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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re KB Consultants, Inc.

Serial No. 75/564,861

Bruce H. Little of Lindquist & Vennum P.L.L.P. for KB Consultants, Inc.

Michael Webster, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

Before Simms, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

KB Consultants, Inc. has filed an application to register the mark shown below (the term “systems” is disclaimed)

for goods and services identified, as amended, as “computer software for use in fund accounting applications used by governmental units, municipalities, public school districts and nonprofit organizations” in International Class 9; and “advertising and marketing services, namely, services

relating to computer software for use in fund accounting applications used by governmental units, municipalities, public school districts and nonprofit organizations" in International Class 35.[1]

The Examining Attorney has refused registration for both classes of goods and services under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of Registration No. 1,977,833[2] for the mark shown below

for "banking and financial services, namely, bail-bonding, financial clearing houses, credit bureaus, foreign money exchanging services, financial management, issuing of travellers' checks, lease-purchase financing, financing loans, mortgage banking, mutual funds, pawn-brokerage, safe deposit services, surety services; insurance underwriting services; stocks, bonds and securities brokerage house services" in International Class 36. The Examining

[1] Application Serial No. 75/564,861, filed October 5, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce. The acceptability of the recitation of services is an issue in this appeal and will be fully addressed later in this decision.

[2] Registration No. 1,977,833, issued June 4, 1996, to Kredietbank, N.V. The claimed date of first use and first use in commerce is September 1977.

Attorney also required a more definite identification of services for International Class 35.

When the requirement for a more definite identification of services and the refusal to register were made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Turning first to the question of the identification of services, the Examining Attorney did not accept the original identification of services "advertising and marketing," and suggested, if appropriate: "advertising and marketing services, namely, [indicate more clearly the type of services provided, e.g., providing television advertising for others, conducting marketing studies]." In response, applicant offered the following amendment to the identification of services: "advertising and marketing services, namely, services relating to computer software for use in fund accounting applications used by governmental units, municipalities, public school districts and nonprofit organizations." Applicant's proposed amendment to the identification of services has also been rejected by the Examining Attorney as indefinite; and the Examining Attorney suggested, if appropriate: "advertising and marketing services, namely, [indicate more clearly the

type of advertising and marketing services provided, e.g., promoting the software of others in the field of fund accounting] by means of [indicate how goods are promoted, e.g., dissemination of printed material, preparing and placing advertisements in an electronic magazine accessed through a global computer network].”

Both applicant and the Examining Attorney argued the issue of a proper identification of services based on the proposed amended identification of services. Thus, our decision relates to the question of the acceptability of applicant’s proposed amended identification.

Section 1(b)(2) of the Trademark Act, 15 U.S.C. §1051(b)(2), requires that the written application specify the goods or services on or in connection with which applicant intends to use the mark. Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth “the particular goods or services” with which the mark is or will be used. See also, Trademark Rule 2.33(b)(2). Further, the identification of goods or services must be specific and definite. See TMEP §§804.01 and 1301.05. It is within the discretion of the United States Patent and Trademark Office to require that the goods or services be specified with particularity. See In re Societe Generale des Eaux

Minerales de Vittel S.A., 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein, rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998).

The problem with applicant's proposed identification of services is that it does not identify applicant's advertising and marketing services with any specificity whatsoever (i.e., "advertising and marketing services, namely services..."). While it does indicate that the services are related to fund accounting and it sets forth the type of entities that may use fund accounting, the identification of services does not state what applicant's advertising and marketing services are. It is clearly insufficient to essentially state "services, namely services...."

Moreover, the activity of "advertising and marketing" by itself is generally unacceptable as constituting a "service" because it is far too broad an identification, and because these activities may refer to an applicant merely advertising and marketing its own goods, which is not a service. See TMEP §1301.01(a)(ii).

The Examining Attorney's requirement for a more definite identification of services is proper.

We turn now to the refusal to register on the ground of likelihood of confusion, which we consider in light of

the Court’s guidance in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Essentially, the Examining Attorney argues that the dominant portion of both marks is the identical letters “KB” as the word “systems” in applicant’s mark and the background circle design in the cited registrant’s mark are each less significant portions of the repsective marks; that the letters “KB” are arbitrary in the financial services industry; that applicant’s computer software and services, both specifically identified as relating to fund accounting, are similar to or within the scope of registrant’s “financial management” services; and that although applicant’s identifications of goods and services are limited as to types of purchasers, there is no limitation in registrant’s services, thus encompassing all normal channels of trade to all usual purchasers for registrant’s services.

