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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Strategic Marketing Partners, Inc.**

Serial No. 75/402,227

James J. Kozuch of Caesar, Rivise, Bernstein, Cohen & Pokotilow,
Ltd. for Strategic Marketing Partners, Inc.

Martha L. Fromm, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Seeherman, Hairston and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Strategic Marketing Partners, Inc. has appealed from the
final refusal of the Trademark Examining Attorney to register the
mark SMP for "market research and business marketing consultation
in the pharmaceutical and biotechnology fields."¹

¹ Application Serial No. 75/402,227, filed December 8, 1997 alleging
dates of first use on September 1, 1994.

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the basis of Registration No. 1,736,975 for the mark SMP ADVERTISING (with "ADVERTISING" disclaimed) for "advertising agency services."²

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods or services.

Turning first to the marks, we find that SMP and SMP ADVERTISING are substantially similar in sound and appearance, and create virtually identical commercial impressions. While marks must be compared in their entireties, there is nothing improper in giving more or less weight to certain features of the marks as being more dominant or otherwise significant, and therefore to give those features greater weight. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Here, the dominant part of both marks is the acronym SMP.

² Issued December 1, 1992; combined affidavit under Sections 8 and 15 filed.

The disclaimed word ADVERTISING is descriptive and therefore less significant. See *In re National Data Corp.*, supra.

Applicant does not dispute the similarity of the marks but instead argues, based on *Homeowners Group v. Home Marketing Specialists*, 931 F.3d 1100, 18 USPQ2d 1587 (6th Cir. 1991), that the "extensive use" of SMP by third parties for "a variety" of goods and services diminishes the likelihood of confusion.³ In support of this position, applicant has submitted thirteen use-based third-party registrations which, as the Examining Attorney observes and applicant does not dispute, are for goods or services which are unrelated to the services involved in this case.

Applicant's argument as to the effect of these registrations is unconvincing for several reasons. To begin with, the factor to be considered in determining likelihood of confusion under du Pont is the number and nature of similar marks "in use on *similar* goods" (emphasis added). See *In re E.I. du Pont de Nemours & Co.*, supra. The registrations on which applicant has relied are not for similar goods or services. Furthermore, third-party registrations are not evidence that the marks shown therein are

³ The Court, quoting the Restatement of Torts §729 (1938), said that "[t]he greater the number of...more or less similar trade-marks already in use on different kinds of goods, the less is the likelihood of confusion...."

in use. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). Finally, while third-party registrations may be used to show the dictionary or commonly understood meaning of a term to those in the trade, the goods and services in these third-party registrations are so unrelated to the services herein as to be of no use in determining whether SMP has any recognized meaning in the field.

We turn then to the services. To support her position that the respective services are related, the Examining Attorney has submitted the following evidence: Copies of over thirty third-party registrations covering both types of services under the same marks; marketing dictionary definitions of "advertising agency" as a company which, if a "full service" agency, offers "a comprehensive range of creative, production, market research, strategic planning, and media planning/buying capabilities"; a trade definition of "marketing"; a number of yellow pages listings for companies which offer both advertising and marketing services under the same marks, some of which contain specific references to research services; printouts from the websites of several advertising agencies which provide both advertising and market research services; and excerpts from the Nexis database showing in at least four of those articles that both advertising and market research services are provided by the same companies.

Applicant argues that the services are not similar or directly competitive and that the respective services are not related merely because they "may co-exist in some types of advertising agencies (i.e., "full-service" agencies)." Applicant further argues that because the Examining Attorney's third-party registrations "explicitly include" market research in addition to advertising agency services, the services in the cited registration should be "limited" to advertising agency services and, in any event, should not be "extended" to include market research services. Applicant maintains that its mark is not used in connection with "marketing" services and has attached its own definitions of "market research" to distinguish that service from the "marketing" services as defined by the Examining Attorney. Arguing that the services are in different channels of trade and directed to different purchasers, applicant contends that advertising agencies typically do not conduct "the types" of market analysis conducted by applicant. According to applicant, the purchasers of the respective services are knowledgeable and are likely to exercise a high degree of care, thus further diminishing the likelihood of confusion.

The Examining Attorney has shown that marketing research services are specifically encompassed within advertising agency services. We note, in particular, the definition of "advertising agency" which makes it clear that marketing research is one of

the functions or activities a "full service" advertising agency would provide. Whether registrant in fact conducts market research services as part of its overall advertising agency service or "the types" of market analysis provided by applicant is not relevant. The question of likelihood of confusion is determined on the basis of the recitation of services set forth in the registration rather than on what any evidence may show as to the actual nature of the services, their channels of trade and/or classes of purchasers. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). There is no restriction in the registration as to the range of services registrant's advertising agency would provide or the customers for those services. We must therefore presume that registrant is a "full service" agency offering marketing research services in general as well as specialized fields, including the pharmaceutical and biotechnology fields specified in applicant's identification.

Moreover, it is not necessary that the services of the applicant and registrant be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give

rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, supra. Even if conducting market research is not an activity which falls within the scope of services an advertising agency would provide, the two services are, nevertheless, closely related.

The numerous third-party registrations submitted by the Examining Attorney show that the same marks are registered for both advertising agency services on the one hand and marketing research and/or marketing consulting services on the other. Although, as we noted earlier, third-party registrations are not evidence of use of the marks in commerce, the registrations have probative value to the extent that they suggest that the identified services are of a type which may emanate from a single source.⁴ See, e.g., *In re Albert Trostel & Sons Co.*, supra at 1785-1786; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Simply because these registrants chose to delineate "market research" as a separate service does not mean that it is necessarily a separate service. More important, whether market research is or should be characterized as a separate service is irrelevant. The relevant consideration is that, as shown by the

⁴ We note that none of these registrations involve house marks for broad or diverse categories of services.

evidence, purchasers would assume that both services are offered by a single company.

In addition, the Nexis articles, website references and Yellow Pages advertisements submitted by the Examining Attorney all show that marketing services and/or market research services are often provided by the same company which offers advertising agency services. Applicant's apparent attempt to discredit this evidence and distinguish the respective services on the basis of the asserted differences in the definitions of "marketing" and "market research" is an exercise in splitting hairs. A significant portion of these materials contain references to market research as well as marketing services and, in any event, the Examining Attorney's definition of advertising agency services (from *The Marketing Glossary*) contains a definition of "marketing services" as including "market researchers."

It is clear from the foregoing evidence that advertising agency services and market research services do not merely "coexist" in the same industry but that they are, in fact, closely related in the industry. Customers for these services would be likely to believe, in view of the similarity of the respective marks, that both services emanate from or are sponsored by the same source. While it is reasonable to assume that the relevant customers at least for applicant's services would be relatively sophisticated and knowledgeable purchasers,

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even such purchasers are not immune from source confusion, particularly under circumstances where, as here, closely related services are sold to the same purchasers under virtually identical marks.⁵ See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Decision: The refusal to register is affirmed.

E. J. Seeherman

P. T. Hairston

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁵ This case is distinguishable from *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 715, 21 USPQ2d 1388 (Fed. Cir. 1992) relied on by applicant. In that case, the parties' respective goods and services on which the marks were used were deemed to be "different" and the respective purchasers were deemed to be "substantially different." (*Supra*, at 1393).