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THIS DISPOSITION IS NOT
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OF THE TTAB

Paper No. 9
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Walsh Jesuit High School

Serial No. 76/014,336

Jeannette L. Knudsen of Buckingham, Doolittle & Burroughs, LLP for Walsh Jesuit High School.

Monique C. Miller, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Seeherman and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark WALSH JESUIT (in typed form) for "educational services, namely, providing courses of instruction at the high school level."¹ Pursuant to the Trademark Examining

¹ Serial No. 76/014,336, filed March 31, 2000. The application is based on use in commerce under Trademark Act Section 1(a), and October 15, 1992 is alleged as the date of first use anywhere and the date of first use in commerce.

Attorney's requirement, applicant has disclaimed the exclusive right to use JESUIT apart from the mark as shown.

The Trademark Examining Attorney has issued a final refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), citing two registrations owned by a single registrant. The first cited registration is of the mark WALSH, in typed form, for "educational services, namely providing courses of instruction at the college and graduate levels."² The second cited registration is of the following mark



also for "educational services, namely providing courses of instruction at the college and graduate levels."³

Applicant has appealed the final refusal. Applicant and the Trademark Examining Attorney filed main briefs, but

² Registration No. 1,955,963, issued February 13, 1996. Section 8 and 15 affidavits accepted and acknowledged. The mark is registered on the Principal Register pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f).

³ Registration No. 1,958,601, issued February 27, 1996. Section 8 and 15 affidavits accepted and acknowledged. The mark is registered on the Principal Register pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f).

applicant did not file a reply brief, nor did applicant request an oral hearing. We affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to a determination of whether applicant's mark and the cited registered mark,⁴ when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side

⁴ In our discussion under this *du Pont* factor, we will refer to the cited registered marks in the singular, i.e., to registrant's WALSH mark. The stylization of registrant's special-form WALSH mark is too minimal to warrant a separate analysis.

comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In terms of appearance, sound, connotation and commercial impression, we find that applicant's mark WALSH JESUIT and registrant's mark WALSH obviously are identical to the extent that they both include the word WALSH, but unidentical to the extent that applicant's mark, but not registrant's mark, includes the word JESUIT. We also find that the dominant feature in applicant's mark, and thus the feature which should be given more weight in our comparison of the marks, is the word WALSH, and that the presence of

the word JESUIT in applicant's mark does not suffice to distinguish the marks, for purposes of the first *du Pont* factor.

We accord less weight to the word JESUIT in applicant's mark because it is less likely to be viewed as an indication of source than as a descriptor of the nature of applicant's services, i.e., that applicant's educational services are offered under the auspices of the Jesuit order of the Roman Catholic Church and/or in accordance with the educational principles established by the Jesuit order.⁵ The term informs purchasers that applicant's educational services, like the educational services provided by many others under many other marks, are "Jesuit" educational services. It is the term WALSH, more than the term JESUIT, that purchasers are likely to look to in distinguishing applicant's services from similar services of others. We do not disregard the term JESUIT in applicant's mark, but we find, for these reasons, that it is entitled to less weight in the commercial impression created by applicant's mark, and thus to less weight in our comparison of

⁵ The descriptive significance of the term JESUIT, as applied to applicant's services, is evidenced by the dictionary definition and the NEXIS excerpts made of record by the Trademark Examining Attorney, as well as by applicant's own descriptive use of the term in the application specimens.

applicant's mark and registrant's mark. *In re National Data Corp., supra.*

It might appear that the marks are distinguishable because applicant's mark, by virtue of the presence of the word JESUIT, affirmatively connotes that applicant is providing "Jesuit" educational services, while registrant's mark has no such connotation, or a different connotation, because it does not include the word JESUIT. However, the evidence of record⁶ establishes that many Jesuit schools do not have the word JESUIT in their names; indeed, none of the Jesuit colleges and universities identified in the record has the word JESUIT in its name. Thus, the presence or absence of the word JESUIT is not dispositive. As applied to Jesuit educational services, which we must presume to be the services at issue in this case because this type of educational service is encompassed by the identification of services in both the application and the cited registration, the marks WALSH and WALSH JESUIT do not create significantly different commercial impressions.

