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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eric Jacobson

Serial No. 75/702,771

Richard L. Morris, Jr., Esq. for Eric Jacobson.[1]

Thomas J. Gleason,[2] Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

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[1] Jeffrey H. Greger of Mason, Mason & Albright filed many of the papers in the application, and appeared at an oral hearing before the Board, although he was never formally appointed applicant's counsel.

[2] Thomas Gleason wrote the appeal brief. The application had previously been examined by Kim Saito, and Nick Altree appeared for the Office at the oral hearing.

Eric Jacobson has appealed from the final refusal of the Trademark Examining Attorney to register IMPACT PHOTOGRAPHY, with the word PHOTOGRAPHY disclaimed, for "professional photography services, namely, customized individual photographic portrait and portfolio services exclusively for athletes, namely fitness and physique photography and athletic model photography."[3] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark IMPACT, previously registered for "lithographic prints of photographs" that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

We affirm the refusal of registration.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA

[3] Application Serial No. 75/702,771, filed May 10, 1999, and asserting first use and first use of the mark in commerce on December 1, 1998.

1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the goods and services, the relationship between photographs and photography services is obvious. Photographs are created as a result of the rendering of photographic services, and the photographic product is seemingly intrinsic to the service, since without the photographs themselves the taking of photographic portraits would have little value. The Examining Attorney has shown this relationship through the submission of third-party registrations which are for both the goods and the services. See, for example, Registration No. 2,272,374 for portrait photography services in the field of youth sports and mounted and unmounted photographs in the field of youth sports. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Applicant, however, points out that the cited registration is not for photographs per se, but is for "lithographic prints of photographs." Applicant argues that lithography and photography are different, and that lithographic prints of photographs refers to a mass production process which would be used for posters and postcards, and not for individual photographs. In support of this argument, applicant has submitted specimens taken from the file of the cited registration, which show a photograph on a postcard and a photograph on what is identified as a "mini picture." Further, based on applicant's characterization of the registrant's goods as postcards, he argues that the pertinent consumers of the goods are bulk buyers, and thus the goods and services would be sold to different consumers through different channels of trade.

It is not clear to us that the term "lithographic prints of photographs" would refer only to postcards, posters and the like. There is nothing in the identification which would preclude the identification to include, for example, prints of photographs which would be considered fine art. However, even if we accept that there is a mass production aspect to the registrant's goods, we find that these goods and applicant's services are related.

There is no question that photographic services would be required to create registrant's lithographic prints of photographs. Moreover, several of the third-party registrations submitted by the Examining Attorney show that a single mark has been registered for, inter alia, reproductions of photographic prints, postcards, posters, gift cards and portrait photography (Registration No. 2,243,000); postcards, posters, photographic prints and photography of people and places for others (Registration No. 2,342,733); photographic prints and notecards and outdoor photography services (Registration No. 1,771,439); personalized photograph cards, calendars and portrait photography services for sports teams (Registration No. 1,931,167); and mounted and unmounted photographs and yearbooks and portrait photographic services (Registration No. 2,130,214). These registrations show that goods such as the registrant's lithographic prints of photographs and applicant's professional photography services may emanate from a single source under a single mark.

Further, lithographic prints of photographs are not necessarily purchased only by bulk buyers. Ordinary consumers may also wish to have lithographic prints made of their photographs, for example, for use as Christmas cards or for the personal photo cards often referred to as

"trading cards." It is common knowledge that individuals and amateur sports teams can have their photographs printed on such cards in order to make it appear that they are professional athletes.

We note that applicant has limited his identification to "customized individual photographic portrait and portfolio services exclusively for athletes, namely fitness and physique photography and athletic model photography." However, because the cited registration is not limited as to subject matter, the lithographic prints of photographs may be of athletes (amateur or professional) and athletic models. Athletes or athletic models might well encounter lithographic prints, whether artistic prints or posters or even personal photograph "trading" cards. They may well think, if photographic portrait and portfolio services were to be offered under the same or a confusingly similar mark as the lithographic prints of photographs, that the photographic portrait and portfolio services and the lithographic prints of photographs emanated from or were sponsored by the same source.

This brings us to a consideration of the marks. Applicant's mark is IMPACT PHOTOGRAPHY; the cited mark is IMPACT. The fact that applicant's mark contains the additional term PHOTOGRAPHY is insufficient to distinguish

the marks. PHOTOGRAPHY is a generic term for applicant's photographic services, and has no source-identifying capacity. As has been said many times, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See **In re In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Because PHOTOGRAPHY is generic for applicant's services, we treat IMPACT as the dominant part of applicant's mark, and find that the marks are virtually identical in appearance, pronunciation and commercial impression.

In saying this, we have considered applicant's argument that the marks have different connotations, and that the cited mark connotes prints that are generated by a "bold and clear reprint process", while applicant's mark connotes "the services of a professional photographer, in this case for individual athletic photo sessions." Brief, p. 4. However, we are not persuaded by this argument. In both cases, we think that IMPACT and IMPACT PHOTOGRAPHY will be viewed as suggesting that the photographs, whether produced as lithographic prints or resulting from applicant's professional photography services, will be

noticeable and have an “impact” on the viewer. Thus, we find that the marks have the same connotation.

