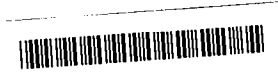


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of	:		:
United Parcel Service of America, Inc.	:		:
Serial No. :		76/309,259	:
Filed :		September 5, 2001	:
Mark :		QUANTUM VIEW OUTBOUND	:

Law Office 103
Examining Attorney
Tracy Cross

BRIEF FOR APPELLANT



12-29-2003
U.S. Patent & TMOt/TM Mail Rcpt Dt. #22

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MISCELLANEOUS

J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:413

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In re Application of	:	:
United Parcel Service of America, Inc.	:	Law Office 103
Serial No. : 76/309,259	:	:
Filed : September 5, 2001	:	Examining Attorney
Mark : QUANTUM VIEW OUTBOUND	:	Tracy Cross
	:	:

BRIEF FOR APPELLANT

INTRODUCTION

Applicant hereby appeals from the Examining Attorney's final refusal to register the above-identified mark by Office Action mailed on April 30, 2003, and respectfully requests that Trademark Trial and Appeal Board reverse the decision of the Examining Attorney.

Accordingly, Appellant submits this Brief.

APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of the mark:

QUANTUM VIEW OUTBOUND

for computer software providing enhanced tracking information on single or multiple piece shipments, package details, current shipping status, e-mail status updates, internet billing access, package arrival dates and delivery notification, in International Class 9; and transportation and delivery of personal property by air, rail, boat and motor vehicle, in International Class 39.

THE REJECTION

The Examining Attorney has refused registration of Applicant's mark contending that the mark as applied to the goods and services so resembles the mark shown in Registration No. 1,746,887 as to be likely to cause confusion, or to cause mistake or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The Examining Attorney has taken the position that the Appellant's QUANTUM VIEW OUTBOUND mark is likely to be confused with the mark OUTBOUND (the "Cited Mark") for computer software for use in calculating shipping costs and preparing shipping manifests, in International Class 9.

By Office Action mailed on April 30, 2003, the Examining Attorney made final the refusal to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Applicant subsequently filed a Request for Reconsideration but that Request was denied by the Examining Attorney on October 8, 2003. This appeal to the Trademark Trial and Appeal Board ("TTAB" or "Board") followed.

ARGUMENT

A. There Is No Likelihood of Confusion Between the Cited Mark and Applicant's Mark

In evaluating whether a mark sought to be registered is likely to be confused with a registered mark, the marks themselves must first be considered for similarities in appearance, sound, connotation and commercial impression. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). This analysis is often referred to as the "sight, sound, and meaning test." Second, the goods or services must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is

likely. Id. at 1361.



1. The Marks Differ Substantially in Sight, Sound and Meaning

The marks at issue differ substantially in sight, sound and meaning. A fundamental tenet in evaluating whether a likelihood of confusion may arise between two marks requires that the marks be considered as the public views them, in their entireties, and should not to be dissected. See In re National Data Corp., 753, F.2d 1056, 1057, 224 U.S.P.Q. 749, 750 (Fed. Cir. 1985); Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 850, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992). Here, the marks at issue, namely QUANTUM VIEW OUTBOUND and OUTBOUND, are readily distinguishable.

a. The Marks Are Not Similar in Appearance

In applying the first prong of the “sight, sound and meaning” test, it is submitted that Applicant’s Mark QUANTUM VIEW OUTBOUND does not look like the Cited Mark. Even though the Applicant’s Mark shares a common word with the Cited Mark, Applicant’s Mark is three separate words, while the Cited Mark is only one word. In addition, the first two words of Applicant’s Mark, comprised of eleven letters, are distinctive terms that make Applicant’s Mark considerably different in appearance. When the Cited Mark and the Applicant’s Mark are viewed (and compared) in their entireties, they look and appear differently and are readily distinguishable.

