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Subject: U.S. TRADEMARK APPLICATION NO. 85901901 - IMPACT - 72742/S307 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85901901

MARK: IMPACT



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Building Research Establishment Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

72742/S307

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the mark IMPACT (& DESIGN) for "[p]roviding 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, on the grounds that it is likely to cause confusion with the registered mark IMPACT (& DESIGN) in U.S. Registration No. 3943768 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 International 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 International Class 42.

STATEMENT OF FACTS

Applicants filed the present application on April 11, 2013, to register the mark IMPACT (& DESIGN) in connection with goods and services in International Classes 9, 37, and 42. In the first office action dated July 30, 2013, registration was refused for all classes under Section 2(d) of the Trademark Act based on a likelihood of confusion with the marks in U.S. Registration Nos. 3943768, 3016156, 3469239, 2967047 2407006, 3859298, 4123403, 4072990, 1775734, 1861636, 4222431, 3727376 and 2709525. Applicant was also advised of four prior-filed pending applications and required to amend the identification of goods and services for all classes and submit a copy of applicant’s foreign registration.

In applicant’s response to office action filed on January 30, 2014, applicant amended the identification for all classes and argued against the Section 2(d) refusal.

On February 27, 2014, applicant's amendments to the identification were accepted. Based on applicant's amended identification, the Section 2(d) refusal was withdrawn as to U.S. Registration Nos. 3016156, 3469239, 2967047 2407006, 3859298, 4123403, 4072990, 1775734, 1861636, 4222431 and 3727376. The prior pending applications were also withdrawn. The refusal under Section 2(d) was continued based on U.S. Registration Nos. 3943768 and 2709525 and limited to applicant's services in International Class 37 only. The application was suspending pending receipt of the foreign registration.

On September 2, 2014, a suspension inquiry was sent requesting the status of the foreign registration.

On October 9, 2014, applicant responded to the suspension inquiry by submitting a copy of the foreign registration.

On November 7, 2014, the foreign registration was accepted. The Section 2(d) refusal was withdrawn as to U.S. Registration No. 2709525 and made final as to U.S. Registration No. 3943768 for applicant's services in International Class 37 only.

Applicant filed a Notice of Appeal on May 1, 2015, and submitted an appeal brief on June 30, 2015. On July 1, 2015, the file was forwarded to the examining attorney for statement.

ISSUE

The sole issue on appeal is whether the applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 3943768, as to be likely to cause confusion, to cause mistake or to deceive. Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

ARGUMENT

I. APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT'S MARK

Applicant's mark IMPACT (& DESIGN) creates a likelihood of confusion when compared to the registered mark IMPACT (& DESIGN) because the marks are similar in appearance, sound, connotation and commercial impression and the relevant goods and channels of trade are related.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In the present case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. Applicant's Mark is Virtually Identical in Appearance, Sound, Connotation and Commercial Impression to the Registered Mark

Applicant's mark IMPACT (& DESIGN) is similar to the registered mark IMPACT (& DESIGN) in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Specifically, the dominant element of applicant's mark, i.e., the literal element IMPACT, is identical to the dominant element of the registrant's mark, i.e., the literal element IMPACT. Although the marks are compared in their entireties in the Section 2(d) analysis, one feature of a mark may be recognized as more significant or dominant in creating a commercial impression. Greater weight is generally given to that dominant feature in determining whether the marks are confusingly similar. See TMEP §1207.01(b); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

In both applicant's and registrant's mark, the term IMPACT is dominant because it is the only literal element and appears in large, bold font. The only other element in each of the respective marks is a minor geometric design element that is generally accorded less weight in the likelihood of confusion analysis. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671

F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

In addition to the fact that both marks contain the identical term IMPACT, the marks are also confusingly similar because the design elements are similar. Specifically, both marks feature a design element that consists of two or more curved or arched bands adjacent to the term IMPACT. The similarities in the designs contribute to the likelihood of confusion because they conveying the same or similar commercial impression.

B. The Registered Mark is Neither Weak Nor Diluted in Relation to the Relevant Services

In the first office action, registration was refused under Section 2(d) of the Trademark Act based on multiple registrations because applicant's identification of goods and services as originally filed was so broad as to potentially include, or overlap with, the goods and/or services identified in each of the cited registrations.

In applicant's response to the first office action filed on January 30, 2014, applicant amended the identification to narrow the description of goods and services. The Section 2(d) refusal was subsequently withdrawn as to those cited registrations for which the goods, services and/or channels of trade no longer presented a bar to registration. The refusal was later limited to applicant's services in International Class 37 only.

