

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
-TRADEMARK-**

Applicant:	Omnipod Inc.	Docket No.:	36761.2800
Serial No.:	75/669,021	Examining Attorney:	Georgia Ann Carty
Filing Date:	June 13, 2000	Law Office No.:	111
Mark:	POD	International Class	9

BRIEF FOR APPELLANT

Assistant Commissioner for Trademarks
Box TTAB-No Fee
2900 Crystal Drive
Arlington, VA 22202-3513

To the Commissioner:

Applicant hereby appeals from the Examiner's final refusal to register the above-identified mark dated December 19, 2001, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner's decision. A timely Notice of Appeal was filed with the Office on June 18, 2002. This Brief is submitted on Monday, August 19, 2002 in triplicate.

Applicant's Trademark

Applicant seeks registration on the Principal Register of its mark "POD" in International Class 9 for:

Computer programs, namely client software programs for managing, viewing and editing files, messages, multimedia content, audio and video content, appointments, contacts, and other digital materials in conjunction with a network server in the field of user productivity, entertainment and communication.

Prior Registrations Cited By the Final Office Action

POD, U.S. Registration No. 1,861,641, for "computer hardware for testing mass storage devices; namely, hard disk drives, floppy disk drives, removable hard disk drives, optical disk drives, magnetic tape drives, magneto-optical drives and floptical drives", assigned to HAVANT INTERNATIONAL LTD.

POD, U.S. Registration No. 1,863,522, for "computer software for testing mass storage devices; namely, hard disk drives, floppy disk drives, removable hard disk drives, optical disk drives,

magnetic tape drives, magneto-optical drives and floptical drives”, assigned to HAVANT INTERNATIONAL LTD.

The Rejection

On December 19, 2001, the Office issued a Final Office Action refusing registration of Appellant's mark. The Final Office Action contends that the mark as applied to the stated goods so resembles Reg. Nos. 1,861,641 and 1,863,522 as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Argument

Applicant respectfully traverses the rejection in that the Office has not met its burden of demonstrating likelihood of confusion, in that the registrations cited against Applicant contain descriptions of goods and services that are facially distinct from those recited in the present application, and in that no genuine relationship exists between Applicant's recited goods and those recited in the aforementioned registrations. Applicant therefore contends that confusion between the marks is highly unlikely.

As set forth in the Final Office Action, multiple factors are considered when determining whether “a likelihood of confusion” exists between two marks. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A., 1973). Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used, or are intended to be used. In re Azteca Restaurant Enterprises, Inc., 50 USPQ 563 (TTAB 1999).

With regard to the similarity between the marks, Applicant does not dispute that both Applicant's mark and the cited marks consist of the term "POD" in block letter form. Nonetheless, a finding of likelihood of confusion requires that there be a viable relationship between the goods recited by applicant and registrant. See In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983). Although it is not necessary that the goods of applicant and registrant be identical or competitive, likelihood of confusion requires that the goods be related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See In re Albert Trostel & Sons, 29 USPQ 1783 (TTAB 1993). No such relationship exists between a device

for testing mass storage devices and a computer program for managing, viewing and editing files, digital materials in the fields of user productivity, entertainment and communication.

1. *The Final Office Action Does Not Support a Finding of Likelihood of Confusion Under Current Board Precedent*

The Final Office Action states that "applicant's goods and the goods of the registrants involve identical and highly related goods in that they involve computer programs/computer software and computer hardware". The Office Action does not further elaborate as to the similarities between the two products. To the contrary, the Office Action concludes without analysis that "computer hardware products are so related to computer software products that their marketing under the same or similar marks may be likely to cause confusion", citing two opinions of the Board from 1984, In re Graphics Technology Corp., 222 USPQ 179 (TTAB 1984) and In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull, 223 USPQ 363 (TTAB 1984). The Final Office Action makes no further inquiry into any alleged relationship between Applicant's goods and those of Registrant.

