

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD



Law Office 115 :  
Examining Attorney: Jennifer Stiver Chicoski :  
In re application of :  
CONCURRENT TECHNOLOGIES CORP. :  
Serial No. 76/040,407 :  
Filed May 4, 2000 :

07-16-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**TRADEMARK  
APPLICATION**

CONCURRENT TECHNOLOGIES  
CORPORATION

I hereby certify that this correspondence is being deposited with the United States Postal service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on

July 14 2003  
Date  
Susan A. Helburg  
Buchanan Ingersoll

**NOTICE OF APPEAL**

07/24/2003 GTHOMAS2 00000132 76040407  
01 FC:6403 100.00 OP

Pittsburgh, Pennsylvania 15219

July 14, 2003

BOX TTAB FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

Madam:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration in the above-captioned matter.

07-16-2003 11:00 AM  
07-16-2003 11:00 AM  
07-16-2003 11:00 AM

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Applicant is simultaneously with this Notice filing a **Request for Reconsideration** as permitted under TMEP 715.04. Accordingly, Applicant respectfully requests that the Board acknowledge the appeal, suspend further proceedings with respect to the appeal, and remand the application to the examining attorney for review of the Request for Reconsideration.

Applicant encloses a check in the amount of \$100 to cover the filing fee for this *ex parte* appeal. Should there be a deficiency in the required fee not covered by the enclosed check, please charge such deficiency to Deposit Account No. 02-4553.

Respectfully submitted,



Janel M. Pernell  
Attorney for Applicant  
BUCHANAN INGERSOLL, P.C.  
One Oxford Centre  
301 Grant Street, 20th Floor  
Pittsburgh, PA 15219

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Law Office 115 :  
Examining Attorney: Jennifer Stiver Chicoski :  
In re application of :  
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**TRADEMARK  
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July 14, 2003  
Date  
Susan A. Helburg  
Buchanan Ingersoll

**REQUEST FOR RECONSIDERATION**

Pittsburgh, Pennsylvania 15219

July 14, 2003

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

Madam:

This Request for Reconsideration is filed in accordance with TMEP 715.03; 37 C.F.R. §2.64(b). Applicant is simultaneously filing a Notice of Appeal with regard to this application to preserve its right to an *ex parte* appeal.

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Registration has been finally refused by the Examining Attorney under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) on the basis that the mark is likely to be confused with U.S. Registration Nos. 1,912,054, 2,480,327 and 2,480,344. In this Request, Applicant is submitting new evidence for consideration by the Examining Attorney.

1. CONCURRENT COMPUTER & design--Registration No. 1,912,054

As noted in Applicant's prior Responses, there are several pending applications, federal registrations and evidence of third-party use in commerce which employ the term CONCURRENT. Applicant believes a close scrutiny of the classes, as well as the identification of goods and services, in certain of these registrations when compared to Registrant's registration, provides greater support for Applicant's argument.

The Registrant's mark includes goods and services in classes 9, 16, 37, 41, and 42. For convenience, the identification of goods and services in the CONCURRENT COMPUTER registration are set forth below:

IC 009: computer systems, sold as a unit or individual parts thereof, comprising-- computer hardware; computer software; namely, operating programs, programming tools, compilers and productivity programs, computer programs for use with computer networks and distributed computing, computer programs for use with graphics and data acquisition, and application programs in the fields of simulation and training, signal intelligence and analysis, financial trading, measurement and control, radar and health care; computer peripherals and computer interfaces for use in conjunction with high performance and real time applications.

IC 016: manuals, printed pamphlets and books related to computer systems for use in high performance and real-time applications or to hardware and/or computer programs associated with such systems.

IC 037: repair, maintenance, and installation services of computer systems used in high performance and real-time applications and of hardware and/or computer programs associated with such systems.

IC 041: training services; namely, concerning computer systems for use in high performance and real-time applications and for hardware and/or computer programs associated with such systems.

