

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: December 11, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Infinity Wind Power, Inc.

Serial Nos. 77572712 and 77575965

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Before Bucher, Kuhlke and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Infinity Wind Power, Inc., filed
applications to register on the Principal Register the mark

INFINITY WIND POWER

in standard characters for the following services:

Wind energy project advisory services, namely,
providing assistance with wind farm site
selection and wind farm construction

in International Class 37;

Wind energy project advisory services, namely,
wind strength testing

in International Class 42; and

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Wind energy advisory services, namely, providing assistance with wind farm permitting, namely, obtaining environmental, design, zoning and other governmental permits
in International Class 45;¹
and the mark



for the following services:

Wind energy project advisory services, namely, providing assistance with wind farm site selection and wind farm construction
in International Class 37.²

The trademark examining attorney refused registration to both applications under Section 2(d) of the Trademark Act on the ground that applicant's marks, as used or intended to be used in connection with applicant's

¹ Application Serial No. 77572712 was filed on September 17, 2008 based upon applicant's assertion of a bona fide intent to use the mark in commerce.

WIND POWER is disclaimed apart from the mark as shown.

² Application Serial No. 77575965 was filed on September 22, 2008 based upon applicant's assertion of May 9, 2008 as a date of first use of the mark anywhere and in commerce in connection with the services in Class 37 and a bona fide intent to use the mark in commerce in connection with the services in Classes 42 and 45.

WIND POWER is disclaimed apart from the mark as shown.

Color is not claimed as a feature of the mark.

The mark consists of a horizontal rectangle with a backwards "S" laying on its side inside of the rectangle to the left of the word "INFINITY" with the words "WIND POWER" below.

services, so resemble the following mark, previously registered on the Principal Register:



for

Business management and consulting in the field of renewable energy services; comprehensive management services for renewable energy systems, namely, photovoltaic energy, concentrated solar power and wind energy systems; distributorship featuring comprehensive management services for renewable energy systems, namely, photovoltaic energy, concentrated solar power and wind energy systems

in International Class 35;

Installation and maintenance of comprehensive renewable energy systems, namely, photovoltaic energy, concentrated solar power and wind energy systems

in International Class 37; and

Comprehensive renewable energy services, namely, development and implementation of renewable energy systems, namely, photovoltaic energy, concentrated solar power and wind energy systems

in International Class 42,³ as to be likely to cause confusion.

³ Registration No. 3711080 issued on November 17, 2009.

The mark consists of a lateral figure "8" in a green hue with the term enfinity in blue.

The color(s) green and blue is/are claimed as a feature of the mark.

When the refusals were made final, applicant appealed. Applicant and the examining attorney have filed briefs on the matter under appeal.

Proceedings Consolidated

The issues raised by the above-noted appeals of the Section 2 (d) refusals to register application Serial Nos. 77572712 and 77575965 are identical. Further, the briefs and evidentiary record in both cases are essentially identical. Accordingly, the Board will address both appeals in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 77575712, unless otherwise noted. We have, of course, considered all arguments and evidence filed in each case, including any arguments and evidence not specifically discussed in this decision.

Preliminary Matters

Before turning to the substantive ground for refusal, we note that in both appeals applicant submitted an exhibit consisting of printed copies of the Notice of Publication, Trademark Snap Shot Publication Stylesheet, and drawing page for third-party application Serial No. 85388837. We agree with the examining attorney that this exhibit is untimely in each case, and it has not been considered. See Trademark Rule 2.142(d) (the record in the application

should be complete prior to the filing of an appeal). We note in any event that had we considered such exhibit in our determination of the issue on appeal, the result would be the same.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (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, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Services, Channels of Trade and

Class of Customers

We begin by comparing applicant's services with those of registrant. In making our determination under the second du Pont factor, we look to the services as identified in the involved applications and cited registration. See *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 question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In this case, we begin by observing that all of applicant's services involve providing wind energy project advice. More specifically, these services include in both applications providing assistance with wind farm site selection and construction, and also include in application Serial No. 77572712 wind strength testing for purposes of wind energy production and obtaining various permits for wind farms. Registrant's services include business management, consultation, installation, maintenance, development and implementation of renewable energy systems, including wind energy, photovoltaic energy and concentrated solar energy. Thus, as recited, applicant's services

concern various aspects of providing wind energy and registrant's services concern related aspects of several forms of renewable energy, including wind energy. As a result, we find the services to be related on the face of their respective identifications.

Further, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for services of a kind similar to those identified in both applicant's applications and the cited registration. The following examples are illustrative:

Registration No. 3147266 for services including design and construction of renewable energy systems, namely, solar and wind energy systems;

Registration No. 3494198 for services including business consulting, management, planning and supervision in the field of wind energy; wind power plant design, development and testing; meteorological study, forecasting and modeling for wind energy development; consulting services in the field of environmental assessment and compliance in the nature of permit and land control issues for wind energy development;

Registration No. 3191002 for services including research and development, management and operation assistance, and construction of wind power energy projects; and

Registration No. 3680518 for services including business consulting, management, planning and operation assistance services in the field of wind power energy; planning and construction of wind energy production facilities.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

In addition, the examining attorney submitted evidence from the commercial Internet websites of various entities offering the services of both applicant and registrant under a single mark. These websites include horizonwind.com; blackwaterenvironmentalservices.com; chinookwind.net; and foresightwind.com. This evidence tends to demonstrate that consumers are likely to encounter the services at issue under a single mark and that such services are available in the same channels of trade and offered to the same class of customers.

