

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 21, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Imagine Labs LLC*

Serial Nos. 88931892  
88931930  
88931972

Peter B. Bartram for Imagine Labs LLC, pro se.<sup>1</sup>

Alec Powers, Trademark Examining Attorney, Law Office 101,  
Zachary R. Sparer, Managing Attorney.

Before Kuhlke, Larkin and Allard,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

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<sup>1</sup> Imagine Labs LLC appeared in this proceeding through its President, Peter B. Bartram.  
See Patent and Trademark Office Rule 11.14(e)(3), 37 C.F.R. § 11.14(e)(3).

Imagine Labs LLC (“Applicant”) seeks registration on the Principal Register for the marks IMAGINELABORATORIES.COM,<sup>2</sup> IMAGINELABORATORY.COM<sup>3</sup> and IMAGINELABS.NET<sup>4</sup> in standard characters for services ultimately identified as:

Telecommunications engineering consultancy; Telecommunications technology consultancy; Custom design and engineering of telephony systems and fiber optics; Technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services, in International Class 42.

The Trademark Examining Attorney refused registration of Applicant’s marks in each application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s marks, when used in connection with the identified services, so resemble the registered mark IMAGINATION LABS in standard characters for:

Television and internet broadcasting of live events and performances relating to marketing, communication, product launches and brands; Computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest [chat rooms]; streaming of audio, video, audiovisual material on the Internet; Telecommunications consultation and advice, in International Class 38<sup>5</sup>

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<sup>2</sup> Application Serial No. 88931892, filed on May 25, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on allegations of first use on May 5, 1995 and first use in commerce on May 18, 1995 of the mark in a different form.

<sup>3</sup> Application Serial No. 88931930, filed on May 25, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on allegations of first use on May 5, 1995 and first use in commerce on May 18, 1995 of the mark in a different form.

<sup>4</sup> Application Serial No. 88931972, filed on May 25, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on allegations of first use on May 5, 1995 and first use in commerce on May 18, 1995 of the mark in a different form.

<sup>5</sup> Registration No. 6166220, issued on October 6, 2020. The registration includes other services in International Classes 9, 16, 35, 37, 41, 42, 43.

as to be likely to cause confusion.

When the Section 2(d) refusals were made final, Applicant requested reconsideration in each application. After the Examining Attorney denied the requests, Applicant appealed and briefs have been filed. We affirm the refusals to register.<sup>6</sup>

### I. Evidentiary Issue

The Examining Attorney objects to “new evidence” submitted with Applicant’s appeal brief. Specifically, the Examining Attorney asserts “[t]he applicant’s analysis on appeal included new references to content of particular websites and quotes from authors in a new attempt [sic] distinguishing the terms ‘imagination’ and ‘imagine’.” Ex. Att. Brief, 10 TTABVUE 7. Certain website URLs and information from Registrant’s website were provided in Applicant’s March 22, 2021 Response and excerpts from Applicant’s websites were submitted as specimens of use. Moreover, we do not consider random quotes from various public figures to be “new evidence.” However, the objection is sustained to the extent that website references that had not been provided during prosecution have not been considered. In addition, merely

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<sup>6</sup> On February 1, 2021, the Board granted the Examining Attorney’s motion to consolidate the appeals. 9 TTABVUE; *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1085 (TTAB 2016) (Board consolidated appeals in two applications upon examining attorney’s motion). 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](http://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). Unless otherwise indicated, citations are to the TSDR and TTABVUE records in Application Serial No. 88931892.

providing a link to a website without the material attached is not sufficient to introduce the website itself into the record. *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided). Because the Examining Attorney did not object to the link and the reference to information on the website provided in the March 22, 2021 Response, we consider that matter for whatever probative value it may have.

Finally, we note the Examining Attorney’s objection to “applicant’s collateral attack of the registrant’s website as evidence of nonuse of its mark” and request that it “not be considered.” Ex. Att. Brief, 10 TTABVUE 7. As discussed below, arguments seeking to restrict the scope of a registration are ineffectual as Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides prima facie evidence of validity to the full scope of a registered mark.

