

Hearing:  
March 20, 2007

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
August 2, 2007  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Crosswalk, Inc.

Serial No. 78424189

Lisa K. Koenig, Andrew Hartman and Keith J. Berets of Cooley  
Godward LLP for Crosswalk, Inc.

Lana H. Pham, Trademark Examining Attorney, Law Office 115  
(Tomas V. Vlcek, Managing Attorney).

Before Bucher, Taylor and Bergsman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Crosswalk, Inc. seeks registration on the Principal  
Register of the mark **CROSSWALK** (*in standard character format*)  
for services recited as follows, as amended:

“professional assessment, design and  
technical support services, namely assessment  
and design of information technology and data  
storage systems for others; design,  
development and implementation of software;  
maintenance of information technology  
software and data storage systems for others”  
in International Class 42.<sup>1</sup>

<sup>1</sup> Application Serial No. 78424189 was filed on May 24, 2004  
based upon Applicant's allegation of a *bona fide* intention to use  
the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney asserts that Applicant's mark, when used in connection with Applicant's recited services, so resembles the marks **CROSSWALK.COM**<sup>2</sup> and **CROSSWALK**,<sup>3</sup> both owned by the same entity, and registered in connection with the following services:

"computer services, namely, providing multiple-user access to a global computer information network; providing databases featuring general news and information; providing search engines for obtaining data on a global computer network; hosting websites of others on a computer server for a global computer network; providing an online computer database in the field of religion and spirituality; providing temporary use of online non-downloadable software for use as a web filtering device" in International Class 42;

and

"computer services, namely electronic transmission of data and documents via computer terminals; providing telecommunications connections to a global computer network; providing bulletin boards

---

<sup>2</sup> Registration No. 2736979 issued to Crosswalk.Com, Inc. on July 15, 2003 based upon an application filed on September 28, 1998 claiming first use anywhere and first use in commerce in both classes of services at least as early as September 9, 1998.

<sup>3</sup> Registration No. 2805119 issued to Crosswalk.Com, Inc. on January 13, 2004 based upon an application filed on September 9, 1998 claiming first use anywhere and first use in commerce in both classes of services at least as early as September 9, 1998.

and chat rooms featuring general news and information of interest to specific groups with specific self-defined interests" in International Class 38.

as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the issue. We reverse the refusal to register.

The Trademark Examining Attorney argues that Applicant's mark is identical to one of Registrant's marks and substantially the same as the second. She takes the position that Registrant's "Crosswalk" mark is inherently strong when used in connection with Registrant's recited services. She also argues that the record demonstrates that these respective services are closely related and that the services will be found in the same overlapping channels of trade.

By contrast, Applicant argues that as applied to Registrant's services, the cited marks have vastly different connotations than does Applicant's mark. Applicant has also contended throughout the prosecution of this application that the services Applicant offers, as described in its application, are completely different from those offered by the Registrant in the cited registrations. In addition to the Trademark Examining Attorney's alleged misunderstandings

about the respective services, Applicant argues that she has incorrectly analyzed the trade channels for the services covered by the respective marks. Furthermore, Applicant argues that the Trademark Examining Attorney has failed to acknowledge appropriately the sophistication of the potential purchasers of Applicant's services - an important *du Pont* factor in the instant case. Finally, Applicant contends that the absence of actual confusion over a period of contemporaneous usage of the respective marks supports a finding of no likelihood of confusion.

### **LIKELIHOOD OF CONFUSION**

We turn then to a consideration of the issue of likelihood of confusion. Our determination is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re*

*Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

### **The marks**

We look first at the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant's **CROSSWALK** mark has exactly the same appearance and sound as does Registrant's **CROSSWALK** mark, and is similar on both of these scores to Registrant's **CROSSWALK.COM** mark.

As to meaning, Applicant and the Trademark Examining Attorney continue to disagree on whether or not there is a significant difference in the connotations of Applicant's mark and the cited marks.

