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Paper No. 13
JQ

10/26/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **i.think inc.**

Serial No. 75/398,920

John P. Pinkerton of Worsham, Forsythe & Wooldridge for applicant.

Michele-Lynn Swain, Trademark Examining Attorney, Law Office 103 (Michael A. Szoke, Managing Attorney).

Before Quinn, **Hairston** and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by i.think inc. to register the mark I.THINK INC. ("INC." disclaimed) for "market research services, namely market analysis, consumer market research, advertising research, conducting marketing studies, and market research conducted in whole or in part via a worldwide computer network" (in International Class

35) and "research and development for new products and services for others" (in International Class 42).¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Act on the ground that applicant's mark, if used in connection with applicant's services, would so resemble the previously registered mark THINK INC. ("INC." disclaimed) for "business management consulting in the area of facilitating business innovation through organization and process changes"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant contends that the marks are different in sound, appearance and meaning. In particular, applicant contends that its mark will be perceived and pronounced as "I DOT THINK INC." Applicant further claims that the cited mark is weak and is entitled to a narrow scope of protection. Applicant also asserts that the services are not directly competitive and that even though the services

¹ Application Serial No. 75/398,920, filed December 2, 1997, alleging a bona fide intention to use the mark in commerce. Counsel's statements suggest that use has commenced, although there is no evidence of record showing such use.

² Registration No. 2,119,018, issued on December 9, 1997.

"may coexist, at least in part, in the same broad industry," the services "are not necessarily related." Applicant states that the channels of trade are different inasmuch as its services will be offered via the Internet. Applicant also points to the sophistication of the business buyers of the services and that there have not been any instances of actual confusion.

The Examining Attorney maintains that the marks are similar in sound, appearance and overall commercial impression. The services are related, according to the Examining Attorney, and it is not uncommon for the same entity to offer both market research and business management consultation services. In this connection, the Examining Attorney submitted third-party registrations and excerpts retrieved from the NEXIS database.

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. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, 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 (CCPA 1976); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

We first turn to consider the similarity between the marks I.THINK INC. and THINK INC. Insofar as sound is concerned, we are not convinced by applicant's contention that its mark will be pronounced as "I DOT THINK INC." There is no evidence on this point and, given the construction of the mark and the nature of the services to which the mark is applied (market research which generally gauges what people think), we view it just as likely that the mark will be perceived and pronounced without the "dot," that is, as "I THINK INC." The marks also are similar in appearance inasmuch as THINK INC., the entirety of registrant's mark, is a significant feature of applicant's mark. The addition of the suggestive portion "I." (suggesting, according to applicant, the Internet) in applicant's mark does not sufficiently distinguish it from registrant's mark in overall commercial impression.³

In connection with its argument that the cited mark is weak and is entitled to a narrow scope of protection, applicant submitted, for the first time with its appeal

³ Applicant states that the "I." portion of its mark conveys an "Internet-based business" and "clearly evidences the channel of trade in which the applicant's mark is used." (brief, p. 7)

brief, a list of third-party registrations and applications for marks which include the word "think." The Examining Attorney, in her brief, neither objected to the untimely submission nor commented on the evidence so as to indicate that she was treating the evidence to be of record.

As a general rule, evidence submitted with an appeal brief is untimely. Trademark Rule 2.142(d). "Evidence submitted after appeal may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record." *Trademark Trial and Appeal Board Manual of Procedure*, §1207.03 [emphasis in original]. In the present case, in view of the untimely submission and the fact that the Examining Attorney did not affirmatively treat the evidence as being of record, the list does not form part of the appeal record. Further, and in any event, the mere listing of third-party registrations and applications are insufficient to make such registrations and applications of record. See, e.g., *In re Consolidated Cigar Corp.*, 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3; and *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2.

Even if the third-party registrations and applications sought to be relied upon by applicant were properly of record, it is pointed out that such evidence is entitled to little weight in evaluating whether there is a likelihood of confusion. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). We particularly point out here that none of the listed third-party marks includes the goods and/or services for which the marks are registered. Accordingly, even if we were to consider the list attached to applicant's brief, the probative value is so limited that it would not change the result in this case.

In sum, we view the marks as sufficiently similar that, if related services were rendered thereunder, confusion would be likely to occur in the marketplace. In reaching this conclusion, we have kept in mind the fallibility of human memory over time and the fact that purchasers usually retain a general rather than a specific impression of marks encountered in the marketplace.

With respect to the services, it is not necessary that they be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the

respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same person under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, applicant recognizes that the involved services "may coexist, at least in part, in the same broad industry." Although applicant goes on to argue that the similarities end there, we agree with the Examining Attorney that the services are sufficiently related that, when rendered under similar marks, confusion is likely to occur. The results of market research can be used in business consulting, and thereby facilitate innovation and changes (including development of new products and services) to meet customers' needs as shown by the research. It may well be, as the Examining Attorney suggests, that purchasers will view applicant's mark as identifying related, albeit different, services offered on the Internet from registrant. That is to say, purchasers will view applicant's mark as identifying market research services offered by registrant via the Internet, the

results of which would then be incorporated into registrant's business consulting.

In finding that applicant's and registrant's services are related, we have considered the third-party registrations which the Examining Attorney has submitted. The registrations show marks which are registered for both types of services as those involved here. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods and services listed therein are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

We also have considered the NEXIS excerpts introduced by the Examining Attorney. The gist of the articles is that a single entity may offer business management, market research and/or research and development services.

Inasmuch as there are no limitations in the cited registration, the identified services must be assumed to move through all the normal channels of trade for such services, and would be offered to all types of business customers. *Octocom Systems Inc. v. Houston Computer*

Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990). Thus, in the present case, registrant's services are broad enough to include those types of services rendered on the Internet. Further, as applicant acknowledges (brief, p. 8), the services of applicant and registrant are directed to the same classes of purchasers, namely businesses. The fact that some businesses may be sophisticated weighs in applicant's favor. This factor, however, is clearly outweighed by the other factors bearing on the relatedness of the services.

In sum, we are persuaded that market research is related to business management consultation services of the type listed in the cited registration.

Our conclusion in this case is not diminished by applicant's unsupported assertion that it has not encountered any instances of actual confusion between its mark and registrant's mark. While the absence of any instances of actual confusion over a significant period of time is a factor indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by the registrant under its mark. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). It is not a

mitigating factor where, as here, the record is devoid of information concerning the nature and extent of the marketing activities of applicant and registrant under their respective marks during the asserted period of contemporaneous use.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We conclude that consumers familiar with registrant's business management consulting services in the area of facilitating business innovation through organization and process changes offered under the mark THINK INC. would be likely to believe, upon encountering applicant's mark I.THINK INC. for market research services, namely market analysis, consumer market research, advertising research, conducting marketing studies, and market research conducted in whole or in part via a worldwide computer network, and research and development for new products and services for others, that the services originated with or are somehow associated with or sponsored by the same entity.

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Decision: The refusal to register is affirmed.

T. J. Quinn

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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