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8/17/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Tutt & Associates, Inc.**

Serial No. 74/719,689

James B. Brady of **Weintraub & Brady** for **Tutt & Associates, Inc.**

Alicia Benmaman, Trademark Examining Attorney, Law Office 103
(**Michael S. Szoke**, Acting Managing Attorney).

Before **Hohein, Bottorff** and **Holtzman**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Tutt & Associates, Inc. has filed an application to register the mark "DIGITAL X-PRESS" for "duplicating services, namely, media duplication of data and digital information" in

International Class 40 and "printing services" in International Class 42.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the mark "DIGITAL EXPRESS," which is registered for "document printing services,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Turning first to consideration of the respective services, it is well settled that that the issue of likelihood of confusion must be determined on the basis of the services as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the services in

¹ Ser. No. 74/719,689, filed on August 24, 1995, which alleges a bona fide intention to use the mark in commerce. The word "DIGITAL" is disclaimed.

² Reg. No. 2,085,276, issued on August 5, 1997, which sets forth dates of first use of July 8, 1995. The word "DIGITAL" is disclaimed.

the application at issue and in the cited registration are broadly described as to their nature and type and, as is the case herein, there are no restrictions in the respective recitations of services as to their channels of trade or classes of customers, it is presumed in each instance that in scope the application and registration encompass not only all services of the nature and type described therein, but that the identified services move in all channels of trade which would be normal for such services and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Although applicant asserts that the respective services are dissimilar and that it, in particular, seeks registration of its mark "for a much more diverse set of services," the Examining Attorney is correct that "[b]oth the applicant and the registrant offer printing services to others." The respective services are clearly identical in part inasmuch as applicant's broadly identified "printing services" encompass the "document printing services" provided by registrant. Plainly, in light of such identity in the respective services, applicant's contentions that the channels of trade and customers therefor are different are without foundation; instead, the distribution outlets and typical

consumers for printing services, including in particular document printing services, are the same.

As to the duplicating services for which applicant also seeks registration and the document printing services rendered by registrant, it is well established that services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, as the Examining Attorney notes, "[t]he services listed in the registration and application are frequently provided by the same entity." It is common knowledge that, in fact, those who render printing services, such as document printing services, often offer duplicating services as well, including, in the computer age, media duplication of data and digital information. Rather than

printing copies of documents, documents in electronic form, including any data and digital information contained therein, may be duplicated on a variety of media. Applicant, we observe, appears to do exactly this, namely, offering duplication of data and digital information while also providing printing services. Consequently, we find that applicant's duplicating services with respect to media duplication of data and digital information and registrant's document printing services are so closely related in a commercial sense that, if offered under the same or substantially similar marks, confusion as to the source or sponsorship of the respective services would be likely to occur.

Turning, therefore, to consideration of the marks at issue, applicant maintains that, when considered in their entirety, the respective marks, as actually used,³ are "distinctively different" and thus are distinguishable. Specifically, while admitting that its "DIGITAL X-PRESS" mark "is similar in sound" to registrant's "DIGITAL EXPRESS" mark, applicant insists that there are "significant differences in appearance and affect [sic] on prospective purchasers which

³ Although applicant, in its main brief, claims to have been using its mark "since 1994," an amendment to allege use has not been submitted.

are sufficient to obviate any likelihood of confusion based on similarity of the marks." According to applicant:

A copy of Applicant's label showing the mark as it appears in the marketplace has been placed into the record. Applicant's mark is ... presented in a multi-color scheme and thus [is] contrasted from [the mark of] Registrant. Thus, while the sound of the dominant word mark is similar, there is sufficient dissimilarity of the marks in their entireties as to appearance and commercial impression to negate a likelihood of confusion.

The Examining Attorney, on the other hand, contends that the respective marks are identical in sound, meaning and overall commercial impression. In particular, the Examining Attorney notes that both marks contain the word "DIGITAL" and that the terms "X-PRESS" and "EXPRESS" are phonetic equivalents. As to applicant's assertions regarding the differences in appearance and overall commercial impression of the marks, the Examining Attorney observes that:

The applicant' mark and the registrant's mark are both presented in typed form. Because neither mark is restricted to a particular stylization, the marks could be presented in a way which emphasized the similarities. "Presentation of a mark for registration in typewritten form means that the mark may be displayed in any style lettering, including, presumptively, the same style as that used by the [other party]." *In re Mars, Inc.*, 221 USPQ 1185 ... (TTAB 1983)[, *rev'd on other grounds*, 741 F.2d 395, 222 USPQ 938 (Fed. Cir. 1984),] *citing Pfizer, Inc. v. Cody John Cosmetics, Inc.*, 211 USPQ 64, 68 (TTAB

1981). Although the applicant contends that its logo and design components make the marks visually and conceptually distinct, such a position is not well taken because how the applicant is using its mark is irrelevant. Only the mark on the drawing page can be considered, and in this case, the applicant's and the registrant's mark[s] were presented ... in typed form.

