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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re National Affinity Group, LLC

Serial No. 78536363

David M. Lafkas of Lafkas Patent LLC for National Affinity Group, LLC.

Kristina Kloiber, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

National Affinity Group, LLC has appealed from the final refusal of the Trademark Examining Attorney to register AFFINITY GROUP THE RESOURCEFUL BUSINESS PARTNERS and design, shown below, with the words GROUP and BUSINESS PARTNERS disclaimed, for "professional services, namely, employment hiring, recruiting, placement, staffing and career networking services; business project management;

business management consultation; business consulting services relating to distribution solutions.”¹ Applicant has provided the following description of its mark: “The mark consists of a stylized uppercase letter ‘A’ having a shape of a key inside the ‘A’.”



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 mark so resembles the following marks, previously registered by the same entity, that, when used in connection with applicant’s identified services, it is likely to cause confusion or mistake or to deceive:

AFFINITY, in standard character form,² for:

Business consulting services; procurement services, namely purchasing computer software, telephone services, bill paying services, inventory management services, and internet connectivity services for others; retail store

¹ Application Serial No. 78536363, filed December 21, 2004, and asserting first use and first use in commerce as of September 2004.

² Registration No. 2705052, issued April 8, 2003. This registration also includes services in Class 38 and Class 42, but it is clear from the file that the refusal of registration is based on the services in Class 35.

services in the field of office supplies, computer software, and business products; operation of businesses for others, namely operation of on-line retail stores in a wide variety of fields (Class 35); and

affinity

for:

Business consulting services; procurement services, namely purchasing computer software, long distance telephone services, bill paying services, inventory management services, and internet connectivity services for others; retail store services in the field of office supplies, computer software, and business products; operating of businesses for others, namely operating of on-line retail stores in a wide variety of fields (Class 35).³

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

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*

³ Registration No. 2729756, issued June 24, 2003. This registration, like Registration No. 2705052, also includes services in Classes 38 and 42, but they are not the basis for the refusal of registration.

Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).⁴ 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).

Turning first to the factor of the similarity of the services, applicant "submits that the respective services do not overlap." Brief, p. 11. Applicant apparently takes this position by focusing on the "employment hiring" item in its identified services, and comparing it with the "procurement services" identified in the cited registrations. See brief at p. 12. However, applicant's identification of services also includes "business project management; business management consultation; business

⁴ In its brief applicant states that "the courts have long followed the eight-part Polaroid test in determining the likelihood of confusion between marks." Brief, p. 8. While this is the test promulgated by the Second Circuit (*Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 128 USPQ 411 (2d. Cir. 1961)), the Board follows the test set forth by our primary reviewing Court, the Court of Appeals for the Federal Circuit, and its predecessor court, the Court of Customs and Patent Appeals. Applicant has also recognized this, to the extent that it has stated that "likelihood of confusion under Section 2(d) is based upon the analysis of the various *duPont* factors." Brief, p. 9. For purposes of our analysis herein, the relevant factors under du Pont and Polaroid identified by applicant are the same.

consulting services relating to distribution solutions.”

The services enumerated in the cited registrations include “business consulting services.” The “business consulting services” listed in the registrations encompass the “business management consultation services” and “business consulting services relating to distribution solutions” identified in applicant’s application. Where the goods or services in a cited registration are broadly described and there are no limitations in the identification as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods and services of the nature and type described, that they move in all channels of trade that would be normal for such goods and services, and that the goods and services would be purchased by all potential customers. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Thus, we must treat the services as being legally identical in part. In addition, “business project management” services are closely related to “business consulting services.”

Accordingly, the du Pont factors of the similarity of the services and the channels of trade favor a finding of likelihood of confusion.

When marks would appear on virtually identical goods or services, 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 mark, as set forth above, contains a large letter "A" next to the word AFFINITY GROUP, and the phrase THE RESOURCEFUL BUSINESS PARTNERS shown in much smaller letters below.



The cited registrations are both for the mark AFFINITY, one in standard character form and therefore not limited to any particular display, and the other in stylized form.