Such perfunctory analysis is insufficient to support a finding of likelihood of confusion, even when the marks in question are identical to each other. The Board has clearly held that there is no per-se rule that all computer hardware and/or software are related for determining likelihood of confusion. Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988). Indeed, the Board has consistently stated that in order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue beyond the fact that each merely involves the use of computers. Reynolds and Reynolds, Co. v. I.E. Systems Inc., 5 USPQ2d 1749, 1751 (TTAB 1987), *cited by* In re Sterling Software Inc., 2002 TTAB LEXIS 192 (TTAB 2002). Further, the Board has expressly clarified that the *Graphics Technology* and *Honeywell Bull* cases cited by the Office do not impose a *per se* rule that source confusion will be found in all cases involving items of computer hardware and software. In re Quadram Corporation, 228 USPQ 863 (TTAB 1985). In specifically addressing the two cases cited in the Final Office Action, the Board stated:

As a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized uses in this industry, we think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace. *Quadram* at 865.

Accordingly, the mere fact that both Applicant's recited goods and Registrant's recited goods relate in some way to computers is insufficient to support a finding of likelihood of confusion. By rejecting

Applicant's mark without further analysis into any alleged relationship between the two products, the Office is applying an impermissible per-se rule. Favorable reconsideration of the rejection is therefore appropriate.

2. No Relationship Exists Between Applicant's Stated Goods and Registrant's Stated Goods

As stated above, a finding of likelihood of confusion requires that there be a viable relationship between the goods recited by applicant and registrant. In re Concordia. In the present case, no such relationship exists because Applicant's recited goods are entirely unrelated to computer hardware/software for testing mass storage devices.

a. The Stated Goods and Services are Distinguishable on their Face

It is well-settled that the question of likelihood of confusion must be determined based on the goods and/or services as they are identified in the application and in the cited registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *see also* In re Kenneth M. Stirbl, 2002 TTAB LEXIS 148 (TTAB 2002). The cases cited by the Final Office Action, for example, addressed broadly-worded descriptions of the goods to find likelihood of confusion. In re Graphics Technology Corp., 222 USPQ 179 (TTAB 1984) (finding a relationship between "computer software programs" and "computer data terminals") and In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull, 223 USPQ 363 (TTAB 1984) (finding a relationship between "computer hardware, namely terminals, keyboards, CRT displays, microcomputers and text editors" and "computer programs and brochures and manuals..."). Unlike the marks in the cited cases, however, both Applicant's and Registrant's statements of goods and services are highly detailed and set forth relatively specialized products that are easily distinguished from each other.

Registrant's stated goods and services are "computer hardware/software for testing mass storage devices; namely, hard disk drives, floppy disk drives, removable hard disk drives, optical disk drives, magnetic tape drives, magneto-optical drives and floptical drives". Registrant's products are thereby narrowly described within a very specific field: testing mass storage devices such as hard disk drives and the like. Even taking a broad reading of Registrant's goods and services, it is inconceivable that hardware and software for testing mass storage devices would have any bearing upon or relationship to the fields of user productivity, entertainment and communication.

Applicant's goods and services are similarly narrowly described, and are thus easily distinguishable from Registrant's goods and services. Applicant's goods are recited as "computer programs, namely client software programs for managing, viewing and editing files, messages,

multimedia content, audio and video content, appointments, contacts, and other digital materials in conjunction with a network server in the field of user productivity, entertainment and communication". This recitation facially calls forth a computer program for managing, viewing and editing digital content in conjunction with a network server. Further, Applicant's goods are recited within the fields of "user productivity, entertainment and communication". No mention whatsoever is made of hardware or software for testing mass storage devices. Indeed, the two products are utterly unrelated, with neither bearing any relationship to the other. Based upon the literal recitation of goods and services, it is apparent that both Applicant's goods and Registrant's goods lie within relatively specific yet unrelated and non-overlapping fields.

