

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Marshfield Consulting LLC
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Serial No. 88099557
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Joshua A. Schaul of Garvey Adam LLP,
for Marshfield Consulting LLC.

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

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Before Mermelstein, Ritchie, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Marshfield Consulting LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark MARSHFIELD CONSULTING (CONSULTING disclaimed) for “Business technology software consultation services; Consulting services in the field of software as a service (SAAS),” in International Class 42.¹

¹ Application Serial No. 88099557 was filed on August 30, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark and first use of the mark in commerce since at least as early as August 10, 2018.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the registered mark shown below



for the following services in International Class 42:

Information technology consulting and advisory services; Consulting and advisory services in the fields of design, selection, implementation, use and integration of computer hardware and software systems for others; Computer services, namely, providing virtual and nonvirtual application servers, web servers, file servers, co-location servers, load balancing servers, redundancy servers, media servers and database servers to others; Computer services, namely, systems and data integration and migration services for databases, computer networks, computer systems, and computer software legacy systems for others; Computer services, namely, computer disaster recovery planning and data recovery services; Technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; Technical support services, namely, monitoring of network systems; Technical support services, namely, remote administration and management of in-house and hosted datacenter devices, databases and software applications; Installation of computer software, web and database software applications in the healthcare and healthcare insurance fields; Software consulting and advisory services in the field of electronic medical records; Application service provider (ASP) featuring software for use in the healthcare field to facilitate business and clinical practice management, accounting and financial reporting, billing, managed care and insurance claims processing, and electronic data interchange, patient and medical center staff scheduling, prescriptions generation and processing, medical inventory management, generation of physician

referrals and consultations, ordering and generation of medical laboratory test results, ordering and generation of patient health and wellness informational printouts, medical decision support, medical research support, and the creation, editing, organization, searching, transmission, storage and sharing of electronic medical records, images, and data for patients and healthcare providers; Data mining and analysis of patient demographics, delivered treatments, treatment outcomes, and healthcare costs,²

as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive.

After the refusal was made final, Applicant appealed and requested reconsideration, which was denied. The appeal is fully briefed.³ We reverse the refusal to register.

I. Record on Appeal⁴

The record on appeal includes Applicant's specimen of use, and the following materials:

² The cited Registration No. 4883924 issued on January 12, 2016. Its owner, Marshfield Clinic Information Systems, Inc. ("Registrant"), disclaimed the exclusive right to use CLINIC INFORMATION SERVICES apart from the mark as shown, and showed under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), that the words MARSHFIELD CLINIC have acquired distinctiveness for the identified services. The record does not reveal the basis of Registrant's acquired distinctiveness showing. Registrant describes its mark as consisting "of the letters 'MCIS' to the right of a stylized Greek cross formed of stacked blocks, and to the left of the words 'MARSHFIELD CLINIC' stacked above 'INFORMATION SERVICES.'"

³ Citations in this opinion to the briefs refer to TTABVue, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVue corresponds to the docket entry number, and any numbers following TTABVue refer to the page number(s) of the docket entry where the cited materials appear.

⁴ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

- Pages from the USPTO's databases regarding the cited registration, made of record by the Examining Attorney;⁵
- Internet webpages of companies that provide technology, software, and computer services, including to the healthcare industry, made of record by the Examining Attorney;⁶
- Pages from the Flaticon website reflecting medical iconography, made of record by Applicant;⁷
- A dictionary definition of the word "clinic" as an "establishment or hospital department where outpatients are given medical treatment or advice, especially of a specialist nature," made of record by Applicant;⁸
- Pages from the website at springcm.com discussing SpringCM document and contract management software, made of record by Applicant;⁹ and
- "Pairs" of third-party registrations of marks containing similar elements and covering services similar to those identified in the application and cited registration, made of record by Applicant.¹⁰

⁵ December 21, 2018 Office Action at TSDR 2-4.

⁶ *Id.* at TSDR 5-33; March 2, 2019 Final Office Action at TSDR 2-52; October 1, 2019 Denial of Request for Reconsideration at TSDR 2-54.

