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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BrightPlanet Corporation II, Inc.

Serial No. 85561168

Tye Biasco of Patterson Thuent Pedersen, P.A. for BrightPlanet Corporation II, Inc.

Jeffrey C. Coward, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Cataldo, Adlin and Gorowitz, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

BrightPlanet Corporation II, Inc. (“Applicant”) seeks registration of DEEP WEB INTELLIGENCE, in standard characters and with DEEP WEB disclaimed, 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 a data mining and harvesting high quality unstructured content from the

Deep Web for use in research, analysis, monitoring, and tracking in International Class 42.¹

The Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with Applicant's goods and services, so resembles the previously-registered mark WEB INTELLIGENCE, in typed 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,"² that use of Applicant's mark in connection with Applicant's goods and services is likely to cause confusion or mistake or to deceive. After the refusal became final, Applicant appealed and filed a request for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all 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 between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper*

¹ Application Serial No. 85561168, filed March 6, 2012 alleging first use dates of February 21, 2012.

² Registration No. 2285994, issued October 12, 1999; renewed.

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.”).

Turning first to the marks, they both consist of the term WEB INTELLIGENCE, with the only difference between them being that Applicant’s mark also includes the modifying prefix “DEEP.” The “deep Web” is defined as “*computing* the part of the World Wide Web not accessible through conventional search engines.” Office Action of June 26, 2012 (“collinsdictionary.com/dictionary/English/deep-web”).³ In other words, the “deep Web” referenced in Applicant’s mark is a subset of the World Wide Web referenced in Registrant’s mark. In fact, with its Office Action Response of December 26, 2012, Applicant introduced a Wikipedia entry for “Deep Web” which explains that Applicant’s founder is “credited with coining the phrase [‘deep Web’],” that the deep Web is also known as the “Invisible Web” and that it refers to “World Wide Web content that is not part of the Surface Web, which is indexed by standard search engines.” Therefore, the meaning conveyed by Applicant’s mark is similar to the meaning conveyed by Registrant’s mark – Registrant’s mark will be understood as referring to World Wide Web-related intelligence, while Applicant’s will be understood as referring to deep Web-related intelligence, a subset of “WEB INTELLIGENCE.” In fact, consumers familiar with Registrant’s goods may

³ While this definition appears to come from the United Kingdom version of the Collins Dictionary, and it is generally preferable to access the American version of dictionaries, the cited definition is entirely consistent with other information included with the same Office Action, as well as materials submitted by Applicant.

perceive Applicant's mark as identifying a new or special-purpose version of Registrant's software.

Moreover, because Applicant's mark contains the *entirety* of the cited mark, the marks create similar overall commercial impressions. *See, Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958) (recognizing and applying general rule "that one may not appropriate the entire mark of another and avoid a likelihood of confusion by the addition thereto of descriptive or otherwise subordinate matter");⁴ *see also, International Paper Co. v. Valley Paper Co.*, 468 F.2d 937, 175 USPQ 704 (CCPA 1972) (DATA for "writing, typewriter and printing paper" confusingly similar to DATA-SPEED for "paper sold in bulk rolls or bulk reams for conversion only into business forms"); *In re Fiesta Palms LLC*, 85 USPQ2d 1360 (TTAB 2007) (CLUB PALMS MVP for casino services confusingly similar to MVP for casino services offered to preferred customers identified by special identification cards); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984) ("we are firmly of the opinion that purchasers who encounter applicant's 'LITTLE GOLIATH' stapler kits and registrant's 'GOLIATH' large diameter woodcased pencils are likely to believe ... that both products emanate from or are in some way associated with the same source"); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155 (TTAB 1982) (EBONY for cosmetics confusingly similar to EBONY DRUM for hairdressing and conditioner).

⁴ The evidence of record, and Applicant's identification of goods and services and disclaimer all reveal that DEEP is descriptive of Applicant's goods and services. *See Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008).

In short, in addition to conveying similar meanings, Applicant's and Registrant's marks both include the identical phrase WEB INTELLIGENCE, and therefore also look and sound quite similar. "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). This factor weighs in favor of finding a likelihood of confusion.

Applicant argues, however, that the cited mark is "not distinctive," relying on the results of a Trademark Electronic Search System ("TESS") search for registered marks in International Class 9 which include the term "web." The search generated 724 "hits." As the Examining Attorney pointed out in denying Applicant's request for reconsideration, however, the search results do not support Applicant's argument because Applicant provided only a list of registration numbers. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); TBMP § 1208.02 (3d ed. rev.2 2013). Moreover, the only two registrations which Applicant properly introduced into the record – Registration No. 4303507 for WEB BROWSER & Design and Registration No. 3642023 for THE SOCIAL WEB BROWSER – also fail to support the argument, because these marks are much more different from Registrant's mark than is Applicant's mark, and both are registered for goods and services entirely distinct from those at issue here (television receivers in Registration No. 4303507 and

browser and communications software and online journals in Registration No. 3642023).

