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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Career Partners International, LLC**

Serial No. 76379105

Corby R. Vowell of Goldstein & Faucett, L.L.P.

Jeffrey S. DeFord, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before **Hanak, Hohein and Hairston**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Career Partners International, LLC has filed an
application to register on the Principal Register the mark
"CAREER PARTNERS INTERNATIONAL" and design, as reproduced below,



for "career counseling services."¹

¹ Ser. No. 76379105, filed on March 6, 2002, which is based on an allegation of a date of first use anywhere and in commerce of March 15, 2001. Although not apparent from the amended drawing of the mark reproduced above, in actual use the words "career" and "partners" appear on the specimens originally submitted in different shades, thereby giving the commercial impression of two separate words. The

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the mark "CAREER PARTNERS," which is registered for the services of "employment counseling and recruiting; [and] employment agencies providing temporary staffing/personnel for others,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion

words "CAREER" and "INTERNATIONAL" are disclaimed. In addition, ownership is claimed with respect to Reg. No. 2,411,523, which issued on the Supplemental Register on December 5, 2000 for the mark "CAREER PARTNERS INTERNATIONAL," with a disclaimer of the words "CAREER" and "INTERNATIONAL," for "business management consultation in the field of career management services, namely, providing strategic human resource management services, career management services, executive search and personal recruitment services, human resources advisory services and compensation services" in International Class 35, "educational services, namely, workshops, seminars and conferences in career management" in International Class 41 and "career counseling services, namely, providing career transition services" in International Class 42; for each of such classes, a date of first use anywhere of March 18, 1994 and a date of first use in commerce of April 26, 1994 are alleged.

² Reg. No. 2,035,031, issued on the Principal Register on February 4, 1997, which sets forth a date of first use anywhere and in commerce of May 3, 1995; combined affidavit §§8 and 15. The word "CAREER" is disclaimed.

analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.³

Turning first to the similarity or dissimilarity in the services at issue, applicant concedes in its brief that "the description of the ... services of the respective parties are somewhat similar," but maintains that "[i]t is important to note that the prior registration relied on by the Examining Attorney is for [services] in international class 035," while it "has restricted this application to [services] in international class 042." Applicant thus contends that "the potential for confusion here is significantly less than if ... Applicant were seeking registration for the same class of goods or services."

However, as the Examining Attorney correctly observes in his brief, it is well settled that the issue of likelihood of confusion must be determined on the basis of the respective services as identified in the involved application and the cited registration. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937,

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Moreover, as the Examining Attorney correctly points out, it is well established that the services at issue 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 respective 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 producer or provider. See, e.g., 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).

In view thereof, the Examining Attorney asserts in his brief that:

The services of the parties in the instant case are identical or are at the very least highly related. The registrant's services are wholly encompassed by the applicant's services. Furthermore, the services are marketed and sold in the same channels of trade and are likely to be sought, encountered and purchased by the same consumers, who will be exposed to the advertisements and other marketing strategies of both parties. In fact the applicant puts forth no arguments that the services are not related or that the registrant's services are not wholly encompassed by the applicant's services.

Finally, while the services are properly classified in [international] classes 41 and 35 respectively, the classification does not serve to differentiate the services such that they are no longer highly related or that the conditions surrounding their marketing are such that they could not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. The fact that the Patent and Trademark Office classifies ... services in different classes does not establish that the ... services are unrelated under Trademark Act Section 2(d) The ... proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990) TMEP §1207.01(d)(v).

We agree with the Examining Attorney to the extent that applicant's "career counseling services" plainly appear to encompass, or are at the very least closely related to, registrant's "employment counseling and recruiting" services inasmuch as career counseling obviously includes employment counseling of those seeking job advice and/or career advancement or direction. Moreover, as noted earlier, applicant admits in its brief that, as identified in its application and in the cited registration, the respective recitations of services, including the "employment agencies providing temporary staffing/personnel for others" offered by registrant, "are somewhat similar" and, indeed, as pointed out by the Examining Attorney, "applicant puts forth no arguments that the services are not related."⁴ Furthermore, as the Examining Attorney correctly observes, the

⁴ We also note that applicant has not filed a reply brief so as to take issue with the Examining Attorney's assertions in this regard in his brief.

purpose of the Patent and Trademark Office in using the classification system is for administrative convenience rather than as an indication of whether goods and/or services are related or not. See, e.g., National Football League v. Jasper Alliance Corp., supra; and In re Leon Shaffer Golnick Advertising, Inc., 185 USPQ 242, 242 n.2 (TTAB 1974). The fact, therefore, that applicant's and registrant's services are classified in a different classes is not an indication that they are unrelated; instead, such fact is simply immaterial in determining the issue of likelihood of confusion. See, e.g., In re Clay, 154 USPQ 620, 621 (TTAB 1967) and cases cited therein. Accordingly, we conclude that applicant's services and those of registrant are identical in part and are otherwise so closely related that, if rendered under the same or similar marks, confusion as to the source or sponsorship of the respective services is likely to occur.

