

This Opinion is not a
Precedent of the TTAB

Mailed: September 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Kyle Meade
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Serial No. 88141931
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Joshua A. Schaul of Garvey Adam LLP,
for Kyle Meade.

Andrea B. Cornwell, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Zervas, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Kyle Meade (Applicant) seeks registration on the Principal Register of the mark ACCIAL CAPITAL, in standard characters, for “Financial services, namely, investment advice, investment management, investment consultation and investment of funds for others, including private and public equity and debt investment services,” in International Class 36.¹ Applicant has disclaimed CAPITAL.

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¹ Application Serial No. 88141931 was filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1(a), on October 3, 2018 claiming dates of first use anywhere and in commerce of August 24, 2018.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used with the identified services, so resembles the marks:

AXIAL, in standard characters, for "Financial advice; Financial advice and consultancy services; Financial advisory and consultancy services; Financial and investment services, namely, asset and investment acquisition, consultation, advisory and development; Financial consultancy," in International Class 36,² and

 AXIAL in stylized form, for "Financial advice; Financial advice and consultancy services; Financial advisory and consultancy services; Financial and investment services, namely, asset and investment acquisition, consultation, advisory and development," in International Class 36,³

as to be likely to cause confusion, mistake or deception. When the refusals were made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. The case is fully briefed. We affirm the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. With its appeal brief, Applicant submitted a list of third-party registrations, none of which was previously introduced into the record during prosecution.⁴ Relying on Rule

² Registration No. 4499379, issued March 18, 2014.

³ Registration No. 4512159, issued April 8, 2014.

⁴ 10 TTABVUE 25-34. Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board's TTABVUE docket system.

2.142(d), 37 C.F.R. § 2.142(d), the Examining Attorney objects to this list of registrations submitted by Applicant as untimely. Rule 2.142(d) states:

The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

As set forth in the Rule, the record should be complete prior to the filing of the appeal. Additionally, submitting a list of registrations generally is not sufficient to make them of record. To make third-party registrations of record, copies of the registrations, either a copy of the paper USPTO record, or a copy taken from the electronic records of the USPTO, should be submitted. *See, e.g., In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record).

Recognizing that the new evidence was both untimely and insufficient, Applicant, in its reply brief, requested that the Board remand the application to the Examining Attorney so that Applicant may put into the record copies of the registrations underlying the listed third-party registrations.⁵

A request for remand contained in the body of a reply brief is not sufficient for the Board to treat it as a proper request for remand. *See In re Hollywood Lawyers Online*,

⁵ 13 TTABVUE 5. The Board, in an order dated August 21, 2019 denied the request to remand as improperly made. 15 TTABVUE. For the sake of completeness, we address the evidence and the request for remand.

110 USPQ2d 1852, 1859 (TTAB 2014) (“To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand.”). Furthermore, even if we treat Applicant’s request for remand as properly made, Applicant has not explained why the evidence could not have been previously obtained and made of record during prosecution, given that all of the listed third-party registrations issued before Applicant filed its first response to the Examining Attorney’s refusal. Thus, Applicant’s request for remand fails to show the requisite good cause. *See In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (request for remand denied for failure to show good cause so late in the appeal). We sustain the Examining Attorney’s objection, and the request for remand is denied. We have not considered the list of third-party registrations submitted with Applicant’s brief.

II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the services and the similarities between the marks. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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.”).

Because the AXIAL mark in Registration No. 4499379 and the services identified therein are most similar to Applicant's mark and its identified services, we focus our likelihood of confusion analysis on this AXIAL mark. If we do not find a likelihood of confusion with this registered mark and its services, then there would be no likelihood of confusion with the mark in the other registration. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Number and nature of similar marks in use with similar services

Under the sixth *DuPont* factor, we first consider “[t]he number and nature of similar marks in use [in connection with similar services].” *DuPont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks in connection with similar goods and services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant argues that:

Based on the clearly large number of AXIAL/AXIS marks that incorporate additional portions that are similar or even nearly identical, it appears that the USPTO has consistently taken the position that variations in the physical appearances of the marks, as well as the goods associated with the marks, are sufficient to distinguish one AXIAL/AXIS mark from another and not cause a likelihood of confusion, despite the similarity in the additional portions of the marks.⁶

⁶ Applicant's Br., p. 12, 10 TTABVUE 19.

In support, Applicant submitted nineteen copies of third-party registrations for allegedly similar marks used in connection with financial services, as well a list of seventy-one such registrations.⁷

Applicant's argument that the registered mark is entitled to only a narrow scope of protection is unpersuasive. None of the third-party registrations comprise the term AXIAL. Instead, they appear to be comprised of terms that simply begin with the letters "AX", e.g., AXIS, AXEL, AXONIA, AXIUS, AXUMIS, AXIOM, AXESS, AXCESS, AXES, AXON, AXA, and the like. The applicable *DuPont* factor is the "number and nature of **similar marks** on similar goods [or services]." *DuPont*, 177 USPQ at 567 (emphasis added). We do not find any of the marks introduced by Applicant to be similar to the registered mark. Thus, the fact that different marks have registered, even for the same financial services, does not establish that AXIAL is weak.

Of all the foregoing third-party marks, only ones comprising the term AXIS are remotely related to the term AXIAL. Even assuming, *arguendo*, that these third-party marks comprising AXIS could be considered similar to AXIAL for purposes of determining its strength, Applicant has introduced only four registrations for AXIS-formative marks used in connection with financial services.⁸ Four such registrations

⁷ Applicant's Response to Office Action dated February 12, 2109, TSDR pp. 15-26; Applicant's Response to Office Action dated April 5, 2109, TSDR pp. 15-26. Inasmuch as the Examining Attorney did not object to the list of third-party registrations for AX-formative marks, we have considered them for what is shown on the list. *See In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012).