From the standpoint of dictionary or glossary entries, we note two very different, alternative meanings for the word, "Crosswalk." As noted by applicant, the term is often defined as the "portion of a roadway where pedestrians are permitted to cross the roadway." However, we note that this term has also taken on a suggestive meaning within the computer field where a crosswalk is a table that maps the

relationships and equivalencies between databases and hence promotes interoperability across two or more metadata formats.<sup>4</sup> Given the central role of "data storage" in Applicant's recitation of services, it seems clear that customers of these services would pick up this suggestive "crossing" connotation of Applicant's mark.

By contrast, there is no reason this suggestive meaning would occur to Registrant's users. Rather, Applicant argues that for Registrant's consumers, the "term 'crosswalk' is a pun on the traditional definition of a street crossing, and a religious 'cross' walk (impliedly relating to Jesus' walk with his cross in Jerusalem)." Applicant's reply brief at 2. In support of this interpretation, Applicant points to the depiction of Registrant's mark appearing on Registrant's website, showing a stylized version of a religious cross

("Faith"), having a supporting leg, that also makes the total image



appear to be a person walking ("Life"), and that the "intersection" of this cross/walking imagery is captured

---

<sup>4</sup> THE DUBLIN CORE METADATA INITIATIVE (DCMI) USAGE GUIDE GLOSSARY, also found at <http://dublincore.org/documents/2005/11/07/usageguide/>. It is settled that the Board may properly take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

within a circle doubling as the letter "O" in the word "crosswalk."

Applicant quotes to Professor McCarthy: "In determining the meaning and connotation which the trademark projects, it is proper to look to the context of use such as material on labels, packaging, advertising and the like." 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:26 - 28.

Accordingly, we agree that this is a case where the connotation of the term is deemed to be clearly different as applied to the respective services. For example, this Board found that the mark PLAYERS on men's underwear and shoes would not result in consumer confusion as to the source of the goods, quoting directly from that applicant's brief:

"PLAYERS" for shoes implies a fit, style, color and durability adapted to outdoor activities. "PLAYERS" for men's underwear implies something else, primarily indoors in nature.

*In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984).

In a later underwear case at the Board, another "CROSS-formative" mark was treated in similar fashion, albeit with another slightly different cross connotation. See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) [CROSS-OVER, when applied to brassieres, is suggestive of the

crisscross construction of the bras, and hence is not likely to be confused with CROSSOVER for women's outerwear].

Here, Registrant's recitations of services do contain references to "the field of religion and spirituality." Given the importance of the symbol of the cross in the Christian faith,<sup>5</sup> we find that this is the commercial impression that users and potential customers of Registrant's services will take from the **CROSSWALK** and **CROSSWALK.COM** marks - a very different commercial impression from that of Applicant's **CROSSWALK** mark as applied to its recited data storage system services. Accordingly, this *du Pont* factor favors a finding of no likelihood of confusion.

***The number and nature of similar marks registered in connection with similar goods and/or services***

Applicant argues that "[t]here are *many* companies in the marketplace that have registered some form of the term 'CROSSWALK' for use in their name or for their company products" [*emphasis supplied*]. As a result, Applicant argues that the cited marks are entitled to only a very narrow scope of protection. *See National Cable Television*

---

<sup>5</sup> "Then [Jesus] said to them all: 'If anyone would come after me, he must deny himself and take up his cross daily and follow me.'" St. Luke, Ch. 9, Verse 23.

*Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). In its brief, Applicant highlights the following examples:<sup>6</sup>

---

**CROSSWALK** for "annual publication, namely pamphlets featuring medical codes used for diagnostic and billing purposes" in Int. Class 16;<sup>7</sup>

---

**CROSSWALKS** for "metal non-luminous and non-mechanical signs" in International Class 6;<sup>8</sup>

---

In addition to these two registrations, the others that Applicant had included as Exhibit K to its response of June 3, 2005, included the following registrations, all of which appear to be owned by Registrant, *not* third parties:

---

**CROSSWALK** for "on-going radio and television programs addressing ethical issues affecting inner city families" in International Class 41;<sup>9</sup>

---

---

<sup>6</sup> A third example that Applicant mentioned in Exhibit M to its brief, Registration No. 1294615, involving the mark CROSSWALK for "resilient hard surface type covering for floors, walls, and other surfaces" has since been cancelled under Section 8 of the Trademark Act.

<sup>7</sup> Registration No. 2004932 issued to American Society of Anesthesiologists, Inc. on October 1, 1996 based upon an application filed on September 29, 1994 later claiming first use anywhere and first use in commerce at least as early as October 5, 1994; renewed.

<sup>8</sup> Registration No. 2275806 issued to Atlas Screen Printing, Inc. on September 7, 1999 based upon an application filed on May 1, 1998 claiming first use anywhere and first use in commerce at least as early as May 1996; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

<sup>9</sup> Registration No. 2463313 issued to Crosswalk.com, Inc. [Registrant, herein] on June 26, 2001 based upon an application filed on July 12, 1999 claiming first use anywhere and first use in commerce at least as early as July 1998; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

**CROSSWALK** for "advertising and business services; namely, preparing and placing advertisements for others on a global communications network, and promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with a global communications network" in Int. Class 35;<sup>10</sup>

**CROSSWALK** for "outreach religious ministry services to inner city families" in International Class 42;<sup>11</sup>

**CROSSWALK** for "charitable fundraising" in Int. Class 36;<sup>12</sup> and

**CROSSWALK** for "publications and other printed material, namely, brochures, manuals, reports, booklets and cards all dealing with services and products offered via a global communications network; ball point pens; book covers; calendars; daily planners; decals; desk pads; desk sets; data books; diaries; classified directories; Bibles; file cards; file folders; note pads; paper banners; paper signs; pen or pencil holders; stationery; books, namely, anniversary books, appointment books, autograph books, baby books, address books, children's books, children's activity books, coloring books, composition books, cook books, date books, engagement books, hymn books, notebooks, picture books, prayer books, printed music books, recipe books, religious books, song books, telephone number books, wedding books, wire bound books, and journals in the fields of family life, marriage, parenting, spiritual life, culture, politics, home improvement, e-commerce, career management, colleges, music, education, personal finance and investing, business, sports, entertainment, religion, health, news, publishing, and technology; personal inspiration books; and educational books, computer program manuals, newsletters, and printed instructional and

<sup>10</sup> Registration No. 2527874 issued to Crosswalk.com, Inc. [Registrant, herein] on January 8, 2002 based upon an application filed on September 9, 1998 claiming first use anywhere and first use in commerce at least as early as September 9, 1998.

<sup>11</sup> Registration No. 2531159 issued to Crosswalk.com, Inc. [Registrant, herein] on January 22, 2002 based upon an application filed on June 2, 1999 claiming first use anywhere and first use in commerce at least as early as July 1998.

<sup>12</sup> Registration No. 2750649 issued to Crosswalk.com, Inc. [Registrant, herein] on August 12, 2003 based upon an application filed on September 9, 1998 claiming first use anywhere and first use in commerce at least as early as February 6, 2003.

---

teaching materials, all in the fields of family life, marriage, parenting, spiritual life, culture, politics, home improvement, e-commerce, career management, colleges, music, education, personal finance and investing, business, sports, entertainment, religion, health, news, publishing, and technology" in International Class 16.<sup>13</sup>

---

Accordingly, contrary to Applicant's position that "[t]here are many companies in the marketplace" using this term, we do not find that the term "Crosswalk" has been used on numerous types of goods and services by different companies, such that we could infer that purchasers have been conditioned to expect different sources for these different goods or services. This *du Pont* is, at best from Applicant's perspective, a neutral factor.<sup>14</sup>

### ***Relationship of the services***

We turn next to the *du Pont* factor focusing on the relationship of the services recited in the involved application and the services of the cited registrations.

