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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jurgensen

Serial No. 78320557

Jeff Landes of Catalyst Law Group for Thomas E. Jurgensen.

Shaunia P. Wallace Carlyle, Trademark Examining Attorney,
Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Bucher, Grendel and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Thomas E. Jurgensen has appealed from the final
refusal of the trademark examining attorney to register
CATALYST LAW GROUP (in standard character form) as a
trademark for "Legal Services in the Fields of

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Biotechnology Law, namely Intellectual Property Law, Business Law and Corporate Law"¹ in International Class 42.

The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered marks THE CATALYST GROUP (in standard character form) for "advisory services, namely, business consultation services relating to business and corporate development in the information technology industry,"² in International Class 35, and THE CATALYST GROUP (in standard character form) for "publications, namely, newsletters, circulars and reports, relating to business and corporate development in the information technology industry,"³ in International Class 16, that, as used on applicant's identified services, applicant's mark is likely to cause confusion or mistake or to deceive.

(Both registrations are owned by the same registrant.)

Additionally, the examining attorney has refused to register applicant's mark in view of her requirement that applicant disclaim the phrase LAW GROUP. (Applicant has

¹ Application Serial No. 78320557, filed October 29, 2003, asserting first use on May 1, 2002 and first use in commerce on November 20, 2002.

² Registration No. 2219977, issued January 26, 1999. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Registration No. 2233289, issued March 23, 1999. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

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disclaimed GROUP only.) According to the examining attorney, the term is merely descriptive of a feature of applicant's services. 15 U.S.C. § 1056(a). See also 15 U.S.C. § 1052(e)(1).

Applicant has appealed the final refusal of his application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusals to register are affirmed.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Marks

We initially consider the first *du Pont* factor, i.e., the similarities or dissimilarities of the marks in their entireties. We must consider whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Also, we are guided by the well-established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The examining attorney maintains that the dominant portion of the marks is the term CATALYST and that the significance of LAW GROUP is that "consumers will believe

that the applicant has a law group named CATLYST [sic]." Brief at p. 3. Applicant maintains that the dominant feature of the mark is CATALYST LAW rather than CATALYST alone, because CATALYST LAW "is a double entendre ... meant to create the commercial impression to the consuming public ..." Brief at p. 8. Applicant adds:

Applicant submits the wording "CATALYST LAW" is meant to express the unification of science and law. More specifically, the wording "CATALYST LAW" will be understood to be a group representing the legal services required in the field of science, namely Intellectual Property Law, Business Law, Corporate Law and Biotechnology Law. The word CATALYST refers to a substance or chemical that increases the rate of a chemical reaction without itself undergoing any change. The word LAW refers to the field of business which is the practice of law. Thus, "CATALYST LAW" is the significant feature of the mark which is responsible to creating the commercial impression upon the consuming public meant to utilize Applicant's services. Rather than focusing on the dominant wording of CATALYST only, Applicant submits the proper focus should be the wording CATALYST LAW as a double entendre ..." *Id.*

We find that the term CATALYST is the dominant term in applicant's mark. CATALYST is the first term in applicant's mark, and the first parts of marks are often those most likely to be impressed on the minds of prospective purchasers and remembered. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988). In fact, applicant, who is the principal founder and sole

shareholder of Catalyst Law Group, APC, refers to Catalyst Law Group, APC as "Catalyst" and the mark CATALYST LAW GROUP as "the 'Catalyst Mark'" in his declaration submitted with applicant's September 3, 2004 response. Further, LAW GROUP - taken as one phrase - has a readily identifiable connotation, i.e., "a number of individuals engaged in the practice of law." See definition of GROUP from *The American Heritage Dictionary of the English Language* (Online Edition), i.e., "[a] number of individuals or things considered together because of similarities," of which we take judicial notice.⁴ As such, LAW GROUP is merely descriptive of a feature of applicant services, i.e., the individuals or group that provides applicant's legal services. It is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services in comparing marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.").

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We disagree with applicant's contention that there is a double entendre in CATALYST LAW. While applicant maintains that the phrase is "meant to express the unification of science and law," we find that the claimed double entendre is simply one that would not be understood without considerable thought and conjecture, even by those in the biotechnology field, if at all. Also, given the clear meaning of LAW GROUP and the highly descriptive nature of LAW in the context of applicant's legal services, we doubt that consumers of applicant's services would find the double entendre which applicant ascribes to CATALYST LAW. Simply put, the definition of LAW GROUP would trump any double entendre - if one exists - in applicant's mark. Thus, we disagree with applicant that the dominant portion of applicant's mark is CATALYST LAW but find that the dominant term in applicant's mark is CATALYST.