⁸ Reg. No. 4411670 for BLUEGREENAXIS, Reg. No. 4452111 for DTCC PAYMENT AXIS, Reg. No. 3690711 for AXIS, and Reg. No. 5521941 for DIRECT AXIS.

fall well short of the “voluminous” evidence required to establish that AXIS or AXIAL is so commonly used that the public will look to other elements to distinguish the source of the goods or services. *Cf. Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1673 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (discussing “voluminous evidence” of registration and use of paw print design elements). *See also Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark).

We find that the cited mark is not weak, and we accord it a normal scope of protection.

B. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression

Next, we consider the similarity of the marks. In comparing the marks, we must consider their appearance, sound, connotation, and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1692. The emphasis of our analysis must be on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. Although we consider the marks as a whole, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Similarity in any one of the elements of sound, appearance, meaning, or commercial impression suffices to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”); *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.”).

Applicant’s mark is ACCIAL CAPITAL, in standard characters. The registered mark is AXIAL, also in standard characters. Applicant’s specimen submitted with its application states that ACCIAL is “pronounced ak-see-uhl.”⁹ We find that the marks are similar in sound inasmuch as the terms ACCIAL and AXIAL are likely to be pronounced the same. That is, the dominant portion of Applicant’s mark and the only element in the registered mark are pronounced the same. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data* 224 USPQ at 751.

The presence of the descriptive and disclaimed term CAPITAL in Applicant’s mark does not change the meaning, or commercial impression of Applicant’s mark sufficiently to distinguish it from the registered mark. The similarity in pronunciation suggests a similarity in meaning and Applicant’s web page indicates

⁹ Application of October 3, 2018, TSDR p. 3.

that Applicant's mark is intended, in part, to suggest the term AXIAL: "ACCIAL is a combination of two words: ACCESS and AXIAL."¹⁰ Incorporating the entirety of one mark within another and simply adding a descriptive, commonly used term typically does not obviate the similarity between the marks, nor does it overcome a likelihood of confusion under Section 2(d). *Cf. In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) ("[T]he presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.").

In sum, we find the similarity of the marks in their entireties as to sound, meaning, and commercial impression support a finding that the marks are confusingly similar. *Krim-Ko Corp.*, 156 USPQ at 526; *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007). This *DuPont* factor weighs in favor of a finding of a likelihood of confusion with respect to the cited registration.

C. Comparison of services, channels of trade, and classes of consumers

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014), while the third *DuPont* factor concerns "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *Id.* at 1161.

The Examining Attorney need not prove, and we need not find, similarity as to each activity listed in the description of services. It is sufficient for a refusal based on

¹⁰ *Id.*

likelihood of confusion that relatedness is established for any item encompassed by the identification of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Both Applicant and Registrant are providing financial services that are, in part, legally identical, namely, financial services, comprising investment advice and consulting. Further, the Examining Attorney introduced website excerpts from a number of financial services companies, such as Charles Schwab & Co., Gallant Financial Planning, Next Wave Wealth, Revolution Group, Montoya Wealth Management, Vermont Wealth & Retirement, Oswald Financial, Variphase Financial Partners, Granite Investment Advisors, and Lazard Asset Management, establishing that the same entity commonly provides investment advice and management services and markets the services under the same mark.¹¹

Given that the respective services are legally identical in part, and given the lack of restrictions on trade channels and classes of customers in the recitations of services, we presume that these services travel through the same channels of trade to the same classes of customers, namely those seeking investment advisory and consulting services. *See Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1162.

Applicant does not contest the Examining Attorney's arguments or evidence regarding these factors. The second and third *DuPont* factors thus weigh heavily in favor of finding a likelihood of confusion.

¹¹ Denial of Request for Reconsideration dated April 23, 2019, TSDR pp. 2-30.

D. Conditions of sale

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues that customers of the respective financial services are sophisticated because its minimum investment threshold is \$5 million and Registrant’s services involve companies with \$5-150 million in revenues.¹² Applicant further claims “high net-worth financial services are traditionally bespoke affairs involving the financial details of persons and corporations, often with minimum investment commitments before an advisor will take on a new client.”¹³

Applicant’s argument is predicated upon perceived limitations of services that do not appear in the application or cited registration. While Registrant’s website may reveal that its services are currently so limited, we must base our decision on its services as identified, which define the scope of Registrant’s rights arising from its registrations. Neither the application nor the registration limit the identifications to “high net-worth financial services” or “minimum investment commitments.” Accordingly, the applicable standard of care for the likelihood of confusion analysis is that of the least sophisticated consumer, i.e., the general public. *Primrose Retirement Communities*, 122 USPQ2d at 1039 (citing *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d at 1163). There is no evidence in the record establishing that

¹² Applicant’s Br., p. 13, 10 TTABVUE 20.

¹³ *Id.*

general-public consumers of the financial services identified in the application and registration are sophisticated or would exercise a high degree of care. *See, e.g., Lincoln Nat'l Corp. v. Anderson*, 110 USPQ2d 1271, 1283 n.18 (TTAB 2014) (where relevant consumers of banking, financial planning, and investment services consisted of both ordinary and knowledgeable and sophisticated consumers, “this factor certainly would not weigh significantly in applicant’s favor.”).

In the absence of any evidence establishing relevant-consumer sophistication, the fourth *DuPont* factor is neutral.

E. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant’s arguments relating thereto, including those arguments not specifically addressed herein, we conclude that there is a likelihood of confusion between Applicant’s mark, ACCIAL CAPITAL, and the mark AXIAL in the cited registration.

Decision: The refusal under Section 2(d) to register Applicant’s mark is affirmed.