⁷ February 4, 2019 Response to Office Action at TSDR 14-17.

⁸ *Id.* at TSDR 18 (OXFORD LIVING DICTIONARIES (US English)).

⁹ *Id.* at TSDR 19-25.

¹⁰ September 3, 2019 Request for Reconsideration at TSDR 10-43.

II. Analysis of Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Applicant and the Examining Attorney both discuss these key factors. 9 TTABVUE 11-20; 11 TTABVUE 5-16. Applicant also invokes the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” *DuPont*, 177 USPQ at 567. 9 TTABVUE 20-27.

A. Similarity or Dissimilarity of the Services and Channels of Trade

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of the services in the application and the cited registration, not on extrinsic evidence of the actual uses of the involved marks. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).¹¹

¹¹ Applicant pays lip service to this principle in acknowledging that “[t]he nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application and registration,” 9 TTABVUE 18-19 (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1207.01(a)(iii)), and that it “is imperative to consider the goods and services as identified in the respective identifications.” *Id.* at 19. Applicant then argues, however, that its “services, as demonstrated in the specimen filed with the instant application, details [sic] that [its] consulting services are focused on implementation of SpringCM software,” while “Registrant’s services focus exclusively in the medical field as detailed in its specimen” *Id.* Applicant cannot restrict the scope of the services identified in its application by extrinsic evidence of use where its identification is unrestricted. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Similarly, although some of Registrant’s services are expressly identified as “focus[ing] exclusively in the medical field,” 9 TTABVUE 19, the most pertinent services are not, and as to them, we “have no authority to read any restrictions or limitation into the registrant’s description,” *In re I-Coat Co.*, 126 USPQ2d 1730, 1739 (TTAB 2018) (quoting *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009)), nor may Applicant “restrict [their] scope . . . by argument or extrinsic evidence.” *Id.* (citations omitted). Accordingly, we disregard Applicant’s extrinsic evidence of use of the involved marks and its arguments that the Examining Attorney’s evidence of the relatedness of the services “does not provide the requisite examples that [sic] SpringCM software consulting as offered by” Applicant, 9 TTABVUE 19, and that its “services are marketed to users of SpringCM software while Registrant’s services are marketed and directed to health care professional entities, clearly separate and distinct industries.” *Id.* at 20. Applicant is silent as to the identifications of services per se.

It is “not necessary that the [services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.* (quoting *7-Eleven*, 83 USPQ2d at 1724).

The Class 42 services identified in the application are “Business technology software consultation services; Consulting services in the field of software as a service (SAAS).” The cited registration contains an extensive list of Class 42 services, but the Examining Attorney need not prove, and we need not find, similarity between each of the services identified in the application and each of the services identified in the cited registration. It is sufficient if one of the services identified in the application is similar to one of the services identified in the cited registration. *See, e.g., Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).¹² The most pertinent services identified in the cited registration are “Information technology consulting and advisory services,” “Consulting and advisory

¹² Applicant argues that “a majority of Registrant’s services are ‘computer technical support services’ whereas Applicant’s services are exclusively focused on business software consulting,” 9 TTABVUE 19, and dismisses the Examining Attorney’s third-party use evidence as “not on point” because none of it “focuses on computer technical support which is the majority of Registrant’s services.” *Id.* at 20. As discussed above, the Examining Attorney need not show that more than one, much less a majority, of the services identified in the cited registration are related to Applicant’s identified services.

services in the fields of design, selection, implementation, use and integration of computer hardware and software systems for others,” and “Software consulting and advisory services in the field of electronic medical records.”