We also find that CATALYST is the dominant term in registrant's mark. THE in registrant's marks has no source identifying capability. GROUP is merely descriptive of registrant as the provider of the services set forth in the registration. Registrant has disclaimed GROUP in both registrations.

Further, because the term CATALYST is arbitrary in the context of applicant's and registrant's goods and services,

and there is no evidence of third-party use of this term in the record for similar or related goods or services, we find that registrant's marks are strong marks. See definition of "catalyst," made of record with applicant's September 30, 2004 response, i.e., "1: a substance (as an enzyme) that enables a chemical reaction to proceed at a usually faster rate or under different conditions ... than otherwise possible[;] 2: an agent that provokes or speeds significant change or action."

Thus, both marks contain the arbitrary term CATALYST and the descriptive term GROUP, with CATALYST as the identical dominant term. While the marks have obvious differences in their appearances and pronunciations due in part to the inclusion of the descriptive term LAW in applicant's mark, these differences are not as significant as the similarities created by the identical common term. Further, in view of the shared dominant term and the shared term GROUP, we find that the meanings of the marks and their commercial impressions are not dissimilar - the addition of the highly descriptive term LAW between CATALYST and GROUP does not alter the overall meaning and commercial impression of the marks and the differences in the meanings and commercial impressions of the marks are not very significant. We conclude that, when we consider

these marks in their entireties, the differences in appearance, pronunciation, meaning, and commercial impression are eclipsed by the similarities of the marks. We therefore resolve the first *du Pont* factor against applicant.

The Services and Goods

We next consider the second *du Pont* factor involving the similarities or dissimilarities of the goods and services, first between applicant's services and registrant's services, and then between applicant's services and registrant's goods.

It is not necessary that the goods or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion, as long as they are related in some manner, and/or that the conditions and activities surrounding the marketing of the services and goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The examining attorney has submitted with her May 17, 2004 Office action several third-party use-based registrations to show that the same entity has adopted a common mark for both legal services and business development services.⁵ See, e.g., the following:

Registration No. 2725795 for CONCISIS for "business management consultation services, namely, advising clients in all business fields including electronics, telecommunications, consumer industries, media, retail, energy, banking, securities, healthcare, insurance and transportation, in the areas of business strategies, organization performance, business related policy areas, marketing, manufacturing and distribution of manpower, business management, planning, control, management information and information technology" in International Class 35; and "providing legal services" in International Class 42;

Registration No. 2736101 for ISOGUARD for "Business consultation services and business investigations" in International Class 35; and "... legal services, namely, enforcement of intellectual property rights of others" in International Class 42; and

Registration No. 2738104 for ALCOS for "... business consultation" in International Class 35; and "legal services" in International Class 42.⁶

⁵ The fact that the services (and goods) are classified in different classes has no bearing on the likelihood of confusion analysis. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993).

⁶ The examining attorney has also made of record several registrations based on Section 44 of the Trademark Act or registrations which do not recite legal services in International Class 42 but rather provide for business consulting services that include consultation on legal issues. Because these registrations are not based on use in commerce or do not provide

These registrations suggest that the same source may provide both business consultation services and legal services. See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988) (although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Additionally, the examining attorney has submitted with her final Office action Internet evidence showing that the same entity offers both legal services and business development services. See, e.g. the following:

www.hill-law-firm.com

Hill, Glowacki, Jaeger & Hughes, LLP is able to provide a variety of services to business and their owners. *** We provide legal services in connection with the formation of corporations, partnerships and limited liability companies. We counsel on the liability, business and tax aspects of business formation. *** BUSINESS COUNSELING. ... We provide ongoing consultation with business owners and managers on a variety of problems.

for legal services as a service in itself, such registrations have no probative value.

www.e-magnify.com

Business Owners Legal Solutions Plan

The Business Owners Legal Solutions Plan provides small businesses with comprehensive services such as: Legal correspondence services[,] ... executed contract review ... This plan also provides business consultation services and other numerous small business focused benefits ...

www.sicyou.com

Prepaid Legal Services designed the Home Based Business Rider to provide small business owners access to commonly needed legal services for a low monthly cost. ... Benefits of the Rider include: ... Trial defense at a 25% discount ... Business consultation services and other numerous small business focused benefits.

www.prweb.com

Legal Services for Entrepreneurs Now Available
Business Owners Legal Solutions Plan provides small businesses with comprehensive and affordable services. This plan also provides business consultation services.

Applicant maintains that "the services differ in two categories: 1) the industry of trade and 2) the type of service provided." Brief at p. 5.

