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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Junior Achievement, Inc.

Serial No. 76264819

Jesus M. Vazquez of Rothgerber Johnson & Lyons LLP for
Junior Achievement, Inc.¹

Shari Sheffield, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pederson, Managing Attorney).

Before Seeherman, Hohein, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 1, 2001, applicant (Junior Achievement, Inc.)
applied to register the mark NATIONAL BUSINESS HALL OF
FAME, in typed form, on the Principal Register for services
in International Class 41 ultimately identified as:

Promoting excellence in young people through the
issuance and presentation of an annual award in the
field of business to selected individuals who have
distinguished themselves as leaders within the private
enterprise system and whose efforts have contributed
to the advancement and prosperity of the nation.

¹ Applicant's brief was submitted by Dana Hartje Cardwell of
Sheridan Ross P.C.

The application was based on an allegation of a date of first use and a date of first use in commerce of October 1974.²

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a prior registration for the following mark:



for services identified as "educational services namely, recognizing and celebrating leaders in American business" in International Class 41.³ The registration contains a disclaimer of the words "American National Business Hall of Fame."

The examining attorney also initially refused registration on the ground that applicant's mark is merely descriptive, but applicant submitted a claim of acquired distinctiveness under Section 2(f), which the examining

² Serial No. 76264819.

³ Registration No. 1,359,752 issued September 10, 1985. The registration alleges a date of first use of January 10, 1975, and a date of first use in commerce of February 28, 1975. An affidavit under Section 8 has been accepted.

attorney accepted. Office Action dated January 2, 2003 at 1. Therefore, only the issue of likelihood of confusion remained.

After the examining attorney made that refusal to register final, applicant appealed.

We analyze the question of whether there is a likelihood of confusion by applying the factors set forth in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we address whether the services of applicant and registrant are related. Applicant's services involve "the issuance and presentation of an annual award in the field of business to selected individuals who have distinguished themselves as leaders within the private enterprise system." Registrant's services involve

"recognizing and celebrating leaders in American business."
Both services recognize American business leaders. The examining attorney has pointed out (Brief at 4) that both applicant and registrant have honored many of the same business leaders. We agree with the examining attorney that the "services are very similar and found within the same channels of trade."

Next, we consider whether applicant's and registrant's marks, when compared in their entirety, are similar in sound, appearance, meaning, and commercial impression. Here, there are both similarities and differences between the marks. Applicant's mark is NATIONAL BUSINESS HALL OF FAME, while registrant's mark is:



Obviously, the marks are similar to the extent that they both contain the words "National Business Hall of Fame." However, registrant adds, in much bigger type, the letters ANBHF superimposed on the map of the United States and the word "American" before "National Business Hall of Fame." Registrant has also disclaimed the words "American National

Business Hall of Fame" and the design of the outline of the United States. We have held that disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). The Federal Circuit has "noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Applicant has submitted copies of numerous registrations showing the widespread registration of the terms "national" and "hall of fame." We consider these registrations as evidence that the terms "national" and "hall of fame" are highly descriptive terms that would not be the dominant part of registrant's mark. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). See, e.g., Registration Nos. 2,569,535 (U.S. NATIONAL SKI HALL OF FAME & MUSEUM); 2,600,329 (OFFICIAL NATIONAL THOROUGHBRED RACING HALL OF FAME); 2,380,148 (THE NATIONAL EDUCATORS' HALL OF FAME); 2,284,264 (NATIONAL OPTOMETRY HALL OF FAME); 2,170,606 (NATIONAL COWGIRL MUSEUM AND HALL OF FAME); 2,150,292 (NATIONAL AVIATION HALL OF FAME);

2,206,285 (NATIONAL ITALIAN AMERICAN SPORTS HALL OF FAME);
and 1,903,995 (NATIONAL BOWHUNTERS HALL OF FAME).

The mere fact that marks overlap in part does not mean that there is a likelihood of confusion. See In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design and K+EFF (stylized) for potassium supplements were not confusingly similar); Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 USPQ2d 1477, 1478 (TTAB 1987) (STEVE'S for different types of restaurants held to not be confusingly similar). Thus, the fact that applicant's mark contains descriptive words found in registrant's mark is not, in and of itself, a sufficient reason for finding the marks to be similar. Registrant has disclaimed the words "National Business Hall of Fame," thereby acknowledging that it does not have the exclusive right to use these words.

