

2/20/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 7
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Action Staffing Group, Inc.,

Serial No. 75/829,997

Larry L. Coats of Coats and Bennett, P.L.L.C., for Action Staffing Group, Inc.

Jill Prater, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 25, 1999, applicant filed the above-referenced application to register the mark "ACTION STAFFING GROUP" on the Principal Register for "employment agency services," in Class 35. The basis for filing the application was applicant's claim of use of the mark in interstate commerce since August of 1998.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the grounds that

applicant's mark, as used in connection with employment agency services, so resembles three registered service marks that confusion is likely. The three cited registrations are each owned by different entities. The marks are as follows:

This registration issued on the Principal Register to Jo Ann Vaughn on June 13, 1989 for "temporary employment placement services."¹

This registration issued on the Principal Register to Action Labor Management, Inc. on April 4, 1995 for "personnel placement and recruitment services."²

ACTION PLUS INDUSTRIAL LABOR

This registration issued on the Principal Register to Action Personnel Services of Charlotte, Inc. on June 4, 1996 for "temporary employment agency" services.³

¹ Reg. No. 1,543,824; affidavits under Sections 8 and 15 of the Lanham Act accepted and acknowledged, respectively. The word "temporaries" is disclaimed apart from the mark as shown.

² Reg. No. 1,887,400.

³ Reg. No. 1,977,798. The term "industrial labor" is disclaimed apart from the mark as shown.

In addition to refusing registration under Section 2(d) of the Lanham Act, the Examining Attorney required applicant to disclaim the descriptive term "STAFFING GROUP" apart from the mark as shown.

Applicant responded by providing the required disclaimer, along with argument that confusion is not likely between its mark and any of the three cited registered marks. Applicant reasoned that if the "ACTION LABOR" and design mark registered after the "ACTION TEMPORARIES" and design mark had already been registered, and then the "ACTION PLUS INDUSTRIAL LABOR" mark was registered after both of the earlier registrations had issued, the Patent and Trademark Office had obviously concluded that the differences among the three marks made confusion unlikely. Applicant argued that when all four of these marks are considered in their entireties, applicant's "ACTION STAFFING GROUP" mark is readily distinguished from each of the cited marks, and further, that the cited marks are more similar to each other than applicant's mark is to any one of them. Additionally, applicant concluded that the professional procurement personnel, who engage employment agencies on behalf of their employers are typically sophisticated, experienced purchasers who would

not likely be confused as easily as ordinary individuals might be.

The Examining Attorney accepted applicant's disclaimer of "STAFFING GROUP," but was not persuaded by applicant's arguments with regard to the issue of likelihood of confusion. The Examining Attorney concluded that the word "ACTION" dominates applicant's mark as well as all of the cited registered marks. In support of this position, the descriptive natures of the other words in the respective marks was noted, as was the fact that the specimen submitted with the application is an advertisement which emphasizes the word "Action" by presenting in bold typeface paragraph headings with the following captions: "Action Staffing Solutions"; "Action Temporaries"; "Action Learning and Placement Center"; "Action Technical Staffing"; and "Action Health Staffing." The refusal to register under Section 2(d) was continued and made final in the second Office Action.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs.

Applicant submitted additional evidence with its brief. This evidence consists of a listing retrieved from the United States Patent and Trademark Office's database of about sixty third-party marks containing the word "action"

registered in Class 35; evidence obtained from an Internet search asserted to show the use of about twenty such "ACTION" marks; and a list of about fifty third-party marks registered in other classes including the word "ACTION" which applicant's attorney retrieved from the Office's database.

Ordinarily, the record for purposes of appeal closes with the filing of the Notice of Appeal. Trademark Rule 2.142(d) provides the procedure by which an applicant or an Examining Attorney may be permitted to supplement the record with additional evidence. In the case at hand, however, applicant did not follow this procedure. Under these circumstances, the Board would ordinarily not consider the evidence submitted untimely with applicant's appeal brief, but in the case at hand, the Examining Attorney did not object to this evidence, and in fact specifically addressed it in his brief as if it had been made of record properly. Accordingly, we have considered this evidence.

Applicant did not request an oral hearing before the Board, so we have resolved this appeal based on the written arguments and the record, including the late-filed evidence discussed above. After careful consideration in light of

the relevant legal precedents, we conclude that the refusal to register must be reversed.

