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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Delaware Valley Legacy Fund

Serial No. 78608669

Michael J. Leonard and Alexander G. Bornstein of Pepper
Hamilton LLP for Delaware Valley Legacy Fund.

Odessa Bibbins, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Mermelstein and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Delaware Valley Legacy Fund, a non-profit
organization, has appealed from the final refusal of the
Trademark Examining Attorney to register WILLPOWER PROJECT
in standard character form, with the word PROJECT
disclaimed, for the following goods and services, as
ultimately identified:

Printed materials, namely,
certificates, workbooks, manuals and
printed educational materials all in

the field of estate planning for the gay, lesbian, bisexual and transgender community (Class 16); and

Educational services, namely conducting classes, seminars, workshops and training services for the purpose of certification of professionals in the field of estate planning, for the gay, lesbian, bisexual and transgender community; educational services, namely, conducting classes, seminars and workshops emphasizing the importance of estate planning for the gay, lesbian, bisexual and transgender community (Class 41).¹

Registration has been refused 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 following marks, registered by different entities, that, when used in connection with applicant's goods and services, it is likely to cause confusion or mistake or to deceive:²

WILLPOWER in typed form for "computer software for estate planning for individual consumers";³ and

WILL POWER in typed form for "professional services, namely

¹ Application Serial No. 78608669, filed April 14, 2005, asserting first use and first use in commerce as early as May 20, 2003. The final refusal also included a final requirement for a disclaimer of PROJECT; applicant submitted such disclaimer with its request for reconsideration.

² A third registration, No. 1947473 for WILLPOWER for "electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills," was originally cited against applicant's application, but the refusal based on this registration was subsequently withdrawn.

³ Registration No. 2649830, issued November 12, 2002; Section 8 & 15 affidavits accepted and acknowledged.

providing legal services in the nature of estate planning.”⁴

Both applicant and the examining attorney have filed briefs.⁵

We must first consider certain evidentiary issues. With its brief, applicant submitted a number of exhibits. The examining attorney specifically objected to Exhibit 2, which consists of copies of four registrations taken from the USPTO’s TESS database. Because the printouts from the database were not submitted during prosecution, the examining attorney contends that these registrations were not timely made of record. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). The examining attorney recognizes that, with its response to the first Office action, applicant submitted a chart identifying these registrations by mark, number, issue date, goods/services and registrant. However, citing *In re Duofold Inc.*, 184

⁴ Registration No. 2708267, issued April 22, 2003.

⁵ In its brief applicant has cited federal district and appellate court cases by their Federal Reporter citations. When cases are cited in a brief, the case citation should include a citation to “The United States Patent Quarterly” (USPQ) if the case is found in that reporter. See TBMP §801.03. Further, we note that several of the citations provided by applicant are incorrect, e.g., *Colgate-Palmolive Co. v. Carter-Wallace* is reported as being at “58 USPQ 735,” when in actuality it is found at “167 USPQ 529”; *In re H & H Products* is cited as being at “228 USPQ 711” when it is actually at “228 USPQ 771.” Needless to say, parties should take care that citations are accurate.

USPQ 638 (TTAB 1974), the examining attorney asserts that submission of this chart is not the appropriate procedure to make third-party registrations of record.

Although the examining attorney is correct that, in general, the mere listing of third-party registrations is insufficient to make them of record, there are limited circumstances in which the Board will consider such listings. TBMP Section 1208.02 specifically states that "if an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise applicant that the listing is insufficient to make the registrations of record at a point when applicant can correct the error, the examining attorney will be deemed to have stipulated the registrations into the record." Here, the examining attorney did not advise applicant prior to appeal that its chart was not admissible. Although in this case applicant waited until its appeal brief to submit the actual copies of the registrations, we will consider these documents as well. See *In re Hayes*, 62 USPQ2d 1443, 1445, n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition during prosecution, and examining attorney did not advise

applicant that copies of the registrations were necessary to make them of record). Accordingly, we have considered Exhibit 2 to applicant's appeal brief.

However, applicant also submitted with its appeal brief certain exhibits that had not been made of record during prosecution of the application. These exhibits are manifestly untimely. See Trademark Rule 2.142(d). Moreover, they were not discussed by the examining attorney in her brief, and therefore cannot be deemed to have been stipulated into the record. Accordingly, Exhibits 1, 3, 4, 5 and 6 have not been considered.⁶

⁶ Even if they were properly of record, they would have no effect on our decision in this appeal. In fact, Exhibit 1, which lists 5,000 501(c)(3) organizations registered with the Internal Revenue Service which have the word "Project" in their names, supports the examining attorney's point that the word PROJECT in applicant's mark is entitled to less weight because "project" is a commonly used term with little or no source-identifying significance. As for Exhibits 4 through 6, which relate to the promotion of applicant's services by third-party organizations, evidence of actual trade channels cannot serve to distinguish applicant's goods or services from those of the owners of the cited registrations, since likelihood of confusion must be determined based on the goods and services identified in the application and the cited registrations, regardless of what the evidence shows them to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, where the goods or services are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the identified goods and services move in all channels of trade that would be normal for such goods and services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

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, 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). In the present case, the examining attorney has also pointed to the factor of the channels of trade, while applicant lists, in addition, the conditions under which and the buyers to whom sales are made, and the length of time during which there has been concurrent use without evidence of actual confusion.