Turning, then, to consideration of the respective marks, applicant argues that, when considered in their entirety, its "CAREER PARTNERS INTERNATIONAL" and design mark does not so resemble registrant's "CAREER PARTNERS" mark that confusion is likely. Applicant, in particular, stresses in its brief the fact that, unlike registrant's mark, its mark contains a design element which is such "an integral part of the Appellant's logo" that "there can be no likelihood of confusion." Applicant further contends that, in his final refusal, the Examining Attorney "dissects Applicant's mark by disregarding the

words CAREER and INTERNATIONAL based on Appellant's disclaimer to the exclusive use of such words." Specifically, applicant points out that "the Examining Attorney takes the position that since Appellant has disclaimed these words, the dominant portion of the mark sought to be registered is the word 'PARTNERS,'" just as the dominant part of registrant's mark, in view of the disclaimer of the word "CAREER," is also the word "PARTNERS." Applicant thus notes that, "[a]ccording to the Examining Attorney's analysis, the appropriate comparison for determining the likelihood of confusion between the marks is the single word 'PARTNERS' that appears in both marks."

Applicant, asserts, however, that "[t]his reasoning overlooks the fact that it is the entire phrase 'CAREER PARTNERS INTERNATIONAL' in combination with the design that creates the commercial impression [of its mark] upon potential customers," who "neither know nor care whether or not a part of a mark is disclaimed." Because "[t]he appropriate test is whether Applicant's mark, in its entirety, is likely to cause confusion as to source with the entire mark of the prior cited registration -- not whether confusion is likely between essential features of the marks," applicant insists that:

Here, where one portion of the mark is common to the prior registration, the fact that other portions of the mark were disclaimed does not eliminate the possibility that the disclaimed portions serve to distinguish the two marks. Thus, when an appropriate comparison is made between the marks in their entireties, including the disclaimed portions and the design element, it is clear that there is no likely confusion.

We need not decide, however, whether the word "PARTNERS" is the dominant element in each of the respective marks. Instead, as the Examining Attorney correctly observes in his brief, the test for whether marks are confusingly similar is not whether they can be distinguished on the basis of a side-by-side comparison since such is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Soloron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Moreover, as the Examining Attorney also correctly notes in his brief, "it has long been held that when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services." See, e.g., *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

Applying the above principles, we agree with the Examining Attorney that, when considered in their entirety, applicant's mark is substantially similar to registrant's mark in sound, appearance, meaning and overall commercial impression. As

the Examining Attorney accurately and persuasively observes in his brief:

In this case the applicant's mark incorporates the entire literal portion of the registrant's mark. The only differences being the addition of the word element INTERNATIONAL, modifying CAREER PARTNERS, and the design features. While these changes do alter the visual appearance of the mark, the changes are slight and do not change the connotation, meaning or most importantly the overall impression of the applicant's mark in relationship to the registered mark. Additionally, the Trademark Trial and Appeal Board (TTAB) has held that the first word or words in a mark are typically the dominant portion saying, "[I]t is often the first part of a mark which is most likely to be impressed upon the mind ... and remembered when making purchasing decisions involving the services of the applicant and registrant." *Presto Products v. Nice-Pak Products, Inc.*, 9 USPQ2d, 1895, 1898 (TTAB 1988).

Furthermore, given that the term "INTERNATIONAL" in applicant's mark is clearly subordinate in size to the other elements therein in addition to being descriptive of the scope of applicant's career counseling services, and since the mark's principal design feature may reasonably be regarded as simply a stylized display of the letters "CP" due to the appearance thereof immediately above the term "CAREER PARTNERS," we concur with the Examining Attorney that the essentially minor differences in applicant's mark "do not obviate the similarity between the marks [at issue]."

Applicant nonetheless insists that because, as indicated earlier, it is the owner of a subsisting registration on the Supplemental Register for the mark "CAREER PARTNERS

INTERNATIONAL"⁵ which registered over the mark which is the subject of the cited registration, it should likewise be entitled to registration of its "CAREER PARTNERS INTERNATIONAL" and design mark on the Principal Register since it merely "now seeks registration for a composite mark that includes both its earlier registered word mark and a unique design element."

However, as the Examining Attorney asserts in his brief, such fact does not establish that there is no likelihood of confusion with the cited registrant's mark because:

Previous decisions of examining attorney's [sic] allowing other marks are without evidentiary value and are not binding upon the agency or the Trademark Trial & Appeal Board. Each case must be decided on its own merits. *In [r]e National Novice Hockey League, Inc.*[,] 222 USPQ 638, 639 (TTAB 1984). The applicant cannot bootstrap one confusingly similar mark ... onto the Register based on a previous error in judgment or oversight.

Moreover, we additionally observe that applicant's prior registration, besides being for a descriptive mark which in any event would be limited to a narrow scope of protection at best, is for various services which, on their face, either are specifically different from those identified in the cited registration or, in the case of its "career counseling services, namely, providing career transition services," are restricted to a particular branch of such services. By contrast, applicant is currently seeking a registration for services which are broadly recited as "career counseling services," a category which not

⁵ Such registration, applicant notes, originally was also "cited ... as a basis for refusing registration in the first office action until Appellant established that it is the owner of that registration."

only includes all areas of such services, but as indicated earlier, would clearly include the cited registrant's "employment counseling and recruiting services." In consequence thereof, applicant's subsisting registration on the Supplemental Register for the descriptive mark "CAREER PARTNERS INTERNATIONAL" cannot serve to preclude a finding of likelihood of confusion in this instance.

We accordingly conclude that consumers who are familiar or acquainted with registrant's "CAREER PARTNERS" mark for the services of "employment counseling and recruiting" and those of "employment agencies providing temporary staffing/personnel for others" would be likely to believe, upon encountering applicant's substantially similar "CAREER PARTNERS INTERNATIONAL" and design mark for "career counseling services," that such identical in part and otherwise closely related services emanate from, or are sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.