## II. 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 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 entireties 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 marks IMAGINELABORATORIES.COM, IMAGINELABORATORY.COM and IMAGINELABS.NET with Registrant’s mark IMAGINATION LABS the similarities are self-evident. Both begin with the letters

IMAGIN to form the related words IMAGINE and IMAGINATION followed by forms of the word LABORATORY. The words IMAGINE and IMAGINATION have similar connotations and overall commercial impressions as do the words LABORATORIES LABORATORY and LABS. The record includes the following Wikipedia and dictionary definitions.

- Imagination -- Imagination is the ability to produce and simulate novel objects, sensations, and ideas in the mind without any immediate input of the senses.<sup>7</sup>
- Imagine -- ... to use the imagination<sup>8</sup>
- Lab – A lab is the same as a laboratory<sup>9</sup>

The addition of the TLD's .com and .net do not serve to distinguish the marks. These additions merely add the connotation of a domain address to the marks. *Apple Computer v. TVNET.net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

Applicant argues that the difference between the words IMAGINATION and IMAGINE distinguishes the marks. For example, Applicant argues:

Having imagination and not actively imagining is equal to not having any imagination. Therefore the act of imagining something is vastly different than the inherent ability of imagination in every human mind.

App. Brief, 6 TTABVUE 12.

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<sup>7</sup> March 4, 2021 Office Action, TSDR at 8 (Wikipedia.org).

<sup>8</sup> *Id.* at 14 (merriam-webster.com).

<sup>9</sup> *Id.* at 27 (collinsdictionary.com American English); *see also id.* at 35 (merriam-webster.com "Definition of lab: Laboratory").

The fact that “imagination” is a noun and “imagine” is a verb does not remove the relationship between these words as shown by the definition – “Imagine ... means to use the imagination.” This relationship results in a similar connotation and commercial impression.

Applicant also argues that because its marks are domain names and the cited mark is a “Brand Service name” there is no cause for confusion. App. Brief, 6 TTABVue 14. As noted, use of the TLD’s, although adding the domain connotation, does not obviate the similarity occasioned by the first part of Applicant’s mark. Applicant seeks to register these “domain names” as trademarks or “Brand service names.” At a minimum, the first part of Applicant’s marks would be perceived as a “Brand service name[s].” It is common practice for brand owners to add a TLD to their brand names. *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (Board may take judicial notice of commonly known facts); *see also B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988); *In re Perry Mfg. Co.*, 12 USPQ2d 1751, 1752 (TTAB 1989).

Applicant also points to two of its registrations that issued prior to the cited registration, arguing that the USPTO already found these marks could co-exist, thus, the marks in the subject applications may co-exist with the mark in the cited registration. For example, Applicant argues:

If we examine the case of our Registered Trademark **Imagination Arts Lab** (Filed on August 2, 2012, Serial #85693301, Registration # 4606041 which registered on September 16, 2014) and the Registered Trademark **Imagination Labs** (Filed on Jun. 19, 2019 Serial # 79267253, Registration # 6166220 which was registered

**six years after** on October 06, 2020) we can see that even in a case of exact match of the words **Imagination** and **Labs**, the USPTO allowed the later trademark to proceed to registration and deemed that there was no Likelihood of Confusion between these two marks. This sets a USPTO precedent that **even in a case of an exact word match of Imagination and Lab(s) and an almost exact word match of each entire trademark**, there is enough difference between these Marks to assume there is no Likelihood of Confusion. Therefore there can be no Likelihood of Confusion between marks that use two **different** words in meaning and spelling (Imagination vs Imagine) or **different** extensions (Labs vs Laboratories.com, Laboratory.com, and Labs.net) forming entirely **different** words and trademarks.