We turn first to a consideration of the marks. Applicant's mark is WILLPOWER PROJECT; the cited marks are WILL POWER and WILLPOWER. Obviously, the additional word PROJECT in applicant's mark creates a difference between its marks and the cited marks. However, we do not consider this difference to be sufficient to differentiate the

marks. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "That a particular feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark." 224 USPQ at 751. See also In re Dixie Restaurants Inc., supra. The word PROJECT, which applicant has disclaimed, is descriptive, and as shown by the numerous third-party registrations made of record by the examining attorney, has been adopted by many entities to indicate the nature of their goods and services.⁷ As a result, this term has little source-identifying significance.

Applicant has essentially taken the cited registrants' marks, WILLPOWER/WILL POWER, and added to this term the non-distinctive element PROJECT. In contrast to the case

⁷ See, for example, Registration No. 2142378 for THE 3:00 PROJECT; Registration No. 2949904 for THE LIGHTHOUSE PROJECT; Registration No. 3022973 for LIBERTY ALLIANCE PROJECT.

cited by applicant, Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970), in which PEAK and PEAK PERIOD were found to convey different connotations and commercial impressions, the additional word PROJECT in applicant's mark does not change the significance of WILLPOWER.

We have considered applicant's argument that "to Applicant's target LGBT audience, the term PROJECT relates to the struggle to obtain equality under the law," and that WILLPOWER PROJECT "connotes a large, organized and non-profit effort to empower the members of a community to plan their financial estates." Brief, p. 6. However, there is no evidence that the word "project," which is defined as "a piece of planned work or an activity which is completed over a period of time and intended to achieve a particular aim"⁸ or, according to applicant, a "planned undertaking,"⁹

⁸ Cambridge Advanced Learner's Dictionary. This definition was submitted by the examining attorney as part of the first Office action.

⁹ Applicant has recited definitions for "project" in its brief which it states come from Webster's Third New International Dictionary, 1986. The Board may take judicial notice of dictionary definitions, see 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), and we have done so here. However, normally a party asking the Board to judicially notice a definition would submit a copy of the dictionary page containing the definition.

would convey anything about a struggle to obtain equality under the law.

Applicant has also pointed to certain third-party registrations to show that the addition of the word PROJECT is sufficient to avoid confusion between two otherwise similar marks. These registrations include PROJECT STRATEGIX for "educational services, namely, classes, seminars, workshops and training in the field of project management," and STRATEGIX for "business consultation in the nature of diagnostic and analysis services utilizing customized measurement tools to identify total constituent behavior in a business"; PROJECT NEXT STEP for "educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of philosophy, religious literature and tradition, and tolerance," and NEXT STEP for "educational services, namely, providing lectures and conducting training workshops concerning alcohol and drug abuse" and "providing consulting services in the field of drug and alcohol abuse programs"; and PROJECT JUMPSTART for "consulting services in the field of business project management" and "educational services, namely, conducting training workshops in the field of business project management" and JUMPSTART for "educational services, namely, planning, arranging and conducting

seminars, conferences, and workshops in the field of career transitioning.”

We need not engage in an extended discussion of these third-party registrations. For some of the registrations, there are clear differences in the subject matter of the goods and services of the paired registrations that are not present in the instant case, as discussed infra. Nor do we know what transpired during the examination/prosecution of the applications that issued into these registrations. Most importantly, there is little persuasive value in the registration of different third-party registration pairs because the Board must assess each mark on the record of public perception submitted with the particular application that is the subject of the appeal. In *re* Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) In any event, the registrations are not evidence that the marks are in use, or that the public is familiar with them, see *In re* Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). Therefore, we cannot conclude, from the coexistence of the registrations on the Register of the U.S. Patent and Trademark Office, that the public distinguishes between similar marks simply on the basis of the addition of the word PROJECT.

