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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Innovation Law Group, Ltd.

Serial No. 76508351

Jacques M. Dulin and Virginia P. Shogren of Innovation Law Group, Ltd. for Innovation Law Group, Ltd.

Tracy Whittaker-Brown, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Chapman and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 21, 2003, Innovation Law Group, Ltd. (a California corporation with a business address in Sequim, Washington) filed an application to register on the Principal Register the mark GOT IDEA?...CALL ILG! for "legal services relating to intellectual property law and strategy, domestic and foreign patents, licensing, trade secrets, trademarks and copyrights" in International Class 42. The application is based on applicant's claimed dates

of first use and first use in commerce of November 8, 2002 and December 10, 2002, respectively.

The 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 applicant's identified services, would be likely to cause confusion, mistake or deception with the registered mark GOT AN IDEA? for "legal services" in International Class 42.¹

When the refusal to register was made final, applicant appealed to the Board. Applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. 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 of

¹ Registration No. 2758736, issued September 2, 2003, to Hinkle & O'Bradovich, LLC. The claimed date of first use and first use in commerce is January 1, 2001.

the marks and the similarities of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We initially consider the first du Pont factor, which is "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

It is well settled that marks must be considered in their entireties 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 commercial impression is created by the purchaser's general reaction to a mark in 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. 2005). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). Moreover, the differences

in the marks may not be recalled by purchasers seeing the marks at separate times. 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 be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

In this case, registrant's mark is the phrase GOT AN IDEA?, and applicant's mark begins with the phrase GOT IDEA? and then applicant's mark adds ...CALL ILG!, a specific reference to applicant. These marks, GOT AN IDEA? and GOT IDEA?...CALL ILG, are similar in sound and appearance. It is often the first term or portion of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Clearly the cited mark and the first portion of applicant's mark evoke the same connotation, which is "do

you have an idea?" The fact that applicant left out the article "an" does not alter the meaning of the phrase to consumers. The implicit connotation of the question "do you have an idea?" is that if you have an idea, then you should contact the entity offering the service. That is, consumers would perceive the marks as asking if they have an idea, then presumably they would want to contact the entity that offers the service. The fact that applicant's mark includes specific information referring to itself by its initials ILG and emphatically invites consumers to "CALL ILG!" is not a sufficient difference to avoid confusion. The addition of a word (or two words) to a registered mark does not generally avoid confusion. See *Menendez v. Holt*, 128 U.S. 514 (1888); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975); and *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988).

We find that the cited mark and applicant's mark are highly similar in sound, appearance, connotation and commercial impression.

Turning next to a consideration of the respective services, 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 as identified in the application with the services 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 v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As the Court of Appeals for the Federal Circuit stated in *Octocom*, supra, 16 USPQ2d at 1787:

The authority is legion that the question of the registrability of an applicant's mark must be decided on the basis of the identification of goods [services] set forth in the application regardless of what the record may reveal as to the particular nature of applicant's goods [services], the particular channels of trade or the class of purchasers to which sales of the goods [services] are directed.

And later the Court reiterated in *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000):

Proceedings before the Board are concerned with registrability and not use of a mark. Accordingly, the identification of goods/services statement in the registration, not the goods/services actually used by the registrant, frames the issue.

Applicant's services are identified as "legal services relating to intellectual property law and strategy, domestic and foreign patents, licensing, trade secrets,

trademarks and copyrights." Registrant's services are identified as "legal services."

Clearly, the services identified in the cited registration ("legal services") encompass the more specific legal services in the field of intellectual property offered by applicant.

The identifications of services of both applicant and registrant are not restricted as to trade channels or purchasers. Therefore, we must presume in this administrative proceeding that the registrant's services are offered through all normal channels of trade to all the usual classes of purchasers for its general "legal services" (which would include as consumers those seeking legal services for intellectual property law issues). See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank v. Wells Fargo Bank*, supra.

Applicant's argument and submissions that the cited mark is weak, as it is generic (brief, p. 2 and reply brief, p. 2), is not persuasive.² The existence of five

² Applicant's argument that the registered mark is generic is an impermissible collateral attack on the cited registration. See Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b). (We note that the cited registration issued on the Principal Register with no reference to Section 2(f) of the Trademark Act and no disclaimer.)

third-party registrations, all for legal services and all of which include the word "IDEA," does not persuade us to reach a different conclusion in this case. The third-party registered marks (e.g., THE IDEA ATTORNEYS, IDEA TO IPO, EVERY IDEA IS UNIQUE) create different commercial impressions from the commercial impressions engendered by the marks involved herein (GOT AN IDEA? and GOT IDEA?...CALL ILG!).

Also, applicant strongly contends that the Examining Attorney "completely ignores PRIOR Registration 2,473,301 for 'GOT AN IDEA? GETSTARTEDHERE.COM'" (emphasis in original) (reply brief, p. 2); and that "why was [the cited registration for the mark GOT AN IDEA?] allowed over the [GOT AN IDEA? GETSTARTEDHERE.COM] mark?" and "while the TMO [Trademark Office] may not be troubled by grievous and glaring inconsistencies, it is a serious issue for applicants and registrants" (reply brief, p. 3).

In the Final Office action (unnumbered page 3), the Examining Attorney specifically referred to this registration (No. 2473301), noting that it is for financial consultation services and explaining that "financial consultation is unrelated to legal services [within the meaning of the Trademark Act]" and there are "diverse channels of trade."

As the Examining Attorney had explained, the services in Registration No. 2473301 ("financial consultation services, namely, providing assistance to new and small businesses in the field of capital funding and investments") are significantly different from the cited registrant's identified "legal services." Moreover, even if one considers the identified services of the cited registrant and the third-party registrant to be related, it does not justify registration of another mark which is likely to cause confusion. Each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

Applicant's argument that the cited registrant "can oppose if so inclined" (reply brief, p. 4) is also unpersuasive. The applicant in the case of *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) made this argument, and the Court responded as follows (at 1535):

Dixie argues alternatively that the PTO should pass the mark to publication and allow the registrant to oppose the applicant's mark, if it chooses. But it is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two

marks. (Citation omitted.) It is also our duty "to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings." (Citations omitted.) Otherwise protecting their rights under the Lanham Act would be an onerous burden for registrants.

Considering all of the relevant du Pont factors, we conclude that consumers familiar with registrant's legal services offered under the mark GOT AN IDEA? would be likely to believe, upon encountering applicant's mark GOT IDEA?...CALL ILG! for legal services relating to intellectual property law, that both originate with or are somehow associated with or sponsored by the same entity.

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