

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 3/10/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pioneer Investment Management, Inc.

Serial No. 76302105

John F. McKenna of Cesari and McKenna for applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Pioneer Investment
Management, Inc. to register the mark UNI-K PLAN ("PLAN"
disclaimed) for "financial investment and advisory services
namely providing 401(k) retirement plans for small
businesses and owner-only businesses."¹

The trademark examining attorney refused registration
on the ground of likelihood of confusion under Section 2(d)

¹ Application Serial No. 76302105, filed August 20, 2001, based
on an allegation of an intention to use the mark in commerce.

of the Trademark Act. The examining attorney asserts that applicant's mark, if used in connection with applicant's services, would so resemble the previously issued registered mark shown below

UNIPLAN

for "training others in implementing qualified retirement plans through training seminars, and providing prototype qualified retirement plans in connection therewith"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant contends that the cited mark is weak and entitled to only a narrow scope of protection. Applicant then goes on to distinguish the marks in detail, pointing out that "the hyphen in UNI-K PLAN results in a mark with three parts and four syllables whereas UNIPLAN is one word with only three syllables." (Brief, p. 5). Applicant also asserts that the letter "K" in its mark suggests a

² Registration No. 1373037, issued November 26, 1985; combined Sections 8 and 15 affidavit filed.

retirement plan known as a "401(k)" whereas registrant's mark conveys no such suggestion. Applicant further argues that the services are distinctly different and are rendered to different classes of purchasers. According to applicant, a typical retirement plan is created and implemented by financial institutions (such as banks, brokerage houses and insurance companies). Based on the registrant's identified services, applicant contends that registrant's training services and associated prototype retirement plans are offered to the implementers of such plans, that is, financial institutions, which then train in-house personnel to implement retirement plans for others. Thus, according to applicant, registrant trains employees of a financial institution to implement a retirement plan which would then be marketed under that institution's own mark through brokers to individuals, businesses, etc. Such services would be advertised in financial publications directed to financial institutions, and registrant would discuss its training services at conferences attended by those same people from the financial institutions. Applicant's services, on the other hand, are directed to the end users of 401(k) plans, namely small businesses and owner-only businesses. Applicant's services involve already-implemented retirement plans that

are presented to the end users of such plans, and these types of services are marketed through brokers to end users. Such services will be advertised in general circulation publications directed to small businesses and owner-only businesses.

To put it another way, the cited registrant and applicant will offer their services in different trade channels to different classes of people for different reasons. This is because they operate at different non-competing levels: the former at a high level trains in-house financial people to implement retirement plans, the latter at a lower level advises people in small businesses about already-implemented retirement plans. The recipients of the latter's services would never know about the training services involved in the implementation of the plans offered by the financial institutions, and the cited registrant's training personnel have no reason to know the names of the plans issued ultimately by the financial institutions to the end users or to interact with those end users.

(Brief, p. 7). In connection with its arguments, applicant introduced several third-party registrations of "UNI-" formative marks covering services in International Class 36.³ Applicant

³ The third-party registrations were submitted in the form of printouts retrieved from the Trademark Electronic Search System (TESS). The examining attorney objected to their introduction, stating that this evidence comprises neither copies of the registrations themselves nor the electronic equivalent thereof, namely printouts retrieved from X-Search. The objection is

also relied upon printouts of excerpts retrieved from its website (www.pioneerfunds.com).

The examining attorney maintains that the marks are "essentially identical" and that applicant's mere addition of a suggestive, if not descriptive, letter "K" to the entirety of registrant's mark is insufficient to distinguish them. The examining attorney further contends that the services are related and, in this connection, he relied on six third-party registrations that purportedly show that educational services and financial services are rendered under the same mark by a single entity. The examining attorney also asserts that registrant's recitation of services is broadly worded and that applicant has impermissibly attempted to limit the scope thereof.

We reverse the refusal to register.

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

overruled. So long as the copies of the third-party registrations are complete printouts taken from any of the Office's automated systems (whether X-Search, TESS, TARR or TRAM), the Board considers the printouts to be the electronic equivalent of the registration itself. See, e.g., *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) [complete TRAM printouts are acceptable]. See also TBMP §1208.02 (2d ed. rev. 2004); and TMEP §710.03 (3d ed. 2002). Accordingly, we have considered the third-party registration evidence in reaching our decision.

