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Mailed: July 18, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pro Tech Monitoring, Inc.

Serial No. 77795303

Nathan P. Suedmeyer of Larson & Larson PA for Pro Tech Monitoring, Inc.

Allison Holtz, Trademark Examining Attorney, Law Office 111 (Robert Lorenzo, Managing Attorney).¹

Before Holtzman, Cataldo and Lykos,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Pro Tech Monitoring, Inc. filed an application, as amended, to seek registration on the Supplemental Register for the mark OFFENDER TRAX in standard characters for "non-downloadable software for use in offender monitoring services" in International Class 9.²

¹ The above application was originally examined by another examining attorney, but was subsequently reassigned to the attorney whose name is shown to prepare the appeal brief.

² Application Serial No. 77795303 was filed on August 3, 2009 on the Principal Register, based upon applicant's assertion of its bona fide intent to use the mark in commerce. In response to a refusal to register based upon mere descriptiveness, applicant

Registration has been finally refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark OFFENDERTRAK (in typed or standard characters) in Registration No. 2641997³ for "computer hardware and software providing a centralized database of inmate, facility and operational information for jail and correctional facilities" in International Class 9, as to be likely, if used on or in connection with the identified goods, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed main briefs on the issue under appeal.

Likelihood of Confusion

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie*

amended its application to assert April 30, 2008 as a date of first use of the mark anywhere and in commerce and to seek registration on the Supplemental Register.

³ Issued on October 29, 2002.

Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's OFFENDER TRAX mark and registrant's OFFENDERTRAK mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

In this case, the marks OFFENDER TRAX and OFFENDERTRAK are nearly identical in appearance and sound. Both marks share the identical first term OFFENDER, followed by the

nearly identical terms TRAX and TRAK. The only differences between the marks are the fact that registrant spells its mark with a letter "K" in TRAK and without a space between the terms OFFENDER and TRAK, whereas applicant substitutes the letter "X" in TRAX and displays its mark with a space between OFFENDER and TRAX. Thus, both marks display the same terms with nearly identical novel spellings, and with applicant's mark essentially being a plural form of registrant's.

The presence or absence of a space between virtually the same words is not a significant difference. *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"); and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"). Also, the word "TRAX" is the equivalent of the word "TRAK." *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (there is no material difference, in a trademark sense, between singular and plural forms of a word).

In addition, it is difficult to perceive any difference in the marks' connotations. Both marks convey the ability to track offenders, and this connotation is borne out by the goods identified under both marks. Contrary to applicant's arguments, we conclude that the marks are nearly identical in appearance, sound and connotation and, overall, convey highly similar commercial impressions.

The Goods

In making our determination under the second *du Pont* factor we look, as we must, to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of

likelihood of confusion must be decided on the basis of the respective descriptions of goods.”)

In this case, applicant’s goods are identified as “non-downloadable software for use in offender monitoring services” and registrant’s goods are identified as “computer hardware and software providing a centralized database of inmate, facility and operational information for jail and correctional facilities.” According to applicant, its goods “allow users to view one or multiple offenders’ location at the same time on a single mapping screen” and permit “authorized users to quickly compare offender tracking points or to review a particular area to identify any offenders who may have travelled to the area.”⁴ In other words, applicant’s goods permit the user to monitor the location of one or more offenders or monitor an area to identify offenders who may have been in that location. Registrant’s goods include computer hardware and software for jails and correctional facilities providing a database of information regarding inmates as well as the operational information regarding the facilities themselves. Because there is no limitation on the types of inmate information collected by registrant’s goods, it is

⁴ Applicant’s April 19, 2010 Response to Office Action.

presumed that it may include information regarding the location of such inmates within a jail or correctional facility. Thus, as identified, registrant's goods provide information regarding the location of inmates within a correctional facility and applicant's goods provide information regarding offenders outside of correctional facilities, i.e., in the community.

In addition, the examining attorney has introduced evidence from commercial and informational Internet websites suggesting that goods performing functions related to those performed by both applicant's and registrant's goods are available by the same entities under the same marks. The following examples are illustrative:

Digital Solutions/Inmate Telephone, Inc.
The Probation & Parole Management System features five primary modules: Offender Case Management, Home Monitoring Module, Chronological Case Notes, Fines & Costs, and Community Service.
Jail Management Solution
From intake to release, information on all aspects of an inmate's incarceration are maintained - including initial intake, charges, sentencing, property, housing, medical, meal planning, scheduling, and temporary release to name a few; and
(disiti.com)

Syscon.net
Over the past 27 years, Syscon has become the #1 global supplier of Offender Management System (OMS) by following the path of integrated solutions for integrated problems. Syscon's

world-beating IAG system creates a seamless records environment that carries an offender from pre-trial through to the end of supervision, whether that be release from detention, parole or probation. It can be used to fully integrate offender tracking and monitoring through County Jails, State Prisons and Community Corrections agencies of all kinds.
(aboutus.org/Syscon.net)

Based upon the goods recited in the involved application and the cited registration and the evidence of record, we find that applicant's goods are related to those provided by registrant.

Channels of Trade

It is settled that in making our determination regarding the channels of trade, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc., supra*; and *Paula Payne Products v. Johnson Publishing Co., supra*. In this case, applicant's goods are "for use in offender monitoring services" and registrant's goods are "for jail and correctional facilities." However, there is no evidence of record that these trade channels are mutually exclusive. Furthermore, and as noted above, it is not necessary for the goods to be directly competitive or move in the same trade channels to support a finding of likelihood of confusion. See *In re International Telephone & Telegraph Corp., supra*. In this

case, applicant and registrant use nearly identical marks to identify software for offender monitoring on one hand and hardware and software for a database of, *inter alia*, inmate information on the other. The Internet evidence made of record by the examining attorney shows that these goods may emanate from a common source and be marketed to the same consumers.

Sophistication of Purchasers

The final *du Pont* factor discussed by applicant and the examining attorney is that of the conditions of sale. Applicant asserts that its goods would be purchased by careful and sophisticated users. However, sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). Moreover, in view of the evidence showing the same entities providing goods similar to those of both applicant and registrant, prospective purchasers may mistakenly believe that these goods could emanate from a single source. In addition, even if some degree of care were exhibited in making the purchasing decision, the involved marks OFFENDER TRAX and OFFENDERTRAK are so nearly identical that even careful purchasers are likely to assume that the marks identify goods emanating from a single source.

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Weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Shell Oil Co., supra*; *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc., supra*.

Decision: The refusal to register is affirmed.