

This Opinion is Not a
Precedent of the TTAB

Mailed: November 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Anton Anisimov
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Serial No. 88149531
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Jason Bergeron of Legalforce RAPC Worldwide PC,
for Anton Anisimov.

Kieu-Nhi Le, Trademark Examining Attorney, Law Office 129,
Pam Willis, Managing Attorney.

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Before Kuhlke, Wolfson and Allard,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Anton Anisimov (“Applicant”) seeks registration on the Principal Register for the
mark INVOODOO in standard characters for services ultimately identified as:

Computer software consulting, not including game
software; Software design and development, not including
gaming software, in International Class 42.¹

¹ Application Serial No. 88149531, filed on October 10, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on allegations of first use and first use in commerce on May 15, 2006.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified services, so resembles the registered mark VOODOO in standard characters for "Designing and developing downloadable electronic game software," in International Class 42² as to be likely to cause confusion.

When the Section 2(d) refusal was made final, Applicant appealed and briefs have been filed. We affirm the refusal to register.³

I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. See *In re Chatam Int'l*

² Registration No. 6441491, issued on August 3, 2021. The registration includes other goods and services in International Classes 9 and 35 not at issue in this proceeding.

³ Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR).

Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all [*DuPont*] factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the [services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity/Dissimilarity of the Marks

We compare the marks in their entirety as to “appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

In comparing Applicant’s mark INVOODOO with Registrant’s mark VOODOO the similarities are self-evident. Applicant’s mark INVOODOO incorporates the entirety of Registrant’s mark VOODOO. In addition, because Applicant’s and Registrant’s marks are in standard characters they are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the

wording and not in any particular display. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). We must consider Applicant's and Registrant's marks "regardless of font style, size, or color," *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011), including iterations that emphasize the common element VOODOO and deemphasize the element IN such as inVOODOO, or (as Applicant presents its mark) InVooDoo using capital letters to indicate the separate word IN. Thus, the addition of the word IN to the beginning of Applicant's mark is not sufficient to outweigh the similarities in appearance and sound.⁴

The term VOODOO is defined as "a religion of West African origin."⁵ This term is arbitrary in connection with Applicant's and Registrant's goods and is separately recognizable in Applicant's mark and, as such, presents the same connotation and overall commercial impression in both marks.

We bear in mind that the "marks 'must be considered . . . in light of the fallibility of memory.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ2d 1, 3 (CCPA 1977)). While a close side-by-side comparison of the marks could reveal the slight differences between them, that is not the proper

⁴ Applicant concurs that the word IN will be perceived as a separate element in its mark. "Applicant's mark starts with the word IN which is missing in the Cited mark." App. Brief, 4 TTABVUE 10.

⁵ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (<https://ahdictionary.com>), November 17, 2021 Office Action, TSDR p. 2.

way to determine likelihood of confusion, as that is not the way customers will view the marks in the marketplace. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *see also In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983) and cases cited therein; *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016). To customers in the marketplace, the marks have a similar appearance and sound, and would convey a similar connotation and commercial impression. In terms of appearance, sound, connotation, and commercial impression, we find the similarity of the marks — considered in their entirety — outweighs their dissimilarity. In view thereof, the similarity of these marks weighs in favor of a finding of likelihood of confusion.

B. Relatedness of the Services, Trade Channels, Classes of Consumers, and Conditions of Sale

When considering the services, trade channels, classes of consumers and conditions of sale, we must make our determinations based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the [services] in question are different from, and thus not related to, one

another in kind, the same [services] can be related in the mind of the consuming public as to the origin of the [services].”). In order to support a finding of a likelihood of confusion, it is sufficient that the types of services of an applicant and registrant are related in some manner or that the conditions surrounding the marketing of these types of services are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000).

In support of the Office’s position, the Examining Attorney submitted printouts from several third-party websites arguing they show that “computer software consulting’ and ‘software design and development’ for gaming and non-gaming software are services commonly provided by the same entity and marketed and sold under the same mark.” Ex. Att. Brief, 6 TTABVUE 11. The examples are summarized below:

- vironIT, advertising software development services, including application development and consultancy more generally, as well as game development;⁶
- Redwerk, advertising software development services in the fields of business automation, e-commerce and healthcare, among others, as well as game development;⁷

⁶ November 17, 2021 Office Action, TSDR pgs. 4-8, 20-30.

⁷ *Id.* at 9-19.

- IntellectSoft, advertising game development and financial software development;⁸
- Chetu, advertising general custom software development services for business operations “for startups, small-to-midsize (SMB), and enterprise-size businesses”, as well as game development services and fantasy sports software development services;⁹
- Zintzotek, advertising custom application development and game development;¹⁰
- Skywell Software, advertising software development services within the “logistics, retail, agriculture, food & beverage” industries and custom game development services;¹¹
- IMG, advertising application development, game development, and web development;¹² and
- Innovecs, advertising FinTech software development services and game development services.¹³

The examples of third-party use show that in the marketplace, consumers are exposed to the same mark used for the respective services, indicating a single source

⁸ *Id.* at 31-47.

⁹ *Id.* at 48-71.

¹⁰ *Id.* 72-76.

¹¹ *Id.* 77-96.

¹² *Id.* 97-106.

¹³ *Id.* 107-139.

for both and an overlap in trade channels and classes of consumers. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-73 (TTAB 2009) (website evidence shows same or overlapping channels of trade).

Applicant's arguments do not persuade us of a different result. Applicant is correct that simply being in the same general industry is not sufficient for a finding of relatedness; however, that is not the basis of the Office's refusal. Rather, the record shows the types of software services offered by Applicant and Registrant are offered by the same source under the same mark. Contrary to Applicant's contention, the evidence is sufficiently probative. The examples do not "cover a wide swath of products and services" to render the evidence unpersuasive. App. Brief, 4 TTABVUE 19. That Applicant and Registrant themselves do not provide both services in the same trade channels does not change consumer perception, having been accustomed to seeing such services under the same mark.

As Applicant states, it is about the marketplace. The question is not whether Applicant and Registrant offer their services in the same trade channels, but rather, whether these types of services are offered in the same trade channels. We must make our determination based on the identification in the registration, not based on a registrant's or applicant's actual use as shown through extrinsic evidence. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1162 (Board must "give full sweep" to an identification of goods [or services] regardless of registrant's actual business); *cf. Anheuser-Busch, LLC v.*

Innovopak Sys. Pty Ltd., 115 USPQ2d 1816, 1825 (TTAB 2015) (in opposition, giving “full sweep” to applicant’s goods as identified) (citing *Paula Payne Prods. Co. v. Johnson Publ’g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973)).

Focusing on the marketplace conditions, Applicant argues that the respective services are of a type that inherently require careful purchasing decisions. We agree these are not impulse items and by their nature, even without evidence, we may infer there would be more care in the purchasing decision. However, on this record we find this does not outweigh the other factors. Despite some heightened care in purchasing the respective services, the relationship between the respective types of services and the overlap in their channels of trade and classes of consumers favor a finding of likelihood of confusion. *Stone Lion*, 110 USPQ2d at 1163-64 (consumers exercising care not immune from source confusion where similar marks used in connection with related services).

II. Conclusion

In sum, we hold that because the marks are similar, the services are related, and the trade channels and classes of consumers overlap, confusion is likely between Applicant’s INVOODOO mark and Registrant’s VOODOO mark.

Decision: The refusal to register Applicant’s mark is affirmed under Trademark Act Section 2(d).