THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 9/28/2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BBK, Ltd.

Serial No. 76315835

Kathleen G. Mellon of Young & Basile, P.C. for BBK, Ltd.

Karanendra S. Chhina, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

Before Hanak, Chapman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 21, 2001, BBK, Ltd. (a Michigan corporation) filed an application to register on the Principal Register the mark BBK for services amended to read “turnaround management consulting services, namely, corporate renewal, operations improvement, interim management, organizational and financial restructuring, litigation support services, and product and supplier analysis, all for troubled companies” in International

Class 35. The application is based on applicant's claimed dates of first use and first use in commerce of May 13, 1988 and September 14, 1989, respectively.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its services, so resembles the mark BB&K, registered for "financial and investment advisory services" in International Class 36,[1] as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination of likelihood of confusion is based on 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). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities of

[1] Registration No. 1304118 issued November 6, 1984 to Bailard, Biehl & Kaiser, Inc.; Section 8 affidavit accepted; Section 15 affidavit acknowledged. The claimed date of first use and first use in commerce is October 1978.

the marks and the similarities of the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Based on the record before us, we find that confusion is likely.

The Examining Attorney argues that the marks are virtually identical in sound, appearance, connotation and commercial impression, both consisting of the letters "BBK"; and that applicant's and registrant's services are related in that entities providing financial and investment advice often also provide business management services, including turnaround business management services. He specifically contends that the absence of the ampersand symbol from applicant's mark does not serve to distinguish the marks; that while the services are not the same, the question is not whether purchasers are confused about the services, but rather the source of the services; that applicant's identification of services includes "financial restructuring" and its specimen brochure refers to several of applicant's "Capabilities" including "Financial management" and "Corporate finance … advice on Corporate Finance, Investment Banking, Refinancing,…"; that registrant's identification of services is not limited as

to channels of trade or classes of purchasers; that actual marketplace realities about trade channels and classes of customers are not particularly relevant in an ex parte case involving registrability; that even if the purchasers of applicant's services are sophisticated, they are not immune from trademark confusion, and in any event, there is no evidence that the purchasers of registrant's services are sophisticated; that inasmuch as turnaround business management consulting services involve offering financial advice as an entity rebounds, applicant's services are within the registrant's normal fields of expansion; and that doubt is resolved in registrant's favor.

The Examining Attorney submitted printouts of several third-party registrations to show that the services of registrant and applicant frequently emanate from a common source under a single mark.

Applicant acknowledges that the marks are similar (see, e.g., brief p. 2, reply brief p. 1), but argues the obvious, i.e., that the marks are not identical due to the ampersand in the registrant's mark. Applicant contends that "because the services are different, in the reality of the marketplace, these marks will never be confused or associated" (request for reconsideration, p. 2). Specifically, applicant argues that it offers

"consultation/management assistance to companies that are in serious financial/operational trouble" (brief, p. 3), and it does not offer investment advice and does not facilitate the manner or means of investing money; that it offers "a very specialized and unique service assisting struggling, troubled companies to turn around their operations, enabling these companies to survive" (brief, p. 12); that it "may be true that there are some (very few) entities which offer both business and financial consultation" (brief, p. 4), but the cited registration is only for financial consultation; that applicant's attorney stated she contacted the cited registrant and "was informed [registrant] has no corporate clients but does individual/group/small business financial planning/investments" (brief, p. 4); that the purchasers of applicant's services are "major OEMs, appliance manufacturers, health institutions, home care industries, holding companies and other major businesses" and applicant "is often hired by banks to assist failing business clients" and by bankruptcy judges to assist a party in bankruptcy (brief, p. 5); that the purchasers of applicant's services are knowledgeable and sophisticated, and they would discover the actual identity of the source of the services prior to purchasing; and that registrant's

financial and investment advisory services are offered through different trade channels to different purchasers. Turning first to a consideration of the marks, the marks "BBK" and "BB&K" obviously consist of the identical letters, "BBK." These marks are unpronounceable except as the separate letters, and would be more difficult to remember, and thus, more susceptible of confusion or mistake. Courts and this Board have often held that consumers have more difficulty recalling differences in what appear to be arbitrary letter strings. See, e.g., Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990); Dere v. Institute for Scientific Information, Inc., 420 F.2d 1068, 164 USPQ 347, 348 (CCPA 1970); and Alberto-Culver Co. v. F.D.C. Wholesale Corp., 16 USPQ2d 1597, 1602 (TTAB 1990), (overruled in part -- on a different issue -- by Eurostar v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994)). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:33 (4th ed. 2001).

Although registrant's mark BB&K might be recognized by purchasers as the initials of the principal names in registrant's trade name, the derivations of the marks are of no particular significance. See Aerojet-General Corp. v. Computer Learning & Sys. Corp., 170 USPQ 358, 362 (TTAB

1971) (fact that letter marks are acronyms derived from different words unimportant because average purchaser probably unaware of derivation).

In any event, the proper test 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 purchasers, who normally retain a general rather than specific impression of the many trademarks encountered; that is, a 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); and Spoons Restaurants Inc. v. Morrision, Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

We find that the marks BBK and BB&K are virtually identical in sound, appearance, connotation and overall commercial impression. See Weiss Associates, Inc. v. HRL Associates, Inc., supra, (confusion found likely in contemporaneous use of TMM and TMS on computer software).

