

THIS OPINION IS NOT A
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February 7, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Access Communications, LLC

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Serial No. 85119888

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Maria A Scungio of Edwards Wildman Palmer LLP for Access Communications, LLC.

Nicholas K. D. Altree, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Zervas, Bergsman and Greenbaum, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Access Communications, LLC (“applicant”) filed an intent-to-use application for the mark S³ STRATEGIC SELLING SOLUTIONS and design, shown below, for services ultimately identified as follows:

Educational services, namely, providing training programs in the field of sales strategy within the managed healthcare industry, specifically, government, commercial and employer payer channels addressing prescription product access and reimbursement, managed care, health care reform, employer benefits, comparative effectiveness and long term care, in Class 41.



STRATEGIC SELLING
S O L U T I O N S

Applicant disclaimed the exclusive right to use the term “Strategic Selling Solutions.”

The Trademark Examining Attorney refused to register applicant’s mark on the ground that it so resembles the mark S³ (stylized), shown below, for the services set forth below as to be likely cause confusion.¹ Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).

Educational services, namely conducting seminars and workshops in the fields of business and sales strategy, negotiating strategy, marketing strategy and business organization strategy and distribution of course materials in connection therewith, in Class 41.



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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the

¹ Registration No. 1982549, issued June 25, 1996; renewed.

similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The 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”).

A. Similarity of the services, channels of trade and classes of consumers.

Applicant is seeking to register its mark for sales strategy training programs in the field of managed health care field. The recitation of services in the cited registration is for conducting seminars and workshops, *inter alia*, in the field of sales strategy. Where the services in the registration are broadly identified as to their nature and type, we must allow for all possible services that may fall within the recitation, including conducting sales strategy workshops and seminars in the managed health care field. Where, as here, there are no restrictions as to the channels of trade and classes of purchasers, it is presumed that in scope registrant’s recitation of services encompasses all of the services of the nature and type described therein and that the identified services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). *See also Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Thus, for our purposes, the services are in part legally identical. Where the services are in part legally identical, we must presume that the channels of trade

and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Even though the services are not completely identical, a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the services set forth in the application and the cited registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

Applicant contends the services of the parties are distinguishable because applicant “is a professional service *specializing in health care communications and marketing . . . to develop sales strategies that enhance demand for pharmaceutical products*” and registrant provides “an internal business assessment and improvement tool, developed through surveys and focus groups ... identifying a way of aligning *sales, support and service* functions within companies, to achieve

improved customer support.”² (Emphasis is the original). As discussed above, the problem with applicant’s argument is that it uses extrinsic evidence to distinguish the services of applicant and registrant. In considering the scope of the cited registration, we look to the recitation of services in the registration itself, and not to extrinsic evidence about the registrant’s actual services, customers, or channels of trade. *In re Elbaum*, 211 USPQ at 640, citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139.³

In view of the foregoing, we find that the services are in part identical and they are presumed to move in the same channels of trade and are sold to the same classes of consumers.

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, meaning and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d

² Applicant’s Brief, p. 7.

³ This is not a case where the recitations of services are unclear and applicant uses extrinsic evidence to show that the recitations of services have specific meanings to members of the trade. See *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990) (“... when the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.” (internal citations omitted)). See also *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Moreover, 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 so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

While applicant's mark S³ STRATEGIC SELLING SOLUTIONS and design and registrant's mark S³ (stylized) have obvious differences, both feature the term S³. In fact, applicant's mark incorporates registrant's entire mark. *See Saks & Co. v. TFM Indus. Inc.*, 5 USPQ2d 1762, 1764 (TTAB 1987) ("the use of the phrase BY FIRE ISLANDER [in FOLIO BY FIRE ISLANDER] may only tend to increase and not decrease the likelihood of confusion" with FOLIO); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986)(SPARKS BY SASSAFRAS for women's clothing is

likely to cause confusion with SPARKS for shoes, boots and slippers, in part, because “[t]he words ‘by sassafras’ indicate to prospective purchasers that ‘sassafras’ is the name of the entity which is the source of the ‘SPARKS’ brand clothing. Prospective purchasers do not necessarily know or care which business calls itself ‘sassafras,’ but they would assume that when ‘SPARKS’ appears on two similar products they both come from the same source.”); *In re Riddle*, 225 USPQ 630 (TTAB 1985)(“Richard Petty's Accu Tune” for automotive service centers specializing in engine tune-ups and oil changes, is likely to cause confusion with “Accutune” automotive testing equipment.”).