IC 042: consulting and design services for others relating to systems integration and to the use of computer systems for use in high performance and real-time applications and of hardware and/or computer programs associated with such systems.

Applicant has ten registrations and applications for the mark CONCURRENT TECHNOLOGIES CORPORATION for a variety of goods and services. Significantly, at least two of these CONCURRENT TECHNOLOGIES CORPORATION marks were recently registered and contain services that could arguably relate to those identified in the CONCURRENT COMPUTER registration, but were allowed even though they were for the identical mark. Applicant is attaching to this Request full copies of these two registrations, along with another registration for CONCURRENT COSTING, all of which were obtained from the Trademark Electronic Search System (TESS).<sup>1</sup>

a. Registration No. 2,689,736 for  
CONCURRENT TECHNOLOGIES CORPORATION

The first printout attached as Exhibit 1 is Applicant's mark CONCURRENT TECHNOLOGIES CORPORATION, Registration No. 2,689,736, filed in International Class 41. This mark was recently registered on February 25, 2003.

The services identified in this registration of Applicant include, in pertinent part, "educational and *training services*, namely...skills training in the fields of ...*information technology, selection, maintenance and utilization of computer hardware and software...*" (emphasis added). Compare the preceding to the CONCURRENT COMPUTER registration for

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<sup>1</sup> Both TESS and TARR are located on the USPTO web site at [www.uspto.gov](http://www.uspto.gov).

services also in Class 41, identified in pertinent part as "*training services*, namely, concerning *computer systems* for use in high performance and real-time applications and for *hardware and/or computer programs* associated with such systems" (emphasis added).

"Information technology" (or "IT") is defined as follows:<sup>2</sup>

IT; Short for *Information Technology*, and pronounced as separate letters, the broad subject concerned with all aspects of managing and processing information, especially within a large organization or company. Because computers are central to information management, computer departments within companies and universities are often called *IT departments*. Some companies refer to this department as *IS (Information Services)* or *MIS (Management Information Services)*.

As shown above, there is a distinct correlation between "IT" or "information technology" and computers. Moreover, both Class 41 services reference "training services" related to computer hardware and software. The examining attorney's argument in the instant case is that "development services of the applicant are broad enough to include the consulting and design services of the registrant" (see Final Action, p. 4). Applicant questions how the Class 41 services as described by both parties above can be differentiated under this argument.

b. Registration No. 2,629,938 for  
CONCURRENT TECHNOLOGIES CORPORATION

The above registration, attached as Exhibit 2, also references services in Class 35 that could arguable encompass Registrant's narrower defined services.

Applicant's mark for CONCURRENT TECHNOLOGIES CORPORATION was registered on October 8, 2002. The identification of services include in pertinent part, "*...organization and management of business meetings*, trade conventions and *business*

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<sup>2</sup> Copied from PCWebopaedia on-line dictionary at <http://www.pcwebopaedia.com/TERM/I/IT.html>.

*information seminars* in the *areas of ...information technology...*; *business consultation* in the areas of *...information technology...*" (emphasis added). Compare this identification to services identified by Registrant in both Class 41 and Class 42: *training services*, namely, concerning *computer systems* for use in high performance and real-time applications and for *hardware and/or computer programs* associated with such systems" in Class 41 and "*consulting and design services for others relating to systems integration* and to the use of *computer systems..*" in Class 42 (emphasis added). Again, because both reference trainings/seminars and consulting services related to information technology and computer systems, it appears these services would overlap as well under the examining attorney's argument.

c. Registration No. 2,409,634 for CONCURRENT COSTING

The above registration, attached as Exhibit 3, references goods in Class 9 that could arguable encompass Registrant's goods.

