

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

Mailed: October 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Palmer Patent Consultants, LLC

Serial No. 76673151

Palmer C. Demeo, *Pro Se*, for Palmer Patent Consultants, LLC.

Raul Cordova, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Walters, Zervas and Ritchie, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Palmer Patent Consultants, LLC has filed an application
to register the standard character mark INVENT! INVENT!
INVENT! PATENT IT! on the Principal Register for
"intellectual property consultation," in International Class
45.¹ The application includes a disclaimer of PATENT apart
from the mark as a whole.

¹ Serial No. 76673151, filed February 26, 2007, based on use of the mark
in commerce, alleging first use and use in commerce as of December 19,
1996.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark PATENT IT!, previously registered for "legal services," in International Class 42,"² that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive. The registration includes a disclaimer of PATENT apart from the mark as a whole.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Our determination under Section 2(d) is 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. See *In re E. I. du Pont de Nemours and 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).

² Registration No. 3557533, issued January 6, 2009. The registration is owned by Steven G. Lisa, Ltd.

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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Services

We consider, first, the services involved in this case, and we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that

they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant's services are identified as "intellectual property consultation" and the services in the cited registration are identified as "legal services." The examining attorney submitted a definition from *The New Oxford American Dictionary* (2nd ed. 2005) of "intellectual property" as "n. Law, a work or invention that is the result of creativity, such as a manuscript or a design, to which one has rights and for which one may apply for a patent, copyright, trademark, etc." Intellectual property is a field of law and consultation in this field includes the rendering of legal services. Registrant's legal services encompass such services rendered in the field of intellectual property. Therefore, the respective services are identical to the extent that they are overlapping.

This *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Trade Channels/Purchasers

To the extent that applicant's and registrant's services are identical, the channels of trade and classes of purchasers are also identical. We presume these services would be rendered in all ordinary trade channels for these services and to all usual classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Applicant contends that the purchasers of the respective services are sophisticated inventors. However, the class of purchasers of legal services in the field of intellectual property encompasses all inventors and owners of other types of intellectual property. This class is likely to run the gamut from highly knowledgeable scientists, engineers and business persons to the small business owner, artist or individual inventor. There is no evidence that this broad class of purchasers is sophisticated or knowledgeable about trademarks or immune to source confusion. See *In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

These *du Pont* factors weigh in favor of a finding of likelihood of confusion.

The Marks

We turn, next, to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound,

connotation and commercial impression. 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 terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). 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). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The examining attorney contends that PATENT IT! is the dominant element of applicant's mark, noting that this phrase is preceded by the exhortation INVENT! INVENT! INVENT! that culminates with the command portion of the slogan, i.e., PATENT IT!; and that this command will make the greatest impression on the purchaser. While the examining attorney acknowledges that PATENT is a weak term

which is merely descriptive, he emphasizes that the PATENT IT! portion of applicant's mark is identical to the registered mark in its entirety. The examining attorney also argues that the phrase INVENT! is also at least highly suggestive in connection with applicant's identified services and the mere repetition of this phrase, i.e., INVENT! INVENT! INVENT!, does not create a commercial impression distinct from the single phrase, i.e., INVENT!.

Applicant contends that the repetitive phrase INVENT! INVENT! INVENT! is the dominant portion of its mark and distinguishes it from the registered mark; that PATENT is a merely descriptive, if not generic, in connection with the respective services; and that its trademark is distinct because it is in the nature of a pep rally slogan.

Applicant referred to two third-party registrations to support its contention that PATENT is a weak term and merely descriptive. Applicant did not submit copies of the referenced registrations, nor did it list any other pertinent registration information. Thus, this evidence is of extremely limited probative value. Applicant also referenced, in its brief, book titles containing the phrase PATENT IT, and the examining attorney objected to this evidence. This evidence is both in improper form and untimely and, thus, it has been given no consideration.

While the term PATENT is clearly merely descriptive of a form of intellectual property protection that is the subject of legal services or other consultation in this field, neither applicant nor the examining attorney have shown that the phrase PATENT IT! is merely descriptive in connection with these services.³ Moreover, other than the descriptive nature of the word PATENT in connection with the respective services, there is no evidence in the record as to the strength or weakness of the cited registered mark.

The phrase PATENT IT! in applicant's mark is identical to and wholly encompasses the mark in the cited registration. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. See *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

³ Applicant may not attack the validity of the cited registration in the context of this ex parte appeal.

Because inventions are the subject of patents, the phrase INVENT! is conceptually related to the phrase PATENT IT! and suggests to inventors that they obtain patents. The mere repetition of the phrase three times does not change this connotation. Neither does the fact that the one-word exclamatory phrase INVENT is followed by an exclamation point change the connotation. Rather, in addition to containing the phrase PATENT IT!, which is identical to the registered mark, the exclamatory nature of the repetitive word INVENT! repeats the exclamatory nature of the phrase PATENT IT! and increases its visual similarity to the registered mark. We view the mark as a unitary whole wherein no one term is dominant.

However, although the marks have certain differences, when we compare them in their entireties we find that on the whole they are similar in appearance, sound, connotation and commercial impression. Both marks contain the identical phrase PATENT IT! and the addition of the highly suggestive phrase INVENT! INVENT! INVENT! in applicant's mark is not sufficient to distinguish it from the registered mark when used in connection with identical services. Consumers familiar with registrant's mark may simply conclude that applicant's mark is an alternate version of the registrant's mark. *See, e.g., In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE" and "JOSE

GASPAR GOLD"); *Lilly Pulitzer, Inc. v. Lilly Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" AND "CREST CAREER IMAGES"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE").

Conclusion

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, INVENT! INVENT! INVENT! PATENT IT!, and registrant's mark, PATENT IT!, their contemporaneous use on the overlapping identical services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

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