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Mailed:
March 2, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re EAG, A Law Corporation.

Serial No. 76515140

Jon-Erik G. Storm of Employer Advocates Group LC for EAG, A Law Corporation.

Lourdes D. Ayala, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Chapman, Bottorff, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 19, 2003, EAG, A Law Corporation (applicant) applied to register the mark shown below on the Principal Register for "legal services" in Class 42.¹ The application described the mark as "EAG (stylized and/or with design)" and the attorney's cover letter identified the subject as "EAG Logo."

¹ Serial No. 76515140 is based on an allegation of a date of first use and first use in commerce of February 3, 2002.



The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark EAG, in typed form, for, inter alia, the following services in Class 42:²

Litigation support services, namely, litigation claims evaluation, preparation of demonstrative exhibits and graphics presentations; expert witness services, namely, selection and evaluation of experts and expert testimony.

When the refusal was made final, applicant filed this appeal.

The examining attorney argues (Brief, fourth, unnumbered page) that the "literal portions of both marks are identical in appearance, sound and meaning" and that litigation support services and legal services "will travel within the same channels of trade." The examining attorney also argues that the special form display of applicant's mark will not avoid confusion. Applicant emphasizes the

² Registration No. 2,315,764, issued February 8, 2000. The registration also contains goods and services in Classes 9, 16, 35, and 36, which are not at issue in this appeal.

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differences in the visual appearance of the marks and it maintains that the "services are not related." Brief at 6. Applicant also argues that the sophistication of the purchasers is another factor supporting a determination that there is no likelihood of confusion.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out 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); and 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).

Obviously, one of the critical factors in any likelihood of confusion analysis is the similarities and dissimilarities of the marks in the application and registration. Here, we agree with the examining attorney that the literal portion of the marks are identical, EAG. Furthermore, we note that registrant's mark is displayed in

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typed form, and it is therefore, not limited to any particular display. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-1848 (Fed. Cir. 2000); and Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). "[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark in a typed drawing, a difference cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same."

Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). However, there are limits to this assumption.

[W]e are not suggesting that because an application or registration depicts a word mark in typed capital letters that therefore the word mark must be considered in all possible forms no matter how extensively stylized. Rather, we are simply indicating that when a drawing in an application or registration depicts a word mark in typed capital letters, this Board -- in deciding the issue of likelihood of confusion -- must consider all reasonable manners in which the word mark could be depicted.

Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1235 (TTAB 1992) (internal quotation marks omitted).

We agree with applicant (Brief at 6) that its mark is "highly stylized" and, therefore, we do not agree with the examining attorney (brief at fifth unnumbered page) that "registrant is free to adopt any style of lettering, including lettering identical to that used by applicant." While we do agree that registrant may adopt a stylization of lettering that may be similar to letters in applicant's mark, applicant's display seems so extensively stylized that we will not assume that it is reasonable for registrant to adopt the exact stylization of the letters in applicant's design mark.

However, while we find that applicant's mark is highly stylized, we do not find that this single factor is enough to hold that the marks are not similar in appearance. We note that the facts in this case are significantly different than the case of In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990). In that case, the Federal Circuit held that the marks K+ and design and K+EFF (stylized) for potassium supplements were not confusingly similar. Significantly, both the registrant's and applicant's marks were either stylized or design marks. Neither mark was a typed drawing so both marks were limited to a specific display, and these displays were "significantly different." 16 USPQ2d at

1240. In addition, the underlying letters, K+ and K+EFF, were not distinctive to the extent that K is the symbol for potassium, "EFF" is an abbreviation for effervescent, and the goods were potassium supplements. Unlike the Electrolyte case, registrant's mark is a typed drawing and, therefore, it is not limited to a single, distinctively different style. Rather we must assume that it may be displaying somewhat similar letters to applicant's. Furthermore, there is no evidence that the underlying verbal portions, the letters EAG, would have any meaning that would diminish the distinctiveness of the letters.

When we compare the literal portions of the marks, they are identical in sound, appearance, and meaning. This factor weighs against applicant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant"). However, the key question in this case is whether the marks as a whole are similar in sound, appearance, meaning, and commercial impression. If applicant's mark would not be perceived as EAG but rather as a design, confusion is much less likely. Regarding the

letters in applicant's mark, it is clear that the letter "G" would be immediately recognized as that letter and the letter "A" is also recognizable. While the letter "E" is displayed in an unusual style with the middle horizontal line lower than would be expected, it is still recognizable as a letter to the extent that the presence of the letters "AG" would encourage potential purchasers to expect another letter.

