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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Duke

Serial No. 76622840

Linda Joy Kattwinkel of Owen, Wickersham & Erickson P.C.
for Linda Duke.

Kristina Kloiber, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney).

Before Hairston, Holtzman and Taylor, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Applicant seeks to register the mark DUKE MARKETING
(in standard character form) for "business marketing
services and consultation, direct mail consulting services,
conducting market studies, providing business marketing
information and interactive business marketing consulting

services via the internet, and direct marketing advertising for others.”¹

The trademark examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s mark, as applied to applicant’s services, so resembles the mark DUKE ENERGY, previously registered for, inter alia, “marketing and advertising in the fields of energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management,”² as to be likely to cause confusion or mistake or to deceive.

When the refusal was made final, applicant filed this appeal. Applicant and the examining attorney have filed briefs.

Before turning to the merits of the appeal, we must discuss an evidentiary matter. With her appeal brief,

¹ Application Serial No. 76622840, filed December 2, 2004, alleging first use anywhere and first use in commerce on March 1, 2001. The word MARKETING is disclaimed apart from the mark as shown.

² Registration No. 2316855, issued June 8, 2000, Section 8 affidavit accepted and Section 15 affidavit acknowledged. The word ENERGY is disclaimed apart from the mark as shown. The registration also includes many other services. However, it is clear from the examining attorney’s comments that the refusal is based on likelihood of confusion with the above services, in particular.

applicant submitted two exhibits. Exhibit 1 consists of a TESS printout of third-party registrations and applications for marks consisting of the term DUKE. Exhibit 2 consists of copies of third-party registrations which applicant maintains demonstrate that marks owned by two different entities and consisting of the identical first term followed by MARKETING and ENERGY respectively can coexist. Applicant requests that the Board take judicial notice of the exhibits, or in the alternative, remand the application to the examining attorney for consideration of the exhibits. The examining attorney, in her brief, objects to exhibit 1 as being in an improper format, and to exhibits 1 and 2 as being untimely.

The record in an application should be complete prior to the filing of an appeal and additional evidence filed after appeal will ordinarily be given no consideration by the Board. See Trademark Rule 2.142(d). Moreover, mere listings of third-party registrations and applications are not an appropriate way to enter such material into the record, and the Board does not take judicial notice of registrations or applications in the USPTO. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB

1974). Accordingly, the examining attorney's objections to applicant's exhibits are well-taken. Further, inasmuch as applicant's alternative request for remand is concerned, remands have been allowed in only limited circumstances. See TBMP Section 1207.02 (2d ed. rev. 2004). In the present case, the TESS printouts and the copies of the third-party registrations could have been introduced long prior to this late juncture. Under the circumstances, applicant's alternative request for remand is denied, and we have not considered the exhibits or applicant's arguments based on such exhibits.³

We now turn our attention to the merits of the refusal to register. Our determination of the issue of likelihood

³ We should add that had such evidence been made of record both timely and properly, the result herein would be the same. With respect to exhibit 1, it is well settled that third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace, or that the public is familiar with the use of those marks and has learned to distinguish between them. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Further, the Board has held that third-party applications are evidence only of the fact they were filed; they have no probative value. See *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694 (TTAB 1982). Insofar as exhibit 2 is concerned, while the USPTO aims for consistency in examination, as often noted by the Board, each case must be decided on its own merits. We are not privy to the records of third-party registration files, and moreover, the determination of registrability of particular marks cannot control the result in a different case. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

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 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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).

Insofar as the respective services are concerned, applicant argues that registrant's identification of services clearly indicates that its marketing and advertising services are in the fields of energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management, and that by contrast, applicant's services primarily are directed to restaurants and retail outlets. As a result, applicant maintains that the respective services are so dissimilar that this factor alone precludes a likelihood of confusion. However, as the examining attorney correctly points out, it is well settled

that the question of likelihood of confusion must be determined on the basis of the services as they are respectively set forth in the particular application and the cited registration, and not in light of what such services are asserted to actually be. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Thus, where as here, the identification of services in the application is broad, with no limitation as to specific fields, it is presumed that the application encompasses all types of fields, including the fields in registrant's more specific identification (i.e., energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management), and that the services move in all normal channels of trade, and are available to all potential customers. We find therefore that applicant's business marketing services and registrant's marketing services in the fields of energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management are legally identical since applicant's business marketing services

encompass registrant's more specific marketing services. Similarly, there is no question but that applicant's direct marketing advertising services and registrant's more specific advertising services in the fields of energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management are closely related. The contemporaneous use of the same or similar marks in connection with such legally identical and closely related services would accordingly be likely to cause confusion as to the source or sponsorship thereof.

We turn then to a consideration of the marks. With respect to the marks, we must determine whether applicant's mark and registrant's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, where as in the present case, the marks appear on identical services, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

Applying these principles to the present case, we find that applicant's mark DUKE MARKETING and registrant's mark DUKE ENERGY, when compared in their entireties in terms of sound, appearance, connotation and commercial impression are highly similar. Both marks begin with the word DUKE, followed by words which are clearly descriptive (MARKETING and ENERGY) and which have been disclaimed. In this case, the word DUKE is clearly the dominant feature of both marks. In view of the descriptiveness of the words which

follow the term, it is the word DUKE which has source-identifying significance. Although the descriptive words MARKETING and ENERGY in the respective marks create some differences in the marks, the presence of these words is not sufficient to distinguish the marks. That is, purchasers will not regard these descriptive words in the marks DUKE MARKETING and DUKE ENERGY as indicating that the services emanate from different sources. Rather, purchasers are likely to believe, based on the presence of DUKE in both marks that a source relationship exists. This is the case notwithstanding that it appears from the nature of the involved services that such services would be marketed to sophisticated purchasers, rather than ordinary consumers. It is well settled that the fact purchasers are knowledgeable and discriminating does not mean they would be immune from source confusion, particularly in cases such as this, where the marks are very similar. See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962).

We accordingly conclude that purchasers familiar with registrant's marketing and advertising services in the fields of energy, natural gas, electricity, utilities, oil, natural gas liquids, refined products, petrochemicals, liquefied natural gas, and asset management rendered under

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its mark DUKE ENERGY, would be likely to believe, upon encountering applicant's mark DUKE MARKETING for business marketing services and direct marketing advertising for others, that applicant's and registrant's services originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register under Section 2(d) is affirmed.