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THE TTAB

Mailed: March 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dash

Serial No. 78607172

Jagannath Dash, pro se.¹

Toby E. Bulloff, Trademark Examining Attorney,² Law Office
117 (Loretta C. Beck, Managing Attorney).

Before Hairston, Drost and Taylor, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Jagannath Dash has filed an application to register on
the Principal Register the mark APPLYING IDEAS INSPIRING
SOLUTIONS (in standard character form) for services
identified as "information technology consulting services"
in International Class 42.³

¹ After applicant's main brief was filed, the Board learned that applicant's original counsel died and, subsequently, applicant entered an appearance on his own behalf.

² Trademark examining attorney Patty Evanko handled the trademark application prior to the briefing stage.

³ Serial No. 78607172, filed April 12, 2005, and alleging November 20, 2004 as the date of first use and date of first use of the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with the identified services, so resembles the registered mark APPLYING TECHNOLOGIES, INSPIRING SOLUTIONS (in standard character form) for "technical consulting in the field of computer hardware and software; [and] ... computer consultation services in the field of life-cycle engineering and development services" in International Class 42,⁴ as to be likely to cause confusion, mistake or to deceive.

When the refusal was made final, applicant appealed. Both applicant and the examining attorney filed briefs. For the reasons discussed below, we affirm the refusal to register.

Before we begin our likelihood of confusion analysis, we must discuss several evidentiary matters. Applicant attached to his brief definitions of the words "solutions," "technology" and "idea" obtained from the online dictionary, Dictionary.com Unabridged (v 1.1), of which we

⁴ Registration No. 3011004, issued November 1, 2005. We note that the registration covers additional classes and additional services in Class 42. However, it is clear that the examining attorney's refusal is based on the services in Class 42 set forth above.

take judicial notice,⁵ and a list of third-party applications and registrations (consisting of the serial and registration numbers, the mark, and whether the application is "Live" or "Dead") for marks containing the term "solutions" obtained from the TESS database of the United States Patent and Trademark Office (USPTO). As regards the list of third-party applications and registrations, it is both untimely and in an improper format. As regards timeliness, 37 C.F.R. § 2.142(d) provides, in part, that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." Moreover, mere listings of third-party applications and registrations are not an appropriate way to enter such material in the record, and the Board does not take judicial notice of applications or registrations in the USPTO. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB

⁵ From the website www.Dictionary.com [based on the Random House Unabridged Dictionary (2008) and the American Heritage Dictionary]. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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, applicant's list of third-party applications and registrations has not been considered in reaching our decision herein.⁶

Additionally, applicant submitted, with his response to the examining attorney's first office action, a list of third-party applications and registrations of marks containing the term "solutions" obtained from a private company's database (trademark.com). While this evidence is also in an improper format, inasmuch as it was timely filed and because the examining attorney did not object to this list or advise applicant that copies of the registrations were necessary, we will consider the list as being of record. See TBMP § 1207.03 (2d ed. rev. 2004).

Nonetheless, for the reasons explained in footnote 6, this

⁶ Even if we had considered the list, our decision would have been the same since a mere listing of third-party marks, without any accompanying indication of the goods and/or services associated therewith, has virtually no probative value. See TBMP § 1208.02 (2d ed. rev. 2004), and the authorities cited therein. Further, the expired registrations and pending and abandoned applications are also of no value. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything"), and the applications show only that they have been filed. *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003).

list of applications and registrations also has virtually no probative value.

Turning now to the merits of the appeal, 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 (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).

We turn first to a consideration of the services identified in the application and the cited registration. The examining attorney argues that "applicant's information technology consulting services are very closely related, if not legally identical, to registrant's Class 042 services, which include technical consulting in the field of computer hardware and software and computer consulting services, among other identified services." Applicant does not argue

otherwise. Indeed, applicant's brief is silent with regard to this factor. The examining attorney attached to her brief a definition of the term "information technology" from the on-line version of the Compact Oxford English Dictionary, of which we take judicial notice.⁷ The term is defined as "the study or use of systems such as computers and telecommunications for storing, retrieving, and sending information." Based on this definition, we conclude that applicant's information technology consulting services encompass registrant's consulting services in the field of computer hardware and software, as well as registrant's computer consulting services in the field of life-cycle engineering and development services.

