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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re United Data Technologies, Inc.

Serial No. 78802358

Stewart L. Gitler of Hoffman, Wasson & Gitler, P.C. for
United Data Technologies, Inc.

Evelyn Bradley, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Walsh and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by United Data Technologies,
Inc. to register on the Principal Register the mark YOUR
TRUSTED TECHNOLOGY ADVISORS in standard characters for
"information technology consultation in the field of
selection, implementation and use of computer hardware and
software" in International Class 42.¹

¹ Application Serial No. 78802358 was filed on January 30, 2006,
based on applicant's assertion of January 1, 2005 as the date of
first use of the mark in commerce. Applicant disclaimed the
exclusive right to use "TECHNOLOGY ADVISORS" apart from the mark
as shown.

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 its services, so resembles the following marks, previously registered to the same registrant on the Principal Register:

YOUR TRUSTED ADVISOR

in typed or standard characters for "providing technical advice and consulting services in the field of disasters involving damage to high-technology equipment to attorneys, insurance companies and property owners" in International Class 42;² and



for "consultation in the field of disaster recovery and computer equipment failure; litigation consultation that consist [sic] of offering expert opinions to the cause of failure, nature and extent of damage, and cost to repair and/or replace equipment damaged through equipment failure and disasters; and consultation in the field of computer data recovery resulting from equipment failure and disaster" in Class 42,³ as to be likely to cause confusion.

² Registration No. 2754044, issued on August 19, 2003.

³ Registration No. 2960464, issued on June 7, 2005.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, in any likelihood of confusion analysis, two key, though not exclusive, 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, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's mark and registrant's marks are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot*

Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that 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 goods or 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). We further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, YOUR TRUSTED TECHNOLOGY ADVISORS, incorporates in its entirety the mark, YOUR TRUSTED ADVISOR, in Registration No. 2754044. As a result, the marks are highly similar in appearance and sound. Further, both marks connote that consumers may trust the advice offered by applicant and registrant. Thus, the marks convey highly similar connotations. The

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addition of the descriptive term TECHNOLOGY to applicant's mark does not create a connotation that is distinct from that of registrant's YOUR TRUSTED ADVISOR mark. Rather, applicant's mark suggests that it is a trusted advisor in the field of technology. As a result, consumers are likely to believe that registrant simply has utilized a more specific mark with regard to technology related services. That is to say, consumers are likely to view the marks as variations of each other that both point to the same source. The marks thus convey highly similar commercial impressions.

Turning to the mark



in Registration No. 2960464, again applicant's YOUR TRUSTED TECHNOLOGY ADVISORS mark incorporates in its entirety the wording YOUR TRUSTED ADVISOR in registrant's mark. For the reasons discussed above, such wording is highly similar in appearance, sound and connotation. The presence of LWG and the simple curved line design in registrant's mark, while adding to the overall commercial impression thereof, does not diminish the fact that applicant has appropriated the words YOUR TRUSTED ADVISOR in such mark. Further for the

reasons discussed above, applicant's YOUR TRUSTED TECHNOLOGY ADVISORS mark appears to be a variation of registrant's LWG YOUR TRUSTED ADVISOR and design mark to designate services directed toward providing advice in the field of technology. In other words, consumers are likely to view both marks as variations of each other, and therefore as indicators of a single source. Thus, despite the fact that registrant's mark includes LWG and a curved line design, the marks are highly similar in appearance, meaning, connotation and commercial impression.

In view of the similarities between applicant's mark and the marks in the cited registrations, this *du Pont* factor favors a finding of likelihood of confusion.

The Services

Turning now to consideration of the recited services, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the services at issue 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 instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the 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).

In this case, the examining attorney has made of record a number of use-based, third-party registrations which show that various entities have adopted a single mark for services that are identified in both applicant's application and the cited registrations or closely related thereto. See, for example:

Registration No. 3030276 for, *inter alia*, computer consultation services in the field of design, selection, implementation and use of computer hardware and software for others, computer services, namely, data recovery services and creating indexes of information, sites and other resources available on computer networks, computer disaster recovery planning;

Registration No. 3135246 for, *inter alia*, computer disaster recovery planning, consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others;

Registration No. 3260887 for, *inter alia*, computer disaster recovery planning, consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; and

Registration No. 3337428 for, *inter alia*, computer consultation, computer disaster recovery planning, consultation services in the fields of

selection, implementation and use of computer hardware and software systems for others.

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.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

In addition, the examining attorney has submitted evidence from informational and commercial Internet sites suggesting that the same entities provide both applicant's and registrant's types of services. The following samples are illustrative:

Spellings Consulting is prepared to serve all your IT needs. Our services include:
Firewall implementation
Install and configure new hardware/software
Consultation on New Hardware/Software Purchases
VPN/Remote Access Implementation
Anti-Spam Software Implementation
Antivirus Software Implementation
Cyber-Security & Physical Security Implementation & Consultation
Data Back-up/Disaster Planning & Recovery
Data Recovery
(www.spellingsconsulting.com); and

Alexander Open Systems
Key Business Activities:
Total or custom solutions that include hardware and software
Network/Infrastructure Design and Implementation
Disaster Recovery/Business Continuity
IT-Related Services Offered:

Consulting Services (i.e.: Professional, project management, integration)
Hardware Services (Maintenance, Support and/or Contracts)
Software Services (Maintenance, Support and/or Contracts).
(www.crn.com).