Applicant argues that registrant's mark is entitled to only a narrow scope of protection because the term IMPACT is a weak, commonly used term as evidenced by the previously cited registrations.¹ Applicant's argument is without merit because the goods and services at issue in the previously cited registrations are not at issue in the present refusal. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods and/or services*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Specifically, U.S. Registration Nos. 4222431, 4072990, 3469239, 2967047, 4123403, 3859298, 3727376, 2407006, 1775734 and 1861636 all relate to computer software that differs from applicant's software. Thus, while the term IMPACT may be deemed weak or diluted in relation to "computer software," applicant has not shown that the term is weak or diluted in relation to the services relevant to the present refusal.

Here, the goods and/or services listed in the third-party registrations referenced by applicant are different from the services at issue in the present case and thus do not show that the relevant wording, i.e., the term IMPACT, is commonly used or diluted in connection with the relevant services.

Applicant's argument also fails because the evidence presented in support of this argument consists solely of the previously cited third-party registrations. Evidence of weakness or dilution consisting solely of third-party registrations, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey*

¹ See p.4-5 of Applicant's Appeal Brief.

Prods. Pty Ltd., 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

C. Applicant's and Registrant's Services Are Related and Are Provided Within the Same Channels of Trade

In the likelihood of confusion determination, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the services would be encountered by the same consumers under circumstances such that offering the services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

Moreover, where the marks of the respective parties are identical or virtually identical, as they are here, the relationship between the relevant services need not be as close to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir.

1993); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); TMEP §1207.01(a).

In the present case, the relevant services of the applicant are “[p]roviding 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 registrant’s services 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” 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.”

Clearly, both parties provide services in the field of construction. Specifically, applicant is providing information and consultation relating to construction and registrant is providing construction services and engineering and design services relating to construction structures. The evidence of records shows that entities that provide construction services often also provide information in the field of construction such that consumers encountering both parties’ services are likely to mistakenly believe that they originate from the same source.

The notice of suspension of February 27, 2014 and the final office action of November 7, 2014, included attachments from various third-party internet websites showing services similar to applicant’s

services originating from the same source as services similar to registrant's services. For example, the attachments from <http://subsurfaceconstructors.com/> show construction and engineering services including subsurface construction of foundations, and online information relating thereto including engineering and safety information, construction project case studies, news and event information, technical specifications etc., all provided by a single source.² The attachments from <http://www.brierleyassociates.com/news/> show construction and engineering services and online news and information in the field of construction provided by the same source.³ The attachments from <http://www.pwt.com/operations/engineering/> show engineering services including subsurface design and construction and related online information including case studies and white papers originating from the same source.⁴ The attachments from <http://www.freemancos.com/> show engineering and construction services provided in conjunction with related news and information.⁵ The attachments from <http://www.timmons.com/> show engineering and construction services provided together with related news and information.⁶ The attachments from <http://www.tsdesigngroup.com/general-contractor.html> show construction and related consulting services provided by the same source.⁷ The attachments from <http://www.jm-a.com/> show construction services, consulting, and news provided by a single source.⁸ The attachments from <http://www.lechase.com/services/preconstructionConsulting.html> show construction services and consulting provided together with building design and construction information.⁹ The Board has

² See p.2-6 of the Final Office Action dated November 7, 2014.

³ See p.7-16 of the Final Office Action dated November 7, 2014.

⁴ See 17-24 of the Final Office Action dated November 7, 2014.

⁵ See p.25-29 of the Final Office Action dated November 7, 2014.

⁶ See p.30-42 of the Final Office Action dated November 7, 2014.

⁷ See p.2 of the Suspension Notice dated February 27, 2104.

⁸ See p.3-4 of the Suspension Notice dated February 27, 2104.

⁹ See p.5-8 of the Suspension Notice dated February 27, 2104.

established that evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related.¹⁰

The evidence in the record establishes that applicant's services and those of the registrant are related for purposes of likelihood of confusion and are provided in the same channels of trade and by the same source. As such, the services of both parties are likely to be encountered by the same group or class of purchasers such that there is likely to be confusion as to the source of the parties' services.

Applicant argues that the services of the parties differ because applicant's services are web-based services that are provided online.¹¹ Applicant's argument is without merit because the evidence of record shows that entities that provide construction services also have websites where they provide online information relating to construction.

Applicant's arguments also fail because applicant's identification broadly describes the subject matter of its information services as relating "to construction" as well as "building construction" and "building material for construction." With respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783,

¹⁰ See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). Material obtained from the Internet is generally accepted as competent evidence. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

¹¹ See p.4 of Applicant's Appeal Brief.

1787 (Fed. Cir. 1990)). In the present case, the subject matter of applicant's information services is broad enough to include information relating to registrant's more specific type of subsurface construction for buildings and other structures. Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

CONCLUSION

Applicant's mark is likely to cause confusion with the registrant's mark because the marks are confusingly similar in appearance, sound, connotation and commercial impression, the services of the parties are related, and the channels of trade are the same. For the foregoing reasons, it is respectfully requested that the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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