

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

-----X
INFORMATION BUILDERS, INC. :
 Opposer, :
 v. :
 : Opposition Nos. 117,490
 : 117,505
TECHINFOCUS, LLC. :
 Applicant. :
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TRADEMARK TRIAL AND
APPEAL BOARD

BRIEF FOR OPPOSER

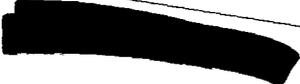

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Design was instituted on March 23, 2000, Opposition No. 117,505 involving TECHINFOCUS was instituted on March 28, 2000, and a Motion to Consolidate the two oppositions was granted on February 14, 2001.

Opposer owns registrations of the trademarks FOCUS, WEBFOCUS, and FOCUS FUSION, for use on computer software for database management, PC/FOCUS for software for use in preparation of reports and graphs from data stored in a computer, and FOCUS VISION for software used to store images in a database.

Opposer also owns three pending applications to register FOCUS for:

computer software for database management; computer software for use in decision support systems; computer software for use in enterprise reporting and analysis systems and for building applications for the management and tracking of data for enterprise reporting systems; computer database programs for use in connection with decision support, analysis, and reporting programs; computer software development tools for use in developing decision support, analysis, and reporting systems and applications; computer software, namely, client/server reporting, analysis and decision support tools; computerized database, reporting, and analysis software for use on corporate intranet web sites; enterprise server software for use in web based data publishing, reporting, and analysis solutions; computer software for accessing databases by means of global computer networks to generate reports; software development tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer network; and computer software for accessing and updating databases through global computer networks (Ser. No. 76/083,549, filed June 30, 2000).

WEBFOCUS for:

computer software for database management; computer software for accessing databases by means of global computer networks to generate reports; software development tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer networks; and computer software for accessing and updating databases through global computer networks (Ser. No. 76/081,024, filed June 30, 2000) and

FOCUS for computer services (Ser. No. 76/603,513, filed December 11, 1998, published May 21, 2002).

Opposer was the owner of registrations covering PS/FOCUS for database management software, and PM/FOCUS for software for use in preparation of reports and graphs from a database. These two registrations have been cancelled under Section 8.

In addition, Opposer is the owner by assignment of the registered trademark FOCUS FORECASTING for computer software and the registered service mark FOCUS FORECASTING for consulting services.

Opposer's software, especially that sold under the trademark WEBFOCUS, is used to transmit over the internet, reports, invoices, marketing information, and data in graphical format that is interactive, i.e., precisely the same function as Applicant's identification of goods.

THE RECORD

The record comprises the following evidence on behalf of Opposer:

1. Transcript of Testimony of Gerald D. Cohen, president of Opposer since Opposer's inception in 1975 (hereinafter "Cohen, [pg. #, line #]");

2. Exhibits 1-30 referred to in the Cohen testimony (there is no Exhibit 14);

3. Notice of Reliance under Rule 2.120(j) dated February 25, 2002 (hereinafter "Opp. Not. Of Rel. I");

4. Notice of Reliance under Rule 2.122(e) dated June 10, 2002 (hereinafter "Opp. Not. Of Rel. II"); and

5. Notice of Reliance under Rule 2.122(e) dated June 14, 2002 (hereinafter "Opp. Not. Of Rel. III").

Applicant took no testimony.

The record includes Applicant's Notice of Reliance dated April 15, 2002 (hereinafter "App. Not. Of Rel.>").

THE ISSUE

The issue to be determined is whether there is a likelihood of confusion between Applicant's trademarks TECHINFOCUS and TECHINFOCUS and Design, for the goods identified in its applications, and any one or more of Opposer's family of "Focus" marks, namely, FOCUS, WEBFOCUS, FOCUS FUSION, PC/FOCUS, FOCUS VISION, and FOCUS FORECASTING, used on the variety of computer software products described above.

There is no issue concerning priority of use. Opposer first used its trademark FOCUS in 1975. Applicant took no testimony, and hence the earliest dates upon which it can rely are the filing dates of its applications, namely, June 30, 1999 (TECHINFOCUS) and July 9, 1999 (TECHINFOCUS and Design).

