

7/26/01

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Impact Imaging, Inc.

Serial No. 75/749,666

Marilynn K. Burningham of Nielsen & Senior, P.C. for Impact Imaging, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 13, 1999, Impact Imaging, Inc. filed an application to register on the Principal Register the mark shown below

!mpact

for services identified, as amended, as "digital printing services; namely, wide format short run reproductions of customer graphics as, for example, billboards, banners, wall displays, truck sides and backlits" in International Class 42. The application was initially based on

applicant's assertion of a bona fide intention to use the mark in commerce. Subsequently, applicant filed an amendment to allege use which was accepted by the Office. Applicant's claimed date of first use and first use in commerce is August 28, 1999.

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 used on its identified services, so resembles the registered mark IMPACT GRAPHICS for "graphic design and offset printing services for modelling agencies, models, entertainment industry, public relations firms and advertising agencies" in International Class 42,¹ as to be likely to cause confusion, mistake or deception.

Applicant has appealed, and briefs have been filed. Applicant did not request an oral hearing.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

¹ Registration No. 2,254,859, issued June 22, 1999. The claimed date of first use is July 1993. The term "graphics" is disclaimed.

We turn first to a consideration of the marks in terms of sound, appearance and connotation. When analyzing applicant's mark and the registered mark, it is not improper to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). The word IMPACT is the dominant portion of both marks. The marks are quite similar in visual appearance, as applicant's mark is the word "impact" in small letters, utilizing an interesting inverted letter "i"; while registrant's typed form mark is two words, IMPACT GRAPHICS.

Further, as the common word IMPACT is identical in both marks, the marks are very similar in sound. We note James G. Clegg's (applicant's vice president of sales) statement in his September 26, 2000 declaration that "[applicant's] mark cannot be pronounced 'impact.'" However, we nonetheless believe that consumers will read applicant's mark as "impact," even though that does not technically fully describe applicant's mark. Consumers do not generally describe all stylizations and designs in

trademarks when asking for the goods or services. That is, the word portion of a mark is the portion utilized in calling for the goods, and is most likely to be impressed in the purchaser's memory and to serve as the indicator of origin. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *Consumers Building Marts, Inc. v. Mr. Panel, Inc.*, 196 USPQ 510 (TTAB 1977). For example, a person seeking a "COCA-COLA" brand beverage would not describe the lettering script or the color of the script lettering; rather, they would simply say the words, "COCA-COLA." While applicant's mark shows the word IMPACT in stylized form, and registrant's mark IMPACT GRAPHICS includes the descriptive/generic (and disclaimed) term "graphics," it is the word "IMPACT" which is the dominant feature of registrant's mark, and it is the pronounceable portion of applicant's mark.

Whatever the connotation of the word "impact" is relative to printing services, it would be the same for both registrant and applicant. One possible connotation, evidenced by applicant's specimen, is that consumers who use the company's printing services will achieve the desired effect/impact on whomever the consumers are directing their material to. (For example, applicant's

specimen of record includes the following statements:

"Because each one of us does whatever it takes to give our customers' image real impact faster and better than anyone"; "[a]nd see how we can give your next headline the impact it deserves.")

The differences between these marks are not sufficient to overcome the likelihood of confusion. See *In re Dixie Restaurants Inc.*, supra. We find that these marks, considered in their entirety, are similar in appearance and commercial impression, and they are very similar in sound and connotation.

Considering next the parties' respective services, it is well settled that services (or goods) need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead 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 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the services (or goods) as identified in the application with the services (or goods) as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

As acknowledged by applicant, "both Registrant and Applicant provide printing services" (brief, p. 7); and "Applicant concedes that many printers may provide both [offset and digital printing] services" (reply brief, p. 4).² However, applicant contends that applicant's identified services are limited to digital reproduction of customer graphics in wide format (i.e., sizes ranging from a minimum of 36 inches); and that there is no evidence that

² Also, the Examining Attorney submitted several excerpted stories retrieved from the Nexis database to show that the same entity may offer both digital printing and offset printing services, such as the following (emphasis added): "Headline: New Owner Transforms Printing Business--... Minuteman Press, a small printing company with four employees that does mostly **offset printing** and some **digital printing**, moved to Distillery Commons in May. . . ., "Business First-Louisville," September 17, 1999.

an offset printing service provider prints wide format materials.

Applicant's digital printing services are limited to wide format runs of reproductions of customer graphics, but applicant's identification is not exclusively limited to "billboards, banners, wall displays, truck sides and backlits." To the contrary, applicant set forth those specific items only as examples of the things applicant may print for a customer. Moreover, there is no limitation in registrant's identification of services as to any specific type or size of offset printing services. Thus, the type of products produced as the result of applicant's services could be produced as the result of registrant's broader identification of services.

We find applicant's and registrant's respective printing services, as identified, are related under the second du Pont factor.

Regarding the channels of trade, applicant contends that its services are offered only through direct mail advertising brochures, by a national sales force, and on an Internet website (see Ms. Griesemer's January 25, 2000 affidavit, paragraph 8), with purchases made only from applicant's trained salespersons; whereas registrant's services are offered only through registrant's own

store/production facility. However, neither applicant's nor registrant's identification of services is limited as to any such specific channels of trade. Applicant's limitation to "wide format" digital printing does not limit the channels of trade to "direct sales" or purchasing "only from applicant's trained salespersons." (Reply brief, p. 2.) Registrant's limitation to certain types of customers does not limit its methods of sale to sales only available at its store/facility.³ The parties' respective channels of trade are potentially overlapping.

