MAR 8 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/309259

APPLICANT: United Parcel Service of America, Inc

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MARK: QUANTUM VIEW OUTBOUND

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	United Parcel Service of America, Inc.	:	BEFORE THE
Trademark:	QUANTUM VIEW OUTBOUND	:	TRADEMARK TRIAL
Serial No:	76/309259	:	AND
Attorneys:	Thomas H. Curtin Keith E. Sharkin	:	APPEAL BOARD
Address:	King & Spalding LLP 1185 Avenue of the Americas New York, New York 10036	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's refusal to register the proposed mark **QUANTUM VIEW OUTBOUND** on the ground that it so resembles the mark in U.S. Registration No. 1746887 when used with the goods and services, that it is likely to cause confusion under Section 2(d) of the Trademark Act (the "Act"), 15 U.S.C. 1052(d).

FACTS

United Parcel Service of America, Inc. ("Applicant") has applied for registration on the Principal Register of the proposed 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" and "transportation and delivery of personal property by air, rail, boat, and motor vehicle." The application was filed as an Intent- to-Use application pursuant to Section 1(b) of the Act, 15 U.S.C. 1051(b).

Registration was refused on the Principal Register under Section 2(d) of the Act because the applicant's mark, when used on or in connection with the identified goods and services, so resembles the mark in U.S. Registration No. 1746887 as to cause confusion, to cause mistake, or to deceive. The registrant's goods encompass "software for use in calculating shipping costs and

preparing shipping manifests." Evidence consisting of excerpted pages from the World Wide Web was entered into the record in support of the refusal. The evidence demonstrates that the same entity may provide software and services for shipping, and that potential consumers may encounter the goods and services of both parties in the same relevant marketplace.

Applicant responded by contending that the audial and visual differences between the marks, and the differing channels of trade mitigate against a likelihood of confusion. When the refusal was made final on April 30, 2003, applicant appealed. The applicant filed a request for reconsideration on July 30, 2003, which was denied on October 8, 2003.

ARGUMENT

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the goods/services, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

I. Relatedness of the Goods/Services

The goods/services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re*

Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

A. The Goods/Services are Closely Related

The issue is not likelihood of confusion between particular goods/services, but likelihood of confusion as to the source of those goods/services. *See In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP section 1207.01. It is very likely that consumers may mistakenly believe that the same entity provides both the applicant's software and services and the registrant's software.

According to the applicant's website, "Quantum View is a Web-based service that provides shipment manifest information, status updates and event alerts for your inbound and outbound packages." Further, "Quantum View can help improve your inventory management, operational planning, and customer service." According to the registrant's website, "Outbound is a flexible software package designed for medium to high volume shippers" and is a "fully automated shipping solution for UPS, FedEx,…" Also, the registrant's system "can be fully integrated into sophisticated shipping environments..." See attached highlighted web pages made previously of record. Potential customers may mistakenly believe that the software packages of both applicant and registrant are provided by the same entity.

Additionally, the software of each party provides tracking information, delivery confirmation, and shipping information. The function of the applicant's software appears to encompass the capabilities offered through the registrant's software. The "package details" and "internet billing access" provided by the applicant's software could include the "shipping manifests" and "shipping costs" provided by the registrant's software. Hence, it appears reasonable to conclude that

registrant's software may be used in conjunction with the applicant's software. The purchasing public may further believe that the registrant's software is used in the provision of the applicant's services.

Consumers are likely be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

B. Channels of Trade

The examining attorney must determine whether there is a likelihood of confusion on the basis of the goods/services identified in the application and registration. If the cited registration describes the goods/services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all goods/services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). TMEP §1207.01(a)(iii).

Likewise, if the application describes the goods/services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application encompasses all goods/services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. TMEP §1207.01(a)(iii). In this case, neither the registrant's goods, nor the applicant's goods/services are further restricted in the field of use or the manner of delivery.

Although the applicant alleges that its customers exercise due care in purchasing, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Potential consumers seeking shipping software and services may mistakenly believe that the goods/services of both parties emanate from the same source.

II. Comparison of the Marks

If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

The applicant's mark is the typed phrase QUANTUM VIEW OUTBOUND, and the registrant has the typed mark OUTBOUND. The mere addition of the terms QUANTUM VIEW to the registered mark OUTBOUND does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER");

Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b)(iii).

