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

Law Office 115 :

Examining Attorney: Jennifer Stiver Chicoski : **TRADEMARK APPLICATION**

In re application of :

CONCURRENT TECHNOLOGIES CORP. : **CONCURRENT TECHNOLOGIES CORPORATION**

Serial No. 76/040,747 :

Filed May 4, 2000 :

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

February 14, 2003
Date
Susan A. Hilburg
Buchanan Ingersoll

APPEAL BRIEF

Pittsburgh, Pennsylvania 15219

February 14, 2003

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

Madam:

This Brief is in support of the Applicant's Appeal of the Examining Attorney's final refusal to register the Applicant's trademark for CONCURRENT TECHNOLOGIES CORPORATION.

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 No. 1,912,054.

Marks must be compared for similarities in appearance, sound, connotation and commercial impression in analyzing likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Furthermore, the goods or services must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to source or origin is likely. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

I. SIMILARITY OF MARKS

Applicant contends that its mark is dissimilar enough to avoid confusion with the Registrant's mark despite the fact that they share the common term "CONCURRENT." The marks are not confusingly similar because the term CONCURRENT is descriptive of Registrant's services and it has disclaimed exclusive rights to use "CONCURRENT COMPUTER" apart from its mark, and the marks are different in sight, sound, meaning and commercial impression.

1. Use of the term "CONCURRENT" with Respect to the Parties' Marks

In its registration, the registrant has disclaimed "the exclusive right to use CONCURRENT COMPUTER apart from the mark as shown" and the term CONCURRENT is descriptive. It only logically follows that Registrant would have no superior rights to anyone using the term CONCURRENT. On the other hand, Applicant's mark is strengthened by the fact that it is an immediate source identifier as it is also the corporate trade name, that the term CONCURRENT is not descriptive of their services, that they have demonstrated acquired

distinctiveness in part from the term TECHNOLOGIES, and they only disclaim the term CORPORATION.

The term CONCURRENT means "operating or occurring at the same time."¹ When used in connection with Registrant's "real-time application" services, this term is descriptive. It is widely agreed that descriptive terms cannot be accorded protection without secondary meaning since, "for policy reasons, descriptive words must be left free for public use." *McCarthy on Trademarks and Unfair Competition, Fourth Ed.*, § 11:18 at 11-26 citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.PA 1968). Accordingly, Registrant's disclaimer to the exclusive rights to use CONCURRENT, along with their failure to prove secondary meaning and file protection under Section 2(f), leaves the term open to the public domain. Applicant cannot infringe on rights the Registrant does not possess.

Applicant, on the other hand, is not using the term in the descriptive sense, but rather as a part of their "trade name" which is immediately apparent to the consumer. "[I]t is well-settled that under certain circumstances otherwise similar marks are not likely to be confused where used in conjunction with the clearly displayed name and/or logo of the manufacturer." *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 220 USPQ 786, 790 (1st Cir. 1983). The examining attorney focuses on comparing CONCURRENT COMPUTER to CONCURRENT TECHNOLOGIES, often neglecting that Applicant's mark is CONCURRENT TECHNOLOGIES CORPORATION. Even though CORPORATION is disclaimed, it remains a distinguishing factor in overall appearance of the mark for a consumer. Hence, because

¹ Obtained from the Merriam Webster's on-line dictionary at <http://www.m-w.com/cgi-bin/dictionary>.

Applicant's mark serves as both a mark and its corporate trade name, it clearly reveals the source of the mark and enables consumers to escape the slightest potential for confusion.

2. The Marks Are Different In Sight, Sound, Meaning And Commercial Impression

Applicant's mark is CONCURRENT TECHNOLOGIES CORPORATION. The use of the additional terms TECHNOLOGIES CORPORATION clearly distinguishes it from Registrant's mark CONCURRENT COMPUTER with a design element. The two marks do not look alike, do not sound alike, nor do they share the same meaning. A consumer would not believe they emanate from the same source merely because they share the common term CONCURRENT. A common word shared by two marks is not enough by itself to render them confusingly similar. *In re Quadram Corp.*, 228 USPQ 863, 866 (TTAB 1985); *In re Hearst Corp.*, 25 USPQ 1238 (Fed. Cir. 1992).