The goods identified in Class 9 are "*computer software program for estimating the cost of manufacturing and finishing a part*, sold with an accompanying user's manual, *all for use in the field of product design and manufacturing.*" Compare to the Class 9 identified goods in the CONCURRENT COMPUTER registration: "computer systems, sold as a unit or individual parts thereof, comprising--computer hardware; *computer software; namely*, operating programs, programming tools, compilers and productivity programs, *computer programs for use with computer networks and distributed computing, computer programs for use with graphics and data acquisition*, and application programs in the fields of simulation and training, signal intelligence and analysis, financial trading, measurement and control, radar and health care; computer peripherals and computer interfaces for use in conjunction with high performance and real time applications." In this case, it appears the CONCURRENT COSTING mark's computer

programs are narrower and could be encompassed by the computer programs identified by the CONCURRENT COMPUTER Registrant. Nonetheless, both marks are registered.

Also, this registration is for software specifically used to "estimating the cost of manufacturing and finishing a part ... in the field of product design and manufacturing," whereas Applicant's Registration No. 2,689,736 (Exhibit 1) includes services related to "...manufacturing processes and products...and the distribution of instructional materials in the nature of interactive multi-media software..." Although these goods and services could arguably cross paths, this registration was also not cited against the Applicant.

The examples above clearly evidence that goods and services can be broad, encompass others, and even cross paths in the trade with a common term such as CONCURRENT, and yet be registered without causing confusion. These examples merely reiterate that CONCURRENT is a weak term in many cases. This is further supported by the fact that the Registrant has disclaimed the wording CONCURRENT COMPUTER in its mark and that the CONCURRENT COSTING registration is registered on the Supplemental Register.

For these reasons, in addition to all previous arguments and evidence submitted, Applicant respectfully requests that the refusal based on likelihood of confusion be withdrawn.

2. CONCUR TECHNOLOGIES--Registration Nos. 2,480,327 and 2,480,344

Applicant encloses a Trademark Consent Agreement executed by and between Concurrent Technologies Corporation and Concur Technologies which states that the parties are not aware of any confusion, believe the marks are sufficiently different, and allows both parties to maintain trademark rights in their marks (see Exhibit 4). They have also agreed that in the

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event that confusion or a likelihood of confusion between their respective marks should arise, they will cooperate to eliminate or minimize such confusion among the public.

In light of this agreement, Applicant respectfully requests that the refusal based on likelihood of confusion with regard to these two marks be withdrawn.

Respectfully submitted,



Janel M. Pernell  
BUCHANAN INGERSOLL, P.C.  
One Oxford Centre  
301 Grant Street, 20th Floor  
Pittsburgh, PA 15219

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## Record 1 out of 1

**Check Status** *(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)*

### Typed Drawing

**Word Mark** CONCURRENT TECHNOLOGIES CORPORATION

**Goods and Services** IC 041. US 100 101 107. G & S: EDUCATIONAL AND TRAINING SERVICES, NAMELY, CLASSES, SEMINARS, WORKSHOPS, CONFERENCES, DEMONSTRATIONS, VIDEO CONFERENCE LECTURES, AND SKILLS TRAINING IN THE FIELDS OF ENGINEERING, ENVIRONMENTAL HEALTH AND SAFETY, HEALTHCARE, MANAGEMENT OF BUSINESS, MANAGEMENT SYSTEMS AND STANDARDS, BUSINESS STANDARDS, BUSINESS PRODUCTIVITY, MANUFACTURING PROCESSES AND PRODUCTS, INDUSTRIAL AND INFORMATION TECHNOLOGY, SELECTION, MAINTENANCE AND UTILIZATION OF COMPUTER HARDWARE AND SOFTWARE, TELECOMMUNICATIONS HARDWARE AND SOFTWARE, AND THE DISTRIBUTION OF INSTRUCTIONAL MATERIALS IN THE NATURE OF INTERACTIVE MULTI-MEDIA SOFTWARE RECORDED ON CD-ROMS AND VIRTUAL REALITY SIMULATION SOFTWARE APPLICATIONS THEREWITH. FIRST USE: 19920403. FIRST USE IN COMMERCE: 19920403