Accordingly, comparing the marks in their entireties, we find that applicant's mark WILLPOWER PROJECT is very similar to the cited marks WILL POWER and WILLPOWER in appearance, pronunciation, connotation and commercial impression. Although applicant's mark has an element, PROJECT, that the cited marks do not have, it is not sufficient to distinguish the marks. The du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

This brings us to a consideration of the goods and services. It is not necessary that the goods or services of applicant and the registrants be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services 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 International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

We first compare applicant's goods and services with those of Registration No. 2708267 for "professional services, namely providing legal services in the nature of estate planning." Applicant's services are, in part,

"educational services, namely, conducting classes, seminars and workshops emphasizing the importance of estate planning for the gay, lesbian, bisexual and transgender community."¹⁰

The subject matter of both applicant's and the registrant's services is estate planning. Although applicant has focused its estate planning information on issues faced by people with particular sexual orientations, because the identification in the cited registration is not limited to a particular clientele, the registrant's services must also be deemed to encompass estate planning legal services for the gay, lesbian, bisexual and transgender community. Further, the examining attorney has made of record several third-party applications which show that entities have adopted a single mark for both educational services and legal services. See Registration No. 2866932 for educational services in the nature of conducting seminars on legal matters and legal services; Registration No. 2988171 for, inter alia, arranging and conducting

¹⁰ We recognize that applicant's services also include "educational services, namely conducting classes, seminars, workshops and training services for the purpose of certification of professionals in the field of estate planning, for the gay, lesbian, bisexual and transgender community." However, because likelihood of confusion will be found as to the entire class if there is likely to be confusion with respect to any item in that class, see *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981), we have limited our comments to the services which are most similar to applicant's services.

educational conferences, and legal services; Registration No. 2996174 for, inter alia, conducting classes, lectures and workshops in the field of building construction and legal services in transactional aspects of construction law. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, supra.¹¹

Further, the complementary nature of legal services in the field of estate planning and educational services in the field of estate planning is obvious. In addition to the subject matter of the services, both services have the same purpose, to assist consumers in recognizing and planning for estate issues. A consumer might, for example,

¹¹ Applicant has cited *In re H & H Products*, 228 USPQ 771 (TTAB 1986) as support for its statement that "the Board has long held that third-party registrations covering all the products in question are not very persuasive corroborating evidence in support of a finding of a likelihood of confusion absent evidence of sales or advertising." Brief, p. 12. The statement made in that decision was in a footnote, and it is not entirely clear to us, given the main text to which it applies, that the decision was requiring that in order to be probative, third-party registration evidence must always be corroborated by evidence of sales or advertising. In any event, we do not regard a statement in a footnote, in a decision which has not been cited in any subsequent cases, to outweigh 20-plus years of case law that states that third-party registrations may serve to suggest that such goods or services are of a type which may emanate from a single source, even without evidence of sales or advertising of the goods listed therein.

attend a class or seminar on the need for estate planning and then decide to seek legal services for estate planning.¹²

Because the registrant's legal services would include the general public who have need of estate planning, and applicant's classes, seminars and workshops on estate planning are directed to ordinary consumers (albeit those with a particular sexual orientation or those who, because of personal or business connections with gay, lesbian, bisexual and transgender individuals, would have an interest in estate planning issues for them), the same classes of consumers must be deemed to encounter both applicant's and the registrant's services. Such consumers who are aware of the registrant's estate planning legal services and who encounter applicant's seminars and the like on the topic of estate planning are likely to assume, because of the similarity of the marks, that both services emanate from or are sponsored by the same source.

Thus, when the complementary nature of the services, the third-party registrations and the manner in which

¹² The Statute also protects against reverse confusion, such that, if consumers who are familiar with applicant's educational activities and then encounter registrant's mark used in connection with legal services are likely to assume that the registrant's legal services are associated with the same source as the educational services, this would constitute likelihood of confusion.

consumers may encounter the services are taken into account, the du Pont factor of the relatedness of the services favors a finding of likelihood of confusion.

As for applicant's goods, again the various printed materials (certificates, workbooks, manuals and printed educational materials) are all for the subject matter of estate planning for the gay, lesbian, bisexual and transgender community, and this is the same subject matter of the registrant's identified legal services, since the identification must be deemed to include estate planning for clients of any sexual orientation. However, only one of the third-party registrations of record shows that a registrant has adopted a single mark for legal services and for course materials and education materials used in connection with their educational conferences, see Registration No. 2988171; further, we note that this registration is not for printed materials per se in Class 16, but only for printed course materials and education materials that are distributed in connection with the registrant's conferences. The examining attorney, pointing to attachments 1, 2, 3 and 4 of her brief, says that this evidence is "an advertisement offering estate planning services by a professional who provides legal services and related printable materials." Unnumbered p. 7 of brief

found in TTABVUE.¹³ Attachments 1 and 2 are, in fact, the two pages of Registration No. 2821568, and this registration is not for legal services. Attachments 3 and 4 are pages from a website for the law firm Bonnie A. Benson, P.A., and advertises Ms. Benson's areas of practice. Although we have carefully reviewed these pages, we find no information that the attorney provides "printable materials" in addition to her legal services. At best, we note that there are links to other websites, such as dictionaries, decisions of the Trademark Trial and Appeal Board, and the like, and presumably one can go to these links and print the information found on them. However, we consider this to be a far cry from showing that a firm that offers legal services also sells or provides printed materials. Although clearly the subject matter of the registrant's services and applicant's printed materials is the same, we cannot conclude, on the basis of a single third-party registration which limits its printed educational matter to materials distributed in connection with its seminars, that entities that offer legal services also sell or provide printed educational matter.

