

This Opinion is not a
Precedent of the TTAB

Mailed: April 24, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Iris Data Services, Inc.
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Serial No. 86455558
—

Carla Calcagno of Calcagno Law PLLC
for Iris Data Services, Inc.

Andrea Hack, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.¹
—

Before Lykos, Hightower and Lynch,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On November 16, 2014, Iris Data Services (“Applicant”) filed an application to register on the Principal Register the mark displayed below



¹ The prosecution of this application was originally assigned to a different Examining Attorney; the above-referenced Examining Attorney prepared the appeal brief.

for “[l]itigation support services, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit” in International Class 45.²

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark ARC in standard characters for “legal services” in International Class 45³ that, when used on or in connection with Applicant’s identified services, it is likely to cause confusion or mistake or to deceive.⁴

Following issuance of a final refusal, Applicant filed a notice of appeal and a request for reconsideration which was denied. In an effort to overcome the refusal, Applicant amended the identification of services to “[l]itigation support services ***provided exclusively to law firms***, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit.” (emphasis added). The Examining Attorney accepted the amendment but determined that the added restriction failed to obviate the likelihood of confusion. The appeal is now fully briefed.

² Application Serial No. 86455558 filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 1, 2014 as the date of first use anywhere and in commerce. The description of the mark, as amended, is as follows: “The mark consists of the word ‘ARC’ and a design of an arch, all in red on a white background.” The colors red and white are claimed as features of the mark. Applicant also claimed ownership of prior Registration No. 4613576.

³ Registration No. 4015798, registered August 23, 2011 on the Principal Register.

⁴ The refusal to register under Section 2(d) based on cited Registration Nos. 4686009 and 4686010 was subsequently withdrawn.

I. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The likelihood of confusion analysis is not a mechanical test - “not all of the *DuPont* factors are relevant or of similar weight in every case.” *Opryland USA Inc. v. Great Am. Music Show*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). *See also In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (the various *du Pont* factors “may play more or less weighty roles in any particular determination”). With this in mind, we commence our analysis.

A. The Marks

At the outset we consider the *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (internal citation omitted).

Both Applicant's and Registrant's marks share the same literal element – ARC. The presentation of Applicant's mark in stylized lettering fails to obviate this similarity. The registered mark is depicted in standard characters without claim to any particular font style, size, or color. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). As such, it could hypothetically be used in the same font and colors as Applicant's applied-for mark. In addition, when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser's memory and to be used in calling for the services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See, e.g., In re Viterro*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). This is especially true here where the arc design in Applicant's mark is a pictorial representation of the wording, thereby reinforcing the connotation and meaning of the literal element.

In view thereof, we find that Applicant's and Registrant's marks overall are similar in sight, sound, connotation, and commercial impression. This *du Pont* factor weighs in favor of finding a likelihood of consumer confusion.

B. The Services and Channels of Trade

Next, we compare the services as they are identified in the application and registration as well as the similarity or dissimilarity of established, likely to continue trade channels. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d

1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Examining Attorney takes the position that Registrant’s “broadly worded ‘legal services’ includes all manner of legal services activities, including legal discovery and legal document review.” Examining Attorney Brief, 16 TTABVUE 26-27. Specifically, the Examining Attorney argues:

The registrant’s “legal” services would involve “legal discovery” and support for litigation. The identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services “travel in the same channels of trade to the same class of purchasers” as the more limited legal services provided by the applicant. *In re Viterro Inc.*, 671 F.3d at 1362, 101 USPQ2d at 1908. Further, the registration uses the broad wording “legal services,” so this wording is presumed to encompass all legal services, including those in applicant’s more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

Id. In support thereof, the Examining Attorney relies on the online version of *The American Heritage Dictionary* to argue that the definition of “legal” refers to “the law,” and the definition of “litigation” refers to “legal cases.”⁵

Applicant counters that its litigation support/electronic discovery services are not performed by lawyers for clients but rather consist of computer-based services offered to legal professionals for use by attorneys in connection with client representation. As Applicant contends, the identified services

⁵ We grant the Examining Attorney’s request in her appeal brief to take judicial notice of said dictionary definitions. *See In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-1768 (TTAB 2016) (Board may take judicial notice of online dictionary definitions also available in printed form). *See also In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1653 n.8 (TTAB 2005), *aff’d*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007).

... allow the user to access an electronic discovery platform, on a subscription basis, to collect, store, filter, collate, and analyze documents.

Applicant's Brief, p. 3; 11 TTAVUE 4. As support, Applicant refers to its amendment restricting customers exclusively to law firms. Applicant also points to excerpts from its specimen describing the services, including the following:⁶

IRIS arc What Features does it include?

- **Fully functioning Relativity 8.x Environment**
 - Current vetted release
 - Expert Systems & Database Administration
- **Complete Relativity Administration**
 - Add, Update & Delete Users, Groups & Matters
 - Create & Delete Workspaces
 - Set all Security Levels
- **Unlimited Relativity Analytics**
 - Concept Searching & Categorization
 - Keyword Expansion – conceptually related terms
- **Relativity Assisted Review**
 - Technology Assisted Review, computer-aided coding
- **Binders**
 - Partner-level attorney iPad application for deposition planning, client interactions and case-related preparation on the go.