The initial point of dissimilarity is the appearance of the marks. It is axiomatic that trademarks must be evaluated in their entirety. Dissecting marks and exploring their individual component parts does not provide an accurate evaluation as to whether there exists a likelihood of confusion between the marks as a whole. As the Court held in *Duluth New-Tribune v. Mesabi Publishing Co.*, 38 USPQ2d 1937, 1940 (8th Cir. 1996), rather than considering the similarities between component parts of the marks, the Court must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.

When comparing the marks side-by-side, it is clear the marks are distinctive.



CONCURRENT TECHNOLOGIES CORPORATION

The Applicant's mark is displayed in type-style text while Registrant's mark is displayed as a distinctive stylistic design. A dominant portion of the Registrant's mark is the diamond-shaped design containing three curved stripes. Composite design marks must be considered in their entireties, rather than element by element. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974). The immediate, stark dissimilarities in the marks obviate any likelihood of confusion.

Furthermore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of a likelihood of confusion analysis. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re MCI Communications Corp.*, 21 USPQ2d 1535 (Comm'r Pats. 1991). The descriptive and/or disclaimed portions of the respective marks obviously do not look or sound alike, nor do they have highly similar meanings. The singular form of technologies ("technology") and the term "computer" are defined as follows by Merriam Webster²:

Main Entry: **tech·nol·o·gy**

Pronunciation: -jĕ

Function: *noun*

Inflected Form(s): *plural -gies*

Etymology: Greek *technologia* systematic treatment of an art, from *technĒ* art, skill + *-o-* + *-logia* -logy

² Obtained from the Merriam Webster's on-line dictionary at <http://www.m-w.com/cgi-bin/dictionary>.

Date: 1859

1 a : the practical application of knowledge especially in a particular area : **ENGINEERING 2** <medical *technology*> **b** : a capability given by the practical application of knowledge <a car's fuel-saving *technology*>

2 : a manner of accomplishing a task especially using technical processes, methods, or knowledge <new *technologies* for information storage>

3 : the specialized aspects of a particular field of endeavor <educational *technology*>

- **tech·nol·o·gist** /-jɪst/ *noun*

Main Entry: **com·put·er**

Pronunciation: k&m-'pyü-t&r

Function: *noun*

Usage: *often attributive*

Date: 1646

: one that computes; *specifically* : a programmable electronic device that can store, retrieve, and process data

- **com·put·er·dom** /-d&m/ *noun*

- **com·put·er·less** /-l&s/ *adjective*

- **com·put·er·like** /-'lɪk/ *adjective*

In the Denial of Request for Reconsideration, the examining attorney attaches definitions of "technology" that reference "'hardware' and 'electronic and digital products' all of which are likely to include COMPUTERS³ within the broad category of goods referred to generally as TECHNOLOGIES." (Denial of Request for Reconsideration, p. 2). The Applicant notes that the first dictionary reference is from Dictionary.com which also includes a similar definition as found in Merriam-Webster above, as well as a definition related to anthropology. The second cited reference which includes a reference to "hardware" is from FOLDOC, an obscure United Kingdom web site. The "definition" alluded to is clearly prefaced under "jargon" and goes on to degrade Windows NT "abuse" of the term "technology." This is clearly an unreliable source.

³ In the Denial of Request for Reconsideration, the examining attorney erroneously refers to Registrant's mark as "CONCURRENT COMPUTERS" when the mark is actually "CONCURRENT COMPUTER."

The fact remains that the term "technology" is a very broad term which includes many categories of goods and services. *In re Hutchinson Technology*, 852 F2d 552, 7 USPQ2d 1490 (1988).

While the terms "technology" and "computer" may be used together, they are not interchangeable. The lack of an obvious reference to the other term in each definition above further evidences that these terms are not "highly similar." In fact, "computer" is no more similar to "technology" than any other modern day technical advancement, e.g. television, microwave, refrigerator, etc. The terms each have clear, separate meanings in and of themselves, and are readily distinguishable by consumers. Even if one would agree the meanings could be related or similar, it is still indisputable that the words differ in appearance and commercial impression because they do not look or sound alike.

