



TTAB

Docket: G2119-906603

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

In re application of :
Automation Consultants, Inc. :
Serial No.: 78/002,694 :
Filed: April 5, 2000 :
For: THE ACI GROUP :



11-16-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #67

McLean, Virginia
November 16, 2001

APPLICANT'S BRIEF ON APPEAL

The sole issue on appeal in this case is whether the Examining Attorney has improperly refused registration of Applicant's mark, "THE ACI GROUP", under Section 2(d), 15 USC §1052(d), in view of a registration for the mark "ACI".

The present application currently seeks registration of the mark "THE ACI GROUP" in connection with, "computer web site design and development for others", in International Class 42. The cited registration (Reg. No. 1,702,234), is for the mark "ACI", as used in connection with, "computer system engineering, software design and programming services on a project basis and providing computer personnel for technical assistance for staff supplementation". These services also fall within the ambit of International Class 42.

The Examining Attorney has concluded that the marks themselves are highly similar. Applicant concedes that the term "ACI" forms the dominant part of its mark, but

notes that the marks are obviously not identical. This fact weighs in favor, although admittedly not heavily, of a finding that no likelihood of confusion exists between Applicant's mark and the mark in the cited registration.

The services are not, as asserted by the Examining Attorney, very closely related. Both are within the universe of computers, however, it is well established that there is no *per se* rule that confusion is likely to occur, solely on the basis that both marks are used in connection with computers. *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985) Notwithstanding this precedent, the refusal to register Applicant's mark, which states as grounds therefor, that, "[B]oth parties offer computer related services", appears to be applying such a *per se* rule.

The only other conclusions that were apparently reached in support of the refusal were that, "[I]t is likely that the registrant's programming and engineering services may expand to include software development and design; or that the applicant may also offer computer programming and related services.", and that, "such services are likely to encompass all those of the type described, and to move in all normal channels of trade, and be available to all potential customers." (emphasis added)

First, in assessing and comparing the registrant's and the Applicant's services, the refusal goes far afield from the services that are actually set forth in the registration and in the application. Secondly, how can it be said that it is "likely" that the services "may" expand to something allegedly similar to Applicant's services? This seems to equate to, at most, a "possibility" that the Registrant's actual services, and not the services that are set forth in the registration, will someday overlap those of Applicant. Such a contention falls well short of establishing that confusion is likely to ensue. Thirdly, Applicant can

not determine what services are being referred to as “such services”, in the assessment of similarity of trade channels and the like. If this is intended to mean that the Registrant’s services encompass the Applicant’s services, Applicant respectfully disagrees.

The services set forth in the cited registration are clearly directed to systems-level engineering, design and programming. In contrast, Applicant seeks registration of its mark in connection with “web site design and development”. Such services are viewed in a completely different context by potential customers. Web site design and development is much more closely associated with graphic arts and graphic design than with the “nuts-and-bolts” computer system engineering and programming. The expertise that potential consumers will be looking for is considerably different, and such potential consumers would not necessarily expect that both types of expertise would be found from the same source. Thus, while possible, it is not probable that potential consumers would believe that Applicant’s web site design services emanate from the same source as do the Registrant’s system-level engineering and programming services. The “likelihood of confusion” standard requires the latter.

Another significant factor leading to a conclusion that no likelihood of confusion will exist is that the services provided by both the Registrant and the Applicant will be purchased or contracted for by careful, sophisticated buyers. Indeed, the types of services set forth in the registration and in the application, are highly personalized (although, as noted above, in two different areas of expertise), and prospective customers will generally spend a considerable amount of time analyzing such companies and their personnel prior to contracting for services.

Applicant has addressed all of the salient points made in the final refusal to register, and has more than adequately demonstrated that it is entitled to have its mark, "THE ACI GROUP", registered on the Principal Register. Applicant respectfully requests that this Board reverse the determination that the mark is unregistrable under Section 2(d), in view of Registration No. 1,702,234, and to approve the mark for publication

Respectfully submitted,

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