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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zimmerman & Partners Advertising, Inc.

Serial No. 76167910

Eric D. Isicoff and Stacy M. Schwartz of Isicoff, Ragatz & Koenigsberg, P.A. for Zimmerman & Partners Advertising, Inc.

Jeri J. Fickes, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Seeherman, Chapman and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Zimmerman & Partners Advertising, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register BRANDTAILING as a mark for "advertising agency services, namely, promoting clients through radio, television, print and other forms of media for next day sales through the creation of a marketing/business plan from which a specialized five step advertising campaign is

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created and implemented."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark BRANDRETAIL, previously registered for "printed reports regarding marketing and advertising" and "marketing research and preparing advertisements for others"² that, as used in connection with applicant's services, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed. Applicant did not request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In*

¹ Application Serial No. 76167910, filed November 20, 2000, and asserting first use and first use in commerce as of October 1997.

² Registration No. 2145964, issued March 24, 1998; Section 8 affidavit accepted; Section 15 affidavit received.

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re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to the services, they are identified in the cited registration as "marketing research and preparing advertisements for others." Applicant's services are identified as "advertising agency services, namely, promoting clients through radio, television, print and other forms of media for next day sales through the creation of a marketing/business plan from which a specialized five step advertising campaign is created and implemented." Although applicant's services are very specific in terms of the media through which they promote clients, and the five-step advertising campaign, there is a clear overlap between its services and those of the registrant. Applicant creates and implements an advertising campaign and the registrant prepares advertisements. Although the wording is different, the services are legally the same. Moreover, to the extent that there is not an actual overlap, there is a close relationship between creating a marketing plan to create an advertising campaign, and marketing research. This du Pont factor, therefore, favors a finding of likelihood of confusion.

Similarly, the services must be deemed to travel in the same channels of trade to the same classes of consumers. Both applicant and the registrant offer advertising services, and any companies that require such services would be customers for the identified services. Therefore, these du Pont factors favor a finding of likelihood of confusion.

When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, there are clear similarities in the marks. Both obviously begin with the word BRAND, and both end with a term that relates to RETAILING. The cited mark uses the term RETAIL itself, while applicant's mark uses only the last part of the word, TAILING. However, in the context of applicant's services, consumers will clearly recognize TAILING as a reference to RETAIL or RETAILING. In this connection, we note that applicant's specimens explain that BRANDTAILING is "the bridge between building a brand & retailing a product."

Although there are specific differences in the marks, overall they are very similar in appearance and pronunciation, and have the same connotation. They also

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convey the same commercial impression. Thus, this du Pont factor also favors a finding of likelihood of confusion.

Applicant asserts that the present situation is similar to that in *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986), in which the Board dismissed an opposition brought against an application to register POLY FLO for paint brushes by the owner of registrations for POLY PRO and EASYFLO for paint brushes. In that case, as applicant points out, the evidence showed that the terms POLY, PRO and FLO were commonly used among paint manufacturers. However, in the record before us there is no evidence that the terms BRAND or RETAIL or variations thereof are used in connection with advertising services. Further, we do not view the cited registration as a highly suggestive mark which is entitled to an extremely limited scope of protection. Although one purpose of advertising may be to promote "retail brands," the reversal of the order of this common phrase, as BRANDRETAIL, gives the registered mark a certain incongruity and distinctiveness.

Although not argued by applicant or the Examining Attorney, there is another du Pont factor that is relevant in this appeal, namely, the conditions under which and buyers to whom sales are made. Advertising services are clearly not impulse purchases, but would be made with care.

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Such a factor would militate against a finding of likelihood of confusion. However, because of the similarity of the marks in terms of the words used and the order in which they are placed, even careful purchasers who are familiar with BRANDRETAIL for the service of preparing advertisements are likely to believe, upon seeing BRANDTAILING for the service of preparing an advertising campaign, that the services emanate from a single source, and that BRANDTAILING is simply a variation of the BRANDRETAIL mark.

Applicant has also pointed out that a different Examining Attorney, examining a third-party application for BRANDTAIL for "advertising services for the promotion of retail sales in the automotive industry," did not raise the registration cited herein as a bar to the registration of that mark.³ Decisions of Examining Attorneys are not binding on the Board. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, it is well-established that such doubt must be resolved in favor of the prior user

³ Applicant was initially advised that this third-party application could, if it issued into a registration, be cited against applicant's application. However, that application was subsequently abandoned.

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and registrant.⁴ In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.

⁴ The application which issued into the cited registration was based on use in commerce and was filed on October 29, 1996; applicant's application claims first use in October 1997.