Mailed: April 11, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Rubicon Communications, L.P.

v.

API Cryptek, Inc.

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Opposition No. 91191929
to application Serial No. 77436934
filed on April 1, 2008

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Dwayne K. Goetzel of Meyertons, Hood, Kivlin, Kowert & Goetzel for Rubicon Communications, L.P.

Benjamin E. Leace of RatnerPrestia PC for API Cryptek, Inc.

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Before Bucher, Cataldo and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

API Cryptek, Inc. ("applicant") filed an intent-to-use application for the mark NETGARD, in standard character form, for "computer hardware and software for encryption and controlling access to data over computer networks," in Class 9.

Rubicon Communications, L.P. ("opposer") opposed the registration of applicant's mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Specifically, opposer alleged

ownership and prior use of the registered trademark NETGATE, in standard character form, for the goods set forth below:

> Computer hardware, namely, computer chips and modules for wireless communications, data communications, and voice communications; computer software for controlling, operating, and interfacing with wireless communications systems; computer hardware and software enabling wireless access to a computer-based information network; computer network security software for protecting networks from unauthorized access.[1]

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

A. Opposer's Evidence.

1. Testimony deposition of James William Thompson, co-owner and Chief Technical Office of opposer, with attached exhibits;

2. Notice of reliance on the following items:

a. A copy of opposer's pleaded registration printed from the USPTO electronic database showing the current status of and title to the registration;

[1] Registration No. 3161285, issued October 24, 2006; Sections 8 and 15 combined declaration has been accepted and acknowledged.

b. Representative pages from opposer's website;

c. Dictionary definitions;

d. Excerpts from applicant's website; and

e. Response to requests for admission.

B. Applicant's Evidence.

1. Testimony deposition of Stephen Walsh, applicant's Director of Programs and Product Development, with attached exhibits; and

2. Notice of Reliance on the following items:

a. A copy of the registration file for opposer's pleaded registration;

b. Copies of third-party registrations for marks beginning with the letters N-E-T-G;

c. Excerpts from applicant's website;[2]

d. Excerpts from opposer's website;

e. Excerpts from the NETGEAR website, a third party; and

f. Excerpts from the PC ENGINES website, a third party.

[2] Applicant's excerpts from the Internet websites did not include the URL or date that the excerpts were printed. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010) ("*if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source* (*e.g.*, the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)."). (Emphasis in the original). However, because applicant's Internet evidence is cumulative and opposer did not lodge an objection, we will consider the excerpts for whatever probative value they may have.

Standing

Because opposer has properly made its pleaded registration of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the products covered by the registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity and nature of the products described in the application and the registration.

Opposer sells security appliances and wireless equipment.[3] Opposer's NETGATE mark is used to identify, *inter alia,* "computer network security software for protecting networks from unauthorized access." James Thompson, opposer's co-owner and Chief Technical Officer, described opposer's products as firewalls and security systems for WiFi.[4]

Applicant sells computer and data security products to the federal government.[5] Applicant's mark is intended for use in connection with "computer hardware and software for encryption and controlling access to data over computer networks." "Encryption is a scrambling of the data to protect it from unauthorized users or access by unauthorized users. … It's a security measure."[6] The product "was specifically designed to control and to identify the individuals that could put data into a federal network without the administrator's knowledge. So, it's designed to

[3] Thompson Dep., p. 5.
[4] Thompson Dep., p. 9. A "firewall" is "a network node [a network junction or connection point] set up as boundary to prevent traffic from one segment to cross over into another." The Computer Glossary, pp. 150 and 268 (7th ed. 1995). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,* 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).
[5] Walsh Dep., p. 6.
[6] Walsh Dep., p. 68.

identify the user and to control access with primarily the scanner, which is the dangerous part of Legacy [sic] machines."[7] Mr. Thompson testified that applicant's description of goods is broad enough to encompass opposer's goods[8] and he likened applicant's products to a printer or scanner firewall.[9]

In view of the foregoing, we find that the products at issue are computer network security hardware and software and that they are closely related.

B. The similarity of or dissimilarity of the likely-to-continue trade channels and classes of consumers.

Mr. Thompson testified that opposer sells its computer network security software through direct sales over the Internet or through distributors who incorporate opposer's security software into networks that they put together.[10] Opposer has a variety of customers.