Further, in the absence of any limitations to the services recited in applicant's application, we must presume that they will be offered in the same channels of trade and will be rendered to the same classes of purchasers as those of registrant. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In view of the above, the *du Pont* factors of the similarity of the services and the

⁷ From the website www.askoxford.com. As indicated in footnote 5, the Board may take judicial notice of dictionary definitions.

channels of trade strongly favor a finding of likelihood of confusion.

We next consider the similarities between the marks, which are both slogans. Applicant argues that the marks are not similar because the dominant term in each mark (i.e., IDEAS in his mark and TECHNOLOGIES in the cited mark) differs in appearance, sound and meaning. Applicant also argues that the term "solutions" is a descriptive and weak term, defined as "a method or process of solving a problem,"⁸ and that the term "inspiring" "is an adjective which expresses how one arrives at a 'SOULUTIONS' [sic]." (Brief at 4). The examining attorney, on the other hand argues that, when viewed as a whole, the marks are similar in connotation and overall commercial impression.

In determining the similarity or dissimilarity of the marks, we must, as applicant points out, consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). 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

⁸ The definition is from the online version of the American Heritage Dictionary found at www.dictionary.com.

their entireties that confusion as to the source of the services offered under the respective marks is likely to result. The 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 Restaurant Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Applicant's mark is APPLYING IDEAS INSPIRING SOLUTIONS and the registered mark is APPLYING TECHNOLOGIES, INSPIRING SOLUTIONS. Contrary to applicant's argument, we do not find that the terms IDEAS and TECHNOLOGIES dominate the respective marks. As noted, the respective marks are slogans and each term in each slogan is equally important in imparting the intended meaning.

As regards appearance and sound, the marks share three of four terms, have the same construction, i.e., they both consist of two, two-word phrases beginning with APPLYING and ending with INSPIRING SOLUTIONS and, given the shared terms, have a very similar cadence. While the second term in each slogan differs, (IDEAS in applicant's mark and TECHNOLOGIES in the registered mark), we do not think that this one word difference distinguishes them in any meaningful way because the different terms are imbedded in

the middle of each slogan. Also, the presence, or absences, of the comma between the two phrases in the respective marks is not significant. The marks hence are similar in sound and appearance.

In terms of meaning and commercial impression, the marks are also similar. While the terms IDEAS and TECHNOLOGIES admittedly have distinct meanings, given the construction of both slogans, both applicant's mark and the cited mark convey to the consumer a similar meaning and the same overall commercial impression. Further, even assuming that the term SOLUTIONS is highly suggestive of computer related consulting services such that marks which include this term are weak marks, SOLUTIONS has the same connotation in both marks. Put simply by the examining attorney, both applicant's mark and the registered mark "convey a commercial impression of 'applying' or 'administering and using' 'ideas or technologies' in order to achieve 'inspiring solutions' or some end result." (Brief at 4). We accordingly find that the marks are similar in sound, appearance, connotation and commercial impression. The factor of similarity of the marks thus favors a finding of likelihood of confusion.

As a final matter, applicant argues that confusion is not likely because both parties sell to professionals who

spend thousands of dollars on the respective services, and that these professional buyers exercise a higher standard of care than exists for ordinary consumers. Even assuming that the services in issue would most likely be purchased with care by sophisticated consumers, we find that the substantial similarity of the marks and relatedness of the services clearly outweigh any purchaser sophistication. In re Decombe, 9 USPQ2d 1812 (TTAB 1988); and In re Pellerin Milnor Corp, 221 USPQ 558 (TTAB 1983). Moreover, the fact that purchasers are sophisticated in a particular field does not mean they are knowledgeable in the field of trademarks or immune from source confusion. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999); In re Hester Industries, Inc., 231 USPQ 991 (TTAB 1986).

In view of the foregoing, we conclude that prospective purchasers familiar with the registered mark APPLYING TECHNOLOGIES, INSPIRING SOLUTIONS for technical consulting in the field of computer hardware and software and computer consultation services in the field of life-cycle engineering and development services would be likely to believe, upon encountering applicant's substantially similar mark APPLYING IDEAS INSPIRING SOLUTIONS for information technology consulting services, that such

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services emanate from, or are sponsored by or affiliated with the same source.

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