The Examining Attorney claims that because the Cited Mark is fully contained in Applicant’s Mark the “mere addition of a term is not sufficient to overcome a likelihood of confusion under Section 2(d).” It should be noted, however, that under the overall impression analysis, there is no rule that confusion is automatic merely because applicant has a mark that contains in part or in whole another’s mark. J.T. McCarthy, McCarthy on Trademarks and Unfair

Competition, §23:41 (4th ed. 2002). See, e.g., Conde Nast Publ'ns, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); In re Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); In re Merch. Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974) (In finding that MMI MENSWEAR was not confusingly similar to MEN'S WEAR, the Board found there is no absolute rule that no one has the right to incorporate the total mark of another as part of one's own mark).

b. The Marks Are Not Similar In Sound

When spoken aloud, the respective marks do not sound alike. While Applicant's Mark and the Cited Mark share a common word, this does not mean that the respective marks sound similar. "The mere use of a name which [another party] had a right to use can not in and of itself constitute unfair competition." Plough, Inc. v. Kreis Laboratories, 314 F.2d 635, 641, 136 U.S.P.Q. 560, 564 (9th Cir. 1963) (COPA TAN, COPA TINT, and COPA CREAM are not confusingly similar in sound to COCA TAN and COCA TINT).

When pronounced, Applicant's mark is three distinct words: QUANTUM, VIEW and OUTBOUND, comprising five syllables. When compared with the Cited Mark, Applicant's Mark has two more words and three more syllables. The first words spoken or heard, QUANTUM and VIEW, are distinctive terms that have no readily apparent meaning as applied to Applicant's goods and services. Thus, as in Plough, Inc., when the marks are spoken in their entireties, *even though they may contain the same word*, Applicant's Mark and the Cited Mark

do not sound confusingly similar at all. The additional words, QUANTUM and VIEW, serve to distinguish Applicant's Mark from the Cited Mark. Indeed, the Cited Mark (and the suffix portion of Applicant's mark) is not a strong mark deserving of a broad scope of protection but rather is weak since that dictionary term has some relation to the goods and services covered by the Cited Mark which relate to outward bound shipments.

c. The Connotation and Commercial Impression of the Marks Are Different

Each mark conveys to the public significantly distinct connotations and impressions. Although the Applicant's Mark and the Cited Mark share the commonly used shipping term "outbound," the respective marks, in their entireties, present a different impression because of their respective connotations. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) ("similarity or dissimilarity of marks in their entireties as to...connotation and commercial impression" is a factor to be considered in evaluating whether confusion is likely).

The words QUANTUM and VIEW are distinctive, fanciful terms as applied to Applicant's goods and services. When combined together with OUTBOUND, the entire mark conveys a wholly different commercial impression than that of the Cited Mark. The attention of consumers will be drawn to the first two, more distinctive words, QUANTUM and VIEW, which have no readily understood meaning in connection with the services covered by Applicant's Mark. In contrast, the term OUTBOUND carries a widely recognized meaning as applied to the goods and services covered by both the Cited Mark and Applicant's Mark.¹ The word "Outbound" as defined in WordNet 1.6 Copyright 1997 by Princeton University describes

¹ Indeed, that term is used descriptively on the outboundshipping.com website cited by the Examining Attorney (Attachment 6).

something that is “going out or leaving.”² The term OUTBOUND on the website relied upon by the Examining Attorney as evidence in support of her arguments describes packages that are precisely that: going out or leaving.

In contrast, Applicant’s Mark QUANTUM VIEW OUTBOUND is an arbitrary and fanciful term that conveys a unique commercial impression and connotation. The dictionary definition of QUANTUM includes: a quantity or amount; or a specified portion; or something that can be counted or measured. However, consumers are familiar with the use of that term in a scientific context (e.g., quantum physics, quantum mechanics, etc.) and therefore use of that term in connection with the goods and services covered by Applicant’s Mark is inherently distinctive. The VIEW portion of the Applicant’s Mark is suggestive of the ability of the consumers utilizing Applicant’s goods and services to have an individualized overview of the status of the different portions, parcels or quanta entrusted to Applicant. Finally, OUTBOUND is a highly suggestive term relating to the status and/or direction of travel of these portions, parcels or quanta. In contrast, the meaning or commercial impression conveyed by the Cited Mark is easily derived from its plain, descriptive meaning, particularly when applied to the goods covered by the Cited Mark. Little or no thought is required to understand the connotation of the term OUTBOUND as applied to the goods covered by the Cited Mark.

Applicant submits that the mark QUANTUM VIEW OUTBOUND presents an entirely different visual picture and meaning than the term OUTBOUND, by itself. If marks in their entireties convey different commercial impressions, likelihood of confusion between marks that add or delete a word can be avoided. See, e.g., In re Farm Fresh Catfish Co., 231 U.S.P.Q. 495

²The American Heritage dictionary defines outbound as “outward bound; headed away.” The American Heritage® Dictionary of the English Language, Fourth Edition. Copyright © 2000 by Houghton Mifflin Company.

