

This Opinion is Not a
Precedent of the TTAB

Mailed: August 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Salesforce.com, Inc.

v.

Edataforce Consulting, LLC

—
Opposition No. 91199539
Cancellation No. 92054039
(consolidated)
—

John L. Slafsky of Wilson Sonsini Goodrich & Rosati
for Salesforce.com, Inc.

Kavitha Akula of Akula & Associates, P.C.
for Edataforce Consulting, LLC.

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Before Bucher, Taylor, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Salesforce.com, Inc. (“Salesforce”) petitions to cancel Registration No. 3898834 for the mark **edataforce** (in standard characters) for “Computer software development and computer programming development for others” in International Class 42,¹ owned by Edataforce Consulting, LLC (“Edataforce”).

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¹ The registration issued January 4, 2011.

Salesforce also opposes Edataforce's application to register the same mark for services described as "Customized software development services; Design and development of computer hardware and software; Research, development, design and upgrading of computer software" in International Class 42.²

As the pleaded ground in both the cancellation and opposition, Salesforce claims likelihood of confusion with its **FORCE** and **FORCE**-formative marks, including an asserted "family" of **FORCE** marks, which it alleges have been used in commerce on software and in association with software-related services "well before any date of first use upon which [Edataforce] can rely." ¶ 15 (Petition for Cancellation and Notice of Opposition). In all, Salesforce pleaded ownership of eleven (11) registrations and ten (10) applications, as well as common law rights in eight (8) additional marks containing the stylized term **FORCE**.³

Edataforce filed answers denying the salient allegations in both the opposition and cancellation. The two proceedings were consolidated prior to trial.⁴

² Application Serial No. 77888877 was filed on December 8, 2009 and is based on an allegation of first anywhere and in commerce on September 29, 2009 under Section 1(a) of the Trademark Act. The application also contains a recitation of services in International Class 35; however, the application was not opposed with respect to the Class 35 services.

³ Several of the pleaded applications matured into registrations and Salesforce introduced copies thereof with its first notice of reliance (16 TTABVUE). In all, and under the same first notice of reliance, Salesforce introduced copies of 36 different registrations it owns as well as three applications, of which all but two are for marks containing the **FORCE** element. See, *infra*, discussion involving "Preliminary Matters."

⁴ See 15 TTABVUE (consolidation order). Unless otherwise specified, all TTABVUE citations in this opinion are references to filings or orders in the consolidated opposition proceeding (No. 91199539).

I. Record

The record in this case consists of the pleadings and, by rule, the files of the involved registration and application. Trademark Rule 2.122(b)(1).

Salesforce has submitted the testimony, with exhibits, of Bradley Armstrong, Salesforce's Director of Platform Business Development.⁵

In addition, Salesforce made the following evidence of record under notices of reliance:

- Copies of 36 registrations and three applications that it owns, including the following registrations:⁶

Mark	Reg. No.	Goods and/or Services
SALESFORCE.COM	2684824 ⁷	providing temporary use of on-line non-downloadable software for storing, managing, tracking and analyzing data in the field of marketing...; computer services, namely, designing, implementing, and maintaining computer software for others... in Class 42
SALESFORCE	3138749 ⁸	downloadable software for use in web site development... [and] for use in customizing computer application user interfaces in Class 9

⁵ 21 TTABVUE (testimony and exhibits designated as "confidential") and 23 TTABVUE.

⁶ 16 TTABVUE (first notice of reliance).

⁷ Issued February 4, 2003 on Supplemental Register.

⁸ Issued September 5, 2006; §§ 8 and 15 declaration accepted and acknowledged.

