

THIS OPINION IS NOT CITABLE
AS PRECEDENT OF
THE TTAB

2/4/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re University of South Florida

Serial No. 78193899

Thomas E. Toner of Smith & Hopen for University of South Florida.

Gene V. J. Maciol, II, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hanak, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

University of South Florida (applicant) seeks to register in typed drawing form USF for "educational services, namely, providing courses of instruction for others at the University level." The application was filed on December 12, 2002 with a claimed first use date of September 1, 1960.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's services, is

likely to cause confusion with two previously registered marks. The first is for USF (stylized) for, among other services, "educational services, namely, providing courses of instruction at the university level." Registration No. 2,404,066. The second is for USF UNIVERSITY OF SAN FRANCISCO (stylized) for "educational services, namely, conducting courses of instruction at the university level." Registration No. 2,430,952.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the services, we find that despite very slight differences in terminology, they are absolutely identical. Applicant's services (providing courses of instruction for others at the University level) are clearly

identical to certain of the services of Registration No. 2,404,066 (providing courses of instruction at the university level) and to the services of Registration No. 2,430,952 (conducting courses of instruction at the university level).

Turning to a consideration of the marks, we note at the outset when the services of the parties are legally identical as is the case here, "the degree of similarity [of the marks] 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).

In the first sentence of page 3 of its brief, applicant makes the following somewhat startling statement: "The respective marks are acronyms and are identical in appearance, sound and connotation." (emphasis added). While applicant's mark USF (typed drawing form) is virtually identical to the mark of Registration No. 2,404,066 (USF, stylized), applicant's mark is just extremely similar to the mark of Registration No. 2,430,952 (USF UNIVERSITY OF SAN FRANCISCO, stylized).

It has been held that when marks are identical, virtually identical or extremely similar, their contemporaneous use can lead to the assumption that there

is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 922 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Of course, in this case applicant's services and the services of the cited registrations are legally identical.

Given the fact that the services are legally identical and that applicant's mark is, at an absolute minimum, extremely similar to the cited marks, we find that there exists a likelihood of confusion, and accordingly affirm the refusal to register.

Applicant devotes the vast majority of its brief to two arguments. First, applicant contends at page 6 of its brief that "because most potential purchasers are highly discriminate as to their choice of school, a likelihood of confusion is unlikely." We do not disagree with applicant's contention that students and their parents, in choosing a college or university, will exercise a considerable degree of care. Nevertheless, given the fact that the marks in question are, at an absolute minimum, extremely similar, we find that such purchaser sophistication would simply not prevent a likelihood of confusion. Of course, as previously noted, applicant actually states that "the respective marks are acronyms and

are identical in appearance, sound and connotation.”

(Applicant’s brief page 3, first sentence).

Second, applicant devotes even more of its brief to its argument that the respective schools are dissimilar in terms of their geographic locations, total student enrollments and the like. Applicant’s argument is misplaced. Applicant’s recitation of services and the recitations of services in the two cited registrations contain no limitations whatsoever as to geographic location, college size or the like. It is well settled that in Board proceedings, “the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant’s application vis-à-vis the goods and/or services recited in [the cited registrations], rather than what the evidence shows the goods and/or services to be.” Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Decision: The refusal to register is affirmed.