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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85561168

MARK: DEEP WEB INTELLIGENCE



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GENERAL TRADEMARK INFORMATION:

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TTAB INFORMATION:

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APPLICANT: BrightPlanet Corporation II, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

4335.14US01

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

The applicant has appealed the examining attorney's final refusal to register the proposed mark **DEEP WEB INTELLIGENCE**, in standard character form, 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 9; 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 42. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the proposed mark, when applied to the services of the applicant, is likely to be confused with the mark in U.S. Registration No. 2285994, for **WEB INTELLIGENCE**, in standard character form, for "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 9.

II. FACTS

On March 6, 2012, the applicant, BrightPlanet Corporation II, Inc., applied for registration on the Principal Register of the proposed standard character 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 9; and "computer services in the nature of

harvesting high quality unstructured content from the Deep Web for research, analysis, monitoring, and tracking; computer services in the nature of storage, analysis, monitoring, and tracking of data harvested from the Deep Web,” in International Class 42.

In the first Office action, dated June 26, 2012, the examining attorney initially refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the proposed mark, when applied to the services of the applicant, is likely to be confused with the mark in U.S. Registration No. 2285994, for **WEB INTELLIGENCE**, in standard characters for “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 9. Additionally, the examining attorney made a requirement that the applicant clarify the precise nature of the services in International Class 42 pursuant to TMEP §1402.01, submit a specimen showing proper use of the proposed mark for the listed services pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), and a requirement that the applicant disclaim the descriptive wording “DEEP WEB” in the proper form pursuant to 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

In its response dated December 26, 2012, the applicant complied with the requirement for an acceptable specimen and submitted the disclaimer of the wording “DEEP WEB” in the proper form. Also, the applicant properly amended the recitation of services in International Class 42 to “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.” Finally, the applicant submitted arguments against the Section 2(d) refusal. After carefully reviewing the applicant’s arguments, the refusal to

register the applicant's amendments and arguments, the refusal to register the proposed mark under Trademark Act Section 2(d) based on U.S. Registration No. 2285994, was maintained and made final in a second Office action dated February 26, 2013.

In response to the final refusal, the applicant filed a notice of appeal and a request for reconsideration on August 26, 2013. On October 29, 2013, the request for reconsideration of the final refusal to register the mark under Trademark Act Section 2(d) based on U.S. Registration No. 2285994 was denied. The applicant filed the required appeal brief on January 3, 2014.

III. ARGUMENT

THE APPLICANT'S PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE IT SO RESEMBLES THE CITED REGISTERED MARK AS TO BE LIKELY TO CAUSE CONFUSION, MISTAKE OR DECEPTION

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 the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). 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.

Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the 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); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or 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 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

A. THE MARKS OF THE APPLICANT AND THE CITED REGISTRANT ARE CONFUSINGLY SIMILAR

In a likelihood of confusion determination, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Importantly, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii). In this case, the applicant has simply added the descriptive term "DEEP" to a registered mark (i.e., WEB INTELLIGENCE) in order to form its proposed mark.

Further, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See *Crocker Nat'l*

Bank v. Canadian Imperial Bank of Commerce, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). Again, the applicant's proposed mark and the cited registered mark share the common identical wording "WEB INTELLIGENCE."

The applicant argues against the similarity of the two marks by asserting that the "web" consists of two distinct and separate parts (i.e., the Surface Web and the Deep Web). To this end the applicant has submitted definitions and purported differences between the "surface web" and the "deep web." Based on these assertions, the applicant urges that the relevant consumers would not confuse the two marks.

In response, the examining attorney would first point out that the registered mark is "**WEB INTELLIGENCE**," and not "**SURFACE WEB INTELLIGENCE**." Significantly, even based on the applicant's own definitions and assertions, the "deep web" is simply an included sub set of the "web." Therefore, based on the marks as they appear, the commercial impression created by the two marks is highly similar.

B. THE GOODS AND SERVICES OF THE APPLICANT AND THE REGISTRANT, AS IDENTIFIED IN THE APPLICATION AND THE REGISTRATION ARE HIGHLY RELATED

The second primary element in an *ex parte* likelihood of confusion analysis involves a consideration of the relatedness of the goods and services offered under the marks. Importantly, the goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *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).

The respective goods and/or 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/or 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)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Notably, in the request for reconsideration, the applicant conceded that the goods and services of the two parties “may be complementary or related,” but asserts that they differ because they are dealing with mutually exclusive areas of the Internet. Specifically, in its brief the applicant states that its goods

and services are limited to the “unstructured content from the ‘Deep Web,’” and the “Registrant’s goods are expressly limited to ‘relational databases,’ which is structured data.”

