

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

AUG 5, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **McGladrey & Pullen**

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Serial No. 74/**583,259**

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**James C. Nemmers, Esq.** for McGladrey & Pullen.

**Rudy R. Singleton**, Trademark Examining Attorney, Law Office 109  
(**Deborah S. Cohn**, Managing Attorney).

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Before **Simms, Hohein** and **Walters**, Administrative Trademark  
Judges.

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

McGladrey & Pullen has filed an application to register  
the mark "RSM INTERNATIONAL" and design, as reproduced below,

**RSM**  

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**international**

for the services of "business and account auditing, accounting services, tax management consulting, and business planning and consultation."<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the mark "RSM," which is registered for "business management consulting services,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Turning first to consideration of the respective services, applicant argues that its "services are consulting and counseling services that are custom, business-specific, interactive consultations provided on a one-to-one basis or in very small groups in which the operation of a specific business is assessed by personal interviews and surveys after which Applicant's representatives work with a management team to brainstorm solutions and discuss implementation of a specific action plan." In such a situation, applicant insists, "the business-client **always** knows with whom it is dealing" (**emphasis in original**), which in this case is "one of the major accounting and consulting firms in the United States." By contrast,

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<sup>1</sup> Ser. No. 74/583,259, filed on October 7, 1994, which alleges dates of first use of January 1993. The word "INTERNATIONAL" is disclaimed.

<sup>2</sup> Reg. No. 1,899,142, issued on June 13, 1995, which sets forth dates of first use of April 1, 1993.

applicant asserts, it "has learned that the prior registrant is a very small *consulting engineering firm* and therefore does not and cannot provide [in connection with its business management consulting services] the 'business and account auditing, accounting services, tax management consulting, and business planning and consultation' services of the Applicant" (*italics in original*).

However, as the Examining Attorney accurately points out, applicant's and registrant's services are identical in part inasmuch as "registrant's broad recitation of services could include the applicant's services," at least with respect to applicant's "business planning and consultation" services being subsumed within registrant's "business management consulting services." In this regard, the Examining Attorney further correctly notes that:

Proper analysis ... requires a determination of a likelihood of confusion on the basis of the services as identified in the application and registration. If the cited registration describes the services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all services of the type described, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Thus, and since applicant concedes in its brief that, indeed, "it is possible that Applicant may initially offer its services to some of the same class of customers as the prior registrant" (underlining in original), it is readily apparent that if identical or otherwise closely related business management

consulting services and business planning and consultation services are offered under the same or similar marks, confusion as to the source or sponsorship thereof is likely to occur.

Considering, then, the respective marks, we disagree with applicant's contention that the marks "are clearly different in both sound and appearance," when considered in their entireties, "because of the additional word 'INTERNATIONAL' [in applicant's mark,] which also communicates a meaning different from the mark of the prior registration[,] which consists only of the word 'RSM'." We concur, instead, with the Examining Attorney's analysis that the respective marks "are highly similar" inasmuch as registrant's mark comprises the arbitrary term "RSM" while "applicant's mark consists of the same RSM term in conjunction with the disclaimed term INTERNATIONAL." As recognized by the Examining Attorney, while it is well established that marks must be considered in their entireties and any disclaimed matter cannot be ignored, it is nevertheless the case, as set forth in *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985), that, in articulating reasons for reaching a conclusion on the issue of likelihood 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, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." For instance, "that a particular feature is descriptive or generic with respect to the involved goods or

services is one commonly accepted rationale for giving less weight to a portion of a mark ...." 224 USPQ at 751.

Here, as pointed out by the Examining Attorney:

[T]he term INTERNATIONAL has little trademark significance because it is descriptive of the scope of the applicant's services. The applicant has admitted to the descriptive nature of the term by disclaiming it. See *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) .... The applicant further admits [in its brief] that the term "is indicative of the availability of the Applicant's services on an international basis." ....

Moreover, as observed by the Examining Attorney, that the arbitrary term "RSM" is "the more significant and dominant feature" of applicant's "RSM INTERNATIONAL" and design mark is apparent from the facts that:

The term appears in bold capital letters above the other components of the mark. The RSM term has been underscored by a horizontal bar or line. The line has little trademark significance as a design feature. Instead, the line appears to merely underline the RSM term and further enhance its dominance.

Below the dominant term RSM, the ... wording INTERNATIONAL appears in lower case and in a smaller font than RSM. In addition to being disclaimed, the smaller font and subordinate position of the term INTERNATIONAL make the term less significant.

Thus, rather than serving to dispel a likelihood of confusion, we agree with the Examining Attorney that "the addition of the term INTERNATIONAL is more likely to lead potential patrons to believe that the applicant's ... RSM INTERNATIONAL services originate from an international division associated with the registrant's RSM services."

Finally, with respect to applicant's assertions that the analysis and reasoning in *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), and *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), "are directly applicable to the case at bar," the Examining Attorney accurately notes that such decisions are factually distinguishable and hence inapposite. Specifically, as the Examining Attorney persuasively explains:

In *Hearst*, the applicant's [VARGA GIRL] mark's dominant portion was not identical to the registrant's [VARGAS] mark. In *Bed & Breakfast*, the Court noted the descriptive nature of the common terms [BED & BREAKFAST] of the applicant's [BED & BREAKFAST REGISTRY] and registrant's [BED & BREAKFAST INTERNATIONAL] marks. In the present case, [by contrast,] the applicant's mark['s] dominant portion consists of an arbitrary term identical to the registrant's mark. Even if consumers could remember [or noticed] the differences between the marks, it is highly likely that prospective consumers would believe that [identical and otherwise closely] related services using the similar marks emanate from the same source. *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987).

Accordingly, we conclude that clients and prospective customers, familiar with registrant's "RSM" mark for "business management and consulting services," would be likely to believe, upon encountering applicant's highly similar "RSM INTERNATIONAL" and design mark for, in particular, "business planning and consultation" services, that such identical in part and otherwise closely related services emanate from an international division of registrant or are in some other manner sponsored by or affiliated with the same source.

**Decision:** The refusal under Section 2(d) is affirmed.

R. L. Simms

G. D. Hohein

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