In support of her position that Applicant's and Registrant's services are provided by the same party under

---

<sup>13</sup> Registration No. 2802602 issued to Caron Broadcasting, Inc. on January 6, 2004 based upon an application filed on September 9, 1998 claiming first use anywhere at least as early as March 1, 2003 and first use in commerce at least as early as May 1, 2003.

<sup>14</sup> If anything, this latter listing hurts Applicant's position on another of the *du Pont* factors we have not discussed at length, namely the one focusing on the wide variety of goods and services on which Registrant's mark is used.

the same mark, the Trademark Examining Attorney submitted for the record the following third-party registrations:<sup>15</sup>



# Computer Comfort

for "computer software and hardware design for others; integration of computer systems and networks; maintenance of computer software; creating and maintaining websites for others; and providing multiple-user access to global computer information network for the transfer and dissemination of a wide range of information" in International Class 42;<sup>16</sup>

## TERASPACE NETWORKS

for, *inter alia*, "providing multiple-user access to and regulated bandwidth for a global computer information network; providing network connections for obtaining data on private, public, secure, and open local, regional, and global computer networks; and electronic data interchange services" in International Class 38; "hosting websites and webpages on a global computer network; computer network software maintenance services" in International Class 42;<sup>17</sup>

<sup>15</sup> Registration Nos. 2285699 and 2337135 have since been cancelled under Section 8 of the Act.

<sup>16</sup> Registration No. 2111973 issued on November 11, 1997 based upon an application filed on August 22, 1996 claiming first use anywhere at least as early as January 1985 and first use in commerce at least as early as February 1, 1986; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the word "Computer" apart from the mark as shown.

<sup>17</sup> Registration No. 2572097 issued to Hillwood Development Corporation on May 21, 2002 based upon an application filed on June 16, 2000 later claiming first use anywhere and first use in commerce in both classes at least as early as May 15, 2001. No claim is made to the word "Networks" apart from the mark as shown.

**TWX-21**

for, *inter alia*, "telecommunications and electronic data interchange services, namely, the receipt and delivery of messages, documents and data by electronic transmission" in International Class 38;  
"computer network access, administration and support services, namely, providing multiple-user access to global computer networks for the dissemination and exchange of a wide range of information and data, designing computer hardware and computer software for telecommunications networks, providing computer network systems integration services, assisting others in the design of computer network sites, assisting others in the operation and maintenance of networked computer systems by maintaining computer software and providing computer programming for others, and protecting the security of data transmitted over computer networks by means of a authentication of user identity and message content, verification of non-repudiation of transmissions and access control; electronic data interchange services for a variety of business enterprises, namely, consulting related to providing computer network systems and providing computer network services for sending and receiving product orders, product and manufacturing estimates, drawings, documents, and inventory lists, managing transportation and delivery of products, providing electronic means for product quality and process control, providing means for electronic notary or authentication of documents and data transmissions, and making financial transactions; loading, revising and updating of computer software for electronic data interchange and telecommunications networks for others; computer network support services, namely, protecting the security of data transmitted over computer networks by means of encryption and cryptography" in International Class 42;<sup>18</sup>

---

<sup>18</sup> Registration No. 2672390 issued to Kabushiki Kaisha Hitachi Seisakusho, d.b.a. Hitachi, Ltd. on January 7, 2003 based upon an application filed on July 1, 1997 claiming first use anywhere and first use in commerce in all classes at least as early as March 14, 2001.



