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Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Parasol Systems, Inc.*

Serial No. 75/585,377

Daniel R. Woodruff and Andrew T. Hoyne of *Armstrong Teasdale LLP* for *Parasol Systems, Inc.*

Caroline Fong Weimer, Trademark Examining Attorney, Law Office 113 (*Meryl Hershkowitz*, Managing Attorney).

Before *Hairston, Walters* and *Rogers*,
Administrative Trademark Judges.

Opinion by *Rogers*, Administrative Trademark Judge:

Parasol Systems, Inc. has filed an application to register IMPACT as a trademark in International Class 9 for goods identified as "computer software for managing sales and customer information in the chemical distribution and manufacturing industry, and manuals sold as a unit therefor."¹

¹ Serial No. 75/585,377, filed November 9, 1998, based on applicant's allegation of a bona fide intention to use the mark

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, as used in connection with the identified goods, is likely to cause confusion or mistake or to deceive consumers, in view of the prior registration of the mark CLEAR IMPACT for "computer software in the nature of a database containing customer information."²

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal.

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 presented by this case, two key considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc.

in commerce. An amendment to allege use was filed which asserts first use as of December 1998 and first use in commerce as of January 1999.

² Registration No. 1,998,807, issued September 3, 1996 to Impact Development Inc.

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin with the goods and note that our analysis of the similarity or relatedness of the goods is based on the identifications in the involved application and registration. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

Registrant's software is broadly identified as a "database containing customer information." Applicant's software "for managing sales and customer information" appears to be a very similar program. While registrant's identification does not state that its database includes sales information, it is elementary that customers purchase goods or services³ from sellers and there is no great leap required to consider registrant's database as including sales information; certainly, there is no reason to presume that registrant's database excludes such information. In any event, we need not engage in conjecture on this point,

³ We take judicial notice of the following definition: "**customer** n. 1. a patron, buyer or shopper." The Random House College Dictionary 329 (first ed., revised, 1982).

for both the applicant and the Examining Attorney have introduced information regarding registrant's database software, retrieved from registrant's web site.⁴ The summary of product features for registrant's database proclaims "Clear Impact has your sales process covered from initial customer contact to delivery of a final quote. ... [And] can generate sales reports and profit summaries..." In short, even if the specific features of the respective software products differ somewhat, they are very similar and appear to be competitive products.

Also, in the absence of any restrictions on channels of trade or classes of consumers, we must presume that registrant's goods move in all normal channels of trade and to all usual classes of consumers therefor, including the industry applicant targets. See CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). Thus, for our analysis, the goods are presumptively marketed through the same channels of trade to the same classes of consumers; that registrant's software may be marketed to additional classes of consumers outside the industry

⁴ Both the applicant and the Examining Attorney introduced the main or home page for registrant's product (www.clearimpact.com). Applicant also introduced the related product updates page while the Examining Attorney introduced the related product features page. We have considered this evidence in its entirety to discern the nature of the identified goods.

applicant targets does not dispel any likelihood of confusion among the common consumers.

Turning to the marks, we begin by noting that when marks will appear on or in connection with virtually identical goods or services, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (citations omitted).

Applicant argues that its mark is significantly different than registrant's mark because the latter includes the term CLEAR, while the former does not. Though this means that the marks look different and, to the extent they may be articulated, sound different, we agree with the Examining Attorney that they possess virtually the same connotation. The term CLEAR, as used by registrant, is merely an adjective that does not change the essential meaning of the term IMPACT.⁵

⁵ Neither applicant nor the Examining Attorney has discussed the connotation of the term "impact," so we take judicial notice of a dictionary definition to establish its meaning. We consider it, in the context of the relevant goods, to mean "a concentrated force producing change: an esp. forceful effect checking or forcing change: an impelling or compelling effect." Webster's Third New International Dictionary 1131 (1993).

