

Hearing:
October 15, 2003

**THIS DISPOSITION IS NOT
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OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Workknowledge LLC

Serial Nos. 75901582 and 75901583

Jay H. Begler and Janel M. Calliham of Buchanan Ingersoll
PC for Workknowledge LLC.

Curtis W. French, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Workknowledge LLC seeks registration on the Principal
Register of the marks WORKKNOWLEDGE and WORKKNOWLEDGE.COM,
each for services recited as follows:

"Business management consultation services,
namely, the collection and analysis of data
based upon employees['] interaction with
knowledge materials¹ delivered to them and

¹ During examination, the Trademark Examining Attorney suggested adoption of the term "training materials" rather than "knowledge materials." In its brief, applicant contends it had earlier filed an amendment complying with the requirements of the Trademark Examining Attorney, but retained the term "knowledge materials." In his brief, the Trademark Examining Attorney notes that such an amendment was never made part of the application file, but that he accepted applicant's recitation of services as written out in applicant's appeal brief. Hence, the Office's records will be amended to reflect this minor change in language.

the presentation of such data and conclusions based thereon to employers, employees and third parties," in International Class 35;

and

"Educational services, namely, conducting business management seminars in the fields of law, medicine, economics, finance, business services, telecommunications, manufacturing, real-estate, retail and wholesale sales, government, non-profit organizations, marketing, advertising, data management, utilization and/or manipulation of software and hardware, technology and high technology," in International Class 41.²

These cases are before the Board on appeal from the final refusal to register the marks in each application based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Specifically, the Trademark Examining Attorney has contended that applicant's marks, if used in connection with the recited services, would so resemble the mark WORKING KNOWLEDGE registered for services identified as "business consultation and business research in the fields of management and management training, development of training materials, course curricula and materials, and thinking and writing skills," in International Class 35,³ as

² Application Serial Nos. 75901582 and 75901583 were filed on January 27, 2000 based upon applicant's allegations of a *bona fide* intention to use these marks in commerce.

³ Reg. No. 1826569 issued on March 15, 1994; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney fully briefed each appeal. The marks, the legal issues, the procedural histories and overall records are closely related in these two appeals. Accordingly, these cases were consolidated for a single oral hearing before this panel of the Board, and we have chosen to issue a single opinion for these two applications to register, affirming both refusals to register.

Applicant argues that its marks are distinctly different from the cited mark; that given applicant's "survey services" in International Class 35, and in light of its emphasis on "knowledge management" in International Class 41, both services are quite different from registrant's enumerated services; and, finally, that applicant's consumers are "a highly sophisticated and educated audience." (Applicant's reply brief, p. 2)

In turn, the Trademark Examining Attorney contends that applicant's marks are highly similar to registrant's mark as to appearance, sound and meaning, and that the services are closely related.

Our determination under Section 2(d) is based upon an analysis of all of the 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 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the du Pont factor focusing on the relationship of the services as described in the applications and in the cited registration.

We note that the overarching term for applicant's services in International Class 35 is "Business management consultation services." Applicant, however, focuses on the limiting wording that follows, i.e., the "collection and analysis of data," and highlights applicant's focus on "knowledge workers," in an attempt to differentiate its services from those of the cited registrant. However, the involved services are still business management consultation services and registrant also renders business consultation services. Moreover, we find applicant's "collection and analysis of data" to be encompassed within registrant's "research" (a broader term), so that when these specific services are both rendered as business consultation services, there is overlap.

As to the nature of applicant's services in International Class 41, applicant argues that applicant is not providing just any form of "business management seminars" but is involved in consulting with companies heavy with "knowledge workers":

At the core of the second set of services is Knowledge Management. While there are varying definitions of Knowledge Management, we believe the following explanation is acceptable:

Knowledge assets are the knowledge regarding markets, products, technologies and organizations, that a business owns or needs to own and which enable its business processes to generate profits, add value, etc.

Knowledge management is not only about managing these knowledge assets but managing the processes that act upon the assets. These processes include: developing knowledge; preserving knowledge; using knowledge, and sharing knowledge.

Therefore, Knowledge management involves the identification and analysis of available and required knowledge assets and knowledge asset related processes, and the subsequent planning and control of actions to develop both the assets and the processes so as to fulfil (sic) organizational objectives.⁴

Applicant's complete recitation of services in International Class 41 makes it clear that its management seminars are focused on knowledge-intensive businesses that place a premium on information and technology and whose employees are concentrated in knowledge-based occupations.

⁴ Applicant's appeal brief, unnumbered page 4. The quoted material appears in applicant's brief without citation.

In essence, applicant argues that its emphasis on "knowledge management" services affects the overall thrust of its management seminars. However, our focus cannot be on particular philosophies employed by various business consultants and/or those providing management seminars when making likelihood of confusion determinations under the Lanham Act (e.g., as to the nature of the services provided, the channels of trade through which they are offered or the details of the audiences targeted). Rather, our determination must be made based upon the recitations of services contained in the involved applications or registrations.

Accordingly, with regard to applicant's International Class 41 services, we note that these include "conducting business management seminars," and registrant's services include the "development of training materials." Hence, we find registrant's services and applicant's International Class 41 services to be related.