**Select Quality Care**

for "licensing computer software for use in analyzing the performance of and quality of care provided by hospitals, and aiding consumers to compare and select hospitals" in International Class 35;  
"providing multiple-user access to global computer information network database in the field of health care" in Int. Class 38;  
"providing health information and analysis in the nature of the performance of and quality of care provided by hospitals via a global computer network; database development services in the field of health care; and computer services, namely, providing access to and analysis of computer databases in the field of health care and computer software development and maintenance services for others" in International Class 42;<sup>19</sup>

**EL SITIO**

for "communication and telecommunication services, namely, electronic transmission of voice, data, images, sounds, and information through a global computer network; providing multiple user access to global computer information networks for the creation, transfer and dissemination of a wide range of information; providing on-line chat rooms for transmission of messages among computer users concerning entertainment, shopping, travel, health and financial issues; providing on-line electronic bulletin boards for transmission of messages among computer users concerning entertainment, shopping, travel, health and financial issues; electronic mail services" in Int. Class 38;  
"computer services, namely, providing an on-line multimedia magazine in the field of cultural and current events rendered by means of a global computer network; computer consultation services: computer programming

---

<sup>19</sup> Registration No. 2701879 issued to HealthShare Technology, Inc. on April 1, 2003 based upon an application filed on August 3, 2001 claiming first use anywhere in all three classes at least as early as February 28, 2001 and first use in commerce in all three classes at least as early as June 8, 2001. No claim is made to the word "Quality Care" apart from the mark as shown.

---

---

for others; custom design services in the field of computer software" in Int. Cl. 42;<sup>20</sup>

---

**CREEKPATH**

for, *inter alia*, "computer support services; namely, providing technical advice and troubleshooting of data storage solution systems via telephone and over global computer networks; providing information and consulting in the field of computer networks and data storage systems; design, testing, development, installation, maintenance and updating of computer software and computer data storage systems; providing temporary use of non-downloadable software used for managing, monitoring, configuring and controlling scaleable storage computer networks and the storage of data thereon via local and remote means and computer utility and network management software; and computer network design for others" in International Class 42;<sup>21</sup>

---

**METATV**

for, *inter alia*, "providing multiple user access to global computer networks and the web via cable, satellite, telecommunications, communications and broadcast networks" in Int. Class 38; and  
"computer services, namely computer consultation and integration of computer systems; computer programming services and computer system analysis for others; design and development for others of web, global computer network, television, digital and analog transmission systems and products; computer software design and development for others; co-location hosting the web sites of others on a computer server for a global computer network" in Int. Class 42.<sup>22</sup>

---

---

<sup>20</sup> Registration No. 2770539 issued to El Sitio International Corporation, a corporation of the British Virgin Islands on October 7, 2003 based upon an application filed on August 3, 1999 claiming use anywhere and first use in commerce in both classes at least as early as June 18, 1999. The English translation of "El Sitio" is "the place."

<sup>21</sup> Registration No. 2811234 issued on February 3, 2004 based upon an application filed on October 2, 2001 claiming first use anywhere and first use in commerce at least as early as April 2000.

<sup>22</sup> Registration No. 2815267 issued to MetaTV on February 17, 2004 based upon an application filed on November 3, 1999 claiming first use anywhere and first use in commerce in class 38 at least

The Trademark Examining Attorney seemed to be looking for instances where the same mark was allegedly being used on the services contained in the heart of the cited registrations (e.g., Internet access and telecommunications services, online chat rooms and the electronic transmission of documents and data) as well as in services regarding the development of infrastructure for high productivity computing systems.

The owner of the CREEKPATH registration appears to be the closest to being in Applicant's field, namely, professional services focused on the development of "data storage systems." On the other hand, the services of the type Registrant markets to individual consumers, such as Internet access and chat rooms, are nowhere to be found in this registration.

