

THIS DISPOSITION IS NOT
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DEC 10, 97

Paper No. 10
EWH/KP

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Ecogroup, Inc.**

Serial No. 74/**636,465**

Richard R. Mybeck for **Ecogroup, Inc.**

Lori S. Schulman, Trademark Examining Attorney, Law Office
103 (**Michael Szoke**, Managing Attorney).

Before **Cissel**, **Hanak** and **Walters**, Administrative Trademark
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

Ecogroup, Inc. (applicant) seeks registration of
BUSINESS EDGE in typed capital letters for "publications,
namely, customized reports which educate consumers regarding
their energy usage fluctuations" and for "business services,
namely, the accumulation of relevant data and the
preparation of a report based thereon to educate consumers
regarding their energy usage fluctuations." The application
was filed on February 21, 1995 with a claimed first use date

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for both the goods and the services of April 27, 1994. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use the word BUSINESS apart from the mark in its entirety.

The Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Trademark Act on the basis that applicant's mark, as used in connection with applicant's goods and services, is likely to cause confusion with the mark BUSINESSEGE, INC., previously registered in typed capital letters for "business consulting services." Registration No. 1,658,490. The owner of this registration disclaimed the exclusive right to use INC. apart from the mark in its entirety.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and services and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative affect of differences in the essential characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, we find that they are nearly identical. The only differences are the applicant depicts BUSINESS EDGE as two words whereas registrant depicts it as one word, and registrant's mark includes the non-source identifying INC.. Applicant itself has acknowledged "the 'near identicality' of the marks in this case." (Applicant's brief page 3).

Turning to a consideration of registrant's services and applicant's goods and services, two propositions must be kept in mind. First, when "the marks are the same or almost so [as is the case here], it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding, 222 USPQ 355, 356 (TTAB 1983). See also 3 J. McCarthy, McCarthy on Trademarks At Unfair Competition Section 23:20 at page 23-46 (4th ed. 1997).

Second, it must be remembered that "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a -vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

The Examining Attorney has made of record excerpts from the NEXIS database showing that the term "business consulting services" (registrant's services) is broad enough to include consulting services related to energy issues, and in particular, energy usage. One such excerpt is from the Los Angeles Times of January 29, 1996, and it reads, in part, as follows: "The energy company will also announce the creation of a new unregulated subsidiary, Edison Source, to provide business consulting services about energy efficiency and environmental matters."

In addition, the Examining Attorney has made of record copies of third-party registrations showing that business consulting services have been identified as specifically relating to energy issues, including energy usage.

In response, applicant has acknowledged that "a great deal of 'evidence' was submitted [by the Examining Attorney] to show that business consultation services are being performed by multiple third parties in relation to energy use. Appellant does not dispute such third party services, nor that 'business consulting can also focus on one particular industry or issue such as energy use.'"

(Applicant's brief page 5). However, applicant "does dispute the notion that general business consultation services necessarily involve consultation on energy use." (Applicant's brief page 5).

The problem with applicant's argument is that the services of the cited registration are described quite broadly as simply "business consulting services" without any limitation. Thus, as described, registrant's services are broad enough to encompass applicant's services. Moreover, when registrant's services are so broadly described (see Canadian Imperial), said services are very closely related to applicant's goods.

Given the "near identicality" of applicant's mark and registrant's mark and the fact that registrant's services, as set forth in the registration, are broad enough to encompass applicant's services and are very closely related to applicant's goods, we find that the use of applicant's mark is likely to result in confusion.

Decision: The refusal to register is affirmed.

R. F. Cissel

E. W. Hanak

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board