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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TLC Services Group, Inc.

Serial No. 78361704

Marvin Gelfand of Gelfand, Rappaport & Glaser LLP for TLC Services Group, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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

Opinion by Drost, Administrative Trademark Judge:

On February 3, 2004, applicant TLC Services Group, Inc. applied to register the mark TLC LOGISTICS MANAGEMENT (in standard character form) on the Principal Register for services in Class 35 identified as:

Business consulting services relating to product distribution, operations management services, logistics, reverse logistics, supply chain, production systems and distribution solutions; and employment counseling and recruiting services, including providing temporary and permanent staff.

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The application (Serial No. 78361704) is based on applicant's allegation of a bona fide intention to use the mark in commerce.

The examining attorney has refused to register applicant's mark on two grounds. First, the examining attorney held that applicant's mark is not registrable under the provisions of Section 2(d) of the Trademark Act because it is likely to cause confusion, to cause mistake, or to deceive with respect to the mark TLC STAFFING (in standard character form), which is registered for "employment agency, namely, providing temporary personnel for others in the professional, administrative and technical fields" in Class 35.¹ 15 U.S.C. § 1052(d). The registration contains a disclaimer of the term "Staffing."

Second, the examining attorney also refused to register applicant's mark under the provisions of Section 2(e)(1) of the Trademark Act because the examining attorney found that the term TLC LOGISTICS MANAGEMENT was merely descriptive of applicant's services. 15 U.S.C. § 1052(e)(1).

After the examining attorney made the refusals to register final, this appeal followed.

¹ Registration No. 2,049,095 issued April 1, 1997, and affidavits under Sections 8 and 15 were accepted and acknowledged.

Preliminary Matters

Before we address the refusals on the merits, we need to first resolve some preliminary disputes. With its appeal brief, applicant submitted "copies of several U.S. Trademark Registrations and Applications from the TARR database"² (Brief at 7) and a definition from the *Merriam-Webster Online Dictionary* (Brief at 13). The examining attorney objects "to the applicant's inclusion of any additional evidence with the brief... Furthermore, to make registrations and other similar matter proper evidence of record, soft copies of the registrations or the complete electronic equivalent must be submitted *before* the applicant files an appeal." Brief a 2-3. In response to the examining attorney's objections, applicant asks that the board take judicial notice of this evidence or "to remand the application for further examination." Reply Brief at 1.

By rule, the "record in the application should be complete prior to the filing of an appeal," (37 CFR § 2.142(d)) and the board does "not take judicial notice of registrations that reside in the Patent Office." In re

² TARR is the USPTO's Trademark Application and Registration Retrieval system, available at <http://tarr.uspto.gov> and may be used to obtain information about, and the status of, particular registrations or applications.

Doufold Inc., 184 USPQ 638, 640 (TTAB 1974). See also In re First Draft Inc., 76 USPQ2d 1183, 1192 (TTAB 2005)

("Submission of the TARR printout with its appeal brief, however, is an untimely submission of this evidence").

Therefore, we will not consider applicant's printouts submitted on appeal.³ Furthermore, we do not normally take judicial notice of online dictionaries that are submitted for the first time on appeal. In re Total Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). Therefore, we sustain the examining attorney's objection to this evidence. However, we do take judicial notice of the following dictionary definition of "logistics" that is very similar to applicant's online dictionary definition.

1. The branch of military science and operations dealing with procurement, supply, and maintenance of equipment with the movement, evacuation, and hospitalization of personnel, with the provision of facilities and services, and with related matters.
2. The planning, implementation, and coordination of the details of a business or other operation.

³ While we have sustained the examining attorney's objection to this evidence, we add that, if the complete printouts from the Office's TARR database had been properly submitted, they would have constituted "copies of the actual registrations or the electronic equivalents therefore, i.e., printouts of the registrations which have been taken from the USPTO's own computerized database." In re JT Tobacconists, 59 USPQ2d 1080, 1081 n.2 (TTAB 2001).

The Random House Dictionary of the English Language
(unabridged) (2d ed. 1987).⁴

Applicant's request, in the alternative, for a remand to consider this additional evidence is also denied. An applicant seeking a remand must support such a request for remand with a showing of good cause. TBMP § 1209.04 (2d. ed. rev. 2004). Applicant has not explained why such a showing could not have been submitted earlier. "Moreover, creation of the record to be considered in an ex parte appeal must, at some point, be concluded. Accordingly, we have not considered the evidence submitted with the reply brief and deny the alternative request for remand so that the Examining Attorney can consider this evidence." In re Zanova Inc., 59 USPQ2d 1300, 1302-03 (TTAB 2001).

Descriptiveness

We now consider the issue of whether the mark TLC LOGISTICS MANAGEMENT is merely descriptive. Applicant has disclaimed the term "Logistics Management" in response to the examining attorney's descriptiveness refusal. That disclaimer is consistent with the disclaimers in other registrations. See No. 1,617,849 (LOGICORP LOGISTICS

⁴ We can take judicial notice of dictionary definitions in printed dictionaries. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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MANAGEMENT, "Logistics Management" disclaimed) and No. 2,095,962 (FIRST ALLIANCE LOGISTICS MANAGEMENT, "Logistics Management" disclaimed). Our case law recognizes that registrations can be used as a form of a dictionary definition to illustrate how a term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987).