(T.T.A.B. 1986) (BOBBER for restaurant services created a different commercial impression than CATFISH BOBBER for fish). For instance, the Board found that CROSS-OVER for bras and CROSSOVER for ladies sportswear conveyed different meanings. In re Sears, Roebuck, & Co., 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987). In that case, the words were nearly identical, and the goods were similar in that they were both items of women's clothing, yet the Board found there was no likelihood of confusion between the marks because of the different commercial impression.

d. Applicant's Mark Is Part of a Family of Marks

The marks are further distinguished by the fact that QUANTUM VIEW OUTBOUND is part of a family of marks. Applicant is the owner of a number of pending applications that share the same distinctive, origin-indicating terms QUANTUM and VIEW, namely: QUANTUM VIEW (Serial No. 76/309,257, Published for Opposition on March 11, 2003); QUANTUM VIEW (Serial No. 76/365,924, Published for Opposition on June 10, 2003); QUANTUM VIEW INBOUND (Serial No. 76/ 309,261, Published for Opposition on June 10, 2003); and QUANTUM VIEW NOTIFY (Serial No. 76/369,843, Published for Opposition on April 8, 2003). The print-outs from Applicant's website relied upon by the Examining Attorney demonstrate that Applicant has developed and is using a family of marks that share the distinctive term QUANTUM VIEW.

"A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in a way that the public associates not only with the individual marks, but the common characteristic of the family, with the trademark owner." J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462, 18 U.S.P.Q. 2d 1889, 1891 (Fed Cir. 1991); see e.g., AMF Inc. v. Am. Leisure Prods, Inc., 474 F.2d 1403, 177 U.S.P.Q. 268

(C.C.P.A. 1973). Applicant submits that it has developed consumer recognition for its family of QUANTUM VIEW marks such that the purchasing public identifies the term QUANTUM VIEW, whether or not accompanied by a suffix term such as NOTIFY, INBOUND or OUTBOUND, as indicating Applicant as the source or origin of the goods and services. The existence of the QUANTUM VIEW family of marks, and consumer recognition and acceptance of same, further dispels any possibility of confusion between Applicant's Mark and the Cited Mark.

e. The Cited Mark Should Not Be Afforded a Broad Scope of Protection

As noted above, the Cited Mark is highly suggestive, if not descriptive of, the goods covered by the Cited Mark. In addition, Applicant notes the following federal registrations of similar marks also for computer software:

1. Reg. No. 2,124,870 for OUTBOUND (Stylized) for computer software for remotely controlling computer operations, creating and deleting files and directories, making files compatible with and between main frames, personal computers, work station servers, cash registers, hand held devices; transferring files between these computers, in International Class 9, issued in 1997; and
2. Reg. No. 2,165,251 for the trademark OUTBOUND TRAIN for distributorships in the field of computer software; electronic distribution for others of computer software via electronic communications, in International Class 35 computer software design for others; design for others of computer-based training systems and computer programs available via electronic communications networks, in International Class 42, issued in 1998.

The Trademark Trial and Appeal Board has stated that such third-party registrations cannot assist an applicant in registering a mark "that is likely to cause confusion with a registered mark." In re Hamilton Bank, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1984). However, the Board did go on state that:

[s]uch registrations are, however, competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. We can also note from such registrations that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade and that marks containing the term or feature have been registered for the same or closely related goods or services because the remaining portions of the marks are sufficient to distinguish the marks as a whole from one another.

In re Hamilton Bank, 222 U.S.P.Q. at 177, (emphasis added), citing American Hosp. Supply Corp. v. Air Prods. and Chems., Inc., 194 U.S.P.Q. 340 (T.T.A.B. 1977). Applicant submits that the term "Outbound" is not a unique, coined term, but a commonly used and widely recognized term in the transportation field. Further, there are at least two other federal registrations for or comprising the identical term for the same goods, computer software. In view of the understanding of the public and trade of the descriptive properties of that term, the existence of third party registration for the same term for the same goods, the Cited Mark should not be afforded a broad scope of protection here, particularly where the marks differ substantially in sight, sound and meaning.

