

Hearing:
October 7, 1998

Paper No. 15
SIMMS/md

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG. 24, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Burke, Inc.**

Serial No. 75/045,982

Patricia B. Hogan of **Dinsmore & Shohl** for **Burke, Inc.**

Karen B. Leetzow, Trademark Examining Attorney, Law Office
101 (**Chris Wells**, Managing Attorney)

Before **Simms**, **Quinn** and **Chapman**, Administrative Trademark
Judges.

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

Burke, Inc. (applicant), an Ohio corporation, has
appealed from the final refusal of the Trademark Examining
Attorney to register the mark shown below

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for market research services.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC § 1052(d), on the basis of Registration No. 1,350,006, issued July 16, 1985, for the mark THE BURKE INSTITUTE ("INSTITUTE" disclaimed) for providing classes and seminars in marketing research. The registration was issued to Burke Marketing Services, Inc., and thereafter assigned to Bases Burke Institute, Inc. Applicant has appealed from this refusal, briefs have been submitted and an oral hearing was held.

In order to more completely understand the facts in this case, a brief summary of the procedural history and the relationship between applicant and registrant will be discussed.

In the Examining Attorney's first Office action, registration was refused on the basis of the registration indicated above as well as Registration No. 1,297,988, issued September 25, 1984, covering the mark shown below for marketing research services.

¹ Application Serial No. 75/045,982, filed January 19, 1996. The application is based upon applicant's claim of use in commerce since July 3, 1995. The Examining Attorney had also refused registration on the ground that the mark was primarily merely a surname under Section 2(e)(4) of the Act, 15 USC § 1052(e)(4), but the applicant submitted a satisfactory showing of acquired distinctiveness under Section 2(f) of the Act, 15 USC § 1052(f).

That registration also issued to Burke Marketing Services, Inc. and was thereafter assigned to Burke Marketing Research, Inc. and eventually to applicant, Burke, Inc. That registration issued under Section 2(f) of the Act, and a combined Sections 8 and 15 declaration was submitted.

After the initial refusal, applicant responded by claiming ownership of the '988 registration. Applicant indicated that the cited registration, the '006 registration, was previously owned by applicant's predecessor and then assigned to Bases Burke Institute, Inc. Applicant stated that that entity brought suit in the Southern District of Ohio (captioned BBI Marketing Services, Inc. v. Burke Marketing Research, Inc.). That litigation was resolved by a settlement agreement between the parties, after the court found that the plaintiff was not likely to succeed on the issue of likelihood of confusion during a preliminary injunction hearing. The settlement agreement, executed by BBI Marketing Services,

Inc. and applicant (Burke, Inc.), among other things, provided:

7. BURKE [applicant] agrees, for a period of two (2) years from the effective date of this Settlement Agreement, to include on each publicly distributed advertisement for seminars in marketing research offered by BURKE, a disclaimer indicating that the seminars being offered by BURKE are not affiliated with "The Burke Institute" or "BBI Marketing Services, Inc."

8. BURKE agrees that it will include a notation or statement to the effect that "The Burke Institute" is a registered service mark of BBI Marketing Services, Inc. any time the term "The Burke Institute" is used in BURKE's marketing or promotional materials.

9. BURKE agrees for a period of two (2) years from the effective date of this Settlement Agreement to use the BURKE LOGO [either the instant mark or applicant's registered mark] in connection with each of its seminars in marketing research and on all advertising for such seminars.

Upon entry of this agreement, the complaint was dismissed with prejudice.

Examining Attorney's Arguments

In the next office action, the Examining Attorney withdrew the refusal with respect to the '988 registration but again refused registration on the basis of the '006 registration covering the mark THE BURKE INSTITUTE for

providing classes and seminars in marketing research. Essentially, the Examining Attorney took the position that the settlement agreement was not an acceptably worded consent agreement for purposes of registration and did not detail the reasons why no likelihood of confusion existed or the arrangements which the parties were undertaking to avoid public confusion. Indeed, the Examining Attorney argued that the requirement by the agreement that applicant include a disclaimer that its services are not associated with the registrant recognized that a likelihood of confusion existed. The Examining Attorney argued that the agreement did not restrict the respective marketing channels or fields of use of the marks. Nor did the agreement explicitly contain a consent by registrant to registration by applicant. The Examining Attorney argued that applicant's mark was similar in commercial impression to the registered mark THE BURKE INSTITUTE because the dominant element of the marks is the word BURKE. The Examining Attorney also contended that applicant's market research services and registrant's educational services were closely related. The Examining Attorney made of record third-party registrations showing various marks registered to different entities for both market research services and classes in marketing research topics, in an

attempt to show that these services might be expected to come from the same entity. As noted, the Examining Attorney took the position that the settlement agreement is not the equivalent of a consent agreement to registration and that applicant has not specified the steps it will take to avoid consumer confusion after the initial two years covered by the agreement.

