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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oxford Global Resources, Inc.

Serial Nos. 76589185 and 76589186

Kevin M. Hayes of Klarquist Sparkman, LLP for Oxford Global Resources, Inc.

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Before Seeherman, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Oxford Global Resources, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register OXFORD INTERNATIONAL, with INTERNATIONAL disclaimed,¹ and OXFORD & ASSOCIATES,² with ASSOCIATES

¹ Application Serial No. 76589186, filed May 23, 2005, and asserting first use and first use in commerce as of December 31, 1988.

² Application Serial No. 76589185, filed May 23, 2005, and asserting first use and first use in commerce as of November 30, 1983.

disclaimed, both depicted in standard character form, and both for the following services:³

Recruiting and placement services for temporary employees, permanent employees and consultants on a domestic and international scale (Class 35).

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 marks, when used in connection with the identified services, so resembles the previously registered mark OXFORD LEGAL ASSOCIATES and design, shown below, with the words LEGAL ASSOCIATES disclaimed, for "temporary employment and job placement services,"⁴ that it is likely to cause confusion or mistake or to deceive.



³ The applications also include "consulting services in the field of information technology, computer hardware and software, and mechanical, electrical and telecommunications engineering, namely consulting services provided directly through consultants and through strategic outsourcing" in Class 42. The Examining Attorney specifically stated that the refusal of registration did not apply to the applications in this class.

The appeals have been fully briefed. Applicant had requested oral hearings but then withdrew the requests.

Because the appeals present common issues and evidence, we have decided both in this single opinion.

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 Co., 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).

We first consider the services. Applicant has identified the services in both its applications as "recruiting and placement services for temporary employees, permanent employees and consultants on a domestic and international scale." The registrant's services are

⁴ Registration No. 2151799, issued April 21, 1998; Section 8 & 15 affidavits accepted and acknowledged.

identified as "temporary employment and job placement services." Applicant's identified services are in part identical to the registrant's identified services: registrant's temporary employment and job placement services would encompass placement services for temporary employees and permanent employees and consultants. Further, because there are no limitations in the cited registration, the identification would include placement services on a domestic and international scale. Moreover, applicant's recruiting services for permanent and temporary employees are closely related to employment and job placement services. Thus, the factor of the similarity of the services favors a finding of likelihood of confusion.

Because the services are legally identical, they must be deemed to be offered in the same channels of trade, to the same classes of consumers. This factor, too, favors a finding of likelihood of confusion.

This brings us to a consideration of applicant's marks vis-à-vis the mark in the cited registration. When marks would appear on virtually identical goods or services, as they do here, 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). Applicant's marks are

OXFORD & ASSOCIATES and OXFORD INTERNATIONAL; the cited registration is for OXFORD LEGAL ASSOCIATES and design. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The elements "& ASSOCIATES" and "INTERNATIONAL" in applicant's mark, which applicant has disclaimed, are descriptive of applicant's services. Thus, consumers will look to the word OXFORD as the source-indicating portion of these marks. As for the registered mark, the words LEGAL ASSOCIATES are also descriptive and have been disclaimed. They are also depicted in much smaller letters, and therefore have a minimal visual presence. Although the registered mark has a noticeable design element, when a mark comprises both a word and a design the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). That is the case here, since consumers may well discuss or recommend a provider of

employment services orally. Accordingly, while we have compared the marks in their entireties, for the reasons given above we have accorded greater weight to the word OXFORD in each.

Although there are specific differences between applicant's marks and the registered mark, the differences are not sufficient to distinguish the marks. Rather, consumers are likely to regard these various OXFORD marks for identical and closely related services as mere variations of each other, with all of them indicating services emanating from a single source. Thus, consumers may view OXFORD LEGAL ASSOCIATES and design as designating employment services for the legal profession and regard OXFORD INTERNATIONAL as a division that deals with international placements and/or employment in companies that concentrate on international work. Moreover, because OXFORD & ASSOCIATES includes the same word, ASSOCIATES, used in much the same way as ASSOCIATES is used in OXFORD LEGAL ASSOCIATES, consumers are likely to view OXFORD & ASSOCIATES as the division that handles non-legal placements, while OXFORD LEGAL ASSOCIATES and design deals with legal placements. Thus, although a direct comparison between applicant's marks and the registered mark shows specific differences, which we have taken into account,

when the marks are compared in their entireties, overall they are similar in appearance, pronunciation, connotation and commercial impression.⁵ We also point out that, under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