THE FACTS

Opposer's History and Products

Opposer's witness, Gerald D. Cohen, is President and Chief Operating Officer of Information Builders, Inc. ("IBI"), the Opposer in the above-identified proceeding. He has been president of IBI since its founding in 1975, and in fact, was one of the founders of the company. (Cohen, pg. 3, l. 24 - pg. 4, l. 12; pg. 6, l. 19 - pg. 7, l. 3; Ex. 1)

As president of IBI, Cohen is in charge of, and fully familiar with, all aspects of IBI's operation, including overseeing the company's trademarks. (Cohen, pg. 4, l. 19 - pg. 5, l. 3)

The purpose of founding IBI in 1975 was to develop and make available computer software which, generally speaking, is used to build information systems. The FOCUS software incorporates what is often referred to as a "fourth generation" computer language, which was an advance over most computer languages in use at the time the company was founded, and remains today a state-of-the-art language.

IBI's "fourth generation" language allows users to construct a computer information system. It can be compared to a "third generation" language, for example, Cobol, and permits constructing an information system using terms which made it easier for the end-user to use the software, and hence contributed to the more widespread use of many computer information systems. One advantage of the fourth generation language is that the computer program did not have to be as detailed in order to obtain a specific result as would be the case using a third generation language computer program. (Cohen, pg. 7, l. 6-19)

Over the years, IBI's customers have used the FOCUS software to analyze information, build information systems, write reports, utilize and enhance tracking systems, and provide forecasting systems, billing systems, and all kinds of analytical systems. (Cohen, pg. 7, l. 20 - pg. 8, l. 17) In addition, IBI's WEBFOCUS software permits users to transmit over public networks and private networks, reports, invoices, marketing information, and data in a graphical format that is interactive. (Cohen, pg. 12, l. 4-11, Ex. 1; Cohen, pg. 69, l. 1 - pg. 70, l. 20; Ex. 26; pg. 72, l. 6-14; pg. 74. l. 17-23, Ex. 27 and 28B)

Of particular interest in this opposition proceeding is Opposer's WEBFOCUS software. This software permits users to

create and save reports as a Microsoft Excel spreadsheet, and manipulate the spreadsheet to produce the information in different forms, i.e., different type fonts and colors. (Cohen, pg. 71, l. 3 - pg. 73, l. 11; Ex. 27) Thus, Opposer's WEBFOCUS software works in conjunction with Microsoft Excel to produce reports in the Excel format. WEBFOCUS has the ability to manipulate the Excel spreadsheet so as to make a more attractive presentation of that spreadsheet. (Cohen, pg. 73, l. 12 - pg. 76, l. 25; Ex. 28A, B, and C) WEBFOCUS reports can be saved in Excel format, and manipulated so as, for example, to "pivot" a table to change rows to columns and vice-versa. (Cohen, pg. 77, l. 1 - pg. 78, l. 22; Ex. 29A and B)

IBI sells its software products through twenty-eight sales and consulting offices in the United States. In addition, IBI has subsidiary companies in nine foreign countries, and sales representatives in an additional eighteen foreign countries. IBI also sells its product by telephone and over the internet. IBI has approximately 1,900 employees, over 100 of whom perform a sales function. (Cohen, pg. 13, l. 16 - pg.15, l. 21; Ex. 2)

IBI also sells its FOCUS software through Value Added Resellers (VARs), who bundle the FOCUS software with their own products. The FOCUS software is also sold through System Integrators, who are hired by organizations to put together all elements of a complete computer system. IBI does business with

about two dozen VARs and about thirty system integrators. FOCUS software is also sold through consultants, i.e., companies which advise clients concerning which software the client should use for a particular assignment. IBI does business with about two hundred consultants and joint marketing companies, e.g., IBM, under which IBI participates as a software partner in marketing of its software. (Cohen, p. 15, l.22 - pg. 17, l. 21)

IBI's first sales of its software, in 1975, were to companies known as "service bureaus", one service bureau being a company called Tymshare. These service bureaus installed IBI's FOCUS software on their own mainframe computers, and in turn sold time on those computers to service bureau customers who accessed the software by means of their own computer terminals. The service bureaus promoted the FOCUS product through their own sales force as well as by direct mail. Sales to service bureaus, both in the United States and abroad, continued through 1985. IBI began selling the FOCUS product directly to software consumers prior to 1985. (Cohen, pg. 31, l. 10 - pg. 34, l. 10; Ex. 10, 11, 12)

Since 1975, IBI's total dollar volume of sales of its software bearing one of IBI's "Focus" marks is almost three billion dollars (\$3,000,000,000), and in recent years sales have exceeded two hundred million dollars (\$200,000,000) per year. (Cohen, pg. 34, l. 24 - pg. 35, l. 22; Ex. 13)

