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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NFO, Inc.

Serial No. 78549135

Garrett M. Weber of Lindquist & Vennum P.L.L.P. for NFO, Inc.

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Before Hohein, Hairston, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

An application has been filed by NFO, Inc. to register the mark MAXIMUM MARKETING for "business marketing and consulting services in the field of grain trading and grain market analysis."[1]

The Trademark Examining Attorney has refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). The Examining contends that applicant's mark, if applied to applicant's services, so closely

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[1] Application Serial No. 78549135, filed on January 18, 2005, based on a *bona fide* intention to use the mark in commerce.

resembles the previously registered mark MAXIMUM for "business marketing consulting services" as to be likely to cause confusion.[2]

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.

We affirm.

Applicant has argued that there is no likelihood of confusion for the following reasons:

1. The marks are different (*i.e.*, MAXIMUM MARKETING is distinct from MAXIMUM);

2. There are numerous "Maximum" marks for business consulting services and, therefore, "Maximum" is a weak term entitled to only a narrow scope of protection; and,

3. The services of the applicant and registrant are different (*i.e.*, applicant's business marketing and consulting services are restricted to grain trading and marketing while the registrant's "general business marketing services . . . have nothing to do with trading or grain marketing." Therefore, there is no overlap in the services).

With respect to its argument that there are numerous "Maximum" marks, applicant has submitted copies of seven (7) registrations consisting in part of the word "maximum" for various marketing services. Applicant asserted that when the Examining Attorney finds registrations for similar marks owned by more than one registrant, the Examining

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[2] Registration No. 1,976,726, issued on May 28, 1996; renewed.

Attorney should consider the extent to which "dilution" may indicate that there is no likelihood of confusion[3] and that the Examining Attorney failed to properly consider the evidence.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). In the case *sub judice,* the record consists of the application, the cited registration, and the seven (7) third-party registrations.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services.

A. The Marks Are Confusingly Similar.

Applicant's mark MAXIMUM MARKETING and registrant's mark MAXIMUM differ only by the generic term "marketing." Applicant posits that the addition of the word "marketing" is a meaningful distinction. We disagree.

First, registrant's MAXIMUM mark is inherently distinctive and, therefore, entitled to trademark

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[3] TMEP §1207.01(d)(x).

protection without a showing of secondary meaning. Moreover, the exclusive appropriation of "Maximum" as a service mark in connection with business marketing consulting services does not interfere with competitors' use of the language because they may use the word "maximum" in its ordinary descriptive sense (*e.g.* in the cited registrations ACHIEVE THE MAXIMUM, MAXIMUM CAPACITY, MAXIMUM CASH, etc., the word "Maximum" retains its dictionary meaning). Accordingly, MAXIMUM when used in connection with business marketing consulting services is an inherently strong mark entitled to a broad scope of protection.

Second, applicant's mark incorporates the entirety of registrant's mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *Johnson Publishing Co. v. International Development Ltd.,* 221 U.S.P.Q. 155, 156 (T.T.A.B. 1982)(EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re Denisi,* 225 U.S.P.Q. 624, 626 (T.T.A.B. 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *In re South Bend Toy Manufacturing Company, Inc.,* 218 U.S.P.Q. 479, 480 (T.T.A.B. 1983) (LIL' LADY

BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

Third, registrant's addition of the generic term "marketing" to applicant's mark MAXIMUM does not avoid a likelihood of confusion. *In re Denisi, supra; In re South Bend Toy Manufacturing Company, Inc., supra.* While not ignoring the caveat that marks must be considered in their entireties when evaluating their similarity or dissimilarity, where the applicant appropriates the entire mark of a registrant, the addition of a descriptive or generic term generally is not sufficient to change a confusingly similar mark into a dissimilar mark. This is sometimes referred to as the rule where the dominant portion of a mark may be given greater weight than other features: that is, likelihood of confusion generally increases where, as here, the dominant portions of the marks are the same. *In re Denisi, supra*. Moreover, the Board has found a likelihood of confusion in the case of marks with identical initial terms to which the junior user has added a suffix. *Presto Products Inc. v. Nice-Pak Products Inc.,* 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered").

For the preceding reasons, applicant's mark MAXIMUM MARKETING creates the same commercial impression as registrant's mark MAXIMUM and, therefore, is confusingly similar.

B. Registrant's Services Encompass Applicant's Services.

We now direct our attention to a consideration of the services:

> "business marketing and consulting services in the field of grain trading and grain market analysis" for applicant

vs.