The Examining Attorney argues that “Registrant’s services may include applicant’s services and vice versa,” 11 TTABVUE 10, and that “[b]oth marks identify consultation services for software and technology purposes and the services may overlap.” *Id.* at 11. She argues that wording in the registration such as “Information technology consulting and advisory services” and “Consulting and advisory services in the fields of design, selection, implementation, use and integration of computer hardware and software systems for others” is broad and “presumably encompasses all services of the type described, including applicant’s services,” *id.* at 15, and that Applicant’s “Business technology software consultation services” and “Consulting services in the field of software as a service (SAAS)’ may include registrant’s services of ‘Software consulting and advisory services in the field of electronic medical records.’” *Id.*

The Examining Attorney also points to webpages showing that companies “provide a wide variety of technology, software, and computer services including, more specifically, consulting services in the fields of software as a service and business technology software as well as information technology consulting services, consulting in designing software, and technical support services . . .” *Id.* at 11.

“We begin with the identifications of . . . services in the registration and application under consideration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *5

(TTAB 2019). Unlike some of the services in the cited registration, such as “Installation of computer software, web and database software applications in the healthcare and healthcare insurance fields,” the services identified in the application as “Business technology software consultation services” have no field of use or other restrictions. Accordingly, we must presume that those “services encompass all services of the type identified.” *Id.* at *4 (quoting *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015)).¹³ We agree with the Examining Attorney that Applicant’s broad “Business technology software consultation services” encompass the services more narrowly identified in the cited registration as “Software consulting and advisory services in the field of electronic medical records.”¹⁴ Those services are thus legally identical. *See, e.g., In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013). “This finding under the second *du Pont* factor supports a conclusion that a likelihood of confusion exists.” *Id.*¹⁵

¹³ As noted above, Applicant may not limit the broad scope of its identification by extrinsic evidence of its current actual use of the mark. “This would be improper because the services recited in the application determine the scope of the post-grant benefit of registration.” *Stone Lion*, 110 USPQ2d at 1162. Parties like Applicant “that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application.” *Id.*

¹⁴ The Board may take judicial notice of dictionary definitions, including from online dictionaries. *See, e.g., In re Omniome, Inc.*, 2020 USPQ2d 3222, *2 n.17 (TTAB 2020). We take judicial notice that the word “consultation” in Applicant’s identification means “the act of consulting or conferring.” MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on May 14, 2020). Applicant’s identification of services uses “consultation” and “consulting” interchangeably to describe the services.

¹⁵ In view of the partial legal identity of the services, we need not make a determination as to the relatedness of the other services. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015). The record shows, however, that the “Business technology software consultation services” and “Consulting services in the field of software as a service (SAAS)” services identified in the application, and the “Information technology consulting and advisory services,” “Consulting and advisory services in the fields of design, selection,

Because these services are legally identical, we must presume that the trade channels and purchasers for the services are likewise identical. *Aquamar*, 115 USPQ2d at 1126 (citing *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed Cir. 2012)). The third *DuPont* factor also supports a finding of a likelihood of confusion.

B. Purchasing Conditions

“The fourth DuPont factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.’” *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that the “test for buyer sophistication is the often cited ‘prudent purchaser’ test, articulated in *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 107 F.2d 699, 704, 43 U.S.P.Q. 262 (10th Cir. 1939): ‘The test is whether the similitude in the labels would probably deceive a purchaser who exercises ordinary prudence, not the careless buyer who makes no examination.’” 9 TTABVue 21. This is an incorrect statement of the applicable law. In *Stone Lion*, the Federal Circuit recognized that “Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *Id.* at 1163 (quoting *Gen. Mills, Inc. v. Fage*

implementation, use and integration of computer hardware and software systems for others,” and some of the healthcare-related services identified in the cited registration, are frequently offered by the same companies. March 2, 2019 Office Action at TSDR 2-7, 8-12, 13-20, 21-37, 38-52; October 1, 2019 Denial of Request for Reconsideration at TSDR 2-7, 8-13, 14-26, 27-38, 39-45, 46-54.

Dairy Proc. Indus. S.A., 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014)).¹⁶

Applicant's argument under the fourth *DuPont* factor is again based on the circumstances of its actual use, not the identification of services in the application.

