

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: March 26, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Bennett Law Office, PC  
v.  
Burrus Intellectual Property Law Group

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Opposition No. 91177164  
to Application No. 78900688  
filed on June 5, 2006

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Tamera H. Bennett, Esq. for Bennett Law Office, PC.

Philip H. Burrus, Esq. for Burrus Intellectual Property Law  
Group.

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Before Walters, Cataldo and Bergsman, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Bennett Law Office, PC filed its opposition to the  
application of Burrus Intellectual Property Law Group to  
register the standard character mark "YOU CREATE. WE  
PROTECT." for "legal services," in International Class 42.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78900688, filed June 5, 2006, based upon use of  
the mark in commerce, alleging dates of first use and use in commerce as  
of August 1, 2005.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services so resembles opposer's previously used and registered stylized mark ©REATE P®OTECT and the previously used standard character mark CREATE PROTECT for "legal services"<sup>2</sup> as to be likely to cause confusion, under Section 2(d) of the Trademark Act.<sup>3</sup>

Applicant, in its answer, denied the salient allegations of the claim. Although not affirmative defenses, applicant included in its answer several amplifications upon its position.

#### *The Record*

The record consists, in part, of the pleadings and the file of the involved application. The parties stipulated to submission of witness testimony by affidavit, and the following evidence is of record by opposer's notice of reliance during its main trial period:

- Certified status and title copy of opposer's Registration No. 3165062;
- Affidavit of Tamera H. Bennett, President of opposer;

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<sup>2</sup> Registration No. 3165062, issued October 31, 2006, in International Class 42.

<sup>3</sup> Opposer also asserted a claim of dilution under Section 43(c) of the Trademark Act. However, this claim was not tried, nor was it argued in opposer's brief. Therefore, we consider the claim to have been waived and we have given it no consideration.

- pp. 53 - 63 of discovery deposition of Philip H. Burrus IV, applicant;
- Status and title copy of applicant's application and specimen;
- Copy of a non-precedential decision of the Board;
- Affidavit of Evan M. Fogelman, a Texas attorney;
- Affidavit of Kellie F. Stokes, a Texas attorney.

The following evidence is of record by opposer's notice of reliance submitted during its rebuttal trial period:

- Three third-party registrations.

Both parties submitted their briefs during their respective trial periods and the Board accepted these briefs as timely, including opposer's reply brief submitted during opposer's rebuttal trial period.

Applicant submitted evidence, attached to his brief, during his trial period. The Board construed this evidence as having been submitted in a timely manner as if by notice of reliance and accepted the following evidence submitted by applicant:

- Discovery deposition of Philip H. Burrus IV in its entirety;
- Copy of Texas Disciplinary Rules of Professional Conduct;

- Opposer's responses and objections to applicant's request for admissions;
- Printout of opposer's Internet website ONLY to the extent that it is authenticated by testimony.

The Board gave leave to opposer to submit rebuttal evidence during its rebuttal testimony period even though this was subsequent to the filing of its main brief. [See Board Orders of September 10, 2008; September 26, 2008; and February 12, 2009.]

#### *Factual Findings*

Both parties are law offices. Opposer's principal, Tamera Bennett, and applicant's principal, Philip Burrus, are both attorneys practicing in the field of intellectual property law. Mr. Burrus is a registered patent attorney. The states in which Ms. Bennett and Mr. Burrus are licensed to practice law do not intersect and, in fact, opposer's practice is located in Texas and applicant's practice is located in Georgia. Opposer established ownership of a valid and subsisting federal registration of the stylized mark ©REATE P®OTECT for legal services. Opposer, through the affidavit of Tamera Bennett, opposer's principal, established first use and use in commerce of this mark for legal services as of October 15, 2001.

*Analysis**Standing*

Because opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Applicant's argument that opposer does not have standing because opposer's and applicant's law practices are geographically remote is a clear misunderstanding of the law. The Board herein is determining the issue of registrability and a federal registration is nationwide in scope. Thus, opposer's registration is valid throughout the United States.

*Priority*

In view of opposer's ownership of valid and subsisting registration, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). It is unnecessary to consider opposer's common law use in connection with either its stylized registered mark or a block letter version of the same mark in connection with opposer's standing or priority. We have considered only the stylized and registered form of the mark in this decision.

By virtue of opposer's ownership of a federal registration, it is unnecessary to consider or determine whether opposer has established priority over applicant by consideration of any common law use. (*Id.*) Further, applicant's assertion that opposer's mark is merely descriptive constitutes a direct attack on the validity of opposer's pleaded and established registration and as such may not be considered in the absence of a counterclaim to cancel. Trademark Rule 2.106(b)(2)(ii), 37 CFR §2.106(b)(2)(ii). *See also Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 109 (TTAB 1976) (contention that opposer's registered mark is merely descriptive may not be considered in the absence of a counterclaim to cancel the registration). Opposer's registration is presumed valid.