The examining attorney also included an entry from www.acronymfinder.com that listed among several meanings of the acronym TLC, the following: "total logistics control." The examining attorney also submitted a registration (No. 1,398,883) for the mark TLC TOTAL LOGISTIC CONTROL and design for "commercial warehousing services and the transportation of goods of commercial concerns" in Class 39. The registration is on the Principal Register with the words "Total Logistic Control" disclaimed.

Based on this evidence, the examining attorney argues (Brief at 9-10) that:

[T]he acronym, "TLC" means "total logistic control" and "total logistic control" has been previously disclaimed in U.S. Registration No. 1,398,883. In addition, as provided by the dictionary definitions and prior registrations attached with the Examining Attorney's initial refusal, "LOGISTICS MANAGEMENT" is also merely descriptive... As each component in the applicant's mark retains its descriptive significance in relation to the recited services, the combination results in a composite that is itself descriptive.

Applicant, on the other hand, argues that "'TLC' in Applicant's mark is not an acronym for 'total logistic control' but for its name 'TLC Services Group, Inc.' and its subsidiary, Translabor Leasing Corp." Reply Brief at 8-9.⁵ Applicant also argues that the "first compound term thought of with 'TLC' is 'tender loving care.'" Brief at 11.

A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service." In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978).

In this case, we are struck by the fact that the only evidence that supports the examining attorney's argument that the abbreviation TLC is merely descriptive is an entry in an acronym finder and a single registration on the Principal Register in which the wording "Total Logistic Control" is disclaimed, but the abbreviation TLC is not

⁵ Inasmuch as it is untimely, we have not considered applicant's and registrant's literature that was submitted for the first time with applicant's Reply Brief. 37 CFR § 2.142(d); Zanova, 59 USPQ2d at 1302-03.

disclaimed.⁶ We take judicial notice that the term TLC is defined in the dictionary as an abbreviation of the term "Tender Loving Care." *Webster's Third New International Dictionary* (1993). While there is some evidence that the term "Total Logistic Control" may be descriptive of the identified services, there is little evidence that the letters TLC are descriptive. The Court of Customs and Patent Appeals, one of the predecessors of our principal reviewing court, has discussed the question of whether letters that correspond to the initial letters of a descriptive combination of words are similarly descriptive. Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) (citations omitted):

The letters "CV" are, of course, the initial letters of the words "continuous vision," and it is possible for initial letters to become so associated with descriptive words as to become descriptive themselves. It does not follow, however, that all initials or combinations of descriptive words are ipso facto unregistrable. While each case must be determined on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

⁶ Because the term TLC is also part of the design, it is possible that there was no requirement for a disclaimer of the term because it was considered unitary. However, it is also possible that the term was not considered to be merely descriptive.

In this case, the evidence, consisting primarily of a single entry in an acronym finder, falls well below the minimum required to show that the letters TLC are generally understood as representing the allegedly descriptive words "Total Logistic Control." We have little, if any, basis to conclude that this abbreviation is recognized by any prospective purchasers as an abbreviation of the underlying term. Therefore, we reverse the examining attorney's refusal to register the mark TLC LOGISTICS MANAGEMENT on the ground that it is merely descriptive.⁷

Likelihood of Confusion

We do, however, affirm the examining attorney's refusal to register on the ground that applicant's mark is likely to cause confusion with the cited registration. In likelihood of confusion cases, we look to the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) to determine whether there is a likelihood of confusion. 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

⁷ We again note that applicant has already disclaimed the words "Logistics Management."

that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

An important factor in these types of cases is a comparison of the similarities and dissimilarities of the respective marks. Here, the marks at issue are TLC LOGISTICS MANAGEMENT and TLC STAFFING. Applicant has disclaimed the words "Logistics Management" and registrant has disclaimed the term "Staffing." The evidence shows that the term "Logistics Management" is descriptive and it is less likely that this term, as well as registrant's disclaimed term "Staffing," would be relied upon by prospective purchasers to distinguish the marks.

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) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'"). See also In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (Disclaimed matter is often "less significant in creating the mark's commercial

impression"). While we do not disregard these terms, we cannot conclude that prospective purchasers of these services are likely to assume that the sources of these services are not related simply because of the presence of these terms in the respective marks.

While we must compare the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." National Data, 224 USPQ at 751. Obviously, the non-disclaimed portion of both marks is the identical term TLC. While the examining attorney noted that this term may be an acronym for "Total Logistic Control," the letters are also defined as an abbreviation for "Tender Loving Care,"⁸ which may suggest some laudatory connotation when used in association with the respective services. This term is likely to be the dominant portion of both marks to the extent that it is not descriptive.

⁸ In either case, we do not find that the letters here are "arbitrarily arranged letters" that are "more difficult to remember." Examining Attorney's Brief at 5.

