

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: November 18, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Building Research Establishment Limited,  
Integrated Environmental Solutions Limited,  
WD Re-Thinking Limited, and AEC3 UK Limited*

—  
Serial No. 85901901  
—

David A. Plumley of Christie, Parker & Hale, LLP  
for Building Research Establishment Limited, Integrated Environmental  
Solutions Limited, WD Re-Thinking Limited, and AEC3 UK Limited.

Deborah E. Lobo, Trademark Examining Attorney, Law Office 109,  
Michael Kazazian, Managing Attorney.

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Before Quinn, Zervas and Bergsman,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Building Research Establishment Limited, Integrated Environmental Solutions  
Limited, WD Re-Thinking Limited, and AEC3 UK Limited (“Applicants”) seek  
registration on the Principal Register of the mark IMPACT and design, shown  
below,



for, *inter alia*, the following services as amended:

Providing an online computer database featuring information in the field of construction; providing an online computer database featuring information in the field of building construction and repair and building materials for construction and repair; providing information relating to construction online via a global computer network; providing information relating to building construction and repair and building material for construction and repair online via a global computer network; providing consultancy, information and advisory services in connection with the aforesaid services in the fields of construction, building construction and repair and building materials for construction and repair, in International Class 37.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicants' mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicants' mark so resembles the registered mark IMPACT and design, shown below,



for the services set forth below as to be likely to cause confusion.<sup>2</sup>

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<sup>1</sup> Application Serial No. 85901901 was filed on April 11, 2013, based upon Applicants' allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act and Section 44(d) of the Trademark Act.

Applicants describe their mark as consisting of the word "IMPACT" in lower case letters with three round arches above the mark."

Applicants also applied to register their mark for software in Class 9 and for repair, maintenance, updating and design of software, in Class 42. The goods and services in Classes 9 and 42 are not involved in this appeal.

<sup>2</sup> Registrant describes its mark as consisting of "two half circles to the left of the literal element 'impact.'"

Construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures, in Class 37; and

Engineering and design services for construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures, in Class 42.<sup>3</sup>

After the Examining Attorney made the refusal final, Applicants appealed to this Board. 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. *Strength of the registered mark.*

The Examining Attorney originally cited the 12 third-party registrations, owned by 11 different entities, listed below against the registration of Applicants' mark but later withdrew them as bars to registration. Based on those registrations, Applicants argue that Registrant's mark is a weak mark entitled to only a narrow scope protection or exclusivity of use.<sup>4</sup>

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<sup>3</sup> Registration No. 3943768, issued April 21, 2011.

<sup>4</sup> 4 TTABVUE 5 and 7 TTABVUE 2.

1. Registration No. 3016156 for the mark IMPACT (typed drawing form) for “design and engineering services; namely, design of structural foundations in the nature of piers and collections of piers,” in Class 42;
2. Registration No. 2709525 for the mark IMPPAC (typed drawing form) for “general construction; construction management; construction planning,” in Class 37;
3. Registration No. 4222431 for the mark IMPACT (standard character form) for “computer software for management of capital improvement programs, construction projects, and for management of related project documentation,” in Class 9;
4. Registration No. 4072990 for the mark IMPACT (standard character form) for, *inter alia*, “software for neurocognitive testing, assessment and evaluation,” in Class 9;
5. Registration No. 3469239 for the mark IMPACT (typed drawing form) for “software used to correlate the effect of weather and other external causal factors such as competition, demographics and economy on consumer demand by product, location and time to support planning and forecasting, product distribution and allocation, and advertising and promotion timing,” in Class 9;
6. Registration No. 2967047 for the mark IMPACT (standard character form) for “computer software for audio production,” in Class 9;
7. Registration No. 4123403 for the mark IMPACT (standard character form) for “computer software for use by financial and insurance advisors and their

clients, namely, software for calculating financial needs analyses, as well as the effect of assets, income, and investments on those needs for use in the fields of financial planning, estate planning, insurance planning, retirement planning, business planning, financial needs analysis and business worksite marketing,” in Class 9;

8. Registration No. 3859298 for the mark IMPACT (standard character form) for “computer software for use by preferred provider organizations, health maintenance organizations and third-party administrators for use in enrollment, claim re-pricing, adjudication and payment processing of medical insurance claims,” in Class 9;

9. Registration No. 3727376 for the mark IMPACT (standard character form) for “computer software for generating typeface designs and ornamental designs,” in Class 9;

10. Registration No. 2407006 for the mark IMPACT (typed drawing form) for “computer software for financial forecasting, namely, evaluating business units and company structure options and analyzing market opportunities, for use by utility companies and investors in utility companies,” in Class 9;

11. Registration No. 1775734 for the mark IMPACT (typed drawing form) for “computer software for record keeping and routine functions by state, county and local governments and judicial systems,” in Class 9; and

12. Registration No. 1861636 for the mark IMPACT (typed drawing form) for “computer software, computer programs, computer programs and instructional manuals sold as a unit, for use in the field of insurance,” in Class 9.

