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Paper No. 9
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Innoventor Engineering, Inc.

Serial No. 75/476,534

Andrew B. Mayfield of Armstrong Teasdale LLP for Innoventor Engineering, Inc.

Kathleen Keener Elsner, Trademark Examining Attorney, Law Office 103 (Dan Vavonese, Acting Managing Attorney).

Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Innoventor Engineering, Inc. to register the mark INNOVENTOR ENGINEERING for use in connection with services which were subsequently identified as the "custom-manufacture of electrical and mechanical equipment for others," in International Class 40, and for the "design and analysis of

electrical and mechanical equipment for others," in International Class 42.¹

Registration has been 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 the identified services, so resembles the mark INNOVENTION and design, shown below,



for "providing product design services for others," also in International Class 42,² as to be likely to cause confusion, or to cause mistake, or to deceive.

When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have each filed a main brief. Applicant did not request an oral hearing.

We affirm the refusal to register in part and reverse the refusal to register in part.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood

¹ Serial No. 75/476,534 filed on April 29, 1998. The application is based upon an asserted date of first use of December 1994 and date of first use in commerce of January 1996 as to the services in both classes.

² Reg. No. 1,235,486 issued on April 19, 1983; §8 affidavit accepted and §15 affidavit acknowledged.

of confusion. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Upon careful consideration of the evidence of record pertaining to these factors, we find as follows.

We turn first to the issue of whether applicant's mark, INNOVENTOR ENGINEERING, and the cited registered mark, INNOVENTION and design, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

As applicant argues, the marks at issue must be considered in their entirety. However, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial

impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we find that the dominant feature of applicant's mark is the coined word INNOVENTOR. Similarly, the dominant source-indicating matter in the registered mark is the coined word INNOVENTION. While not explored in depth by the Trademark Examining Attorney or the applicant, applicant's mark seems to be a combination of the first two syllables of the root word "innovate" plus the final two syllables of the word "inventor." Similarly, registrant's marks would appear to be a combination of the first two syllables of the root word "innovate" plus the final two syllables of the word "invention." The other wording in applicant's mark, i.e., ENGINEERING, comprises generic matter that has been disclaimed by applicant.

Applicant argues that the word INNOVENTOR, when combined with the word ENGINEERING, creates the commercial impression of an engineering business that invents innovative products, as contrasted with the word INNOVENTION alone, which applicant argues does not connote engineering capabilities. The Board disagrees. This generic designation for an engineering firm contributes very little to the commercial impression created by applicant's mark. Accordingly, any dissimilarity in the

marks that might result from applicant's use of this generic wording is greatly outweighed by the marks' basic similarity, i.e., their similar use of the coined terms INNOVENTOR and INNOVENTION.

Applicant also argues that "[registrant's compass] design creates the impression of a drafting business that does not actively invent products but rather serves as a design drafting agent for others." While the letter "V" in the registered mark does indeed appear to be a compass used for drawing circles and arcs, this device appears to be a symbol equally appropriate for product design as it would be for mere drafting. Furthermore, where the design image is highly suggestive and incorporated in such an integral way with the word mark, it is not something customers or potential customers would be able readily to articulate in calling for the service.

In short, when we consider the marks in their entirety, we find them to be similar rather than dissimilar. This similarity of the marks weighs in favor of a finding of likelihood of confusion in this case.

We turn next to the similarity in the services. The original recital in this application read as follows: "Design, analysis, manufacture, and maintenance of electrical and mechanical equipment for others." In

response to the first Office action, applicant narrowed its recital by eliminating the maintenance function and amended to a two-class application for the manufacturing services in International Class 40 and the design and analysis services in International Class 42.

In her final refusal, the Trademark Examining Attorney takes the following position:

The applicant has applied for the mark for use with design and analysis of electrical and mechanical equipment for others. The registrant's mark is used in conjunction with product design services. The applicant's services are identical to the services registrant provides...

We agree with the position of the Trademark Examining Attorney that registrant's broad recital of "product design services" must be read as including applicant's more specific services involving the design of "electrical and mechanical equipment." Accordingly, as to applicant's design services in International Class 42, this factor also weighs in favor of a finding of likelihood of confusion. Taken in conjunction with our discussion of the similarity of the respective marks, we affirm the refusal to register as to applicant's services in International Class 42.

However, inasmuch as this is a combined class application, also including applicant's custom-manufacturing services in International Class 40, the

position of the Trademark Examining Attorney is less clear from this record. In the section of her brief discussing the similarity of the services, the "custom manufacturing" services are listed, but the file contains no evidence or clear argument about the relatedness of registrant's design services and applicant's manufacturing services.

Accordingly, on this record, we must take the position that these services are not necessarily closely related and reverse the refusal as to applicant's manufacturing services in International Class 40.

As is often the case, the two key considerations affecting our analysis of likelihood of confusion, based upon the instant record, are the similarities between the marks and the relatedness of the services. Federated Food, Inc. v. Fort Howard Paper Co., 554 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). However, in cases having service recitals such as the present one, we are often faced with evidence and argumentation as to the sophistication of the purchasers. Because the instant record is devoid of such advocacy, we can only speculate as to the outcome if additional du Pont factors such as the sophistication of applicant's purchasers had been explored in greater depth.

Decision: The refusal to register is affirmed as to the services in International Class 42 but reversed as to

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the services in International Class 40. Accordingly, this application should proceed to publication in International Class 40 only, namely as to the "custom-manufacture of electrical and mechanical equipment for others."