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Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Career Matrix, Inc.

Serial No. 75/487,869

Timothy E. Eagle of Varnum Riddering Schmidt & Howlett LLP for  
Career Matrix, Inc.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law  
Office 105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Bucher and Rogers, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Career Matrix, Inc. seeks registration on the Principal Register for the mark CAREER MATRIX for services recited as "employment agency, employment counseling and recruiting employment outplacement services, employee relocation and information regarding employees, employees and employment opportunities all of which may be accessed through a global computer network," in International Class 35.<sup>1</sup>

<sup>1</sup> Application Serial No. 75/487,869 was filed on May 19, 1998, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

This case is now before the Board on appeal from final refusals to register based upon Sections 6 and 2(d) of the Trademark Act, 15 U.S.C. §1056 and §1052(d). The Trademark Examining Attorney has held that the word "Career" must be disclaimed apart from the mark as shown inasmuch as it is merely descriptive of the recited employment services. The Trademark Examining Attorney has also held that applicant's mark, if it is used in connection with the recited services, so resembles the mark MATRIX registered for "placement of data processing professionals on both a permanent and contract basis," also in International Class 35,<sup>2</sup> that it would be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing.

We affirm the refusals to register.

DISCLAIMER

In support of his position that the word "Career" is merely descriptive of applicant's services, the Trademark Examining Attorney has placed into the record dictionary definitions of the term as well as LEXIS/NEXIS stories where

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<sup>2</sup> Registration No. 1,677,832, issued on the Principal Register on March 3, 1992; Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed.

the term is used in conjunction with employment services.<sup>3</sup>

This combination of sources certainly demonstrates a connection between the term "career" and employment services of various types, including those of applicant.

While applicant refers (in the context of its likelihood of confusion discussion, appeal brief, p. 3) to "Career" as the " ... arguably strongest portion of its mark," applicant fails to explain why the word "Career" is not descriptive or why it refuses to disclaim this term.<sup>4</sup>

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<sup>3</sup> The Trademark Examining Attorney searched the NEXIS news database using the query "CAREER W/5 EMPLOYMENT AGENC!" This search retrieved 517 results of which 23 of the first 49 hits were printed using the "kwic" format. While not reprinted herein, they do show that terms like "career," "careers," "career center," "career fairs," "career professionals," "career advisor," "career placement," "career help" and "career issues" occur in the same sentence with a term like "employment agency" (or "employment agencies"). It is also clear from these excerpts that the word "Career" is sometimes used within trade names for employment agencies, and that the terms "career sites" and "career portals" are general ways of describing online points for access to employment agency services of the type applicant is offering.

<sup>4</sup> In the final substantive paragraph of its appeal brief, applicant quotes to language from the *Trademark Manual of Examining Procedure* (e.g., TMEP §1213.05 "Unitary Marks," 3<sup>rd</sup> Ed. 2003) about the inappropriateness of a disclaimer requirement in composite marks involving unitary terms. However, there is no explanation as to why applicant concludes that the combination CAREER MATRIX is unitary.

Nor has applicant countered the Trademark Examining Attorney's showing that the word "Career" is descriptive. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [When the Trademark Examining Attorney sets forth a *prima facie* case, the applicant cannot simply criticize the absence of additional evidence supporting the refusal, but must come forward with evidence supporting its argument for registration.].

In light of the uncontroverted showing made by the Trademark Examining Attorney that the term "Career" is merely descriptive of a feature, purpose or function of applicant's services (i.e., use of applicant's services may help one begin or further a career), we affirm the refusal to register in light of applicant's failure to comply with the Office's requirement to disclaim this term.

LIKELIHOOD OF CONFUSION

Applicant also argues that the Trademark Examining Attorney has erroneously refused its application as being likely to cause confusion with the cited registration. Much of this discussion, however, is tied to the Trademark Examining Attorney's earlier (and erroneous) characterization of the word "CAREER" as having been disclaimed by applicant.<sup>5</sup> Nonetheless, applicant has largely failed to develop its

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<sup>5</sup> Applicant's response of August 2, 1999, began as follows:

The Examining Attorney has requested that Applicant insert the following disclaimer into the record:

"No claim is made to the exclusive right to use CAREER apart from the mark as shown."

The requirement is respectfully traversed.

...

Evidently, the Trademark Examining Attorney and the paralegal support staff within the Office erroneously processed this as if applicant has agreed to the disclaimer. When the Trademark Examining Attorney was alerted to this miscommunication by the applicant, he reinstated the requirement for a disclaimer on December 7, 2000 and went Final as to this refusal to register.

position in the context of the du Pont factors<sup>6</sup> under which we must decide this ground of refusal. Rather, in a most conclusory fashion, applicant contends that applicant's services are easily differentiated from registrant's services and that the two marks create different commercial impressions.