For all of these reasons, the marks are not highly similar in sight, sound, meaning or commercial impression.

II. RELATEDNESS OF SERVICES

1. The Term CONCURRENT is Used and Registered by Others for Related Goods and Services

As noted in previous counsel's Response to the first Office Action, there are pending applications, federal registrations and evidence of third-party use in commerce which employ the term CONCURRENT. The examining attorney also correctly points out that there are "fifteen active application and registrations for the marks incorporating the term 'CONCURRENT.'" (See Denial of Request for Reconsideration, p. 3). The examining attorney downplays the significance of the other applications and registrations, ten of which belong to the applicant. However, a close scrutiny of the classes and identification of goods and services in these other

applications and registrations as compared to Registrant's registration, provides even 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.

It should be noted that the examining attorney referenced fifteen CONCURRENT pending applications and registrations and provided a listing of all fifteen, however, she attached full printouts of only four of the fifteen. (See attachments to Denial of Request for Reconsideration). Particularly, the examining attorney did not attach any of the pending or registered marks that belong to the applicant, five of which have been registered and one

published within the last six months. It is true the Applicant's ten registrations and applications include other classes. Significantly however, at least two of these contain services that could arguably relate to those identified in the CONCURRENT COMPUTER registration, but were nonetheless allowed even though they were for the identical mark CONCURRENT TECHNOLOGIES CORPORATION. Applicant is attaching to this brief full copies of these two marks obtained from the Trademark Electronic Search System (TESS), as well as copies of the status obtained from the Trademark Applications and Registrations Retrieval (TARR),⁴ both of which have been previously identified in the listing provided by the examining attorney (See attached Exhibits 1 and 2).

a. Application Serial No. 76/040,473 for
CONCURRENT TECHNOLOGIES CORPORATION

The first printout attached as Exhibit 1 is Applicant's pending application, CONCURRENT TECHNOLOGIES CORPORATION Serial No. 76/040,473 in International Class 41. This application was handled by the same examining attorney to the instant matter and was published for opposition on December 3, 2002. Neither Applicant nor applicant's counsel of record received a Notice of Opposition or a Request to Extend Time to Oppose from any party. Therefore, it is highly probable this application will mature into registration shortly.

The services identified in this application 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 services also in Class 41, identified in pertinent part as "*training services*, namely, concerning

⁴ Both TESS and TARR are located on the USPTO web site at www.uspto.gov.

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:⁵

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 "applicant's services are broad enough to include the more specific design services of the registrant" (see Denial of Request for Reconsideration, p. 3). 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. Although the status does not show the examining attorney, it was in fact the same that is handling the instant matter. The identification of services include in

⁵ Copied from PCWebopaedia on-line dictionary at <http://www.pcwebopaedia.com/TERM/I/IT.html>.

pertinent part, "...**organization and management of business meetings**, trade conventions and **business 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. CONCURRENT COSTING Registration No. 2,409,634

The above identified registration is the second full printout attached by examining attorney to the Denial of Request for Reconsideration. 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.

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 application Serial No. 76/040,473 (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 not cited against the Applicant either.

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 or nearly registered without causing confusion. These examples merely reiterate that CONCURRENT is a weak term in many cases. As also pointed out by the examining attorney, the CONCURRENT PROGRAMMING SYSTEM and CONCURRENT COSTING registrations she attached are registered on the Supplemental Register. The existence of third-party registrations is evidence that the mark is less than a strong mark and, as a result, its scope of protection is limited. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981).

In finding SUN BANKS was not confusingly similar to SUN FEDERAL, both for financial related services, the Court considered the numerous other third party registrations containing the term SUN and cited the following language from *3 Callman, Law of Trademarks*, § 82.1(i) at 722:

Whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. **Where a trademark is itself weak, minor additions may effectively negate any confusing similarity.** (Emphasis added).

Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association, 651 F.2d 311, 211 USPQ 844 (5th Cir. 1981). See also: *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988)(finding AMALGAMATED not similar to AMALGAMATED BANK); *Beneficial Finance v. Beneficial Capital Corp.*, 529 F. Supp. 445, 213 USPQ 1091 (S.D.N.Y. 1982) (finding BENEFICIAL FINANCE was not similar to BENEFICIAL CAPITAL); *Better Homes Realty, Inc. v. Meredith Corp.*, 207 USPQ 457 (E.D. Va. 1979)(finding BETTER HOMES AND GARDENS not similar to BETTER HOMES); *Colony Roods, Inc. v. Sagemark, Ltd.*, 753 F.2d 1336, 22 USPQ 185 (Fed. Cir. 1984)(finding HOBO JOE'S and HOBO JUNCTION not similar to HUNGRY HOBO).

The Eighth Circuit explained the significance of a mark's weakness in *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987), where it stated:

Determining that a mark is weak means that the consumer confusion [is] unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related. *Id.*

By this logic, consumers have learned to carefully pick out highly similar marks from each other and are not likely to be confused as to the source of the mark. This theory is even more applicable when one is not dealing with an average purchaser, but a sophisticated buyer.

2. Buyer Sophistication

Both Applicant's and Registrant's services clearly involve sophisticated corporate clientele who are well-educated in the purchasing process and would not believe the Registrant's

services are associated with the Applicant's. The services provided by both are costly, very technical and highly specialized. Therefore, the consumers involved with these services are more discriminating than the average consumer. When the cost of the product is high, the courts assume that purchasers are likely to be more discriminating and source-conscious than they otherwise might be. *Maxim's Ltd v. Badonsky*, 772 F.2d 388, 227 USPQ 316 (7th Cir. 1985); *Weis Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (where goods [software] expensive, reasonably prudent purchaser standard elevated to discrimination purchaser). Furthermore, the fact that the use of a particular service entails both substantial funds and a "fairly detailed purchasing process" is recognized as being a significant index of buyer sophistication. *McGregor-Doniger Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1138, 202 USPQ 81, 92 (2d Cir. 1979) citing *Blue Bell, Inc. v. Jaymar-Ruby, Inc.*, 497 F.2d 433, 435-36 & n.5, 182 USPQ at 66-67 & n.5 (2d Cir. 1974) (Court found no likelihood of confusion due to the "sophisticated purchaser" theory).

In the Request for Reconsideration, Applicant attached an Affidavit signed by a Vice President of its corporation, Mr. Emil Sarady, wherein he attested that their clientele "consists primarily of sophisticated businesses comprised of well-educated personnel, including several departments of the U.S. government" (see Request for Reconsideration, Exhibit 4).

Additionally, a review of Applicant's web site indicates the sophistication of its services and its clients. Pages obtained from Applicant's web site are provided in the record (see Request for Reconsideration, Exhibit 6). Even a cursory review of the web site pages logically infers that from the extensive work with government agencies, industry and the non-profit sector, Applicant's services are obtained primarily through a thorough bidding and proposal contract process. Contracts of this magnitude are the epitome of a detailed purchasing process.

The first page of the Exhibit 4 entitled "Solutions" lists examples of projects completed through Applicant's services. Under the heading "Information Systems and Technology," four such projects are listed. The following four pages of the attachment give details of these projects, to include: (1) creating the Navy's Serial Number Tracking System, (2) developing a Web Invoicing System for the Defense Finance and Accounting Service (the military's pay department), (3) transforming the extensive contracting paperwork process in to a Web-based system for the Department of Defense, and (4) developing a highly automated advanced-imaging system for storing thousands of pledge cards for a major nonprofit agency. These types of projects are obviously not geared toward an average consumer. Rather, they are highly sophisticated and customized services offered only to the extremely competitive and discriminating consumer.

Furthermore, the *Registrant's* services are also highly advanced, costly, and provided to sophisticated clients. This is indicated in the printout from the Registrant's web site which describes their services (see Request for Reconsideration, Exhibit 7). In paragraph three, it states "the Real-Time Division provides mission-critical, high-performance solutions to a broad range of blue ribbon customers including Lockheed Martin, United Technologies, FlightSafety and Boeing, just to name a few." Again, these consumers are highly sophisticated, discriminating, and choose their required services only after a tedious bidding process and much consideration.

