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Deposited March 21, 2002

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

*In re Application of*  
**TEKSYSTEMS, INC.**

Mark: TEK  
Serial No.: 75/754,896  
Basis: Actual Use  
Filed: July 20, 1999

Law Office 104  
Asmat A. Khan,  
Examining Attorney

Hon. Commissioner of Trademarks  
Box: TTAB - No Fee  
2900 Crystal Drive  
Arlington, VA 22202-3513

**APPEAL BRIEF FOR APPLICANT**

Introduction

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney dated January 29, 2001, finally refusing registration of the above-identified mark, and from the decision of the Examining Attorney dated December 19, 2001, continuing the final refusal in response to Applicant's request for reconsideration.

Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney. A Request for Reconsideration and Notice of Appeal were filed on July 25, 2001.

Applicant's Request for Reconsideration was denied on December 19, 2001. By Notice of the Trademark Trial and Appeal Board dated January 22, 2002, the appeal was resumed and Applicant was allowed sixty days to file this brief. No oral argument is requested.

### Applicant's Trademark

Applicant seeks registration on the Principal Register of its mark TEK for temporary and permanent placement of personnel in the information systems industry, in International Class 35; and computer services, namely, computer consultation and systems management, integration of computer systems and networks and on-site monitoring of computer systems in the information systems industry, in International Class 42.

### Prior Registration Cited by Examining Attorney

The Examining Attorney refused registration on the ground that Applicant's mark is likely to be confused with U.S. Regs. No. 1,945,003 and 2,075,297 for TEK RESOURCES INC. (AND DESIGN) and TEK RESOURCES, respectively, for temporary and contract employment services in the computer technology field; employment recruiting and counseling in the computer technology field, in International Class 35.

### The Rejection

The Examining Attorney refused registration under Section 2(d) on the ground that Applicant's mark is likely to be confused with the TEK RESOURCES registrations.

### Argument

Likelihood of confusion is determined by applying those factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563, 567 (C.C.P.A. 1973) ("DuPont"), relevant to the particular case. An analysis under Section 2(d) of the Trademark Act requires consideration of not only the similarity of the marks, but of all relevant factors affecting whether there is a practical likelihood of confusion. *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 164 U.S.P.Q. (BNA) 43 (C.C.P.A. 1969). The Trademark Trial and Appeal Board ("TTAB") has uniformly held that there is no hard and fast rule that

likelihood of confusion must automatically be found to exist if there is a similarity in sight, sound, or commercial meaning of the marks. *See Dor-O-Matic Division of Republic Ind., Inc. v. Doormaid, Inc.*, 199 U.S.P.Q. (BNA) 573 (TTAB 1978); *Guerlain, Inc. v. Richardson-Merrell, Inc.*, 189 U.S.P.Q. (BNA) 116 (TTAB 1975); *In re Software Design, Inc.*, 220 U.S.P.Q. 662 (TTAB 1983).

The marks TEK and TEK RESOURCES are distinctive in sight because the registered mark includes the term RESOURCES as a prominent element of the mark. The marks are distinctive in sound because the registered mark contains two distinctive terms comprising three syllables whereas Applicant's mark contains one term comprised of one syllable. There is no indication that TEK RESOURCES is referred to as "TEK," and there is no use by Applicant of the term RESOURCES with its TEK mark. Finally, the commercial impression engendered by the TEK mark is sufficiently distinct to obviate the likelihood of consumer confusion. The TEK mark conjures a different mental impression than when "TEK" is used with "Resources" or "Resources Inc.". The fact that the marks share the term "TEK" is not enough to make confusion likely in light of the distinct commercial impression engendered by each mark in its entirety. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 U.S.P.Q. (BNA) 185 (Fed. Cir. 1984); *In re Loew's Theatres, Inc.*, 218 U.S.P.Q. 956 (TTAB 1983).