When we consider the marks, TLC LOGISTICS MANAGEMENT and TLC STAFFING, in their entireties, we conclude that they are similar in sound, appearance, meaning, and commercial impression. The marks are similar to the extent that the initial part of the mark is identical and, therefore, they would look and sound similar and the addition of the descriptive matter would not result in dissimilar marks. Plantronics Inc. v. Starcom Inc., 213 USPQ 699, 702 (TTAB 1982) ("Accepting that the marks have differences in sound and appearance, they are identical in respect of their dominant features i.e. the prefix "STAR". Similarity of dominant features must be accorded greatest weight"). Furthermore, we cannot agree with applicant that the marks would have different meanings and their commercial impressions would be different. The descriptive portion of applicant's and registrant's marks, LOGISTICS MANAGEMENT and STAFFING, simply describes similar services that are available from the applicant and registrant. Both marks are likely to have similar meanings regardless of whether the meaning of TLC is "Tender Loving Care" or "Total Logistic Control" and the marks would have similar commercial impressions. While customers may notice the different descriptive wording at the end of each of the

marks, they are not likely to assume that such wording indicates that the sources of the services are different. These customers are instead likely simply to assume that registrant offers related services under a slightly different mark.

Next, we address whether applicant's and registrant's services are related. Applicant's services are:

Business consulting services relating to product distribution, operations management services, logistics, reverse logistics, supply chain, production systems and distribution solutions; and employment counseling and recruiting services, including providing temporary and permanent staff.

Registrant's services are "employment agency, namely, providing temporary personnel for others in the professional, administrative and technical fields." The examining attorney argues (Brief at 7, emphasis omitted) that:

[W]hile applicant provides "employment counseling and recruiting services, including providing temporary and permanent staff," the registrant also provides "temporary personnel for others in the professional, administrative and technical fields." As such, both parties provide temporary staffing solutions. In addition, individuals with professional, administrative and technical backgrounds can conceivably work, at least temporarily, in the product distribution and logistics management industries.

Applicant responds by arguing (Reply Brief at 6, emphasis omitted) that:

The applicant does not only provide "employment counseling and recruiting services, including providing temporary and permanent staff," but "business consulting services relating to product distribution, operating management services, logistics, reverse logistics, supply chain, production systems and distribution solutions; and employment counseling and recruiting services, including providing temporary and permanent staff." As such, the services are defined not only as an employment agency, but a business consulting service relating to product distribution, operating management services, logistics, reverse logistics, supply chain, production systems and distribution solutions.

We must consider the services as they are set out in the identification of services in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services).

Applicant's services include employment counseling and recruiting services, including providing temporary and permanent staff. Registrant's employment agency services provide temporary personnel for others in the professional, administrative and technical fields. Both applicant and registrant's services include providing temporary staffing and, therefore, we must conclude that they are in part identical. We add that applicant does not limit its employment agency services to any particular field so we must assume that applicant's employment agency services are provided in the professional, administrative and technical fields. Regardless of how applicant is actually using its mark, we do not read limitations into the application or registration. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). We also add that we compare the individual services set out in applicant's identification of services to determine if there is a likelihood of confusion. Therefore, the fact that applicant also seeks registration of its mark for "business consulting services" does not limit its "employment counseling and recruiting services." Each separate service is considered individually and a refusal is proper if any service in the application is related to a service in the

cited registration.⁹ Therefore, we must conclude that the services overlap. The services are also closely related to the extent that applicant is also providing permanent staffing services and registrant is providing temporary staffing services.

We add at this point that when services are identical, marks do not need to be as similar to support a conclusion that there is a likelihood of confusion. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines"). Furthermore, when goods or services are identical, we must assume that the prospective purchasers and channels of trade are the same. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold

⁹ "[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item." Tuxedo Monopoly Inc. v. General Mills Fun, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

to the same classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Applicant also argues that the "marks are weak and entitled to a narrow scope of protection." Brief at 7. While we do not find that the marks are weak, even if the marks were weak, the registered mark would still be entitled to protection when very similar marks are used on overlapping services. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982) ("[E]ven weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services"); In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover). Furthermore, third-party registrations are not evidence that a mark is weak. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original) ("As to strength of a mark, however, registration evidence may not be given any weight." See also AMF Inc. v. American Leisure Prods.,

Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"). Finally, even if the presence of a few registrations was relevant, the fact that a term has been registered for other goods and services would hardly establish that a mark was weak. Therefore, we cannot conclude that the registered mark is entitled to only a narrow scope of protection.

We also add that even if the purchasers of applicant's and registrant's services were considered to be sophisticated purchasers, confusion would still be likely. The marks are very similar and the services are in part overlapping and closely related. Even sophisticated purchasers are likely to be confused under these circumstances. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible"). See also 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

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confusion as to source where, as here, substantially identical marks are applied to related products").

Therefore, when we consider, *inter alia*, that the marks are very similar and the services are in part identical and closely related, we conclude that there is a likelihood of confusion.

Decision: The refusal to register applicant's mark on the ground that its mark is merely descriptive is reversed. The refusal to register on the ground that applicant's mark, when used on its identified services, is confusingly similar to the mark in the cited registration is affirmed.