The assumption in the sophisticated purchaser doctrine is best described as follows:

...where a purchaser is buying an expensive product, he is likely to be deliberate in his product selection and therefore in his differentiation between trademarks. He is normally thought to take greater time in purchasing, to investigate all of the facts, to shop for competing products, and to spend his money only when he is convinced that a particular trademarked product is precisely what he wants. These purchasing habits, to be contrasted sharply with 'impulse' purchases

made on the spur of the moment, are generally thought to reduce the likelihood that the purchaser will be confused."

5 *Gilson, Trademark Protection and Practice* § 5.08[4] at p. 5-134.

The examining attorney concedes that Applicant's and Registrant's services are sophisticated in stating "review of the submitted pages does demonstrate that the applicant's and registrant's services are highly technical and likely to involve much consideration..." (see Denial of Request for Reconsideration, p.4). However, she attempts to rebut this by citing *In re Research and Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986) which states "that the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. Human memories even of discriminating purchasers...are not infallible." *Id.*, (internal citation omitted); (see Denial of Request for Reconsideration, p.4).

This instant matter, as well as most of the cases dealing with *goods* in a buyer sophistication scenario, are distinguishable from facts involving procurement of sophisticated *services*. In obtaining services, especially highly technical services such as these, a prospective client does not see the marks in the way one would see a mark identifying a product. It is easy to understand that a purchaser sophisticated in the field of safety equipment could confuse a product called ROPELOK identified for goods described as "safety fall protection equipment for attachment to workers operating at elevated heights..." with a product called ROPELOCK for "releasable walking buckles for ropes particularly for industrial purposes." *In re Research and Trading Corp.*, 793 F.2d 1276, 1278, 230 USPQ 49, 50 (Fed. Cir. 1986). When that purchaser is affronted with the two marks in trade catalogs, source confusion may be likely despite the fact that he is knowledgeable in the safety equipment industry.

However, this logic does not apply to a situation where such sophisticated services are involved. The services of the Applicant and Registrant in the instant case are sought by major corporations and government agencies for a very specific purpose and are more "custom" oriented. They do not "advertise" in the traditional sense (except for possibly their respective web sites). It is evident from the nature of their services that they are obtained through proposals, bidding and word-of-mouth within a knowledgeable industry. These are controlled situations with *highly* sophisticated purchasers, not merely discriminating. With clientele such as the Navy, the Department of Defense, Lockheed Martin, and Boeing, confusion is simply not likely.

Likelihood of confusion requires that confusion be *probable*, not simply a possibility. *HMH Publishing Co. v. Brincat*, 504 F.2d 713, 717, 183 USPQ 141, 144, (9th Cir. 1974); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 804, 167 USPQ 713, 720 (9th Cir. 1970). In stating that the mere purchase of goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers, the U.S. Court of Appeals for the Federal Circuit appropriately reiterated the following:

"We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."

Electronic Design & Sales, Inc. v. Electronic Data Systems, 954 F.2d 713, 717, 21 USPQ2d 1388 (Fed. Cir. 1992). The Court also found buyer sophistication a significant factor in finding no likelihood of confusion because the goods involved were "expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation" *Id.* at 718. Moreover, the Court stated "the near identity of the marks here is apparent and is not seriously

disputed...but it was given excessive weight by the Board in light of the sophistication of the purchasers here." *Id.* at FN2.

Applicant would argue likewise. Under these particular facts, the sophistication of the purchasers and sophisticated nature of the services provided by both Applicant and Registrant should be weighed heavily in Applicant's favor.

Finally, both Applicant and Registrant have built impressive, reputable business relationships and co-existed peacefully for over nine (9) years with no evidence of confusion. This has been attested to by the Applicant in the Affidavit of Emil Sarady (see Request for Reconsideration, Exhibit 4). Furthermore, it is evidenced by the fact that the Registrant has not tried to enforce superior rights over Applicant through a cease and desist letter, opposition or cancellation proceeding, or court action.

Because CONCURRENT COMPUTER has been disclaimed by the Registrant; the marks are not highly similar in appearance, sound, or commercial impression; the term CONCURRENT is used on other goods and related services that co-exist peacefully on the Register and in commerce; the Applicant's services involve sophisticated purchasers that are not likely to be confused; and there has been no evidence of confusion on behalf of Applicant nor filing of inter-

partes proceedings by the Registrant, Applicant respectfully requests that the refusal for Likelihood of Confusion under Section 2(d) be overturned.

