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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fiduciary Asset Management, LLC

Serial No. 78959263

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Before Seeherman, Kuhlke and Bergsman, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On August 24, 2006, Fiduciary Asset Management, LLC
applied to register the mark FAMCO (in standard character
form) on the Principal Register based on a bona fide
intention to use the mark in commerce under Section 1(b) of
the Trademark Act, 15 U.S.C. §1052(b), for services
identified as "cost control, namely, cost containment in
the field of fund investment and investment portfolio
construction" in International Class 35, and "financial
investment services, namely, financial management of

Serial No. 78959263

investments; fund investment consultation; investment consultation; investment advice; funds investment; financial analysis and consultation; providing information on the topics of fund investment consultation, investment consultation, investment advice, funds investment, financial analysis and consultation via a global computer network; investment portfolio construction; financial risk management; mutual fund investment; and providing information in the field of mutual funds and mutual fund investment; mutual fund investment consultation, advice and analysis; risk management, risk management consultation; and financial analysis and consultation, namely, macroeconomic analysis strategy" in International Class 36.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified services, so resembles the registered mark FAM (in standard character form) for "investment management and financial research services," in International Class 36, as to be likely to cause confusion, mistake or deception.¹

Applicant has appealed the final refusal and the appeal is fully briefed. We affirm the refusal to register.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out 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 (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 services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With regard to the services, registrant's "investment management and financial research services," if not identical, encompass applicant's International Class 36 services which include "financial management of investments; fund investment consultation; investment consultation; investment advice; funds investment; financial analysis and consultation." In addition, registrant's "investment management services" encompass applicant's International Class 35 services "cost containment in the field of fund investment and investment portfolio construction." *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

¹ Registration No. 3110595, issued June 27, 2006.

question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Furthermore, inasmuch as registrant's services encompass applicant's services, we must presume that the purchasers and channels of trade for such services would also overlap. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' foods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). Finally, applicant has not presented evidence to support any argument that the services, as identified, are not related.

In view of the above, the du Pont factors of the relatedness of the services, the channels of trade, and

class of customers favor a finding of likelihood of confusion as to the cited registration.

In determining the similarity between the marks we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567. While it is a basic principle that "marks must be compared in their entirety...[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Finally, where as in the present case, registrant's services encompass, at least in part, applicant's services, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant argues that the examining attorney impermissibly dissected the marks in her comparison analysis. Applicant asserts that when taken as a whole the differences in the marks are sufficient to avoid confusing

similarity. In particular, applicant highlights that its mark consists of five letters in comparison to registrant's three letter mark and that applicant's mark "tends to be viewed as a word that one says completely at once while the registrant's mark, with only three letters, is easier to say as separate letters." Br. p. 13.

It is well established that there is no correct pronunciation of a mark and we must consider any possible pronunciation including those that are more similar, such that the only difference would be the CO sound on the end of applicant's mark. *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985). Thus, because applicant has incorporated the entirety of registrant's mark, there is some similarity in sound and appearance.

In terms of connotation, applicant argues that the examining attorney has not presented evidence to support her allegation that consumers would perceive the CO suffix of applicant's mark as meaning the abbreviation for the word "company." Given the widely known meaning of CO as the abbreviation for the word company, *The American Heritage Dictionary of the English Language* (4th ed. 2000),²

² The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

and that applicant is a limited liability company, we find that some consumers would perceive the CO portion of applicant's mark as the abbreviation of the word company and thus of little source-indicating significance.

However, even for those consumers who do not view the "CO" portion as meaning company, the marks remain highly similar inasmuch as it is the first portion of a mark that is likely to make an impression on a consumer, and applicant's first portion incorporates the whole of registrant's mark. See *Palm Bay*, 73 USPQ2d at 1692; *Mattel Inc. v. Funline Merchandise Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). The addition of two letters to the end of applicant's mark is not sufficient to distinguish the marks, in particular, given the highly related nature of the services. See *Schering Corp. v. Alza Corp.*, 207 USPQ 504 (TTAB 1980) (CHRONOMER and CHRONOTAB confusingly similar).

In view of the above, the factor of the similarity of the marks weighs in favor of a likelihood of confusion.

Applicant relies heavily on its argument that its consumers are "highly sophisticated and careful purchasers" because "[t]he purchase being made by Applicant's consumer requires a great deal of money and is not one that a

purchaser enters into whimsically..." Br. p. 15.

Applicant further contends that its purchasers are "apt to spend close to, if not more than, a million dollars in a single transaction [and] ... are in frequent contact with Applicant as the decisions are ones that carry great weight and require approval from the consumer." Id. In addition, applicant asserts that its consumers "would very likely consult additional outside counsel such as an attorney, accountant or other professional, before deciding to proceed with a purchase." Br. 16.

While we agree that purchases of applicant's services are not casual purchases, we cannot agree that all of the potential purchasers are necessarily sophisticated. Despite what may actually be the case, applicant's identified services are not limited to those who would be considered sophisticated purchasers, e.g., institutional customers, but would include the general public seeking investment advice who would be ordinary purchasers. Obviously, this is not an impulse purchase but even careful purchasers are likely to be confused by similar marks. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human

memories even of discriminating purchasers ... are not infallible.'" In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) quoting Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Therefore, the fact that the purchasers may exercise care before purchasing these services does not mean there can be no likelihood of confusion.

The cases cited by applicant where the sophistication of the purchasers weighed heavily against a likelihood of confusion are distinguishable on their facts. In In re Digirad Corp., 45 USPQ2d 1841 (TTAB 1998), the Board held there was no likelihood of confusion based on the evidence of record submitted by applicant that established the differences in the relevant purchasers of the goods, the sophistication of those purchasers, the care with which the products are purchased, and the expense thereof. In this case, applicant has not put in evidence to support its allegations that all of its transactions involve "close to a million dollars" or that its customers consult legal counsel in their purchasing decision. Moreover, unlike Digirad, where because of the very nature of the goods they were expensive and purchased by sophisticated purchasers, here applicant's services, as identified, could be

purchased by ordinary consumers who wish to make even a modest investment.

Similarly, in the case of *American Optical Corp. v. Atwood Oceanics, Inc.*, 180 USPQ 532 (TTAB 1973), there was evidence of record that supported the manner in which goods of the type identified in the subject application were sold and the sophistication of the potential purchasers. While the relative sophistication of the potential consumers and purchaser care are relevant considerations, they are not controlling in this case.

Finally, applicant submitted a few sets of third-party registrations "where the same starting letters are shared and one registrant was allowed to register those shared letters with the addition of CO." Br. p. 12. Applicant argues that "[t]hese registrations...are notable examples of the recognition by the Trademark Office of the ability of consumers to discern between marks distinguished by the CO portion of the mark and the associated goods and services." Id.

As noted by the examining attorney, the Board is not bound by decisions made in other applications. See *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). See also *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Each case must be decided on its own facts. AMF

Serial No. 78959263

Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). This is not, as applicant suggests, "code for the proposition that precedent and uniformity has no place here," but rather a recognition that the Board is not privy to information resulting in allowance of prior registrations (for example possible consent agreements) and/or that possible prior mistakes by the Office are not a proper basis upon which to register a confusingly similar mark.

In conclusion, we find that because the marks are similar, the services are related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark for its identified services and the mark in the cited registration.

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