IBI first advertised its FOCUS software in 1977 and has continued such advertising annually until the present time. Advertising expenditures for products sold under IBI's various "Focus" marks, through 2001, exceed forty seven million dollars (\$47,000,000). (Cohen, pg. 41, l. 23 - pg. 42, l. 25; Ex. 17)

Since at least as early as 1984, Opposer has published general information guides about the company and its FOCUS software. (Cohen, pg. 17, l. 22 - pg. 21, l. 10; Ex. 3-6)

IBI's FOCUS software is sold throughout the United States, and in fact IBI has users of its FOCUS software in every state of the United States. (Cohen, pg. 43, l. 2-19)

IBI sells its FOCUS software to companies in every major industry in the United States. IBI's customers are involved in banking and securities; education; exploration, engineering, and construction; financial services; government and public sector; health care; insurance; manufacturing; non-profit; publishing; services; telecommunications; transportation and distribution; and utilities. (Cohen, pg. 21, l. 15 - pg. 23, l. 24; Ex. 7A, 7B)

In addition to its trademark FOCUS, IBI has been using trademarks which combine other words or letters with FOCUS, namely, PC/FOCUS, FOCUS FUSION, FOCUS VISION, and WEBFOCUS. Thus IBI has a history of adding phrases to the word FOCUS to create new trademarks, and this pattern is likely to continue. (Cohen, pg. 43, l. 25 - pg. 45, l. 4)

The trademark FOCUS by itself and in conjunction with other words or letters is now, and has been since its first use, conspicuously applied to Opposer's computer software programs themselves, to manuals accompanying the programs, and to the containers in which Opposer's computer software programs are packaged, shipped and sold. Opposer's computer software programs have been widely shipped, distributed and sold in interstate commerce throughout the United States. Representative labels for Opposer's products are presented as Ex. 15. (Cohen, pg. 36, l. 2 - pg. 37, l. 2; Ex. 15)

While FOCUS was originally a mainframe computer product, it is now used on all computers, both mainframe and personal computers (PCs). (Cohen, pg. 9, l. 13 - pg. 10, l. 12)

Opposer's mainframe software sells for many thousands of dollars, but Opposer also sells software for PCs for as little as \$395. (Cohen, pg. 79, l. 10-17)

Opposer has extensively advertised and promoted its computer software programs under the trademark FOCUS, by itself and in conjunction with other words or letters, in newspapers and trade publications in interstate commerce throughout the United States, including, Computerworld, Information Week, DM Review, Enterprise Systems Journal, Computing Canada, Government Computer News, UNIX World, and Software Magazine. (Cohen, pg. 37, l. 3 - 17) Copies of ads in these publications are presented as Ex. 16. (Cohen, pg. 37, l. 18 - pg. 41, l. 14; Ex. 16)

By virtue of the widespread sales and the extensive advertising and promotion of Opposer's computer software programs, and the excellence of the goods themselves, Opposer's mark FOCUS has come to be and is now widely and favorably known and of great value to Opposer. It has come to and does now, in the minds of the trade and the public, identify and designate Opposer's computer software programs exclusively and distinguish those goods from the goods of others. A number of articles written by third parties about Opposer and its FOCUS products evidence Opposer's fame. These articles appeared in Database Programming & Design, Information Week, Midrange Systems, DEC Professional, DBMS, PC Week, Crain's New York Business, Computer Reseller News, and DM Review. (Cohen, pg. 45, l. 9 - pg. 47, l. 25; Ex. 18)

Further evidencing of the fame of Opposer's trademark is a report prepared by an outside agency named Datapro Information Services Group that analyzes Opposer and its FOCUS line of products positively versus its competition, namely, Oracle Corp.'s ORACLE; Sybase, Inc.'s SYBASE; Computer Associates Intl.'s CA-RAMIS; MUST Software's NOMAD; Cognos' POWERHOUSE; Software AG's NATURAL; and Cincom's MANTIS. (Cohen pg. 48, l. 2-17, Ex. 19)

Moreover, Opposer is believed to be the largest computer software company in New York City (Cohen, pg. 4, l. 16-18), and

in the year 2000 received a proclamation from Mayor Giuliani of New York congratulating IBI on its twenty fifth anniversary. (Cohen, pg. 13, l. 2-15; Ex. 1)

The trademark FOCUS has been registered and applied for in the United States Patent and Trademark Office by Opposer under the following numbers:

FOCUS, Reg. No. 1,652,265, for "computer programs for data base management";

PC/FOCUS, Reg. No. 1,300,245, for "diskettes containing a microprocessor program for use in preparation of reports and graphs from data stored in a personal computer"

FOCUS VISION, Reg. No. 1,478,426, for "re-recorded computer programs used to store images in a database";

FOCUS FUSION, Reg. No. 1,965,984, for "computer software for database management systems";

WEBFOCUS, Reg. No. 2,248,562, for "computer programs for data base management";

WEBFOCUS, Appln. No. 76/081,024 for an expanded list of computer software products;

FOCUS, Appln. No. 76/083,549 for an expanded list of computer software products;

FOCUS, Appln. No. 75/603,513, for "computer services. . .".

PS/FOCUS, Reg. No. 1,478,427, for "pre-recorded database management computer programs" (was cancelled in 1994 under Section 8 of the Trademark Act);

PM/FOCUS, Reg. No. 1,822,512, for "computer program for use in preparation of reports and graphs from a data base"; (was cancelled in 2000 under Section 8)

In addition, Opposer is the owner by assignment of the following registrations:

FOCUS FORECASTING, Reg. No. 2,223,450, for "consulting services in the field of inventory management and control for businesses including the use of computers and computer techniques in the field of inventory management and control for businesses"; and

FOCUS FORECASTING, Reg. No. 2,223,457, for "computer programs recorded on electronic media, namely tapes or discs, for use by businesses to plan inventory needs and to manage and control inventory".

(Cohen, pg. 24, l. 4 - pg. 26, l. 14; Ex. 8)

In addition to the trademarks Opposer has registered and applied for in the United States Patent and Trademark Office, Opposer uses its FOCUS trademark in connection with computerized instruction and training courses, with related printed materials, for teaching the use of the FOCUS computer software. Courses at all levels are offered for Data Processing Professionals and Business Professionals. (Cohen, pg. 48, l. 18 - pg. 51, l. 25, Ex 20A - 20D)

Throughout most of its history, Opposer has published and distributed a variety of sales tools dealing with its FOCUS software. (Cohen, pg. 26, l. 15 - pg. 31, l. 9, Ex. 9A-9J)

Opposer uses its FOCUS trademark in connection with three newsletters and magazines it publishes: FOCUS NEWS, FOCUS FLASH, FOCUS SYSTEMS JOURNAL, and WEBFOCUS NEWSLETTER. Tens of thousands of these publications are distributed directly to cus-

tomers and computer users several times a year, and the WEBFOCUS NEWSLETTER is distributed in both print and e-mail form. These publications inform users of corporate goings-on, new product developments, product updates, course calendars, and new FOCUS customers. (Cohen, pg. 52, l. 7 - pg. 55, l. 10; Ex. 21)

Moreover, Opposer sells thousands of copies of a large variety of technical publications that explain how to use the different FOCUS products. Opposer distributes tens of thousands of catalogs of its Focus-related publications, and makes the catalogs available online as well. (Cohen, pg. 55, l. 11 - pg. 57, l. 17; Ex. 22A - 22C)

In 1979, IBI established "The Focus Users Group", known as FUSE. (Cohen, pg. 8, l. 18 - pg. 9, l. 2; Ex. 1) Through regular meetings, FUSE members, from end-users to application developers to information technology executives, pay to attend and receive the latest information about how to use the various FOCUS products. About a thousand people from 300 - 400 famous companies all over the world attend these conferences, for example, AT&T, Air Canada, Amoco, Becton Dickinson, Black & Decker, Blue Cross/Blue Shield, British Airways, Capital Cities/ABC, Coca-Cola, County of Los Angeles, Department of Defense, Dow Jones, E & J Gallo Winery, Eastman Kodak, Federal Reserve Board, Fidelity Investments, Florida Lottery, General Electric, Gerber Products, Hallmark Cards, Harvard University,

Hoechst Celanese, Home Box Office, J.P. Morgan, JC Penney, Johns Hopkins Hospital, Jones, Day, Reavis & Pogue, Lands' End, Mercedes-Benz Merrill Lynch, Miller Brewing Company, Patent and Trademark Office, Procter & Gamble, Ralston Purina, Social Security Administration, Sony, The Dallas Morning News, U.S. Dept. of the Treasury, U.S. Navy, and U.S. Postal Service. (Cohen, pg. 57, l. 25 - pg. 60, l. 15, ex. 23A-B)