The risk of public confusion regarding the origin of services is directly related to the mark's strength. Because a weak mark is entitled to less protection, it is less likely to be associated with a single source and less likely to be confused. *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1533, 30 U.S.P.Q.2d (BNA) 1930, 1935 (10<sup>th</sup> Cir.), *cert. denied*, 513 U.S. 1052 (1994); *Homeowners Group, Inc. v. Home Marketing Specialists*,

*Inc.*, 931 F.2d 1100, 1108, 18 U.S.P.Q.2d (BNA) 1587, 1593 (6<sup>th</sup> Cir. 1991). Because the differences between weak marks are more noticeable, "[w]here a party uses a weak mark [its] competitors may come closer to [its] mark than would be the case with a strong mark without violating [its] rights." *Kenner Parker Toys, Inc. v. Rose Art Ind., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d (BNA) 1453, 1456 (Fed. Cir.), *cert. denied*, 506 U.S. 862 (1992), quoting *Sure-Fit Prod. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 U.S.P.Q. (BNA) 295, 296 (C.C.P.A. 1958). "When the primary term is weakly protected to begin with, minor alterations may effectively negate any confusing similarity between the two marks." *First Sav. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 655, 40 U.S.P.Q.2d (BNA) 1865, 1873 (10<sup>th</sup> Cir. 1996) (marks FIRSTBANK and FIRST BANK SYSTEM held not to be confusingly similar); *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 205 U.S.P.Q. (BNA) 981 (9<sup>th</sup> Cir. 1980) (ALPHA and ALPHA STEEL held not to be confusingly similar); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q. 2d (BNA) 1459 (Fed. Cir. 1998) (CRISTAL and CRYSTAL CREEK held not to be confusingly similar)]. Accordingly, conflict is avoided because the differences, even if relatively minor, enable consumers to differentiate them.

Indeed, the fact that marks have "identical, even dominant, words in common does not automatically mean that two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d (BNA) 1442, 1445 (8<sup>th</sup> Cir. 1987) (citations omitted). If the common portion is weak, conflict is often avoided even though the noncommon matter is suggestive or descriptive. In these cases, the differences between the marks, however slight, suffice to enable consumers to differentiate them. *Universal Money Centers, Inc. v. AT&T*,

22 F.3d 1527, 30 U.S.P.Q. 2d (BNA) 1930 (10<sup>th</sup> Cir.), *cert. denied*, 513 U.S. 1052 (1994) (UNIVERSAL and UNIVERSAL MONEY for credit and electronic banking cards not confusingly similar); *Industrial Adhesive Co. v. Borden, Inc.*, 218 U.S.P.Q. (BNA) 945, 951-52 (TTAB 1983) (BOND PLUS v. WONDER BOND PLUS for adhesives); *Redken Labs., Inc. v. Clairol, Inc.*, 501 F.2d 1403, 183 U.S.P.Q. (BNA) 84 (9<sup>th</sup> Cir. 1974) (CONDITION v. CURL & CONDITION for hair products); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 390 F.2d 1015, 157 U.S.P.Q. (BNA) 55 (C.C.P.A.), *cert. denied*, 393 U.S. 831, *reh'g denied*, 393 U.S. 971 (1968) (HI-DRI and SO-DRI for paper towels).

There is no indication that the registered mark, TEK RESOURCES, is a strong or famous mark. The mark is not inherently strong, nor is there any evidence whatsoever that it has acquired strength. Thus, the use of the term TEK alone sufficiently distinguishes it from TEK RESOURCES as a matter of law and renders it not likely to be confused by the public.

Moreover, the terms TEK, TEC, and TECH are subject to heavy third party use in connection with "technology" for employment-related services. *See* TECH USA (U.S. Reg. No. 2,407,621); TECH CENTER (U.S. Reg. No. 2,387,260); SEARCHTECH (U.S. Reg. No. 2,288,679); TECHSMART (U.S. Reg. No. 2,296,699); TECH SPECIALISTS (U.S. Reg. No. 2,117,296); SELECTECH (U.S. Reg. No. 1,915, 336); TECHSTAFF INC (U.S. Reg. No. 1,412,584); TECH TEMPS (U.S. Reg. No. 2,060,649); TECH STARS (U.S. Reg. No. 2,022,148). Indeed, the mark TEC, U.S. Reg. No. 2,365,757, is registered for temporary personnel placement services. As such, these terms are entitled to a narrow scope of protection. The common third party usage of descriptive terms weighs strongly against a finding of likelihood of confusion, as consumers are less likely to attribute the services to a single source. *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 1999),

citing *Sun Banks of Florida, Inc., v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 316, 211 U.S.P.Q. (BNA) 844, 849, *reh'g denied*, 659 F.2d 1079 (5<sup>th</sup> Cir. 1981). The impact of third party use of the terms TEK, TEC, and TECH is entitled to particularly heavy weight in a case such as this where the marks and services are so similar.

