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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VIA Architecture Incorporated

Serial No. 78949705

Jere M. Webb of Stoel Rives LLP for VIA Architecture Incorporated.

Frank J. Lattuca, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Seeherman, Drost, and Wellington, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 10, 2006, applicant VIA Architecture Incorporated filed an application to register the mark VIA ARCHITECTURE in standard character form on the Principal Register for:

Architectural planning and architectural design services, namely, urban planning and design, commercial and residential building planning and design, master planning, sustainability planning, transit and infrastructure planning and design, community consultation and development, planning and

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design for the renovation and historic preservation of buildings (Class 42).¹

Applicant has disclaimed the term "Architecture."

The examining attorney has refused to register applicant's mark on the ground that it is confusingly similar under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) with the marks in the following registrations (owned by the same entity) for the identified services:

I.

VIA Concepts

For: Architecture design (Class 42)
No. 2700197
Issued: March 25, 2003

II.



VIA Concepts, LLC

For: Architecture design (Class 42)
No. 2702476
Issued: April 1, 2003

¹ Serial No. 78949705. The application includes dates of first use anywhere and in commerce of July 1, 2002.

After the examining attorney made the refusal final, a request for reconsideration and this appeal followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We first look at whether the services of applicant and registrant are related.

It is a well settled principle of trademark law that it is not necessary that the goods [or services] of the parties 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 for purposes herein that the respective goods [or services] of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods [or 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 used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer.

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

Both cited registrations define their services as including "architecture design." Registrant's services are not limited so we must consider these services broadly

without reading any limitations into the services. *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 [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] 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" or services).

Applicant identifies its services as:

Architectural planning and architectural design services, namely, urban planning and design, commercial and residential building planning and design, master planning, sustainability planning, transit and infrastructure planning and design, community consultation and development, planning and design for the renovation and historic preservation of buildings.

Therefore, both applicant and registrant have architecture design services. Specifically, applicant's architectural design and planning services include

commercial and residential building planning and design. The term "architecture" is defined as "the profession of designing buildings, open areas, communities, and other artificial constructions and environments, usually with some regard to aesthetic effect. Architecture often includes design or selection of furnishings and decorations, supervision of construction work, and the examination, restoration, or remodeling of existing buildings." Office Action dated January 8, 2007, attachment (Dictionary.com Unabridged based on the *Random House Unabridged Dictionary* (2006)). Applicant's architectural planning and architectural design services including commercial and residential building planning and design would overlap with or be encompassed by registrant's architecture design services. Other services of applicant, including the planning and design for the renovation and historic preservation of buildings are either overlapping or closely related to registrant's architecture design services.

We add that the examining attorney has also included evidence in the form of third-party, use-based registrations to suggest that architectural design and architectural planning services are registered under a common mark. See, e.g., Registration No. 2369073

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("architectural design and architectural planning services"); No. 3205995 ("architectural design... architectural planning"); No. 3195751 ("architectural design, interior design, design of new products for others, design of furniture for others, and architectural planning"); and No. 2661462 ("architectural design, architectural planning"). See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). Therefore, we conclude that applicant's and registrant's services include overlapping and closely related services. "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Furthermore, inasmuch as the services overlap, we must assume that the purchasers and channels of trade for such

services would also overlap. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). In this case, the identified services would be encountered by the same consumers.

Applicant also argues that the "purchasers of both the Applicant's and Registrant's services are sophisticated... Purchasers would not purchase these services casually because of the time, money, and commitment required." Brief at 7. While we agree that purchases of architectural services are not casual purchases, we cannot agree that these purchasers are necessarily sophisticated. While applicant contends that purchasers of its services include sophisticated government agency purchasers, its identified services are not limited to those that are purchased by sophisticated purchasers. Purchasers of architectural design services would include homeowners and other property

owners who would be ordinary purchasers. To the extent that architectural design services may be recommended from one homeowner to another by word-of-mouth, even careful purchasers are likely to be confused by similar marks. We add that even if "the relevant class of buyers may exercise care [that] does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods." *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). Therefore, the fact that the purchasers may exercise care before purchasing these services does not mean there can be no likelihood of confusion.