Opposer sells its products directly to people who have computers, usually companies of all sizes. (Cohen, pg. 60, l. 16 - pg. 61, l. 5) The software provides the user with a way to manage its database, and to access information contained in its database, so that it can then report and analyze that information. (Cohen, pg. 7, l. 20 - pg. 8, l. 14) If desired, the customer can access the information via the internet and manipulate it by means of a graphical format that is interactive. (Cohen pg. 74, l. 17 - 23)

Opposer publishes the following product fact sheets showing the broad variety of applications of Opposer's products:

1. FOCUS for UNIX: The Open Language for Open Systems
2. FOCUS for UNIX: Oracle Interface
3. FOCUS for UNIX: Digital Equipment Corporation ULTRIX DECstations and DECsystems
4. FOCUS for UNIX: System 7000 Series, StarServer E, and 3B2 Family
5. FOCUS for UNIX: NCR System 3000 Family

6. FOCUS for UNIX: Informix Interface
7. FOCUS for UNIX: Pyramid Technology MIServer Series
8. FOCUS for UNIX under IBM AIX: RISC System/6000 Workstations and Servers, PS/2, RT and Mainframe
9. FOCUS for UNIX under AT&T UNIX System V
10. FOCUS for UNIX: Ingres Interface
11. FOCUS for UNIX: Under Sun Microsystems SunOS Sun Workstations and Servers
12. FOCUS for UNIX under Sequent Computer Systems DYNIX
13. FOCUS for UNIX under Pyramid Technology dualPORT OSx
14. FOCUS for UNIX under Data General DG/UX
15. FOCUS for UNIX under the Santa Cruz Operation System V Intel 80386-Based Microcomputers
16. An Enhanced Version of FOCUS for UNIX
17. FOCUS for VAX
18. FOCUS for VAX/VMS: Ingres Interface
19. FOCUS for VAX/VMS: DBMS Interface
20. FOCUS for VAX/VMS: Rdb Interface
21. FOCUS for VAX/VMS: RMS Interface
22. FOCUS for VAX/VMS: Teradata Interface
23. FOCUS for VAX/VMS: Interface to Oracle
24. FOCUS for VAX/VMS: SYBASE Interface
25. FOCUS for VAX/VMS: ADABAS Interface
26. FOCUS for VAX/VMS: ShareBase Interface

27. FOCUS in Action: VAX/VMS
28. FOCUS for Wang VS: PACE Analyzer
29. FOCUS for Wang VS: FOCNET VS-to-VS Distributed Processing (VVDP)
30. FOCUS for Wang VS: Document Imaging Interface
31. FOCUS for Wang VS: Integration with WP, WP Plus, and OFFICE
32. FOCNET: UNIX to MVS & VM
33. FOCNET: Gateway/CONNECT and PC/LAN to VM & MVS
34. FOCNET: VMS to VM & MVS
35. FOCNET: UNIX to VM & MVS
36. FOCNET/Cross-Machine Interface: VM to MVS, DOS/VSE and VS1
37. FOCUS for Bull: GCOS 7
38. FOCUS for Bull: Bull Open Software and SPIX
39. FOCUS for Bull: GCOS 8
40. FOCUS for HP-UX: Interface to Oracle
41. FOCUS for HP MPE XL: Interface to TurboIMAGE
42. FOCUS for SQL/DS
43. FOCUS for Tandem
44. FOCCALC: The FOCUS Spreadsheet
45. HiperFOCUS: High Performance FOCUS for MVS/ESA
46. FOCUS for ALL-IN-i Interface
47. FOCUS for DB2
48. FOCUS Universal MODIFY Facility (UMF) for VSAM Files

49. FOCUS for Teradata: A FOCUS Read/Write ` Interface for SQL-Based Teradata DBC/1012
50. SmartMode for FOCUS
51. Multi-Session Option (MSO) for MVS
52. FOCUS for AS/400: Advanced PC Communications PC/FOCUS Plus to FOCUS for AS/400
53. FOCUS for NAS
54. FOCUS for OpenVMS StyleSheet
55. FOCUS/DLL
56. FOCUS/EIS for Windows
57. FOCUS/DB Toolkit for Visual Basic
58. PC/FOCUS: PC/FOCCALC
59. PC/FOCUS Plus
60. PC/FOCUS Host Language Interface
61. PC/FOCUS: SQL Server Interface
62. PC/FOCUS: PC/FOCUS LANpak
63. PC/FOCUS: dBASE Interface
64. PM/FOCUS