In view thereof, the Examining Attorney concludes that "[t]here are no significant differences in the commercial impression created by the terms DIGITAL X-PRESS and DIGITAL EXPRESS" and that, when used in connection with the respective services, confusion as to the origin or affiliation thereof is likely to occur.

We agree with the Examining Attorney that the marks "DIGITAL X-PRESS" and "DIGITAL EXPRESS" are not only identical in sound, as applicant has conceded, but are substantially similar in appearance and virtually the same in connotation. Both marks begin with the word "DIGITAL" and the term "X-PRESS" in applicant's mark, being an alternative spelling of the word "EXPRESS" in registrant's mark, results marks which, in their entireties, look highly alike and mean essentially the same. While such marks are perhaps distinguishable on a side-by-side comparison,⁴ when the marks are utilized in

⁴ A side-by-side comparison, however, is not the proper test to be used in determining the issue of likelihood of confusion since it is not the ordinary way that consumers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the

connection with duplicating and printing services which are identical in part and are otherwise closely related, the overall commercial impression engendered by applicant's mark is virtually identical to that projected by registrant's mark.⁵ Furthermore, the Examining Attorney is correct in noting that, because both applicant's and registrant's marks are registered in a typed format consisting of all capital letters, the rights therein respectively encompass the designations "DIGITAL X-PRESS" and "DIGITAL EXPRESS" and are thus not limited to the depiction thereof in any special form.

fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. See, e.g., In re United Service Distributors, Inc., 229 USPQ 237, 239 (TTAB 1986); and In re Solar Energy Corp., 217 USPQ 743, 745 (TTAB 1983).

⁵ While applicant also claims that registrant's mark is weak, and hence is entitled only to a narrow scope of protection, on the basis that it "has searched the U.S. Patent and Trademark Office records and the state registries" and "has uncovered 29 entries for, or encompassing, the terms 'DIGITAL [and] EXPRESS'" (including "those at issue here"), of which "[a]t least nine ... [list] services in Registrant's International Class 42," the Examining Attorney properly points out that, since applicant failed to provide copies of the third-party registrations, such "registrations are not part of the record and have not been considered." The Board, moreover, does not take judicial notice of third-party registrations and, thus, a mere reference thereto is insufficient to make such registrations of record. See, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). There consequently are no third-party registrations to be considered in connection with this appeal.

See Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).⁶

Applicant argues, however, that confusion is not likely since consumers of the respective services are sophisticated purchasers. While the Examining Attorney has not addressed this contention, suffice it to say that, as broadly identified, applicant's duplicating and printing services, on the one hand, and registrant's document printing services, on the other hand, would be purchased by customers of all types, including ordinary consumers as well as business purchasers and other discriminating buyers. Nevertheless, even among the latter, the fact that such purchasers may be careful and sophisticated consumers when it comes to selecting duplicating and printing services, including document printing services, "does not necessarily preclude their mistaking one trademark [or service mark] for another" or that they otherwise are entirely immune from confusion as to source or

⁶ In any event, "[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the mark] could be depicted". *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). Because the converse of such proposition is also true, registrant's "DIGITAL EXPRESS" mark must be regarded as encompassing the display thereof in the same stylized format as the "multi-color scheme" in which applicant actually uses its "DIGITAL X-PRESS" mark, including the identical style of lettering (e.g., "*digital Express*" versus "*digital X-press*"), since such is a reasonable manner of presentation for such marks. The stylization employed in applicant's mark, therefore, does not serve to distinguish its mark from registrant's mark.

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sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Finally, applicant makes much of the unsupported factual assertion in its initial brief that, since applicant and registrant "have apparently co-existed for the last few years, and neither one of them has apparently heard of the other, it is clear that there had been no actual confusion and it is also clear that the likelihood of confusion is de minimis." That applicant and registrant, according to applicant, appear to have been unaware of each other is indicative, however, that their respective services have not coexisted under the marks at issue in the same marketplaces for any meaningful interval. Yet, in order for the claimed absence of any incidents of actual confusion to be probative that there is no real likelihood of confusion between the respective marks, evidence demonstrating appreciable and continuous use of the such marks for a significant period of time in the same markets as those served by registrant is necessary. Absent such proof, the mere assertion of a lack of any reported incidents of actual confusion is simply not a meaningful factor in this appeal. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Accordingly, we conclude that customers and prospective purchasers, familiar with registrant's mark "DIGITAL EXPRESS" for "document printing services," would be likely to believe, upon encountering applicant's substantially similar mark "DIGITAL X-PRESS" for both "duplicating services, namely, media duplication of data and digital information" and "printing services," that such closely related and, in part, identical services emanate from, or are otherwise sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.

G. D. Hohein

C. M. Bottorff

T. E. Holtzman
Administrative Trademark

Judges,
Board
Trademark Trial and Appeal