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OF THE TTAB

Hearing:
October 11, 2005

Mailed: November 3, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re UTi Worldwide Inc.

Serial No. 76177195

Thomas J. Moore of Bacon & Thomas, PLLC for UTi Worldwide Inc.

Raul Cordova, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 8, 2000, UTi Worldwide Inc. (a British Virgin Islands corporation) filed an application to register on the Principal Register the mark shown below

The logo for eMpower features the word "eMpower" in a bold, italicized, sans-serif font. A thick, black, curved line arches over the letters "M" and "p", starting under the "e" and ending under the "r".

for services ultimately identified as follows:

"information relating to the storage
and forwarding of freight that will be,

was or is being shipped by the service mark owner provided only to staff and customers with a password; information relating to the storage and forwarding of freight that will be, was or is being shipped by the service mark owner, provided on-line only to staff and customers with a password via computer database or the Internet from the website of the service mark owner" in International Class 39; and

"information relating to the tracking of freight that will be, was or is currently being shipped by the service mark owner provided only to staff and customers with a password; information relating to the tracking of freight that will be, was or is being shipped by the owner of the service mark, provided online only to staff and customers with a password via a computer database or the Internet from the website of the service mark owner" in International Class 42.

The application is based on applicant's claimed date of first use of January 2000.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Examining Attorney cited a registration for the mark IMPOWER for the following goods and services:

"computer programs for use in the shipping industry, namely, a customs regulation and import information database for cargo, entry, and billing data" in International Class 9;

"transportation of goods of others by air, rail, ship or truck" in International Class 39; and

"computer services, namely, providing a database containing shipping and freight information" in International Class 42.¹

The Examining Attorney asserts that applicant's mark, when used in connection with its identified services, would so resemble the mark in the cited registration as to be likely to cause confusion, mistake or deception.

Applicant has appealed, and briefs have been filed. An oral hearing was held on October 11, 2005.

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

¹ Registration No. 2639923, issued October 22, 2002 to CNF Inc., and was subsequently transferred through mense assignments to United Parcel Service of America, Inc. (Reel 3072, Frame 0750.)

We turn first to a consideration of the respective goods and services -- International Classes 39 and 42 in the application, and International Classes 9, 39 and 42 in the cited registration.² It is well settled that goods and/or services need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, supra; *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

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 goods and/or services as identified in the application with the goods and/or services as identified in the cited registration(s). See

² Both applicant and the Examining Attorney argued the relatedness of the respective services, and neither focused on the cited registrant's goods ("computer programs ..." in International Class 9). Thus, the Board will determine the relatedness of only the involved services.

Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce 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., supra, 55 USPQ2d at 1846:

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 involve information relating to the storage and forwarding as well as tracking of freight and registrant's services involve transportation (i.e., forwarding) of freight and providing a database with shipping and freight information (i.e., tracking). The Examining Attorney points out that applicant's specimen

includes references to "supply chain management business," "supply chain planning and optimization," "customs brokerage," "freight forwarding," "global tracking," and "web-based shipment monitoring"; and that registrant's website (printouts of a few pages of which had been made of record by the Examining Attorney) includes references to "supply chain management," "supply chain synchronization," "customs brokerage," "global logistics," and "data-flow management." It is clear on this record that applicant's and registrant's services, as identified, are virtually identical.

Applicant strongly argues that the trade channels and the purchasers of the parties' services are different; and that applicant has limited its identifications of services to providing the information services only to "staff and customers with a password"; and that it is unreasonable to assume that registrant's customers would need a password for the conventional distribution of registrant's services. As identified, applicant's services are accessible only by applicant's own staff or by customers who have been issued a password. Nonetheless, as argued by the Examining Attorney, the use of passwords is not excluded from registrant's identifications of services; and "in modern times, passwords are ubiquitous and do not represent an

entry barrier to trade." (Examining Attorney's brief, p. 5.) We agree with the Examining Attorney that registrant's unrestricted identifications of services encompass the restriction found in applicant's services. We are not persuaded by applicant's argument that the respective trade channels are different.

Further, there is nothing in the identifications of services of either applicant or registrant which limits the purchasers of these services. That is, any entity seeking to ship something could potentially seek applicant's and/or registrant's services (industrial/commercial shippers, or an individual shipping a single package). Therefore, we must presume in this administrative proceeding that the involved services are offered to all usual classes of purchasers. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, supra.