Applicant is correct that registrant's purchasers are limited in its identification of services to "modelling agencies, models, entertainment industry, public relations firms and advertising agencies." However, applicant's identification of services is not limited as to customers; and in fact, applicant stated that its services are "targeted to outdoor advertisers..." and are "most often purchased by the production manager of an advertising agency or an in-house ad department" (brief, p. 2), and

³ Applicant cited the case of *In re The Shoe Works Inc.*, 6 USPQ2d 1890 (TTAB 1988) in support of its argument about separate channels of trade. In that case applicant's identification of goods was specifically limited as "women's shoes sold solely through applicant's retail shoe store outlets"; and there was a consent agreement between the parties. In the appeal now before us, applicant's identification of services is not so restricted and there is no consent agreement between applicant and registrant of record herein.

advertising agencies are specifically listed in registrant's identification of services. In addition, the declaration of James G. Clegg (paragraph 8) includes a statement that "[o]ur finished products are used for product advertising, for professional sports teams advertising and venue decoration, for event promotion, for advertising of all kinds of services and for delivering public service messages or other information." The record before us clearly shows that both applicant and registrant market their services to at least some of the same classes of purchasers, such as the entertainment industry (including sporting events) and advertising agencies. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra; and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

We recognize applicant's point that purchasers of the involved printing services are likely to be experienced, sophisticated buyers who exercise a degree of care. Even when the purchasers are sophisticated, however, it does not mean that they are sophisticated in their knowledge of trademarks or that they are immune from confusion as to the origin or affiliation of goods or services, especially when the involved marks are substantially similar and the services are clearly related. See *Towers v. Advent*

Software Inc., 17 USPQ2d 1471, 1473 (TTAB 1989).⁴ Moreover, it is not clear that all, or even most, purchasers of applicant's services would be sophisticated purchasers. In fact, applicant's president, Kim Griesemer, stated (emphasis added) in her September 26, 2000 declaration (paragraph 6) that "[applicant] *routinely produces, as its smallest product, a banner measuring 1½ by 5 feet.* Wide format printing also includes a finished product 14 feet by 48 feet or 85 feet by 224 feet. All of these sizes are referred to in the industry as 'wide format,' meaning the product is 36 inches or larger in either dimension." Also, applicant submitted in the record an estimate for a job of \$7,161.80 and an invoice for a banner of \$208.92. Thus, it is clear that applicant's wide format printing services cover a very broad span in terms of potential cost of the various printing services.

Turning to the du Pont factor of the number and nature of similar marks in use on similar goods or services, applicant contends that there are that there are numerous other "impact" marks and thus the term is weak as an indicator of a single source, and is therefore afforded

⁴ This decision was affirmed by the Court of Appeals for the Federal Circuit at 913 F.2d 942, 16 USPQ2d 1039 (1990). The Board decision was released for publication as citable precedent in 1990.

only a narrow scope of protection. This argument is not substantiated in the record. Applicant's Exhibit E (attached to the September 26, 2000 declaration of Kim Griesemer, applicant's president) is a copy of only the "USPTO Report" portion of a private database search report of the word IMPACT for "custom grand format printing services."⁵ According to Ms. Griesemer (declaration, paragraph 10), the report shows "49 live marks using the word 'Impact' with related services or goods."⁶ Although we have considered this evidence, it is of extremely limited probative value, first, because it does not indicate any of the goods or services⁷; and second, because the existence of pending applications or even of registrations does not prove use of the involved marks and that the relevant public is aware of them. Thus, there is no evidence of

⁵ In her January 25, 2000 affidavit, she explained that "grand format" printing (not included in applicant's identification of services) involves "billboard-size or wall-size displays, or large banners which exceed two meters (80 inches) in width." (Paragraph 5.)

⁶ In her brief, the Examining Attorney objected to the evidence relating to the existence of other pending applications or registered marks incorporating the term IMPACT. The Examining Attorney's objection is untimely and is overruled. Applicant first submitted this report with its September 29, 2000 request for reconsideration, which the Examining Attorney denied on November 11, 2000 without commenting on the acceptability of applicant's evidence. However, the probative value of the evidence is quite limited for the reasons explained above.

⁷ The report does set forth the International Class number, and there are none listed in International Class 42.

record herein on the number and nature of similar marks in use on similar or related goods or services.⁸

Even if applicant had shown that the cited mark is weak, such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Applicant states that it is not aware of any instances of actual confusion. However, there is no evidence of applicant's and registrant's respective geographic areas of sales, or the amount of sales of the involved services under their respective marks, IMPACT (stylized) and IMPACT GRAPHICS, since applicant commenced its use in August 1999. Further, there is no information from registrant on the issue of actual confusion. This factor is not persuasive

⁸ Applicant requested on page 4 of its reply brief that "if evidence of the marketplace realities is to be determinative, applicant requests remand for the submission of additional evidence." The evidentiary record should be complete prior to filing the ex parte appeal. See Trademark Rule 2.142(d). Applicant's request at this late stage of the appeal is denied. Moreover, there is no indication that this information was not previously available to applicant. (Applicant stated on page 5 of its reply brief, that "[a]pplicant's President, Kim Griesemer, in her affidavit of September 26, 2000, attached an excerpt of the results of a search of 'impact' company names in the Dun & Bradstreet database and in the American Business Directory." The September 26, 2000 declaration of Ms. Griesemer included only one exhibit and that was the USPTO section of the report; and her January 25, 2000 affidavit referenced only one exhibit which related to applicant's direct mail and Internet website.)

in the overall balancing of the du Pont factors in this case.

Accordingly, because of the substantial similarity of applicant's and registrant's respective marks; the relatedness of their respective services; and the overlap of the trade channels to at least some of the same purchasers; we find that there is a likelihood that the purchasing public would be confused when applicant uses its mark for its services.

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