Applicant also asserts that IMPACT is a weak mark and is entitled to a limited scope of protection. In connection with this argument, applicant stated at page 4 of his appeal brief that “there are over 1,461 IMPACT formative marks maintained in [the] U.S. Patent and Trademark database,” and submitted as an exhibit a page from the USPTO TESS database showing that, for the search term “*impact*[bi,ti]” 1461 records were found, and listing the marks and serial numbers of 19 applications (2 of which are “dead”) and of one registration (for THE BIVINGS GROUP WIRED GLOBAL IMPACT). The Examining Attorney has objected to this exhibit as untimely, and we agree. Applicant also argues that the Board should take judicial notice of these registrations because “this information is a public record readily available to the examining core [sic] and the Board.” Reply brief, p. 2. However, it is well-established that the Board does not take judicial notice of registrations that reside in the U.S. Patent and Trademark Office, and that the submission of a list of registrations

is insufficient to make them of record. See **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974).[4]

Applicant also asserts that, even if the Board does not consider the 1,461 IMPACT-formative marks indicated by the TESS system, there is evidence in the record of 1,090 IMPACT-formative marks. Applicant refers to the search initially conducted by the Examining Attorney to determine whether there were any conflicting registrations. The search result simply shows that for the search "*impact*[bi,ti]" there were a total of 1090 marks. There is no indication of what those marks are. As we indicated above, a list of registrations is insufficient to make them of record. Here, of course, the search statement does not even provide a list of the marks. We would also point out that the search statement could refer to applications as well as registrations (and applications are not evidence of anything other than the fact that they were filed), and to marks for goods or services totally unrelated to the registrant's or to applicant's.

Applicant also refers to his statement, in his response to the first Office action, that "a search for the

[4] We point out that in this case applicant did not even supply a list of the 1,461 alleged IMPACT marks, just a summary statement from the TESS system.

mark IMPACT revealed over three hundred registrations comprising IMPACT formative marks." That response also indicated that "there are at least forty-four IMPACT formative trademarks in Class 16," which implies that over 250 registrations are not for similar goods or services. Needless to say, the mere statement that this number of registrations exists does not suffice to make them of record.

What is of record, however, are ten registrations for IMPACT formative marks which applicant submitted with his response to the first Office action. Some of these registrations are for goods and/or marks that are sufficiently different from the registrant's marks and goods that they do not persuade us that registrant's mark IMPACT is entitled to a limited scope of protection. See, for example, Registration No. 1,985,612 for IMPACT-LATCH for picture frame hangers and screws sold as a unit therewith; Registration No. 2,106,370 for VISUAL IMPACT for computer programs and program user manuals sold as a unit to banks and financial institutions for image processing of documents, especially to develop, enhance and transmit graphic images of checks and financial instruments; Registration No. 1,782,454 for IMAGES WITH IMAPCT! for computer software and instruction manuals sold together as

a unit for use in publishing and printing graphics; and Registration No. 2,233,485 for IMPACTUSA for promoting the goods and services of others through the distribution of printed material.

While there are certain third-party registrations which are closer to registrant's mark and goods, most particularly Registration No. 2,117,186 for IMPACT for printed material, namely posters, comic magazines, milk cap trading cards, trading cards and picture booklets, we do not view this registration as demonstrating that the cited mark IMPACT is so weak that its protection would not extend to prevent the registration of IMPACT PHOTOGRAPHY for the photographic services identified in applicant's application. Although the third-party registrations, as well as the meaning of the word itself, show that IMPACT has a suggestive significance, that suggestion, as we said previously, is the same for both applicant's and the registrant's marks.

Applicant also argues that the purchasers of the registrant's goods and applicant's services are careful and discriminating. Applicant bases this argument on the assertion that the registrant's goods are purchased in bulk by companies which then resell the goods, such as postcards, to the end users. However, as we stated above,

the purchase of lithographic prints is not limited to commercial enterprises; individuals, including amateur athletes and models, can purchase such items. Further, although applicant's customized individual photographic portrait and portfolio services for athletes and athletic models may cost "thousands of dollars for a single reproduction," the services, as identified, cannot be deemed to be only for such expensive reproductions or photo shoots. Thus, an amateur athlete or bodybuilder may wish to have his or her photograph taken either to have for himself or herself or to give to his/her friends, and may obtain the services of a photographer who specializes in such pictures. That consumer could even use the photograph obtained in such manner for a greeting card or personal "trading card."

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the registrant and prior user. **In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes**, 487 F. 2d 918, 179 USPQ 729 (CCPA 1973). In this case, we note that registrant's registration was issued in 1978, and claims a date of first use of 1975; applicant did not begin using his mark until December 1998.

Decision: The refusal of registration is affirmed.