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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Red Magnet Marketing, LLC

Serial No. 76481092

Andrew G. DiNovo of Jenkins & Gilchrist, P.C. for Red Magnet Marketing, LLC.

Carol Spils, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Hohein, Zervas and Cataldo, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Red Magnet Marketing, LLC to register the mark RED MAGNET MARKETING in standard character form on the Principal Register for the following services, as amended: "business marketing and direct mail consulting services for financial services" in International Class 35.¹

¹ Application Serial No. 76481092 was filed January 9, 2003, based on applicant's assertion of its bona fide intent to use the mark in commerce. In response to a requirement by the trademark examining attorney, applicant disclaimed the exclusive right to use "MARKETING" apart from the mark as shown.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with its services, so resembles the mark REDMAGNET, previously registered on the Principal Register in standard character form for "providing multiple-user access to a global computer information network" in International Class 38 and "web site creation and design, maintenance and implementation for others, graphic art design" in International Class 42,² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal. An oral hearing was not requested.

Applicant contends that its mark does not create the same commercial impression as the mark in the cited registration. Specifically, applicant argues that while "RED MAGNET" may be the dominant feature of its mark, the disclaimed term "MARKETING" is not "devoid of significance in terms of the entire composition of the mark" (brief, p. 6). Applicant further contends that it provides business marketing and direct mail consulting services for customers in the financial services industry; that, by contrast, registrant provides Internet access, web site design and

² Registration No. 2628675, issued October 1, 2002.

hosting services, and graphic art design; that as identified, applicant's services are not related to those of registrant; and that the examining attorney has failed to demonstrate any relation between them. Applicant asserts in addition that the recitation of services in the cited registration is "unquestionably overbroad, impermissibly vague, and unnecessarily imprecise;" that nonetheless, registrant's broadly identified services do not encompass applicant's "potentially complementary services;" and that "it is inequitable to cite a broad vague mark whose identification of services contains the words 'web site' or 'global computer information network' against the Applicant's mark when no reasonable person could ever be confused as to the source of the respective services," (brief, p. 4, 5 and 8). Applicant contends moreover that the trade channels for its services "are limited by their own terms to the financial services market, such as banks, mortgage companies, insurers, investment brokers, and the like;" that the trade channels for registrant's services include information technology, computer and creative design professionals, web masters and "online business persons;" that registrant's services are "not specifically targeted to the financial services industry;" and that, as a result, the trade channels for

its services differ from those of registrant's services. (brief, p. 10-11). Applicant also insists that the consumers of registrant's services as well as its own are highly sophisticated professionals; that the services provided under both marks are expensive; and that, as a result, the purchasers of the services provided under both marks are careful and exercise great care in their selection thereof.

The examining attorney maintains that applicant's mark consists of the dominant wording "RED MAGNET" and the disclaimed wording "MARKETING;" that the dominant portion of applicant's mark is more significant in creating a commercial impression than the disclaimed wording; and that, when viewed as a whole, applicant's mark is highly similar to the registered mark REDMAGNET. The examining attorney further maintains that the same marks are used to indicate the source of both applicant's services as well as those of registrant; that registrant's services are broadly described and contain no restrictions as to their channels of trade; and that, as a result, registrant's services are presumed to encompass those of applicant, and to move in all normal channels of trade for such services. The examining attorney asserts in addition that the same consumers will be exposed to the services identified under

both applicant's mark and that of registrant; and that even sophisticated purchasers may experience confusion as to the source of those services.

Our determination of the issue 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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

We first consider the similarity of the marks. In this case, applicant's mark, RED MAGNET MARKETING, is highly similar to the cited mark, REDMAGNET. Although applicant displays its mark with a space between the terms RED and MAGNET and registrant's mark is displayed as a single term, i.e., REDMAGNET, consumers are not likely to note or remember such a minor difference that does not affect pronunciation and barely affects the appearance of

the marks. We note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). As for the presence of MARKETING in applicant's mark, this term, which has been disclaimed, is obviously descriptive of the recited services. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 entirety. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In view of the descriptive nature of the word MARKETING, it has little, if any, source-indicating significance, and is entitled to less weight in the likelihood of confusion analysis. Consumers who are familiar with the mark, REDMAGNET, used in connection with registrant's various web site, graphic art design and Internet access services, who then see the mark RED MAGNET MARKETING used in connection with business marketing and direct mail consulting services for financial services, are likely to assume that the owner

of the REDMAGNET mark has simply added MARKETING when using the mark in connection with marketing and related services. In other words, consumers are likely to view both marks as variations of each other, but both as indicating a single source. Thus, despite the fact that the applicant's mark includes the word MARKETING, the marks REDMAGNET and RED MAGNET MARKETING are highly similar in appearance, pronunciation, connotation and commercial impression. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

