

THIS DISPOSITION IS
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re UMI Company

Serial No. 75/003,713

Richard A. Gaffin of Miller, Canfield, Paddock and Stone,
P.L.C. for UMI Company

Julia S. Shields, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney)

Before Cissel, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by UMI Company (a
corporation of Delaware) to register the mark INFOSTORE for
"obtaining article reprints, reports, documents and
government records in an expedited manner, in subject areas
requested by the customer."¹

¹ Application Serial No. 75/003,713, filed October 6, 1995. The
claimed date of first use is April 27, 1995. Applicant claimed
ownership of Registration No. 1,399,896, issued July 1, 1986,
Section 8 accepted, Section 15 acknowledged, for the mark THE
INFORMATION STORE for "document retrieval services," with a

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The Trademark Examining Attorney has refused registration 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 its identified services, so resembles the registered mark shown below

for "pickup, storage and delivery services for documents, files and computer media,"² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See

claimed date of first use of January 19, 1979. The term "information" is disclaimed.

² Reg. No. 1,514,878, issued November 29, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Examining Attorney contends that the word feature is dominant in both marks; that the slightly different spellings are phonetic equivalents; that applicant has simply adopted the word portion of the registered mark in its mark; and that as applicant's mark INFOSTORE is presented for registration in typed form, applicant could alter the actual presentation of the mark at any time in other ways that emphasize the two syllables. The Examining Attorney further contends that the services, as identified, are similar and overlapping; and that it is presumed that the registrant's broad identification of services encompasses all types of pickup, storage and delivery of documents, including those covered by applicant's more specific recitation of services; and that the services must be presumed to travel through all normal channels of trade and are available to all potential consumers.³

³ Applicant essentially objected to the excerpted Nexis stories submitted by the Examining Attorney on the basis that these stories are incomplete and are hearsay. Applicant's objection is not well taken because applicant was at liberty to investigate and file any additional portions of the stories it found beneficial, and because the excerpted stories are considered only in that they show the terms appeared in the articles, not for the truth of the matters asserted therein. See *In re Murphy Door Bed Company, Inc.*, 223 USPQ 1030, footnote 9 (TTAB 1984).

Applicant contends that the marks present different connotations, specifically, registrant's mark connotes "storage" while the applicant's connotes "store"; that the registered mark includes a significant design; that the registrant's services, as shown on the specimens of record in the application which matured into the registration, are essentially a document storage service, whereas applicant has shown that it offers a research service which locates, copies and provides third-party material to its customers; and that within the broad category of information management, there should be no per se rule of a finding of likelihood of confusion.⁴

Turning first to a consideration of the respective marks, we find there is a strong similarity between the marks. It is clear that registrant's mark includes a design feature. However, it is not improper to give more weight to a dominant feature of a mark, in this instance, the word portion of the mark. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and

⁴ The Examining Attorney, citing TBMP §1208, objected to all four exhibits submitted by applicant on the basis that they were not accompanied by an authenticating affidavit or declaration. We find the Examining Attorney's reading of the TBMP too strict. There is no requirement that every item of evidence submitted by the applicant in an ex parte case must be verified by affidavit or declaration. We have considered applicant's exhibits for whatever probative value, if any, they have.

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In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). Applicant's word mark is identical in sound to the word portion of the cited registrant's mark. The inclusion of the silent letter "E" in applicant's mark is insignificant regarding the pronunciation.

The design feature of registrant's mark does not serve to distinguish the marks because purchasers are unlikely to remember some differences between the marks. Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255, 259 (TTAB 1980). The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).

The words INFOSTOR and INFOSTORE are also similar, if not identical, in connotation. Applicant's argument that

the syllable "STORE" in its mark suggests "a retail entity for finding information" (brief, p. 6), whereas "STOR" in the registrant's mark suggests "storage," is not persuasive. First, this is merely argument by applicant's attorney, as there is no evidence of record that the purchasing public would draw these distinctions. Moreover, we take judicial notice of The American Heritage Dictionary definition of "store" which includes not only "a place where merchandise is offered for sale," but also "to receive or put away for future use."⁵ That is, the word "store" relates not only to retail stores but also to storing items someplace.

We find that applicant's mark and the registrant's mark are substantially similar in sound, pronunciation, connotation, and overall commercial impression.

Turning next to a consideration of the involved services, applicant's services are "obtaining article reprints, reports, documents and government records in an expedited manner, in subject areas requested by the customer," and the services in the cited registration are "pickup, storage and delivery services for documents, files and computer media." Clearly both identifications refer to delivery of documents services. We are aware that

⁵ See TBMP §712.01, and cases cited therein.

applicant strongly contends that in the actual marketplace (as evidenced by e.g., a specimen of use from the cited registration, a specimen of use from applicant's application and one other brochure by applicant), registrant is in the business of traditional record storage services for businesses who have the registrant pickup and store documents and then deliver back any requested records; whereas applicant is a research service which locates and provides copies of third-party articles to its customers. The problem we have with applicant's argument is that the cited registrant's identification of services is not limited solely to the storage of documents, as applicant contends. Likewise, applicant's identification of services is not limited to conducting research and providing the documents therefrom. Rather, the cited registration has a broad identification which includes delivery of documents, and the applicant identified its services as obtaining documents for its customers.

Of course, the Board is constrained to compare the services as identified in the application with the services as identified in the cited registration. If the registrant's services and the applicant's services are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual services

of the applicant and registrant are not similar. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); In re Trackmobile Inc., 15 USPQ2d 1152 (TTAB 1990); and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985).

In its reply brief, applicant cites the Trackmobile case, supra, arguing that in the current case, the extrinsic evidence could be considered to the extent there is ambiguity in the meaning of the identification of services. We do not find the identifications of services are ambiguous. Registrant's identification may be broad, and applicant's identification may not be precisely worded to refer to applicant's actual research services, but neither identification is ambiguous or unclear.

Moreover, it is well settled that services need not be identical or even competitive to support a finding of likelihood of confusion. It is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See In re Peebles Inc., 23 USPQ2d 1795, 1796 (TTAB

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1992); and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978).

Inasmuch as neither applicant's nor the cited registrant's identification of services is restricted as to trade channels or purchasers, the Board must consider that the parties' respective services could be offered and sold to the same class of purchasers through all normal channels of trade for such services. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

We find that the same person may seek applicant's and the cited registrant's services; and upon seeing the substantially similar marks INFOSTOR (and design) and INFOSTORE for the respective services, may believe the services emanate from or are otherwise sponsored by or affiliated with the same source.

Finally, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993).

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Decision: The refusal to register under Section 2(d)
of the Trademark Act is affirmed.

R. F. Cissel

C. E. Walters

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board