By contrast, the Trademark Examining Attorney takes the position that applicant's services are closely related to registrant's services and that the respective marks create substantially similar overall commercial impressions.

Turning first to a consideration of the respective services, it is well settled that services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

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<sup>6</sup> In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). This case sets forth the factors that must be considered in determining likelihood of confusion if relevant evidence is of record.

We concur with the Trademark Examining Attorney that applicant's "employment agency, employment counseling and recruiting employment outplacement services, employee relocation and information" services and registrant's services recited as the "placement of data processing professionals," are so closely related in a commercial sense that, if rendered under similar marks, confusion as to their origin or affiliation would be likely.

In defining registrant's and applicant's respective customers, we note that both applicant and registrant provide personnel placement services. It appears that registrant offers its services to "data processing" (now more commonly referred to as "information technology" or "IT") professionals. Ostensibly, applicant's services will be available to a broader range of personnel, but clearly applicant's population of job seekers would have to include IT or "data processing" professionals.

As to the way in which these services are, or will be, offered, it is explicit in applicant's recital that its services are to be provided online. While presumably registrant's services were offered from a brick-and-mortar location when first used in 1983, there is no restriction in registrant's recital that precludes its offering its services online. In short, we must consider applicant's services and

registrant's services as both being offered online. In any case, even if registrant's services were limited to a bricks-and-mortar operation, this distinction is without any meaningful significance because IT or "data processing" professionals in search of career placement could still obtain essentially the same assistance through either applicant's services or those of registrant. Thus, a consumer may not only utilize the registrant's professional placement services, but that same consumer, when selecting alternatives for additional employment assistance, may choose the applicant's other employment services under the mistaken belief that it is the same company that provided his/her initial placement services.

Furthermore, the Internet evidence made of record by applicant serves to confirm the closely related and overlapping nature of applicant's and registrant's services. Not surprisingly, "computers" is among the "career channels" touted on applicant's webpages. Such evidence reveals that personnel placement services of the type registrant offers are identical to the services that applicant intends to offer online to candidates seeking assistance with career or employment opportunities in the data processing/information technology/computer fields.

We turn then to the respective marks. Applicant stresses that the first word in its mark is "Career" - a word not found in the cited mark. This addition creates dissimilarities in the sound and appearance of the marks. However, we find that in this case, this difference cannot serve to distinguish the marks.

While we compare the marks in their entireties, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question 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 or portion of a mark. That is, one feature of a mark may have more significance than another. See Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987), and In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Moreover, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather, the decision must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG

v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

Hence, while we find some dissimilarities in sound and appearance between the two marks, we conclude these differences are legally insignificant.

By contrast, we find much more important the significant similarities in the connotations of MATRIX and CAREER MATRIX as applied to the recited services. According to all the evidence of record, MATRIX is a seemingly arbitrary mark for registrant's placement services. The term MATRIX is an English-language word having a number of different meanings, but a prevalent one evokes mathematical arrays.<sup>7</sup> If indeed this term is arbitrary as applied to registrant's services, it must be presumed to be an inherently strong mark. Then, applicant's mark (CAREER MATRIX) simply adds the "Career" designation to the front of registrant's mark. The added word ("Career") is merely descriptive for applicant's services and, as discussed above, should have been disclaimed.

Hence, we conclude that the term, "Matrix," plays a major role in forming the overall commercial impression of both

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<sup>7</sup> **Matrix:** a set of numbers arranged in rows and columns so as to form a rectangular array. The numbers are called the elements, or entries, of the matrix. Matrices have wide applications in engineering, physics, economics, and statistics as well as in various branches of mathematics. <http://www.britannica.com/eb/article?eu=52683&tocid=0&query=matrix&ct=> This online encyclopedia entry contains a link to a series of popular science fiction / action movies of recent years entitled "**Matrix**" starring Keanu Reeves.

marks, and that the commercial impressions created by the marks involved herein are substantially the same. See The Wella Corporation v. California Concept Corporation, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and Gruen Industries, Inc. v. Ray Curran & Co., 152 USPQ 778 (TTAB 1967).

Accordingly, we find that consumers and prospective customers, familiar with registrant's mark MATRIX for "placement of data processing professionals" would be likely to believe, upon encountering applicant's confusingly similar mark CAREER MATRIX for "employment agency, employment counseling and recruiting employment outplacement services, employee relocation and information regarding employees, employees and employment opportunities all of which may be accessed through a global computer network," that such closely related and overlapping services emanate from, or are otherwise sponsored by or affiliated with, the same source. Therefore, the refusal under Section 2(d) of the Act is also affirmed.

*Decision:* Both refusals to register are hereby affirmed.