The next *du Pont* factor we consider "requires examination of 'the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Here, the marks are VIA ARCHITECTURE and VIA CONCEPTS (stylized) and VIA VIA CONCEPTS LLC and design. We will concentrate our discussion on registrant's VIA CONCEPTS mark because, if there is no likelihood of confusion with this mark, there would likewise be no confusion with the '476 registration

(the design mark), which adds additional features that are not found in applicant's mark. Similarly, if there is a likelihood of confusion with the '197 registration (the stylized mark), there is no need to determine if there is also confusion with the '476 registration.

Inasmuch as applicant's mark is shown in standard character form, it may be displayed in the same type style as registrant's mark. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same"). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce").

Therefore, when we compare the marks, we must determine if the marks displayed with the identical stylization, such as "VIA Architecture" and "VIA Concepts,"

are similar. These marks are identical inasmuch as they both begin with the word VIA and they differ because the second words in the marks (Architecture and Concepts) are different. The examining attorney points out that consumers "are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark." Brief at unnumbered p. 4. See *Palm Bay Imports*, 73 USPQ2d at 1692 ("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark").

Regarding the second terms in the marks, applicant has disclaimed the term "Architecture," which is a generic term for architectural design and planning services. Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). Particularly here, where the term "Architecture" is a generic term for applicant's services and registrant is providing "architecture design" services, prospective purchasers will place much less, if any, significance on this term to distinguish the services

of applicant and registrant. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“With respect to ALE, the Board noted that the term is generic and that the registrant disclaimed it in its registration. Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under DuPont. As a generic term, ALE simply delineates a class of goods”).

Registrant’s term “concept” is defined as a “general idea derived or inferred from specific instances or occurrences.” Response dated July 9, 2007, attachment (Bartleby.com based on *The American Heritage Dictionary of the English Language* (2000)). Inasmuch as architecture design would begin with a general idea derived from specific instances, the term has a suggestive significance. Therefore, the term “VIA” is a more significant term that consumers would rely on to identify these services. Certainly, the way registrant displays the term emphasizes the VIA part of the mark.

While applicant argues that the “differences between the marks far outweigh any common visual elements” (Brief at 4), we cannot agree. The only difference between applicant’s mark and the ‘197 mark is the second word in

each. Neither term significantly distinguishes the marks. "Human memories even of discriminating purchasers ... are not infallible." *Research and Trading Corp.*, 230 USPQ at 50, quoting, *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Many customers are likely to believe that "VIA Architecture" architectural design services are associated with "VIA Concepts" architecture design services. As discussed below, there is no evidence that others have used or registered the term VIA in connection with architectural design services. The additional words "Architecture" and "Concepts" for architectural design services do not result in marks that are significantly different in meaning or commercial impression, and the identical first term results in marks that have similarities in appearance and pronunciation. Ultimately, we find that the marks in their entirety are similar in sound, appearance, meaning, and commercial impression.

Applicant argues that "Registrant's Mark is weak because it occupies a crowded field and because the word 'via' is in common use as a mark." Reply Brief at 3. In support of this argument, applicant submitted evidence that "345 filings have been registered or published for marks that contain the word 'via...'" Additionally, many of the

uses of the word 'via' in registered or published marks are within the same or similar classification of goods and services, showing that the class of goods and services does not impact whether confusion is likely." Brief at 3. The examining attorney responded by pointing out that "[n]one of the third-party registrations submitted by applicant are for these or even related types of services, but simply are a variety of marks where the word 'via' is used." Brief at 7. In reply, applicant points to the general use of the term VIA: "Applicant's and Registrant's Mark are weak because the word 'via' in [them] is in common use as a mark, making such mark a weak mark, which purchasers are able to distinguish." Reply Brief at 4.