The Final Office Action notes that the Examining Attorney must consider any goods in the Registrant's normal fields of expansion to determine whether the Registrant's goods or services are related to the Applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The Final Office Action cites sixteen third party registrations, mostly relating to software for testing computer network components, without elaboration. Third party registrations may be cited by the Office to show fields of expansion or overlap. *In re Albert Trostel & Sons, Co.*, 29 USPQ2d 1783 (TTAB 1993). Here, however, the cited registrations fail to disclose any overlap between the goods recited by Registrant and Applicant. To that end, none of the cited registrations recite both "hardware/software for testing mass storage devices" and "client software programs for managing, viewing and editing digital content in the fields of user productivity, entertainment and communication". Absent a recitation of both goods in a single mark, no evidence of likely expansion into overlapping fields can be found. Even to the extent that certain parties may provide software for testing network components (as is the case with most of the cited registrations), this does not indicate that a maker of hardware/software for testing mass storage devices is in any way likely to expand into the business of providing client programs for managing, editing and viewing digital content in the fields of user productivity, entertainment and communication. Indeed, such expansion by a test equipment company is highly counter-intuitive because the two fields are entirely disparate, and because the markets for such goods are entirely distinct, as set forth more fully below.

Accordingly, the Office has not shown that a relationship exists between the goods recited by Applicant and Registrant. Because both marks facially describe goods that are suited to distinct and specialized markets, no relationship exists between the two products and confusion between the two marks remains highly unlikely.

b. The Stated Goods and Services are Distinguishable in the Marketplace

Likelihood of confusion requires that the goods be related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. In re Albert Trostel & Sons, 29 USPQ 1783 (TTAB 1993). No such conditions are present in the incident case, making confusion highly unlikely.

As a preliminary matter, Applicant has attempted to obtain additional information about Registrant's products and marketing channels, but has not identified any recent public use of the mark by Registrant. It is believed that the original Registrant, Zadian Technologies Inc., was acquired in 1996 by Xyratex, a division of Havant Internation, Ltd., which is the present Registrant of record, and that Zadian's POD products were discontinued shortly after the acquisition. Applicant has conducted searches of the Internet, Registrant's web sites, and the Lexis databases and has been unable to find a current reference to "POD" products provided by Registrant, or to any products provided by Registrant relating to testing mass storage devices. Applicant therefore believes that Registrant is no longer publicly using the mark in conjunction with the cited goods, making confusion in the marketplace highly unlikely. Even to the extent that Registrant may be continuing to use the POD mark in some form that is not readily identifiable by Applicant, the relative obscurity of the use argues strongly against a finding of likelihood of confusion.

Nevertheless, the conditions surrounding their marketing of the products described by the two marks are such that the products are unlikely to be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from, or are associated with, the same source. Registrant's goods are oriented toward computer technicians who diagnose or repair mass storage devices. Customers of these products are therefore computer professionals who are interested in testing various hardware components such as hard drives, optical drives and the like. Such products would not be marketed or otherwise oriented toward home or business users, or toward any other purchasers in the fields of user productivity, entertainment or communications. To the contrary, the market for Registrant's goods is a very specialized niche of computer technicians, who are by definition skilled and knowledgeable about computer-related technologies.

Applicant's products, while similarly marketed to sophisticated consumers, are not marketed toward the same customer base as Registrant's products. Applicant's products are in no way marketed toward hardware or repair technicians, but rather are oriented toward corporate network users. Applicant's products are licensed to corporations and other large entities for use in

conjunction with server programs, as noted in Applicant's statement of goods and services. Applicant's customers are therefore sophisticated information technology professionals who are unlikely to confuse Applicant's products with a product for testing mass storage devices. Even assuming *arguendo* that Registrant's POD products may still be available in some form, then, it remains highly unlikely Applicant's products and Registrant's products would be encountered by the same persons. To the extent that any overlap between hardware technicians and corporate IT purchasers did exist, such overlap would be purely *de minimis*.