Applicant argues that

[i]ts services are consulting in the implementation and deployment of SpringCM software. Appellant charges an hourly [sic] are over \$200/hour and average consulting products entail at least 150 hours of work on Appellant's part. Thus, for a typical installation and/or configuration consultation matter, Appellant charges at least \$30,000. At these prices, it is clear the exercise of ordinary prudence on the part of Appellant's customers would be employed to ensure the rollout of SpringCM software was performed properly and according to the customer's specifications. Moreover, at a minimum of \$30,000, confusion is almost non existence [sic] for once a potential customer understood the breadth and scope of Appellant's services, namely consulting in the fiend [sic] of SpringCM software, it would be readily apparent whether Appellant and its MARSHFIELD CONSULTING services were what the potential customer was looking for. Further, the lead time to establish a potential customer as an actual customer is several months, plenty of time for said customers to vette [sic] Appellant to ensure the consulting services offered are in line with what the potential customer had in mind (e.g., SpringCM consulting v. medical management consulting).

9 TTABVUE 21.

¹⁶ Applicant cites five other non-Federal Circuit cases in its discussion of the fourth *DuPont* factor, 9 TTABVUE 20-22, and multiple non-Federal Circuit cases on other factors. These cases are not helpful to us because we must apply Federal Circuit law on all of the *DuPont* factors.

Applicant's focus on the claimed sophistication of its actual customers is improper as a matter of law.¹⁷ In *Stone Lion*, which involved legally identical investment advisory, investment fund management, and capital investment consultation services, the Federal Circuit held that the Board properly "focused on the sophistication of all *potential* customers of the parties' services as they are recited in the application and registrations," *Stone Lion*, 110 USPQ2d at 1162 (quotation omitted), not just the parties' actual current customers, who the parties agreed were sophisticated. *Id.* We must do likewise here.

The potential customers of the "Business technology software consultation services" broadly identified in the application are not limited to those seeking "implementation and deployment of SpringCM software" who are "charged over \$200/hour" and pay Applicant "at least \$30,000" for such installation, 9 TTABVue 21, but are entities and persons who need software consulting, including individuals, sole proprietors, and small businesses. *Cf. Stone Lion*, 110 USPQ2d at 1162 (Board properly found that "investment advisory services" and "capital investment consultation" services "could be offered to, and consumed by, anyone with money to invest, including ordinary consumers seeking investment services"). There is no evidence that the least sophisticated potential consumer of "business technology software consultation services" is likely to exercise anything other than ordinary care

¹⁷ It is also based solely on argument of counsel, which is "no substitute for evidence." *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, *14 (TTAB 2019) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (internal quotation omitted)).

in purchasing the services. We find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.¹⁸

C. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019).

The proper test regarding similarity “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.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the

¹⁸ Applicant argues that “[e]ven assuming, arguendo, that [Applicant’s] software consulting services and Registrant’s computer support services are similar, numerous cases permit registration of identical or similar goods/services if the purchaser is sophisticated.” 9 TTABVUE 22. The referenced “numerous cases” are third-party registrations that Applicant claims demonstrate that “similar services are routinely offered by different owners using similar marks/brands.” *Id.* at 22-27. The existence of these registrations is irrelevant to our analysis of the likelihood of confusion in this case. *See, e.g., In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, *9-11 (TTAB 2020).

average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

The partial legal identity of the services “reduce[s] the degree of similarity between the marks necessary to find a likelihood of confusion.” *Aquamar*, 115 USPQ2d at 1126 (citations omitted). Applicant acknowledges that such “authority is legion,” 9 TTABVUE 27, but argues that its mark is so different from the cited mark “that even when [the marks are] used on in-part identical goods [sic], confusion is unlikely.” *Id.* at 27-28.

Applicant makes multiple arguments for dissimilarity of its MARSHFIELD CONSULTING mark to the cited mark shown again below:¹⁹



Applicant first argues that the marks are visually distinct when considered in their entireties because of the different words in the marks and because Applicant’s mark “comprises two words” while Registrant’s “mark comprises one design, one initialism and . . . four words.” *Id.* at 14.