DREAMFORCE	3035403 ⁹	educational services, namely, conducting seminars, conferences, workshops, and computer application training in the fields of marketing, promotion, sales, customer information, customer relationship management, sales support and employee efficiency, and distributing course materials in connection therewith in Class 41
CLOUDFORCE	3795483 ¹⁰	(same as immediately above)
FINANCIALFORCE	3836879 ¹¹	... computer services, namely, designing, developing, and maintaining computer software applications for others and consulting services related thereto in Class 42
VISUALFORCE	3966372 ¹²	... online hosted computer services, namely, designing, developing, customizing and maintaining computer application user interfaces for others and consulting services related thereto in Class 42
FORCE.COM	3592166	... online hosted computer services, namely, designing, developing, and maintaining computer software applications for others and consulting services related thereto in Class 42

- Copies of various filings made by Salesforce with the SEC;¹³
- Copies of printouts from TTABVUE, website of National Arbitration Forum for purposes of showing that Salesforce has opposed registration or third-party use of FORCE-formative marks or domain names;¹⁴
- Copies of 22 articles regarding Salesforce;¹⁵ and
- Copies of printouts from Salesforce's website, Edataforce's website, and 35 press releases issued by Salesforce.¹⁶

⁹ Issued December 27, 2005; §§ 8 and 15 declaration accepted and acknowledged.

¹⁰ Issued June 1, 2010.

¹¹ Issued August 24, 2010.

¹² Issued May 24, 2011.

¹³ 17 TTABVUE (second notice of reliance).

¹⁴ 18 TTABVUE (fifth notice of reliance).

¹⁵ 19 TTABVUE (fourth notice of reliance).

¹⁶ 20 TTABVUE (third notice of reliance).

II. Preliminary Matters

A. Burden of Proof

As an initial matter, we note that Edataforce did not submit any evidence or file a trial brief. In effect, the extent of Edataforce's participation in both proceedings is limited to the answers it filed. It is not required to do more and we keep in mind that the burden of proof with respect to both the cancellation and opposition remains with Salesforce. That is, Salesforce is the plaintiff in both matters and bears the ultimate responsibility of proving the asserted ground for opposition and cancellation by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

B. Salesforce's Unpleaded Registrations

Another preliminary matter involves Salesforce's reliance on registered marks that were not pleaded in the Notice of Opposition or Petition for Cancellation. Specifically and as already noted, Salesforce pleaded ownership of certain registrations and applications for marks containing the term FORCE. At trial, it introduced copies showing status and title of not only the pleaded registrations, but also registrations that matured from the pleaded applications and registrations that were not identified, in application status or otherwise, in the pleadings.

With respect to the pleaded applications that matured into registrations, we deem the Notice of Opposition and Petition for Cancellation amended to include reliance on these registrations. *See DC Comics v. Pan American Grain Mfg. Co.* 77 USPQ2d 1220 (TTAB 2005).

As to Salesforce's introduction of registrations that were not identified (either by application or registration number) in the pleadings, it may only rely on these registrations if this was an issue that was tried by implied consent. That is, the trial of an unpleaded issue can be found where the nonoffering party (1) raised no objection to the introduction of the evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-1721 (TTAB 2008).

The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter.

Morgan Creek Productions Inc., 91 USPQ2d at 1139.

Here, Edataforce raised no objection to the introduction of copies of Salesforce's unpleaded registrations showing their status and title and Salesforce informed Edataforce in the first notice of reliance that it "intends to rely upon" these registrations. Under these circumstances, we conclude that Salesforce's reliance on these registrations was tried by implied consent and they may serve as a basis in Salesforce's priority and likelihood of confusion claim. *See, e.g., Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations).

In sum, all registrations owned by Salesforce and made of record by attaching copies under a notice of reliance may serve as a basis in Salesforce's priority and likelihood of confusion claim.

C. Salesforce's Family of 'FORCE' Marks

Salesforce pleaded and asserts ownership of a "family of **FORCE** marks," arguing that it began using this family of marks in 2003. Brief, p. 24. Indeed, Salesforce argues the likelihood of confusion ground based greatly, if not exclusively, on this family of marks rather than relying on any one of its individual **FORCE**-formative marks.

