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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85901901
Applicant	Building Research Establishment Limited
Applied for Mark	IMPACT
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Date	06/30/2015

TRADEMARK AND SERVICE MARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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/Jennifer Guerra/  
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Mark : IMPACT (stylized) and Design  
Serial No. : 85/901,901  
Filed : April 11, 2013  
Applicant : Building Research Establishment Limited  
  
Law Office : 109  
Examiner : Deborah E. Lobo  
Docket No. : 72742/S307

**SUBMISSION OF APPEAL BRIEF  
TO THE TRADEMARK TRIAL AND APPEAL BOARD  
(Responding to the November 7, 2014 Final Office Action)**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Post Office Box 29001  
Glendale, CA 91209-9001  
June 30, 2015

Commissioner:

**I. Introduction**

The subject application includes goods and services in classes 9, 37, and 42. In a previous Office action, registration was refused in all classes under §2(d) based on a likelihood of confusion in which the examining attorney cited thirteen prior registrations for marks that include the term IMPACT or variations. In response, applicant amended the goods and services for clarification, and submitted arguments distinguishing its goods and services from those of the thirteen prior registrations. In the Office action dated November 7, 2014, the examining attorney indicated that the §2(d) refusals as to twelve of the prior registrations and been overcome, but maintained and made final the refusal based on a likelihood of confusion with U.S. Registration No. 3,943,768. However, that refusal was limited solely to the services in class 37.

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The class 37 services for the subject application are: "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 contrast, the services in cited U.S. Registration No. 3,943,768 are: "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

## **II. Argument**

In matters before the Patent and Trademark Office, *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), is considered "the seminal case" for a likelihood of confusion analysis under §2(d). See TMEP 1207.01. There, the U.S. Court of Customs and Patent Appeals listed numerous factors relevant in a §2(d) analysis. While "[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression" and "[t]he relatedness of the goods or services as described in the application and registration(s)" are important factors in any analysis under §2(d), "each case must be decided on its own facts." *Id.* citations omitted. For example, the strength of the marks at issue can be an important factor in determining likelihood of confusion. See TMEP 1207.01(b)(ix) ("The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word", citing *Palm Bay Imps., Inc. v. Veuve Clicquot*

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*Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ 2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ 2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ 2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984.)

For the present application, applicant concedes that the marks at issue each include the identical word "impact," but "even close similarity between two marks is not dispositive of the issue of likelihood of confusion." *McGregor-Doniger Inc. v. Drizzle Inc.*, 202 USPQ 81, 89 (2d Cir. 1979). Here, due to specific differences in the respective services associated with the marks in question combined with the weakness of the common term, applicant's mark is entitled to registration over the cited mark.

**A. The Specific Services are Sufficiently Different to Prevent Confusion**

As set forth above, applicant's services in class 37 specifically relate to the service of providing online-based information that is relevant to the construction industry. In contrast, the services associated with the cited registration all relate to structural engineering services. When applicant pointed this difference out to the examining attorney in the response filed on January 30, 2014, the examining attorney dismissed the argument, asserting that applicant's services "relate broadly to 'construction' information, consultancy and advice." However, in asserting that applicant is providing consulting services in the construction field, the examining attorney may be misreading the identification of services. Therefore, the recitation of services will be explained in greater detail.

The services at issue in the present application can be divided into five groups as follows, with emphasis added by applicant:

1. **providing an online computer database** featuring information in the field of construction;

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2. *providing an online computer database* featuring information in the field of building construction and repair and building materials for construction and repair;
3. *providing information* relating to construction *online via a global computer network*;
4. *providing information* relating to building construction and repair and building material for construction and repair *online via a global computer network*; and
5. *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 first four groups of services are clearly web-based services. The first two groups specifically state "providing an online computer database." The next two groups clearly identify "providing information . . . online via a global computer network." Perhaps the fifth group is the source of confusion since it specifically includes the terms "consultancy" and "advisory" in defining its services. However, upon a closer inspection of the language, it is clear that such 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. Consequently, all of the services at issue are web-based services, and nowhere does the identification of services recite that any consultancy or engineering services directly relate to the field of construction. Because the services in class 37 are substantially different from those of the cited registration, confusion among the relevant consumers is unlikely:

**B. The Element Common to the Marks at Issue is a Weak, Commonly Used Term**

In the July 30, 2013 Office action, the examining attorney refused registration citing thirteen prior registrations for marks that include the term "impact" or its variations. That the examining attorney found thirteen registrations for marks that include the term "impact" or variations for use with arguably related goods or services is compelling evidence that "impact" is

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so commonly used and weak as a trademark element that each party using such a mark is entitled to a narrow scope of protection because the consuming public will be able to rely on other factors to distinguish the source of the goods or services. See TMEP 1207.01(d)(iii) ("third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services", citations omitted.) Given the weakness of the term "impact" combined with the specific differences between the services of the present application compared to the services of the cited registration, consumers would be readily capable of distinguishing the source of the services at issue, making confusion unlikely.

**III. Conclusion**

Based on the above analysis, applicant requests that the examining attorney's refusal under §2(d) be reversed, and that the application proceed to publication.

Respectfully submitted,

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