Applicant, on the other hand, argues that when considered in their entireties, the marks are different and distinct in appearance as applicant’s mark includes the word “systems” with the letters “KB,” while registrant’s mark is the letters “KB” appearing in a black circle design; that the marks are different in connotation because applicant’s mark KB SYSTEMS brings to mind applicant’s

computer software systems and registrant's mark "KB" merely consists of the initials of registrant; that applicant's goods and services relate solely to computer software used for fund accounting (a specific type of accounting) and are used by governmental units, municipalities, public school systems and nonprofit organizations, whereas registrant is a bank which provides banking services to its customers; and that the goods and services of applicant are not marketed in such a way as to be encountered by the same persons seeking registrant's services.

Turning first to a consideration of the marks, we find there is a strong similarity between the involved marks. As to appearance, while there are clearly differences in these respective marks (registrant's includes a background circle design and applicant's includes the word "systems"), it is not improper to give more weight to a dominant feature of a mark. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). The letters "KB" are the dominant portion of both marks. It is these letters which would be utilized in calling for the goods and services, and the letters would most likely be impressed in the purchaser's

memory and serve as the indication of origin. See Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977). That is, the differences are not likely to be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988); and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).

The dominant portion of applicant's mark "KB" is identical in sound to the spoken portion of the cited registrant's mark. Moreover, there is no evidence that the combination of the letters "KB" have any special meaning, aside from trademark significance, to purchasers of the involved goods and services. "KB" is unpronounceable except as the separate letters, and would be more difficult to remember, and thus, more susceptible of confusion, or mistake. Applicant's addition of the descriptive term

"systems" simply does not serve to distinguish its mark from registrant's mark. See Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (confusion found likely in contemporaneous use of TMM and TMS on computer software).

The marks, KB SYSTEMS and KB and design, are very similar in sound, somewhat similar in appearance, and create similar commercial impressions.

With respect to the goods and services, we must consider the services in the cited registration vis-a-vis both applicant's goods and services. Regarding applicant's goods, "computer software for use in fund accounting applications used by governmental units, municipalities, public school districts and nonprofit organizations," the Examining Attorney has not established a prima facie showing of the relatedness of these computer software goods to the cited registrant's various "banking and financial services" and specifically its "financial management" services. The Examining Attorney made of record five third-party registrations, all based on use in commerce, which indicate that entities have registered a single mark for both accounting services and financial consulting services, but only one of these five third-party registrations also includes computer programs in the field

of accounting, auditing, and tax and management consulting. The Examining Attorney's argument that "applicant's 'fund accounting' software and services may be provided by banks or other financial institutions" (final Office action, p. 3) is simply not supported in the record with regard to applicant's computer software.

Regarding the relatedness of registrant's "financial management" services and applicant's quite indefinite "advertising and marketing services, namely, services relating to computer software for use in fund accounting applications used by governmental units, municipalities, public school districts and nonprofit organizations," we find that the record sufficiently establishes the relatedness between these services. Specifically, registrant's financial management services, as identified, would encompass the broad (and indefinite) services set forth by applicant which "relate to" fund accounting. Of course, services need not be identical or even competitive to support a finding of likelihood of confusion; it is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the

same source. See In re Peebles Inc., 23 USPQ2d 1795 (TTAB 1992); and Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590 (TTAB 1978).

Further, the Board must determine the issue of likelihood of confusion on the basis of the goods and services as identified in the application and the registration. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

In this case, applicant's goods and services are both limited by identifying the customers as "governmental units, municipalities, public school districts and nonprofit organizations." In the context of applicant's services this limitation is of little assistance to applicant in view of the otherwise related and/or overlapping nature of the identified services, and the indefiniteness of applicant's identified services.

However, with respect to the trade channels and purchasers of applicant's goods vis-a-vis registrant's services, not only are applicant's goods limited within applicant's identification of goods, but also the record includes the declaration of Kevin Brown, applicant's president, averring that applicant provides no banking or

financial services, but rather applicant sells computer software tailored to a specific type of accounting and a specific market for that software. We cannot find on this ex parte record that applicant's goods and registrant's services are sold through the same or similar channels of trade to the same or similar classes of purchasers.

Considering all of the relevant du Pont factors, we conclude that consumers familiar with registrant's financial management services sold under the mark KB and design would be likely to believe, upon encountering applicant's mark, KB SYSTEMS, for advertising and marketing services relating to fund accounting, that both originated with or were somehow associated with or sponsored by the same entity. However, this ex parte record does not establish the same conclusion with regard to applicant's goods.

Decision: The requirement for a more definite identification of services in International Class 35 is affirmed; the refusal to register under Section 2(d) is affirmed as to applicant's International Class 35 services; and the refusal to register under Section 2(d) is reversed as to applicant's International Class 9 goods. (In due course, the application file will be forwarded to the Examining Attorney for appropriate action in approving the

application for publication on the International Class 9 goods.)