

This Opinion is not a  
Precedent of the TTAB

Mailed: November 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

———  
Trademark Trial and Appeal Board

———  
*In re Scram Software Pty Ltd.*

———  
Serial No. 86658580

———  
Joshua M. Gerben, Gerben Law Firm PLLC,  
for Scram Software Pty Ltd.

Brittany A. Estell, Trademark Examining Attorney, Law Office 122,  
John Lincoski, Managing Attorney.

———  
Before Zervas, Hightower, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Scram Software Pty Ltd. (“Applicant”) seeks registration on the Principal Register of the mark CLOUD SHERIFF in standard characters (“CLOUD” disclaimed) for goods and services identified as:

“Computer software for encrypting, decrypting, synchronizing, replicating, processing, transmitting, exchanging, storing, backing up, archiving, organizing, sharing, modifying, updating, digitally signing, watermarking, removing metadata from, manipulating and accessing files and directories, data, documents, information, messages, emails, text, photos, images, graphics, music, audio, video, and multimedia content via

global and local computer networks and other communication networks; computer software for encrypting, decrypting, integrity checking and detecting unauthorized activity of computer files, directories, documents, folders, data and information; computer software for use in a cloud or networked computing environment providing data encryption and privacy relating to storing, organizing, transmitting, processing, sharing, accessing, backing up and archiving of files, directories, emails and other electronic data and information on public and private networks; computer software for synchronizing and replicating files, directories, data and information across electronic devices; computer software for synchronizing of computer files, directories, data and information within a collaborative work environment; computer software for the encrypted and private storage of computer files, directories, documents, folders, data and information on storage hardware, cloud storage services and networked computers; computer software for detecting unauthorized creation and modification of computer files, directories, documents, folders, data and information; computer software for the encryption, decryption and private sharing of computer files, directories, documents, folders, data and information; computer software for creating, exchanging and managing encryption keys,” in International Class 9, and

“Providing on-line non-downloadable software for text, picture and video messaging; Providing on-line non-downloadable software for electronically exchanging encrypted data, audio, video images and graphics via computers, mobile devices, wireless and telecommunications networks; providing on-line non-downloadable software for creating, exchanging and managing encryption keys; providing on-line non-downloadable software for detecting copyright infringement; providing on-line non-downloadable software for digitally signing electronic files, photos and other electronic documents; providing on-line non-downloadable software for verifying the authenticity and existence of electronic files, photos and other electronic documents; providing on-line non-downloadable software for detecting unauthorized modification or forgery of electronic files, photos and other electronic documents;

development, design, implementation, testing, analysis, and consulting services in the field of security, access, authorization, authentication, encryption, and identification systems for computers, computer systems, computer software, computer hardware and computer networks,” in International Class 42.<sup>1</sup>

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s CLOUD SHERIFF mark so resembles the mark HISOFTWARE SECURITY SHERIFF in standard characters (“SECURITY” disclaimed) shown in Registration No. 4623241 for the following goods and services:

“Computer software, namely, downloadable software for use in document, data and information security, protection of documents, data and information, and encryption of documents, data and information, and restriction and tracking of access to documents, data and information,” in International Class 9, and

“Providing temporary use of online non-downloadable software for use in document, data and information security, protection of documents, data and information, and encryption of documents, data and information, and restriction and tracking of access to documents, data and information; software as a service (SAAS) services, namely, hosting software for use in document, data and information security, protection of documents, data and information, and encryption of documents, data and information, and restriction and tracking of access to documents, data and information,” in International Class 42,

as to be likely, when used in connection with Applicant’s goods and services, to cause confusion, mistake, or deception.<sup>2</sup> After the Examining Attorney made the refusal

---

<sup>1</sup> Application Serial No. 86658580 was filed on June 10, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

<sup>2</sup> Cited Registration No. 4623241 issued on October 21, 2014.

final, Applicant timely appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. The case is fully briefed. We reverse the refusal to register.

## **I. Record on Appeal**

The record consists of the following:

- Pages from the U.S. Patent and Trademark Office’s (“PTO”) TESS database regarding Registration No. 3693241 for the mark HISOFTWARE COMPLIANCE SHERIFF and Registration No. 3552758 for the mark HISOFTWARE COMPLIANCE SHERIFF, both owned by the owner of the cited mark (July 21, 2015 Office Action);
- A dictionary definition of the term “cloud computing” from the *Free Online Dictionary of Computing* (July 21, 2015 Office Action);<sup>3</sup>
- A dictionary definition of “sheriff” from the *Oxford Dictionary* online dictionary (September 9, 2015 Office Action);
- Pages from the websites at folddoc.org, lifehacker.com, and alertsec.com discussing cloud computing (July 21, 2015 Office Action and September 9, 2015 Office Action);
- Pages from the websites at security.stackexchange.com, spychecker.com, sophos.com, artisoft.com, viivo.com, and vormetric.com discussing computer file

---

<sup>3</sup> In the July 21, 2015 Office Action, the Examining Attorney mentioned a dictionary definition of “house mark” from dictionary.com, but the definition was not made of record.

encryption and computer data security (July 21, 2015 Office Action and September 9, 2015 Office Action);

- Copies of the certificates of registrations for various third-party registrations of SHERIFF-formative marks (August 16, 2015 Response to Office Action and March 2, 2016 Request for Reconsideration);<sup>4</sup> and

- Pages from third-party websites at thesheriffapp.com, createautomate.com, websheriff.com, teleosoft.com, sheriff-software.com, download.cnet.com, pcworld.com, spillman.com, and mailshell.com, showing the use of SHERIFF-formative marks (August 16, 2015 Response to Office Action and March 2, 2016 Request for Reconsideration).