In view of the above remarks, registration of Applicant's mark is warranted and respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Janel M. Pernell". The signature is written in black ink and is positioned above the typed name and address.

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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PENNSYLVANIA 100 CTC Drive Johnstown PENNSYLVANIA 15904

Attorney of

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Limitation
Statement** as to "TECHNOLOGIES"

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	TOP	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-02-14 15:06:15 ET

Serial Number: 76040473

Registration Number: (NOT AVAILABLE)

Mark (words only): CONCURRENT TECHNOLOGIES CORPORATION

Current Status: Application has been published for opposition.

Date of Status: 2002-12-03

Filing Date: 2000-05-04

The Information will be/was published in the Official Gazette on 2002-12-03

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMO Law Office 115

Attorney Assigned:
CHICOSKI JENNIFER D Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2002-10-23

CURRENT APPLICANT(S)/OWNER(S)

1. Concurrent Technologies Corporation

Address:

Concurrent Technologies Corporation
100 CTC Drive
Johnstown, PA 15904
United States

State or Country of Incorporation: Pennsylvania

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

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

International Class: 041

First Use Date: 1992-04-03

First Use in Commerce Date: 1992-04-03

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "CORPORATION"

Section 2(f): as to "TECHNOLOGIES"

PROSECUTION HISTORY

2002-12-03 - Published for opposition
2002-11-13 - Notice of publication
2002-09-24 - Approved for Pub - Principal Register (Initial exam)
2002-09-18 - Case file assigned to examining attorney
2002-09-17 - Reinstated
2002-05-06 - PAPER RECEIVED
2002-04-26 - Abandonment - Failure to respond
2000-08-02 - Unresponsive paper received
2001-03-08 - Non-final action mailed
2000-11-22 - Communication received from applicant
2000-10-06 - Communication received from applicant
2000-10-05 - Non-final action mailed
2000-10-04 - Case file assigned to examining attorney
2000-09-26 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
GEORGE PATRICK BAIER (Attorney of record)

GEORGE PATRICK BAIER
BUCHANAN & INGERSOLL
ONE OXFORD CENTRE
301 GRANT STREET, 20 FLOOR
PITTSBURGH PA 15219-1410
United States



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

2

TESS was last updated on Thu Feb 13 04:11:58 EST 2003

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DIET	BOTTOM	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: OR [Jump](#) to record: **Record 2 out of 2**

[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 GEORGE PATRICK BAIER

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-02-14 15:06:50 ET

Serial Number: 76040124

Registration Number: 2629938

Mark (words only): CONCURRENT TECHNOLOGIES CORPORATION

Current Status: Registered.

Date of Status: 2002-10-08

Filing Date: 2000-05-04

Registration Date: 2002-10-08

Law Office Assigned: TMO Law Office 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-10-28

CURRENT APPLICANT(S)/OWNER(S)

1. Concurrent Technologies Corporation

Address:

Concurrent Technologies Corporation
100 CTC Drive
Johnstown, PA 15904
United States

State or Country of Incorporation: Pennsylvania

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

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

International Class: 035

First Use Date: 1992-04-03

First Use in Commerce Date: 1992-04-03

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "CORPORATION"

Section 2(f): as to "TECHNOLOGIES"

PROSECUTION HISTORY

2002-10-08 - Registered - Principal Register

2002-07-16 - Published for opposition

2002-06-26 - Notice of publication

2002-01-10 - Approved for Pub - Principal Register (Initial exam)

2001-03-15 - Final refusal mailed

2000-11-28 - Communication received from applicant

2000-10-06 - Communication received from applicant

2000-10-10 - Non-final action mailed

2000-09-26 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

GEORGE PATRICK BAIER (Attorney of record)

GEORGE PATRICK BAIER
BUCHANAN INGERSOLL, P.C.
ONE OXFORD CENTRE
301 GRANT STREET, 20TH FLOOR
PITTSBURG, PA 15219
United States

September 30, 2002
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