In its appeal brief applicant has made the argument that the term OXFORD is weak, and that the commonality of this term in its marks and the registered mark is not likely to cause confusion. In support of this argument, applicant pointed to a listing of third-party registrations (consisting of the mark, registration number, and indication that the registration is "live") for marks comprising or containing the word OXFORD which was taken from the USPTO TESS database. Applicant had submitted this list in its response to the first Office action in each application, and the Examining Attorney advised applicant that such a listing was insufficient to make the

⁵ While in its appeal brief applicant argues that the non-Oxford elements in the marks cause the marks to have different connotations, in its reply brief applicant also argues that the word OXFORD has a different connotation in registrant's mark from the connotation it has in applicant's marks. We address that argument infra.

registrations of record. Nonetheless, applicant never submitted copies of the actual registration, and merely submitted another copy of this same listing with its brief in each appeal. In his brief, the Examining Attorney maintained his objection to the listing. Applicant never addressed this objection in its reply brief, nor did it reiterate its claim that the cited registration is weak, so it appears that applicant has conceded that the objection is well taken. In any event, we agree with the Examining Attorney that submitting a mere listing of third-party marks and registration numbers is insufficient to make such registrations of record. See TBMP §1208.02 (2d ed. rev. 2004), and cases cited therein.⁶

Applicant also asserts that, as used in the cited registration, OXFORD is a geographically suggestive term. It bases this statement on information taken from a map of Pennsylvania, which it asks us to judicially notice. In his brief, the Examining Attorney has stated that he has no

⁶ Even if the listing of third-party marks were considered, they would not change the result herein. The listing does not indicate the goods or services of the various registrations, such that we could view OXFORD as having a significance for employment services. Applicant itself states that none of the registrations is for services in Class 35. Moreover, the evidence submitted by the Examining Attorney in the final Office action, of a search he conducted of USPTO records on June 23, 2005, shows that there are no third-party registrations for OXFORD marks for such services or services related thereto.

objection to our consideration of this evidence, although he has asked us to also consider evidence taken from wikipedia.org and from the official website of the Oxford, Pennsylvania Chamber of Commerce as rebuttal to the evidence submitted by applicant with its brief. In view of these circumstances, applicant's evidence will be treated as having been stipulated into the record, and we also grant the Examining Attorney's request. See TBMP 1207.03. We also note that applicant has discussed this evidence in its reply brief.

The map submitted by applicant indicates that there is a town named Oxford located in southeastern Pennsylvania, very close to the Pennsylvania/Maryland border and within approximately 20 miles of Wilmington, Delaware. The website evidence from the Oxford Chamber of Commerce reports that, according to the 2000 Census, the population of Oxford Borough (which is the town of Oxford) has 4315 residents. The website also states that "The Oxford area is an area of rich farmland and there is a definite Amish presence, which adds to the charm of this community." In applicant's main brief, it contended that, because Oxford, Pennsylvania is "less than 60 miles from the Fort Washington, Pennsylvania address listed for the owner of the cited registration ... OXFORD is a geographically

suggestive term in the cited registration." Brief, p. 8, Serial No. 76589185; pp. 7-8, Serial No. 76589186. In its reply brief, applicant appears to have changed its argument somewhat, asserting that as used in registrant's mark, OXFORD would have the connotation of this town, while such a meaning would not apply to applicant's marks.

We are not persuaded by either of these arguments. With respect to the connotation of the term in the registered mark, the fact that there is a small town located 60 miles away from the registrant's address of record does not mean that consumers would make a geographic association between this town and the registrant's services. This is not a situation where a company is located in a suburb of a major city, such that the name of the city would be viewed as the geographic location of the company. There is no evidence that Fort Washington, Pennsylvania has any relationship whatsoever with Oxford, Pennsylvania, or that consumers would make any association between the registrant's address in Fort Washington and the word OXFORD in its mark. Thus, the fact that there is a town in Pennsylvania called Oxford does not give the registrant's mark a connotation different from the applicant's marks.

