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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/424189

APPLICANT: Crosswalk, Inc.



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the final refusal to register the mark “CROSSWALK” for “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” (as amended) in International Class 42, on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

FACTS

Applicant, Crosswalk, Inc., applied to register the standard character mark “CROSSWALK” for use on “Professional services and support in connection with the assessment and design of information and data storage systems for others; design development and implementation of software; maintenance of software and data storage systems for others” in International Class 42. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) based on a likelihood of confusion with U.S. Registration No. 2805119 for the mark “CROSSWALK” (typed form) and U.S. Registration No. 2736979 for the mark “CROSSWALK.COM” (typed form) for “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; Computer services, namely electronic transmission of data and documents via computer terminals; providing telecommunications connections to a global computer network; providing bulletin boards and chat rooms featuring general news and information of interest to specific groups with specific self-defined interests.”

In addition, the applicant was required to provide a more definite identification of services. This appeal follows the Examining Attorney’s Final Refusal of July 29, 2005.

IDENTIFICATION

Applicant submitted an amendment to its identification in the appeal brief. While the proper procedure is to file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand, the applicant's identification amendment is accepted. TBMP Section 1205. Thus, the requirement for an acceptable identification has been satisfied. The examining attorney shall now refer to the applicant's services as "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."

ARGUMENT

THE MARKS OF APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR AND THE SERVICES OF THE PARTIES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks and similarity of the services.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the prior registrant and against the applicant who has a legal duty to select a mark that is

completely dissimilar to trademarks already being used. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

A. The Respective Marks are Highly Similar

The marks must be compared for similarities in sound, appearance, meaning or connotation. *Op.cit. E.I. du Pont de Nemours*. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of the mark may be recognized as more significant in creating a similar commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985).

In this case, the marks are either identical or nearly identical. The applicant's mark displays the term "CROSSWALK" in standard characters while the registrant's marks display the terms "CROSSWALK" and "CROSSWALK.COM" in typed form. Applicant has merely deleted ".COM" from registrant's mark. The TLD will be perceived by prospective customers as part of an Internet address, and, therefore, has no source identifying significance. *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). Thus, the TLD, ".COM" appearing in registrant's mark would be less significant in creating a commercial impression in the minds of consumers, and should be given little weight in comparing the respective marks.

If the marks of the respective parties are identical, as in this case, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); TMEP §1207.01(a).

Applicant argues that the respective marks have different connotations. Based upon extracts from what applicant believes as the registrant's website, applicant alleges that the cross inside the letter "o" found on the suspected website implies that registrant is using the term "cross" in order to signify a religious connotation. This is inapposite. Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and registrant is free to adopt any style of lettering, including that found on applicant's website.

Applicant also claims that even assuming the marks are similar, the cited marks are in a crowded field of "CROSSWALK" marks and are thus entitled to very narrow protection. The examining attorney disagrees. There are only three registered computer-related service marks in the registry- one being the applicant's and the other two are owned by registrant. Crosswalk is thus a relatively strong mark. Nonetheless, even if the cited marks are "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

B. The Services are Closely Related to the Registrant's Services

In establishing the relatedness of the services, it is noted that the goods and/or services of the parties need not be identical or directly competitive, especially when the respective marks are identical, to find a likelihood of confusion. Instead, the services need only be related in some manner, or the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

The applicant's identification of services, as amended in its Appeal Brief, is identified as "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."

The registrant's services are identified as "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; Computer services, namely electronic transmission of data and

documents via computer terminals; providing telecommunications connections to a global computer network; providing bulletin boards and chat rooms featuring general news and information of interest to specific groups with specific self-defined interests.”

The respective computer services are closely related. Services such as the designing, developing and maintaining of software, information technology and data storage systems, providing multiple user access to a global information network, providing temporary use of online non-downloadable software, and the electronic transmission of data and documents are likely to be encountered by the same purchasers. 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. In addition, consumers who seek a service to have their data and documents electronically transmitted may also need a data storage system for storing such data and documents. Likewise, companies that design, develop, implement and maintain software are likely to provide and market such temporary use of the software online, as well. Lastly, the applicant’s use of the term, “information technology” is so overly broad that it can encompass virtually all of the registrant’s offered services, including but not limited to, providing databases featuring general news and information, providing an online computer database in the field of religion and spirituality and providing bulletin boards and chat rooms featuring general news and information of interest to specific groups with specific self-defined interests. Such services rely on the design of an application layer that is directly connected to a database.

Therefore, confusion as to source is likely because consumers will use or encounter these related services in the same marketplace. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

In her final Office Action, the examining attorney made of record several third-party registrations showing the applicant and registrant's services are often provided by the same party under the same mark. As shown by Registration Nos. 2285699, 2111973, 2672390, 2337135, 2770539, 2815267, 2572097, 2701879, and 2811234, providing multiple user access to global computer networks, electronic transmission of documents and data, telecommunication services through the access to global computer networks, and/or providing online chat rooms AND the design, development and maintenance of computer software, information technology and data storage systems are the type of services that originate from a common source. Please see attachments in the Examining Attorney's final Office Action dated July 29, 2005. These printouts have probative value to the extent that they serve to suggest that the services listed therein are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001).

As an example, the examining attorney has also made of record trade channel evidence of a company that has both designed (or redesigned) a software and provided such use of the non-downloadable software online. See final Office Action dated July 29, 2005. Such evidence demonstrates the conditions surrounding the marketing of the services are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a single or related source.

Based on a website allegedly owned by registrant, applicant asserts that the cited marks are used in connection with religious services and marketed exclusively to individuals and religious organizations. This is without merit. First, no evidence was submitted to substantiate ownership of the website and not all services were identified on the website. Second, likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Other than one minor portion of registrant's identification, namely, providing an online computer database in the field of religion and spirituality, registrant's services are identified broadly. Thus, it is presumed that the registration encompasses all goods and/or services of the type described, including those in the applicant's identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP §1207.01(a)(iii). It is also important to note that applicant's identification does not limit its channels of trade and is available to all potential customers, including the purportedly "religious" consumers that applicant claims are targeted by registrant.

Furthermore, any services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). In this instance, it has already been established that services such as software development, design and maintenance and providing multiple user access to a global computer information network are found in the same channels of trade and within the registrant's normal field of expansion. It is not uncommon for companies that provide Internet portals, databases, search engines, data

transmissions, Internet connections, bulletin boards, chat rooms and use of online non-downloadable software to also provide software maintenance and technical support services for its consumers.

Applicant states that its advice and consultation services regarding information technology and data storage services are marketed to and purchased by sophisticated consumers. As acknowledged above, applicant's identification is not limited to any particular trade channels and is available to all potential customers. Moreover, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); TMEP §1207.01(d)(vii). In addition, even sophisticated purchasers may not be aware of the range of services offered by a party. Consequently, if such computer related services were to be marketed under the same or similar marks, confusion as to source or sponsorship would be likely.

Finally, the applicant argues that despite registrant's use since September 1998, confusion is not likely because both marks have been concurrently used in the marketplace without instances of confusion for "several" years, namely, since the middle of 2004. The applicant's affirmations are without merit. 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. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), as cases cited therein.

CONCLUSION

Because the marks are essentially identical and the services can be found in the same overlapping channels of trade, marketed to the same or similar purchasers, and the type that emanates from a common source, prospective customers are likely to believe that the services originate from the same source. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register under Section 2(d) of the Trademark Act.

Respectfully submitted,

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