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 words AFFINITY GROUP and the "A" design are visually the most prominent part of applicant's mark. THE RESOURCEFUL BUSINESS PARTNERS would be viewed as a mere slogan that describes the services and, if people were to aurally refer to the mark, they are likely to omit this phrase. As for the design element, as a general rule, if 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). This is particularly true of business management and business consulting services, since they are not products that would be bought off-the-shelf, but can be the subject of a word-of-mouth recommendation. Therefore, even though the "A" design is a prominent element in applicant's mark, we do not consider it to be sufficient to distinguish it from the registered marks for AFFINITY and AFFINITY in stylized form.⁵ If anything, it merely reinforces the word AFFINITY. Nor does the word GROUP in applicant's mark serve to distinguish it.

⁵ Applicant has asserted that the "A" design contains a "G" in the negative space formed by the top portion of the "A" with the key. We note that applicant made no reference to a letter "G" in its description of the mark. In any event, the letter "G" is not readily apparent, and would not be deciphered by most people. Rather, most would view the design as merely the letter "A" with a key.

This word, which has been disclaimed, is a descriptive term that has no source-indicating value. Thus, if an executive in a company hears of another company's successful experience with AFFINITY business consulting services, the executive might well think, upon encountering applicant's mark, that it is the registrant's mark. Even if a potential consumer notes the differences between applicant's mark and the registrant's AFFINITY marks, he/she is likely to assume, when these marks are used for identical or closely related services, that the marks are all variations of each other, and that they all indicate services emanating from the same source.

We have undertaken a rather detailed analysis of applicant's mark not because we have dissected the marks and then compared them, but to explain our reasons for according the word AFFINITY in applicant's mark greater weight in our consideration of the marks. When the marks are considered in their entirety, they convey a similar commercial impression.

Applicant argues that the connotations of the marks are different because its mark includes the phrase THE RESOURCEFUL BUSINESS PARTNERS, "connoting an entity [that] works efficiently, skillfully, and promptly in conjunction [with] businesses to assist in their needs." Brief, p. 10.

However, as discussed above, this phrase has such a subordinate position in applicant's mark that it is not the phrase that gives the mark its connotation, but the word AFFINITY. And this word is the same as the entirety of the registered marks. As a result, the connotations of the marks are the same.⁶

We have also considered applicant's argument that its mark contains five more words than the registered marks, and that its mark has "more than three times the number of syllables"--thirteen rather than four--than the registered marks. Brief, p. 10. However, we are not persuaded by this rather mechanical analysis.

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 or services 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.

⁶ Applicant makes the point that the word "affinity" has a number of definitions, including "relationship by marriage." We doubt that this meaning is the one people would ascribe to marks used for business consulting or business management services. However, we need not speculate as to what definition of "affinity" consumers would apply. Because both applicant's and the registrant's marks are used for legally identical services, the word would have the same meaning in both marks.

Baseball America Inc. v. Powerplay Sports Ltd., 71 USPQ2d 1844, 1848 (TTAB 2004). Overall, applicant's mark and the registered marks convey the same commercial impression and, as discussed above, to the extent that consumers would note the differences between applicant's mark and the registered marks, they would view applicant's mark as a variation of the registered marks, with all of them indicating a single source of the services.

The factor of the similarity of the marks favors a finding of likelihood of confusion.

The third du Pont factor that applicant has mentioned is "the conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." Applicant's argument in this respect is that "the respective services are purchased by sophisticated consumers, i.e., not those in the business of making hasty decisions without excessive due diligence." Brief, p. 8. We agree with applicant that purchasers of business consultation services will be careful, and will not make a decision to hire a company on impulse. However, because of the similarity of the marks, careful purchasers, even if they note the differences between applicant's mark and the registered marks, are likely to believe that applicant's mark is a variation of the two registered AFFINITY marks,

and view all three marks as indicating origin in a single source.

Finally, applicant asserts that it had previously owned an application for another AFFINITY GROUP mark for the same services (Serial No. 78273995) which had been approved for publication despite the existence of the registrations cited herein. Applicant argues that it should be able to rely on precedent "when considering, evaluating and filing for additional trademark registrations--especially when the only aspect of Applicant's present mark apparently at issue with the Trademark Office is unchanged from the previous application." Brief, p. 13.

In *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001), the Court stated:

Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application.

We agree that it is unfortunate that applicant apparently assumed that it would not encounter a likelihood of confusion refusal when it filed its present application in view of its prior experience. (Applicant states that its prior application was abandoned because of a potential

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opposition arising out of a different design element that was present in that mark.) However, the Board's mandate is to consider whether an applied-for mark is likely to cause confusion with a previously registered mark, and in view of the du Pont factors we have discussed, that is our assessment here.

Decision: The refusal of registration is affirmed.