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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Marketing Tree LLC

Serial No. 78631229

Joan H. Lowenstein of Jaffe, Raitt, Heuer and Weiss for The Marketing Tree LLC.

Kelly Boulton, Trademark Examining Attorney, Law Office 112 (Thomas V. Shaw, Managing Attorney).

Before Grendel, Zervas and Wellington, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

The Marketing Tree LLC, applicant herein, seeks registration on the Principal Register of the mark THE MARKETING TREE (in standard character form; MARKETING disclaimed) for services recited in the application as

Advertising, marketing and promotion services; advertising services, namely, creating corporate and brand identity for others; advice in the field of business management and marketing;

arranging and conducting marketing promotional events for others; marketing consulting; providing business marketing information; development of marketing strategies and concepts; statistical evaluations of marketing data; direct marketing advertising for others; business marketing and direct mail consulting services; direct marketing services; cooperative advertising and marketing services by way of solicitation, customer service and providing marketing information via websites on a global computer network; business marketing consulting services; business consultation and management regarding marketing activities and launching of new products; services relating to the analysis, evaluation, creation and brand establishment of trademarks, trade names and domain names; concept and brand development for others in the field of business marketing; creation of marketing tools designed to increase a client company's knowledge of customer needs, and its competitors' products and services, pricing, advertising strategy and sales strategy; market research studies; market analysis; market research services; market manipulation, research and analysis, whether or not via the internet; conducting business and market research surveys; public relations; general business networking referral services, namely, promoting the goods and services of others by passing business leads and referrals among group members; referrals in the field of marketing and advertising; publicity and sales promotion services; business management consultancy as well as development of processes for the analysis and the implementation of strategy plans and management projects; business project management services for others; preparation and realization of media and advertising plans and concepts; advertising via billboards, electronic media and print advertisements; preparing business reports for others; production of radio and television commercials; and preparation of internet and print media advertisements

in class 35.¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as used in connection with the recited services, so resembles the mark MARKETTREE, previously registered (in standard character form) for services recited in the registration as "direct marketing services" in Class 35,² as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir.

¹ Serial No. 78631229, filed on May 17, 2005. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). April 26, 2005 is alleged in the application to be the date of first use of the mark anywhere. May 11, 2005 is alleged in the application to be the date of first use of the mark in commerce.

² Registration No. 3077768, issued on April 4, 2006.

2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Under the second *du Pont* factor (similarity or dissimilarity of the services), we find that the "direct marketing services" and "direct marketing advertising for others" identified in applicant's recitation of services are identical to the "direct marketing services" recited in the cited registration. The evidence of record also establishes that registrant's "direct marketing services" are similar and related to many of the other marketing services included in applicant's recitation of services. See the thirty-two third-party registrations made of record by the Trademark Examining Attorney which include in their respective recitations of services both applicant's types of services and registrant's "direct marketing services." Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Because applicant's services are in part identical to and otherwise similar and related to the services recited in the cited registration, we find that the second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor (similarity or dissimilarity of trade channels), we find that applicant's trade channels and registrant's trade channels are identical to the extent that the services themselves are identical, i.e., "direct marketing services." We also find that the trade channels for the other marketing services recited in applicant's application are similar to and closely related to the trade channels for registrant's direct marketing services. There are no limitations or restrictions in either applicant's or registrant's recitation of services, so we must presume that the respective services are marketed in all of the normal trade channels and to all the normal classes of purchasers for such services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We find that the normal trade channels for applicant's and registrant's highly similar and related services are overlapping. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 terms of their overall commercial impression that confusion as to the source of the services 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 and service marks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, in cases such as this, where the applicant's services are in part identical to the opposer's services, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's mark is THE MARKETING TREE. The cited registered mark is MARKETTREE. In terms of appearance,

we find that the marks are similar to the extent that they both include some form of the word MARKET and the word TREE. The marks are not identical in appearance due to the fact that the registered mark is a compound word and applicant's mark is not, and to the extent that applicant's mark includes the inconsequential word THE. On balance, however, we find that the marks look very similar.

In terms of sound, we find that the marks are highly similar. Indeed, the marks sound the same except for the word THE and the extra syllable "-ing" in the middle of applicant's mark. Those points of dissimilarity are greatly outweighed by the overall aural similarity between the marks.

In terms of connotation and overall commercial impression, we find that the marks are similar. Both include the word MARKET or a formative thereof, as well as the word TREE. As applied to the marketing services at issue in this case, the two marks mean essentially the same thing and they present essentially the same commercial impression.

Viewing the marks in their entireties, we find that they are similar and likely to cause confusion when used in connection with the identical and highly similar

services involved in this case. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The sixth *du Pont* factor requires us to consider evidence of third-party use of similar marks in connection with similar services. We find that there is no such evidence in this case. Applicant asserts that there are numerous third-party registrations and applications for MARKET marks and TREE marks in connection with marketing services. However, applicant has failed to provide any competent evidence to support that assertion. Moreover, even if applicant had provided such evidence (i.e., copies of the entire registrations or electronic equivalents thereof from the Office's database), it is settled that third-party registrations (much less third-party applications) are not evidence of third-party use and thus are not probative evidence under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In the absence of evidence of third-party use, we find that the sixth *du Pont* factor is neutral in this case.

For the reasons discussed above, and considering all of the evidence of record pertaining to the *du Pont*

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factors, we conclude that a likelihood of confusion exists. Applicant's mark is very similar to the cited registered mark, and applicant's services are identical in part and otherwise closely related to the services recited in the cited registration. We have no doubt that confusion is likely.

Decision: The refusal to register is affirmed.