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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79152257

MARK: ENERGYWORX



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Energyworx Solutions & Services B.V

CORRESPONDENT'S REFERENCE/DOCKET NO:

0064.31-TM

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1216597

The applicant, Energyworx Solutions & Services B.V., appeals a refusal to register the applied-for mark in Application Ser. No. 79152257, pursuant to Trademark Act Section 2(d), 15, U.S.C. §1052(d), because of a likelihood of confusion with the mark in U.S. Registration No. 2304418.

Facts and Background

The applicant seeks under the Madrid Protocol extension of protection and registration in the United States of its mark “ENERGYWORX” in a stylized form with color, for the following goods and services:

- International Class 9: Computer software, namely, computer programs for electronic data processing and transmission; computer software used for data aggregation and analytics for the energy and utilities industry;
- International Class 38: Telecommunications services, namely, transmission of data from sensors and meters used in the field of energy and utilities industry via cellular telephone, internet, and satellite;
- International Class 42: Application service provider, namely, providing, hosting, managing, developing and maintaining software, web sites and databases in the field of data aggregation and analytics within the energy and utilities industry; providing on-line, non-downloadable software as a services for data collection from metering equipment, sensors and other software systems.

On October 1, 2014, the examining attorney issued an Office action requiring that the applicant provide an accurate description of the color mark and amend the identifications of goods and services. After receiving applicant’s March 24, 2015, response, the examining attorney conducted additional searches of the Trademark Office’s database given that the applicant’s response addressed with greater particularity the nature, purpose, and subject matter of its goods and services. On April 8, 2015, the examining attorney issued another Office action, maintaining the previous requirements concerning the

mark description and some regarding the identifications. Furthermore, the examining attorney refused registration for the first time under Trademark Act §2(d) citing three registered marks.

The applicant responded on October 7, 2015, and successfully addressed the mark description requirements. However, the applicant's arguments concerning the refusal under §2(d) were only persuasive as to two of the cited marks. Therefore, on October 27, 2015, the examining attorney issued a final refusal, maintaining the likelihood of confusion refusal regarding one of the three registered marks initially cited, U.S. Registration No. 2304418 ("ENERGYWORKS"). The examining attorney also maintained requirements that the applicant sufficiently clarify the identifications of goods and services. On January 27, 2016, the applicant requested reconsideration of the refusal and requirements. On February 29, 2016, the examining attorney accepted the amendments to the identifications in the request for reconsideration, but maintained the likelihood of confusion refusal based on U.S. Registration No. 2304418, which features the following live identifications of services:

- International Class 37: installation of energy systems, construction of power plants;
- International Class 39: distribution and transmission of electrical power;
- International Class 42: energy management services, and energy design and engineering services, providing energy auditing and feasibility studies, product research and development, research in the energy field, development of projects in the energy field.

This appeal followed, and the refusal under §2(d) is the sole issue on appeal.

Issue

THE APPLICANT'S MARK CREATES A CONFUSINGLY SIMILAR COMMERCIAL IMPRESSION TO THE CITED REGISTERED MARK, AND THE PARTIES' GOODS AND SERVICES ARE CLOSELY RELATED, SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(d).

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis, and in the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion. *See also* TMEP §1207.01 *et seq.* Among these factors are the similarity of the marks as to appearance, sound, meaning, and overall commercial impression, the relatedness of the goods and/or services, and the similarity of trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq.* Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

Applying the most relevant *du Pont* factors in this case, the applicant's mark conveys a very similar overall commercial impression as that conveyed by the cited registered mark, there is no evidence of other similar marks in use for similar goods or services, and the parties' goods and services

are related in purpose and will likely be marketed in similar trade channels to overlapping groups of consumers.

Similarity of the Parties' Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); TMEP §1207.01(b).

In this case, the applicant's mark "ENERGYWORX" creates a confusingly similar overall source impression with the cited registered mark "ENERGYWORKS". Both marks combine two words into one term, the first being the word "ENERGY". The second portion in each mark—"WORX" and "WORKS"—are phonetically equivalent as the "X" sound is identical to the sound of "KS"; the applicant's mark appears to intentionally misspell the word "works" to create its mark. For these reasons, the marks are essentially indistinguishable in sound and apparent meaning, and very similar in their appearance.

The applicant's only makes one argument challenging the similarities of the marks in a side-by-side comparison, namely, that its mark features "distinctive" stylization. However, this argument is not persuasive. In addition to the intentional misspelling, the applicant's mark features color and some stylization of the letter font, but features no figurative elements that convey any additional or

transcendent mental impression. Furthermore, the cited registered mark is a typed mark. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 101 USPQ2d at 1909; TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). Furthermore, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016).

The applicant argues that the registered mark is deserving of lesser protection for two related reasons. First, the applicant argues that “ENERGYWORKS” is descriptive or at least highly suggestive of the associated services, and is therefore a weak mark. This line of argument is not persuasive. The argument borders on a collateral attack on the validity of the registered mark, but evidence and arguments that constitute a collateral attack on a cited registration are not relevant during ex parte prosecution. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); TMEP §1207.01(d)(iv). Moreover, the argument that the registered mark is inherently weak may just as

easily be made concerning the applicant's mark, which creates a nearly indistinguishable commercial impression in sound and meaning, and is used for related goods and services.