At the oral hearing, applicant's counsel retreated somewhat from the argument that the focus of applicant's services on "Knowledge management" provides fundamental support for finding there is a difference in the involved services, and even conceded that there may well be some "overlap" in the recited services. Certainly, these

recitations of services are not limited in any way as to the size of businesses targeted by applicant or by registrant. As a result, we must presume that the population of prospective customers ranges from small, start-up companies all the way to the largest of the Fortune 100 firms; that in offering these services, both applicant and registrant rely upon "research" (or the "collection of data"); and that the enumerated training (or seminars) could be offered online and/or in a bricks-and-mortar location. Accordingly, taking the plain meanings of the words in these recitations, and in the absence of any limitation as to channels of trade or classes of prospective customers, we agree with the Trademark Examining Attorney that there is overlap in some of the involved services, and that others are closely related.

We turn then to the similarity or dissimilarity of the marks in their entirety as to look, sound and connotation.

As for appearance, applicant correctly points out that WORKKNOWLEDGE is a single word while WORKING KNOWLEDGE is two words. In turn, the Trademark Examining Attorney notes that both are combinations of some form of the words WORK and KNOWLEDGE, and appear in the same order.

As noted by the Trademark Examining Attorney, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks create the same overall commercial impression. Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980). We must take into consideration the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. Chemtron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979). Using this standard, we find that WORKKNOWLEDGE and WORKING KNOWLEDGE are similar enough in appearance to support a finding of likelihood of confusion when used in connection with the same and/or closely related services.

As to sound, applicant argues that the mark in the cited registration, WORKING KNOWLEDGE, has a distinctive "ing" sound that is clearly absent in applicant's marks, WORKKNOWLEDGE and WORKKNOWLEDGE.COM. In turn, the Trademark Examining Attorney contends that when registrant's mark and applicant's marks are considered in their entireties, there exists only a slight difference in sound. See In re Energy Telecommunications & Electrical Association, 222 USPQ 350 (TTAB 1983) [marks were INTELLECT v. ENTELEC]. Again, we agree with the Trademark Examining Attorney.

Given its placement, the "ing" syllable is arguably the least distinctive portion of registrant's mark linguistically, and the absence of this internal syllable in applicant's marks may not be easily discernible to customers familiar with registrant's mark.

Finally, as to connotation, applicant argues that WORKING KNOWLEDGE suggests a high level of competence in a particular field while WORKKNOWLEDGE suggests the assimilation of knowledge related to one's work. By contrast, the Trademark Examining Attorney contends that both terms conjure up the meaning of the basic knowledge to make something work.

Contrary to applicant's interpretation of the likely connotation of registrant's mark, we find that the term "working knowledge" suggests something less than a high level of competence.⁵ In any case, registrant's mark and both of applicant's marks connote a body of information or familiarity with facts gained through past experience.

On any of the trilogy of comparing the marks (sight, sound and meaning), the ".COM" portion of applicant's WORKKNOWLEDGE.COM mark represents applicant's top level

⁵ **Working:** ... 15. Adequate for usual or customary needs; a *working knowledge of Spanish* ... The Random House Dictionary of the English Language, Second Edition Unabridged (1987).

domain (TLD) name. The addition of this TLD in one of applicant's marks does not alter its overall commercial impression, as it has no source-indicating function. See In re Martin Container Inc., 65 USPQ2d 1058 (TTAB 2002) (the Board held the term CONTAINER.COM incapable of distinguishing applicant's services and hence unregistrable on the Supplemental Register); and In re Eilberg, 49 USPQ2d 1955 (TTAB 1998) (the Board held the term WWW.EILBERG.COM incapable of distinguishing applicant's services and hence unregistrable on the Supplemental Register).

Hence, we agree with the Trademark Examining Attorney that when these marks are considered in their entireties, the commercial impressions of applicant's marks, WORKKNOWLEDGE and WORKKNOWLEDGE.COM, are highly similar to that of the registered mark, WORKING KNOWLEDGE.

We turn next to the du Pont factor focusing on the conditions under which and buyers to whom sales are made. Applicant urges us to find that decisions about seeking out vendors of consulting services are made by high-level, sophisticated business people making careful purchasing decisions, and that both the procurement and implementation of the services involves detailed interaction between the vendor and customer that would eliminate any doubt as to the exact source of the services.

Based on the record before us, we must consider these respective services to be available at a wide range of prices to many different-sized organizations, including small, start-up companies. These latter companies may well not be sophisticated. Moreover, knowledge and sophistication with respect to particular services does not necessarily translate into the ability to avoid being confused by the use of similar marks in connection with closely related services. Accordingly, even careful consumers may be confused as to source or sponsorship of the involved services when marketed to the same class of purchasers under similar marks. See Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999); and In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We note that there is nothing in the record to suggest that the cited mark is weak in any way. Hence, we presume it to be an inherently distinctive mark as applied to the recited services. Even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods.⁶

⁶ We specifically note that the cited registered mark is on the Principal Register and it is, of course, entitled to the statutory presumptions under Section 7(b) of the Lanham Act.

In conclusion, we find that these marks are quite similar as to overall commercial impression and that the services are the same or closely related. Although it works in applicant's favor that many of the purchasers of these services will tend to be fairly sophisticated business managers, this factor alone is not sufficient to counter the fact that the two major considerations (the similarities between the marks and the relationship between the services) support a finding of a likelihood of confusion.

Finally, while we have no doubt about the likelihood of confusion in this case, we note that if there were any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and *In re Hyper Shoppes (Ohio), Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusals to register under Section 2(d) of the Trademark Act are hereby affirmed.