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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MackTrack Inc.

Serial No. 78665858

Melissa Georges of Frankfort Kurnit Klein & Selz P.C. for
MackTrack Inc.

Tashia A. Bunch, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Rogers, Drost, and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 7, 2005, MackTrack Inc. (applicant) filed an
intent-to-use application to register the mark WEALTHTRACK
(in standard character form) on the Principal Register for
goods in Class 16 identified as "Books, newsletters and
syndicated newspaper columns in the field of finances,
financial advice, investing and money management."

The examining attorney¹ refused to register applicant's mark because of a registration of the mark WEALTHTRAX (in standard character form) for "education, namely wealth creation and wealth preservation seminars, workshops and study courses" in Class 41.²

The examining attorney argues that "both marks share the same terms or phonetic equivalent terms, namely, WEALTH and TRACK, to identify goods and services in the financial field. As such, the marks project the same connotation and meaning." Brief at unnumbered p. 4. Regarding the relatedness of the goods and services, the examining attorney argues that "[t]hose that offer wealth creation and preservation course often publish books and printed matter giving financial advice." Brief at unnumbered p. 6.

In response to the refusal, applicant argues that: "The two marks neither look nor sound alike" and "Consumers seeing and hearing the two marks will be able to perceive the differences between the two." Brief at 4. Furthermore, "Registrant continually emphasizes the dominant TRAX portion of its mark, and has in fact, developed a family of TRAX marks, making that portion of

¹ The current examining attorney was not the original examining attorney in this application.

² Registration No. 2910127 issued December 14, 2004.

the mark a source identifier." *Id.* Regarding the goods and services, applicant argues that the marketing "conditions surrounding these slightly related goods and services are quite distinct. As noted above, Registrant markets its services using various TRAX marks, including the Registered Mark at issue. Further, unlike Registrant, Applicant is not offering wealth creation or preservation seminars." Brief at 7.

After the examining attorney made the refusal final, this appeal followed.

Before discussing the issue of likelihood of confusion, we must briefly address some questions regarding evidence that applicant attached to its brief. The examining attorney objects to the inclusion of a Notice of Allowance for applicant's pending application (Serial No. 78665870)³ and specimens from the cited registration.⁴ We agree that this evidence is untimely and we will not rely on it. 37 CFR § 2.142(d).

In likelihood of confusion cases, we must consider the evidence as it relates to the factors set forth in *In re*

³ We note that the Office's electronic records now indicate that this Notice of Allowance has been withdrawn.

⁴ As explained subsequently, the manner in which registrant has used its mark in the past or currently does not limit our likelihood of confusion analysis in this proceeding.

E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), keeping in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is whether the marks, in their entireties, are similar in sound, appearance, connotation, and commercial impression. *du Pont*, 177 USPQ at 567. See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

Here, the marks are WEALTHTRACK and WEALTHTRAX; neither is depicted with any stylization. They are identical to the extent that they both begin with the identical term "Wealth" and then they add a second term without a space between the words. The second terms begin with the identical three letters, "TRA." The only difference is the fact that applicant's mark ends with the letters "CK," while registrant's ends with an "X." Despite this difference in spelling, the terms WEALTHTRACK and WEALTHTRAX would be pronounced almost identically. The

only difference would be that registrant's mark would be pronounced like the plural of applicant's mark. Applicant argues that the plural/singular difference results in marks for which consumers "will be able to perceive the differences." Brief at 4. This slight difference in pronunciation, which results from the singular and plural pronunciations of the marks, would not result in any significant differences because the marks would be pronounced almost the same. *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word "Zombie" and they will therefore be regarded here as the same mark"). In appearance and commercial impression, the marks are also extremely similar and, again the slightly different endings would not give consumers much of a basis to distinguish the marks. To determine if there is a likelihood of confusion, a "[s]ide by side comparison is not the test." *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Our "focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 (TTAB 2004).

Here, the use of singular and plural forms of the phonetically equivalent term "wealth track" does not constitute use of terms with markedly different appearances or commercial impressions. *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("There is little room to debate the similarity between ROPELOCK and ROPELOK in appearance"). In addition, the meaning of the two marks would be virtually identical. Both marks would mean "track(s) to wealth."

Therefore, when we consider the marks WEALTHTRACK and WEALTHTRAX in their entireties, we conclude that they are very similar.

Next, we look at the relatedness of the goods and services. It has long been held that when we compare the goods and services, we must consider them as they are described in the identifications of goods and services in the application and registration. *Octocom Systems Inc. v. Houston Computer Services*, 918 F.2d 937, 942, 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 set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers

to which sales of the goods 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).

