

THIS DISPOSITION
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Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Specialty Merchandise Corporation

Serial No. 75/398,505; 75/398,506; and
75/398,507

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Zhaleh Sybil Delaney, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Specialty Merchandise Corporation has filed applications to register the marks SMC, SMC MEMBER, and SMC MEMBER and design as shown below,

Ser No. 75/398,505; 75/398,506; and 75/398,507

for the following services:

business planning services specifically tailored to providing marketing advice in the establishment and operation of retail and wholesale distributorships specializing in selling and distributing giftware, novelties, collectibles, housewares, dolls, toys, games, sporting goods, clothing and accessories, jewelry and horological instruments, notions, business publications, business supplies, including stationery, carrying cases and leather and imitation leather portfolios, electronics, photographic equipment, eyeglasses, hand tools, cosmetics, fragrances, personal care items, musical instruments, musical boxes, fabrics and artificial plants.¹

Registration has been finally refused in each application under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that each of applicant's marks, when used in connection with the identified services, so resembles the following registered marks, all owned by the same entity, as to be likely to cause confusion, mistake or deception:

- (a) SMC for "advice and consultation in management sciences" (Registration No. 893,015; Section 8 & 15 affidavit filed);
- (b) SMC for "management consulting" (Registration No. 1,354,604; Section 8 & 15 affidavit filed); and

¹ Serial No. 75/398,507 filed December 1, 1997, alleging dates of first use of July 5, 1967; Serial No. 75/398,506 filed December 1, 1997, alleging a bona fide intention to use the mark in commerce; and Serial No. 75/398,505 filed December 1, 1997, alleging a bona fide intention to use the mark in commerce, respectively. In the latter two applications, the word MEMBER is disclaimed apart from the mark as shown.

(c)

for "management consulting (Registration No. 1,337,092; Section 8 & 15 affidavit filed). The registration includes the statement that "The mark consists of the stylized letters SMC".²

Both applicant and the Examining Attorney have filed briefs and an oral hearing was held.

We turn first to a consideration of the respective services. At the outset, it should be noted that it is not necessary that the services be identical or even competitive to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated

² We note that Registration Nos. 1,354,604 and 1,337,092 cover additional services. However, the refusals to register are based solely on management consulting services.

Ser No. 75/398,505; 75/398,506; and 75/398,507

with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In the present case, we find that the record supports the Examining Attorney's position that applicant's business planning services which are designed to assist others in the establishment and operation of general novelty retail and wholesale distributorships are related to registrant's management consulting services. It has long been settled that the question of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods and services as they are identified in the involved application and the cited registration. In re Elbaum, 211 USPQ 639 (TTAB 1981). Thus, while we recognize that applicant's business planning services are restricted to the field of general novelty merchandise, we note that the recitations of services in the cited registrations contain no restrictions as to the field in which they are offered. In the absence of any restrictions, we must assume that registrant's management consulting services could be offered to individuals operating retail and/or wholesale distributorships specializing in general novelty merchandise. In short, for purposes of our likelihood of confusion analysis, we can draw no distinctions among the

Ser No. 75/398,505; 75/398,506; and 75/398,507

purchasers and channels of trade for the respective services.

Also, in this case, the Examining Attorney submitted copies of over twenty third-party registrations showing that entities have registered the same mark for business planning services, on the one hand, and management consulting services, on the other hand. For example, the mark LIFESPAN is registered for business planning and management consulting services (Registration No. 2,137,788); the mark STRATEGIC LEVERAGE is registered for business management consultation and conducting classes and seminars in the field of business planning (Registration No. 2,005,847); the mark BUSINESS ONE USA is registered for business planning services and management consulting services (Registration No. 1,966,880); and the mark ORIENTATION TECHNOLOGIES DIRECTION FOR GROWTH is registered for business planning and business management consultation (Registration No. 2,289,308). These third-party registrations serve to suggest that the involved services are of a type which may emanate from a single source. In addition, several of the third-party registrations indicate that business planning is considered part of management consulting. For example, BOSSARD is registered for business management consultation services, namely global

Ser No. 75/398,505; 75/398,506; and 75/398,507

strategic business planning (Registration No. 1,787,668) and the mark CONSENSUS PLUS is registered for management consulting services focusing on strategic business planning (Registration No. 1,511,215). In view of the foregoing, we find that the services of applicant and registrant are sufficiently related that if marketed under the same or similar marks, confusion as to source or origin would be likely to occur.

Turning then to a consideration of the respective marks, we note that applicant, in its brief on the case, does not dispute the Examining Attorney's contention that applicant's marks SMC, SMC MEMBER, and SMC MEMBER and design are identical or highly similar to registrant's mark SMC in typed form. For the reasons set forth by the Examining Attorney, we agree that these marks are identical or highly similar. Individuals familiar with registrant's management consulting services offered under the typed mark SMC are likely to believe, upon encountering applicant's marks SMC, SMC MEMBER, and/or SMC MEMBER and design for its particular business planning services, that the respective services originate or are somehow associated with the same source. With respect to registrant's design mark SMC, however, we find that because the design is so highly

Ser No. 75/398,505; 75/398,506; and 75/398,507

stylized, this mark is not similar to any of applicant's marks and thus, confusion is not likely.

Decision: The refusals to register Serial Nos. 75/398,505; 75/398,506; and 75/398,507 in view of Registration Nos. 893,015 and 1,354,604 are affirmed. The refusals to register the applications in view of Registration No. 1,337,092 are reversed.

Ser No. 75/398,505; 75/398,506; and 75/398,507