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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 85561168 |
| Applicant | BrightPlanet Corporation II, Inc. |
| Applied for Mark | DEEP WEB INTELLIGENCE |
| Correspondence Address | TYE BIASCO PATTERSON THUENTE CHRISTENSEN ET AL 4800 80TH SOUTH 8TH ST, 4800 IDS CTR MINNEAPOLIS, MN 55402 UNITED STATES trademark@ptslaw.com |
| Submission | Reply Brief |
| Attachments | 4335.14US01.pdf(106370 bytes) |
| Filer's Name | Tye Biasco |
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| Signature | /Tye Biasco/ |
| Date | 01/03/2014 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: BrightPlanet Corporation II, Inc.

Serial No.: 85/561,168

Filed: March 6, 2012

Examining Attorney: Jeffery C. Coward

Law Office: 106

Mark: DEEP WEB INTELLIGENCE

Docket: 4335.14US01

APPLICANT'S BRIEF ON APPEAL

MAIL STOP: TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant appeals from the Examining Attorney's Office Action of February 26, 2013 that maintains and continues the final refusal to register the above-identified pending application for registration on the Principal Register. Attached hereto is Applicant's Brief on Appeal.

APPLICANT'S MEMORANDUM IN SUPPORT OF BRIEF ON APPEAL

I. DESCRIPTION OF THE RECORD

Applicant filed an application for registration of the mark DEEP WEB INTELLIGENCE in the United States Patent and Trademark Office on the Principal Register on March 6, 2012.

In an Office Action dated June 26, 2012 the Examining Attorney refused registration of Appellant's mark DEEP WEB INTELLIGENCE, asserting a likelihood of confusion with U.S. Registration No. 2,285,994 for WEB INTELLIGENCE and arguing that Appellant's mark was

merely the cited mark with the modifier DEEP. The Examining Attorney also asserted that the services associated with the Appellant's mark, DEEP WEB INTELLIGENCE, are related to the goods associated with the cited mark. The Examining Attorney also objected to the specimen of use filed for International Class 042 and required clarification of the identification of services to place the services under International Class 042 or 039. The Examining Attorney also requested clarification of the disclaimer to "DEEP WEB."

In response to the June 26, 2012 Office Action, Appellant addressed the Examining Attorney's contention that there is a likelihood of confusion between the cited mark and Appellant's mark by explaining, with evidence, the significant difference between the WEB and the DEEP WEB. Appellant further explained and showed with evidence that the goods covered by the cited mark were expressly different from the goods and services related to Appellant's mark. The response also amended the description of its goods and services under International Class 042 as recommended by the Examining Attorney to goods "computer services in the nature of data mining and harvesting high quality unstructured content from the Deep Web for use in research, analysis, monitoring, and tracking" and submitted a substitute specimen of use. The response also clarified the disclaimer to apply to the term "DEEP WEB" as requested by the Examining Attorney.

In a Final Office Action dated February 26, 2013 the Examining Attorney again refused registration of Appellant's DEEP WEB INTELLIGENCE mark, the Examining Attorney maintaining the assertion that Appellant's mark is merely the cited mark of Registration No. 2,285,994 with the modifier DEEP. The Examining Attorney also argued that the cited mark is not limited to the SURFACE WEB as contended by Appellant because the identification of goods related to cited mark does not use such a limitation. The Examining Attorney concluded

that, even if there is a difference between the DEEP WEB and SURFACE WEB, that there is a likelihood of confusion because the same consumers would use the services of the registrant and Appellant with the DEEP WEB being a subset of the WEB.

Appellant subsequently filed a Request for Reconsideration on August 26, 2013 in which Appellant again explained that, while the cited mark does not use the term “SURFACE WEB,” it is so limited because it is expressly limited to “relational databases” (i.e., structured data). Appellant noted that its goods and services are used for searching data not found in relational databases (i.e., unstructured data) and, therefore, the respective areas of the internet are exclusive to one another. In support of its argument, Appellant included as evidence a white paper that explains the significant difference between searching relational databases versus searching unstructured data of the Deep Web. Appellant also demonstrated, with evidence, the sophistication of the consumers of Appellant’s goods and services and the significant differences in channels of trade between Appellant’s goods and services and the goods of the cited mark. Finally, Appellant showed that the cited mark is not distinctive and provided evidence of registrations in International Class 009 for both THE SOCIAL WEB BROWSER and WEB BROWSER.

On October 29, 2013, the Examining Attorney denied the Request for Reconsideration. The Examining Attorney stated that Applicant’s request did not resolve outstanding issues. The Board resumed Applicant’s appeal on November 4, 2013.