We find that the channels of trade and the classes of purchasers are the same or are, at least, overlapping.

Applicant argues that the purchasers of both applicant's and registrant's services would make "careful, sophisticated purchasing decisions." (Brief, p. 13.) Applicant's specimens and registrant's website indicate that these services would involve some degree of care and

sophistication in purchasing. However, assuming sophistication of and care taken by the purchasers of these services, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also, Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and In re Decombe, 9 USPQ2d 1812 (TTAB 1988). That is, even sophisticated purchasers of these virtually identical services are likely to believe that the services emanate from the same source, when offered under similar marks. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841-1842 (Fed. Cir. 1990); and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

We consider next the marks in terms of their similarities and dissimilarities as to sound, appearance, connotation and commercial impression. It is well settled that marks must be considered in their entirety because the commercial impression of a mark on a 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 impression is created by the purchaser's cursory 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). The proper test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the overall similarities and dissimilarities engendered by the involved marks.

Applicant argues that its mark is "dominated by a unique and highly distinctive design" (brief, p. 10); that the first letter is a lower case "e" in italics, followed by the letter "M" in upper case, and then "power" in lower case; that the design emphasizes the meaning of the word "power," while "the 'eM' suggests the famous equation of Albert Einstein" (brief, p. 10); that the different fonts suggest "a pronunciation of 'e-M-power' rather than 'empower'" (brief, p. 10); that the "initial letter 'e' is commonly understood to refer to electronic processing and the Internet" (applicant's July 13, 2004 response, p. 2); and that the Examining Attorney has not considered applicant's mark as a whole.

Applicant referred in its July 13, 2004 response (p. 2) to two dictionary definitions of terms, specifically, (1) Webster's Ninth New Collegiate Dictionary (1986)

definition of "empower" as "to give official authority or legal power to"; and (2) Webster's Third New International Dictionary (Unabridged 1986) definition of "impower" as "obsolete variant of empower."

The Examining Attorney argues that the dominant feature of applicant's mark is the word "empower"; that the difference in the words EMPOWER and IMPOWER would be difficult to discern when spoken; that the brainydictionary.com definition of "impower" as "(v.t.) See Empower" establishes that the terms are equivalent in meaning; and that the design element in applicant's mark does not obviate the similarity of the marks in this case.

While it is plausible, as applicant argues, that its mark would be pronounced by some consumers as the letter "e," the letter "m" and the word "power," we find it is equally plausible that some consumers would pronounce it as the word "empower." The Board finds it noteworthy that in applicant's declaration (filed January 14, 2005), applicant refers to its mark as "EMPOWER"; and that applicant referred to its mark in its application as "EMPOWER and Design." When spoken, "empower" and "impower" are virtually indistinguishable.

Given the dictionary definitions of the words "impower" and "empower," and inasmuch as the word "impower"

is an older variant of the word "empower," we find the connotations of the two words are the same, specifically giving customers more control over or knowledge about their shipments.

As to appearance, we acknowledge that applicant's mark involves upper and lower case letters in different sizes and fonts and it includes a design, whereas the mark in the cited registration is the word IMPOWER. Nonetheless, we keep in mind, as stated previously, that the proper test in determining likelihood of confusion is not a side-by-side comparison of the marks. Rather, the determination must be based on the recollection of the purchasers, who normally retain a general rather than specific impression of the many trademarks encountered; that is, a purchaser's fallibility of memory over a period of time must also 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). The differences between the marks are not sufficient to obviate the likelihood of confusion. See *In re Dixie Restaurants Inc.*, supra; and *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

We find that these marks, considered in their entirety, are similar in sound, connotation and commercial impression. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Applicant's citation to and argument concerning the case of *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990) is not persuasive. The facts of that case (involving the symbol of the potassium ion, "K+"), are readily distinguishable from the facts in the appeal now before us involving the registered word "impower" and applicant's mark which can be read as the word "empower."

