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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87882281

Mark: ASK JIM FIRST

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Reference/Docket No. 1075512

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant James Kelleher has appealed the trademark examining attorney's final refusal to register his proposed trademark, ASK JIM FIRST, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the basis of a likelihood of confusion with U.S. Registration No. 3289118.

I. FACTS

Applicant applied to register the mark ASK JIM FIRST (in standard characters) for services, which as amended, are: "Lawyer referral services provided to consumers who seek to retain an attorney to

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represent them in personal injury matters excluding business advice, inquiries and information services" in International Class 35. Registration was initially refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on a likelihood of confusion with the marks in U.S. Registration Nos. 2151373 and 3289118. Following cancellation of U.S. Registration No. 2151373, the refusal as to U.S. Registration No. 3289118 for the mark ASK JIM (in standard characters) for "business advice, inquiries or information" in International Class 35 was made final on February 8, 2019 and applicant's first request for reconsideration dated May 1, 2019 was denied. Applicant submitted a second request for reconsideration on July 23, 2019 and filed the instant appeal on July 24, 2019. The instant application was reassigned to the undersigned trademark examining attorney and a motion to remand dated November 7, 2019 was filed by the trademark examining attorney requesting suspension of the appeal and remand of the application for submission of new evidence. Following the Board's grant of the motion to remand, the trademark examining attorney issued a subsequent final refusal of the applicant's mark under Section 2(d). This appeal follows the trademark examining attorney's subsequent final refusal under Section 2(d) and denial of applicant's third request for reconsideration dated April 20, 2020.

II. ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of

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similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

A. ASK JIM FIRST and ASK JIM are Similar Marks

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In the present case, applicant's mark is ASK JIM FIRST in standard characters and registrant's mark is ASK JIM in standard characters. A comparison of the marks show they are similar in appearance, sound, connotation, and overall commercial impression.

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The applied-for mark merely adds the wording "FIRST" to the end of the registrant's mark. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). Thus, the marks are identical in part as to the wording "ASK JIM".

Applicant argues that the marks are not similar because of the addition of the wording "FIRST" to applicant's mark. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34). In this case, the addition of the wording "FIRST" does not obviate the likelihood of confusion because the additional wording appears at the end of the wording that the applied-for mark shares with the registered mark, namely, "ASK JIM". Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir.

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