The fact that Salesforce has used and registered numerous marks incorporating **FORCE** is not in itself sufficient to establish the existence of a family of marks. Salesforce has the burden of demonstrating that these marks have been used and advertised in such a manner as to create common exposure and thereafter recognition of common ownership based upon the **FORCE** feature common to each mark. *See Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009).

The Federal Circuit has defined a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

Upon review of the entire record in this proceeding, we find Salesforce has met this burden in showing it has rights in a **FORCE**-formative family of marks.

As early as 2005, Salesforce was clearly making a conscious effort to advertise its various **FORCE**-formative marks in connection with computer software services in such a manner that consumers would clearly perceive that common element in the mark. For example, Salesforce's website at that time was listing several of its marks alongside each other with an emphasis (in bold) on the common element **FORCE** and stating that it offers "A Complete Family of On-Demand Solutions":¹⁷



In the same year and on the same website, Salesforce also displayed its marks and described several of its service products in the following manner:

¹⁷ 20 TTABVUE (Exhibit D-7, at p. 75 of 385).



Salesforce: A comprehensive, on-demand sales and marketing application

Salesforce.com's flagship sales force automation (SFA) and marketing solution consistently drives more success than any other application. From campaigns to cash, Salesforce offers a complete suite of tools to support your company's complete, unique sales and marketing processes, including contact management, lead and opportunity management, mobile CRM, sales forecasting, workflow, real-time analytics, and more.



Supportforce: A flexible on-demand customer service and support application

Supportforce offers companies of all sizes a complete, on-demand, multichannel call center solution. The customizable Supportforce features all the CTI, self-service, knowledge management, internationalization, and other capabilities that modern call centers require to stay competitive.



Customforce: A built-in point-and-click customization tool

Customforce, the innovative point-and-click customization tool from salesforce.com, allows anyone to fully customize CRM and create new on-demand applications in minutes. Now any company can enjoy a CRM solution that precisely meets its business requirements and reflects its unique competitive advantage.



Sforce: A trusted on-demand integration platform

One of the most widely used and broadly supported enterprise Web services, the Sforce platform allows companies to create modern, standards-based enterprise CRM strategies by integrating salesforce.com solutions with existing ERP systems, security systems, email systems, Web sites, and more.



Multiforce: A powerful on-demand operating system

With Multiforce, you can create and deploy completely new on-demand applications right within Salesforce, and users can access them with a single click. Multiforce applications can be made up of standard tabs that group together existing functionality, such as lead management. Or you can create sets of custom tabs that make up completely new apps designed for non-CRM processes like recruiting, project management, or bug tracking.

Salesforce's witness, Mr. Armstrong, testified to the accuracy of exhibits identified as "website traffic data summaries" which reflect a significant number of people have visited Salesforce's websites, including the time spent, conversion rate and views at the domains.¹⁸

Mr. Armstrong also testified that consumers are continuously exposed to "heavy promotion" of the **FORCE** family of marks at Salesforce's "Dreamforce" conference held typically each year at the Moscone Center in San Francisco since 2003. This

¹⁸ 23 TTABVUE (Armstrong Dep. at pp. 35-7, Exhibit 12).

conference is attended by “tens of thousands” and involves a series of presentations involving Salesforce’s products and services.¹⁹

Salesforce also enters into partnership agreements with other companies and will license use of a “**FORCE**-related brand” to signify this venture between Salesforce and the partner.²⁰ In other words, the **FORCE** element of the mark is being used to signify to consumers that Salesforce is collaborating in the effort. Mr. Armstrong testified that Salesforce keeps a tight control on any use of a **FORCE**-formative mark whether it is used in such a partnership or whether the mark is being used by its own employees in conducting business with its customers. According to Mr. Armstrong, Salesforce not only advertises its marks as a family but communicates treatment of its marks as a family by engaging in “education internally and education of partners and customers via [various documents] and by enforcing these rights when necessary.”²¹ Indeed, Salesforce has internal written guidelines governing employee use and promotion of its marks to the public.

In sum, we find that Salesforce has used and advertised its **FORCE**-formative marks in such a manner as to create exposure and recognition of common ownership based on that common element. Salesforce has demonstrated that it has owned a family of **FORCE** formative marks at least as early as 2005.