> Q. [W]hat type of person or business does [opposer] sell to under the Netgate mark?
>
> A. We have a variety of - - customers. Everything from banks to telecommunications providers to Internet service providers to people who build robotic devices for use in war theaters, bomb sniffing, that kind of thing. Other people who OEM things from us and resale them, distributors.

[7] Walsh Dep., pp. 9-10.
[8] Thompson Dep., p. 19.
[9] Thompson Dep., p. 19.
[10] Thompson Dep., p. 24.

Q. Do you sell to the telecommunications sector?

A. Yes.

Q. Do you sell to the healthcare industries?

A. Yes. We have, yes.

Q. You mentioned - - I think you said war theater, if I understood you right. Would that be defense or what does that mean?

A. One of our customers builds devices, robotic devices, that can find and remotely detonate IUDs - - or IEDs, rather.[11]

As indicated above, Stephen Walsh, applicant's Director of Programs and Product Development, testified that applicant sells to the federal government and the Department of Defense.[12] Unlike opposer's products, applicant does not sell its products through the Internet; they are purchased under a contract for "system-scale implementation."[13]

However, despite what the evidence shows, because there are no restrictions as to channels of trade or classes of consumers in the description of goods in the application or opposer's pleaded registration, we must presume that applicant's "computer hardware and software for encryption and controlling access to data over computer networks" and opposer's "computer network security software for protecting

[11] Thompson Dep., p. 23.
[12] Walsh Dep., p. 6.
[13] Walsh Dep., p. 12.

networks from unauthorized access" are sold in all of the normal channels of trade to all of the normal purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Toys R Us v. Lamps R Us,* 219 USPQ 340, 343 (TTAB 1983). Accordingly, because the goods are closely related and the evidence shows that the channels of trade and classes of consumers overlap, we find that the goods move in the same channels of trade and are sold to the same classes of consumers.

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

Considering the particular nature of the goods involved in this proceeding, purchasing decisions will not be made impulsively or carelessly, as would be the case when purchasing a snack which is inexpensive and subject to routine purchases, in contrast to the more deliberate purchase of a product to provide computer network security.

With respect to applicant's sales to the federal government and the Department of Defense, Mr. Walsh testified about the long sales process involving the creation of personal relationships with the IT managers in government entities that might need applicant's security devices and how applicant offers installation and network

management services for a network-wide system.[14] Moreover, applicant's equipment is expensive: the desktop encrypter is approximately $4,000 per unit and the manager appliance is approximately $10,000.[15]

Opposer's contention that its customers do not necessarily exercise a high degree of care is not persuasive. On the one hand, opposer's witness testified that its products are sold to the telecommunications industry, banking industry, and robotics industry, and on the other opposer asserts that people who own and operate boats may buy one of opposer's devices to secure his WiFi network.[16]

> And I have to assume that some of those sales are, "Hey, buddy, just get yourself one of these and you'll be hooked, up." "Well, where do it get it?" "Netgate."
>
> I know we have had soldiers in tents in Iraq who have passed around business cards of ours, "Get this one. It works." I would describe that as an impulse purchase.[17]

Although opposer's products may be sold for use in multicomputer networks and to individuals, Opposer's "computer network security software for protecting networks from unauthorized access" by its nature is a complex

[14] Walsh Dep., pp. 12-14.
[15] Walsh Dep., p. 14.
[16] Thompson Dep., p. 74.
[17] Thompson Dep., p. 74.

product, sold to a consumer with a focused need for the product.[18]

We find that the relevant purchasers will exercise great care and correspondingly pay careful attention to the trademark for the products.

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

Opposer has agreed to allow AT&T to use the mark AT&T NETGATE to identify "telecommunications products, namely, encryption devices to enable a virtual private telecommunications network" sold "to larger scale enterprises that also accept or obtain services from AT&T."[19] While there was testimony regarding an opposition between opposer and AT&T leading to the above-noted agreement, there was no testimony or evidence proffered regarding the use of the mark AT&T NETGATE.

