

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: June 4, 2020

Mailed: August 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Justice Without Borders

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Serial No. 87870907

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Patrick C. Muldoon of Duane Morris LLP,
for Justice Without Borders.

Carol Spils, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Zervas, Kuczma and English,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Justice Without Borders (“Applicant”) seeks registration on the Principal Register
of the combined word, letter and design mark



for the following International Class 45 services:

providing legal advice, legal support services, and litigation services in support of migrant workers in the fields of labor exploitation and human trafficking, not including services associated with international humanitarian relief projects or providing medical or health care assistance to victims of disasters and/or conflicts in underdeveloped countries.¹

The mark is described as consisting of “a globe with the phrase ‘JUSTICE WITHOUT BORDERS’ superimposed over the globe, and the ‘J’ over the word ‘JUSTICE’, the letter ‘W’ over the word ‘WITHOUT’, and the letter ‘B’ over the word BORDERS’.”

Color is not claimed as a feature of the mark.

The Examining Attorney refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark is likely to cause confusion with the registered typed² mark JWB for “legal services for on-line global computer network” in International Class 42.³

After the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on

¹ Application Serial No. 87870907, filed on April 10, 2018 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use on November 1, 2013 and first use in commerce on January 14, 2014.

² Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

³ Registration No. 2285619 (twice renewed).

a likelihood of confusion. See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”); see also *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). “Not all of the [*DuPont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

The *DuPont* factors addressed by Applicant and the Examining Attorney are discussed below.

a. Similarity of the Marks

We first consider whether Applicant’s and Registrant’s marks are similar when viewed in their entirety in terms of appearance, sound, connotation and commercial impression. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1689). The test under this *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the

marks are sufficiently similar that confusion as to the source of the services offered under the respective marks is likely to result. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Coach Servs. Inc.*, 101 USPQ2d at 1721. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

While we must consider the marks in their entirety, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks than to the less distinctive elements in determining whether the marks are similar. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here 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 consideration of the marks in their entirety.”).⁴ When a mark comprises both words and a design, the words are normally accorded greater weight because they are more likely to be impressed upon a purchaser’s memory and would typically be used by purchasers to request the goods or services. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012). The same general principle applies to composite marks involving letters and designs because letters, like words, are more likely to be

⁴ Applicant states that “the Examining Attorney relies solely upon the letters and ignores the actual words in the Mark ...” Applicant’s brief at p. 4, 4 TTABVUE 5. This is not correct and ignores the holding in *Nat'l Data* quoted above. It also ignores what the Examining Attorney stated in the final Office Action, “In the applied-for mark, the letters ‘JWB’ appear in the center of the design and are much larger than the wording in the mark. In the registered mark, ‘JWB’ is the actual mark.” March 15, 2019 Office Action, TSDR 1.

recalled than designs and to be used in verbalizing composite marks in the course of referring to the mark owner or requesting its goods or services.

Registrant's entire mark is JWB. The most notable part of Applicant's mark is the same lettering JWB because it is prominently displayed in very large lettering superimposed on the center of the globe design (functioning as a background design) and above the wording JUSTICE WITHOUT BORDERS in far smaller letters.⁵ Likelihood of confusion has been found where the entirety of one mark is encompassed by another. *See, e.g., The Wella Corp, v. Calif. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with the mark CONCEPT for cold permanent wave lotion and neutralizer); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP for "engineering services in the field of computer hardware, integrated circuits, communications hardware and software and computer networks for others" and BARR for "engineering services" confusingly similar); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) ("Richard Petty's Accu Tune" for automotive service centers specializing in engine tune-ups and oil changes likely to cause confusion with "Accutune" automotive testing equipment.).

The marks are similar, of course, in that both marks contain the lettering JWB. These letters would be read first when considering Applicant's mark because of their

⁵ Applicant agrees that the JWB component of its mark is "the most significant in size." Applicant's brief at p. 5, 4 TTABVUE 6.

prominent display. “[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). *See also Palm Bay Imps.*, 73 USPQ2d at 1692 (“The presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar ...”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Thus, while we do not ignore JUSTICE WITHOUT BORDERS in Applicant’s mark, we find this wording to be subordinate to the letters JWB.