¹⁹ One is that the cited mark is weak because it “is descriptive since ‘clinic information services’ relates to a feature of Registrant’s services, namely, Application service provider (ASP) featuring software for use in the healthcare field.” 9 TTABVUE 10. As noted above, Registrant has disclaimed the exclusive right to use those words, but the USPTO issued the cited Principal Register registration following Registrant’s showing of acquired distinctiveness as to the words “Marshfield Clinic.” We agree with the Examining Attorney that “Applicant provides no evidence to support [its] assertion that the registrant’s mark is weak,” 11 TTABVUE 9, and that “marks deemed ‘weak’ or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods and/or services.” *Id.*

Applicant next argues that the marks are audibly distinct because “the term CONSULTING is noticeably absent from Registrant’s mark,” Registrant’s mark “contains the terms MCIS and CLINIC and INFORMATION and SERVICES which are obviously missing from [Applicant’s] mark,” and Applicant’s mark contains five syllables, while Registrant’s mark contains 15. *Id.* at 15.

Finally, Applicant argues that the marks are “unequivocally distinguishable in commercial impression,” *id.* at 16, because the cross design in Registrant’s mark “is ubiquitous iconography with the medical industry and/or services,” and the word CLINIC has a medically-related meaning, *id.*, which together give Registrant’s mark “a meaning and connotation of medical consulting and advisory services.” *Id.* at 17. Applicant contrasts that meaning with the meaning of its mark, which it claims “does not in any way evoke medical and/or medicinal services.” *Id.*

The Examining Attorney argues that the marks are similar because “[b]oth the applied-for and registered marks contain the identical word MARSHFIELD, which is identical both in spelling and pronunciation.” 11 TTABVUE 5. According to the Examining Attorney, “MARSHFIELD is the dominant element in both marks,” *id.* at 7, because “[i]n the applied-for mark, the word ‘CONSULTING’ is descriptive and disclaimed” and in “the registered mark, the wording ‘CLINIC INFORMATION SERVICES’ is descriptive and disclaimed and the acronym ‘MCIS’ simply modifies the mark and stands for the wording in the mark, MARSHFIELD CLINIC INFORMATION SERVICES,” *id.*, and “the recollection of the average purchaser will be that of the dominant term ‘MARSHFIELD.’” *Id.* at 10. She also argues that the

word portion of the cited composite word-and-design mark should be given less weight than its design element, and that because Applicant's mark is a standard character mark, it "may be displayed in any lettering style, including the particular display and lettering style as the wording in the registered mark." *Id.* at 8.

In response to the Examining Attorney's argument regarding the dominant portion of the marks, Applicant argues in its reply brief that MCIS, not Marshfield, is the dominant portion of the cited mark because "MCIS is both physically larger and more prominent (i.e. bold) than the term MARSHFIELD." 12 TTABVUE 3.

The linchpin of the Examining Attorney's similarity arguments is her claim that "MARSHFIELD is the dominant element in both marks." 11 TTABVUE 7. We agree with her that MARSHFIELD is the dominant element of Applicant's mark because it is the first word in the mark and the word CONSULTING that follows MARSHFIELD has been disclaimed as descriptive of (if not generic for) the "consultation" and "consulting" services identified in the application. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1049. We disagree, however, with her conclusion that MARSHFIELD also dominates the cited mark, which we reproduce again below for ease of reference in following our analysis:



As the Examining Attorney correctly notes, in composite word-and-design marks such as the cited mark, "the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them,

and be used by them to refer to or request the goods and/or services.” 11 TTABVUE 8 (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181 (TTAB 2018)). It does not follow, however, that among the literal elements of the cited mark, the word “Marshfield” is necessarily its dominant element. The cited mark’s design element may not be verbalized, or otherwise used “to request the [services],” *Aquitaine Wine*, 126 USPQ2d at 1184, but the initialism MCIS and the words “Marshfield Clinic Information Services” can each be so used, and as between the two, MCIS is “[d]isplayed in a large, bold typeface, [and] comprises the largest literal portion of the mark in terms of size, position, and emphasis. It is also the first term in the mark, further establishing its prominence.” *Id.* at 1184-85. From the standpoint of “the average customer, who retains a general rather than specific impression of marks,” *i.am.symbolic*, 127 USPQ2d at 1630, the visual prominence and positioning of the initialism MCIS strongly suggest that it, not “Marshfield,” is the dominant portion of the mark.