Applicant argues that the proposed mark is part of the applicant's family of marks. In this case, the "family of marks" is analogous to "house marks." The addition of a house mark does not avoid any possibility of confusion. Where marks are otherwise virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks. *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982). It is likely not only that the two products sold under these marks would be attributed to the same source but also that purchasers would mistakenly assume that both were products of applicant by virtue of its use of QUANTUM VIEW with the shared term OUTBOUND. *See In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986), citing *Menendez v. Holt*, 128 US 514 (1888) ("It is a general rule that the addition of extra matter such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them."); *A.T. Cross Co., v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 176 USPQ 15 (2nd Cir. 1972); *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 168 USPQ 1 (2nd Cir 1970); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200 (C.C.P.A. 1955); *Hammermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662, 143 USPQ 237 (C.C.P.A. 1964). Each such case must be determined on its own facts and circumstances. *Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (C.C.P.A. 1967).

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods or services. *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigoror Industries,* 31 USPQ2d 1592 (3d Cir. 1994).

Lastly, the applicant asserts that the cited mark is not strong, thus deserving a limited scope of protection. Even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

The totality of the evidence of record is sufficient to demonstrate that the relevant public is likely to mistakenly believe that both products originate from the same entity.

CONCLUSION

For the foregoing reasons, it is concluded that the similarity of the marks and the relatedness of the goods support the conclusion that confusion as to the source of the goods is likely.

Accordingly, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d) should be affirmed.

Respectfully submitted,

T Cross

Tracy Cross

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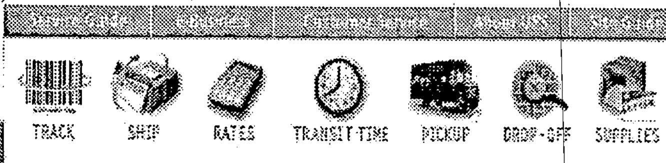

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Quantum View Outbound™

KEEP AN EYE ON YOUR SHIPMENTS

Quantum View Outbound is a secure Web-based service that provides frequent updates about the packages you ship with UPS. Shipping status, delivery, and exception information is available up to hourly. This increased visibility into the movement of your goods can help you:

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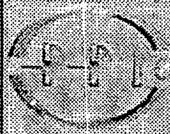
- Improve inventory management and planning.
- Bill your customers as soon as shipments arrive, improving the efficiency of your receivables processes.
- Provide proactive customer service by notifying customers before their shipment is overdue.
- Aggregate shipping information across shipping platforms and/or multiple locations.
- Reduce time spent tracking individual packages.
- Get straight to the analysis by using file formats that import directly into familiar desktop applications or enterprise systems.

CHOOSE FROM THREE SERVICE OPTIONS

- **Outbound Notification** - Complete information about outbound packages. Includes status updates through delivery with ship date, exception, and delivery detail. You can also add date elements for a complete manifest.
- **Delivery Notification** - Provides delivery details and manifest information, including ship date, date and time of delivery, reference number, full delivery address, the name of the person who signed for the delivery, COD Amount collected, and other valuable delivery information. You can also add origin information and complete manifest data elements.

  Note: Delivery Notification does not include the signature image or exception updates.
- **Exception Notification** - Provides information about packages shipped that will not make the scheduled date of delivery. This includes exception status as well as re-scheduled date of delivery. This service provides a limited



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OutBound Parcel Shipping System

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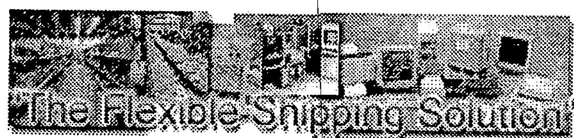
Features & Benefits

- Multi-Carrier Support - OutBound is a fully automated shipping solution for UPS, FedEx, Airborne Express, US Postal Service, and several regional parcel carriers and most LTL carriers.
- Automatic shipping label and compliance label printing.
- Multiple workstation, multiple company support.
- Comprehensive shipment reporting module.
- UPS "online" certified- sends package level detailed information to UPS automatically.
- Automatic Rate Shopping- selects the least expensive shipping method, saving time and money
- Flexible integration with order entry, accounting, customer service and other systems.
- Contents Tracking module- interfaces with "order entry" and verifies the product and quantities packed and shipped in each container. This data can be used to produce the ***"Advanced Shipping Notification" (ASN)***, required by many companies.
- Picker/Packer Tracking.
- USPS "Delivery Confirmation" certified.
- Barcode ready
- Unbeatable support
- Easy to use



The OutBound Difference

Unlike most shipping system vendors, we developed and support our own software. Our intimate knowledge of our product not only allows us to offer the finest support in the industry, it enables us to customize OutBound to fit ***your*** company's specific needs. PPI is a full service consulting firm with over ten years experience in the areas of system integration, distribution and warehouse management. We know the business and understand that every company has a unique combination of policies, procedures and shipping requirements. We believe that shipping software should conform to the way that ***you*** do business.

What makes OutBound stand out from the rest of the field?

Customization!