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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ABBTECH Staffing Services, Inc.

Serial No. 78412590

Elizabeth M. Seltzer of Driscoll & Seltzer for ABBTECH Staffing Services, Inc.

Mark V. Sparacino, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by ABBTECH Staffing Services, Inc. to register the mark ABBTECH for "temporary and career placement and staffing services."[1]

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with applicant's services, so resembles the previously registered mark ABB

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[1] Application Serial No. 78412590, filed May 4, 2004, alleging first use anywhere and first use in commerce on August 6, 1991.

FULL SERVICE ("FULL SERVICE" disclaimed) for services that include "personnel staffing and placement services and consulting in connection therewith, namely providing temporary, permanent and contract employees and human resources management,"[2] as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues that the marks ABBTECH and ABB FULL SERVICE, when compared in their entireties, are different in sound, appearance, meaning and commercial impression. Applicant contends that the examining attorney has impermissibly dissected applicant's unitary mark with his contention that the ABB portion dominates applicant's mark. Applicant asserts that, in any event, the prefixes ABB and AB are commonly used in the marketplace; such uses, according to applicant, are mainly due to a business's desire, including applicant's, to be listed at the beginning of business and phone directories. Applicant also contends that the services are different, stating that registrant performs industrial support projects and only incidentally staffs such projects with personnel to

[2] Registration No. 2551801, issued March 26, 2002. The registration includes other services in International Class 35, as well as in three additional classes.

perform and complete the projects, whereas applicant is a true personnel placement business. Applicant further asserts that the services are rendered to sophisticated customers who are not likely to be confused by these assertedly different marks for different services. Applicant points out that another one of its marks, ABBSOURCE, for services identical to those in the present application, was the subject of a notice of allowance.[3] In support of its arguments, applicant submitted the declaration of Threase Baker, applicant's vice president of operations; dictionary definitions of the words "full" and "service"; copies of third-party ABB- and AB- formative registrations retrieved from the USPTO's TESS database; excerpts from printed publications retrieved from the NEXIS database showing uses of business names incorporating the prefixes ABB- and AB-; and screen shots of portions of both applicant's and registrant's websites.

The examining attorney maintains that the marks are similar and that the services rendered thereunder are identical. As to the marks, the examining attorney argues that both include the dominant portion ABB followed by

[3] A check of Office records shows that applicant's application matured into Reg. No. 3080661 on April 11, 2006 for the mark ABBSOURCE for "temporary and career placement and staffing services."

descriptive terms. Insofar as the services are concerned, the examining attorney points out that registrant's recitation of services is not restricted and, thus, registrant's services must be considered to be legally identical to applicant's services for purposes of the likelihood of confusion determination. With respect to the weakness of the ABB- prefix, the examining attorney contends that much of applicant's evidence pertaining thereto is irrelevant because the evidence relates to goods and services different from the services involved herein. As to applicant's recently issued registration, the examining attorney states that he is not bound by the prior actions and decisions of another examining attorney. When the marks are used in connection with identical services, the examining attorney concludes, customers will mistakenly believe that ABBTECH identifies "tech" staffing services that are part of a comprehensive "full service" company that provides a range of staffing services under the mark ABB FULL SERVICE.

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 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).

Insofar as the services are concerned, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the services in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of services encompasses not only all the services of the nature and type described therein, but that the identified services are offered in all channels of

trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Applicant's recitation of services reads "temporary and career placement and staffing services" and registrant's recitation of services reads "personnel staffing and placement services and consulting in connection therewith, namely providing temporary, permanent and contract employees and human resources management." As recited in the respective recitations, the services are, for purposes of the likelihood of confusion analysis, legally identical. We must presume that the services are rendered in the same trade channels to the same classes of purchasers.

Applicant's reliance on registrant's website in an attempt to restrict the scope of registrant's services is to no avail. An applicant may not restrict the scope of the services covered in the cited registration by argument or extrinsic evidence. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986).