As noted, Registrant’s mark is a typed mark. With such marks, the rights reside in the wording or other literal element and not in any particular display or rendition. *See Viterra*, 101 USPQ2d at 1909; *Mighty Leaf Tea*, 94 USPQ2d at 1260. Registrant’s mark hence may be displayed in the same lettering style as Applicant’s mark.

Applicant argues:

Of the three elements in the applied-for-mark, only the letters JWB are shared with the registered Mark, however they are the most specific and thus the least likely to be recalled. More likely the phrase “Justice Without Borders” and the image of the globe establish the general impression. The individual letters of JWB while only significant in size are akin to license plate numbers in which they are also the most significant in size, however other than the first letter are the most unimpressible.⁶

We are not persuaded by Applicant’s arguments for several reasons. First, consumers have a tendency to shorten marks. *Giant Food, Inc. v. Nation’s*

⁶ *Id.*

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) (“we cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the “T.H.” in referring to registrant’s stores [T.H. MANDY].”). JWB is easier to articulate than “Justice Without Borders” and those who perceive Applicant’s mark are being instructed on how to abbreviate the mark, within the mark itself through the emphasis of the letters JWB. Second, the alphanumeric characters on a license plate are not abbreviations for matter on the license plate and serve a different function than a term intended as a source indicator for certain services. Third, the alphanumeric characters on the license plate depicted in Applicant’s brief – JSR-7531 – include seven letters and numerals, while Applicant’s mark includes only three letters. Three letters are simply easier to recall. Thus, the analogy to a license plate is not apt.

In view of the foregoing, we find the marks in their entirety are similar.

b. Similarity of Services

Services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475

(Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

We evaluate the relatedness of the respective services based on their identifications in the subject application and cited registration. *Stone Lion Capital Partners*, 110 USPQ2d at 1162. *See also Octocom Sys. Inc. v. Hous. Computs. Servs. 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.”); *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [or services]”).

For convenience, we repeat the services involved herein. Registrant’s services are identified as “legal services for on-line global computer network.” Applicant’s services are identified as:

providing legal advice, legal support services, and litigation services in support of migrant workers in the fields of labor exploitation and human trafficking, not including services associated with international humanitarian relief projects

or providing medical or health care assistance to victims of disasters and/or conflicts in underdeveloped countries.

The Examining Attorney maintains that Registrant's services pertain to any legal service which is provided online "including applicant's legal services which may be provided online, [and which] have an online global computer network presence"; and that "any providers of legal services have an online global computer network presence and also use online portals or other online resources."⁷ In addition, the Examining Attorney argues that Registrant "provide[s] legal services for the online global computer network, such as intellectual property services,"⁸ emphasizing that "the same source may provide the legal services of both applicant and registrant since firms and other legal sources often provide a variety of different types of legal services to a wide range of industries, including immigration related legal services and legal services for the online global computer network, such as intellectual property legal services."⁹ For support, the Examining Attorney relies on webpage printouts submitted with the March 15, 2019 Office Action of the following law firms which provide legal services in both the intellectual property and immigration fields, which the Examining Attorney states includes "services for non-immigrants and temporary workers, as well as advice, litigation services, and the use of online technology by the firm, including an IP Portal":¹⁰

⁷ Examining Attorney's brief, 6 TTABVUE 9.

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.* at TTABVUE 10-11.