In short, the similarity between the marks which arises from the presence in both marks of the word WALSH

⁶ See the printouts from the Web sites of, respectively, the Jesuit Secondary Education Association and the Association of Jesuit Colleges and Universities, of lists of their respective member institutions, i.e., of Jesuit secondary schools and of Jesuit colleges and universities.

outweighs the dissimilarity between the marks which arises from applicant's addition of the word JESUIT. We have considered the marks in their entireties in terms of appearance, sound, connotation and commercial impression, and we conclude, for the reasons discussed above, that the marks are more similar than dissimilar. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to a determination, under the second *du Pont* factor, of the similarity or dissimilarity of the services recited in applicant's application and the services recited in the cited registrations. It is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir.

1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applicant's services, as recited in the application, are "educational services, namely, providing courses of instruction at the high school level." The services recited in the cited registrations are "educational services, namely, providing courses of instruction at the college and graduate levels." The Trademark Examining Attorney has made of record nineteen third-party registrations (owned by fourteen different registrants) which include both of these types of services in their recitations of services. Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they

suggest that the services identified therein are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). That is, this evidence suggests that a single source, under a single mark, may provide both high school-level courses of instruction like those recited in applicant's application as well as college- and graduate-level courses of instruction like those recited in the cited registrations. This evidence supports a finding that the respective services are sufficiently related that source confusion is likely to result if the services are marketed and rendered under confusingly similar marks.⁷

⁷ In making our findings under the second *du Pont* factor, we have not relied on the Trademark Examining Attorney's evidence from the Web sites of the associations of Jesuit secondary schools and Jesuit colleges and universities, which list the member schools of each association. (See *supra* at footnote 6.) The Trademark Examining Attorney has identified fourteen pairs of schools (each pair consisting of one high school and one college or university) which share the same or similar names, and she contends that in each of these pairs the high school "has an affiliation or at one time had an affiliation" with the college or university. However, there is no evidence in the record to support this assertion. That is, the schools in each pair of schools appear to be affiliated in the sense that they are Jesuit schools, but there is no evidence of any source, sponsorship or other connection between any of the schools which have similar names. This evidence therefore does not support the proposition for which the Trademark Examining Attorney cites it, i.e., that a Jesuit high school and a Jesuit college or university which share similar names also share a source connection.

We also find, under the third *du Pont* factor, that the trade channels and classes of purchasers for these respective services are similar. There are no restrictions or limitations in the respective recitations of services, so we must presume that the services are marketed in all normal trade channels and to all normal classes of purchasers for such services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Purchasers of applicant's high school-level educational services are potential future purchasers of registrant's college- and graduate-level educational services, and parents with both high school-age and college-age children are potential purchasers of both applicant's and registrant's services. This overlap in potential purchasers further supports a finding of likelihood of confusion.

Applicant argues that source confusion is unlikely because the educational services offered by applicant and by registrant are expensive, and because the decision to enroll at applicant's or registrant's academic institutions is made only after careful, informed consideration. However, the services recited in the application and registration are not rendered solely by means of academic institutions with expensive tuitions and complicated application and enrollment procedures. They must be

presumed to include educational services offered through less formal means and which are not necessarily purchased with significant care. The third-party registrations made of record by the Trademark Examining Attorney show that the services recited in the application and registration may be rendered by commercial entities and purchased by ordinary consumers, outside the context of formal academic institutions. Further, as the services are identified, they would include the situation of a consumer enrolling in a single course taught, respectively, at the high school or college level. In these circumstances, we cannot conclude that the services recited in the application and registration are necessarily purchased with a great degree of care, or that purchasers of these services necessarily are so sophisticated and careful in making their purchasing decisions that they would be immune to source confusion.

In summary, we have considered the evidence of record as it pertains to the *du Pont* likelihood of confusion factors, and we conclude that a likelihood of confusion exists. Any doubt as to this conclusion must be resolved against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). We have carefully considered

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all of applicant's arguments, including those not specifically discussed in this opinion, but find them to be unpersuasive of a different result.

Decision: The refusal to register is affirmed.