

From: Cooper, Christine H.

Sent: 10/2/2012 7:13:16 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77750175 - I-SITE - 09-40122-US -
Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 1

Files: 77750175.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77750175

MARK: I-SITE



CORRESPONDENT ADDRESS:

CARL H PIERCE
REED SMITH LLP
PO BOX 7990INTELLECTUAL PROPERTY
PHILADELPHIA, PA 19101-7990

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: I-Site, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

09-40122-US

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration dated September 10, 2012 and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The refusal made final in the Office action dated March 8, 2012 is maintained and continues to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action, specifically, the refusal under **Section 2(d) only as to applicant's services in International class 42**. Accordingly, the request is denied.

The Marks are Highly Similar, Phonetic Equivalentents and the Services are Identical

Applicant makes a number of arguments regarding the visual differences in the marks and possible differences in meanings or commercial impressions of the marks. However, the differences noted by the applicant do not outweigh the similarities of the marks which sound identical and share several visual points of similarity.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d at 1438; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Applicant repeats its argument that the services of the parties are unrelated notwithstanding the recitation of services in the application and registration. However, in a likelihood of confusion analysis, the comparison of the parties' services is based on the services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

Applicant's services are, in part, "design and development of computer software and applications for others; design and development of computer software and applications; design and development of computer software for portable devices." Registrant's services are, in part, "computer software design for others."

These services are identical as registrant's services encompass applicant's services. As such, it is presumed that the services move in all normal channels of trade and are available to all potential customers. See *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii). As previously discussed, registrant's remaining services, "technical support services, namely, troubleshooting of computer hardware and software problems via telephone, e-mail and in person; database development services," are closely related to applicant's services identified above. Accordingly, the services are considered related for purposes of the likelihood of confusion analysis.

Moreover, where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); TMEP §1207.01(b).

Registered Mark is Not Weak in Connection with the Identified Services

Applicant's argument that the wording in the marks is "weak" and so widely used that it should not be afforded a broad scope of protection is also unpersuasive. Applicant attempts to show that the marks at issue here are weak based on the existence of active and cancelled registrations having phonetically identical or similar marks. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Here, however, applicant includes marks used with a variety of goods and services, including *software* and *software design*, which does not show that consumers are accustomed to careful discrimination of marks in the field of software design. This particular line of reasoning also ignores the fact that the registrations for software are further distinguished due to the specificity of the function, purpose and/or field of the software.

Nevertheless, evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Regarding the third-party registrations submitted by applicant that are either cancelled or expired, it must be noted that a cancelled or expired registration is not evidence that the mark listed therein is currently in use in the marketplace; it is evidence only that the registration issued. See *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1654 n.6 (TTAB 2002); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1048 n.2 (TTAB 2002); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987); TBMP §704.03(b)(1)(A). Thus, these third-party registrations have little, if any, probative value with respect to the registrability of applicant's mark.

Despite applicant's assertion that the marks here are weak, the fact is, the marks are not weak *relative to the services at issue here*. But, even if they were deemed weak marks, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Absence of Consumer Confusion not Dispositive

Regarding applicant's statement that it is unaware of actual consumer confusion related to use of these marks, it should be noted that the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Applicant's Claim of Prior Use Not Relevant in Ex Parte Proceeding

Finally, applicant asserts that it is the senior common law user of the mark. However, a claim of priority of use is not relevant to this ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

In sum, the applicant's and registrant's marks are highly similar and the services of the parties are identical and closely related as discussed and supported in the record. These issues having previously been addressed and no new or compelling arguments having been advanced, the request for reconsideration must be denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding

final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

/Christine Cooper/
Senior Attorney
Law Office 110
US Patent & Trademark Office
(571) 272-9844
christine.cooper@uspto.gov