Since the USPTO has decided precedent, there is no Likelihood of Confusion between:

**Imagination Labs versus Imagination Arts Lab**

Therefore there should be no Likelihood of Confusion between:

**Imagination Labs versus ImagineLaboratories.com**

**Imagination Labs versus ImagineLaboratory.com**

**Imagination Labs versus ImagineLabs.net**

6 TTABVUE 15-16 (emphasis supplied by Applicant).

Each case must be decided on its own merits. *E.g., In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). The USPTO is not bound by the decisions of the examining attorneys who examined the applications for an applicant's previously registered marks, based on different records. *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1871 (TTAB 2001); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re Nat'l Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118



USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (upholding examining attorney’s requirement for amendment of the term “chronographs” in the identification of goods, notwithstanding applicant’s ownership of several registrations in which this term appears without further qualification in the identification); *In re Merrill Lynch, Pierce, Fenner, & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars).

One exception is set forth in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012), where the Board reversed a refusal to register the mark ANYWEAR (in stylized text) for “footwear,” finding no likelihood of confusion with the registered mark ANYWEAR BY JOSIE NATORI (and design), for “jackets, shirts, pants, stretch T-tops and stoles.” Given the similarity in the marks and the relatedness of the goods, the Board stated that “under usual circumstances” it would conclude that confusion is likely to occur; however, an “unusual situation” compelled the Board “to balance

the similarities between the marks and goods against the facts that applicant already owns a registration for a substantially similar mark for the identical goods, and that applicant's registration and the cited registration have coexisted for over five years."

When determining whether the coexistence of an applicant's prior registration with a cited registration weighs against affirming a Section 2(d) refusal of the applicant's applied-for mark, we consider: (1) whether the applicant's prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods/services in the application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has co-existed with the registration being considered as the basis for the Section 2(d) refusal. *See Strategic Partners*, 102 USPQ2d at 1400.

The facts presented by the subject applications and prior registrations do not fit within this exception because the marks and services in the prior registrations are different. *Inn at St. John's*, 126 USPQ2d at 1748 (finding that applicant's earlier registration of a partially similar mark was a neutral factor in the §2(d) analysis, because the applied-for mark was more similar to the cited registered mark than applicant's previously registered mark); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (distinguishing *Strategic Partners* and finding that the 3½-year coexistence of applicant's prior registration and the cited registration was a relevant consideration but did not outweigh the other relevant *DuPont* factors). These differences also serve to underscore why such prior actions by

the USPTO are not binding on subsequent applications and why each case must be analyzed on its own record.

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 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 would convey a similar connotation and commercial impression. In terms of appearance, connotation, and commercial impression, we find the similarity of the marks — considered in their entirety — outweighs their dissimilarities. 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 and Classes of Consumers


When considering the services, trade channels and classes of consumers, 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 Capital Partners, L.P. v.*

*Lion Capital 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 goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”).


It is sufficient to support a finding of a likelihood of confusion that the types of services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing 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).

The Examining Attorney asserts that Applicant’s “Telecommunications engineering consultancy; Telecommunications technology consultancy” services in International Class 42 are closely related to Registrant’s services “Telecommunications consultation and advice,” in International Class 38 because they “both involve telecommunications consultancy.” Ex. Att. Brief, 10 TTABVue 10. To support this position, the Examining Attorney relies on several third-party

registrations that include both services under the same mark. A few examples are set out below.<sup>10</sup>

Registration No.	Mark	Services
6139126	GIGABITNOW	Telecommunications consultation Class 38; Telecommunications technology consultancy Class 42
6110877	TRIBALCO	Telecommunications consultation Class 38; Telecommunications engineering consultancy; Telecommunications technology consultancy Class 42
5953370	ISOFUSION	Telecommunications consultation Class 38; Telecommunications technology consultancy Class 42
5404944	PROFOCUS	Telecommunication consultation in the nature of technical consulting in the field of audio, text and visual data transmission and communication Class 38; Telecommunications technology consultancy Class 42
6037506	 <b>speedcast</b> <small>THE CRITICAL COMMUNICATIONS COMPANY</small>	Telecommunications consultancy in the field of data processing equipment... Class 38; Telecommunications technology consultancy Class 42

<sup>10</sup> March 4, 2021 Office Action, TSDR at 42-80.