In the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set forth the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods or services set forth in the application and the cited registrations, respectively. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to consideration of the issue of the relationship between the services specified in the application and the cited registrations, we note that the application states applicant's services as "employment agency services" and the cited registrations list the services therein as "temporary employment placement services," "personnel placement and recruitment services," and "temporary employment agency" services, respectively. A reasonable reading of this language leads to the conclusion that these services are either the same or very closely related. All such services would be expected to be rendered through the same channels of trade to the same

customers, including businesses seeking workers and individuals seeking employment. If these services were identified by the same or similar marks, customers would likely assume a single source to be responsible for them all.

We therefore turn our inquiry to whether or not applicant's mark so resembles the cited registered marks that confusion is likely. In doing so, we recognize that the application of a simple, easily enunciated test could lead to the conclusion that confusion is likely. This formulaic approach, in a nutshell, is that confusion is likely because applicant's mark and the three cited registered marks all create similar commercial impressions because each is dominated by the same word. The reasoning would be that all four of these marks are basically the word "ACTION" combined with words and designs which have comparatively little source-identifying significance, and that when these marks are used in connection with these identical or closely related services, customers are likely to be confused.

As to the third-party registrations submitted by applicant, the Examining Attorney cites case law in support of the proposition that third-party registrations do not establish use of the marks therein, and that absent

evidence of the use of such marks, we have no basis upon which to conclude that the common word in these marks, "ACTION," is so frequently encountered in the marketplace for these services that customers look to other elements of the marks in order to distinguish among them. As to the facts that so many "ACTION" marks are registered in Class 35 and that the Office has issued not only the three registrations cited as bars to the instant application, but also two others for the same or related services,⁴ the Examining Attorney points out that neither she nor the Board is privy to the reasoning or the evidence which led to the registration of all these marks dominated by the same word, nor are we bound by the decisions of previous Examining Attorneys based on records which are not before us in the instant proceeding. Moreover, it is well settled that even if these registrations were issued in error, the Board is not bound to compound the error by registering yet another mark which is likely to cause confusion. The Examining Attorney has done a creditable job of enunciating

⁴ Reg. No. 1,179,471 for the mark "TAC TECHNICAL AID CORPS. THE ACTION COMPANIES" and design, for "providing temporary contract workers for services in businesses of others," and Reg. No. 2,317,444, for the mark "AMS ACTION MANAGEMENT SYSTEMS" and design for, inter alia, "temporary employment agency services for project work."

these principles, which lead her to conclude that it is appropriate to refuse registration in this case under Section 2(d) of the Lanham Act based on the three different cited registrations owned by three different entities.

Our conclusion, however, is that confusion is not likely in this case because the third-party registrations of record, especially the three registered marks cited as bars to the instant application, show that the word common to all of them, "ACTION," is a suggestive, commonly adopted component of marks in this field of commerce, such that the remaining portions or components of the marks are sufficient to distinguish the marks in their entireties from one another. While not evidence of use, and therefore not probative of consumer awareness of the commercial presence of these marks in a marketplace for these services, these registrations are nonetheless useful because they demonstrate that "ACTION" has a commonly understood suggestive meaning in the trade. See: *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984). Considering the ordinary meaning of the word, we conclude that employment agencies and businesses providing temporary employees have adopted marks containing the word "ACTION" apparently because it suggests that the services in connection with which these marks are used involve accomplishing the

employment objectives of their clients by means of taking appropriate, effective action.

The multiplicity of marks incorporating this suggestive word leads us to conclude that customers and potential customers for these services look to other elements of these marks in order to distinguish among them. When the marks are compared in their entireties with this in mind, the coexistence of all of the registered marks on the register is explained, as is the conclusion that applicant's mark is not likely to cause confusion with any of them. None of the cited marks includes the wording "STAFFING GROUP." Although this descriptive term has been disclaimed by applicant, it nonetheless makes up the majority of applicant's mark, and its appearance, pronunciation and connotation help create for applicant's mark a commercial impression that is distinct from "ACTION TEMPORARIES," "ACTION LABOR," and "ACTION PLUS INDUSTRIAL LABOR," irrespective of the design elements which further distinguish two of these three marks.

In summary, when these four marks are considered in their entireties in light of the suggestive nature of the term common to them all, we hold that they are sufficiently different as to make confusion unlikely.

Ser No. 75/829,997

Decision: The refusal to register under Section 2(d) of the Act is reversed.