Perhaps more importantly, as the Examining Attorney acknowledges, MCIS “stands for the wording in the mark, MARSHFIELD CLINIC INFORMATION SERVICES.” 11 TTABVUE 7. Initialisms and acronyms leverage the well-established “penchant of consumers to shorten marks.” *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (citation omitted). The large bolded initialism MCIS in the cited mark gives consumers a user-friendly shorthand for the four words “Marshfield Clinic Information Services” that appear next to it in much smaller text. We can safely assume that Registrant included the initialism in its mark, and made it more

prominent than the words “Marshfield Clinic Information Services,” because it is far easier to remember, verbalize, and write four letters than four words. *See Amica Mut. Ins. Co. v. R. H. Cosmetics Corp.*, 204 USPQ 155, 163 (TTAB 1979) (finding that opposer’s adoption of its AMICA mark, “an acronym from the name of opposer’s initial predecessor [Automobile Mutual Insurance Company of America],” was “to avoid a ‘mouthful’”).

Because of the visual and positional prominence of the initialism in the cited mark and its function as an abbreviation for the accompanying words, we find that the initialism MCIS is the dominant portion of the cited mark because it is the portion of the mark that is most likely to be remembered and used to refer to Registrant and to call for its services. We turn now to the required comparison of the marks in their entireties, keeping in mind the prominence of the word MARSHFIELD in Applicant’s mark, and the prominence of the initialism MCIS in the cited mark.

The Examining Attorney’s argument regarding the similarity of the marks in the first two means of comparison is that “both marks contain the identical wording MARSHFIELD, with respect to spelling and pronunciation.” 11 TTABVUE 6. With respect to appearance, the Examining Attorney is correct that because Applicant’s mark is a standard character mark, we must assume that the words MARSHFIELD CONSULTING “may be presented in any font style, size or color,” *Aquitaine Wine*, 126 USPQ2d at 1186, “because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size or color.” *Id.*

(citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 673 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)).

We are uncertain as to what display the Examining Attorney contemplates in her argument that Applicant's mark could be displayed in "the particular display and lettering style as the wording in the registered mark," 11 TTABVUE 8, but "illustrations of the mark as actually used may assist [us] in visualizing other forms in which the mark may appear." *Citigroup*, 98 USPQ2d at 1259. Applicant's specimen of use, a page from its website, displays the mark as follows:



This display of the mark emphasizes the word MARSHFIELD by depicting it in large capital letters and deemphasizes the disclaimed word CONSULTING by depicting it beneath MARSHFIELD in much smaller lowercase letters.

As shown and discussed above, the largest and most visually prominent portion of the cited mark is the initialism MCIS. The words "Marshfield Clinic Information Services" are relatively more difficult to read and, more importantly, to recall and visualize in the mind's eye. As explained above, the display of the initialism MCIS is intended to make it unnecessary to do either. Some consumers may recall and visualize both the initialism MCIS and the exact words for which it stands, but it is far more likely that a consumer exposed to the cited mark will recall and visualize

²⁰ August 30, 2018 Specimen of Use at TSDR 1.

“MCIS” rather than the four words “Marshfield Clinic Information Services,” the two words “Marshfield Clinic” (as to which Registrant showed acquired distinctiveness and which appear in larger type than the disclaimed words “Information Services”), or the word “Marshfield” alone. Even if the initialism MCIS is recalled as appearing with some of the words, the recalled mark bears no particular resemblance to the words MARSHFIELD CONSULTING when they are displayed as they appear above, or in some other manner that accentuates the word MARSHFIELD and deemphasizes CONSULTING. We find that the marks are dissimilar in appearance from the standpoint of the average consumer with only a general recollection of the cited mark.