As for applicant's argument that OXFORD is a geographically suggestive term, and therefore weak, again the fact that Oxford is the name of a small town in Pennsylvania is insufficient to demonstrate that OXFORD, as used in the registrant's mark, has this geographic significance. The word "oxford" has a variety of meanings, including that of the famous university in England. In view thereof, we do not consider OXFORD to be a geographically suggestive term, such that the cited registration should be entitled to a limited scope of protection. Based on the evidence that is of record, we must consider the cited registration to be a strong mark for the identified services.⁷ The non-Oxford elements in applicant's marks and in the registered mark are not sufficient to distinguish applicant's marks from the cited mark. The factors of the similarity of the marks, and the strength of the registered mark, favor a finding of likelihood of confusion.

Applicant has argued that consumer sophistication should play a strong role in the likelihood of confusion analysis. Even if we assume that companies that use

⁷ In view thereof, the case cited by applicant, *In re Texas Trading & Milling Corp.*, 178 USPQ 319 (TTAB 1978) is distinguishable. In that case, the marks TEXAS BEST and TEXAS PRIDE were both found to be highly suggestive, and therefore the registered mark was accorded only a narrow scope of protection.

employment agencies make their choices with care, applicant's marks are so similar to the registrant's mark that this would not avoid the likelihood of confusion. Instead, as discussed above, even careful consumers are likely to believe that applicant's marks and the registered mark are variations of each other, with all three indicating a single source for the services. Moreover, we do not see how the asserted sophistication of these consumers would avoid confusion. Applicant's services and those of the registrant are for the most part identical and otherwise closely related. The registrant's mark, as far as this record is concerned, is a strong mark. In these circumstances, even sophisticated consumers are likely to believe that when applicant's marks, which are so similar to the registrant's, are used in connection with such services, the services come from a single source. Moreover, although applicant presumably views its customers as employees of personnel offices or human relations specialists when it asserts that they are sophisticated, applicant's services and those of the registrant would also be rendered to the employees that applicant and registrant recruit and place. Such consumers would not have a particular sophistication in the employment agency field. Rather, someone looking for a job might hear from a friend

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of a good experience with OXFORD LEGAL ASSOCIATES. Upon being contacted by or seeing an advertisement from OXFORD & ASSOCIATES or OXFORD INTERNATIONAL, that person might, because of the fallibility of memory, think that this was the same name that had been mentioned by the friend, or think that these marks are variations of OXFORD LEGAL SERVICES. Accordingly, we cannot find that this factor of the conditions under which and buyers to whom sales are made favors applicant's position.

Finally, applicant asserts that there have been no incidents of actual confusion. In support of this argument, applicant relies on the declaration of its president, Michael J. McGowan. Mr. McGowan states that his company has used the trademarks in issue since prior to August 15, 1995, the claimed date of first use in the cited registration, and that he is not aware of any instances of actual confusion. However, although applicant has stated the length of time it has used its marks, it has not provided any information about the extent of such use, including whether the mark has been used or advertised in the same market area as the registrant's mark. For that matter, we have no information whatsoever about the registrant's activities, such as the area in which the registrant renders its services, or the extent of its

business activity or its advertising. Nor do we have any information from the registrant as to its experience with actual confusion. As the Court stated in *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984), quoted by the Examining Attorney in his brief (citations omitted):

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case). Moreover, the test under Section 2(d) of the Statute is not actual confusion but likelihood of confusion.

Thus, the fact that applicant has not experienced any actual confusion is entitled to little weight in our analysis of the issue of likelihood of confusion.⁸

Having considered the du Pont factors on which there is evidence, we find that applicant's use of the marks OXFORD & ASSOCIATES and OXFORD INTERNATIONAL for its

⁸ Cases in which lack of evidence of actual confusion have been found persuasive generally involve inter partes proceedings, in which the experience of both parties is of record.

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identified services in Class 35 is likely to cause confusion with the registration for OXFORD LEGAL ASSOCIATES and design.

Decision: The refusals of registration of OXFORD & ASSOCIATES and OXFORD INTERNATIONAL with respect to the services in Class 35 are affirmed. However, because the Examining Attorney did not refuse registration with respect to the services in Class 42, after this appeal is terminated the applications will go forward to publication for the services in Class 42.