¹⁹ Id. (Armstrong Dep. at pp. 64-65)

²⁰ Id. (Armstrong Dep. at pp. 69-70)

²¹ Id. (Armstrong Dep. at p. 72)

III. Salesforce's Standing and Priority

Salesforce has shown it possesses a real interest in each of the consolidated proceedings beyond that of a mere intermeddler, and has a reasonable basis for belief of damage. Its pleaded registrations for marks containing the element **FORCE** and covering various software goods and services are of record and, as discussed in the previous section, it owns a family of **FORCE** marks. These established facts suffice for purposes of Petitioner's standing in bringing this matter before the Board. *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-190 (CCPA 1982); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.").

In the context of the opposition proceeding, priority is not an issue with respect to the Salesforce registrations of record vis-à-vis Edataforce's applied-for mark. *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). However, in the context of the cancellation proceeding, it is necessary for Salesforce to establish priority in order to prevail on a claim of likelihood of confusion based on any of registered marks, it must prove it has prior proprietary rights. *See Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281 (TTAB 1998).

As to Salesforce's common law rights in the family of **FORCE** marks, it must prove prior use of this family in both the opposition and cancellation proceedings. *J & J Snack Foods*, 932 F2d at 1464 ("preference is accorded the prior user of a mark or family of marks, as against a newcomer.").

For purposes of priority, Edataforce may rely on the constructive use or filing date, *i.e.*, December 1, 2009, of the underlying application that matured into its registration. Although the registration contains an allegation of use as of September 1, 2009, a date earlier than the filing date, respondent has not submitted any evidence to establish this allegation and thus cannot rely on this earlier date. Trademark Rule 2.122(b)(2) (“The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”)

As already discussed, Salesforce has demonstrated that, as early as 2005, it acquired rights in a family of **FORCE**-formative marks in connection with its computer software design, development and programming services. Thus, Salesforce has priority with respect to its **FORCE** family of marks vis-à-vis Edataforce’s registered mark.

We further note that the filing dates for many of Salesforce’s relied-upon registrations precede September 1, 2009 and, as constructive use dates, they serve to establish Salesforce’s priority in connection with those registered marks (in connection with the identified goods and services) vis-à-vis Edataforce’s registered mark. Trademark Act § 7(c). *See J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). These registered marks, with prior filing dates, include the following: **SALESFORCE**, **SUCCESSFORCE**, **FINANCIALFORCE**, **CLOUDFORCE**, **DREAMFORCE**, **MIRRORFORCE**, and **SFORCE**.

For purposes of determining if there is a likelihood of confusion in both the opposition and cancellation, however, we focus our analysis below on Salesforce's **FORCE** family of marks used in connection with computer software design, development and programming services and Edataforce's mark, **edataforce**, in connection with the services recited in its registration and Class 42 of the application.

IV. Likelihood of Confusion

Our determination under Trademark Act 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. *See Federated Foods, Inc. v. Fort Howard Paper 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.”).

A. Similarity of the Parties' Services, Trade Channels and Consumers

Edataforce's services, as described in its registration, are “computer software development and computer programming development for others.” Its services, as recited in its application, are “customized software development services; design and development of computer hardware and software; research, development, design and upgrading of computer software.”

Salesforce's services, as described in several of its registrations listed above, comprises, among other services, "providing temporary use of on-line non-downloadable software for storing, managing, tracking and analyzing data in the field of marketing...; computer services, namely, designing, implementing, and maintaining computer software for others." The record, including printouts from Salesforce's website and the testimony from Mr. Armstrong, corroborates and evidences Salesforce's use of its family of marks in connection with these services.

As is evident, the services of the parties are essentially identical. Edataforce's computer software development and design services for others is the same as Salesforce's "designing" and "implementing" computer software for others. In substance, both parties' services involve designing and developing computer software for others. Although the printouts from Salesforce's website shows that its services are generally directed to helping consumers with "customer relationship management (CRM)," Edataforce's computer software services are broadly defined and may include development and designing software in the same CRM field.