Applicant argues that there are "numerous other marks that comprise 'POWER'" (brief, p. 14); and that a search of the USPTO's TESS records for live marks with the word "POWER" resulted in 10,027 records, with live marks in International Class 39 being 241 and live marks in International Class 42 being 806. Applicant specifically requests in its reply brief (pp. 1-2) that the Board "consider third[-]party marks which are the subject of an active federal application or registration"; and that due to the situation today with the information available on

the USPTO website, there should no longer be a need for copies of a federal application or registration, including the entire file wrapper thereof.³ Essentially, applicant requests that the Board take judicial notice of trademark application and registration records of the USPTO. We reject that request for several reasons.

It is well settled that the Board does not take judicial notice of third-party applications and registrations. See *In re Wada*, 48 USPQ2d 1689, footnote 2 (TTAB 1998), *aff'd* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Carolina Apparel*, 48 USPQ2d 1542, footnote 2 (TTAB 1998); *In re Caserta*, 46 USPQ2d 1088, footnote 4 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, footnote 2 (TTAB 1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974).⁴ Rather, the interested party must properly make any third-party application(s) and/or registration(s) of record by submitting either a photocopy of the official record itself

³ Applicant filed at the same time as its reply brief a request that the appeal be suspended and the application be remanded to the Examining Attorney for consideration of one third-party application (Serial No. 78373496) and one third-party registration (Registration No. 2673845). Applicant's request to suspend and remand was denied by Board order dated July 12, 2005.

⁴ As noted in these cases, third-party applications are of extremely limited probative value being evidence only that the application was filed on a particular date, and third-party registrations are generally of limited probative value.

(that is, each individual third-party application/registration) or a printout from the USPTO database of each one (not a printout of a list -- see *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992)). See generally, TBMP §§1208.02 and 1208.04 (2d ed. rev. 2004).

Here applicant's attorney has simply referenced his search of USPTO TESS records and asserts there are over 10,000 live records with the term POWER. This is an excellent illustration of a significant policy reason why the Board does not take judicial notice of USPTO trademark application/registration records. The Board does not have the personnel or the time to search USPTO records when it was the interested entity's obligation to submit the evidence into the record. Moreover, the Board would not know exactly what evidence the entity (either an applicant or an Examining Attorney) truly wanted the Board to consider and what it presumably proves in their view.

In addition, whether a term is a weak mark must be determined in the context of the particular line or field of merchandise or services on or in connection with which the mark is used. See *In re Bayuk Cigars Incorporated*, 197 USPQ 627 (TTAB 1977). Thus, while a term may be weak or commonly used in one field, the same word may be unique and possess strong trademark significance in another field.

Thus, even a large number (i.e., as here, over 10,000 "POWER" marks) does not, by itself, prove that a term is weak in a particular field. We note that applicant did not include any results of any searches of live third-party applications and/or registrations with either the word "IMPOWER" or "EMPOWER."

The record does include one third-party registration which was cited by the Examining Attorney under Section 2(d), even though he later withdrew the refusal based thereon. That cited registration, Registration No. 2503803, issued November 6, 2001 for the mark "MPOWER" for "business consulting on efficient methods of manufacturing, distributing, accounting and communicating with suppliers and vendors" in International Class 35. We find this registration distinguishable as applicant argued during the course of this ex parte prosecution. In any event, as often noted by the Board and the Courts, each case must be decided on its own merits. The determination of registrability of another mark by another Trademark Examining Attorney cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

Even if applicant had shown that the cited mark is weak (which it has not done), such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976). The registrant's ownership of its registration gives it the exclusive right to use the registered mark on and in connection with its goods and services specified in the certificate of registration. See Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b).

Applicant submitted a declaration (the signature and title lines are illegible) that "Applicant is unaware of any confusion between Applicant's mark EMPOWER, and the mark IMPOWER of U.S. Registration No. 2,639,923." However, there is no evidence of applicant's and registrant's respective geographic areas of sales, or the amount of sales of the involved services under their respective marks, since applicant commenced its use in January 2000. Further, there is no information from registrant on the issue of actual confusion. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). This factor is not

persuasive in the overall balancing of the du Pont factors in this case. See also, *In re Majestic Distilling Company, Inc.*, supra.

In view of the similar marks, the identical services, and the same or overlapping channels of trade and the same purchasers, we find that consumers seeing applicant's mark EMPOWER and design, may likely assume that applicant's services emanate from or are associated with or sponsored by the cited registrant.

While we do not have doubt on the question of likelihood of confusion in this case, if there were such doubt, it must be resolved against applicant as the newcomer, as applicant 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); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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