(Cohen, pg. 61, l. 6 - pg. 68, l. 15; Ex. 24)

Some representative brochures published by Opposer showing how the FOCUS computer software is used by some of Opposer's clients are the following:

1. Polaroid Corporation's VAX-Based Network Promotes Product Quality Worldwide
2. FOCUS in Action: US Sprint
3. Finnair Maintains Its Fleet With FOCMAN

4. FOCUS in Action: Sony Executive Information Systems
5. AT&T Automates World-Class Telecommunications System With FOCUS
6. MCI Services Leverages FOCUS and Open Systems in Successful Friends & Family Program
7. University of Alberta Hospitals Implements Patient Care and Business Systems with FOCUS on Fault-Tolerant Tandem Computers
8. Valero Natural Gas Monitors Pipeline with Realtime FOCUS System
9. FOCUS Provides Transparent Access to Data on Humana's Corporate Network

(Cohen, pg. 68, l. 16 - pg. 70, l. 20; Ex. 25)

Opposer has expended considerable time and money policing its FOCUS trademark. Specifically, over the years, Opposer has brought more than one hundred twenty opposition proceedings and three cancellation proceedings in the United States Patent and Trademark Office involving trademarks and service marks including the word FOCUS. (Cohen, pg. 80, l. 8 - pg. 81, l. 16; Ex. 30)

Applicant's Goods

In its applications, opposed herein, Applicant describes its goods as "software that permits users to transmit over public networks and private networks, reports, invoices, marketing information, and data in a graphical format that is interactive".

More specifically, Applicant's product is computer software designed to operate in conjunction with, and as a "plug-in" to, third party software products such as Microsoft Excel. Applicant's software, called EP2U, would create a spreadsheet of data in Microsoft Excel and create an attractive presentation formatting of the Excel spreadsheet data. The formatted presentation may then be used for marketing presentations, internal reports, proposals, invoices sales reports or other items. (Opp. Not. of Rel. I, Answers to Interrogatories Nos. 1 and 2)

Applicant anticipates that it will charge about \$200 for its software (Opp. Not. of Rel. I, Answer to Interrogatory No. 8)

Applicant's software is marketed to users in small to medium size businesses. (Opp. Not. of Rel. I, Answer to Interrogatory No. 15)

ARGUMENT

The following analysis of the duPont factors will make clear that a likelihood of confusion exists between Opposer's and Applicant's marks as applied to their respective goods. In re E.I. duPont de Nemours & Co., 177 USPQ 536, 567 (CCPA 1973).

The DuPont factors:

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

Applicant's mark (both the word alone and word with design) will be read and understood as "tech in focus" or "technology in focus". Therefore, prospective purchasers will pay little attention to the prefix "TECHIN" in Applicant's marks, because these syllables mean "technology in" and hence describes the products of both parties, these products relating to information technology.

Consequently, the eye of the viewer will immediately skip to the suffix "FOCUS", which is completely arbitrary as applied to the goods of both parties. In other words, Applicant's mark is likely to register with the viewer as "techinFOCUS", because the prefix "techin" has virtually no trademark significance as applied to Applicant's goods. For this reason, Applicant's mark is likely to bring Opposer's line of software to mind.

The same analysis applies to the sound of the two marks. The term "Techin" is likely to be disregarded, because so commonplace, and the sound that will make an impression is the arbitrary word "Focus".

With respect to the connotations of, and commercial impressions made by, the two marks, it should be noted that FOCUS is totally arbitrary as applied to Opposer's software. Thus, those familiar with Opposer's products recognize FOCUS as Opposer's brand name for software, and nothing else. This being the case, such a prospective customer seeing Applicant's mark,

TECHINFOCUS, may very well believe that it is another line from Opposer. In other words, it would not be unusual for a company owning the trademark FOCUS for database management software to employ related trademarks such as "DATAINFOCUS", "INFOINFOCUS" or "TECHINFOCUS". Such marks are obvious possibilities of naming line extensions, in the same way that Opposer actually uses, in addition to FOCUS, the trademarks WEBFOCUS and PC/FOCUS, as well as FOCUS FUSION and FOCUS VISION. Moreover, in the past Opposer used the trademarks PS/FOCUS and PM/FOCUS.

