

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
February 28, 2017

Mailed:
April 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re ECI Software Solutions, Inc.

—
Serial No. 86544101

—
Peter J. Willsey, Vincent J. Badolato, and Shane M. Rumbaugh of Cooley LLP for
ECI Software Solutions, Inc.

Nicole Nguyen, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop,
Managing Attorney).

—
Before Adlin, Masiello, and Goodman, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

ECI Software Solutions, Inc. (“Applicant”) filed an application for registration on
the Principal Register of the mark NAVERISK in standard characters for the
following goods and services:¹

Computer software for the monitoring and management
of IT systems; computer software for project and resource
management, specifically excluding software that
facilitates or relates to Policy Management, insurance

¹ Application Serial No. 86544101 was filed on February 24, 2015 under Trademark Act
Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s alleged *bona fide* intention to
use the mark in commerce.

claims management and loss control, in International Class 9;

Computer services for the monitoring and management of IT systems; design and development of computer software for others, specifically excluding the design and development of software that facilitates or relates to Policy Management, insurance claims management and loss control; computer services for project and resource management, specifically excluding computer services relating to Policy Management, insurance claims management and loss control; computer technical support services, namely, service desk or help desk services for IT systems; providing online non-downloadable software for use in the monitoring and management of IT systems, in International Class 42.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods and services, so resembles the registered mark NAVRISK (in standard characters) as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for "Computer software platforms for Policy Management, insurance claims management and loss control," in International Class 9.² When the refusal was made final, Applicant appealed to this Board and filed a request for reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. The case is fully briefed and Applicant and the Examining Attorney appeared at an oral hearing on February 28, 2017.

² Reg. No. 3526752, issued November 4, 2008; Section 8 affidavit accepted.

1. Evidentiary matter.

Applicant objects to the evidence that the Examining Attorney submitted for the first time with her brief.³ That evidence is untimely. 37 C.F.R. § 2.142(d);⁴ TBMP § 1207.01 (Jan. 2017). The new evidence is not suitable for judicial notice⁵ because it does not consist of facts “not subject to reasonable dispute” nor does it come from “sources whose accuracy cannot reasonably be questioned.” *See* Fed. R. Evid. 201(b). We have not considered the evidence.

2. Refusal under Section 2(d).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also presented evidence and arguments regarding customers, and lack of actual confusion.

³ Applicant’s reply brief at 6, 14 TTABVUE 7.

⁴ “Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.”

⁵ Examining Attorney’s brief, 13 TTABVUE 14.

(a) The marks.

We first consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and 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). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

The marks NAVERISK and NAVRISK are quite similar in appearance. They differ by only a single letter and otherwise share the letter strings NAV and RISK in the same order. As to sound, while it is true that there is no single correct pronunciation of a coined trademark, *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012), it is nonetheless obvious that these two marks could be pronounced the same, as they are so highly similar in spelling. With respect to meaning, both marks appear to be coined terms having no recognized meaning. To the extent that they may be perceived as suggestive, they are likely to convey the same suggestive meaning or connotation because they are so similar. Applicant’s argument that the registered mark suggests “navigating risk,” while Applicant’s mark does not because it is a “fanciful term,”⁶ is not persuasive. Applicant provides

⁶ Applicant’s brief at 3, 11 TTABVUE 7.

no explanation for why the addition of the letter E in its mark should suffice to rid its mark of the suggestion of navigation and risk.

Considering the marks in their entirety, with their similarities in appearance, sound, and connotation, and their very minor differences, we find that they create highly similar overall commercial impressions. Therefore, this factor weighs heavily in favor of a finding of likelihood of confusion.

(b) The goods and services.

We next consider the similarity or dissimilarity of the goods and services as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We need not consider whether each of Applicant's identified goods and services is related to Registrant's goods; for purposes of a *du Pont* analysis, it is sufficient if likelihood of confusion is found with respect to use of an applicant's mark in connection with any good or service in a particular International Class. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). In this case, both Applicant and the Examining Attorney have focused their attention on comparing Registrant's "Computer software platforms for Policy Management" with Applicant's computer software and computer services "for the monitoring and management of IT systems." Applicant correctly points out that it would be unrealistic to suggest that

all types of computer software are commercially related goods for purposes of a *du Pont* analysis,⁷ and the same is true when comparing computer software and computer services.