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 76040473

**Filing Date** May 4, 2000

**Published for Opposition** December 3, 2002

**Registration Number** 2689736

**Registration Date** February 25, 2003

**Owner** (REGISTRANT) Concurrent Technologies Corporation CORPORATION PENNSYLVANIA 100 CTC Drive Johnstown PENNSYLVANIA 15904

**Attorney of Record** GEORGE PATRICK BAIER

07/29/2003 11:41 AM

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CORPORATION"  
APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL-2(F)-IN PART

**Live/Dead Indicator** LIVE

**Distinctiveness**

**Limitation Statement** as to "TECHNOLOGIES"

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## Record 1 out of 1

**Check Status** (TARR contains current status, correspondence address and attorney of record for this mark.  
Use the "Back" button of the Internet Browser to return to TESS)

### Typed Drawing

**Word Mark** CONCURRENT TECHNOLOGIES CORPORATION

**Goods and Services** IC 035. US 100 101 102. G & S: Business consultation; operation of businesses for others; business import and export consultation; organization and management of business meetings, trade conventions and business information seminars in the areas of business management and standards, business optimization, facility management, information technology, management models, and electronic commerce utilization; business consultation in the areas of business management and standards, business optimization, facility management, information technology, management models, and electronic commerce utilization; business and management services in the areas of medicine and health care for others; management of medical and health care facilities. FIRST USE: 19920403. FIRST USE IN COMMERCE: 19920403

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 76040124

**Filing Date** May 4, 2000

**Published for Opposition** July 16, 2002

**Registration Number** 2629938

**Registration Date** October 8, 2002

**Owner** (REGISTRANT) Concurrent Technologies Corporation CORPORATION  
PENNSYLVANIA 100 CTC Drive Johnstown PENNSYLVANIA 15904

**Attorney of Record** GEORGE PATRICK BAIER

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CORPORATION"  
APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL-2(F)-IN PART

07/20/01  
**Live/Dead  
Indicator**

LIVE

**Distinctiveness  
Limitation  
Statement**

as to "TECHNOLOGIES"

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## Record 1 out of 1

**Check Status** *(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)*

### Typed Drawing

**Word Mark** CONCURRENT COSTING

**Goods and Services** IC 009. US 021 023 026 036 038. G & S: computer software program for estimating the cost of manufacturing and finishing a part, sold with an accompanying user's manual, all for use in the field of product design and manufacturing. FIRST USE: 19990701. FIRST USE IN COMMERCE: 19990701

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 75810870

**Filing Date** September 29, 1999

**Supplemental Register Date** August 28, 2000

**Registration Number** 2409634

**Registration Date** November 28, 2000

**Owner** (REGISTRANT) Boothroyd Dewhurst, Inc. CORPORATION RHODE ISLAND 138 Main Street Wakefield RHODE ISLAND 02879

**Attorney of Record** John L. Welch

**Type of Mark** TRADEMARK

**Register** SUPPLEMENTAL

**Live/Dead Indicator** LIVE

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## TRADEMARK CONSENT AGREEMENT

**THIS AGREEMENT**, is made and entered into to be effective as of the latest date of signature below (the "Effective Date") by and among:

**CONCUR TECHNOLOGIES, INC.**, a Delaware corporation with a principal place of business at 6222 185th Avenue NE, Redmond, Washington 98052 (hereinafter referred to as "CONCUR"); and

**CONCURRENT TECHNOLOGIES CORPORATION**, a Pennsylvania corporation with a principal place of business at 100 CTC Drive, Johnstown, Pennsylvania 15904 (hereinafter referred to as "CONCURRENT").