¹³ The attachments referred to by the examining attorney appear in the copy of the brief that is in the TICRS database, but not in the TTABVUE database.

As for Registration No. 2649830 for software for estate planning for individual consumers, it is clear from the examining attorney's brief that she considers these goods related only to applicant's printed materials in Class 16, and not to its services in Class 41,¹⁴ and we will therefore limit our consideration of the issue of likelihood of confusion to applicant's Class 16 goods. In support of her position, the examining attorney has pointed to a third-party registration, No. 2811339, which includes, inter alia, computer software for personal financial planning and estate planning and for printed educational and teaching materials in the field of estate planning. A second registration, No. 2821568, for the identical goods and owned by the same registrant, is also of record.

We cannot conclude from the activities of a single entity that computer programs and printed educational materials are related simply because, in this one instance, both types of goods emanate from a single source. Again, although we recognize that the goods have a similar purpose and subject matter, the evidence is insufficient to show

¹⁴ In connection with Registration No. 2649830, the examining attorney refers only to applicant's printed materials in the field of estate planning, and has referred to evidence which shows "the relatedness of applicant's goods to the registrant's, where the vendor provides both computer software and printed educational materials featuring estate planning." Unnumbered p. 7.

that companies that sell computer software for individuals to do estate planning also sell printed educational materials on estate planning. Accordingly, on this record, we find that the examining attorney has failed to show that the goods are related.

Thus, after considering the evidence of record, we find that the du Pont factor of the similarity of the services favors a finding of likelihood of confusion with respect only to applicant's educational services in Class 41 vis-à-vis the legal services in Registration No. 2708267. Although applicant's mark is similar to the marks in the cited registrations, we decline to find a likelihood of confusion with respect to applicant's goods because the Office has not demonstrated that the goods are related to the goods in Registration No. 2649830 or the services in Registration No. 2708267.

With respect to applicant's application for the identified services in Class 41 and Registration No. 2708267, we have considered applicant's arguments with respect to the du Pont factors of the conditions of purchase and the lack of evidence of actual confusion, but are not persuaded that they outweigh the factors of the similarity of the marks and the services. In fact, we do not regard the factor of no evidence of actual confusion as

favoring applicant. Applicant has claimed use of its mark only since May 2003. The record does not show the extent of applicant's usage of its mark, either in terms of the extent of its activities or their geographic scope. Nor do we have any information about the scope of registrant's activities, such that we could conclude that there has been sufficient contemporaneous use that there has been an opportunity for confusion to occur if it were likely to occur. Moreover, as the Court stated in Majestic Distilling, supra at 65 USPQ2d 1205, "the lack of evidence of actual confusion carries little weight."

As for the conditions of purchase, as stated previously, the consumers for both applicant's and the registrant's services are the general public. We agree with applicant that legal services in the field of estate planning would be chosen with care, although it is not as clear that those who decide to attend applicant's classes, seminars and workshops emphasizing the importance of estate planning for the gay, lesbian, bisexual and transgender community would exercise the same degree of care in making the choice to attend a class. In any event, even careful purchasers are likely to assume, because of the strong similarity of the marks and the relatedness of the

services, that the marks identify services emanating from or sponsored by or associated with the same source.

Finally, we also have taken into consideration that the owners of the two cited registrations and the owner of the cited registration that was withdrawn have all adopted the mark WILLPOWER, presumably because it is a clever play on words when used for goods and services related to estate planning. We do not regard this as an indication that Registration No. 2708267 is weak, but even if it were entitled to a more limited scope of protection, it would still extend to prevent applicant from registering the confusingly similar mark WILLPOWER PROJECT for the related services identified in applicant's application.

Decision: The refusal of registration with respect to applicant's services in Class 41 is affirmed on the basis of likelihood of confusion with Registration No. 2708267; the refusal of registration with respect to applicant's goods in Class 16 on the basis of likelihood of confusion with Registration No. 2780827, and the refusal of registration with respect to applicant's goods in Class 16 and services in Class 41 on the basis of likelihood of confusion with Registration No. 2649839, are reversed. After the period for appeal has expired, the application

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will be forwarded for publication for the goods in Class
16.