The Examining Attorney and Applicant disagree as to the meaning of “Policy Management” as used in the cited registration. Applicant contends that this term is ambiguous and argues:

The phrase “policy management” should be construed *conjunctively*, not disjunctively, with the remaining text in the description. ... The inclusion of the phrases “insurance claims management” and “loss control” in the description of goods for the Cited Mark are obvious references to *insurance* policy management. Use of these other terms makes clear that the registrant included “policy” in its description of goods as a reference to insurance policies or agreements ...⁸

Clearly, if we construe “Policy” to mean “insurance policy,” the software identified in the cited registration would have a very particular purpose, *i.e.*, to assist in the administration of the contractual terms of insurance policies. Applicant argues that such insurance-related software is far different from its own software and computer services for managing information technology (“IT”).

The Examining Attorney contends, however, and the record shows, that “policy management” is a term of art in the administration of business enterprises. The record includes references to many third-party products that are described as “policy management” software. Advertisements describe these software products as helping businesses create, update and change internal policies; to keep track of

⁷ Applicant’s brief at 4-5, 11 TTABVUE 8-9.

⁸ *Id.* at 7, 11 TTABVUE 11 (emphasis in original).

them by storing and organizing them; to make current versions of the policies readily available to employees for their reference; to facilitate educating employees about them; to enforce them; and to assess employees' compliance with them. They are often described as helping businesses coordinate internal policies and comply with government regulations. Some examples from the record are set forth below:

DynamicPolicy is a Web-based application that automates and manages the complete cycle of creation, distribution, publication, education and enforcement of corporate policies and procedures. ... Management is also able to track the understanding and compliance of the corporate policies among employees ...⁹

PolicyStat is policy management software that gets your staff the information they need when they need it. ... Keeping policies current and easy for your staff to find reduces risks and eliminates surprises.¹⁰

Thomson Reuters Policy Manager: Ensure compliance through effective policy management across your organization. ... [A]n enterprise-wide solution that directly connects your organization's internal policies with the governing external regulations.¹¹

Accountable is an online HIPAA compliance management platform that helps organizations manage employee training, business associate agreements, and their annual risk assessment. The software was developed to help simplify the process of becoming HIPAA compliant ...¹²

PowerDMS: Reduces the cost and complexity of policy management and training by storing, updating, disseminating, and tracking critical content.¹³

⁹ Applicant's response of June 1, 2016 at 50.

¹⁰ *Id.* at 67.

¹¹ *Id.* at 66.

¹² *Id.* at 34.

¹³ *Id.* at 34.

RSA Archer Policy Management Software that provides a consistent process for managing the lifecycle of corporate policies and their exceptions. It offers a centralized infrastructure for creating policies, standards, and control procedures and mapping them to corporate objectives, regulations, industry guidelines, and best practices.¹⁴

MetricStream IT Policy Management Software Solution: ... provides a central repository for storing and organizing all types of IT policies based on various templates and classification criteria with automatic or user defined numbering scheme. ...The solution allows users to create a new or to change an existing IT policy. ... The solution provides tight integration between the IT policy and procedure repository and the IT compliance, risk and control framework.¹⁵

BWise Compliance & Policy Management Software Solution: ... BWise helps compliance teams quickly identify company policies and business processes directly impacted by each regulation.¹⁶

See also references to similar software products under the marks ARALOC, MCN Healthcare Policy Manager, and Check Point.¹⁷ Applicant agrees that this type of “policy management software” is “software designed to manage organizational policies and procedures and assist policy drafters in writing, sharing, updating, and attesting to policy changes.”¹⁸

Applicant and the Examining Attorney agree that the Board may look to extrinsic evidence in order to determine the meaning of “Policy Management.” However, Applicant goes too far in arguing that we should look to Registrant’s internet

¹⁴ Office Action of December 1, 2015 at 16.

¹⁵ *Id.* at 23.

¹⁶ *Id.* at 27.

¹⁷ Applicant’s response of June 1, 2016 at 34 and 30; Office Action of December 1, 2015 at 8.

¹⁸ Applicant’s brief at 10, 11 TTABVUE 14.

website in order to learn that Registrant's software is primarily (or perhaps exclusively) insurance-related, citing *In re Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1990). Indeed, as the Examining Attorney correctly argues, such extrinsic evidence may not be used to limit in any way the scope of protection accorded the cited registration.