2. The Marks Are Applied to Disparate Goods and Services

The Cited Mark and Applicant's Mark must not be compared in the abstract, but in connection with their respective goods and services. See In re E.I. DuPont, 476 F.2d at 1361. Here, a connection to shipping software is where the similarity between the parties' goods begins and ends. Applicant contends that this similarity is not enough to support a likelihood of confusion.

It is the law in the Federal Circuit that a likelihood of confusion does not exist even when identical marks are used for the same category of goods. The goods must also be sufficiently similar. See, e.g., Dynamics Research Corp. v. Langenau Mfg. Co., 704 F.2d 1575, 1576, 217 U.S.P.Q. 649, 650 (Fed. Cir. 1983) (no likelihood of confusion between two DRC marks both used for goods in the metal fabrication industry); Elec. Design & Sales Inc. v. Elec. Data Sys., Corp., 954 F.2d 713, 716,

21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (no likelihood of confusion between EDS and E.D.S., where both marks used for products designed for the medical field); Reynolds and Reynolds Co. v. I.E. Sys. Inc., 5 U.S.P.Q.2d 1749, 1752 (T.T.A.B. 1987) (mere fact that the ACCU prefix was used by each party for computers was insufficient to support a likelihood of confusion).

The Examining Attorney argues that the goods and services offered under the two marks in question are related. However, the only similarity between the goods and services is that they relate generally to shipping software. The TTAB has said there can be no rule that certain goods and services are per se related. See, e.g., In re Quadram Corp., 228 U.S.P.Q. 863 (T.T.A.B. 1985) (regarding computer hardware and software). Each case must be decided on its own merits. See In re Ampco Foods, Inc., 227 U.S.P.Q. 331 (T.T.A.B. 1985). Specifically, the courts have found that "there is certainly no rule that all computer products and services are related." Sports Auth. Michigan Inc. v. PC Auth. Inc., 63 U.S.P.Q.2d 1782 (T.T.A.B. 2002). In Quadram Corp., the Board found that the two marks MICRIOFAZER and FASER were not confusingly similar. The Board stated that:

As a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized uses in this industry, we think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace. We note that, in the past, tendencies toward applying "per se" rules relating to likelihood of confusion in other fields have been struck down as being too inflexible and contrary to trademark law where each case must be decided based on its own facts and circumstances.

In re Quadram Corp., 228 U.S.P.Q. at 865. Applicant's mark QUANTUM VIEW

OUTBOUND is no more similar to the Cited Mark OUTBOUND than the above cited marks are to

each other. In addition, as noted above, there are other OUTBOUND marks that are registered for software and software-related services.

The Cited Mark is limited to computer software for use in calculating shipping costs and preparing shipping manifests. These tasks are usually conducted in preparation for shipping a package. The purpose and function of the computer software identified in Applicant's Mark is readily distinguishable from the software identified in the Cited Mark as they pertain to information concerning the package en route and at delivery. Specifically, Applicant's software program provides customers access to personalized and enhanced tracking information.

Therefore, although both marks are used for computer software, the similarities end there as the respective software products have different and distinct intended uses and functions. Because of the "almost limitless number of specialized products and specialized uses in [the software] industry", the concurrent use and registration of Applicant's Mark and the Cited Mark is not likely to confuse consumers. *Id.* at 865.

3. The Respective Marks are Offered Through Different Channels of Trade to Sophisticated Consumers

Applicant submits that the respective products and services covered by the Cited Mark and Applicant's Mark are offered and sold through different channels of trade and that the goods and services Applicant offers under the QUANTUM VIEW OUTBOUND mark are marketed to sophisticated consumers. The law in the Federal Circuit (as well as the law in other circuits) requires a detailed examination into the parties' respective channels of trade and the sophistication of the relevant purchasers. As shown below, in cases such as this one, these factors are not necessarily mere considerations, they can be determinative.

In Elec. Design & Sales, 954 F.2d 713, the parties' marks were virtually identical. Opposer's mark was EDS mark for computer services and Applicant's mark was E.D.S. mark for component

parts of medical equipment. Not only were the respective goods sold in the same medical field, but they were also sold to some of the same large corporations. Opposer sold its product to medical insurers and Applicant sold its goods to manufacturers of medical equipment.