5290276		Telecommunications consultation Class 38; Telecommunications technology consultancy Class 42
5602440	ARRAKIS CONSULTING	Telecommunications consultation Class 38; Telecommunications technology consultancy Class 42

In addition, the Examining Attorney submitted printouts of third-party websites showing the same entity providing telecommunication consultation and telecommunication technology consultation under the same mark (Elite Technologies & Communications ... provides full service telecom consulting, and beginning-to-end telecom engineering solutions (April 24, 2021 Office Action, TSDR 30); CelPlan ... Telecommunications Engineering and Consulting (*Id.* at 34)).

The Examining Attorney argues first that “the fact that the applicant’s services are in International Class 42 and the registrant’s services have been classified in International Class 38 does not affect the determination of relatedness for purposes of a likelihood of confusion analysis,” and then argues that “the registration uses broad wording to describe ‘telecommunications consultation and advice’, which presumably encompasses all services of the type described, including applicant’s more narrow services namely, ‘Telecommunications engineering consultancy; Telecommunications technology consultancy; Custom design and engineering of telephone systems, cable television systems and fiber optics; Technical consulting services in the fields of datacenter architecture, public and private cloud computing

solutions, and evaluation and implementation of internet technology and services’. ... Thus, applicant’s and registrant’s services are legally identical.” Ex. Att. Brief, 10 TTABVUE 11-12.

It is correct that classification itself does not impact the analysis of likely confusion; it is the manner in which the services are identified that controls. *Compare In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047 (Fed. Cir. 2018); *Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) with *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 & n.5 (TTAB 1990). However, in some cases if certain words are included or omitted that may impact classification. In this case, Applicant’s services include the words “engineering,” “technology,” and “technical” which places those services in Class 42. By contrast, the registration omits such words and focuses only on the telecommunications aspect, keeping it in Class 38. To interpret Registrant’s services as including “engineering,” “technology,” or “technical” would make it indefinite as it would include services in two Classes. Therefore, we do not view Registrant’s services as encompassing Applicant’s services such that they would be legally identical.

Although not legally identical, based on the third-party registrations and examples of third-party uses we find the services to be related and to be offered in the same channels of trade. *Hewlett-Packard Co.*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff’d per curiam*, 864 F.2d 149 (Fed. Cir. 1988). Applicant’s unrestricted

“Telecommunications engineering consultancy; Telecommunications technology consultancy;” and Registrant’s unrestricted “Telecommunications consultation and advice,” all separated by semi colons, stand apart from the remaining more detailed services. *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013) (finding that, because a semicolon separated the two relevant clauses in registrant’s identification, its “restaurant and bar services” is a discrete category of services that stands alone and independently as a basis for likelihood-of-confusion analysis, and is not connected to nor dependent on the services set out on the other side of the semicolon). It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

The examples of third-party use show that in the context of the marketplace, consumers are exposed to the same mark used for the respective services, indicating a single source for both and an overlap in trade channels and classes of consumers. *See, e.g., Davey Prods.*, 92 USPQ2d at 1203-04; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-73 (TTAB 2009) (website evidence shows same or overlapping channels of trade).

Applicant first argues that “There is virtually no similarity between what they claim as their Good and Services and ours in Class 042. The only goods and services that even bear a close resemblance to our goods and services in Class 042 is:



**computer software design and development, namely, design and development of software applications for mobile telephones.”** App. Brief, 6 TTABVue 25 (emphasis in original). Applicant then argues based on excerpts from Registrant’s website that:

There is No Statement on their website that indicates actual use of the design and development of software applications for mobile telephones. Our Goods and Services could relate to Mobile Phone Applications in the future but it would seem that in the vast, broad claims and multiple Classes of Goods and Services in the Imagination Labs Trademark and their meager real world Actual Use found in the descriptions on their website that this would be stretching the claim of Likelihood of Confusion into something it is not, resembling a Pretzel.

