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Mailed: December 13, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re David Adress

Serial No. 76364167

David Adress, pro se.

Anne Madden, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Chapman, Holtzman and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant filed on January 30, 2002, an application to register on the Principal Register the mark PC WIZ for services identified as "consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others" in International Class 42.¹ Applicant disclaimed the letters "PC." The

¹ During the prosecution of the application, applicant offered an amendment to the identification of services to add the phrase "in the states of New York, New Jersey and Connecticut." This amendment was erroneously accepted by the Examining Attorney. Geographic restrictions to an applicant's rights in a mark are

application is based on applicant's claimed date of first use and first use in commerce of October 1, 2000.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the two previously registered marks listed below, both issued to PC Wizards, Inc.:

not accomplished through an amendment to the identification of goods and/or services. See Trademark Rule 2.42; and *Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587 (TTAB 1995). In applicant's reply brief (p. 2), he stated the following:

"[W]e [sic] had argued that because the registrant and applicant operated in widely separated geographical areas, there would be little opportunity for confusion to occur. The cases that we cited were based on adjudication of common law rights which can reflect on geographical considerations. We subsequently became aware that this is not the situation in respect to trademark registration and therefore, we admit that the wide separation between the companies is not relevant to these proceedings."

Thus, it appears that applicant offered a contingent amended identification of services in an effort to overcome the Examining Attorney's refusal under Section 2(d) of the Trademark Act, which it did not accomplish. Because (i) applicant's purpose for his contingent amendment to the identification of services was not met, and (ii) putting geographic restrictions into identifications of services is inappropriate, the geographic restriction in applicant's identification of services has been removed.

If applicant sought a concurrent use (geographically restricted) application, he would have to have so amended his application. However, he has never offered such an amendment (which includes, *inter alia*, a clear statement that the applicant is not entitled to exclusive use of the mark and reciting the exception(s) to the applicant's right to use the mark). In fact, both applicant and registrant have Internet websites (applicant's specimen is a printout of a page from his website (www.PC-WIZ-INC.com), and Exhibit 5 to applicant's August 1, 2002 response is a printout of a page from registrant's website (www.pcwiz.net)). The Examining Attorney noted in her brief (p. 6), that "the broad reach of the Internet" is not limited to any geographic area.

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(1) Registration No. 2531763, issued January 22, 2002, for the mark PC WIZARDS ("PC" disclaimed); and

(2) Registration No. 2671071, issued January 7, 2003, for the mark shown below



("PC" disclaimed)("The stippling shown in the drawing is a feature of the mark and not intended to indicate color").

Both registrations cover the following services:

"repair services for computer hardware, namely, personal computer end network installations and maintenance services" in International Class 37; and

"computer consulting services, namely, technical support services in the nature of troubleshooting of computer hardware and software problems via e-mail, by telephone or in person; maintenance of computer software; custom website design and hosting for others" in International Class 42.

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

Our determination under Section 2(d) is based on an analysis of all of the 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). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). 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 *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of applicant's services and the cited registrant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Of course, it has been repeatedly held that in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant identified his services as "consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others." The cited registrant's most relevant services (and those emphasized by both applicant and the Examining Attorney) are identified as "computer consulting services, namely, technical support services in the nature of troubleshooting of computer hardware and software problems via e-mail, by telephone or in person; maintenance of computer software; custom website design and hosting for others."

It is clear that, as identified, applicant's consulting services include design, implementation and use of computer hardware and software systems; and registrant's computer consulting services include custom website design,

troubleshooting computer hardware and software problems, and maintenance of computer software. These are closely related, if not legally identical services. Indeed, applicant acknowledged that "[T]he examiner has correctly stated that the services of the registrant and applicant are closely related in that they both pertain to computer consulting for others." (Applicant's response of April 18, 2003, p. 3.)

We find that applicant's services and the registrant's services overlap in part and are otherwise closely related.