The court held that although the marks were identical, it was an error to deny registration just because both parties' goods were marketed and sold in the medical field or to the same companies. Instead, the court found that there was no likelihood of confusion because the parties' goods were non-competitive and purchased by different customers:

Thus, although the two parties conduct business not only in the same fields [with the same marks] but also with some of the same companies, the mere purchase of goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. The likelihood of confusion must be shown to exist not in a purchasing *institution*, but in "a customer or purchaser."

Elec. Design & Sales Inc., 954 F.2d at 717 (citing Astra Pharmaceutical Prods., Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206 (1st Cir. 1983). Accord, Electronic Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460 (T.T.A.B. 1992) (no likelihood of confusion between EDS for computer programming services including electronic data processing programs and EDSA for computer programs for performing system analysis and design, even though parties' software was often purchased by the same large companies. Because the ultimate consumers occupied different positions in companies and purchasers were highly sophisticated, the court held that confusion was unlikely.)

Likewise, in USA Network v. Gannett Co., Inc., 584 F.Supp. 195, 223 U.S.P.Q. 678 (D. Colo. 1984), the district court found that there was no likelihood of confusion between USA NETWORK for cable television services and KUSA for a television station, because the purchasers of the parties' respective services were advertisers who were highly sophisticated and who "exercise great care" in placing advertisements. Id. at 681. See also Info. Res. Inc. v. X*Press Info. Serv., 6

U.S.P.Q.2d 1034, 1038-39 (T.T.A.B. 1988) (no confusion between EXPRESS for computer software for data management and X*PRESS for news service data stream delivered to computers via cable television operators where goods and services are expensive and purchasers exercise care); The United States Jaycees v. Commodities Magazine Inc., 661 F.Supp. 1360, 1363, 2 U.S.P.Q.2d 1119, 1122 (N.D. Iowa 1987) (due to different trade channels, no likelihood of confusion between FUTURE magazine distributed by mail and not sold on newsstands and FUTURES magazines sold for commodities and options, *distributed to subscribers*); Homeowners Group, Inc. v. Home Mktg. Specialists, Inc., 931 F.2d 1100, 1109, 18 U.S.P.Q.2d 1587, 1594 (6th Cir. 1991) (no likelihood of confusion between parties' use of HMS in real estate industry - both on rooftop designs, because companies operate at different levels in real estate and sell to different buyers); Pan Am. World Airways, Inc. v. Panamerican Sch. of Travel, Inc., 648 F. Supp. 1026, 1036-37, 1 U.S.P.Q.2d 1020, 1027 (S.D.N.Y. 1968) (no likelihood of confusion between PAN AMERICAN for airline and travel related services and PANAMERICAN SCHOOL OF TRAVEL for a school that trains travel agents and airline ticketing personnel), aff'd, 810 F.2d 1160 (2d Cir. 1986).

The type of goods and services offered under the mark QUANTUM VIEW OUTBOUND are specialized and offered only through Applicant's website to Applicant's subscribing customers. See United States Jaycees v. Commodities Magazine Inc., 661 F.Supp. at 1363. Specifically, consumers are exposed to the mark QUANTUM VIEW OUTBOUND by accessing the services offered and provided only through the Applicant's popular "ups.com" website. The evidence of record includes a screenshot of Applicant's website which provides: "[t]o use Quantum View Outbound, your company must have a UPS Account and must be registered with MY UPS.COM" (See Attachment 11 to Examining Attorney's Final Action), and on Attachment 1 to the Examining Attorney's Final Action, it states "QUANTUM VIEW OUTBOUND provides information about packages you ship using your UPS Accounts." The information of

record from Applicant's ups.com website demonstrates that the goods and services provided under QUANTUM VIEW OUTBOUND are marketed primarily to consumers who are already subscribing customers of Applicant and who must download Applicant's software product from Applicant's website.

Applicant submits that its consumers are primarily businesses, and the individuals making the software acquisition decisions on behalf of these businesses are professionals with technical expertise in the field, who recognize the value of Applicant's software products and services. For example, before such a professional would agree to a contract to use and then download and install any type of software for his or her employer's business, it is reasonable to expect such potential customers to exercise a high degree of care, evaluating all possible benefits, risks and other available options. This high degree of purchasing care significantly reduces the likelihood of confusion between the marks. See e.g., Elec. Design & Sales Inc., 954 F.2d 713; See also Freedom Savings and Loan Ass'n v. Way, 757 F.2d 1176, 1185, 226 U.S.P.Q. 123, 129 (11th Cir. 1985), cert. denied, 474 U.S. 845 (1985).