Furthermore, we note that each of the owners of these individual registrations, judging only from the face of the registrations, deals with a relatively specialized and narrow target audience: viz., individuals and companies concerned with health care utilization (SELECT QUALITY CARE); interactive television for large enterprises (METATV); real estate developers of data centers (TERASPACE NETWORKS); and,

---

as early as May 7, 2000 and claiming first use anywhere and first use in commerce in class 42 at least as early as March 20, 2000.

computer repair and maintenance for individuals and small businesses (COMPUTER COMFORT). Finally, we suspect that the scale, and hence, breadth, of commerce in the field of information technology is quite different on the part of a British Virgin Islands corporation (EL SITIO) than is the case in the United States. Finally, Hitachi's TWX-21 technology is employed as a specialized electronic commerce product mark for the Business-to-Business (B2B) market.

Accordingly, although the Trademark Examining Attorney argues that Registrant's and Applicant's services are "closely related," these seven registrations seem to us a relatively weak reed upon which to support a finding of the relatedness of these respective services.

Similarly, six-pages of screen shots that the Trademark Examining Attorney took from the Internet on July 29, 2005, discuss in detail the business of Senticore, Inc. - a diversified public holding company with an emphasis in real estate, timber and sports entertainment. In December 2004, Senticore happened to purchase PokerBook Gaming Corporation as an investment opportunity. According to this website, Senticore's software development team redesigned PokerBook's non-downloadable gaming software in order that it could then be licensed to gaming operators worldwide. Senticore would

appear to be in neither Registrant's nor Applicant's fields of business.

The failure of the third-party registrations and this Internet evidence to show any relationship between the parties' respective services supports Applicant's contention that the services Applicant offers are completely different from those offered by Registrant - the owner of the cited marks.

In order to find such a difference, it is not necessary for us to narrow the scope of the cited registrations through a resort to extrinsic evidence, as applicant would have us do (i.e., to conclude from information drawn from a website apparently owned by Registrant that the cited marks belong to a company that runs a religious Internet portal prominently featuring scriptures, news and a chat room on its website).

Rather, the burden is on the Trademark Examining Attorney to show the relationships of the respective services, and based on this record, we find that she has failed to do so.

Instead, we find confusing the various attempts of the Trademark Examining Attorney to paint word pictures tying these services together. She postulates that because both

Registrant and Applicant "implement databases," the services of the parties are related.<sup>23</sup> Applicant responds that:

"the Examiner twists logic to reason that since data storage systems (about which Applicant consults) require databases and Registrant provides databases, therefore Applicant's consulting services regarding data storage systems and Registrant's databases are "complimentary." [sic] This is simply unsupported by the record, and strains the identification of the services to the point of breaking. The limited portion of the Cited Mark's identification of services that even includes databases is specifically 'providing an online computer database in the field of religion and spirituality.' There is no other mention of 'databases' in any portion of the Cited Marks' descriptions of services. There is nothing in the record, and it is devoid of logic, to suggest that a large-scale data storage system identified by Applicant's Mark would run on a religion and spirituality database as identified in the Cited Marks. The reference to a database in the Cited Marks' description most likely relates to a large database of articles and literature regarding religion and spirituality that can be accessed on its website. There is no relationship to data storage systems as in Applicant's description."

Applicant's reply brief at 4.

---

<sup>23</sup> "The respective parties both provide similar services with regards to the implementation of databases and software applications. Applicant's services include the assessment, design and maintenance of data storage systems. Such data storage systems rely on a structured database. Because registrant provides databases, such services are complementary and are likely to originate from a common source."

Trademark Examining Attorney appeal brief at 5.

Similarly, the Trademark Examining Attorney argues that "consumers who seek a service to have their data and documents electronically transmitted [referring to Registrant's services] may also need a data storage system for storing such data and documents." Trademark Examining Attorney appeal brief at 6. Again, we agree with Applicant that "this is a presumption with no evidence behind it and second it is irrelevant. If someone purchases a book, she might need to buy a lamp to read it with but this does not mean the two items are related, nor that anyone would be confused as to their source." Applicant's reply brief at 5.

