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Mailed:
June 28, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Alta Group, LLC

Serial No. 76563783

Bonnie Drinkwater of Drinkwater Law Offices for The Alta Group, LLC.

Kimberly Frye, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Walters, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark THE ALTA GROUP (in standard character form; GROUP disclaimed) for services recited in the application

as "business consulting services provided to the equipment financing and leasing industry."¹

The Trademark Examining Attorney has issued a final refusal to register applicant's mark, on the ground that the mark, as applied to applicant's recited services, so resembles the mark ALTA RESOURCES and design as depicted below,



previously registered on the Principal Register (with a disclaimer of RESOURCES) for services recited in the registration as "business services, namely providing business consultation, business networking, business personnel and business specialist services in the fields of customer acquisition, customer service, customer management, data management, shipping, marketing and sales for commercial businesses, excluding business consulting services in the field of equipment financing and leasing."²

¹ Serial No. 76563783, filed December 8, 2003. The application is based on use in commerce, and May 18, 1993 is alleged in the application as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

² Registration No. 2463521, issued June 27, 2001.

Applicant has appealed the final refusal. Applicant and the Trademark Examining Attorney have filed main appeal briefs. Applicant did not file a reply brief, nor did applicant request an oral hearing. The evidence of record on appeal consists of printouts of fifteen third-party registrations submitted by the Trademark Examining Attorney, and a printout of pages from applicant's website, submitted by applicant.

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 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn initially to the first *du Pont* factor, i.e., whether applicant's mark, THE ALTA GROUP, and the cited registered mark, ALTA RESOURCES and design, are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression.

The test is not whether the marks can be distinguished when subjected to a side-by-side 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 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).

First, we find that the word ALTA is the dominant feature in the commercial impression created by each of the marks at issue. The word GROUP in applicant's mark, and the word RESOURCES in the cited registered mark, are descriptive and disclaimed, and they contribute relatively less to the commercial impressions of the respective marks. Likewise, the design feature in the registered mark is of less significance to the mark's commercial impression than

is the word ALTA, and its presence in the cited registered mark does not suffice to distinguish the marks. See *In re Chatham International Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).³

In terms of appearance, sound, connotation and overall commercial impression, we find that the similarity between the marks which results from the presence of the word ALTA in both marks outweighs the minor points of dissimilarity between the marks, i.e., the different descriptive words GROUP and RESOURCES in the respective marks, and the presence of the design element in the cited registered mark. Viewing the marks in their entirety, we find that they are similar because the dominant feature of both marks is the distinctive word ALTA.

We turn next to the second and third *du Pont* factors, i.e., the similarity or dissimilarity of the respective services, and the similarity or dissimilarity of the trade channels and classes of purchasers for the respective purchasers. We must make our determinations under these

³ Applicant contends that its mark always is displayed with a design feature of its own. However, our determination must be made on the basis of the mark as it appears in the application, which includes no such design feature.

factors based on the services as they are recited in the application and registration, respectively. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Applicant's services are "business consulting services provided to the equipment financing and leasing industry." Registrant's recitation of services also includes "business consulting services," but specifically excludes "business consulting services in the field of equipment financing and leasing." To that extent, applicant's trade channels and purchasers are dissimilar to registrant's trade channels and purchasers. However, the other services recited in the cited registration have no such trade channel or purchaser limitations. Registrant's "business networking, business personnel and business specialist services in the fields of customer acquisition, customer service, customer management, data management, shipping, marketing and sales" are similar in kind to applicant's "business consulting services," as is evidenced by the third-party registrations made of record by the Trademark Examining Attorney. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Moreover, those services of registrant's are not limited as to trade channels or purchasers, and they thus must be presumed to be marketed to and rendered to all

"commercial businesses," including the same businesses in the equipment financing and leasing industry to which applicant markets its services. These factors support a finding of likelihood of confusion.