Through its QUANTUM VIEW OUTBOUND product, Applicant provides its corporate clients with discrete and sophisticated shipping services and support, as noted on the Examining Attorney's Attachment 11. Applicant's goods and services offered under Applicant's Mark are marketed to Applicant's registered customers, and these customers exercise due care in purchasing or using the sophisticated software products and services offered under Applicant's Mark. Indeed, as part of registering for QUANTUM VIEW brand services, Applicant requires that a company authorize a representative to act as its Corporate Administrator. Only that Corporate Administrator has authority to manage access to that company's UPS Accounts, and only one Corporate Administrator may be established for each UPS Account. (See Attachment 1

to Applicant's Request for Reconsideration). Presumably, the sole Corporate Administrator entrusted with choosing software for the purpose of addressing and meeting various shipping, tracking and billing needs for a company will exercise care in doing so.

Although there is no information of record concerning the purchasers of the software sold under Applicant's Mark, there is no reason to believe that consumers purchasing such shipping software from Applicant would do so in an impulsive manner but rather would use care in any purchasing decision for such business shipping software. Courts have consistently held that care in purchasing may minimize likelihood of confusion. See Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr., 109 F.3d 275, 42 U.S.P.Q.2d 1173 (6th Cir. 1997) (when services are expensive or unusual, the buyer can be expected to exercise greater care in their purchases). Applicant offers very specialized and technical software services for its sophisticated customers. There is less likelihood of confusion when services are sold to such buyers. Electropix v. Liberty Livewire Corp., 178 F. Supp. 2d 1125, 60 U.S.P.Q.2d 1346 (C.D. Cal. 2001) (finding sophistication of consumers in that specialized area would render it unlikely that consumer confusion will arise between LIBERTY LIVEWIRE and LIVE WIRE).

CONCLUSION

The Lanham Act supports refusal of registration based on confusion only where such confusion is likely. The fact that confusion may be possible will not support a finding of likelihood of confusion. In re Massey-Ferguson Inc., 222 U.S.P.Q. 367, 368 (T.T.A.B. 1983), quoting from Witco Chemical Co. v. Whitfield Chem. Co., 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969):

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which trademark laws deal.

Applicant respectfully submits that its mark QUANTUM VIEW OUTBOUND, for the aforementioned goods and services, is not confusingly similar to the Cited Mark. The two marks differ significantly in sight, sound and meaning. The respective goods and services are not closely related but rather, have distinctly different applications and functions in the larger market of shipping software. Further, Applicant uses its mark through its ups.com website making its goods and services available only to its registered customers who are sophisticated purchasers. Finally, QUANTUM VIEW OUTBOUND is part of a family of marks, created by Applicant, that center upon the distinctive, origin-indicating term QUANTUM VIEW.

In view of the foregoing, Applicant respectfully requests that the Board grant this appeal and overturn the refusal of the Examining Attorney to register the Applicant's Mark under Section 2(d) and approve Application Serial No. 76/309,259 for publication.

Respectfully submitted,

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December 29, 2003



12-29-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

VIA EXPRESS MAIL NO.: EV073347927US

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Re: United Parcel Service of America, Inc.
Serial No.: 76/309,259
Filed: September 5, 2001
Mark: QUANTUM VIEW OUTBOUND
Examining Attorney: Tracy Cross

Dear Madam:

We enclose herewith on behalf of UNITED PARCEL SERVICE OF AMERICA, INC., a copy of the Brief for Appellant in response to the Examining Final Refusal to register Application Serial No. 76/309,259 for QUANTUM VIEW OUTBOUND.

Please acknowledge receipt of the foregoing on the enclosed postcard.

Very truly yours,

David M. Viscomi

DMV/cr
Enclosures

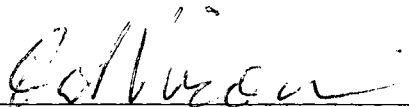
CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

Express Mail Label No.: EV073347927US

Date of Deposit: December 29, 2003

I hereby certify that the attached correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to:

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Arlington, Virginia 22202-3514



David M. Viscomi