

10/29/01

Hearing:
July 26, 2001

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Flexible Resources, Inc.

Serial Nos. 75/538,019 and 75/538,020

Michael M. Zadrozny of Shlesinger, Arkwright & Garvey,
L.L.P. for Flexible Resources, Inc.

Michael Engel, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Bottorff, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Flexible Resources, Inc. has applied to register the
mark FLEXIBLE RESOURCES (in typed form) and the composite
word and design mark set forth below, each for services
identified as "employment counseling and recruitment."



Ser No. 75/538,019 and No. 75/538,020

Each application is based on applicant's claim of use of the involved mark in commerce. In each application, applicant has alleged January 1996 as the date of first use and first use in commerce.

The Examining Attorney, in regard to each application, has refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), because of the prior registration of the mark FLEXIBLE PERSONNEL for "temporary personnel placement and recruitment services." In addition, he has made a requirement in each application, under Section 6 of the Lanham Act, 15 U.S.C. §1056, that applicant include a disclaimer of exclusive right to use of the term RESOURCES. While the Section 2(d) refusal was clearly argued in each office action, these actions have been less clear in regard to the disclaimer requirement and, therefore, as a preliminary matter, we review these actions to determine the proper scope of the appeals.

In the initial action in each application, the Examining Attorney asserted that the term RESOURCES is descriptive and required a disclaimer of the term. Applicant, in arguing against each Section 2(d) refusal, asserted that FLEXIBLE is a descriptive term or, at best a highly suggestive term, for applicant's and registrant's services. The Examining Attorney, in the respective second

Ser No. 75/538,019 and No. 75/538,020

office actions, stated that the evidence applicant offered to support this assertion was persuasive. Therefore, in application no. 75/538,019 for FLEXIBLE RESOURCES and design, the Examining Attorney changed the disclaimer requirement to seek a disclaimer of the entire phrase FLEXIBLE RESOURCES; and in application 75/538,020, for the typed mark FLEXIBLE RESOURCES, the Examining Attorney issued a refusal of the entire mark, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive.

In its responses to the respective second office actions, the applicant submitted a disclaimer only of FLEXIBLE. Applicant argued that RESOURCES is not descriptive and, in the alternative, even if it is, it has acquired distinctiveness in regard to applicant's services.

The Examining Attorney, in his respective final office actions, accepted the disclaimer of FLEXIBLE, maintained his position that RESOURCES is highly descriptive for applicant's services, rejected both applicant's argument to the contrary and its alternative claim of acquired distinctiveness, and made final the requirement for a disclaimer of RESOURCES.

In regard to application no. 75/538,019 for FLEXIBLE RESOURCES and design, we consider the final requirement for

Ser No. 75/538,019 and No. 75/538,020

a disclaimer of RESOURCES to constitute a requirement that the disclaimer of FLEXIBLE be amended to a disclaimer of FLEXIBLE RESOURCES. See Trademark Manual of Examining Procedure [TMEP] §1213.09(b), which directs an Examining Attorney to require a single disclaimer of unregistrable matter in its entirety rather than disclaimer of individual components.

In regard to application no. 75/538,020 for the typed mark FLEXIBLE RESOURCES, the final requirement for a disclaimer of RESOURCES is perplexing. In view of both the Examining Attorney's acceptance of a disclaimer of FLEXIBLE in that application and his continuing argument that RESOURCES is descriptive, the Examining Attorney ought to have maintained and made final his refusal of registration under Section 2(e)(1), for an entire mark may not be the subject of a disclaimer. See Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991). We do not, however, consider the final requirement for a disclaimer of RESOURCES to constitute a final refusal of registration under Section 2(e)(1); neither the Examining Attorney nor applicant presented arguments in their appeal briefs on that basis. Rather, we consider the Section 2(e)(1) refusal to have been withdrawn. In any event, we need not divine the

Ser No. 75/538,019 and No. 75/538,020

Examining Attorney's thinking in regard to this issue for, *infra*, we find RESOURCES to be suggestive rather than descriptive, in conjunction with applicant's services; and we do not, therefore, reach applicant's alternative argument that the term has acquired distinctiveness.

Applicant has appealed from the Section 2(d) refusal and disclaimer requirement in each application. Though separate briefs were filed by both applicant and the Examining Attorney in regard to each application, the applications were consolidated for a single oral argument.¹

We consider the asserted descriptiveness of RESOURCES first. It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See, In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); also, In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

¹ The issues presented by each appeal are essentially identical, and the facts are similar. Accordingly, in the interest of judicial economy, we consider the appeals together and issue a single opinion.

The record on this issue includes three third party registrations and a dictionary definition of "resources," all made of record by the Examining Attorney²; and a much larger number of third party registrations made of record by applicant with its reply brief.³ The Examining Attorney also attempted to make of record a definition of "human resources" from an on-line dictionary, by requesting in his brief in each case that we take judicial notice of the same. Applicant, however, objected to this request in his reply brief. The objection is well taken; we have not considered the definition.⁴ See In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999).