The evidence of record supports a finding that the same marks are used to identify both applicant's services and those of registrant. The evidence further supports a finding that the same entities provide services of the type identified both in the involved application and cited registrations. This evidence demonstrates the related nature of the services at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

Furthermore, we are not persuaded by applicant's arguments that its customers differ from those of registrant or that registrant's services travel in channels of trade that are separate and distinct from those in which applicant's services may be encountered. It is settled that in making our determination regarding the relatedness of the parties' services, we must look to the services as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 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 the sales of 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.")

In this case, there are no restrictions in applicant's recitation of services as to the channels of trade in which the services may be encountered, or type or class of customer to which the services are marketed. Nor are there any such restrictions in the recitation of services in cited Registration No. 2960464. As a result, these services must be presumed to move in all normal channels of trade therefor and be encountered by all typical classes of purchasers, including consumers of each others' services. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). While cited Registration No. 2754044 indicates that the services recited therein are directed toward "attorneys, insurance companies and property owners," there is no evidence of record that these trade channels are so exclusive that they

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are not included among the unlimited channels of trade in which applicant's services are presumed to be encountered. Further, and as noted above, it is not necessary for the services to be directly competitive or move in the same trade channels to support a finding of likelihood of confusion. See *In re International Telephone & Telegraph Corp.*, *supra*.

Thus, while applicant argues that registrant's services are directed toward "disaster recovery assistance, rather than IT system network design" (brief, unnumbered p. 2), neither its recitation of services nor that in Registration No. 2754044 contain any such limitations. In addition, the trade channels for applicant's unlimited recitation of services are presumed to include the more narrowly defined trade channels in Registration No. 2960464.

As a result, applicant's services are presumed to move in the same channels of trade as the services recited in Registration No. 2754044, and encompass the channels of trade recited in Registration No. 2960464, and this *du Pont* factor also favors a finding of likelihood of confusion.

Strength of the Cited Marks

Finally, applicant argues that registrant's marks are weak and entitled to a limited scope of protection. In

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support of this contention, applicant has made of record printed copies of twenty third-party registrations taken from the United States Patent and Trademark Office's (USPTO) Trademark Applications and Registrations Retrieval (TARR) database, containing the words TRUSTED ADVISOR alone or in context with other words and designs for various goods and services. Included are the following:

Registration No. 3102238 for TRUSTED ADVISOR for "real estate brokerage; real estate mortgage banking and mortgage lending services;"

Registration No. 3094466 for THE TRUSTED ADVISOR for "newsletters in the filed of mortgages and real estate;"

Registration No. 2608045 for the mark TRUSTADVISOR for business consultation and information services on the subject of security and monitoring of data in the fields of authentication, privacy, and confidentiality of data on a computer web site; computer services, namely, providing information and data bases for security and monitoring of data in the fields of authentication, privacy, and confidentiality of data on a global communication network; computer software development services for others; computer consultation services; rating of web sites, businesses and individuals for the security of data and monitoring the privacy, authenticity and confidentiality of data on a computer web site;

Registration No. 2089878 for the mark TRUSTED ADVISORS for "financial and tax planning services;"

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Registration No. 3123205 for the mark TRUSTED BROADBAND ADVISOR PROGRAM for "business marketing services;" and

Registration No. 2433459 for TRUSTED ADVISORS TO TRUSTED ADVISORS for "employment counseling and recruiting, namely, executive search consultant services."

However, applicant's evidence of third-party registrations is entitled to limited probative value.⁴ The registrations are not evidence of use of the marks shown therein. As a result, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *See 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). Thus, while applicant's proffered third-party registrations indicate that the USPTO has registered a number of "TRUSTED ADVISOR" formative marks in relation to various services, most of which are financial services unrelated to those in the involved application or cited registrations, such evidence fails to establish that the consuming public has been exposed to third-party use of similar marks on similar

⁴ Applicant's evidence also included copies of the registrations cited herein.

services, such that consumers would distinguish applicant's mark from the cited marks based on the very minor differences between them.

Third-party registrations also may be used in the manner of dictionary definitions to show that a term has a certain significance in a particular field. The registrations made of record by applicant show that the concept of having an advisor one may trust has a positive connotation particularly in the financial field. However, and as noted above, financial services are not related to the computer and technology focused consulting services recited in the involved application and cited registrations. Even if the third-party registrations relied upon by applicant were evidence of use - and they are not - such registrations would only be evidence that TRUSTED ADVISOR is a weak term in the field of financial services, and not in the fields of computer and high-technology consulting where only the cited marks contain such wording. Furthermore, if we were to conclude, based on applicant's evidence, that registrant's mark is entitled to a more narrow scope of protection than a totally arbitrary mark, the scope is still broad enough to prevent the registration of a highly similar mark for services that are highly similar to the services identified in the cited

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registrations. See *In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

Summary

In light of the foregoing, and resolving any doubt as we must in favor of the prior registrant, we find that a likelihood of confusion exists between the applied-for mark and the mark in the cited registrations. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal of registration is affirmed.