We find the 12 third-party registrations to be of limited probative value in assessing the strength of Registrant’s mark. First, contrary to the gist of Applicants’ argument, only the first three registrations listed above are for services related to Registrant’s construction, engineering and design services. The other registrations do not cover services similar to Registrant’s services. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue). *See also Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (“The real world segment of the public is limited to the market or universe necessary to circumscribe purchasers or users of products or services like those being offered by the parties under the ‘common’ mark. Only if other offerings under the ‘common’ mark are also directed to that relevant public is it reasonable to infer that they may have become conditioned to draw fine lines between sources of ‘related’ goods or services. Thus, in the relevant market or universe, even a ‘common’ mark may stand alone, but for the single newcomer, and there is simply no basis for an inference that the ‘public’ has been conditioned to distinguish between sources of related products or services.”); *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our

conclusion altered by the presence in the record of about 40 third-party registrations which embody the word ‘KEY.’ The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here.”). Three relevant third-party registrations do not persuade us that the public has become conditioned to encountering so many “Impact” marks in the construction field that Registrant’s mark “Impact” should be considered a weak mark, entitled to only a narrow scope of protection.

Second, because “[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.” *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Although we do not find Applicants’ evidence of the suggestive weakness of the term IMPACT to be of very great weight, we take it into consideration in our analysis.

*B. The similarity or dissimilarity of the marks.*

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, “two marks may

be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The marks are displayed below:

Applicants’ Mark



Registrant’s Mark



The marks are very similar. Both marks consist of the word “impact” displayed in lower case letters and include arch designs. Applicants’ mark has three round

arches above the word “impact” and Registrant’s mark has two ovular arches or “half circles” to the side of the word impact.

We find that the marks are very similar in terms of appearance, sound, connotation and commercial impression.<sup>5</sup>

*C. The similarity or dissimilarity and nature of the services.*

As noted above, Applicants are seeking to register its mark for the services listed below:

Providing an online computer database featuring information in the field of construction; providing an online computer database featuring information in the field of building construction and repair and building materials for construction and repair; providing information relating to construction online via a global computer network; providing information relating to building construction and repair and building material for construction and repair online via a global computer network; providing consultancy, information and advisory services in connection with the aforesaid services in the fields of construction, building construction and repair and building materials for construction and repair.

The services in the cited registration are listed below:

Construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures; and

Engineering and design services for construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures.

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<sup>5</sup> Applicants did not argue that the marks are not similar; however, Applicants contend that “due to specific differences in the respective services associated with the marks in question combined with the weakness of the common term, applicant’s [sic] mark is entitled to registration over the cited mark.” 4 TTABVUE 4.

Applicants' proposed services, specifically providing information relating to construction online via a global computer network and providing information relating to building construction and repair and building material for construction and repair online via a global computer network, are identified broadly enough to encompass Registrant's construction, engineering and design services for civil engineering structures, namely, soil and subsurface improvement structures for buildings, and commercial, industrial, residential, and transportation related structures. In other words, Registrant's construction, engineering and design services presumptively include providing information relating to building construction and repair and building material for construction and repair.<sup>6</sup>

"Civil engineering" is defined as "[t]he branch of engineering that specializes in the design and construction of structures such as bridges, roads, and dams."<sup>7</sup> The three categories of civil engineering functions are set forth below:

1. Activities performed before construction (feasibility studies, site investigations, and design);

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<sup>6</sup> Under this *du Pont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the description of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

<sup>7</sup> *Dictionary.com* derived from **THE AMERICAN HERITAGE SCIENCE DICTIONARY** (2002). See also *Merriam-Webster online* (merriam-webster.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

2. Activities performed during construction (dealing with clients, consulting engineers, and contractors); and

3. Activities performed after construction (maintenance and research).<sup>8</sup>

Feasibility studies are described as extensive studies of the objective and potential options. “Feasibility studies may cover alternative methods—*e.g.*, bridge versus tunnel, in the case of a water crossing—or, once the method is decided, the choice of route. Both economic and engineering problems must be considered.”<sup>9</sup>

Consulting engineers are often hired for large specialized projects.