Thus, the only issue to decide herein is likelihood of confusion.

#### *Likelihood of Confusion*

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company*,

*Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The relevant *du Pont* factors in the proceeding now before us are discussed below.

#### *The Goods and Services*

We determine the question of likelihood of confusion based on an analysis of the goods and/or services recited in applicant's application vis-à-vis the goods and/or services identified in opposer's pleaded registration(s). *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). There is no question that the services of the parties are identical.

Applicant's argument that the services differ because of the obvious differences in the two individuals rendering the services and their different geographic locations is

irrelevant. The services as identified are exactly the same and, as previously stated, opposer's registration is nationwide in scope.

The *du Pont* factor of the similarity of the services favors a finding of likelihood of confusion.

*Trade Channels, Purchasers and Conditions of Sale*

Because the parties' services are identical, we must presume that they are rendered in identical trade channels and are purchased by the same consumers. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). The purchasers of legal services consist of the full range of the general public. Thus, while we can assume that at least a substantial portion of the purchasing public will exercise care in choosing an attorney, even knowledgeable, careful consumers are not necessarily knowledgeable about trademarks and are not immune from confusion, especially when the services are identical. See *In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

The *du Pont* factors of the trade channels, purchasers and conditions of sale favor a finding of likelihood of confusion.

*The Marks*

We now turn to consideration of the marks. In view of opposer's disclaimer in its registration of the copyright



and trademark registration symbols in its mark, applicant makes the following argument:

Opposer's mark is properly construed as "REATE P OTECT" as significant portions of opposer's alleged mark are proscribed from trademark protection by statute. ... The stylized symbols are unpronounceable. Thus, opposer's mark consists of two unpronounceable fragments; whereas, applicant's mark is two pronounceable sentences.  
(Brief, p. 5.)

Applicant's argument is entirely without merit. As the wording of the disclaimer indicates (i.e., "no claim is made to the exclusive use of ... *apart from the mark as shown*" - *emphasis added*), the disclaimed matter is accorded significance as an integral part of the composite mark. See *American Dietetics Company, Inc. et. al. v. Plus Products*, 412 F.Supp. 691, 191 USPQ 146 (DCNY 1976). The disclaimer of matter in a mark does not have the effect of removing the matter from the mark. *Bordon, Inc. v. W.R. Grace & Co.*, 180 USPQ 157 (TTAB 1973). It is well established that a disclaimer is of no legal significance in determining likelihood of confusion, rather, the disclaimed matter must be considered. See *Kellogg Co. v. Pack "Em Enterprises Inc.*, 14 USPQ 2d 1545 (TTAB 1990); and *Glamorene Products Corporation v. Boyle-Midway, Inc., et. al.*, 188 USPQ 145 (SDNY 1975). Moreover, the public viewing the mark is unaware of what, if any, portions of a mark may be

disclaimed in a federal registration. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Therefore, we examine the similarities and dissimilarities of the marks in their entireties in terms of their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. Opposer's stylized mark is ©REATE P®OTECT.

Applicant correctly notes that its mark differs from opposer's mark because it contains the nouns "you" and "we" as well as punctuation. The marks also differ because opposer uses the copyright symbol to depict the "C" as "create" and the federal trademark registration symbol to depict the "R" in "protect." However, the test 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 their entireties that confusion as to the source of the 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). As indicated above, purchasers of legal services consist of the full range of the general public.

In this case, both marks use the words "create" and "protect" and they use them in the same order. The punctuation is of little, if any, significance. Punctuation is likely to be read into any phrase where appropriate by the viewer and, in applicant's mark, the punctuation appears where one would expect and it does not change the connotation of the mark at all. In articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We find that the verbs "create" and "protect" are the operative, action terms in the mark and, thus, are dominant.

Opposer's mark, CREATE PROTECT is likely to be viewed as an imperative, so that the viewer will impute the word "you" or "we" before each verb. The copyright symbol in place of a "C" and the trademark registration symbol in place of an "R" in these words look merely like stylized forms of a "C" and "R" respectively and will be viewed as those letters in the context of the words "create" and "protect."

Considering the marks in their entireties, we find that the sound, appearance and connotations of the marks are substantially similar and, certainly, the overall commercial impressions are more similar than they are dissimilar. Applicant's argument that the marks will be distinguishable as actually used because relevant disciplinary rules require the use of an attorney's name in advertising is unavailing. We must consider the marks as represented in the application and the registration, which is without additional names.

The *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

#### *Actual Confusion*

While both parties agree that there has been no actual confusion, it is also clear that, based on the differences in the location of the services, there has been little if no opportunity for confusion. Therefore, this *du Pont* factor is neutral.

#### *Conclusion*

We find that the *du Pont* factors weigh strongly in favor of a finding of likelihood of confusion. When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, YOU CREATE.

WE PROTECT., and registrant's mark, ©REATE P®OTECT, their contemporaneous use on the identical services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

*Decision:* The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.