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**THIS DISPOSITION
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Paper No. 14
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Affinity Media, Inc.

Serial No. 75/230,840

F. Lawrence Harasym, III, Esq. for applicant.

James A. Rauen, Trademark Examining Attorney, Law Office
103 (Michael A. Szoke, Managing Attorney).

Before Cissel, Hohein and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Affinity Media, Inc. has filed an application to register the mark shown below for "computer services, namely, designing multimedia software and providing information regarding the development and integration of software tools and services for companies in data-intensive industries, such as engineering, architecture, government, healthcare, manufacturing and distribution, for use with the

Serial No. 75/230,840

global computer network."¹ Applicant entered a disclaimer of MEDIA INCORPORATED apart from the mark as a whole.



The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark AFFINITY, previously registered for "engineering design and analysis services; namely, computer design and analysis services, and computer software design and analysis services," in International Class 42, and "electronic transmission of data and documents via computer terminals," In International Class

¹ Serial No. 75/230,840, in International Class 38, filed January 24, 1997, based on an allegation of use of the mark in commerce, alleging first use and use in commerce as of May 23, 1995.

Serial No. 75/230,840

38,² that, when used in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registrant's mark, when viewed in their entirety, are sufficiently similar in terms of appearance, sound, connotation and commercial impression.

² Registration No. 1,834,042, issued May 3, 1994, to Bull S.A. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are 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 general, rather than specific, impressions of trademarks. *See, Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, 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).

Considering applicant's mark in its entirety, we find the term AFFINITY to be a significant portion of applicant's mark. As evidenced by the disclaimer of record, the terms MEDIA and INCORPORATED in applicant's mark are merely descriptive in connection with applicant's identified services, whereas the term AFFINITY appears to be arbitrary in connection therewith.

Serial No. 75/230,840

The design element of applicant's mark consists of the words AFFINITY MEDIA INCORPORATED surrounding a pyramid design. We find that the word portion of applicant's mark predominates over its design elements. The word portion of a mark comprised of both a word and a design is normally accorded greater weight, in a likelihood of confusion analysis, because it would be used by purchasers to request the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985).

Applicant's mark incorporates registrant's mark, AFFINITY, in its entirety and that term is also a significant portion of applicant's mark. The commercial impressions of applicant's mark and registrant's mark are substantially similar.

Turning to consideration of the services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services recited in the registration, rather than what the evidence shows the services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom*

Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, 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 each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The specific nature of registrant's "engineering design and analysis services," in International Class 42, could be interpreted as broadly encompassing "computer engineering services,"³ or as limiting registrant's specified computer services to services rendered to the

³ We take judicial notice of the definition of "engineering" in *The American Heritage Dictionary* (2nd College Edition, 1985) as "1. The application of scientific and mathematical principles to practical ends such as the design, construction and operation of efficient and economical structures, equipment and systems."

engineering professions. Regardless, applicant's recited computer services overlap and are related to registrant's recited services in International Class 42. Both applicant's and registrant's services include computer software design and analysis of a client's needs in relation thereto.

Moreover, because applicant's software design and information services pertain specifically to enabling companies to make better use of the Internet, we find these services are similar to registrant's services recited in both International Classes 42 and 38. Registrant's services in International Class 42 are sufficiently broad to encompass applicant's computer software design and information services. Registrant's services in International Class 38, electronic transmission of data and documents via computer terminals, clearly encompass transmission via the Internet. As such, registrant's recited services are extremely broad. Applicant's identified services are rendered to "data-intensive" industries, and those services specifically involve helping companies make better use of the Internet, which would logically include transmission of data, electronically, via the Internet.

Thus, we find that applicant's recited services are closely related to registrant's services in International Class 38.

We conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the overlapping and closely related services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

Applicant's arguments to the contrary are unpersuasive.

First, arguing that AFFINITY is a weak mark, applicant's brief recites a list of registered marks that purportedly contain the term AFFINITY. However, these registrations have not been considered as they are not properly of record. Not only is the proffer of the list untimely, but we cannot tell from a mere list of registrations the nature of the involved goods or services or the status of the registrations.

Additionally, applicant refers to its Registration No. 2,260,215, issued July 13, 1999, for the mark AFFINITY MEDIA INCORPORATED for the same services recited in this application. Applicant argues that, in view of that registration, the application before us should not

Serial No. 75/230,840

be refused registration. However, we are deciding this case on the facts before us. The record of applicant's registration is not before us. Further, the Board is not bound by the decisions of Trademark Examining Attorneys, nor is the Office bound by any prior mistakes that may have been made in another case. See *In re AFG Industries, Inc.*, 17 USPQ2d 1162 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566 (TTAB 1985); and *In re D. B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985).

Serial No. 75/230,840

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

R. F. Cissel

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board