In this case, there are some significant differences in the marks, including the presence of non-descriptive matter (the letters ANBHF) in larger type, the outline of the United States, and the word "American" before the phrase "National Business Hall of Fame." Therefore, there are differences in their appearance. To the extent that the marks contain the same words, "National Business Hall of Fame," they are similar in pronunciation. Regarding the

registered mark's meaning and commercial impression, the words "American National Business Hall of Fame" would be perceived, in the context of the mark, as mere informational material that is subordinate to the design and abbreviation ANBHF. In addition, the word "American" and the outline of the United States of America emphasize the "American" portion of the mark. Applicant's mark, lacking the design and letters, does not have the same connotation or commercial impression.

Therefore, we find that, when we consider the marks as a whole, the registered mark contains several important, additional features that minimize the similarities between the marks.

Another factor we take into consideration is the course of conduct of applicant and the registrant before the Office.

Here, the course of conduct manifested by applicant and the cited registrant, as reflected in the state of the register over a period of more than 50 years, plainly indicates that such parties, who are in the best position to know the realities of the marketplace for their respective products and are the ones most likely to be harmed if confusion occurs, have repeatedly shown, by their behavior toward the acquisition and maintenance of their registrations, their belief that contemporaneous use of marks which consist of or contain the surname "SCHIAPARELLI" is not likely to cause confusion.

In re Parfums Schiaparelli Inc., 37 USPQ2d 1864, 1872 (TTAB 1995); overruled in part on other grounds, In re Sambado & Sons, Inc., 45 USPQ2d 1312, 1314-15 (TTAB 1997).

In this case, we are not faced with a record that is as extensive as the Schiaparelli case, but nonetheless the record herein provides some evidence of a course of conduct that argues against a likelihood of confusion. Applicant previously owned Registration Nos. 1,114,682 and 1,567,682, both for the NATIONAL BUSINESS HALL OF FAME.⁴ Applicant's first registration for the mark NATIONAL BUSINESS HALL OF FAME issued on March 26, 1979. On July 30, 1984, while that registration was still in force, registrant filed an application for what eventually issued on September 10, 1985, as the cited registration.⁵ Subsequently, applicant

⁴ Copies of these registrations could not be located in the file. However, applicant referred to one of its registrations in its response to the first Office Action. Subsequently, in its amendment and response dated September 10, 2002, in its request for reconsideration, and in its appeal brief, applicant referred to both registrations as support for its argument that there was no likelihood of confusion. The examining attorney has not objected to these references nor did the examining attorney ever advise applicant that if it wanted to have these registrations considered, it would have to submit copies of them. Furthermore, after the examining attorney refused to accept applicant's claim of acquired distinctiveness based on long use, applicant argued that applicant's prior registrations were strong evidence that applicant's mark had acquired distinctiveness. The examining attorney then accepted applicant's claim of acquired distinctiveness. Therefore, even if these registrations may not have been formally entered into the record, we deem the registrations to be of record.

⁵ USPTO records indicate that applicant's registered mark was not identified as "cancelled" until September 12, 1985.

applied for the same mark on April 30, 1987, and it registered on November 21, 1989, despite the presence of the cited registration on the register. Applicant's second registration indicated that the mark issued under the provisions of Section 2(f), as having acquired distinctiveness. This registration was not renewed and it expired in 1999. In short, applicant received a registration for its NATIONAL HALL OF FAME mark first. The application that became the cited registration was filed and examined while applicant's registration was active. Applicant then applied for, and received, a second registration for the same mark. This registration issued despite the presence of the cited mark on the Principal Register. Therefore, applicant's and registrant's marks have each, at various times, been pending while the other party's registration was on the register. In neither case did one registration prevent the registration of the other party's mark.

Coupled with this course of conduct, we also note that the examining attorney has submitted evidence that both registrant and applicant have honored many of the same individuals, which both refer to as laureates. See, e.g. Mark Kay Ash, William M. Batten, Stephen Bechtel Sr., Charles Becker, Oliver Ann Beech, William Blackie, Edward

E. Carlson, Frederick C. Crawford, Arthur V. Davis, John Deere, and Max DePree. The fact that applicant's and registrant's mark were co-existing on the register at the same time that both applicant and registrant were honoring many of the same individuals is at least an indication that confusion in this case is not likely. It even suggests that applicant and registrant were aware of each other's mark.

When we consider all the evidence of record, we simply are not persuaded that confusion is likely. While we do not give a great deal of weight to factors such as the course of conduct and the overlap of laureates, even giving them some weight, combined with the descriptive nature of the words National Business Hall of Fame as used in registrant's mark, is enough to convince us that confusion is not likely. Here, "the potential for confusion appears a mere possibility not a probability." Electronic Data & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1393 (Fed. Cir. 1992).

Decision: The refusal to register applicant's mark for the identified services under Section 2(d) is reversed.