We begin by agreeing with the examining attorney that the *du Pont* factors speak of the "number and nature of similar marks *in use on similar goods*." 177 USPQ at 567 (emphasis added). Inasmuch as the registrations that applicant has made of record are for unrelated goods and services, they do not have much, if any, relevance for the issue in this specific case. *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) ("Registrations for goods unrelated to the clothing field are irrelevant to our discussion"); *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988)

("[E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner's skin care products or respondent's stuffing box sealant"); and *Anderson, Clayton & Co. v. Christie Food Products Inc.*, 4 USPQ2d 1555, 1557 n.7 (TTAB 1987) ("The other third-party registrations relating to marks in unrelated fields are of no probative value"). *Accord Palm Bay Imports*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection") (emphasis added).²

Further, third-party registrations³ are not evidence of use of the marks in commerce. *See AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations

² We emphasize that there is no evidence of third-party use, only third-party registrations, in this case.

³ We note that applicant has cited numerous third-party applications that have been published for opposition. It has long been held that "[w]hile applicant also submitted a copy of a third-party application ..., such has no probative value other than as evidence that the application was filed." *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002). *See also Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092, n.5 (TTAB 1979) ("The filing of a notice of reliance upon third-party applications is a futile act because copies of those applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else").

is not evidence of what happens in the market place or that customers are familiar with them").⁴

One obvious reason that third-party registrations can have only nominal weight is the simple fact that if the goods or services are unrelated, the registrant would have little basis to oppose a mark before the board. Indeed, it would be odd to limit the scope of protection for registrant's VIA CONCEPTS mark for architecture design services because the Office has registered different VIA mark such as VIAYOGA and design for yoga vacation services (No. 2991782); VIA PENDIO for work bags sold empty for personal items, handbags, purses and tote bags (No. 3352253); VIA NUEVA for Mexican spices and sauces (No. 302017); or VIA MC2 for bowling balls (No. 2854952). It is not particularly relevant that the word "via" when combined with other words for different and unrelated goods or services has been registered.

⁴ "[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry." *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). However, because the goods and services in the registrations submitted by applicant are different from applicant's and the cited registrant's services, they do not show that the term "via" has any descriptive significance for the services in this case.

We must determine whether there is a likelihood of confusion for the marks VIA ARCHITECTURE and VIA CONCEPTS for overlapping services based on the record in this case. The fact that, for other goods and services, different marks containing the word "via" have been registered cannot control the result here. "Each case must rest upon its own distinctive fact situation." *Star Watch Case Company v. Gebruder Junghans, A.G.*, 267 F.2d 950, 122 USPQ 370, 371 (CCPA 1959). *See also In re Venturi, Inc.*, 197 USPQ 714, 717 (TTAB 1977) ("It is of course well settled that prior decisions, while pertinent to the extent that they may set standards to be applied generally in proceedings such as this, are of little value in determining a specific issue of descriptiveness, distinctiveness, likelihood of confusion, etc. since each case must be decided on its own facts"). Quite simply, even if the third-party registrations did show that registrations for marks containing the word VIA co-exist in other classes, it would hardly establish there is no likelihood of confusion in this case where there are no co-existing registrations for architectural design services.

Finally, applicant argues that "despite almost six years of concurrent use, no actual confusion has been observed." Brief at 8. However, we have few facts upon

which to conclude that there has been a significant opportunity for actual confusion to occur. Particularly in ex parte cases where the registrant has not had an opportunity to present any evidence of confusion, the fact there is no evidence of actual confusion is not uncommon and is entitled to little weight. See *Majestic Distilling*, 65 USPQ2d at 1205:

With regard to the seventh *DuPont* factor, we agree with the Board that *Majestic's* uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 C.C.P.A. 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

When we consider, inter alia, that the services in this case overlap and that the marks, VIA ARCHITECTURE and VIA CONCEPTS, are similar, we conclude that there is a likelihood of confusion.

Decision: The refusal to register is affirmed.