In *Trackmobile*, the Board was faced with interpreting an identification of goods that included an industry term of art ("light railway motor tractors"). The Board considered the registrant's specimens and marketing literature in order to learn the meaning of that term of art (which indeed turned out to be quite different from what a layperson might have thought). Similarly, in the present case it is appropriate for us to consider the evidence presented by Applicant and the Examining Attorney in order to learn the meaning of the term "policy management." However, there is a difference between determining the meaning of a term of art and determining the current scope of a registrant's business. The Board in *Trackmobile* did not look to the specimens and literature for the purpose of limiting the scope of the registration to the precise limits of the registrant's current business. Therefore, on this point we agree with the Examining Attorney: in interpreting the cited registration, we must presume that Registrant's goods encompass all goods of the nature and type identified in the registration. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Although Applicant's suggestion that "Policy" means "insurance policy" is a plausible one, the evidence shows that "policy management" has a particular, non-insurance meaning in the

field of business software. We must include this meaning in our interpretation of the scope of the cited registration. Indeed, in an *ex parte* proceeding we are required to give “full sweep” to Registrant’s identified goods. *Paula Payne Prods. Co. v. Johnson Publ’g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973).¹⁹

We turn, then, to consider whether the goods and services at issue “are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (internal quotation omitted). Applicant contends that they are not related, that the respective goods and services offer “a different function, to fulfill a different demand, marketed to different customers”;²⁰ and that typically “companies that offer Policy Management software ... do not also provide software for the monitoring and managing of IT systems.”²¹

The Examining Attorney has sought to demonstrate that providers of IT management software or services also provide policy management software. Her contention is supported by the following three items of evidence:

¹⁹ We have given full consideration to Applicant’s argument that the word “policy” is a “homograph” and that, in order to avoid an absurd interpretation, we must not give it every conceivable meaning that it could have. *See* Applicant’s brief at 6, 11 TTABVUE 10 (“The Cited Registration should not be interpreted expansively to include both meanings of the word ‘policy’ because it invokes distinctly different sectors of the marketplace and refers to completely unrelated goods.”) The evidence shows that “policy management” has a meaning that is relevant to businesses in general, including Registrant, even if we assume that Registrant’s business is limited to insurance. Therefore, when we interpret “policy management” software to mean more than “insurance policy management” software, we are not straying into a “distinctly different sector of the marketplace.”

²⁰ Applicant’s brief at 10, 11 TTABVUE 14.

²¹ *Id.* at 13, 11 TTABVUE 17.

LabTech Solutions offers “IT management solutions” for “remote monitoring and management.”²² Its website also touts its software as follows: “Managing configurations and IT policies has never been easier ... LabTech’s dynamic group structure brings IT policy management to a whole new level ... Need to make a policy update? Changes easily replicate to all group members automatically.”²³

Ventiv Technology provides “IT Solutions” to the insurance industry, “manages mission-critical insurance applications ... includ[ing] proactively monitoring application availability, performance, response times, exceptions, faults, and failures.”²⁴ It also provides “Policy and Program Management” to help insurance companies “in managing their increasingly complicated insurance requirements. ... Our policy and program management capabilities helps you ... remain compliant with each local country’s regulations ...”²⁵

Kaseya offers an “IT systems management platform” that allows users to remotely manage “Clients, Servers, Networks & Mobile Devices.”²⁶ It also offers a policy management software for “[k]eeping users’ settings aligned with corporate policy” that “allows you to take stock of your environment and effectively manage desktop policy by enforcing ... security settings...”²⁷

²² Office Action of June 23, 2016 at 35.

²³ *Id.* at 38.

²⁴ *Id.* at 7-8.

²⁵ *Id.* at 13. As the evidence shows, this company provides software and services in all three of the most relevant areas: IT management, corporate policy management, and insurance policy-related applications.

²⁶ Office Action of June 23, 2016 at 41-42.

²⁷ *Id.* at 48. We do not agree with Applicant’s contention that this function is “very different” from policy management. The evidence indicates that ensuring that employees follow IT security policies is often central to compliance with laws and rules relating to data confidentiality (e.g., HIPAA) that may apply to various types of businesses. Much of the evidence concerning “policy management” software (discussed above) relates to security requirements of this type.