Applicant introduced 17 third-party registrations for marks beginning with the letters N-E-T-G, including the registrations listed below:

1. Registration No. 1703739 for the mark NETGUARD for "computer installation and repair";

2. Registration No. 3102633 for the mark NETGURU SMOOTH and design for "computer networking equipment, namely, … firewalls …";

[18] *See* opposer's user manuals attached to its notice of reliance.
[19] Thompson Dep., pp. 25-26 and 47-54 and Exhibit 17.

3. Registration No. 3146119 for the mark NETGATE for "telecommunications products, namely, encryption devices to enable a virtual private telecommunications network." This is the registration owned by AT&T noted above; and

4. Registration No. 3395024 for the mark BEST NETGUARD and design for Ethernet cable.

Third-party registrations do not prove that "Netgate" is a weak term. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

> [I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party [sic] registrations are still in use. Because of this doubt, third party [sic] registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

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

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992).

We also note that where, as here, the goods are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21*

Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang,* 84 USPQ2d 1323, 1325 (TTAB 2007).

In analyzing the similarity or dissimilarity of the marks, we note that the prefix "net" is descriptive of network hardware and software. Therefore, the shared prefix has little trademark significance and the dominant element of the marks will be the suffix portions of the marks. While the marks must be compared in their entireties when analyzing their similarity or dissimilarity, there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corporation,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The words "gate" and "gard" are separate and distinct words that are readily recognizable. "Gard," of course, is a misspelling of the word "guard." The word "gate" is generally defined as "any means of access or entrance." In electronics, "gate" means "a signal that makes an electronic circuit operative or inoperative either for a certain time interval or until another signal is received."[20] The

[20] *Dictionary.com* based on the Random House Dictionary (2012) (Opposer's notice of reliance).

meaning of and commercial impression engendered by the mark NETGATE when used in connection with "computer network security software for protecting networks from unauthorized access" are network access.

The word "gard" or "guard" means "to keep safe from harm or danger; protect; to watch over." Synonyms include, *inter alia,* defense, protection, safety and security.[21] The meaning of and commercial impression engendered by the mark NETGARD when used in connection with "computer hardware and software for encryption and controlling access to data over computer networks" are network protection.

The marks share similar, but distinguishable, meanings and commercial impressions because they are suggestive of network security hardware and software. Under such circumstances, the prior use and registration of a suggestive term should not preclude the subsequent registration of a similarly suggestive, but otherwise distinguishable mark, for related goods. *See E. L. Bruce Co. v. American Termicide*, 285 F.2d 462, 128 USPQ 341, 342 (CCPA 1960) (highly suggestive nature of "TERMI" on products for extermination of termites is critical part of holding that "TERMICIDE" AND "TERMINIX" are not confusingly similar, in spite of their similar connotations); *Safer Inc. v. OMS Investments Inc.,* 94 USPQ2d 1031, 1044 (TTAB 2010) (DEAR-B-

[21] *Id.*

GON for animal repellant is not similar to DEER AWAY for the same goods); *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801 (TTAB 1982) (opposer's mark OLD HEARTH for bread is sufficiently suggestive as not to preclude the subsequent registration of the similarly suggestive, but nevertheless distinguishable, HERITAGE HEARTH for bread).

The following statement by the Court of Customs and Patent Appeals, in one of the frequently cited cases on this point, *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA, 1958) in which "SURE FIT" and "RITE-FIT" were held not to be confusingly similar, is appropriate:

> It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

In the case before us, the marks NETGATE and NETGARD were adopted to indicate that the products offer network access and network protection respectively, and that this indication or suggestion is readily apparent to prospective purchasers. Under these circumstances and considering the overall differences between the marks, we find that

notwithstanding their similarities, the marks are more dissimilar than similar.

F. Balancing the factors.

Because the marks are more dissimilar than similar and because consumers exercise a high degree of care when purchasing network security hardware and software products, we find that applicant's mark NETGARD, for "computer hardware and software for encryption and controlling access to data over computer networks," is not likely to cause confusion with NETGATE for "computer hardware, namely, computer chips and modules for wireless communications, data communications, and voice communications; computer software for controlling, operating, and interfacing with wireless communications systems; computer hardware and software enabling wireless access to a computer-based information network; computer network security software for protecting networks from unauthorized access."

Decision: The opposition is dismissed and a notice of allowance will be issued to applicant in due course.