Because the parties' software services are the same, we presume that the services move in all normal channels of trade and are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). Accordingly, we presume the trade channels and classes of customers to be the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028

(TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this presumption).

Accordingly, the factors focusing on the similarity of the parties' services, trade channels and consumers all strongly support a finding of likely confusion.

B. Similarity of the Marks

Where, as here, the parties use their marks in connection with services that are legally identical, the similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

In comparing the **edataforce** mark with Salesforce's **FORCE** family of marks, we keep in mind that the relevant question is would **edataforce** be likely to be viewed as a member of the **FORCE** family of marks. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1720 (TTAB 2007); *The Black & Decker Corporation v. Emerson Electric Co.*, 84 USPQ2d 1482, 1491 (TTAB 2007); *Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464, 465 n.8 (TTAB 1983) ("purchasers familiar with plaintiff's family of marks would believe the defendant's mark is but another member of that family."). We believe this to be the case. That is, consumers viewing **edataforce** are likely to perceive it as conforming to the Salesforce's **FORCE** family of marks, which include: **SALESFORCE**, **SUCCESSFORCE**, **FINANCIALFORCE**, **CLOUDFORCE**, **DREAMFORCE**, **MIRRORFORCE**, and **SFORCE**. The structure of the Edataforce's mark is very close to, if not the same, as that employed in

Salesforce's family of marks inasmuch because it ends with the term "Force" and is prefaced with highly suggestive or descriptive terms. Descriptive or generic matter has less significance in creating a mark's commercial impression and little weight in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.'") (quoting *In re Nat'l Data Corp.*, 224 USPQ at 752). In contrast, the family of marks is characterized by the arbitrary and distinctive term FORCE.

For the reasons mentioned, we find **edataforce** is sufficiently similar to Salesforce's **FORCE** family of marks that, if used in connection with closely related or identical services, consumers would mistakenly believe it is a member of the same family. The first *du Pont* factor thus also weighs in favor of a finding of likelihood of confusion.

C. Strength of Salesforce's **FORCE** Family of Marks

Salesforce's annual sales, as well as its advertising and marketing expenditures are significant. While several of the Armstrong deposition testimonial exhibits involving Salesforce's success have been designated as confidential, Salesforce has highlighted in its brief several relevant statistics such as marketing expenditures beginning in the "tens of millions in the early 2000s and surpassing a billion dollars in recent years." Brief at p. 29. The number of Salesforce's customers has been designated as confidential but we can state that it is quite substantial. The record

also comprises copies of unsolicited mainstream media articles featuring Salesforce and several of its **FORCE** family of marks in connection with the services offered.

Salesforce does not argue that its **FORCE** family of marks is famous and we would not find it to be famous on this record; however, we can agree with the assessment that the family is very strong for purposes of likelihood of confusion.

As a result, we find that this factor weighs slightly in favor of finding a likelihood of confusion.

V. Conclusion

In sum, we find that Salesforce has priority of use with respect to its **FORCE** family of marks. As discussed above, the parties' services, trade channels and classes of consumers are identical in-part and otherwise closely related. Given these factors and that the **edataforce** mark so resembles Salesforce's strong **FORCE** family of marks, it likely to be mistaken as a member of the family and thus cause confusion.²²

Decision: The petition to cancel is granted pursuant to Section 14(1) of the Trademark Act, 15 U.S.C. § 1064(1) and Registration No. 3898834 will be cancelled in due course. The opposition is sustained with respect to the services in International Class 42, as recited in Application Serial No. 77888877 pursuant to Section 13 of the Trademark Act, 15 U.S.C. § 1063. These services will be deleted and the application will proceed to registration as to the remaining services in International Class 35.

²² In view of our finding, there is no need for us to consider likelihood of confusion as to the Salesforce's marks, on an individual basis, vis-à-vis Edataforce's mark.