Turning to the goods and services, they need not be identical or even competitive in order to support a finding of likelihood of confusion. It is enough that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used, to a mistaken belief that Applicant's goods and services and Registrant's goods originate from or are in some way associated with the same source or that there is an association between the sources of the goods and services. *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1432 (TTAB 1993); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of the goods and services. *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

Here, there is a relationship between the goods and services. The identifications themselves make this clear, as the cited mark is used for software to "access, query and analyze via a global computer network information stored in relational databases," using the World Wide Web. Applicant concedes that the

reference to “relational databases” in Registrant’s identification of goods means “structured content or the same as the ‘surface web,’” and the “surface Web” is part of the World Wide Web. Applicant’s Appeal Brief at 5 (emphasis in original); *See also*, Office Action Response of December 26, 2012 (SAP BusinessObjects brochure for Registrant’s WEB INTELLIGENCE software which indicates that Registrant’s product provides a “web-based interface” and “access to heterogeneous sources of data” including from “multidimensional or relational databases”). Applicant’s mark is used for software to search and analyze information from the “deep Web,” which is a portion or subset of the Internet, and more specifically the World Wide Web.⁵ Applicant also provides related services in Class 42. Applicant’s Class 42 specimen indicates that Applicant’s services “simplify web research and analytics” and “harvest relevant data from *any* source on the Web” (emphasis supplied).

Applicant argues that its goods and services and Registrant’s goods are “mutually exclusive,” in that “[t]here is a significant difference between searching relational databases versus searching unstructured data of the Deep Web.” Applicant’s Appeal Brief at 5. We disagree. Even assuming that Applicant’s assertion is correct as a factual matter, there is still a relationship between the goods and services because customers may use Registrant’s software to search the surface Web, and Applicant’s to search the deep Web, both of which are components of the World Wide Web, and customers and prospective customers may even believe,

⁵ Applicant essentially concedes the point. Office Action Response of December 26, 2012 (“The WEB is known by those that utilize data mining and harvesting of data as consisting of two distinct and separate parts – the Surface Web and the Deep Web.”).

given the similarity of the marks, that Applicant's product is the deep Web version of Registrant's surface Web product. In fact, Applicant conceded during prosecution that "Applicant's goods and Registrant's goods may be complementary or related." Applicant's Request for Reconsideration August 26, 2013. Where, as here, products are complementary, they may be found to be related. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *General Mills, Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1597-98 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009).

Moreover, the evidence establishes that Applicant's claim that there is a "significant difference" between searching the deep Web and the surface Web is overstated. The Wikipedia entry for the Deep Web which Applicant made of record indicates that in fact some search engines, including Yahoo! Subscriptions, DeepPeep, Intute, Deep Web Technologies and Scirus have made at least parts of the deep Web searchable or accessible. Office Action Response of December 26, 2012. Furthermore, "[c]ommercial search engines have begun exploring alternative methods to crawl the deep Web." *Id.*; *see also*, printout from "clark.edu" website attached to Office Action of February 26, 2013 (stating that "what's deep today may surface tomorrow"). Perhaps most importantly, under the heading "Future," the Wikipedia entry states that "[t]he lines between search engine content and the deep Web have begun to blur ... An increasing amount of deep Web content is opening up to free search as publishers and libraries make agreements with large search

engines.” *Id.* And Applicant, in a “whitepaper” which bears the DEEP WEB INTELLIGENCE mark, states that “Surface Web search engines (Google/Bing/Yahoo) can lead you to websites that have unstructured Deep Web content.” Request for Reconsideration August 26, 2013 (Steve Pederson, applicant’s CEO, “Understanding the Deep Web in 10 Minutes,” March 2013). Similarly, Applicant’s Class 42 specimen indicates that Applicant can help “find and harvest relevant data from *any* source on the Web” (emphasis supplied).

In short, because Applicant’s goods and services and Registrant’s goods enable users to search parts of the Web, and may be complementary, they are at least related. This factor therefore also weighs in favor of finding a likelihood of confusion.

As for the channels of trade, Applicant and Registrant both offer computer software for searching the Web, with no limitations as to channels of trade or classes of consumers, and their goods are therefore presumed to move in all normal channels of trade for those goods and be available to all classes of consumers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *see also, Stone Lion Capital*, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (“Even assuming there is no overlap between Stone Lion’s and Lion’s current customers, the Board correctly declined to look beyond the application and registered marks at issue. An application with ‘no restriction on trade channels’ cannot be ‘narrowed by testimony that the applicant’s

use is, in fact, restricted to a particular class of purchasers.”).⁶ Moreover, the evidence indicates that there may be increasing overlap between deep Web searching and surface Web searching, and between the customers for deep Web and surface Web search products and services. In short, the channels of trade also weigh in favor of finding a likelihood of confusion.

Finally, Applicant argues that consumers are “sophisticated enough to distinguish between Applicant’s mark and Registrant’s mark.” Applicant’s Appeal Brief at 7. Even if we assume that consumers may exercise at least some care in purchasing Applicant’s and Registrant’s products and services, even careful purchasers can be confused as to source when presented with highly similar marks used on related and/or complementary goods and services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”). This factor therefore does not outweigh the similarity of the marks, related goods and similar channels of trade.

There is no relevant evidence or argument concerning the remaining likelihood of confusion factors, and we therefore treat them as neutral.

⁶ Applicant’s claim that its goods and services are intended for military, intelligence and law enforcement agencies is not reflected in its identification of goods and services. In any event, Registrant’s software could be offered to the same types of agencies.

Conclusion

After considering all of the evidence of record as it pertains to the relevant *du Pont* factors, including all of Applicant's arguments and evidence, even if not specifically discussed herein, we find that confusion is likely because the marks are quite similar, the goods and services related and the channels of trade overlapping.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.