The applicant also argues that "ENERGYWORKS" is weak due to the presence of similar registered marks featuring the terms "energy" and "work" for related goods and services. This line of argument is not persuasive, as the third-party marks referenced by the applicant, "ENERGY WORKBENCH", "@ENERGY/POWERWORKS", and "ENERGY@WORK", are much more easily distinguished from the marks at issue in this appeal. The other marks feature additional wording and different overall construction that is more significant than the minor stylization and spelling differences between the applicant's mark and the cited registered mark. Finally, it should be noted that the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is "to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong mark'"); TMEP §1207.01(b)(ix).

Accordingly, the applicant's mark "ENERGYWORX" creates an overall commercial source impression that is nearly indistinguishable from the cited registered mark "ENERGYWORKS". Consumers encountering the marks in the same commercial channels are very likely to confuse the marks and mistake the underlying sources of related goods and services provided under the marks. Further, it is noted that where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and services needed to support a finding of

likelihood of confusion declines. See *In re i.am.symbolic, Llc*, 116 USPQ2d 1406, 1411 (TTAB 2015); TMEP §1207.01(a).

Relatedness of the Goods and Services Provided under the Marks

When analyzing an applicant's and registrant's goods and services for similarity and relatedness, the determination is based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d at 1323, 110 USPQ2d at 1162. Therefore, absent restrictions in an application and/or registration, the identified goods and services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d at 1362, 101 USPQ2d at 1908 (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

The applicant's goods and services are related to the services provided by the cited registrant because they serve the same industry and are thus likely to be marketed to overlapping groups of consumers in the same commercial channels. Again, the applicant identifies the following goods and services:

- International Class 9: Computer software, namely, computer programs for electronic data processing and transmission; computer software used for data aggregation and analytics for the energy and utilities industry;

- International Class 38: Telecommunications services, namely, transmission of data from sensors and meters used in the field of energy and utilities industry via cellular telephone, internet, and satellite;
- International Class 42: Application service provider, namely, providing, hosting, managing, developing and maintaining software, web sites and databases in the field of data aggregation and analytics within the energy and utilities industry; providing on-line, non-downloadable software as a services for data collection from metering equipment, sensors and other software systems.

The identifications of services in the cited registration for “ENERGYWORKS” are as follows:

- International Class 37: installation of energy systems, construction of power plants;
- International Class 39: distribution and transmission of electrical power;
- International Class 42: energy management services, and energy design and engineering services, providing energy auditing and feasibility studies, product research and development, research in the energy field, development of projects in the energy field.

While not identical, the goods and services provided by the applicant and registrant are nevertheless related given their common application to the energy industry. Furthermore, whereas the applicant’s goods and services all serve to facilitate energy data collection and analysis, the registrant’s services in International Class 42 in particular serve to foster management, auditing, and research in the energy field, likely necessitating data collection and analysis. In any case, the goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). Rather, the respective goods and services need only be “related in some manner and/or if the circumstances surrounding their

marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i). All circumstances surrounding the sale of the goods and services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973).

The applicant challenges the relationship of the parties’ goods and services, first by assessing the nature of the companies and their operations. The applicant describes the registrant as “a traditional engineering, procurement, and construction (EPC) company.” Appeal Brief at 10. This description reasonably tracks the identifications of services in the registration. The applicant looks to the registrant’s website to further explain that the registrant “carries out detailed engineering design of energy related projects, procures all the equipment and materials and then constructs to deliver a functioning facility to its clients.” *Id.* at 11. In contrast, the applicant states that rather than “supply infrastructure components and metering equipment [or] install these for customers...Applicant merely receives data from its customers which can be grid operators, energy retailers, energy producers, or the like, that Applicant processes and analyzes. *Id.* at 11-12. The applicant concludes that the differences between the businesses “can be distilled to Applicant only supplies data intelligence services using data from energy and utility companies...and Registrant delivers hardware equipment for infrastructure and implementation/installation of that infrastructure mainly in wind and bio energy industries.”

The applicant's analysis of the respective business activities appears accurate, albeit somewhat incomplete regarding the registrant's ancillary activities as discussed below. Most importantly, the applicant's analysis only bolsters the assertion that the parties' operate in the same industry and share potential customers. The registrant's services are focused more on the physical aspects of energy plants and installations, while the applicant's products and services focus on data gathered from those exact sorts of energy facilities and elsewhere along the energy use supply chain. The registrant's prospective consumers are energy utilities that generate power in the facilities that registrant helps construct, power companies that purchase, transmit, and re-sell to end consumers the energy that the registrant helps transmit, and third-party facilities that require outsourced management of their energy concerns. 02/29/2016 Reconsideration Letter, TSDR 8-13. Similarly, the applicant's prospective consumers are the same sorts of energy utilities and power companies, as the applicant addresses their need for data about costs and consumption. See, for example, the evidence from the applicant's website indicating that the applicant's products and services are marketed to "any organization within the energy and utility industry" needing insights from energy data, such as from grids and meters. *Id.* at TSDR 30. For these reasons, given the lack of limits on the prospective purchasers within the identifications as well as the additional extrinsic evidence that both parties market their businesses to all sorts of consumers along many points of the energy supply chain, the goods and services clearly travel the same commercial channels and appeal to overlapping groups of consumers.