Ser No. 76302105

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

The marks involved herein, UNIPLAN versus UNI-K PLAN, are similar in sound and appearance. The marks are somewhat different, however, in connotation. The addition of the letter "K" in applicant's marks suggests that the services relate to 401(k) plans, a suggestion not conveyed by registrant's mark.

In arguing that the cited mark is weak, applicant submitted copies of several third-party registrations (both live and dead) of marks that begin with a "UNI-" prefix, all covering services in International Class 36. Applicant also points to the descriptiveness of the term "PLAN" as it relates to retirement plans and services related thereto. These registrations are entitled to little probative value on the question of likelihood of confusion. Third-party

registrations do not establish that the marks shown therein are in use, much less that customers are so familiar with them that they are able to distinguish among such marks. Nevertheless, the registrations highlight the fact that the prefix "UNI-" has in the past appealed to others in the financial and insurance fields as an appropriate term for inclusion in a mark to convey, as applicant indicates, the suggestion of "one" or "single."⁴

We turn next to the second du Pont factor, namely, the similarity or dissimilarity of the parties' respective services. In comparing the services, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). The issue of likelihood of

⁴ In this connection, we take judicial notice of the dictionary definition of "uni": "one; single." Webster's Third New International Dictionary (unabridged ed. 1993).

confusion must be determined on the basis of the services as set forth in the application and the cited registration. *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

The mere fact that applicant's and registrant's services involve retirement plans is an insufficient basis upon which to find that the services are related for purposes of the likelihood of confusion analysis. It is common knowledge that financial services relating to retirements are ubiquitous in this country. Thus, we are not persuaded that a relationship exists between applicant's and registrant's services simply because each fits in the extremely broad category of financial services relating to retirements. See *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992). Simply put, applicant's "financial investment and advisory services namely providing 401(k) retirement plans for small businesses and owner-only businesses" and registrant's services of "training others in implementing qualified retirement plans through training seminars, and providing prototype qualified retirement plans in connection therewith" are distinctly different in significant respects.

As shown by the limitation in applicant's recitation of services, applicant offers its 401(k) retirement plans solely to small businesses (more specifically, self-employed individuals) and owner-only businesses (and their spouses). Applicant's promotional materials specifically indicate that its retirement services are not suitable for businesses with employees; specific types of businesses that are suitable for applicant's services, as identified by applicant, include real estate brokers, lawyers, accountants, interior decorators and graphic artists.

Registrant's services are also limited in that the training services are rendered to others *in implementing retirement plans*, and, in connection therewith, registrant provides prototype retirement plans. It is readily apparent that the implementation of retirement plans is the province of financial institutions and the like, and this is the relevant class of purchasers for registrant's services.

A fair reading of the respective recitations of services is that registrant renders its training services to financial institutions which then implement retirement plans for others, while applicant's services involve already-implemented retirement plans directed to the end users of such plans. When the respective services are

compared, it does not appear that there is any overlap in customers. Indeed, we cannot conceive of any overlap, and the examining attorney has not pointed to any one class of customers that would be interested in both types of services.⁵ But, to the extent that there is a theoretical overlap, the common customers for these services would be highly sophisticated and would know, therefore, that the respective services do not emanate from a common source.

The evidence submitted by the examining attorney to show the relatedness of the involved services is of questionable value. Third-party registrations which individually cover a number of different goods or services and which are based on use in commerce serve to suggest that the listed goods or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). A superficial glance at the six third-party registrations might lead one to believe that this evidence supports the examining attorney's contention that applicant's and registrant's services are related. Upon closer inspection, however, it

⁵ The examining attorney states "[i]t must be presumed that registrant's services are directed to all customers, including small businesses and owner-only businesses." (Brief, p. 6). This statement ignores the clear limitation in registrant's recitation, namely, that registrant's training services are offered to the implementers of retirement plans, rather than the end users of already-implemented retirement plans.

is apparent that the nature of the educational services listed in these registrations is entirely different from the training services rendered by registrant. The seminars, conferences, workshops and the like are offered by these financial institutions to clients and prospective clients, and not to the implementers of retirement plans, that is, other financial institutions. None of the six registrations covers both financial investment services and the specific type of training services listed in the cited registration (that is, training others in implementing retirement plans).

Based on the record before us, we see the examining attorney's assessment of the likelihood of confusion as amounting to only a speculative possibility. We conclude that the cumulative differences in the marks and the services rendered thereunder, and the differences in the prospective sophisticated purchasers for the services, preclude a likelihood of confusion.

Decision: The refusal to register is reversed.