Applicant has pointed out (in its appeal brief), and the Trademark Examining Attorney has acknowledged (in her appeal brief), that applicant owned a previous registration (Reg. No. 1970744, hereinafter the '744 registration) of the same mark (THE ALTA GROUP) and for the same services ("business consulting services in the field of equipment financing and leasing") as those for which it now seeks registration.⁴ This '744 registration was cancelled (on February 1, 2003) under Trademark Act Section 8, 15 U.S.C. §1058, due to applicant's failure to file the required affidavit of continued use. Applicant notes that this prior registration was extant when the cited ALTA RESOURCES registration was issued, and that the two registrations coexisted on the Register for over one year. Applicant contends that the cited ALTA RESOURCES mark most likely was able to be registered only after amendment of its recitation of services to specifically exclude the services

⁴ Applicant did not make the '744 registration of record prior to appeal or with its appeal brief, but the Trademark Examining Attorney has treated it as being of record, and so shall we.

covered by applicant's prior '744 registration, i.e., "business consulting services in the field of equipment financing and leasing."

In essence, applicant is attempting to re-register its mark after having inadvertently allowed its previous registration to be cancelled. Applicant argues that if the cited ALTA RESOURCES intervening registration could coexist on the Register with applicant's previous '744 registration for over one year, then it also can coexist with the registration applicant now seeks by its current application. Although we are not unsympathetic to this argument, we are not persuaded.

That the cited registration was issued over, and coexisted for a time with, applicant's previous '744 registration is "a factor which is placed in the hopper with other matters which ordinarily are considered in resolving the question of likelihood of confusion, but which is not in the least determinative of said issue." *In re Trelleborgs Gummifabriks Aktiebolag*, 189 USPQ 106, 107 (TTAB 1975). In the more recent case of *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001), the Board, citing the *In re Trelleborgs* decision, noted as follows:

We can only speculate as to why the cited registration issued over applicant's

predecessor's now-cancelled registration. In any event, even when one registration issues over the other and both exist side-by-side for some period of time (in this case about six years), that is one element 'which is placed in the hopper...' [of the likelihood of confusion analysis].

59 USPQ2d at 1377. The Board also noted that "[n]either the Board, nor the Courts, are bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits on the basis of the record therein. See *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). See also, *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001)."

In re Trelleborgs and *In re Kent-Gamebore* both involved the situation at hand here, i.e., the registration cited as a Section 2(d) bar to registration of the applicant's mark was an intervening registration which issued over the applicant's now-cancelled previous registration. In both cases, the Board found that a likelihood of confusion existed, due to the similarities between the applicant's and intervening registrant's respective marks and respective goods or services. We likewise find in this case that, due to the similarity between applicant's mark THE ALTA GROUP and registrant's mark ALTA RESOURCES and design, and to the similarity

between applicant's and registrant's respective recited services, trade channels and purchasers, a likelihood of confusion exists. We have considered the fact that the cited registration coexisted on the Register with applicant's prior '744 registration for a period of time, but we find that fact to be outweighed, in our likelihood of confusion analysis, by the other *du Pont* factors which weigh markedly in favor of a finding of likelihood of confusion.

Finally, applicant argues that it is unaware of any instances of actual confusion between its mark and the cited registered mark, notwithstanding contemporaneous use of the two marks for a period of years. However, we cannot determine on this record that the nature and scope of applicant's and registrant's actual use of their marks have been such as to have created any meaningful opportunity for actual confusion to occur. The absence of actual confusion, under the seventh *du Pont* factor, therefore is counterbalanced by the absence of evidence of any opportunity for actual confusion to have occurred, under

the eighth *du Pont* factor.⁵

After carefully considering all of the evidence as it pertains to the relevant *du Pont* factors, and for the reasons discussed above, we find that a likelihood of confusion exists, and that registration of applicant's mark is barred under Trademark Act Section 2(d). We have considered applicant's arguments to the contrary, but are unpersuaded.

Decision: The refusal to register is affirmed.

⁵ We cannot find, on this *ex parte* record, that the owner of the cited registration likewise is aware of no instances of actual confusion having occurred. Nor is there of record a consent agreement between applicant and registrant, which obviously would have been entitled to great weight in our analysis. See, e.g., *Bongrain International (American) Corporation v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); *In re Kent-Gamebore Corp.*, *supra*.