*Id.*

These arguments are not persuasive. First, as noted above, the fact that services are in a different class does not preclude them from being related and, as shown by the record, Registrant’s Class 38 services are related to Applicant’s Class 42 services. Second, we must make our determination based on the identification in the registration not based on a registrant’s actual use as shown through extrinsic evidence. *Detroit Athletic Co.*, 128 USPQ2d at 1052; *Stone Lion*, 110 USPQ2d at 1162 (Board must “give full sweep” to an identification of goods [or services] regardless of registrant’s actual business). Restriction of a registration to the actual use of the mark in the marketplace may be done in a separate cancellation proceeding but not in the context of an ex parte appeal, where it is considered an impermissible collateral attack on the registration. *Detroit Athletic Co.*, 128 USPQ2d at 1053 (noting that applicant’s objection to the breadth of the goods or trade channels described in the

cited registration “amounts to an attack on the registration’s validity” and that “the present ex parte proceeding is not the proper forum from which to launch such an attack,” which is “better suited for resolution in a cancellation proceeding”). A registration enjoys presumptions under Section 7, 15 U.S.C. § 1057, including coverage for the full scope of its services **as identified in the registration**. *Id*; see also *In re Bercut-Vanderboort & Co.*, 229 USPQ 763, 764-765 (TTAB 1986) (“[T]he question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods [and services] identified in the application vis-à-vis the goods [and services] recited in the registration, rather than what extrinsic evidence shows those goods to be.”). Applicant’s arguments go to marketplace realities that are not reflected in the registration.

We find the relationship between the services and the overlap in their channels of trade and classes of consumers favor a finding of likelihood of confusion.

### C. Actual Confusion

Applicant asserts that:

We are unable to see how this seems like a case of likelihood of confusion, the chance of anyone confusing the two companies is zero, we have owned the domain Imagine.com and we have never had anyone confuse our domain with imagination.com owned by The Imagination Group Limited and we have never received a phone call for Imagination. In the real world outside of this trademark application, no one will actually confuse the two trademarks in practice.

App. Brief, 6 TTABVUE 13.

The question of actual confusion is addressed in the factors looking at the “nature and extent of any actual confusion” and the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. As to the factor looking at the nature and extent of any actual confusion, uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *Majestic Distilling*, 65 USPQ2d at 1205. *See also In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion).

First, Applicant’s argument pertains to coexistence with a different mark, IMAGINE.COM. Moreover, in the context of an ex parte appeal, there is no opportunity to hear from the registrant about whether it is aware of any reported instances of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”) (citations omitted).

As distinct from our analysis as to the similarity or dissimilarity of the services, channels of trade, and relevant consumers, which are based on the identifications as

set forth in the application and the cited registration, the factor considering the absence of evidence of actual confusion, by contrast – “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *see DuPont*, 177 USPQ at 567 – requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, \*6 (TTAB 2020). Here, there is no evidence that in the actual marketplace, the same consumers have been exposed to both marks for the respective services, such that we could make a finding as to the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567.

In any event, “the test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion.” *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439-40 (TTAB 2006); *see also Detroit Athletic Co.*, 128 USPQ2d at 1053 (“[T]he relevant test is likelihood of confusion, not actual confusion.”) (emphasis in original); *i.am.symbolic*, 123 USPQ2d at 1747 (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion.”) (quoting *Herbko Int’l.*, 64 USPQ2d at 1380).

We find these factors to be neutral.

### III. 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

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Applicant's IMAGINELABORATORIES.COM, IMAGINELABORATORY.COM and IMAGINELABS.NET marks and Registrant's IMAGINATION LABS mark.

**Decision:** The refusals to register Applicant's marks are affirmed under Trademark Act Section 2(d).