Applicant argues that the involved services are offered to sophisticated customers or at least to customers who "exercise a reasonably high level of care in making their choice" (applicant's response of July 30, 2002, p. 3); that both applicant and registrant serve their customers "primarily through on-site implementation and troubleshooting of computer hardware and software" (applicant's response of April 18, 2003, p. 3); that "close personal interaction is a hallmark of this type of business" (Id.); and that the services involve custom tailored design of computer systems and websites and solutions to computer hardware and software problems, which involve extensive discussions with the customers.

Purchasers, either institutional or individual, of these computer hardware and software design, implementation and troubleshooting services may make such purchasing decisions with at least some degree of care. However, even if purchased with some care, and through in-person discussions by sophisticated purchasers, these purchasers are not immune from confusion as to the source of services, particularly when they are sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Moreover, there is a growing tendency for the general public to be purchasers of computers and therefore computer services such as those involved herein, specifically, the design, implementation and troubleshooting of computer hardware and software. Thus, potential customers for both applicant and registrant include poorly informed and unsophisticated purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716-1717 (TTAB 1992); and *In re Graphics Technology Corp.*, 222 USPQ 179, 181 (TTAB 1984). See also, *In re TIE/Communications Inc.*, 5 USPQ2d 1457, 1458 (TTAB 1987).

Turning now to the marks, applicant makes a painstaking comparison of the etymology of the words "wiz"

(including spelled as "whiz"² and "wizz") and "wizard," including the older and current meanings; and pointing out that the same definitions are not given in numerous dictionaries, with some being, according to applicant, contradictory. Applicant argues that "wiz" has a positive connotation meaning "a person considered especially gifted or skilled," while "wizard" has a negative connotation of "a conjurer, an enchanter, a sorcerer"; that the Examining Attorney's evidence that "wiz" is a shortened form of wizard is inadequate; and that applicant's mark is different in sound, appearance, connotation and overall commercial impression from each of registrant's marks, particularly noting that one of registrant's marks includes a design feature of a "wizard" thereby emphasizing that connotation.

It is well settled that marks must be considered in their entirety because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in

² The Examining Attorney requested in her brief (p. 3) that the Board take judicial notice of The American Heritage Dictionary (Fourth Edition 2000) definition of "whiz." The Examining Attorney's request is considered moot because the term "WHIZ" is not part of the involved marks.

the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). The proper test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks.

In this case, applicant's mark is PC WIZ and registrant's marks are PC WIZARDS and PC WIZARDS and design. The design feature is merely the pictorial representation of the word "wizard." The marks (applicant's and each of registrant's) are similar in sound and appearance.

As to connotation, the Examining Attorney made of record the entry from the on-line Merriam-Webster Dictionary for the term "wiz" defined as "noun ... wizard." The Board takes judicial notice of the following dictionary definitions: (i) "wiz" defined as "n. Informal. A person considered exceptionally gifted or skilled. [Short for WIZARD.]" The American Heritage Dictionary (1976); (ii) "wiz" defined as "n. [by shortening]: wizard" Webster's

Third New International Dictionary (1993); and (iii) "wizard" defined as "1. archaic: a man of wisdom and knowledge: sage, wise man ... 3. one endowed with exceptional skill or able to achieve something held to be impossible: a genius or prodigy esp. in a particular field of endeavor" Webster's Third New International Dictionary (1993). Given that a commonly understood English meaning of "wiz" is that of a shorthand version of "wizard," we find that these marks are similar in connotation. Thus, consumers will likely perceive PC WIZ as a shorthand reference to PC WIZARDS. Moreover, we are not persuaded that consumers will mentally go through the thorough analysis of the etymology and the older and current specific dictionary meanings of the two terms, as suggested by applicant. See *In re Dixie Restaurants Inc.*, supra.

When considered in their entireties, we find that applicant's mark and each of registrant's marks are highly similar in overall commercial impression such that, when used on the closely related, if not legally identical, services involved herein, confusion as to source is likely. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Applicant's reliance on the case of *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998) is not persuasive of a different result herein.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, we would resolve it against applicant, as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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