Regarding the "industry of trade" argument, applicant maintains that applicant "provides [his] services to the field of biotechnology including, biology, chemistry and biochemistry, medical devices and pharmaceuticals, etc. while Registrant provides services to the field of information technology"; and that "the public would not be confused because the services, including the industry of the trade ... are substantially different." Brief at

pp. 5 - 6. However, the test is not whether purchasers would confuse legal services in the biotechnology field with business consultation services in the information technology industry, but rather whether purchasers would be confused as to the source of these services. Additionally, although registrant limits its services to the information technology industry, information technology is part of the computer industry, which is ubiquitous and certainly has application in the biotechnology field.

Regarding applicant's "type of services" argument, applicant explains that "the business services provided by a legal organization are substantially different from those of a non-legal entity and would not cause a likelihood of confusion." Brief at p. 6. Applicant submits:

The business services provided by a legal entity, including those by Applicant, are legally related, including issues and problems regarding securities formation and regulation, business formation, contract formation, etc. However, a non-legal entity provides such business services such as marketing, corporate development, market trend analysis, product marketing, etc. The two examples provided by the examining attorney, Pre-Paid Legal Services and Hill Law Firm, are legal entities that offer legal related business services. For example, the "business consultation services" offered by Pre-Paid Legal Services include contract review, document review, legal correspondence services, trial defense services, etc. while those of the Hill Law Firm include business formation, contract review, dispute resolution, etc. These business services are legal business services such as

those provided by the Applicant and are not business services provided by non-legal entities such as those provided by the Registrant. Brief at p. 6

Applicant, however, has not provided any support for his contention that the business services provided by a "legal entity" are limited to those that "are legally related, including issues and problems regarding securities formation and regulation, business formation, [and] contract formation." *Id.* Certainly, a law firm is not restricted to providing only legal advice or legal services. See third party registrations of record. Additionally, there is no basis for applicant's restrictive interpretation of the scope of the business consulting services provided by Pre-Paid Legal Services and the Hill Law Firm. These firms do not only address "issues and problems regarding securities formation and regulation, business formation, [and] contract formation." *Id.* The printout describing "The Business Owners Legal Solutions Plan" states that small businesses are provided with business consultation services and identifies such services, obtainable through GoSmallBiz.com as offering "a panel of experts to provide direction and advisement on any business issue" such as financing options, website promotion, sales challenges, computers, time management,

motivating employees and management." Further, the site states, "[i]f your question leads our counselors to conclude that you need hands-on business advice, then you may be referred to a retired business executive in your area who will provide free consulting and advice."

We find that the examining attorney has made a prima facie case that applicant's legal services in the biotechnology field and registrant's business consulting services in the information technology industry are sufficiently related and that applicant's legal services would likely be offered in the same channels of trade to the same purchasers who would be interested in registrant's business consulting services, and applicant has not rebutted the examining attorney's prima facie case. Thus, the second *du Pont* factor is resolved against applicant in connection with Registration No. 2219977 involving advisory services.

We now consider the similarities and dissimilarities between applicant's services and registrant's goods. The examining attorney relies on the following registrations to show that consumers have come to view applicant's legal services and registrant's publications as being of a type that emanates from a single source:

Registration No. 2827799 for RADER FISHMAN & GRAUER for "Brochures and newsletters in the fields of legal and technology services" in International Class 16; and "Legal services, intellectual property consultation, namely, management of intellectual property portfolios for domestic and foreign clients; computer services, namely, offering U.S. and foreign intellectual property data" in International Class 42;

Registration No. 2859652 for JENNER & BLOCK (stylized) for "Magazines, newsletters and pamphlets in the field of legal services" in International Class 16; and "Legal services in the fields of general litigation, client counseling, commercial law, employee benefits and executive compensation, corporate and securities law, corporate transactions, antitrust/unfair competition, appellate litigation, financial services/institutions law, tax, labor/employment/human resources, environmental, technology and intellectual property, international law, government issues, estate planning and probate, family law, and media/communications/First Amendment law" in International Class 42; and

Registration No. 2674481 for RFG for "Periodic publications, namely, newsletters in the field of intellectual property law" in International Class 16; and "Legal services in the field of intellectual property law" in International Class 42.⁷

With the exception of the registration for RADER FISHMAN & GRAUER, the above registrations are limited to legal publications, and do not concern publications in the

⁷ The examining attorney has included several Section 44 registrations with her final Office action in support of her contention that there is a relationship between applicant's services and registrant's goods. For the reasons set forth in footnote 6, *supra*, these Section 44 registrations have no probative value.

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information technology industry. While the registration for RADER FISHMAN & GRAUER includes brochures and newsletters in the field of technology services, the term "technology services" is ambiguous. Also, one registration is insufficient to demonstrate prima facie that consumers have come to view legal services and publications relating to business and corporate development in the information technology industry as coming from a common source. Thus, the second *du Pont* factor is resolved in applicant's favor in connection with Registration No. 2233289 involving publications.