Thus, the recitation of the respective services themselves as well as the foregoing evidence demonstrate that applicant's services in all International Classes are of a type that are related to or otherwise may be encountered with those of registrant and are offered in the same channels of trade to the same class of purchasers, and these du Pont factors favor a finding of likelihood of confusion.

Similarity of the Marks

We turn to the first du Pont factor, i.e., whether applicant's marks and registrant's mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first du Pont factor 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 impression that confusion as to the source of the goods or services offered under the respective marks is likely to result.

In this case, applicant's marks, INFINITY WIND POWER and



are similar to registrant's mark



in that the most visually prominent portion of registrant's mark, i.e., ENFINITY is nearly identical in appearance and

sound to the term INFINITY in applicant's marks. Further, there is no evidence of record to suggest that ENFINITY is anything other than a novel spelling of INFINITY, suggesting that the terms are identical in meaning or connotation.

With regard to the other components of the marks, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, the term WIND POWER in applicant's marks is disclaimed and clearly describes a central feature of applicant's services. With regard to the design element in in registrant's mark and the mark in application Serial No. 77575965, it is further settled that when a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). We also note that the design in registrant's mark and the mark

in application Serial No. 77575965 appear highly similar. They are described, respectively, as a lateral figure 8 and a backward letter S. Nonetheless, and especially in the context of the marks at issue, both resemble the infinity symbol (∞) and, in any event, bear close resemblance to each other.

In view of the foregoing, we find the terms ENFINITY and INFINITY as they appear the respective marks, are the dominant terms therein and are highly similar in appearance, sound and connotation. We further find that the design portions of registrant's mark and the mark in application Serial No. 77575965 are highly similar in appearance and connotation.

Viewing the marks as a whole, we find that applicant's marks are more similar to registrant's mark than dissimilar. As a result, applicant's marks are highly similar in appearance, sound and connotation to registrant's mark and thus highly similar in overall commercial impression.

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

Strength of the Marks in the Cited Registrations

In considering the involved marks, we have taken into account applicant's reliance upon two additional third-

party registrations originally cited but later dropped by the examining attorney as bars to registration of applicant's marks. These include Registration No. 3194024 for the mark INFINITY REDEVELOPMENT for various real estate services, and Registration No. 3229169 for the mark INFINITE POWER SOLUTIONS for manufacturing of thin-film energy storage devices.⁴ Applicant argues that the marks in these registrations are evidence of the weak nature of the mark upon which the examining attorney bases her final refusal to register that is the subject of these appeals. This evidence is of limited probative value. Firstly, the registrations are not evidence of use of the marks shown therein and further are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Secondly, the registrations cover services which are not as closely related to those in the cited registration as are applicant's services.

⁴ The examining attorney also cited an additional registration that subsequently was cancelled. A cancelled registration is not evidence of anything except that it issued. See TBMP §704.03(b) (October 2012) and cases cited therein. See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

In addition, applicant submitted from a private database copies of numerous third-party applications before the USPTO and international registrations, only some of which extend protection to the United States, for marks containing various permutations of the term INFINITY. For the following reasons, we find this evidence to be unpersuasive. First, submission of third party applications and registrations from a private database is insufficient to make them of record. See TBMP § 1208.02 (October 2012) and the authorities cited therein. To make a third-party registration of record, an applicant must submit either a copy of the paper USPTO record or a copy of the registration taken from the electronic records of the Office. See, for example, *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010). Thus, applicant's proffered list of third party applications and registrations is not properly of record. See *Id.* Second, the international registrations that extend protection under Section 66 of the Trademark Act that were submitted by applicant, even if properly of record, recite goods and services that are either unrelated or not as closely related to the services in its applications as are the services in the cited registration. The international registrations that do not confer protection of the marks at issue in the United

States are irrelevant with regard to the relative strength of weakness in the United States of the mark in the cited registration. Finally, applicant's submitted applications to the USPTO, even if properly of record, are of very limited probative value inasmuch as third-party applications are evidence only of their filing. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1050, n.4 (TTAB 2002).

We accordingly find that, on the record in this case, the mark in the cited registration is entitled to more than a narrow scope of protection, particularly in the field of renewable energy systems. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd* unpub., (Appeal No. 92-1086, Federal Circuit, June 5, 1992). Cf. *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996).

Sophistication of Purchasers

Finally, applicant contends that its services and those of registrant are expensive and that purchasers of these services are sophisticated and would exercise care in their selection. We note that while applicant has not submitted evidence in support of this argument, the nature of the services themselves suggests that they are technical in nature, and are not as likely to be the subject of

casual purchase as common consumer goods. However, even assuming arguendo that purchases of applicant's and registrant's services would involve a deliberate decision-making process, this does not mean that the purchasers are immune from confusion. As we view the present case, the high degree of relatedness of the services and the similarity between the marks outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."].

Summary

Neither applicant nor the examining attorney has discussed any of the remaining du Pont factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

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In light of the foregoing, we conclude that consumers familiar with registrant's services sold under its above-referenced mark would be likely to believe, upon encountering applicant's services rendered under its mark that the services originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register application Serial Nos. 77572712 and 77575965 are affirmed.