In response, the examining attorney would first submit that even assuming *arguendo* that the applicant’s assertion that the goods and services of the applicant and the registrant are focused on different portions of the Internet does not necessitate that the goods and services are not related for purposes of a likelihood of confusion analysis. The inquiry is whether the goods and/or services are related, not identical. Thus, the issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused about their source. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Importantly, as noted above, the fact that the goods and services of the two parties are complementary or related is enough to find a likelihood of confusion. In this case, both parties have computer software and/or services that involve the retrieval and analysis of information contained on the Internet. Therefore, even if the goods and services of the two parties are focused primarily on different portions of the web, they are still at the very least related, and would be used by the same consumers to conduct a detailed search of the web. Again, as stated above, the applicant’s proposed mark and goods and services that are limited to the “deep web” would simply be seen as a sub set of the broader category of the entire “web” included in the registered mark. It is also of note that the lines between the “deep web” and “surface web” are often blurred. As evidence of this fact, the examining attorney refers to the article from the Clark College Library attached to the final Office action, mailed on February 26, 2013, that discusses the blurring of the lines between the “surface web” and the “deep web.”

Further, in addition to the applicant's primary argument that the goods and services of the two parties are distinguishable because they deal with different areas of the Internet, the applicant also contends in its appeal brief that the consumers for the goods and services of the two parties are different.

Specifically, the applicant states:

“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). Registrant’s customers seek business data in relational databases (i.e., structured data).”

To support both of these assertions, the applicant relies almost entirely on information contained in a brochure from SAP Business Objects attached to the December 26, 2012 and a 2013 whitepaper submitted with the applicant's request for reconsideration dated August 26, 2013. The brochure and the whitepaper purportedly show that the goods and services and relevant consumers of the applicant and registrant are in fact different. However, with respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Significantly, absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally,

unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the registration has no restrictions as to nature, type, channels of trade. Notably, the registrant's computer programs are not limited to acquiring "structured data" on the "surface web." Admittedly, the applicant's "computer programs" are limited to information stored on "relational databases." However, based on the applicant's own whitepaper and definitions for the term "deep web," and the examining attorney's definitions for the term "deep web," much of the deep web content is located on databases. For example, the definition of the term "deep web" from *The Free Dictionary* that was attached to the final Office action, dated February 26, 2012 reads, in part, as follows: "content on the Web that is not found in most search engine results, because it is stored in a database rather than HTML pages." In addition, despite the applicant's assertions to the contrary, based on the web excerpts attached to the action denying the request for reconsideration, dated October 29, 2013, it is also clear that much of the content on the "deep web" is actually contained specifically on "relational databases" such as those referenced in the registration.

Importantly, the registration uses broad wording to describe the goods and/or services and this wording is presumed to encompass all goods and/or services of the type described, including those in applicant's more narrow identification. Specifically, because the computer programs in the registration are not limited to accessing, querying and analyzing "structured information" from databases on the "surface web," it is legally presumed that the computer programs could also be used to acquire, query and analyze "structured" or "unstructured data" taken from databases on the "surface web" or on the "deep

web." Further, even if the registrant's computer programs were limited to acquiring and analyzing "structured content," it should be noted that although the applicant's services are limited to data mining and harvesting "unstructured content," the function of the applicant's computer software is not limited to providing searching, extraction, storage and analytics of "unstructured content." Again, even if the goods and services are not identical, they are at the very least highly related.

Next, as to the purported limitations to the customers of the applicant and registrant, the identifications set forth in the application and registration have no restrictions as to the classes of purchasers (i.e., The applicant's purchasers are not limited to military, intelligence and law enforcement agencies, and the registrant's purchasers are not limited to businesses seeking business data). Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers.

Additionally, although the registration is limited to computer programs, and the application includes related computer services as well as computer software, The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have held that various electronic goods are sufficiently related to computer or technology-related services such that a likelihood of confusion exists when the marks at issue are otherwise identical or highly similar. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (holding "electronic transmission of data and documents via computer terminals" to be sufficiently related to facsimile machines, computers, and computer software such that confusion would be likely where the marks at issue convey a similar commercial impression); *MSI Data Corp. v. Microprocessor Sys., Inc.*, 220 USPQ 655 (TTAB 1983) (holding MSI for "computer hardware manufacturing services to the order of or specification of others" likely to

be confused with MSI for "electronic ordering systems for gathering and transmitting source data comprising a recorder-transmitter and data receiver"); *Commc'ns Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 166 USPQ 353 (4th Cir. 1970) (holding COMSAT for satellite services likely to be confused with COMCET for computers because computers can be used to receive data transmitted by satellites).

As evidence of the relatedness of computer software and programs and computer services the trademark examining attorney refers to the ten (10) representative third party registrations from the USPTO's X-Search database attached to the initial Office action, dated June 26, 2012. Importantly, this evidence shows that the goods and/or services listed therein, namely computer programs and software and related computer services, are of a kind that may emanate from a single source under a single mark. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Of course, it should be noted that the applicant itself is using the proposed mark in connection with both computer software and related computer services.

Finally, the applicant again asserts that the consumers of the two parties are different, and that the applicant's customers are "sophisticated" enough to "distinguish between the Applicant's mark and Registrant's mark." However, as discussed above, the supposed limitations of the customer bases are not reflected in the identifications of the application and registration. Further, even assuming *arguendo* that the applicant's customers are sophisticated or knowledgeable in a particular field such as on-line searching and data mining, 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., *Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top*

Tobacco LP v. N. Atl. Operating Co., 101 USPQ2d 1163, 1170 (TTAB 2011). Again, the issue is not whether consumers will confuse the goods and/or services with each other, but rather whether the public will be confused about their source. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975).

IV. CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register the proposed mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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