We also note that applicant's name is "EAG, A Legal Corporation," which reinforces the perception that EAG are the letters in the mark. In addition, we also consider applicant's mark as it appears on the specimens of record. In re Nationwide Industries, 6 USPQ2d 1882, 1884 (TTAB 1984) ("Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to purchasers"). Applicant's specimen, a Yellow Pages advertisement, begins with the heading: EMPLOYER ADVOCATES GROUP, immediately followed by the EAG mark. The appearance of the name Employer Advocates Group followed by the EAG mark would aid potential purchasers to understand the mark to be initials for the name in the advertisement. Also, the concluding line of the advertisement is the website (www.EAGLawGroup.com), with

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the letters EAG capitalized. When we view the specimen, it is clear that applicant's mark would be understood by consumers as the letters EAG and the specimen rebuts any argument to the contrary. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (CCPA 1984) ("Applicant's labels support rather than negate that of which opposer complains: that SPICE VALLEY inherently creates a commercial impression which is confusingly similar to that of SPICE ISLANDS"); In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209, 1211 (TTAB 1999) ("On applicant's menus, which are the specimens of record, the words appear on a line below the term AZTECA and are in smaller type than the term AZTECA. Certainly, when applicant's mark is viewed as a whole, it is the term AZTECA which is the dominating and distinguishing element thereof"). Therefore, when we consider the marks as a whole, we conclude that they would be pronounced identically and have the same meaning. In addition, their similarities in appearance and commercial impression outweigh the difference in their displays.

Next, we look at the relationship between applicant's and registrant's services. We are not required to find that the services overlap in order to find that the services are related. It "has often been said that goods

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or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could 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 producer or that there is an association between the producers of each parties' goods or services." In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant's services are "legal services," while the relevant services in the cited registration are

litigation support services, namely, litigation claims evaluation, preparation of demonstrative exhibits and graphics presentations; expert witness services, namely, selection and evaluation of experts and expert testimony.

We start with the established proposition that we must consider the services as they are described in the identification of services in the application and registration.³ Octocom Systems, Inc. v. Houston Computers

³ In its Brief (p. 3), applicant refers to information on registrant's website. To the extent that this information is not

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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 [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services). Furthermore, the fact that the cited registration contains goods and services in several other classes for software, financial reports, and businesses investigations cannot be read to limit the scope of registrant's litigation support services. 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

otherwise of record, "a mere reference to a website does not make the information of record." See In re Planalytics Inc., 70 USPQ2d 1453, 1457 (TTAB 2004).

drinks. The Board, thus, improperly read limitations into the registration").

Therefore, the question we address is whether prospective purchasers may assume that there is some association or relationship between legal services and litigation support services including claim evaluation, preparing exhibits, and expert witness services. While applicant argues that the "only thing the services provided by Applicant and Registrant have in common is the accident of placement in Class 42" (Brief at 5), legal services and litigation support services have much more in common than their classification.⁴ Inasmuch as legal services include representing clients in litigation, litigation support services and legal services involving litigation would occur together. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

⁴ Obviously, the classification of the services is not a factor in a determination of likelihood of confusion. 15 U.S.C. § 1112 ("The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office

The examining attorney has included printouts of several registrations that show that legal services and litigation support services have been registered under a common mark by the same entity. See, e.g. Registration No. 2,673,708 ("legal services, namely ... general legal work, and legal consulting services; litigation support services, namely, the monitoring and handling of claims, claims quality review and general claims management"); No. 2,576,166 ("legal services and litigation support services in the field of patents, and legal negotiation services between patent owners and potential infringers"); No. 2,404,297 ("attorney services; legal research; and legal research services; litigation support services"). These registrations provide at least some support for the examining attorney's argument that applicant's and registrant's services are related. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may

administration, but not to limit or extend the applicant's or registrant's rights").

emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).⁵

We also disagree with applicant's argument (Brief at 6, emphasis in original) that "there is no consumer who is likely to constitute an overlapping class of purchaser for both marks. Applicant markets its services to those who seek legal services; on the other hand, Registrant markets its class 42 services at those who *perform* legal services, such as Applicant itself." We note that applicant's own advertising indicates that it "represents employers in all aspects of labor and employment law" including wrongful termination, sexual harassment, employment discrimination, and non-competition. It is not clear why attorneys and law firms would not be consumers of these employer-related legal services as well as registrant's litigation support services. Also, corporations in need of applicant's legal services would also be potential consumers of registrant's litigation support services for their in-house litigation activities.

⁵ Whether "Registrant is legally capable of providing legal services" is not the determining factor on the question of whether applicant's and registrant's services are related. Reply Brief at 5. As indicated above, we do not read limitations into the identification of services and we must determine these services without regard to what the individual states require for the performance of legal services. Furthermore, applicant does not argue that there is any prohibition for a law firm also providing registrant's litigation support services.

Applicant also argues that the purchasers in this case are sophisticated. While we have considered applicant's argument, any sophistication of the purchasers does not overcome the similarity of the marks and the services. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ("[E]ven careful purchasers are not immune from source confusion"); 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 this case, when different entities use the identical abbreviation EAG, even with some difference in stylization, for legal services and litigation support services, it is difficult to see on what basis even careful purchasers would not assume that there is no relationship between the sources of the services.

After analyzing the facts of this case under the factors set out in Majestic Distilling, we are convinced that there is a likelihood of confusion. We add that, if we had any doubts about this conclusion, we must resolve them in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir.

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1988); In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

Decision: The examining attorney's refusal to register under Section 2(d) of the Trademark Act is affirmed.