The consulting engineer may be required first to undertake feasibility studies, then to recommend a scheme and quote an approximate cost. The engineer is responsible for the design of the works, supplying specifications, drawings, and legal documents in sufficient detail to seek competitive tender prices. The engineer must compare quotations and recommend acceptance of one of them. Although he is not a party to the contract, the engineer’s duties are defined in it; the staff must supervise the construction and the engineer must certify completion of the work. Actions must be consistent with duty to the client; the professional organizations exercise disciplinary control over professional conduct. The consulting engineer’s senior representative on the site is the resident engineer.<sup>10</sup>

Civil engineering services also include a maintenance aspect.

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<sup>8</sup> *Encyclopædia Britannica Online*, s. v. “civil engineering”, accessed November 16, 2015 ([britannica.com/technology/civil-engineering](http://britannica.com/technology/civil-engineering)). The Board may take judicial notice of information in encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (encyclopedias may be consulted); *Productos Lacteos Tocombo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works).

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

The contractor maintains the works to the satisfaction of the consulting engineer. Responsibility for maintenance extends to ancillary and temporary works where these form part of the overall construction. After construction a period of maintenance is undertaken by the contractor, and the payment of the final installment of the contract price is held back until released by the consulting engineer. Central and local government engineering and public works departments are concerned primarily with maintenance, for which they employ direct labour.<sup>11</sup>

Thus, because civil engineering services include providing information relating to construction and repair and building material for construction, the services are in part identical.

To further support her contention that the services are related, the Examining Attorney submitted excerpts from several civil engineering firms that provide information and advisory services relating to some form of building construction. For example,

1. Brierley Associates (brierleyassociates.com) advertise pre-bid analysis services where it “helps Contractors evaluate a project through technical review of the contract documents, risk determination, constructability assessment, and identification of alternate design concepts.”<sup>12</sup> It also advertises its feasibility studies services where Brierley Associates “help evaluate alignments and construction alternative to determine options that best suit the work.”<sup>13</sup>

2. Pacific Western Technologies, Ltd (pwt.com) is an engineering firm, including civil engineering, that advertises that it offers “full-service environmental

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<sup>11</sup> *Id.*

<sup>12</sup> November 7, 2014 Office Action.

<sup>13</sup> *Id.*

consulting, engineering, design and construction capabilities,” including feasibility studies and engineering evaluations and computer simulations and design of water distribution systems.<sup>14</sup>

3. Freeman Companies (freemancos.com) is a civil engineering firm that advertises “a wide range for services under the all-encompassing umbrella of civil engineering ... from the early planning and design development stages through ensuring that construction activities are performed in accordance with the contract documents – and everywhere in between.”<sup>15</sup>

Applicants argue that their services “specifically relate to the service of providing online-based information that is relevant to the construction industry,” whereas Registrant’s services “relate to structural engineering services.”<sup>16</sup> Applicants contend that their consultancy and advisory services “are not directly related to the field of construction, but rather are directed to *‘the aforesaid services,’* referring to the previously-identified web-based services.”<sup>17</sup> Essentially, Applicants’ arguments are based on the false premise that Applicants are providing an information service devoid of subject matter. According to the description of services, Applicants are providing information in the fields of construction, building construction and repair and building materials for construction and repair, which is broad enough to encompass soil and subsurface improvement structures for support

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<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> 4 TTABVUE 4 and 7 TTABVUE 4.

<sup>17</sup> 4 TTABVUE 5 and 7 TTABVUE 4.

of buildings and other commercial, industrial, residential, and transportation-related structures. The fact that Applicants intend to offer those services through an online service does not change the inherent nature of the services (*i.e.*, providing information in the field of building construction).

In view of the foregoing, we find that the services are in part identical or otherwise closely related.

*D. Established, likely-to-continue channels of trade.*

Because the services described in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

*E. Balancing the factors.*

Because the marks are very similar, the services are in part identical and, therefore, we must presume that the services move in the same channels of trade, we find that Applicants' mark  for "providing an online computer database featuring information in the field of construction; providing an online computer

database featuring information in the field of building construction and repair and building materials for construction and repair; providing information relating to construction online via a global computer network; providing information relating to building construction and repair and building material for construction and repair online via a global computer network; providing consultancy, information and advisory services in connection with the aforesaid services in the fields of construction, building construction and repair and building materials for construction and repair” so resembles the registered mark  for the services set forth below as to be likely to cause confusion.

Construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures; and

Engineering and design services for construction of civil engineering structures, namely, soil and subsurface improvement structures for support of buildings and other commercial, industrial, residential, and transportation-related structures.

**Decision:** The refusal to register Applicants’ mark  for the services identified in Class 37 is affirmed.

The application will be forwarded for publication in Classes 9 and 42 in due course.