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⁶ When a term used in the identification is unclear, the Board may resort to extrinsic evidence to determine or clarify how the term is used or understood in the relevant industry or trade. See *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010) (“However, applicant has submitted extrinsic evidence to demonstrate the meaning of its description of goods, not to restrict or limit the goods. Where, as here, applicant’s description of goods provides basic information, and the goods are of a technical nature, it is entirely appropriate to consider extrinsic evidence to determine the specific meaning of the description of goods.”).



IRIS | arc Iris Discovery Management

- **Iris arc is part of Iris' managed services program**
- **Focus on practicing law, not implementing technology...**
 - No more **outsourcing** to evaluate...
 - No more **software** to license...
 - No more **upgrades** to schedule...
 - No more **versions** to install...
 - No more **systems** to integrate...
- Ramp up/down for large cases...
- Expert people to fill in the gaps...



Relativity

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IRIS | arc Iris DM Advantages

- **Increased Law Firm Revenue**
 - Spread cost across multiple matters
 - Subscription fee—predictable monthly amount
 - Minimal upfront investment
- **Encompasses End-to-End Services**
 - Complete nearly all requests internally; eliminate the need to outsource
- **Iris Innovative Technologies & Development**
 - Learn from Iris processes & experience
 - When Iris improves its environment, your environment is automatically updated
- **Iris Reliable Infrastructure & Support**
 - Fast & easy scalability
 - Iris support & resources readily available
 - Proven workflows & project tracking applications

“Iris DM will allow Dykema to spend less time managing vendors & litigation technologies and more time practicing law.”

*Scott Pilat
Manager of Legal Technologies
Dykema Gossett PLLC*

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The Examining Attorney urges the Board to find that the involved services are legally identical based on dictionary definitions, thereby entitling the Board to rely on the presumption that the services fall in the same trade channels. We do not find the Examining Attorney's reasoning convincing. The definitions of "legal" and "law" proffered by the Examining Attorney are too imprecise for us to find that they subsume electronic discovery services of the type identified here. Other than the dictionary definitions, the Examining Attorney has submitted no evidence to show that the involved services are legally identical, or even for that matter related. For example, there is no record evidence showing that third-parties provide both legal services and litigation support services in the nature of conducting electronic legal discovery marketed solely to law firms. In addition, Applicant's added restriction that its services are provided "exclusively to law firms" renders the trade channels distinct. The record is devoid of evidence that the professionals employed at law firms responsible for purchasing electronic discovery services are also the same individuals retaining "legal services" within the context of a traditional attorney/client relationship. While law firms could theoretically also be the consumers of "legal services" in general they are not. Thus, Applicant's litigation support/electronic discovery services are rendered in a different market segment. As Applicant explains by way of analogy,

... [W]hile law firms do engage in research for their client representations, that does not mean that they offer electronic legal research services such as those offered by LEXIS or WESTLAW. Instead, the record reflects that lawyers and law firms use services such as LEXIS and WESTLAW and Applicant's electronic discovery services as computerized tools in performing their own services.

Applicant's Brief, p. 15; 11 TTABVUE 16 (emphasis in the original).

This leaves us with no record evidence to show that the involved services are legally identical or related. Simply because the services have something to do with the legal field does not make them per se related. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d at 1410 (“[A] finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both.”) (internal citation omitted); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). In other words, a shared industry or field does not necessarily equate to an identical target market or related services.