Two of the three registrations made of record by the Examining Attorney do not, in fact, include disclaimers of the term "resources." One of these two registrations

² The registrations were made of record in both application files. The definition was made of record only in application no. 75/538,020, but was relied on by the Examining Attorney in each of the briefs, without objection by applicant.

³ During the oral hearing, the Examining Attorney discussed this evidence and treated it as part of the record.

⁴ We note that, in any event, the definition of "human resources," even if considered, would not change our decision. The question presented by the Examining Attorney's requirement that applicant disclaim rights in "resources" because it is descriptive is not resolved by trying to establish that "human resources" is descriptive of applicant's services, at least in the absence of a concurrent showing that "resources" is an accepted shorthand reference to "human resources." On this latter point, we have only the Examining Attorney's argument, which we find unpersuasive.

Ser No. 75/538,019 and No. 75/538,020

includes a disclaimer of "technical resources" and the other includes a disclaimer of "human resources." Thus, the Examining Attorney's support for his claim that "resources" is descriptive when used in connection with applicant's services consists of (1) the registration for the mark EMINENT RESOURCES for "employment agency services in the field of data processing," which includes a disclaimer of "resources," and (2) a dictionary definition of "resources." In contrast, applicant has made of record many third party registrations, for services similar to applicant's, that include the term "resources" and which do not include a disclaimer of that term. In fact, many of these registrations include only two words and, in each, the word other than "resources" is disclaimed. On this record, we cannot say that the Examining Attorney has made out a prima facie case that "resources" is descriptive of applicant's services.⁵ We reverse the requirement for a disclaimer of "resources" in each of the applications.

⁵ Third party registrations, of course, are not evidence that the registered marks are in use in commerce or that consumers are familiar with them. They can, however, be probative in the same way that dictionary definitions can, i.e., as tending to establish the meaning for a particular term in a particular field. The registrations entered by applicant tend to counter the Examining Attorney's contention that when "resources" is used in connection with employment agency, employment counseling, and recruitment-type services it will generally be understood to mean only "human resources."

Ser No. 75/538,019 and No. 75/538,020

We therefore turn to the Section 2(d) refusal in each application. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. duPont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any particular case, key considerations in the analysis of likelihood of confusion may be the similarities or dissimilarities of the marks and the similarity or dissimilarity of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant does not argue that its services are significantly different from those listed in the cited registration. Thus, our focus is on the marks.

In essence, the Examining Attorney argues that the dominant part of the mark FLEXIBLE PERSONNEL is FLEXIBLE, because PERSONNEL is the subject of a disclaimer; that FLEXIBLE is also the dominant element of applicant's marks, in view of the asserted descriptiveness of RESOURCES; and that, in regard to applicant's mark FLEXIBLE RESOURCES and design, applicant cannot rely on the design element to distinguish its mark from the cited mark because, in composite word and design marks, words tend to dominate

Ser No. 75/538,019 and No. 75/538,020

over designs and the addition of a design will not obviate a likelihood of confusion that exists when two marks have similar literal elements.

Applicant argues that FLEXIBLE is weak, if not descriptive, when used in connection with employment services because it is the current equivalent of "part-time"; that the Examining Attorney has acquiesced in this contention by finding applicant's evidence in support thereof "persuasive" and accepting applicant's disclaimer of FLEXIBLE; that RESOURCES is the dominant element of applicant's mark; that the sight, sound, meaning and overall commercial impression of the marks differ; and that the Examining Attorney reached a contrary conclusion only by impermissibly dissecting the marks.

In this case, we find the dissimilarities in the marks of particular significance. FLEXIBLE PERSONNEL and FLEXIBLE RESOURCES, though they share the same first word, are pronounced differently. In addition, they look different, particularly when applicant's mark FLEXIBLE RESOURCES and design is considered. The connotation of FLEXIBLE PERSONNEL is quite specific; the connotation of FLEXIBLE RESOURCES is more ambiguous.⁶

⁶ We acknowledge a theoretical difficulty presented by the apparent conflict between, on the one hand, the Examining

Ser No. 75/538,019 and No. 75/538,020

In view of the differences in the marks, we find there is no likelihood of confusion, mistake or deception among consumers. Accordingly, we reverse the Section 2(d) refusals.

Decision: The refusal of registration under Section 2(d), in each application, is reversed. The requirement, made under Section 6 of the Lanham Act, for a disclaimer of RESOURCES in each application, also is reversed.

Attorney's argument that FLEXIBLE must be considered the dominant portion of the cited mark, in view of the disclaimer of PERSONNEL, and, on the other hand, applicant's disclaimer of the FLEXIBLE portion of its marks, even though applicant and registrant use the marks in connection with similar services. Notwithstanding this apparent difficulty, we have evaluated the connotation of applicant's marks, as we must, based on the record created in these applications. On that record, FLEXIBLE is the less dominant term in applicant's marks. We also find that the scope of protection to be accorded FLEXIBLE PERSONNEL is narrow.