

This Opinion is not a
Precedent of the TTAB

Oral Hearing: February 9, 2022

Mailed: March 31, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re J. Spagnuolo & Associates, P.C.
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Serial No. 88789548
—

Dean W. Amburn of Amburn Law PLLC,
for J. Spagnuolo & Associates, P.C.

Kyle Ingram, Trademark Examining Attorney, Law Office 125,
Heather Biddulph, Managing Attorney.

—
Before Lykos, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

J. Spagnuolo & Associates, P.C. (“Applicant”) seeks registration on the Principal



Register of the mark **MACOMB LAW GROUP** (“Macomb Law Group”
disclaimed) for:

Legal services; Providing customized legal information, counseling, and advice, and litigation services in the field of tort law in International Class 45.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on likelihood of confusion with the mark MLG AUTOMOTIVE LAW (in standard characters, "automotive law" disclaimed) for:

Legal consultation services; Legal consulting services in the field of automotive related legal cases; Legal services in International Class 45.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. An oral hearing was held.

We reverse the refusal to register.

¹ Application Serial No. 88789548 was filed on February 7, 2020, based upon Applicant's claim of September 1, 2017 as its first use anywhere date and January 30, 2018 as its first use in commerce date under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). As described in the Application, "the mark consists of the stylized literal element 'MLG' overlaid by the scales of justice design with MACOMB LAW GROUP written below the scales of justice design. The letter L is positioned in the middle of M and G and it is slightly lower than M and G. The scales of justice include a horizontally curved beam that is resting on the top portion of the L as its central pivot point and it is extended over the center of the M and G. Scales are seen hanging from the ends of the curved beam proximate to the M and G. Color is not claimed as a feature of the mark."

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; after this designation are the page references, if applicable. Applicant's brief is at 6 TTABVUE. The Examining Attorney's brief is at 8 TTABVUE. Applicant's reply brief is at 9 TTABVUE.

² Registration No. 4699169, issued March 10, 2015; Section 8 accepted and Section 15 acknowledged.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address a few evidentiary matters.

The Examining Attorney objects to consideration of third-party registrations attached to Applicant's appeal brief as exhibit B. These registrations were not submitted during prosecution.

Because the third-party registrations in exhibit B were not previously submitted, the Examining Attorney's objection is sustained and the third-party registrations in exhibit B will not be considered. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (evidence "submitted with Applicant's appeal brief that Applicant did not previously submit during prosecution is untimely and will not be considered."), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019)). *See also* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.").

Applicant also submitted with its appeal brief third-party registration evidence (exhibit A) and website evidence (exhibit C) that it already provided in its October 28, 2020 Response to Office Action at TSDR 8-35. While obviously admissible, the Board discourages this practice. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) ("[T]he Board discourages attaching such material to briefs. ... [I]t is far more helpful to identify, by the date of submission and the page numbers in the Office's [TSDR] database, the material which is referred to in a brief."); *In re Thor Tech Inc.*,

85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from the record to a brief is duplicative and unnecessary).

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors and others for which there is evidence and argument are discussed below.

A. Similarity or Dissimilarity of the Services

We first consider the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. *See also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d

1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). The goods or services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods [or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). It is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified goods or services within that class in the application or cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

During prosecution and in its brief, Applicant argued that the legal services are different because Applicant is providing tort law services and Registrant’s legal services focus on automotive law. 6 TTABVUE 22.

Applicant’s services are identified as “Legal services; Providing customized legal information, counseling, and advice, and litigation services in the field of tort law,” and Registrant’s services are identified as “Legal consultation services; Legal consulting services in the field of automotive related legal cases; Legal services.”

Applicant’s and Registrant’s “legal services” are legally identical. Registrant’s “legal consultation services” encompass Applicant’s more narrowly defined

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