It is evident from the record as a whole that, although IT management and policy management are different functions, they are both likely to be important concerns of many businesses. A business that uses a computer system may desire either services or software for IT management, *i.e.*, services or software that assist with the “monitoring, managing and maintaining IT systems.”²⁸ Similarly, businesses that use computer systems to store and process data are likely to have policies for the proper use of those computer systems and the proper treatment of those data, such as policies regarding computer system security and policies regarding access to and confidentiality of data. These businesses would have an interest in policy management software, and they would overlap with the businesses interested in Applicant’s goods and services. Both IT and IT policy may require management. Those who use computer systems are likely to view the management of the operation of those systems as related to the policies regarding the use of those systems.

Applicant has presented evidence intended to show “over a dozen examples of industry leaders that do not provide a combination of Applicant’s goods and services and the goods covered by the Cited Registration.”²⁹ We find this evidence unconvincing: we cannot deduce from evidence indicating that a company *does* provide a certain product or service that it *does not* provide any other product or service.

²⁸ See Applicant’s characterization of “IT Management” software, Applicant’s brief at 9, 11 TTABVUE 13.

²⁹ Applicant’s brief at 14, 11 TTABVUE 18; Applicant’s response of June 1, 2016 at 27-67.

The record is full of marketing materials from businesses offering computer services and software, and it is evident that such purveyors offer to provide comprehensive products to serve a wide range of computer-related needs, often customized to the order of the buyer. As customers are likely to see a relationship between needs filled by Applicant's and Registrant's products and services, and IT companies sometimes offer both types of software or service, the circumstances are such that customers would likely believe the goods and services at issue emanate from the same source if they were offered under confusingly similar marks. This *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

(c) Customers.

Applicant contends that IT management software "is often purchased by managed service providers" or "MSPs," and explains that "[a]n MSP is an entity that remotely manages a customer's IT infrastructure and/or end-user systems..."³⁰ However, there is nothing in the application that would limit Applicant's customers to MSPs, and we must therefore assume that Applicant's goods and services are available to all classes of customers for those goods and services. *See, e.g., Paula Payne Products Co. v. Johnson Publishing Co.*, 177 USPQ at 77-78. As was discussed above, Applicant's goods and services appear to be appropriate for enterprises that operate their businesses by use of computer systems; and the Ventiv and LabTech advertisements are directed to businesses other than MSPs. Even if we accept Applicant's contention that Registrant's goods are appropriate only for insurance

³⁰ Applicant's brief at 9-10, 11 TTABVUE 13-14.

companies, there is evidence showing that IBM,³¹ AppDynamics,³² and Ventiv offer IT management services to insurance companies. Although not voluminous, this evidence indicates that the goods and services at issue are offered in some cases to the same classes of customers.

On the other hand, we agree with Applicant's suggestion that the relevant customers are sophisticated "professional or commercial purchasers"³³ that would apply to the selection of the goods and services a degree of care commensurate with business decisions, even though there is no evidence regarding the cost of the goods and services to support Applicant's contention that the goods are "high-priced and infrequently made."³⁴

Thus, the fact that the goods and services may be offered to the same classes of customers weighs in favor of a finding of likelihood of confusion, while the sophistication of the customers weighs against such a finding.

(d) Absence of actual confusion.

Applicant contends that its mark has been in use for three years, and that it is not aware of any instances of actual confusion with Registrant's mark.³⁵ The record of this case contains little information regarding the extent to which Applicant has used and promoted its mark, or the extent of use of Registrant's mark. On this record we cannot determine whether there have been meaningful opportunities for

³¹ Office Action of June 23, 2016 at 29-30, 32.

³² *Id.* at 56-57, 63.

³³ Applicant's brief at 15, 11 TTABVUE 19.

³⁴ *Id.* at 16, 11 TTABVUE 20.

³⁵ Declaration of Gordon P. Kushner ¶¶ 2-3, Applicant's response of June 1, 2016 at 16-17.

actual confusion to occur in the marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, the uncorroborated statement that there are no known instances of actual confusion is of little evidentiary value in this *ex parte* proceeding, in which we have no opportunity to hear from Registrant. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is neutral.

(e) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The marks are highly similar in appearance, sound, meaning and overall commercial impression; the goods and services at issue sometimes emanate from the same source, and it has been shown that they are sometimes marketed to the same class of customers. Although the relevant customers exercise care, the marks are so similar that even a careful customer could mistake one for the other under ordinary market conditions. Overall, we find that Applicant's mark, in the context of Applicant's identified goods and services, so resembles the cited registered mark as to be likely to cause confusion or mistake or to deceive.

Decision: The refusal under Section 2(d) is affirmed.