In addition to operating in the same industry and sharing overlapping consumers, the applicant and registrant provide goods and services that other parties' often bundle together. Thus, consumers are likely to expect the services to be provided by a similar source. First, it should be noted that the registrant's energy management services appear to include energy data monitoring activities of the kind more expressly identified as a key function of the applicant's products and service activities. *Id.* at TSDR

10-11. Thus, the applicant's services are essentially complementary to the registrant's services in that the registrant offers these as incidental to the overall management services. Furthermore, the examining attorney includes in the record several examples of third parties that expressly offer the kinds of physical construction, installation, and engineering services of the kinds provided by the registrant as well as the data gathering, monitoring, and analysis of the kinds provided by the applicant's software products and services. For example, U.S. Registration No. 4845006 and the associated website for Sunpower Corporation shows that this business provides software for energy monitoring and management, services of energy usage management information services, installation of solar energy systems, design and engineering of energy systems, remote monitoring, metering, and data analysis of such systems. *Id.* at TSDR 31-45. These services are a mix of the kinds of goods and services provided by both applicant and registrant in this case. U.S. Registration No. 4905978 and the associated website evidence for Vedero Software, Inc. shows that this business provides physical installation of electrical energy management systems and engineering services for such systems as well as provides computer hardware and software-based services for energy management, monitoring, meter reading, and data analysis. *Id.* at TSDR 53-57. U.S. Registration No. 4770300 and the associated website evidence for Enable Midstream Partners, LP, shows that this business provides software-based energy monitoring, installation of energy infrastructure, data transmission services, distribution of energy, and services of providing web-based information about energy, including monitoring and procurement. *Id.* at TSDR 58-65. U.S. Registration No. 4636518 and the associated website evidence for South Jersey Industries shows that this company provides energy system engineering and design, energy distribution, and software platforms for energy utility data management and analysis. *Id.* at TSDR 66-74. The record contains additional evidence similar to this and demonstrates that companies that provide services of the kinds provided by the cited registrant – energy system engineering, installation, and construction, energy distribution, and/or energy management – also often provide goods and services of the kinds

provided by the applicant, such as software-based energy data gathering, monitoring, and analysis and energy data transmission. *Id.* at TSDR 75-110. For these reasons, the parties' goods and services are demonstrably complementary, likely to appear in the same commercial channels, and likely to be perceived by consumers as commonly emanating from a single source.

The applicant finally argues that confusion is unlikely because the relevant consumers are sophisticated and deliberative in their purchasing decisions. First, the applicant argues that the intended consumers are considered professional and commercial purchasers. This argument is not sufficiently supported by the evidence of record. While some of the kinds of entities that seek out the goods and services offered by applicant and registrant may be very knowledgeable in their fields, there are prospective consumers that may not be as directly involved in the energy industry and rather rely on providers like the applicant and registrant for their expertise. For example, the evidence from the registrant's website indicates that consumers as varied as "shopping centers", "dairy, poultry, and swine operations", and "healthcare facilities" may also benefit from the outsourcing to the registrant of energy management services. *Id.* at TSDR 8-11. These kinds of consumers are not likely as sophisticated in the field of energy in the same way that the applicant and registrant are. Furthermore, the applicant's argument fails to appreciate the fact even if purchasers are sophisticated and knowledgeable in a particular field, this does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163-64.

The applicant also argues that the high costs and time horizons of some of the services provided by the registrant ensures a degree of deliberation that would lessen the concern of confusion. This

argument is not persuasive, as the applicant only considers the extremely expensive engineering and construction services provided by the registrant. The applicant neglects that the registrant also offers what appear to be more modest outsourcing energy management services to third parties that are not as extensive in their time or financial commitments. Furthermore, even if the applicant's sophistication argument is accepted, it addresses only the consumers of the registrant's services. The applicant's products and services need not be as costly and may thus invite less deliberative consumers. Moreover, as discussed above, there is clear overlap in the kinds of providers that offer the array of products and services marketed by the applicant and registrant here. Therefore, even sophisticated consumers may expect the same entities to operate in the parties' respective fields. Here, where the marks are nearly indistinguishable, it would take a significant degree of sophistication to not confuse the marks for such related goods and services.

Consequently, consumers are likely to encounter the goods and services provided by the applicant and registrant in the same channels of commerce. The respective consumers of the goods and services appear to overlap given the lack of limitations in the identifications and the fairly broad scope suggested in the parties' respective marketing materials. Given the strong similarities between the marks at issue, consumers encountering the parties' goods and services are very likely to confuse the marks and mistake the underlying sources of the goods and services provided under the marks. Furthermore, the overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d at 1265, 62

USPQ2d at 1003. Therefore, the examining attorney respectfully requests that the Board affirm the refusal to register under Trademark Act §2(d).

Respectfully submitted,

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