The Examining Attorney, in her brief, asked that we take judicial notice of a definition of "clear" from an on-line dictionary, and attached a reprint of the definition to her brief. This is a manifestly untimely submission of such

Applicant argues that there is no absolute rule that a likelihood of confusion must be found when "a junior user has a mark that contains in part the whole of another's mark." The point of the argument is not at all clear and the cases on which applicant relies are not apposite.⁶ Each of those cases involved a situation wherein a registrant had a one-word mark and a subsequent applicant sought registration of a two-word mark that incorporated the registered term. We are faced with exactly the opposite situation. Applicant seeks to register registrant's mark, minus its modifying adjective. We do not doubt that there are cases in which deletion of one word of a two-word mark would yield a one-word mark with a different connotation

evidence. See In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999). Nonetheless, definitions of "clear" are readily available in printed dictionaries, and we take judicial notice of the following meanings, which appear the most apt for registrant's mark: "easily understood; without ambiguity...entirely comprehensible; completely understood..." The Random House College Dictionary 250 (first ed., revised, 1982). That prospective purchasers would consider the term CLEAR in this manner stems from applicant's promotion of its goods as having a "simple design [which] gets you up and running right away" and a "focused approach."

In short, the likely connotations of the involved marks are of a concentrated force for changing the way one manages sales and customer information (applicant's software), and an easily understood concentrated force for maintaining a database of customer information (registrant's software).

⁶ Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 USPQ 529 (CCPA 1970) and In re Merchandising Motivation, Inc., 184 USPQ 364 (TTAB 1974).

than that of the two-word mark; the instant case, however, does not present such a situation.

Applicant also argues that there are numerous registrations for the term IMPACT for computer related goods⁷ and that the term is very weak and entitled to only a limited scope of protection. Applicant concludes that consumers are accustomed to distinguishing between different entities using this term as a mark based on differences in their respective goods and that they will likewise be able to distinguish between applicant and

⁷ Applicant attached, as exhibit B to its response to the Examining Attorney's initial Office action, information reported to have been retrieved from a "TrademarksCan" search. This exhibit covers five registrations and two pending applications. (One of the registrations subsequently was cancelled under Section 8 of the Trademark Act; the two applications subsequently resulted in issuance of registrations.)

A private search system printout is an improper method for introducing third party registrations and applications into the record. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974); see also Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). The Examining Attorney, however, did not object to the form of the material and, in her brief, discussed the relevance of these submissions. Accordingly, we have considered applicant's exhibit B.

Applicant also attached, as exhibit E to its response to the initial Office action, approximately 50 pages of additional private search system information regarding IMPACT and IMPACT-formative marks. (Applicant asserts, in its response to the first Office action, that this material is from a search of Patent and Trademark Office records, but this clearly is not true.) Applicant's only reference to the material in this exhibit is its statement that this material reveals "additional marks approved for registration or applications for marks consisting of the word IMPACT for a variety of other goods and services." Not one of the marks in this exhibit was specifically addressed by either applicant or the Examining Attorney. We decline applicant's implied invitation that we explore this exhibit for possibly relevant material.

registrant in view of the differences in their respective goods.

We agree with applicant that the various registrations for IMPACT, and registrant's registration for CLEAR IMPACT, appear able to coexist because of differences in the respective goods. We agree with the Examining Attorney, however, that applicant's goods and those of the cited registrant do not differ in any significant manner, for reasons already discussed herein. Moreover, even if we consider the cited mark to be weak, the owner of a registration for a weak mark is entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976).

Under the circumstances of this case, we find that consumers familiar with registrant's mark used on or in connection with its software, when confronted with applicant's mark used on or in connection with applicant's software, will likely be confused as to source or sponsorship. We rely, in this regard, not only on the competitive nature of the involved goods and the similarities of applicant's and the cited registrant's respective product marks, but also on the registrant's

trade name--Impact Development Inc.--used in conjunction with its product mark.⁸ It would not be at all unusual for a prospective purchaser of IMPACT software to assume that it emanates from or has some connection with Impact Development Inc., the source of CLEAR IMPACT software.

To the extent that, in view of the numerous third party registrations for the term IMPACT, there is any doubt about the merit of refusing registration to applicant, we resolve this doubt in favor of registrant. 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).

Decision: The refusal of registration is affirmed.

⁸ The final *du Pont* factor directs our consideration to "[a]ny other established fact probative of the effect of use." *E. I. du Pont, supra*, 177 USPQ at 567 (factor 13). The web site evidence made of record by both applicant and the Examining Attorney establishes registrant's use of this trade name.