With respect to sound, the Examining Attorney argues that both “marks contain the identical word MARSHFIELD, which is identical in . . . pronunciation.” 11 TTABVUE 5. That is not relevant, however, to how the marks are likely to be verbalized. Applicant’s mark would be verbalized as “MARSHFIELD CONSULTING” or perhaps “MARSHFIELD” alone, but given the nature and structure of the cited mark, it is more likely that it would be verbalized as “MCIS” than as “Marshfield Clinic Information Services,” “Marshfield Clinic,” or “Marshfield,” with or without the initialism. The initialism MCIS in the cited mark is intended to make it unnecessary to verbalize the “mouthful” that is the phrase “Marshfield Clinic Information Services,” *Amica Mut. Ins.*, 204 USPQ at 163, or the words “Marshfield Clinic” or “Marshfield.” Given Registrant’s showing of acquired distinctiveness as to the words “Marshfield Clinic,” we may infer that some consumers will recall and verbalize the

cited mark as “MCIS Marshfield Clinic,” but given the “penchant of consumers to shorten marks,” *Bay State Brewing*, 117 USPQ2d at 1961, it is far more likely that it will be verbalized simply as “MCIS.” In any event, that verbalization, the verbalization of the mark as “MCIS Marshfield Clinic,” and the verbalization of the entire “mouthful” “MCIS Marshfield Clinic Information System,” are dissimilar in sound to MARSHFIELD CONSULTING.

Finally, with respect to meaning, which the Examining Attorney does not specifically address, 11 TTABVUE 5-10,²¹ the most likely general recollection of the cited mark is as the initialism MCIS. It is not likely, much less certain, that all or even most consumers will recall that the initialism stands for “Marshfield Clinic Information Services.” As a general matter, “companies are frequently called by shortened names, such as Penney’s for J.C. Penney’s, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward’s for Montgomery Ward’s, and Bloomies for Bloomingdale’s,” *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992), and the use of the initialism MCIS is intended to make it unnecessary to recall the full name and mark of the Registrant, or even shortened versions such as “Marshfield Clinic” or “Marshfield,” to identify Registrant and its services. If the cited mark is recalled simply as MCIS, there is no

²¹ The Examining Attorney appears to rely on the claimed similarities in appearance and sound to establish the similarity of the marks. As noted above, similarity in any of the means of comparison may render two marks confusingly similar, but we have found that the marks are dissimilar in the means of comparison on which the Examining Attorney focuses.

discernable similarity in connotation or commercial impression to MARSHFIELD CONSULTING or its shortened version MARSHFIELD.

To the extent that consumers recall more than MCIS alone, the four letters in the initialism logically encourage consumers to try to recall the four corresponding words for which the initialism stands. For the reasons discussed above, that is a tall order. Registrant made a showing that the words “Marshfield Clinic” had acquired distinctiveness, so it appears more likely that consumers would recall that portion of the initialism than all four words. In any case, to the extent that the four words “Marshfield Clinic Information Services,” the two words “Marshfield Clinic,” or the Greek cross are recalled together with the initialism MCIS, they connote services provided to a clinic, which the dictionary definition of record indicates is suggestive of the medical field, particularly in the context of the various medical-related services identified in the registration. On its face, Applicant’s MARSHFIELD CONSULTING mark does not have a similar connotation or commercial impression.

We find that the marks are dissimilar in appearance, sound, and connotation and commercial impression. The first *DuPont* factor weighs against a finding of a likelihood of confusion.

D. Balancing the *DuPont* Factors

The first *DuPont* factor weighs against a finding of a likelihood of confusion, while the second and third *DuPont* factors support such a finding, and the fourth *DuPont* factor is neutral. In balancing the factors, we conclude that even though the partial legal identity of the services reduces the degree of similarity between the marks

necessary for confusion to be likely, the marks are sufficiently dissimilar under that standard to avoid a likelihood of confusion. *See In re Medline Indus., Inc.*, 2020 USPQ2d 10237, *13 (TTAB 2020) (citing *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998); and *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991)).

Decision: The refusal to register is reversed.