Finally, the Trademark Examining Attorney contends that "applicant's use of the term, 'information technology' is so overly broad that it can encompass virtually all of the registrant's offered services." Trademark Examining Attorney appeal brief at 6. However, Applicant's recitation of services does not state that it "provides information technology." Rather, very specific terminology ["professional ... assessment and design of information technology systems for others ... [and] maintenance of information technology software and data storage systems for others"] identifies professional services targeting the development and maintenance of complex infrastructures for data storage systems. On this record, we agree with

Applicant that "[t]hese services are worlds away from the provision of internet hosting, temporary use of hosted databases and hosted software and chat rooms." Applicant's reply brief at 5.

Accordingly, we find that the Trademark Examining Attorney has not demonstrated the relationship of the respective services, and hence, that this critical *du Pont* factor favors the position of Applicant that there is no likelihood of confusion herein.

***The similarity or dissimilarity of established, likely-to-continue trade channels***

Applicant would have us narrow Registrant's market to Christian consumers. Based on this record, that may well be an accurate characterization of Registrant's primary market. However, in identifying the trade channels most relevant to our likelihood of confusion determination, we find more compelling Applicant's arguments about its own channels of trade. Looking only to the four corners of the involved application, we find that Applicant offers highly complex, professional services dealing with computerized data storage systems. The target audience is presumably corporate executives responsible for information technology, and information technology professionals comfortable in an ecosystem of high productivity computing. Whether or not

one restricts Registrant to a Christian audience, we find that the only overlap involves executives and IT professionals who are not likely to believe that the services of the Applicant and Registrant emanate from the same source. Accordingly, we believe that this *du Pont* factor weighs in favor of finding that there is no likelihood of confusion.

***The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.***

As seen above, the reality of the marketplace in which Applicant's mark is used necessarily frames our analysis. Only enterprises with highly specialized or complex computerized data storage systems would need to hire Applicant or one of its competitors. Given the obvious cost and complexity of Applicant's services, the relevant buyer class of these services is going to be composed of sophisticated, professional purchasers who make this contracting decision within their professional capacity. These decision makers will deliberate and evaluate competing proposals most carefully. It would require a high degree of sophistication simply to understand how these components will fit, if at all, into an enterprise's IT infrastructure. We agree with Applicant that the Trademark Examining Attorney failed to acknowledge appropriately the

sophistication of the potential purchasers of Applicant's services. Hence, this *du Pont* factor is an important factor under the relevant legal precedent, and clearly favors the position of Applicant herein.

***Period of contemporaneous use without actual confusion***

Finally, we turn to the *du Pont* factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. Although this is an intent-to-use application, Applicant argues that coexistence over a period of years provides strong evidence that confusion is not likely to occur in the future. As to whether there has been sufficient opportunity for confusion to occur, the record contains no indication of the level of sales or advertising by Applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an Applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of Registrant's use, and thus we cannot tell whether there has been sufficient opportunity for

confusion to occur, as we have not heard from the Registrant on this point.

All of these enumerated factors materially reduce the probative value of Applicant's argument regarding asserted lack of actual confusion. Therefore, Applicant's claim that no instances of actual confusion have been brought to Applicant's attention is not indicative of an absence of a likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

### **Conclusion: Likelihood of Confusion**

In conclusion, the *du Pont* factors favoring a finding of likelihood of confusion include the presumption that the respective services might move through the same channels of trade, and perhaps, the seeming variety of goods and services on which Registrant's mark is used. In reaching our determination, these factors are outweighed by the *du Pont* factors favoring a finding of no likelihood of confusion, namely, the different connotations and commercial impressions of the marks, the Trademark Examining Attorney's failure to demonstrate the relationship of the services, and

the relative sophistication of Applicant's purchasing class. Neutral factors include whether similar marks are used or registered for related goods, any indications of an absence of actual confusion over the past several years, and the renown of the cited mark.

*Decision:* The refusal under Section 2(d) of the Lanham Act is hereby reversed.