Even in the unlikely event that a consumer were exposed to both products, such a multi-skilled person would be unlikely to mistakenly assume that Applicant's goods emanated from or were associated with Registrant's goods. The products themselves are entirely unrelated to each other, and would have no common purpose whatsoever. The marketing channels for the two products are entirely distinct. Both are purchased/licensed by highly sophisticated users for a particular (and non-overlapping) purpose. Both are specialized products that would not be purchased by casual users. Because of the very nature of the two products and their respective customer base, then, it is unlikely that circumstances would arise that would create mistaken assumptions as to source or affiliation.

Accordingly, Applicant respectfully submits that the goods are not related in any manner, nor are the conditions surrounding their marketing such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source.

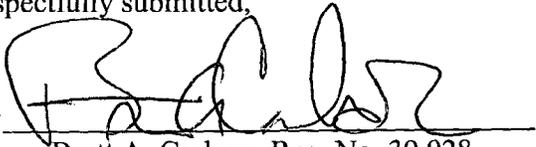
CONCLUSION

The Office has failed to demonstrate a relationship between Applicant's goods and those of the cited registration beyond the fact that both relate to computers. According to Board precedent, however, the mere fact that two marks related to computers is insufficient for a finding of likelihood of confusion. Moreover, Applicant has demonstrated herein that Applicant's mark is readily distinguishable from Registrant's in that both marks recite relatively narrowly defined fields for their goods and services such that they are unlikely to be encountered by the same consumers. Accordingly, no viable relationship exists between Applicant's goods and those recited by Registrant, and no circumstances exist that would support the mistaken belief that the recited goods emanate from, or are associated with, the same source as Registrant's goods. The rejection under Section 2(d) set forth in the Final Office Action is therefore traversed.

For the reasons set forth above, Appellant submits that there is no likelihood of confusion, mistake, or deception between Appellant's mark and the cited registrations. Accordingly, Appellant's mark is entitled to registration. Withdrawal of the § 2(d) refusal is respectfully

requested. The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's mark..

Respectfully submitted,

By: 

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U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #57



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**APPELLANT'S BRIEF
PURSUANT TO 37 C.F.R. § 1.192**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Applicant(s): Omnipod, Inc. Docket No.: 36761.2800
Serial No.: 75/669,021 Law Office No.: 111
Filing Date: June 13, 2000 Examiner: Georgia Ann Carty
TITLE: POD International Class: 9

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U.S. Patent & TMOtc/TM Mail Rcpt. Dt. #57
08-19-2002

Dear Commissioner:

Attached herewith is Applicants' Brief for Appellant (filed in triplicate).

Also Attached:

[X] Acknowledgment Postcard

Fee Calculation Brief Fee:

Fee Calculation: Request for Extension of Time pursuant to 37 C.F.R. §1.136(a)

Table with 3 columns: Response description, Amount, and Status. Rows include first through fifth month extensions and a subtotal of \$0.00.

Discount for "small entity" status, enter half (1/2) of the second subtotal and subtract.

TOTAL ADDITIONAL FEE: \$0.00

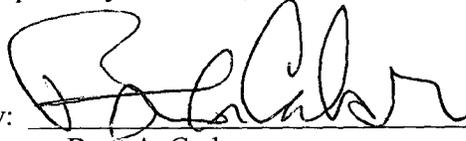
- [] Please charge Deposit Account No. 19-2814 in the amount of \$
A duplicate copy of this sheet is attached.
[] Snell & Wilmer Check # in the amount of
[] Snell & Wilmer Check # in the amount of

This statement does NOT authorize charge of the issue fee. The Commissioner is hereby authorized to charge any other fee specifically authorized hereafter, or any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under 37 C.F.R. §§1.16-1.18 (deficiency only) now or hereafter relative to

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this Application and the resulting Official document under 37 C.F.R. §1.20, or credit any overpayment to Account No. 19-2814 for **which purpose a duplicate copy of this sheet is attached.**

Respectfully submitted,



By: _____

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Date: August 19, 2002

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