

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/533102

APPLICANT: Matrix Operations Company, LLC

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BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL

MARK: MATRIX PLUS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

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

Applicant:	Matrix Operations Company, LLC	:	BEFORE THE
Trademark:	MATRIX PLUS	:	TRADEMARK TRIAL
Serial No:	78/533102	:	AND
Attorney:	JENNIFER L. CERCE	:	APPEAL BOARD
Address:	MAIELLO, BRUNGO & MAIELLO, LLP ONE CHURCHILL PARK 3301 MCCRADY ROAD PITTSBURGH, PA 15221	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed from the Trademark Examining Attorney's final refusal to register the mark MATRIX PLUS & design for "Computer software for use by the media industry encompassing television, cable, print, online and radio media sources for the development, execution and monitoring of successful sales strategies which permit the user to download historical and prospective sales data directly from traffic systems thereby providing up-to-date sales information" pursuant to Section 2(d) of the Trademark Act. The examining attorney refused registration on the Principal Register because the applicant's mark is likely to be confused with the mark in Registration No. 1725130 for MATRIX, which is used on "computer program and software, all of which is used in the marketing/marketing research environment to facilitate understanding, analysis and implementation of sales and marketing data."

PROCEEDING BELOW

The applicant filed Application Serial No. 78/533,102 on December 28, 2004 to register the mark MATRIX PLUS & design for "Computer software for use by the media industry encompassing television, cable, print, online and radio media sources for the development, execution and monitoring of successful sales strategies which permit the user to download historical and prospective sales data directly from traffic systems thereby providing up-to-date sales information" in International Class 9. In its application, the applicant disclaimed the term PLUS as descriptive. On July 25, 2005 the examining attorney refused registration under Trademark Act Section 2(d), because the applicant's mark is likely to be confused with the mark in Registration No. 1,725,130 for MATRIX, which is used on "computer program and software, all of which is used in the marketing/marketing research environment to facilitate understanding, analysis and implementation of sales and marketing data." On January 23, 2006, the applicant responded to the Office Action by arguing against the refusal to register the mark under Section 2(d). The examining attorney was unpersuaded by the applicant's arguments, and on October 26, 2006, issued a final refusal.

ISSUE

Whether or not the applicant's mark, MATRIX PLUS is confusingly similar to the mark in Registration No. 1725130 for MATRIX when used on related software, namely "computer software for use by the media industry encompassing television, cable, print, online and radio media sources for the development, execution and monitoring of successful sales strategies which permit the user to download historical and prospective sales data directly from traffic systems thereby providing up-to-date sales information" and "computer program and software, all of which is used in the marketing/marketing research environment to facilitate understanding, analysis and implementation of sales and marketing data."

ARGUMENTS

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

I. THE MARKS ARE CONFUSINGLY SIMILAR AS SOURCE INDICATORS

The applicant and the registrant use the identical term MATRIX. The applicant includes the term PLUS, which, the applicant argues, serves to distinguish it from the registrant's mark. The term PLUS is frequently added to trademarks to denote an improved or advanced version of the goods. See the previously attached registrations showing excerpts of third party registrations such as COLORFROST and COLORFROST PLUS and RXSCAN and RXSCAN PLUS. Thus, even if consumers were to notice the differences in the respective marks, they will believe that due to the shared term MATRIX the software offered by registrant under its mark represents an enhanced or updated version of the software offered by the registrant.

Further, a disclaimed term such as PLUS is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, the term MATRIX is clearly more significant in creating a commercial impression. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). However, when the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956).

The addition of the design matter in the applicant's mark does not change the general impression of the mark for comparison purposes. If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or

services. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). The design element sits in between the wording in the applicant's mark but is not incorporated with the wording in such a way that it changes the commercial impact of the term MATRIX. The design element adds less to the mark's source-indicating commercial impression than does the word MATRIX.

The applicant argues that MATRIX appears to be weak mark, and has provided registrations using the term MATRIX in order to demonstrate the widespread usage of the term. However, the examining attorney must determine whether the goods are similar or related or, in this case, whether the specific software functions are similar or related or would be found in similar channels of trade. The applicant has not provided any registrations for the mark MATRIX used on software providing functions in the fields of sales and marketing. Therefore the term cannot be considered particularly for weak for similar software in this field. Even if applicant has shown that the term MATRIX is "weak," the mark is still entitled to protection against registration by a subsequent user of the term MATRIX for use on sales and marketing-specific software. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

II. THE GOODS OF THE APPLICANT AND REGISTRANT ARE HIGHLY RELATED

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be 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. *Online Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The registrant's software is used to facilitate understanding, analysis and implementation of sales and marketing data. The applicant's software is used to analyze sales data and provide the user with sales strategies. The software programs in question provide similar, if not identical, functions. The applicant argues that the goods are used for different purposes and in different markets, citing evidence from the registrant's website describing the services provided by the registrant. However the evidence provided by the applicant does not describe the specific software registered by the applicant in any detail. The likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration only. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The evidence provided by the applicant as to the scope of use for its

goods must be discounted by the examining attorney, who must rely solely on the identification of goods in the registration. There is no language in the registrant's identification of goods indicating that usage of the software is limited to any specific industry. The examining attorney therefore must presume that the registration encompasses software that may be used in all settings, including the media industry.

Any goods in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or 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 case, the test is whether purchasers would believe that software featuring industry specific sales data functions is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). Given the broad nature of the registrant's identification of goods, there is nothing to preclude a potential customer from believing that the registrant's software could be used in the media industry.

Overall, applicant's mark and the registered mark conveys the same commercial impression and, to the extent that customers would note the differences between applicant's mark and the registered marks, they would view applicant's mark as a variation of the registered mark, with both of them indicating a single source of the software.

CONCLUSION

For the foregoing reasons, it is respectfully urged that the refusal, pursuant to Section 2(d) of the Trademark Act, to register the applicant's mark MATRIX PLUS & design on the ground it so resembles the mark MATRIX under Registration No. 1,725,130 as to be likely to cause confusion or mistake, is proper and should be affirmed.

Respectfully submitted,

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