Applicant's Arguments

In support of registration, applicant argues that the written agreement settling the federal law suit constitutes a valid consent agreement which is substantial evidence that confusion is unlikely, and that applicant is the owner of a registration for a nearly identical mark for the same services covered by this application. With respect to the settlement agreement, applicant contends that both it and registrant have operated with knowledge of the other's use of the respective marks since June 1989, when the registrant became a separate corporate entity. Because registrant was using its mark in connection with the conducting of classes and seminars in marketing research, registrant's efforts were directed at limiting applicant's use in connection with educational services, applicant contends. According to applicant, the registrant has not only consented to use by applicant of the mark herein

sought to be registered but has "required" it in the settlement agreement. Applicant argues that the fact that the agreement covers only applicant's use of its mark in connection with seminars supports the view that applicant's market research services, which are the subject of this application, will not be viewed by the relevant public as emanating from the same source, if offered under the mark herein sought to be registered. Pointing to the provision requiring a disclaimer of affiliation when applicant advertises its seminars for a period of two years, applicant argues that the parties to the agreement believed that this disclaimer would dispel any possibility of confusion during the initial period of time when both parties were offering seminars. Applicant states that the sophistication of the customers was considered in determining that two years would be a sufficient amount of time for this disclaimer to be in effect. Both applicant and the Examining Attorney have argued the effect of a number of Federal Circuit cases in the area of consent agreements, and applicant urges that the Board not substitute its judgment, but rather give substantial weight to the settlement agreement in this case. Finally, applicant argues that the Board should permit registration of this mark, which is substantially similar to its

incontestably registered mark (also showing the word BURKE in white letters on a black background) shown on page 3 above, which mark has been in use since 1931, long prior to registrant's use and registration.

Discussion and Opinion

After careful consideration of this record and the argument of the attorneys, we believe that applicant has demonstrated, at least prima facie, that we should allow applicant's mark to be published for possible opposition. Although it is true that the settlement agreement concluding the civil action between applicant and an entity in privity with registrant does not specifically cover applicant's right to register, we nevertheless believe that the settlement agreement should be considered as a consent agreement between applicant and the owner of the cited registration. See *In re N.A.D. Inc.*, 743 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985), and *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987). As applicant has noted, the Court has repeatedly admonished the Board to defer to the parties, who are familiar with the trade practices and the marketplace. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Amalgamated Bank v. Amalgamated Trust & Savings*, 842 F.2d 1270, 6 USPQ2d 1365 (Fed. Cir. 1988); and *Bongrain*

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International (American) Corp. v. Delice de France, Inc.,
811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987).

Giving proper weight to the settlement agreement in this case, we believe that registrant has, in effect, consented to the use and registration by applicant of the mark herein sought to be registered for market research services. In reaching this conclusion, we have considered the fact that the agreement by its terms only covers applicant's use of the instant mark in connection with educational services and not the services involved in this application. As applicant has argued, the registrant's focus in the agreement seemed to have been on those services offered by applicant which are identical to registrant's, and not on the market research services which are not. This is all the more reason to believe that registrant has no objection to applicant's use and registration of this mark, which is different from registrant's registered mark (BURKE and design vs. THE BURKE INSTITUTE). See also *In re Parfums Schiaparelli Inc.*, 37 USPQ2d 1864 (TTAB 1995), overruled in part by *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997). Accordingly, we conclude that, on this record, confusion is

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not likely and that applicant's mark should be published for opposition.²

Decision: The refusal of registration is reversed.

R. L. Simms

T. J. Quinn

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board.

² Although we have found registrability on the basis of this record, we are troubled by the fact that a supplemental consent to registration was apparently not sought by applicant. Given the relationship between applicant and registrant (and their predecessors) and the fact that they resolved a prior legal conflict by an agreement, a supplemental agreement along with the existing settlement agreement perhaps could have avoided the needless delay and expense caused by the repeated refusals and this appeal, as well as the expenditure of TTAB resources.