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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re First Principles, Inc.¹

Serial No. 75/782,740

Joseph J. Christian of Schmeiser, Olsen & Watts for First Principles, Inc.

Michael E. Bodson, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Cissel, Hairston, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 20, 1999, an application that was eventually assigned to First Principles, Inc. (applicant) was filed to register the mark ESP (in typed form) on the Principal Register for services ultimately identified as "conducting classes, seminars, and individualized instruction in the field of the psychological methodologies of learning and

¹ The application was originally filed by Executive Success Programs, Inc. In an assignment recorded at Reel 2684, Frame 0243, the application was assigned to First Principles, Inc.

Ser No. 75/782,740

facilitating how to develop the psychological habits for success therefrom; distribution of course materials in connection therewith" in International Class 41.² See Applicant's Response dated March 21, 2001.³

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), because of a registration⁴ of the mark ESP (in typed form) for "educational services, namely, providing instructions to improve social skills, personal presentation and communication" in International Class 41.

After the examining attorney made the refusal final, this appeal followed. An oral hearing was held on August 19, 2003.

We affirm.

² The application (Serial No. 75/782,740) is based on applicant's claim of a date of first use and a date of first use in commerce of August 31, 1998.

³ We note that in its appeal brief (page 1), applicant refers to its services as they were previously identified, i.e., "classes, seminars and individualized instruction in the field of psychological basis of learning; distribution of course materials therewith." See Applicant's Response dated July 19, 2000 at 1. At oral argument, neither applicant nor the examining attorney indicated that the identification of services was an issue or that the identification would change the outcome of the case. Indeed, the current identification simply uses the term psychological "methodologies" and adds the phrases or terms "facilitating how to develop the psychological habits of success therefrom," "conducting," and "in connection." The same refusal was made regardless of the identification of services. Therefore, we will refer to the services as applicant last amended them.

⁴ Registration No. 2,163,935 issued on June 9, 1998.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must 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 and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Regarding the similarities of the marks, it is clear that the marks are identical. Both marks are for the identical term, "ESP," in typed form.

We now consider whether the services of the parties are related. We must consider the services as they are identified in the application and registration.⁵ In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811

⁵ As we indicated previously, we will use applicant's most recent amended identification of services.

Ser No. 75/782,740

F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987)

("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). Furthermore, when both parties are using the identical designation, "the

relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

In this case, registrant's educational services involve providing instruction to improve social skills, personal presentation, and communication. Applicant's services involve providing instruction in the psychological methodologies of learning. A review of applicant's brochure includes a checklist "of skills you need to improve or develop." Among the list are such skills as communication, developing relationships, public speaking, team building, and rapport. The brochure maintains that these "are just some of the skills you will learn to develop at The Executive Success Programs Inc."

Applicant's services clearly include instruction in the areas of social skills, public speaking, and communication, and thus, there is at the very least some overlap between applicant's and registrant's services.

Applicant argues that the services are different because registrant's classes are "a one-day seminar teaching social appearance and presentation. Appellant's courses do not teach [how to] dress for success or what to say at cocktail parties, etc. The Appellant's services are a plurality of interactive modules, related to a myriad of topics, taught over several days, if not months and years." Applicant's Brief at 5. Similarly, applicant also argues that the channels of trade are different. The problem with applicant's arguments is that registrant's services are not limited in the way applicant suggests and even if registrant were currently limiting its services in this manner, nothing prevents registrant from changing the length or style of its educational services or its channels of trade. As discussed previously, we must consider registrant's services as they are described in the registration. In addition, we cannot read limitations into these services even if there was evidence of record on this point. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration.") Because applicant's

Ser No. 75/782,740

services include providing instructions in communication, public speaking, relationships, team building, and rapport, these services must be considered to be closely related, if not virtually identical, to registrant's instructions in the fields of communication, personal presentation, and social skills. There is also no basis for finding that the channels of trade for the identified services are different.

We also note that the examining attorney has included copies of registrations and Lexis/Nexis printouts that are also some evidence that personal growth and development services (which would be similar to the services applicant's brochure indicates applicant is providing) and educational services in the field of communication skills are related. See, e.g., Bangor Daily News, September 4, 1998 (Personal development series featuring a communication workshop) and Registration Nos. 2,116,906; 1,997,745; and 1,920,104.⁶

Having found that the marks are identical and the services are closely related, if not overlapping, we now address applicant's remaining arguments. Applicant argues that the "purchase of the Applicant's services is a

⁶ In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

sophisticated, expensive purchase made by a highly discriminating purchaser." Applicant's Brief at 9. While there is little evidence on this point, we cannot agree that, even if the purchasers are sophisticated and the services expensive, this factor would overcome the likelihood of confusion when the identical mark is used on overlapping or virtually identical services. In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"); In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion").

Applicant also makes two final arguments. The first is that there is no evidence that the registered mark is famous and the second is that there is no evidence of any actual confusion involving the marks. Neither argument is persuasive. The absence of evidence of fame is hardly

significant. See Majestic Distilling, 65 USPQ2d at 1205 (citation omitted) (“Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark’s not being famous”). Regarding the lack of actual confusion, we note that there is little, if any, evidence of the extent of use by applicant of its trademark, and, of course, we have not had an opportunity to hear from the registrant in this ex parte proceeding. Moreover, the “lack of evidence of actual confusion carries little weight.” Majestic Distilling, 65 USPQ2d at 1205.

While we have considered applicant’s arguments to the contrary, we are convinced that there is a likelihood of confusion when applicant and registrant use the identical mark ESP on closely related services.

Decision: The refusal to register applicant’s mark under Section 2(d) is affirmed.