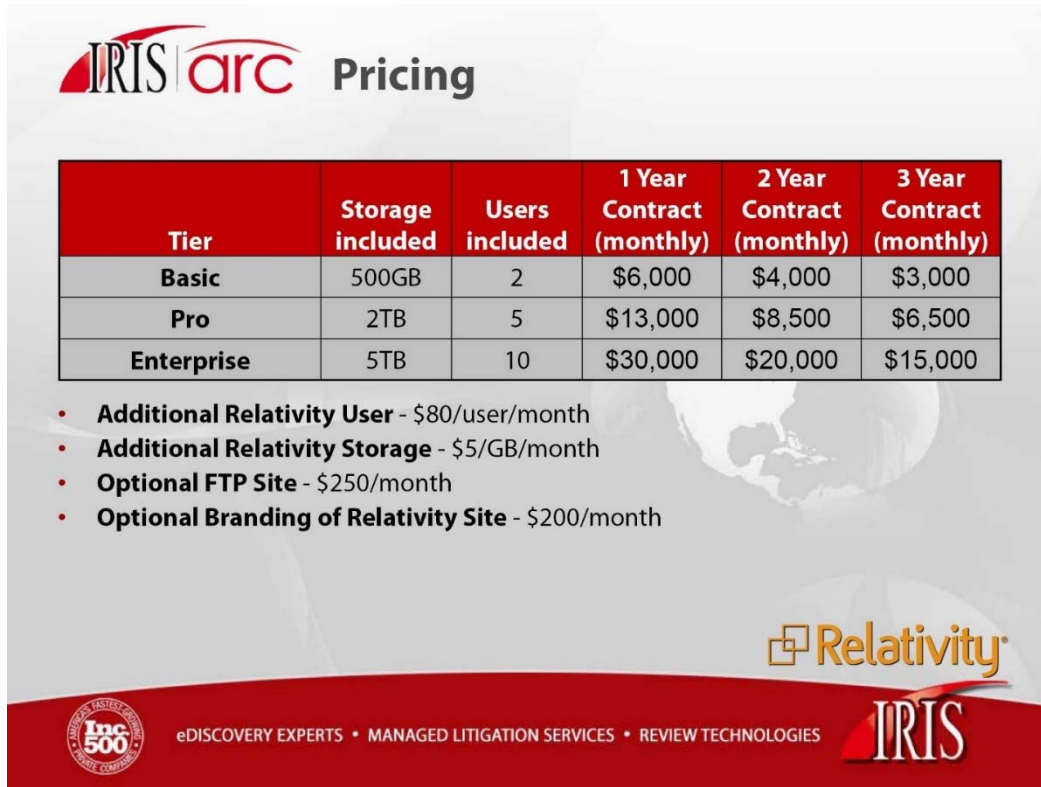
In short, we cannot conclude, based on the record herein, that consumers would assume that Applicant's “[l]itigation support services provided exclusively to law firms, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit” and Registrant's “legal services” would come from the same source and be marketed to the same consumers. Absent any evidence to show that these services are related and offered in the same channels of trade, we simply cannot draw the inference suggested by the Examining Attorney based solely on dictionary definitions. These *du Pont* factors therefore weigh against a finding of likelihood of confusion.

C. Conditions of Sale

We now consider the conditions under which the services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

There is no restriction in Registrant's "legal services" so we must assume that this encompasses both high-priced and low-priced legal services, and even legal services offered on a pro bono basis. That being said, given the nature of the services, we can assume that potential clients will exercise a relatively high degree of care when deciding whom to hire.

The record shows the following pricing for Applicant's electronic discovery services sold to law firms as a subscription based on the number of users and length of time:



IRIS arc Pricing

Tier	Storage included	Users included	1 Year Contract (monthly)	2 Year Contract (monthly)	3 Year Contract (monthly)
Basic	500GB	2	\$6,000	\$4,000	\$3,000
Pro	2TB	5	\$13,000	\$8,500	\$6,500
Enterprise	5TB	10	\$30,000	\$20,000	\$15,000

- **Additional Relativity User** - \$80/user/month
- **Additional Relativity Storage** - \$5/GB/month
- **Optional FTP Site** - \$250/month
- **Optional Branding of Relativity Site** - \$200/month

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As the chart illustrates, the most basic service for only 2 users and 500 GB of data costs \$72,000 annually; if the number of users increases to 10 with 5 terabytes of data, the price jumps to \$360,000 per year. The relatively high price and specialized nature of Applicant's services mandates careful, deliberative purchasing decisions. We can also assume that purchasers of Applicant's services are highly sophisticated professionals knowledgeable about electronic discovery and information technology. Accordingly, this *du Pont* factor also weighs against a likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) ("[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.").

II. Conclusion

We have carefully considered all evidence of record and arguments, even if not specifically discussed herein, as they pertain to the relevant *du Pont* factors.⁷ Balancing these factors, we find that the similarity of the marks is outweighed by the fact the record is devoid of evidence that the involved services are related and marketed in the same trade channels. Moreover, neither Applicant's nor Registrant's services are impulse purchases. And as explained in detail above, Applicant's services are relatively expensive. Simply put, the record before us fails to establish that the circumstances surrounding the marketing of Applicant's "[l]itigation support services provided exclusively to law firms, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit," on the one hand, and Registrant's "legal services," on the other hand, are such that relevant purchasers would mistakenly believe that the respective services originate from the same source, even if a highly similar mark is used on both. "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc.*, 21 USPQ2d at 1391 (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d

⁷ Applicant argues and has introduced evidence of third-party registrations and uses purporting to show that the cited mark is weak. See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). We have reviewed this evidence and do not find it persuasive. We therefore deem this sixth *du Pont* factor neutral.

1403, 164 USPQ 43, 44-45 (CCPA 1969)). Accordingly, we find that confusion is unlikely between Applicant's applied-for mark and the mark in the cited registration. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) ("The board placed the greatest weight on its findings that the goods in question were not related and that the channels of trade and purchasers are different. Because of the dominant role these factors play in this case, we find no error in the weight the board accorded them."); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010) ("Because of the differences in the channels of trade and customers for applicant's and the registrant's goods, there is virtually no opportunity for confusion to arise.").

Decision: The Section 2(d) refusal is reversed.