> "business marketing consulting services" for registrant.

It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods or services as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the services, their channels of trade and/or classes of purchasers. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank,* 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum,* 211 U.S.P.Q. 639 (T.T.A.B. 1981). Accordingly, applicant's argument that there is no overlap between its services and

registrant's services is not persuasive because there is no restriction in the identification of services as to the registrant's channels of trade. We must therefore consider the registrant's services as if they were being rendered in all of the normal channels of trade to all of the normal purchasers for such services. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra; Toys R Us, Inc. v. Lamps R Us,* 219 U.S.P.Q. 340, 343 (T.T.A.B. 1983). Registrant's business marketing consulting services, as identified, is broad enough to encompass marketing consulting services in the field of grain trading and grain market analysis. Absent any limitation in the cited registration as to whether registrant's services exclude the grain industry, we cannot infer that such a limitation exists. *In re Denisi, supra*.

C. No Inferences Can Be Drawn From The Third-Party Registrations.

Finally, we turn to applicant's argument that the "numerous" third-party registrations including the word "maximum" demonstrate that registrant's mark is entitled to only a narrow scope of protection. Essentially, applicant is arguing that the following inferences should be drawn from the seven (7) registrations it submitted:

1. The registrant does not believe that there is a likelihood of confusion between these marks for the listed services;

2. The third-party registrants were satisfied to register their marks side-by-side with other existing registrations for business marketing services; and,

3. A number of different trademark owners have believed that that various "Maximum" marks can be used and registered side-by-side without causing confusion provided that there are minimal differences between the marks or their services.

Plus Products v. Natural Organics, Inc., 204 U.S.P.Q. 773, 779 (T.T.A.B. 1979); *Jerrold Electronics Corp. v. The Magnavox Company,* 199 U.S.P.Q. 751, 757-758 (T.T.A.B. 1978).

Under the circumstances of this case, we decline to draw those inferences. First, the third-party registrations simply demonstrate that their owners believe that the term "maximum" is appropriate for a service mark used in connection with business marketing services. The question still remains whether the applicant's mark and the registrant's mark viewed as a whole are confusingly similar. The existence of third-party registrations of other "Maximum" marks has very little weight in this regard because such registrations are not evidence of what happens in the marketplace or that customers are familiar with their use. Moreover, the existence of other confusingly

similar marks already on the register will not aid an applicant to register another confusingly similar mark. *AMF Inc. v. American Leisure Products, Inc.,* 474 F.2d 1403, 177 U.S.P.Q. 268, 269 (C.C.P.A. 1973); *Lilly Pulitzer, Inc. v. Lilli Ann Corporation,* 376 F.2d 324, 153 U.S.P.Q. 406, 407 (C.C.P.A. 1967); *In re Total Quality Group, Inc.,* 51 U.S.P.Q.2d 1474, 1477 (T.T.A.B. 1999).

Second, third-party registrations of similar marks for similar services is relevant to show that the mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin,* 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). However, the probative value of third-party marks depends on their usage because such use conditions or educates consumers to distinguish between different marks on the bases of minimal differences. *Id., citing Scarves by Vera, Inc. v. Todo Imports, Ltd.,* 544 F.2d 1167, 1173, 192 U.S.P.Q. 289 (2nd Cir. 1976)("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, they were well promoted or that they were recognized by consumers."). In the case *sub judice,* applicant did not submit any evidence of third-party use of the "Maximum" marks. Therefore, the third-

party registrations are not evidence that the public is aware of the marks. Absent any evidence of actual use of any of the registered third-party "Maximum" marks, the probative value of the registrations is minimal. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin, supra; Han Beauty, Inc. v. Alberto-Culver Co.,* 236 F.3d 1333, 1338, 57 U.S.P.Q.2d 1557 (Fed. Cir. 2001).

Finally, as we indicated previously, MAXIMUM and MAXIMUM MARKETING when used in connection with business marketing consulting services (with or without reference to the grain industry) are essentially the same mark because the word "marketing" is generic for marketing services. Thus, even assuming that marks consisting of the word "Maximum" may be weak marks, this does not aid applicant because the commercial impression created by both marks is the same.

In view of the foregoing, there is insufficient evidence to undermine the strength of the registrant's mark.

We find that there is a likelihood of confusion between MAXIMUM MARKETING proposed for use in connection with "business marketing and consulting services in the field of grain trading and grain market analysis" and

MAXIMUM used in connection with "business marketing consulting services".

Decision: The refusal to register is affirmed.