Because likelihood of confusion is a question of fact, the following factors must be considered: the nature and extent of any actual confusion; the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; and the extent of potential confusion. *Coca-Cola Co. v. Snow Crest Beverages, Inc.*, 162 F.2d 280, 73 U.S.P.Q. 518 (1<sup>st</sup> Cir.), *cert. denied*, 332 U.S. 809, *reh'g denied*, 332 U.S. 832 (1947). The absence of proof of actual confusion despite significant use of the marks for a substantial period of time indicates an absence of likelihood of confusion. *See Freedom Sav. and Loan Ass'n v. Way*, 757 F.2d 1176, 226 U.S.P.Q. (BNA) 123 (11<sup>th</sup> Cir.), *cert. denied*, 474 U.S. 845 (1985).

The TEK RESOURCES marks have been in use in commerce since 1988. Applicant's TEK mark has been in use in commerce since September 1997 in connection with services similar to those provided in connection with the TEK RESOURCES marks -- employee placement services -- as well as in connection with computer consulting services in International Class 42. Despite the use of the TEK and TEK RESOURCES marks for over four years in similar trade channels, Applicant is aware of only one incident of actual confusion that occurred in late 1997 or early 1998, when it first began to use its TEK mark. *See* Declaration of Paul J. Bowie, attached hereto and made a part hereof as Exhibit A. At that time, Applicant received several resumes from applicants that had been sent to Tek Resources, Inc. *See* Exhibit A. Since that time, there has been no actual confusion among consumers regarding the source of services

being provided. Thus, there is no factual basis to conclude that consumers might be confused – much less are likely to be confused – as to the source of the services they are purchasing.

The weakness of the marks, the proliferation of "tech" marks in the marketplace, and the differences between the subject marks are sufficient to obviate any reasonable likelihood of consumer confusion.

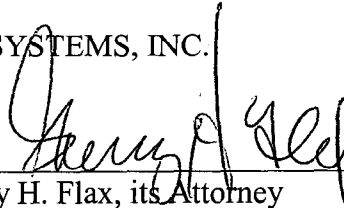
Respectfully submitted,

TEKSYSTEMS, INC.

Date:

Nov 20, 2002

By:



Sherry H. Flax, its Attorney  
SAUL EWING LLP  
100 South Charles Street  
Baltimore, Maryland 21201  
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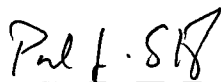
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EL 890469975 US, postage prepaid, in an envelope addressed to: Box TTAB – NO FEE, Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date indicated below.

This Certificate applies to Appeal Brief for Appellant, with Exhibit A.

Date of Mailing: March 21, 2002

Printed Name of Depositor: Paul J. Stumpf

Signature of Depositor:



Date of Signing: March 21, 2002

Trademark Attorney: Jordan T. Pulaski

**DECLARATION OF PAUL J. BOWIE**

I, Paul J. Bowie, declare that I am Vice-President of Finance, TekSystems, Inc. ("Applicant"), a Maryland corporation, and am authorized to make this declaration on behalf of said Applicant.

1. Applicant has used the TEK service mark extensively in connection with providing temporary and permanent placement of personnel and computer services in the information systems industry since September 1997.

2. Applicant is aware of only one incident of customer confusion with respect to the source of the services provided by Applicant under the TEK service mark. In late 1997 or early 1998, Applicant received several resumes from Tek Resources, Inc. that were intended by the customer to be sent to Applicant.

3. With the exception of the receipt of the resumes in late 1997 or early 1998, Applicant has had no encounters with Tek Resources, Inc. in connection with the operation of its business or use of the TEK service mark.

I HEREBY AFFIRM, under the penalties of perjury, that the foregoing is true and correct to the best of my knowledge, information and belief.

TEKSYSTEMS, INC.

By: Paul J. Bowie  
VP of Finance





TTAB

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March 21, 2002

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**Re: In re TEKSYSTEMS, INC.  
Mark: TEK  
Serial No.: 75/754,896**

Dear Sir or Madam:

Enclosed this date for the referenced mark are (1) Appeal Brief for Applicant, with Exhibit A; (2) Certificate of Mailing; and (3) postage-paid receipt postcard.

Please charge any applicable fees to Deposit Account No. 50-0469.

Thank you.

Very truly yours,

A handwritten signature in cursive script that reads "Paul Stumpf".

Paul J. Stumpf  
Legal Assistant

Encl.

cc: Sherry H. Flax, Esq.

A handwritten mark or signature in the bottom right corner of the page.