In view of this history of Opposer using a family of "FOCUS" marks, it is likely that Opposer will in the future adopt other marks including the word "FOCUS" combined with different prefixes and suffixes. (Cohen, pg. 44, l. 13 - pg. 45, l. 4) No doubt, Opposer's many customers are aware of this pattern of Opposer's trademarks and are likely to believe that Opposer has added another similar mark to its line.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

Applicant's product is software which permits users to transmit, over the internet, reports and data in graphical format that is interactive. Opposer sells exactly this same type of software under its trademark WEBFOCUS. Thus, Applicant's software, as defined in its application, is identical to software being sold by Opposer.

More specifically, Applicant's software operates in conjunction with Microsoft Excel to create a spreadsheet in Excel format which can be manipulated to provide attractive presentations (see Page 20 of this Brief). Similarly, Opposer's WEBFOCUS software permits users to create Microsoft Excel spreadsheets and manipulate those spreadsheets in terms of form, type fonts, and colors to produce attractive presentations (see paragraph bridging pages 6 and 7 of this Brief).

Applicant's software will cost about \$200 (Brief, pg. 20). Opposer sells some of its FOCUS software for \$395 (Brief, pg. 10)

3. The similarity or dissimilarity of established, likely-to-continue trade channels.

The trade channels of the parties are identical. Opposer sells its FOCUS software to companies in every major industry in the United States (Brief, pg. 9), including companies of all sizes (Brief, pg. 15). Applicant's software is marketed to users in small to medium size companies (Brief, pg. 20)

4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful sophisticated purchasing.

In terms of computer software purchased by business firms, Applicant's software and some of Opposer's software verge on being "impulse" items because of their relatively low cost. Applicant's software will sell for about \$200, and Opposer sells

some FOCUS software for \$395. Company purchasing agents are not likely to thoroughly investigate software selling for such modest prices.

5. The fame of the prior mark (sales, advertising, length of use).

By every criterion, sales, advertising, and length of use, Applicant's mark is extremely famous in the community familiar with computer software. This fame is brought about by Opposer's continuous use of its FOCUS trademark since 1975 (Brief, pg. 5). Opposer operates 28 sales and consulting offices in the United States, has subsidiary companies in nine foreign countries, and sales representatives in an additional eighteen foreign countries (Brief, pg. 7). Opposer has 1,900 employees, about 100 of whom perform a sales function. Opposer sells its FOCUS software through many value added resellers (VARs), system integrators, and consultants, as well as by means of joint marketing agreements (Brief, pg. 7-8).

Opposer's total sales of its FOCUS software products amount to almost Three Billion dollars (\$3,000,000,000) current sales running at over Two Hundred Million Dollars (\$200,000,000) annually, and Opposer's total advertising expenditures for its FOCUS software products exceed Forty Seven Million Dollars (\$47,000,000) (Brief, pg. 8-9).

Opposer sells its FOCUS software to companies in every major industry in the United States, and to customers in every

state of the United States (Brief, pg. 9).

Opposer's trademark is advertised widely in a large variety of computer publications (Brief, pg. 10), and numerous articles have been written about Opposer's FOCUS software (Brief, pg. 11). Articles have been written comparing Opposer's FOCUS software to software made by such well known companies as Oracle, Sybase, and Computer Associates (Brief, pg. 11).

Opposer is believed to be the largest computer software company in New York City, and Opposer has received a congratulatory proclamation from Major Giuliani. (Brief, pg. 11, 12)

Opposer has not only registered its trademark FOCUS, but has also registered six additional "FOCUS" trademarks for computer software, owns three pending applications, and is the owner by assignment of two "FOCUS" marks, one for computer software and the other for computer consulting services (Brief, pg. 12, 13).

Opposer has published and distributed tens of thousands of newsletters and magazines bearing the titles FOCUS NEWS, FOCUS FLASH, FOCUS SYSTEMS JOURNAL, and WEBFOCUS NEWSLETTER (Brief pg. 13, 14).

Representatives from hundreds of major United States and international corporations, government agencies, and educational institutions attend regular meetings to discuss Opposer's FOCUS products (Brief, pg. 14, 15).

Certainly, by any definition, Opposer's mark is "famous".