Insofar as the services are concerned, it is not necessary that goods and/or services be identical or even competitive in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be

likely to be encountered by the same persons in situations that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods and/or services originate from or are in some way associated with the same source. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, the registered mark is for “financial and investment advisory services,” while applicant offers the service of “turnaround management consulting services, namely, corporate renewal, operations improvement, interim management, organizational and financial restructuring,

litigation support services, and product and supplier analysis, all for troubled companies."[2]

The Examining Attorney has submitted printouts of numerous third-party registrations, all based on use in commerce, indicating the same entities offer financial and investment services as well as business consultation services (a few specifically business turnaround services) under the same mark. See, for example, Registration No. 2630153 for "business management consulting services, namely, providing advice and assistance to businesses in … turnaround management, …" and "financial services, namely, … making acquisitions and investments"; Registration No. 1774410 for "… business management planning, assistance and supervision; … business crisis consultation services" and "investment consultation; … financial analysis and consultation services; … business turnaround consultation services";[3] Registration No. 2287126 for "financial planning and investment consultation" and "business planning and business management planning"; Registration No. 2434489 for "financial consulting services" and "business management

[2] The fact that the services are classified in different international classes is irrelevant. See Section 30 of the Trademark Act, 15 U.S.C. §1112; and Jean Patou Inc. v. Theon Inc., 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993).
[3] The entity listed as the owner of this registration is also the listed owner of four of the other third-party registrations, all for the same services.

consulting"; Registration No. 2318215 for "financial analysis and consultation; …" and "business planning; business management planning and consultation; …"; Registration No. 2384321 for "financial management and consulting, financial planning and consulting, and investment advisory services" and "business management, consultation and planning …"; and Registration No. 2441878 for "financial services, namely investment consulting services and financial analysis, consultation and planning" and "business management consulting services and business consulting services."

When considering the third-party registrations submitted by the Examining Attorney, we remain mindful that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such services are of a type which emanate from the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, footnote 6 (TTAB 1988).

We acknowledge that several of the third-party registrations are for broader business management consulting services, not specifically for turnaround

management consulting services. However, the third-party registrations covering the broader business management and consulting services would conceivably and reasonably encompass turnaround management consulting services. Thus, these third-party registrations submitted are persuasive evidence of the relatedness of the respective services.[4]

Purchasers aware of registrant's financial investment and advisory services, who encounter applicant's turnaround consultation services for troubled companies, offered under these highly similar marks, are likely to believe that applicant's services are in some way affiliated with registrant, possibly even that registrant's financial services are a spinoff of applicant's larger category of turnaround business management consultation services.

When the respective services are compared in light of the legal principles cited above and the evidence of record

[4] As the Examining Attorney correctly pointed out, applicant's original identification of services was "business management consultation services, namely, corporate renewal, operations improvement, interim management, restructuring, operations management, financial management, corporate finance, accounts receivable and credit services, market analysis and research, risk assessment, litigation support, public policy and economic analysis; crisis turnaround management and consultation" and its amended identification of services (voluntarily offered by applicant after the Examining Attorney issued his final refusal) was acceptable because it was a narrower identification. That is to say, "turnaround management consulting services" "for troubled companies" is a specific service which is encompassed within the broad spectrum of business management consulting services.

(particularly the third-party registrations, and applicant's specimens -- quoted earlier herein), we find that applicant's turnaround management consulting services and registrant's financial investment and advisory services are related.[5]

Applicant's contentions regarding its contact with registrant and the realities of the marketplace with regard to the assertedly different channels of trade and different purchasers is not supported by evidence, and in any event, as explained previously, the Board must consider the services as set forth in the application and the registration. While we acknowledge that "turnaround management consulting services … for troubled companies" is clearly a specific service limited to those troubled companies seeking such crisis business assistance, the registrant's identification of services is not limited as to trade channels or customers. Thus, we must assume that its financial and investment advisory services are offered to all normal classes of customers including customers who may one day seek applicant's services. Even noting the

[5] To be clear, we find that the evidence demonstrates that registrant's and applicant's services, as identified respectively, are related such that there is a likelihood of confusion resulting from the contemporaneous use of registrant's BB&K mark and applicant's BBK mark. In other words, we have not relied upon the "expansion of trade doctrine" in finding that there exists a likelihood of confusion.

limitations in applicant's identification of goods (turnaround management for troubled companies), nonetheless, the channels of trade and the classes of purchasers could be at least overlapping. In fact, applicant has stated that the purchasers of its services include banks, and banks may also have dealings with financial and investment advisory companies, for example, one such as registrant.

We find that the respective services, as identified, could be offered through the same or at least overlapping channels of trade, to the same or at least overlapping classes of purchasers.

It is true that these types of services (both registrant's financial and investment and applicant's business consultation) would not be impulse purchase decisions, but rather, would be made through careful consideration.

Applicant argues that the purchasers of its involved services are sophisticated purchasers. The Examining Attorney correctly argues that even sophisticated purchasers are not immune from source confusion; and that there is no evidence of record as to the sophistication of potential purchasers of registrant's services. In fact, we agree with the Examining Attorney's argument that "at a

minimum, even if the applicant's consumers may not be likely confused, one cannot assume the same about the registrant's consumers (i.e., due to 'reverse' source confusion)." (Brief, p. 11.)

Assuming the sophistication of the purchasers of applicant's services, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also, Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Decombe, 9 USPQ2d 1812 (TTAB 1988); and In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"]. That is, even relatively sophisticated purchasers of these services are likely to believe that the respective services emanate from or are affiliated with the same source, if offered under the virtually identical marks. See Weiss Associates Inc. v. HRL Associates Inc., supra; and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Based on the virtual identity of the marks; the relatedness of the identified services; the same or overlapping trade channels; and the same or overlapping purchasers, we find that the purchasers would likely be confused as to the source of applicant's services vis-a-vis registrant's services, when offered under their respective marks.

To the extent we have doubt on the question of likelihood of confusion in this case, we resolve that doubt, as we must, against applicant as the newcomer, as it has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.