Applicant's mark includes within itself the entirety of Registrant's mark. The added terms THE and SCHOOL in Applicant's mark are points of difference in appearance and sound. However, they do little to distinguish the marks because SCHOOL is generic in the context of the services of both Applicant and Registrant. We find that the two marks create similar commercial impressions and, with respect to the mark THE AUBURN SCHOOL, the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

Turning next to a comparison of Applicant's special form mark to Registrant's mark, the marks are, again, similar to the extent that each includes the term AUBURN. However, Applicant's mark has many points of difference in appearance, sound, and meaning by virtue of the additional wording CAMP ARISTOTLE AT THE and SCHOOL, as well as the design elements and the graphic layout of the words. The term ARISTOTLE is by far the dominant element of the mark, by virtue of its presentation in lettering that is substantially larger than the other lettering, and because it is an arbitrary term and therefore strongly distinctive. The term AUBURN

is presented in the smallest lettering of the mark, embedded among other text and positioned at the bottom of the graphic display. It is therefore, in appearance, a subordinate component of the mark. The Examining Attorney argues that Applicant's mark "is worded such that consumers will understand that CAMP ARISTOTLE is part of THE AUBURN SCHOOL and is a smaller portion of that entity and that THE AUBURN SCHOOL is the source of the services."<sup>17</sup> This is a viable contention, and it is conceivable that in this case the tail can wag the dog. However, when we consider the mark in its entirety, as we must, we find its many points of difference in appearance, sound, and meaning sufficient to distinguish it from Registrant's mark. Therefore, in the case of Applicant's special form mark, the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

## II. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Applicant's standard character mark is highly similar to Registrant's mark AUBURN. However, we have found Applicant's special form mark to be quite dissimilar. Moreover, the element that the marks at issue have in common, AUBURN, has been shown to have geographic significance and to have been used by third-party educational institutions, often located in places named "Auburn." The likelihood that relevant customers would perceive AUBURN as a geographic term reduces the degree to which it would

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<sup>17</sup> Examining Attorney's brief (87048675), 13 TTABVUE 7.

be perceived as an indicator of a single source. Although the services at issue fall under the broad category of education, we are not persuaded that customers would readily expect a university to provide special needs education at the elementary to high school levels. Considering the differences between the services at issue and the inherent weakness of the term AUBURN, we find Applicant's marks sufficiently different from Registrant's marks to avoid giving rise to confusion as to the source of Applicant's services.

**Decision:** In each case, the refusal under Section 2(d) is REVERSED.