In this case, the structure of applicant’s mark having the S³ design above three words beginning with the letter “S” emphasizes the S³ design. In other words, the term STRATEGIC SELLING SOLUTIONS evokes the S³ commercial impression. By the same token, registrant uses its S³ mark in connection with “sales, support and services” evoking the same commercial impression as applicant’s mark.⁴

Further highlighting the importance of the S³ design is the propensity of consumers to abbreviate names (*e.g.*, consumer may shorten STRATEGIC SELLING SOLUTIONS to S3, S³, or as applicant referred to the mark S “to the third power” or “S cubed”).⁵ In this regard, “[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline

⁴ Registrant’s website attached to the August 3, 2011 Office action.

⁵ Applicant’s Brief, p. 3.

service station to gas station.” *In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring).

[C]ompanies are frequently called by shortened names, such as Penney’s for J.C. Penney’s, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward’s for Montgomery Ward’s, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).

Applicant often abbreviates its mark in marketing materials and refers to its services as S³. The examples listed below are illustrative.

FOUNDATION OF SALES TRAINING AND ROI

S³ is a strategic selling partner offering specialized tools and services to address the managed markets business-acumen needs of our pharmaceutical and biotechnology clients.⁶

PRESS ROOM

S³ (Strategic Selling Solutions) Launches With Success at the Society for Pharmaceutical and Biotech Trainers (SPBT) Annual Conference

In May 2011, S³, an Access Group company, premiered at the SPBT 40th annual conference in Orlando as a full-fledged training entity. In addition to launching a striking booth design that featured the S³ creative concept, “tailored training,” S³ also was an invited workshop presenter, along with its client, sanofi-aventis. ...⁷

⁶ Applicant’s website attached to the August 3, 2011 Office action.

⁷ *Id.*

Introducing the Access Group and Its New Business Entities

Leading Health Care Communications Firm Expands Consultancy Offerings and Executive Staff to Meet Growing Client Demands

Berkeley Heights, NJ [March 18, 2011] - ...

S³ was founded on the continuous organic requests by clients of the Access Group's managed markets entities to provide quality insight and guidance to help them meet sales training return-on-investment challenges. With this solid foundation in managed markets, S³ provides specialized strategic consulting to advance managed market excellence. S³ employs multifaceted, stimulating adult-learning approaches to turn perceived managed markets barriers into opportunities for actionable, strategic execution within all payer channels.⁸

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⁸ *Id.*

⁹ *Id.*



The S³ initial or abbreviation is inherently arbitrary when used in connection with sales strategy education services. Such an arbitrary or inherently meaningless initial or abbreviation is more difficult to remember than ordinary words and more likely to be found similar to another letter “S” initial or abbreviation. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990). Applicant’s use of the S³ initial or abbreviation is likely to trigger the recollection of registrant’s S³ mark used in connection with similar services.

Even if we consider the term Strategic Selling Solutions to be the dominant portion of applicant’s mark, the use of that term where each word begins with the letter “S” emphasizes the S³ feature of the mark. Accordingly, giving appropriate weight to the components of applicant’s mark, we find that on balance, the similarities in the marks outweigh their differences and, therefore the marks are similar.

C. Degree of care.

Applicant, without any evidentiary support, contends that the relevant consumers will exercise a high degree of consumer care, thereby minimizing any likelihood of confusion.

¹⁰ *Id.*

In the present case, inherent in the nature of the services offered by the Applicant is the fact that the class of consumers are [sic] pharmaceutical and biotechnology industry professionals. These professionals are sophisticated and knowledgeable [sic] and less likely to be confused than ordinary consumers. The purchasers of services identified in the Cited Mark are professional buyers focused on services to improve the operation of their respective business organizations. Given the experienced, sophisticated and professional nature of these purchasers, confusion between Applicant's Mark and the Cited Mark is unlikely.¹¹

Based on the nature of the services at issue, we find that the relevant consumers will exercise a high degree consumer care in making their decision to engage applicant or registrant.

D. Balancing the factors.

In view of the facts that the marks are similar and that they are used in connection with services that are in part legally identical and, therefore, presumptively moving in the same channels of trade to the same classes of consumers, we find that applicant's mark S³ STRATEGIC SELLING SOLUTIONS and design for "educational services, namely, providing training programs in the field of sales strategy within the managed healthcare industry" is likely to cause confusion with the mark S³ (stylized) used in connection with conducting seminars and workshops in the fields of business and sales strategy.

Decision: The refusal to register is affirmed.

¹¹ Applicant's Brief, p. 8. Without any evidentiary support, we are left to speculate about the "experienced, sophisticated and professional nature of these purchasers" and the role this high degree of care plays in the purchasing process vis-à-vis the marks at issue.