WHEREAS, CONCUR asserts that it has been using and obtained federal registration of the mark "CONCUR TECHNOLOGIES" (the "CONCUR MARK") at United States Trademark Registration Nos. 2,488,095 and 2,480,344 in conjunction with a company name and for computer software consulting; providing consulting services pertaining to the use of computer software; and computer software for automating a wide range of employee tasks, transactions and enterprise data such as expense management, budgeting, procurement, facilities management, employee benefits and other personnel data;

WHEREAS, CONCURRENT asserts that it has been using the mark "CONCURRENT TECHNOLOGIES CORPORATION" (the "CONCURRENT MARK") in connection with a company name and with goods and services in the fields of engineering, product and process manufacturing, metalworking, and scientific research, including computer consulting and computer software, as cited in U.S. Registrations Nos. 2,616,493, 2,616,494, 2,619,577 and 2,622,976 as well as in pending application Serial Nos. 76/040,469, 76/040,447, and 76/040,407; and

WHEREAS, the parties are not aware of any confusion and believe that confusion is not likely because the CONCUR mark and the CONCURRENT mark are sufficiently different, and the goods and services for which the marks relate to are in sufficiently different markets. The parties wish to avoid any likelihood of confusion and recognize the desirability of resolving through mutual assent any existing or potential controversy.

NOW, THEREFORE, the parties, intending to be legally bound, hereby agree as follows:

1. The parties agree that the above recitals are true and correct and are hereby incorporated into the Agreement.

KRS

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2. CONCUR hereby agrees that it will not oppose, challenge or attempt to cancel any application, registration, or use of the CONCURRENT MARK.
3. CONCURRENT hereby agrees that it will not oppose, challenge or attempt to cancel any application, registration, or use of the CONCUR MARK.
4. CONCUR will take no action nor support any action adverse to the CONCURRENT MARK or rights there in.
5. CONCURRENT will take no action nor support any action adverse to the CONCUR MARK or rights there in.
6. CONCUR and CONCURRENT agree that, in the event that confusion or a likelihood of confusion between their respective marks should arise, the parties will cooperate to eliminate or minimize such confusion among the public.
7. The parties agree to cooperate with each other in permitting each party to obtain and maintain the application and registration of their respective marks specified in this Agreement, and otherwise to assist each other in carrying out the intent and purposes of this Agreement, including preparing, executing and filing any additional documents as needed or as required by the United States Patent and Trademark Office.
8. The parties agree that this Agreement and such other documentation as provided hereunder may be submitted to the United States Patent and Trademark Office, in aid of this Agreement's recited intent and purposes.
9. This Agreement shall be binding upon and inure to the benefit of the parties and their respective licensees, successors and assigns, and all others acting by, through or in privity with them.
10. This Agreement, which may be executed in counterparts, constitutes the entire agreement between the parties with respect to the subject matter hereof and supersedes all understandings, representations and agreements, whether oral or written, which may have been made prior to the Effective Date of this Agreement.
11. This Agreement cannot be modified or amended except by an instrument in writing signed on behalf of both the parties hereto.
12. This Agreement is assignable by either party to a purchaser of the business to which this Agreement relates.
13. Should any provision of this Agreement be held to be void, invalid, unenforceable or illegal by a court of competent jurisdiction, such provisions will be enforceable to the fullest extent permitted by applicable law and the validity and enforceability of the other provisions shall not be affected thereby.

VPS

07/29/2003TTAB

14. This Agreement shall be governed by and interpreted in accordance with the laws of the state of New York, United States of America.
15. The scope of this Agreement shall be worldwide.

IN WITNESS THEREOF, by their execution below, the parties hereto have agreed to all of the terms and conditions of this Agreement.

**CONCUR TECHNOLOGIES, INC.**

By: \_\_\_\_\_



Name: **Kyle Sugamele**

Title: **Vice President and General Counsel**

Date: \_\_\_\_\_

1/22/03

**CONCURRENT TECHNOLOGIES CORPORATION**

By: \_\_\_\_\_



Name: **Edward J. Sheehan, Jr.**

Title: **Senior Vice President and CFO**

Date: \_\_\_\_\_

01/31/03

VCS