

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Borchers
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Serial No. 76717536

Paul M. Denk, for James A. Borchers.

Justin Severson, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

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Before Shaw, Gorowitz and Masiello,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

James A. Borchers (“Applicant”) seeks registration on the Principal Register of
the mark INNOVARE LAW (in standard characters) for

“Legal services, excluding intellectual property laws,” in
International Class 45.¹

The Trademark Examining Attorney refused registration of Applicant’s mark
under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 76717536 was filed on February 3, 2015, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The word “LAW” is disclaimed

Applicant's mark so resembles the mark InnovarIP Consulting Group and design, as set forth below,



for “legal document preparation and research services for attorneys, legal research and legal services, namely, providing customized information, counseling, advice and litigation services in all areas of intellectual property laws,” in International Class 45,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed. We affirm the refusal to register.

I. Likelihood of Confusion.

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.*, 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

² Registration No. 4068966 issued December 13, 2011. The phrase “Consulting Group” is disclaimed.

1976). *See also, In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity or dissimilarity of the marks.

We start our analysis with a determination of the similarity or dissimilarity of the marks INNOVARE LAW (in standard characters) and



and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entirety ... 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 entirety.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, Applicant's mark is in standard characters while the cited mark is a composite mark consisting of a verbal or literal portion and a design. When evaluating a composite mark containing both words and designs, the verbal portion of the mark is typically the one most likely to indicate the origin of the goods or services to which it is affixed because it is the portion of the mark that consumers would use to refer to or request the goods or services. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012). *See also, In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1593-95 (TTAB 1999). The literal portion of the cited mark is InnovarIP Consulting Group.

The dominant part of Applicant's mark INNOVARE LAW is INNOVARE. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

In addition to placement, the word “LAW” has less significance since it is descriptive and disclaimed. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In*

re National Data Corp., 224 USPQ at 752 (Fed. Cir. 1983) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”); *In re Dixie Rests. Inc.*, 41 USPQ2d at 1533-34; *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Similarly, because of its placement, the dominant part of the cited mark is Innovar, since “IP”³ is descriptive of the subject-matter of the Registrant’s legal services and “Consulting Group,” is both descriptive and disclaimed.

The dominant portions of the two marks, Innovare and Innovar, have no meaning and thus are arbitrary. They are similar in appearance and sound.

Applicant, however, asserts that “the mark of the cited registration not only appears differently from the mark of this application, but obviously is going to the [sic] pronounced entirely differently, in its application.” Appeal Brief, 4 TTABVUE 7. In terms of how the marks are spoken, it is settled that “there is no correct pronunciation of a trademark that is not a recognized word.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014). Therefore, the

³ We take judicial notice that in the field of law the definition of IP is “intellectual property.” Merriam-Webster On-line Law Dictionary, <https://www.merriam-webster.com/dictionary/IP>.

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format, *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014).

dominant portions of the marks “INNOVARE” and “INNOVAR” may have the same or similar pronunciation.

When we compare the marks in their entireties, and give greater weight to the dominant elements, we conclude that the marks are similar in appearance, sound, and meaning. *See Palm Bay Imports., Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d at 1692 (affirming TTAB’s holding that contemporaneous use of appellant’s mark, VEUVE ROYALE, for sparkling wine, and appellee’s marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, noting that the presence of the “strong distinctive term [VEUVE] as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE”); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”); and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1266, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that even though applicant’s mark PACKARD TECHNOLOGIES (with “TECHNOLOGIES” disclaimed) does not incorporate every feature of opposer’s HEWLETT PACKARD marks, a similar overall commercial impression is created).

Accordingly, the first *du Pont* factor favors a finding of likelihood of confusion.

B. Similarity or dissimilarity of services, channels of trade and classes of purchasers.

Next, we determine the similarity or dissimilarity of the services. Our evaluation is based on the services as identified in the registration and the applications. *In re Dixie Rests. Inc.*, 41 USPQ2d at 1534. *See also Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001; and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's services are identified as "legal services, excluding intellectual property laws," which we read to mean the rendering of legal services in fields other than intellectual property law. The services in the cited registration are identified as "legal document preparation and research services for attorneys, legal research and legal services, namely, providing customized information, counseling, advice and litigation services in all areas of intellectual property laws."

Applicant argues that the "services rendered by the applicant, and by the registrant are different [because] [t]he service of the applicant is to the public, and not involved in any intellectual property law. The mark of the registration is generally the preparation of legal documents and research services, involving intellectual property law, for attorneys. Thus the channels of trade are quite distinct." Appeal Brief, 4 TTABVUE 7. To distinguish the services in the cited registration, Applicant incorrectly implies that Registrant's services are limited to preparation of legal documents and research services which are further limited to the subject matter of intellectual property and rendered to attorneys.

The Examining Attorney correctly notes that the document preparation and research services are the only services in the registration whose channels of trade are restricted to “attorneys.” Examining Attorney’s Brief, 6 TTABVUE 14. The subject matter of the remaining services (legal research and legal services) is limited to the subject matter of intellectual property law. *Id.*

Both the application and the cited registration cover “legal services,” which differ only by the area of law practiced. There is no restriction on the purchasers of the legal services, both of which can be offered to the same purchasers, including the public in general.

The services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007).

It is common knowledge that legal services are offered by law firms, which may include attorneys practicing in various areas of law. A firm offering intellectual property law services may also offer general litigation and other legal services under the same service mark. The services are often advertised and promoted together.

We find that the services are related and that the services are offered in the same channels of trade to the same classes of purchasers.

Thus, the second and third *du Pont* factors favor a finding of likelihood of confusion.

C. Conclusion.

After considering all the evidence and argument on the relevant *du Pont* factors regarding likelihood of confusion between Applicant's mark INNOVARE LAW (in standard characters) for "legal services, excluding intellectual property laws" and the

cited mark  for "legal document preparation and research services for attorneys, legal research and legal services, namely, providing customized information, counseling, advice and litigation services in all areas of intellectual property laws," we find that there is a likelihood of confusion.

Decision: The refusal to register Applicant's mark INNOVARE LAW is affirmed.