II. STATEMENT OF THE ISSUES

The issue presented in this appeal is whether there is a likelihood of confusion under 15 U.S.C. § 1052(d) between Appellant’s DEEP WEB INTELLIGENCE mark and the mark

shown in U.S. Registration No. 2,285,994. If there is no likelihood of confusion, then Applicant's DEEP WEB INTELLIGENCE mark is registerable.

III. RECITATION OF THE FACTS

The relevant facts in this proceeding include the identification of goods listed in the Application, specifically the express limitations of customers/channels of trade, and the significant difference between the Deep Web and relational databases. These facts establish that there is no likelihood of confusion between Appellant's DEEP WEB INTELLIGENCE mark and those shown in U.S. Registration No. 2,285,994.

A. Applicant's Identification of Goods.

Appellant seeks registration on the Principal Register of its mark DEEP WEB INTELLIGENCE for computer software that provides automated search and extraction, storage, and analytics of information harvested from the Deep Web; computer software that provides a web interface used in the harvesting of information from the Deep Web in International Class 009 and computer services in the nature of data mining and harvesting high quality unstructured content from the Deep Web for use in research, analysis, monitoring, and tracking in International Class 042

B. Registrations Cited by Examining Attorney.

U.S. Reg. No. 2,285,994 WEB INTELLIGENCE

Computer programs for use in allowing end-users to access, query and analyze via a global computer network information stored in relational databases and for use in allowing end-users to formulate queries and instruction manuals therefore sold as a unit in International Class 009.

IV. ARGUMENT

A. Applicant's Goods and Services Are Expressly Distinct From the Goods of the Cited Mark.

The Examiner committed an error by not giving significant weight to the fact that Appellant's goods and services and the Registrant's goods are mutually exclusive. Applicant's goods and services are expressly limited to unstructured content from the "Deep Web." Registrant's goods are expressly limited to "relational databases," which is structured data. These areas of the internet are exclusive to one another. Applicant's goods and services are used for searching data not found in relational databases of searched by Registrant's goods.

There is a significant difference between searching relational databases versus searching unstructured data of the Deep Web. As explained in the March 2013 whitepaper submitted as evidence in Applicant's August 26, 2013 Request for Reconsideration, Registrant's goods are limited to "information stored in relational databases," which is structured content or the same as the "surface web." Applicant's goods and services are limited to unstructured data not found in relational databases.

While the goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion, they need 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 services come from a common source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984); In re Corning Glass Works, 229 U.S.P.Q. 65 (T.T.A.B. 1985); In re Rexel Inc., 223 U.S.P.Q. 830 (T.T.A.B. 1984); Guardian Products Co., Inc. v. Scott Paper Co., 200 U.S.P.Q. 738 (T.T.A.B. 1978); In re International Telephone & Telegraph Corp., 197

U.S.P.Q. 910 (T.T.A.B. 1978). As outlined in the 2013 whitepaper, Applicant's goods and services are utilized by military, intelligence, and law enforcement agencies for mining information beyond that available via search engines used with Registrant's goods (i.e., unstructured data). Registrants customers seek business data in relational databases (i.e., structured data).

The Examining Attorney's refusal to reconsider asserts that relational databases are also found in the Deep Web and cites to four web excerpts. However, the web excerpts cited by the Examining Attorney confirm that the data found in the Deep Web is not accessible to Web search engines used with Registrant's goods because it is not structured data.

B. The Channels of Trade and Potential Consumers Differ.

The Examiner committed an error by not giving significant weight to the fact that Appellant's goods and services and the Registrants' goods are marketed and sold in different channels of trade to different consumers. One factor that must be considered in determining whether a likelihood of confusion exists is "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." Application of E. I. DuPont DeNemours & Co., 476 F.2d at 1361 (C.C.P.A. 1973).

The channels of trade for the goods associated with Registrant's mark and Appellant's mark are distinct. Appellant markets to military, intelligence, and law enforcement agencies while Registrant's customers seek business data in relational databases (as evidenced in the Registrant's brochure submitted as evidence in Applicant's August 26, 2013 Request for Reconsideration). It is also likely that consumers of companies that use relational database searching would not be involved in unstructured data searching or, if so, would understand the differences in such services. Given the parties' respective clientele, confusion is not likely

because Applicant's customers are sophisticated enough to distinguish between Applicant's mark and Registrant's mark. Further, Applicant's mark and the cited mark are not likely to be encountered by the same customers because of the Applicant's specialty field of trade. Considering these facts, Applicant submits that confusion is not likely.

V. SUMMARY

For the reasons set forth hereinabove, Appellant submits that the likelihood of confusion, mistake, or deception between Appellant's mark and the prior cited registrations is quite low. The fact that the goods and services are mutually exclusive is extremely strong evidence that there is little, if any likelihood of confusion. Accordingly, Appellant's mark is entitled to registration. The board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's mark.

Respectfully submitted,

Dated: January 3, 2014



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