Ballard Spahr¹¹

Barley Snyder

Duane Morris

Hill Wallack

Moore & Van Allen

Polsinelli

Smith Amundsen

Thompson Hine

Applicant argues that “the legal services of the registered mark are directed to the network, not general legal services offered over the internet, but for the internet, whereas the services for the applied-for-mark are ‘in support of migrant workers.’ These are distinct and unrelated areas of Law”¹²; and that “[t]he Examining Attorney has not shown that there is an overlap between the services of the registered mark and the applied-for-mark, especially in view of the narrow and unique services of the applied-for mark.”¹³ Alternatively put, “[t]he Examining Attorney has not shown, that firms routinely or ever offer legal services to global online networks and legal services related to labor exploitation and human trafficking services to migrate [sic] workers, nor would a relevant consumer make such an assumption.”¹⁴

An identification of services must be given its broadest possible interpretation. *See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007).

¹¹ One Ballard Spahr webpage lists “Internet” as a substantive area under “Intellectual Property” services. March 15, 2019 Office Action, TSDR 9.

¹² Applicant’s brief at p. 6, 4 TTABVUE 7.

¹³ *Id.* at p. 7, 4 TTABVUE 8.

¹⁴ *Id.*

With this in mind, we turn first to the Examining Attorney's contention that Registrant's identification of services identifies a substantive area of the law, internet law, which includes aspects of intellectual property law. Under this interpretation, which we find plausible, we find that the involved services are related to each other. Applicant's services are a subset of immigration and perhaps labor law,¹⁵ particularly as they apply to migrant workers, and immigration and labor law are fields of law serviced by the same law firms under one service mark. The evidence hence demonstrates a commercial relationship between these services.

Further, we agree with the Examining Attorney that Registrant's services as identified also encompass legal services in any substantive area of the law but offered on the Internet, and find that Applicant's services are encompassed within Registrant's services. Under this interpretation of the identification of services, Registrant's services are not limited to any specific field of law and therefore may include the specific field noted in Applicant's identification of services, but provided through the Internet. The record includes evidence that legal services are provided on the Internet - *see* Duane Morris' webpage which states that the firm offers its "clients Web access to our firm [-] wide case management system, the Duane Morris IP Portal. ... Through the Duane Morris IP Portal, clients can access ... a wealth of information about their patent and trademark portfolios, including status updates on

¹⁵ *See* references to labor law from the materials submitted with the March 15, 2019 Office Action, such as "we work seamlessly with the firm's other practice areas including Employment and Labor ..." (Barley Snyder, TSDR 7), "labor certifications" (Duane Morris, TSDR 13) and "[t]his approach is particularly vital in the area of immigration law, which is closely associated with labor and employment issues." (Hill Wallack, TSDR 21).

filings, alerts to upcoming deadlines and information useful in litigation preparation.”¹⁶

In sum, we find that the Examining Attorney has established that there is a viable relationship between Applicant’s and Registrant’s services if Registrant’s services are interpreted to be restricted to intellectual property law, and that Applicant’s services are encompassed within Registrant’s services if they are interpreted to mean the provision of legal services in any field, but via the Internet.

c. Channels of Trade and Purchasers

In our inquiry under the *DuPont* factor regarding trade channels and classes of purchasers, we also look to the identifications of services of the application and the cited registration. *See Stone Lion Capital Partners*, 110 USPQ2d at 1161; *Octocom Sys.*, 16 USPQ2d at 1787; *Paula Payne Prods.*, 177 USPQ at 77.

The third-party website evidence submitted by the Examining Attorney demonstrates that Applicant’s services may be offered via the same virtual marketplace (that is, on the same websites by the same entity) to all relevant classes of purchasers, i.e., individuals or their employers seeking legal assistance in the fields contained within the involved application, or within the fields noted in Applicant’s and Registrant’s identifications of services. In addition, to the extent that Registrant’s identified services encompass Applicant’s services, we may presume that the channels of trade and classes of purchasers are the same. *See Viterra*, 101

¹⁶ March 15, 2019 Office Action, TSDR 19.

USPQ2d at 1908 (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”)); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

d. Conclusion

We have considered all of the evidence in the record and the arguments of the Examining Attorney and Applicant. The marks are similar and the services, purchasers and trade channels overlap or are otherwise related. We therefore conclude that Applicant’s mark for its services would be likely to be confused with Registrant’s mark for its services.

Decision: The refusal to register is affirmed.