Mailed:
June 5, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Dynamic Edge, Inc.

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Serial No. 78760920

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Christopher J. Falkowski of Falkowski PLLC for Dynamic Edge, Inc.

Robin S. Chosid-Brown, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Zervas, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Dynamic Edge, Inc. filed a use based application for the mark DE and design, shown below, for a wide variety of computer related services including, *inter alia,* application service provider, namely, hosting computer software applications of others, computer network design for others, computer security services, namely, restricting access to and by computer networks to and of undesired websites, media, individuals and facilities, computer services, namely, monitoring and reporting on the performance, availability, and errors of websites for

others, computer services, namely, managing websites for others, computer services, namely, monitoring the websites of others to improve scalability and performance of websites of others, customization of computer hardware and software, design and development of online computer software systems, technical support services, namely, trouble shooting of computer hardware and software problems, computer site design, computer software consultation, computer software design for others, and computer software development, in Class 42 (Serial No. 78760920).

Applicant described its mark as a "stylized design of a circuit board used in conjunction with the letters D and E."

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, used in connection with the services described in its application,

is likely to cause confusion with the mark DE and design, shown below, for "computer site design; computer software consultation; computer software design for others; computer software development," in Class 42,[1] and "computer software used for the security, monitoring and management of websites, networked web pages and other operating software systems used for machine to machine interaction over a network," in Class 9.[2]

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or

[1] Registration No. 2662972, issued December 17, 2002.
[2] Registration No. 3087918, issued May 2, 2006.

dissimilarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity and nature of the goods and services.

It is well settled that the services of the applicant and the goods and services of the registrant do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Moreover, in an *ex parte* appeal, likelihood of confusion is determined on the basis of the services as

they are identified in the application and the goods and services as they are recited in the registrations. *In re Elbaum,* 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.,* 190 USPQ 47, 48 (TTAB 1976). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.,* 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In its application, applicant includes all of the services described in Registration No. 2662972 ("computer site design; computer software consultation; computer software design for others; computer software development"). Therefore, applicant's description of services is identical in part to the registrant's description of services.

With respect to Registration No. 3087918, the description of registrant's software is "computer software used for the security, monitoring and management of websites, networked web pages and other operating software

systems used for machine to machine interaction over a network." In essence, it is software for managing websites and computer networks. Applicant is seeking to register its mark for application service provider services, including monitoring and reporting on the performance, availability, and errors of websites of others, managing and monitoring websites for others, as well as customization of computer hardware and software and troubleshooting of computer hardware and software problems. In essence, applicant is managing websites for others. Accordingly, we find that applicant's services and registrant's software are complementary because they could be used together. Applicant is seeking to register its mark for managing websites for others while the registrant's mark is for software used to manage websites. Accordingly, applicant's services are sufficiently related to the registrant's software as to be likely to cause confusion if they are marketed under similar marks.

B. The similarity or dissimilarity of established, likely-to-continue channels of trade and classes of consumers.

Because there are no restrictions as to trade channels and classes of consumers in the application or the cited registrations, we presume that the goods and services move in all normal trade channels for such goods and services

and are sold to all normal classes of purchasers for such goods and services. *In re Elbaum,* 211 USPQ 639, 640 (TTAB 1981). *See also In re Smith and Mehaffey,* 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Having previously found that the services in Registration No. 2662972 are in part identical to the services in the application, we find that applicant's services and registrant's services move in the same channels of trade and are sold to the same classes of consumers.

With respect to registrant's software, we have found that applicant's services and registrant's software are complementary, and therefore they could be marketed to the same classes of customers. For example, consumers using registrant's software may be interested in retaining applicant (or another application service provider) to manage their websites and computer network or to customize and troubleshoot their software. Accordingly, we find that the channels of trade and the classes of consumers are the same.

C. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v.*

Oliver & Winston, Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer would be someone who licenses software for the security, monitoring, and management of websites and computer networks and who would engage a contractor to manage its websites and computer networks.

Finally, in comparing the marks, we are mindful that where, as here, the services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

The marks are set forth below.

Applicant's Mark	Registrant's Mark
	

The similarity in the appearance of the marks outweighs any differences in their appearance. Both marks consist of the white letters "De" superimposed on a square, black background. The fact that the letters in applicant's mark appear as D_e as opposed to the D^e displayed in registrant's mark does not diminish the similarity of the commercial impression engendered thereby. Also, applicant's circuit board design is not sufficient to distinguish the marks because the black background dominates applicant's mark.

Because both marks consist of the letters DE, they have the identical sound.

There is nothing in the record that indicates that the letters DE have any significance when used in connection with the applicant's services or the registrant's software and services. Accordingly, the marks are arbitrary when used in connection with the goods and services at issue, and therefore their meaning is the same.

Considering the similarities between the marks, a purchaser who sees one mark and later encounters the other is likely to view the marks as variations of each other, representing a single source. Accordingly, we conclude that the marks of the applicant and the registrant are similar in appearance, sound, meaning, and commercial impression.

D. The conditions under which sales are made.

With respect to the conditions under which sales are made, applicant made the following argument:

> Both the Appellant's Mark and the two Cited Marks are associated with information technology services and products purchased by business entities, not consumers. IT expenses constitute a growing expense for large and small businesses. Purchasers of IT services often involve comprehensive Requests for Proposal ("RFPs") and other forms of due diligence. In short, there is every reason to believe that the applicable market for all three marks consists of sophisticated non-impulse purchasers. Such purchasers are not likely to be confused by any similarities between Appellant's Mark and the Cited Marks.[3]

Unfortunately, applicant does not provide any evidence regarding the decision process used by these careful and sophisticated purchasers, the role trademarks play in their

[3] Applicant's Brief, pp. 11-12.

decision making process, or how observant and discriminating they are in practice. *See In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 60, 70 (TTAB 1983) ("Unfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence"). Moreover, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812, 1814 - 1815 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). However, as indicated above, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. In this regard, licensing software to manage a company's website or computer network and/or engaging a contractor to manage a company's website or computer network typically are not impulse decisions. Accordingly, the conditions under which sales are made is a likelihood of confusion factor that weighs slightly against finding that there is a likelihood of confusion.

E. Balancing the factors.

Having found that applicant's services are in part identical to registrant's services and complementary to registrant's software, that applicant's services and

registrant's software and services move in the same channels of trade and are sold to the same classes of consumers, and that the marks are similar, we conclude that applicant's mark, DE and design, for the services set forth in Class 42, is likely to cause confusion with the registrant's mark DE and design, for "computer site design; computer software consultation; computer software design for others; computer software development," in Class 9, and for "computer software used for the security, monitoring and management of websites, networked web pages and other operating software systems used for machine to machine interaction over a network," in Class 42. Based on the record before us, the fact that relevant consumers may exercise a high degree of care does not outweigh the other relevant likelihood of confusion factors.

Decision: The refusal to register applicant's mark is affirmed.