Turning now to our consideration of the recited services, it is clear that applicant's services are different from those of registrant. However, it is not necessary that the services at issue 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 instead 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 persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re*

International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for services that are identified in both applicant's application and the cited registration. *See, for example:*

Registration No. 2689047 for, *inter alia*, business marketing consulting services, creating web sites for others, and graphic art design;

Registration No. 2623165 for, *inter alia*, business marketing consulting services, computer web site design, and printing and graphic art design;

Registration No. 2692001 for, *inter alia*, business marketing consulting services, graphic art design, and computer site design in the nature of design of world wide web pages;

Registration No. 2676874 for, *inter alia*, advertising and marketing consultation services for others, graphic art design, and creating, designing and implementing websites for others;

Registration No. 2726552 for, *inter alia*, business marketing consulting services, creating, designing, implementing and maintaining web sites for others, and graphic art design;

Registration No. 2723528 for, *inter alia*, graphic art design of direct mail and printed business forms, and direct mail consulting services;

Registration No. 2784991 for, *inter alia*, business marketing consulting services, graphic art design, and computer services, namely, designing and implementing web sites for others;

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Registration No. 2721452 for, *inter alia*, business marketing and direct mail consultation services, graphic art design, and creating implementing, and maintaining web sites, and computer graphics services, for others;

Registration No. 2665803 for, *inter alia*, business marketing consulting services, computer services, namely, designing and implementing web sites for others in the field of healthcare, and providing multiple-user access to a global computer information network for the transfer and dissemination of information relating to the field of healthcare; and

Registration No. 2363855 for, *inter alia*, business marketing consulting services; and providing multiple-user access to a global computer information network.

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, 1786 (TTAB 1993).

In addition, the Examining Attorney submitted evidence from the Lexis/Nexis computer database suggesting that the same entities provide both marketing and web site design services. Excerpts from these articles and web pages follow (emphasis in originals):

The agency offers **marketing, web site design** and public relations services to companies such as CVS, John Hancock, Verizon Wireless and Anheuser-Busch. The Boston headquarters, which takes up... (**The Patriot Ledger**, June 1, 2005);

... catalogs featuring the company's services offered, pricing estimators, data capture and reporting, customer relationship management tools, interactive **marketing, web site design**, hosting, credit card processing, and IT hosting. The consumer site, located at SimplyDone.com, provides a rich ...
(**Business Wire**, August 22, 2000);

... a small volume of requests in using Visual WebTools customers who wanted the Company to consult on business, **marketing and web site design** concerns. Currently the request by users of Pacific WebWorks solutions has increased due to recent sales growth of Visual Web ...
(**Business Wire**, May 10, 2000); and

... Duxbury, that offers entrepreneurs and small business owners an array of professional services, from desktop publishing and bookkeeping to secretarial support, **marketing and web site design**, The business was founded by James Tzarnos of The Practice Management and Cheryl McKeary of McKeary Desktop Designs.
(**The Patriot Ledger**, June 6, 1998).

The foregoing evidence demonstrates the related nature of the services at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Furthermore, we are not persuaded by applicant's arguments that the recitation of services in the cited registration is "unquestionably overbroad" or that registrant's services travel in channels of trade that are separate and distinct from those in which applicant's services may be encountered. It is settled that in making our determination regarding the relatedness of the parties'

services, we must look to the services as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") Thus, while applicant's services, as identified, may be directed toward businesses and other entities in the financial field, registrant's recitation of services contains no such limitations. Accordingly, registrant's services are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including consumers of applicant's services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The final *du Pont* factor discussed by applicant and the examining attorney is that of the conditions of sale. Applicant asserts that both its services and those of registrant are expensive, and would be purchased by careful and sophisticated users. However, sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). Further, there is no evidence that either applicant's or registrant's services would be purchased only by highly sophisticated persons. Moreover, in view of the third-party registrations which are evidence that both marketing services and web site, graphic art design, and Internet access services are of a type which may emanate from a single source, prospective purchasers may mistakenly believe that these services could emanate from a single source. In addition, even if some degree of care were exhibited in making the purchasing decision, the marks RED MAGNET MARKETING and REDMAGNET are so similar that even careful purchasers are likely to assume that the marks identify services emanating from a single source.

Decision: The refusal of registration is affirmed.