Applicant also contends that the purchasers of the involved services are sophisticated and, thus, are more likely to be able to distinguish the marks as to source. While the services would, by their very nature, be offered

to businesses, potential purchasers could include those that do not require staffing on a regular basis, and therefore might not be aware of what applicant claims is a commonplace practice, using ABB- prefix marks to get a favorable telephone directory listing. It is obvious that not all purchasers of such services would obtain the services by looking in telephone directories. Therefore, someone who had heard positive things about ABB FULL SERVICE staffing from a business friend might assume that the same services offered under the mark ABBTECH emanated from the same source. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated in the field of trademarks or immune from source confusion. See In re Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing 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 Decombe, 9 USPQ2d 1812 (TTAB 1988).

We next turn our attention to a comparison of the marks ABB FULL SERVICE and ABBTECH. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound,

connotation 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). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. Finally, where, as in the present case, the marks appear in connection with, at least in part, legally identical services, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The marks are similar in that both begin with the arbitrary portion ABB and end with a descriptive term. As to the ABB portion, applicant states that it is a common practice for businesses to start their names “with the letters A and B, which for marketing purposes, facilitates the company’s name placement at the top of the list in traditional and online directories.” (Brief, p. 8). While businesses sometimes choose tradenames that begin with the letters AB-, nevertheless ABB is arbitrary when used in connection with the involved services.

Insofar as the term FULL SERVICE in registrant's mark is concerned, it is descriptive and has been disclaimed. With regard to the term TECH in applicant's mark, the examining attorney has introduced several third-party registrations for marks comprising, in part, the term "tech" wherein the term is disclaimed; the registrations cover a range of services in the technology field.[4] The examining attorney also submitted excerpts of articles retrieved from the NEXIS database, as well as excerpts of third-party websites, showing uses of "tech staffing" in the personnel placement and staffing services field. The uses include the following: "many workers use tech staffing agencies" (*Chicago Daily* Herald, February 27, 2000); and "Tech, short for technology, is a term that can be applied to just about every profession related to computers, engineering, or science. Tech workers are always needed in every field related to any type of technology...As a tech staffing agency, we provide the best temporary, temp-to-hire, and permanent placement high-tech staffing services for our employer clients."

[4] The examining attorney also submitted a TESS printout showing that there are over 17,000 registered marks comprising, in part, some form (or phonetic equivalent) of the term "TECH" (e.g., TECH, TECHNOLOGY, TEK, etc.). A mere printout is insufficient to make any of the registrations of record. TBMP § 1208.02 (2d ed. rev. 2004). Accordingly, the printout has not been considered in reaching our decision.

(www.insourcesolutions.com). Applicant states, on its website, that it specializes in “Information Technology, Technical, Telecom and Administrative personnel.” Indeed, applicant acknowledges the descriptiveness of “TECH” in the field “when considered as a separate, insular component”: “Applicant does not disagree with the notion that TECH is descriptive of the term ‘technology’, and is commonly used in relation to numerous industries and vocations, including staffing services.” (Appeal Brief, pp. 11-12). In view thereof, although applicant’s mark ABBTECH is unitary, we cannot ignore the fact that it is comprised of an arbitrary portion combined with a descriptive term.

Although the marks must be compared 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 the mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In the cited mark, the disclaimed words FULL SERVICE are descriptive of a complete line of services which, in this case, would include personnel staffing and placement services. These words deserve little weight in the likelihood of confusion analysis, because they have no source-indicating significance. Rather, it is to the ABB portion that purchasers will turn to identify the source of the

services. Consumers will view ABB FULL SERVICE and ABBTECH, both for personnel staffing services, as indicating such services emanating from the same source. Purchasers will understand the words FULL SERVICE to be an appropriate descriptive term when used in connection with a complete line of services, and will assume that ABBTECH is a variation of that mark, and that this mark identifies the more specific tech staffing services offered as part of a comprehensive full service entity. Given the identity in the arbitrary first portion of each mark, the presence of FULL SERVICE in the cited mark and the presence of TECH in applicant's mark does not serve to distinguish the marks, especially when used in connection with identical services.