More specifically, we do not read limitations into the identifications of goods and services. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Therefore, we will not consider applicant's argument (Brief at 7) that registrant only "markets its services using various TRAX marks." See *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977) (Registrant's rights "are not to be tied into its current business practices, which may change at any time"). The fact that registrant owns other trademarks does not limit the scope of protection the cited mark is entitled to in this proceeding.

Also, while applicant points out that the "respective marks are also within different trademark classes" (Brief at 6), this has no bearing on the outcome here. The trademark classification system is "for convenience of Patent and Trademark Office administration, but not to

limit or extend the applicant's or registrant's rights."

15 U.S.C. § 1112.

While applicant admits that the goods are "generally related" (Brief at 8), it nonetheless argues that they are "quite different." The board has set out the following points to consider when determining whether goods and services are related:

It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services."

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney has introduced evidence to attempt to demonstrate that publications and educational services in the financial field are registered under a common mark. Pertinent registrations with the relevant portions of the identifications of goods and services are set out below.

No. 2329908

Ser No. 78665858

Quarterly printed newsletters and printed educational brochures featuring financial, estate and tax planning, investment, and management advice

Providing educational seminars featuring financial, estate and tax planning, investment, and management advice

No. 3055889

Newsletters and informational flyers featuring information in the fields of food and health, insurance, transportation, housing, vacations, clothing, personal finance, and vehicle and home repair and maintenance

Educational services, namely, conducting classes and seminars in the field of financial planning, and cash and debt management and distributing course materials in connection therewith; individual training services in the field of financial planning, and cash and debt management

No. 2952683

Printed materials, namely, newsletters and bulletins promoting the interests of mature individuals and in the fields of retirement, mature or retired lifestyles, finance, health, insurance, medicine, aging and family relationships

Arranging and conducting seminars and conferences promoting the interests of mature individuals and in the fields of retirement, mature or retired lifestyles, finance, health, insurance, medicine, aging and family relationships; and distribution of course materials

No. 3037569

Newsletters in the fields of finance and investments; printed informational and educational materials in the areas of investing, investments, financial strategies and planning, and asset management

Educational services, namely, providing seminars to individual investors about investing, investments, financial strategies and planning, and asset management

No. 2974699

Pamphlets, books, course books, newsletters, studies, brochures, and guidebooks, all pertaining to the [sic] investing and finance

Educational services, namely, conducting classes, seminars, conferences, workshops and online exhibitions, displays and interactive exhibits in the field of finance, investments, loans, securities, bonds, stocks, mutual funds, and financial markets and providing course materials in the nature of booklets, manuals, books, workbooks, worksheets, examples and online web pages and content distributed in connection therewith

No. 2907592

Printed instructional, educational and teaching materials for specialized coursework in industry specific areas, namely finance, travel and tourism and information technology industries

Providing educational services, namely, conducting seminars, internships and courses in industry specific areas, namely, finance, travel and tourism and information technology services

The examining attorney also included the following website information that shows the same individual providing publications and educational services in the field of wealth creation.⁵

⁵ We find less relevant two Australian authors who also give seminars on wealth creation apparently only in Australia. www.motivatedmoney.com.au (Peter Thornhill) and www.moneybags.com.au (Peter McDonald, former CEO of Taxpayers' Australia). *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark"). Another site (www.questlive.com) only features a wealth creation seminar and a guest speaker who wrote a book about the energy crisis. There is no indication that the speaker's book is associated with the seminar's sponsor.

Marc Allen's Success With Ease Seminars, Books, and Audios

Is it possible to have success with ease? Is it possible to be successful - doing what you love to do - and still have plenty of time for what matters most to you in your life?

...

Marc Allen is internationally known for his seminars, books, audio programs, and music. He can show you how to attain financial success by doing what you love to do.

www.marcallen.com.

The registrations and internet evidence support the examining attorney's position that the goods and services of applicant and registrant are related. See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988)

(Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

We find that the registrant's services of offering seminars and other educational services in the field of finance are related to publications in the same field. Consumers seeking financial advice are likely to be potential purchasers of both applicant's books and

registrant's services. Purchasers who are familiar with registrant's WEALTHTRAX seminars to create and preserve wealth are likely to believe, when they encounter applicant's WEALTHTRACK publications on finances, financial advice, investing and money management, that the sources of these goods and services are related or associated in some way.

Therefore, we conclude that under these circumstances, confusion is likely if applicant were to use its WEALTHTRACK mark for its identified goods in view of the registrant's mark WEALTHTRAX for its identified services.

Decision: The refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.