Trade Channels

Applicant maintains that *applicant's* marketing activities are specifically calculated to reach only individuals or companies engaging in some form of scientific research; and that applicant typically markets his services through industry-specific trade shows, presentations and publications. In contrast, applicant maintains that the typical consumers of *registrant's* services are telecommunications companies "looking for better ways to market ... products, follow market trends and raise capital"; and that registrant markets its services through trade shows, networking events and publications

specific to the telecommunications industry.⁸ Applicant concludes that “[g]iven the entirely unrelated nature of telecommunications and life sciences, it is highly unlikely that consumers in the market for advertising, marketing and financial services, such as offered by the Registrant, will ever be exposed to the Applicant marketing its [sic] intellectual property services.” Brief at pp. 9 - 10.

In so arguing, applicant unduly restricts the scope of registrant’s identification of services, which is not limited to the telecommunications industry. We must consider registrant’s services as described in the registration, and not as what applicant determines them to be from registrant’s marketing materials. Thus, applicant's arguments regarding trade channels are not well taken.

Further, we have recognized that the information technology industry is ubiquitous and would include applications in the biotechnology field. Applicant

⁸ Applicant characterizes registrant's services based on information applicant obtained from registrant’s promotional material. It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant’s application vis-à-vis the goods and/or services recited in the registrations, rather than what the evidence shows the goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

maintains that both applicant and registrant market their services through trade shows. Brief at p. 9. Because registrant's identification of services does not limit the field in which its business consulting services relating to business and corporate development in the information technology industry are provided, we conclude that registrant's services includes services directed to the biotechnology field and may be marketed in the same trade shows where applicant appears. Thus, we find that the trade channels for applicant's and registrant's services overlap, and resolve the third *du Pont* factor against applicant.

*Conditions Under Which and Buyers to
Whom Sales are Made*

Applicant maintains that applicant's customers are well-educated and "highly sophisticated," and are not impulse-oriented purchasers, but careful, sophisticated professionals interested in specific and clearly defined services from a particular source." Brief at p. 10. However, even careful and sophisticated purchasers are not immune from source confusion. In this case, because of the similarities of the marks and the relatedness of the services, we believe that even sophisticated purchasers are likely to believe that applicant's and registrant's

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services emanate from a single source. The fourth *du Pont* factor is resolved against applicant.

No Actual Confusion

Applicant states in his declaration submitted with his September 3, 2004 response that "there has not been a single instance of actual confusion between Catalyst's mark and the mark THE CATALYST GROUP No customers have ever contacted Catalyst and inquired about the goods and services provided under THE CATALYST GROUP mark."

There is no evidence in the record as to the geographic locations where applicant and registrant have been doing business. If distant from each other, the geographic separation may account for this lack of actual confusion. Also, there is no evidence in the record regarding the level of sales or advertising by applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and

thus we cannot tell whether there has been sufficient opportunity for confusion to occur, as we have not heard from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument regarding a lack of actual confusion. Therefore, applicant's contention that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See *In re Majestic Distilling Co., supra*. Applicant's argument regarding actual confusion therefore is unpersuasive, and the seventh *du Pont* factor is neutral.

Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, we conclude that, when potential purchasers of applicant's legal services and registrant's business consultation services encounter the marks CATALYST LAW GROUP and THE CATALYST GROUP for these services, they are likely to believe that the sources of these services are in some way related or associated. As a result, there is a likelihood of confusion. We add that to the extent that we have had doubts about the question of likelihood of confusion, which we have in this case, we have resolved them in favor of the registrant and against

the newcomer. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Further, when we consider the record and the relevant likelihood of confusion factors, we conclude that, when potential purchasers of applicant's legal services and registrant's publications encounter the marks CATALYST LAW GROUP and THE CATALYST GROUP for these services and goods, they are *not* likely to believe that the sources of these services and goods are in some way related or associated.

Disclaimer

As discussed above, we do not accept that there is a double entendre in CATALYST LAW but rather find that LAW GROUP is merely descriptive of a feature of applicant's services. In view thereof, we affirm the examining attorney's requirement for a disclaimer of LAW GROUP. See 15 U.S.C. §§ 1052(e)(1) and 1056(a).

DECISION: The refusal to register the mark under Section 2(d) of the Trademark Act in view of Registration No. 2219977 is affirmed. However, the refusal to register the mark under Section 2(d) in view of Registration

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No. 2233289 is reversed. The refusal to register applicant's mark in the absence of a disclaimer of the phrase LAW GROUP is affirmed.