Notwithstanding the identity in the ABB portion of the marks, applicant argues that this portion is pronounced differently in the marks. In this connection, applicant submitted the declaration of Threase Baker, applicant's vice president of operations. Ms. Baker states that she placed a phone call to the main corporate office of registrant, and that the person answering the phone "pronounced the company's name as an acronym with three distinct letters 'A' then 'B' then 'B', not the prefix 'ab.'" According to applicant, its mark would be spoken as "abtek" while registrant's mark is pronounced "a" "b" "b"

"full service." Applicant's evidence and argument do not control when comparing the marks in terms of sound. As often stated, there is no "correct" pronunciation of a trademark that is not composed of a recognized word because it is impossible to predict how the public will pronounce a particular mark. Thus, "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. See Kabushiki Kaisha Hattori Tokeiten v. Scuotto, 228 USPQ 461 (TTAB 1985); and In re Energy Telecommunications & Electrical Association, 222 USPQ 350 (TTAB 1983). Given the propensity of consumers to use shorthand forms of words, as well as to pronounce acronyms as words rather than as individual letters, it is just as likely that purchasers will refer to registrant's ABB in the same way that they would refer to the ABB portion in applicant's mark, rather than as the separate letters A-B-B.

In trying to limit the scope of protection to be accorded registrant's mark, applicant has submitted evidence of third-party uses and registrations of AB- and ABB- marks. More specifically, applicant introduced the names of businesses listed in an on-line publication, "U.S. Business Directory"; each of the businesses is named AB- or ABB-, or the full name begins with those letters as in, for

example, ABBOTT. Applicant also submitted third-party registrations of AB- and ABB- marks.

Applicant's evidence related to third-party uses and registrations is entitled to limited probative value. As for the registrations, they are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result would be able to distinguish between the AB- and ABB- marks based on slight differences between them. Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and Richardson-Vicks, Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982). The probative value of the third-party registrations and uses is significantly diminished by virtue of the fact that the trademarks/trade names cover a wide variety of goods and services, most of which are not even remotely related to personnel placement and staffing services. See Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Fed. Cir., June 5, 1992). Very few of the third-party uses and registrations cover staffing services; further, some of the marks, as for example, ABBOTT and ABLEST, hardly show the purported weakness of ABB. In any event, even if we were

to find, based on applicant's evidence, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of a similar mark for identical services. See In re Farah Manufacturing Co., Inc., 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

In view of the above, although there are specific differences between the marks, these differences are outweighed by the similarities. The marks ABB FULL SERVICE and ABBTECH are sufficiently similar in sound, appearance, meaning and overall commercial impression that, when used in connection with these identical services, purchasers are likely to be confused.

In reaching our conclusion, we have taken into account applicant's recently issued Registration No. 3080661 for the mark ABBSOURCE for the same services as set forth in its present application. The Office's issuance of the registration, however, does not justify reversal of the refusal in this case. Whatever the examining attorney's reasons were for approving applicant's mark ABBSOURCE over registrant's mark, applicant's marks ABBSOURCE and ABBTECH obviously are different. There are cases, as in the present one, where differences in an applicant's marks warrant different results when its marks are compared with

other marks in determining the likelihood of confusion. As often stated, each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the Board. In re Sunmarks Inc., 32 USPQ2d 1470 (TTAB 1994); In re Perez, 21 USPQ2d 1075 (TTAB 1991); and In re J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1987). Accord In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]; and In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) ["each application for registration of a mark for particular goods must be separately evaluated"].

We conclude that purchasers familiar with registrant's "personnel staffing and placement services and consulting in connection therewith, namely providing temporary, permanent and contract employees and human resources management" rendered under its mark ABB FULL SERVICE would be likely to believe, upon encountering applicant's "temporary and career placement and staffing services" rendered under the mark ABBTECH, that applicant's mark identifies "tech" staffing services that are part of a

comprehensive “full service” company that provides a range of staffing services under the mark ABB FULL SERVICE. Thus, purchasers would think that the services originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin’s Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.