6. The number and nature of similar marks in use on similar goods.

Applicant took no testimony, and hence there is no evidence of use (even by Applicant) of any trademark, for computer software, including the word "Focus", other than the uses by Opposer. Moreover, Opposer is not aware of any other software being sold under a trademark including the word "Focus". (Cohen, pg. 44, l. 5-12)

Applicant's Notice of Reliance cites eight third party trademark registrations, and four third party service mark registrations. However, third party registrations are of little or no evidentiary value, because there is no indication of whether or not these marks are in use. In re Barnhardt Farms, Inc. (96 USPQ 309, 311 (TTAB 1977))

Nevertheless, it should be pointed out that, concerning the trademarks cited by Applicant:

1. Registration No. 2,223,457, FOCUS FORECASTING, is not a third party registration, but is owned by Opposer (Opp. Not. of Rel. II, assignment from Bernard T. Smith to Opposer).

2. Reg. No. 2,503,414, UNIFOCUS and Design, and Reg. No. 2,503,415, UNIFOCUS. These registrations erroneously include goods in Class 9, and the Class 9 goods will be deleted when amended registrations are issued (Opp. Not. of Rel. II, TTAB letters).

7. The nature and extent of any actual confusion, and

8. The length of time during and condition under which there has been concurrent use without evidence of actual confusion.

There is no evidence that Applicant has actually used its mark. Thus, the absence of actual confusion is not surprising.

9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

Opposer owns a "family" of FOCUS marks for its various software products. (Brief, pg. 9, pg. 12-13; Ex. 8) Thus, Applicant's mark might very well be taken as just another one of Opposer's family of marks.

Moreover, Opposer sells a wide variety of software products, which perform many functions, on different platforms, all under its various "Focus" marks.

The duPont factor 10 is not applicable to the current situation.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

Opposer has been assiduous in objecting to the use of "Focus" trademarks by others on computer software. As a result of its activity, Opposer has firmly established its right to exclude others from using "Focus" trademarks on software.

More specifically, Opposer has, since 1985, filed more than one hundred twenty Notices of Opposition in the Patent and trademark Office, and three petitions for cancellation (Ex. 30). While none of these cases has been fully tried and decided by the TTAB on its merits, in almost all cases which have been terminated, the opposition has been sustained (by default or concession on the part of the Applicant), and the cancellation petitions have been granted. In a few cases, the opposition proceedings have been settled, and withdrawn, after the identification of goods in the application was amended to make clear that the mark is not used on computer software.

This history makes two things clear. Opposer has gone through great expense over the years to protect its rights in the trademark FOCUS and its other "Focus" trademarks. In addition, this history shows that the industry has recognized Opposer's rights in "Focus" trademarks as applied to computer software.

It is submitted that there can be no more persuasive proof of the strength of Opposer's rights than recognition of those rights by those active in the market place.

12. The extent of potential confusion, i.e., whether de minimis or substantial.

The only non-descriptive portion of Applicant's mark is the word "Focus". This portion of Applicant's mark is identical to

Opposer's trademark FOCUS, and identical to the arbitrary portions of Opposer's other "Focus" trademarks. Moreover, Applicant's software performs the same function as software sold by Opposer with its WEBFOCUS trademark. Consequently, the potential confusion between the marks of the parties is substantial.

SUMMARY

Applicant seeks to register TECHINFOCUS for software which works in conjunction with Microsoft Excel to create spreadsheets, which can then be manipulated to provide attractive presentations. Opposer owns and uses a variety of "Focus" trademarks for software, one of which, WEBFOCUS, works in conjunction with Microsoft Excel to create spreadsheets which can be manipulated to provide attractive presentations.

The likelihood of confusion between Applicant's mark and Opposer's family of "Focus" marks is evident.

Consequently, this opposition should be sustained and registration denied to Applicant.

Respectfully,
INFORMATION BUILDERS INC.

By Alan H. Levine

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New York, New York
August 16, 2002

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing BRIEF FOR OPPOSER has been sent this 16th day of August, 2002, by first class mail, postage prepaid to:

Michael D. Oliver, Esq.
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APPEAL BOARD
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INFORMATION BUILDERS, INC. :
Opposer, :
v. : Opposition Nos. 117,490
TECHINFOCUS, LLC. : 117,505
Applicant. :
-----X

August 16, 2002

Box TTAB
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

08-19-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #79

FILING OF BRIEF FOR OPPOSER

With reference to the above-identified consolidated opposition proceedings, enclosed herewith is the Brief for Opposer, in triplicate.

Respectfully,

Alan H. Levine
Attorney for Opposer

AHL:gmt
Enclosure

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513, ON THE DATE INDICATED BELOW.

NAME Alan H. Levine
DATE August 16, 2002