## II. Analysis

Section 2(d) of the Trademark Act prohibits the registration of a mark that so resembles a prior registered mark as to be likely, when used in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based upon an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The Examining Attorney correctly notes that “[n]ot all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record.” 9 TTABVue 6 (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344,

---

<sup>4</sup> These registrations and various third-party uses are described on a chart below.

98 USPQ2d 1253, 1260 (Fed. Cir. 2011), *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003), and *du Pont*, 177 USPQ at 567). In every case under Section 2(d), of course, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We also find relevant, on the record here, the sixth *du Pont* factor regarding the nature and number of third-party marks in use on similar goods and services.

#### **A. Similarities Between the Goods and Services**

Under the second *du Pont* factor, the determination of the similarities of the subject goods and services is based upon the identifications of goods and services in the involved application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods and services do not have to be identical or even competitive for confusion to be likely. They need only be “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*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The identification of goods in the application covers, *inter alia*, “Computer software for encrypting . . . documents . . .” The identification of goods in the cited registration covers, *inter alia*, “Computer software, namely, downloadable software for use in . . . encryption of documents . . .” The goods are thus identical in part. The identification of services in the application covers “development, design, implementation, testing, analysis, and consulting services in the field of . . . encryption . . .,” while the identification of services in the cited registration covers “hosting software for use in . . . encryption of documents.” The services are thus very similar. The Examining Attorney also made of record Internet evidence showing that third parties frequently provide the goods and services identified in the application and in the cited registration under the same mark. July 21, 2015 Office Action and September 9, 2015 Office Action. Applicant does not address this *du Pont* factor in its briefs, relying instead on “the differences between the marks and the crowded field of SHERIFF marks in the marketplace,” 7 TTABVUE 8, and thus concedes that the subject goods and services are identical in part and closely related. This *du Pont* factor thus strongly favors a finding a likelihood of confusion. The identity of the goods in part also requires us to presume that they travel in the same channels of trade to the same classes of customers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). This too favors a finding of a likelihood of confusion under the third and fourth *du Pont* factors.

**B. The Number and Nature of Similar Marks in Use on Similar Goods or Services**

Under the sixth *du Pont* factor, we consider “[t]he number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567. This factor addresses the strength of a mark with respect to both its inherent strength, based on the nature of the term itself, and its commercial strength, based on the marketplace recognition value of the term as a mark. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”)).

The Federal Circuit has held that evidence of the extensive registration and use of a term by others can be powerful evidence of the term’s commercial weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Third-party registrations and uses are also “competent to show that the common term [between two marks] has an accepted meaning in a given field and that marks containing the term have been registered and used for related goods because the remaining portions of the mark may be sufficient to distinguish the marks as a whole from one another.” *Promark v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015); *see also In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) (“Third-party registrations

can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry.”).

Applicant made of record the following third-party registrations and uses:

Mark	Reg. No. <sup>5</sup>	Goods/Services
ISHERIFF	4711968	Software as a service (SAAS) services, namely, hosting software for use by others for purposes of computer security for businesses and enterprises; cloud computing featuring software for use in the field of computer security for businesses and enterprises; Computer virus protection services.
PHONESHERIFF	4083686	Computer software for use in monitoring computer and computer network activity.
ISHERIFF and Design	4519026	Computer software for use in database case related information management, for e-filing, e-forwarding and the electronic transmission of documents for use by law enforcement, detectives, private investigators, paralegals, legal assistants, attorneys, judges, clerks of court and process servers in the civil and criminal justice systems that may be downloaded from a global computer network; private investigation; legal services, namely, process serving.
ISHERIFF	4589479	Computer software for use in database case related information management, for e-filing, e-forwarding and the electronic transmission of documents for use by law enforcement, detectives, private investigators, paralegals, legal assistants, attorneys, judges, clerks of court and process servers in the civil and criminal justice systems that may be downloaded from a global computer network; private investigation; legal services, namely, process serving.
WEB SHERIFF PROTECTING YOUR RIGHTS ON THE INTERNET and Design	4051296	Legal consulting services in the fields of entertainment, internet, right of publicity, intellectual property, take down notifications and online anti-piracy investigations; all relating to the Internet.

---

<sup>5</sup> Applicant also made of record summaries of three pending applications to register SHERIFF-formative marks, with no evidence of use of the marks. This evidence shows nothing more than that the applications were filed with the PTO. *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009). We have given the applications no consideration.

SHERIFF'S REWARD	3867984	Electronic game programs; Gaming equipment, namely, slot machines with or without video output; Gaming machines; Machines for playing games of chance; Slot machines.
TM SHERIFF	4520624	Negotiation and settlement of commercial transactions for third parties, namely, intellectual property acquisition services in the negotiation and acquisition of intellectual property and domain names on behalf of others; intellectual property watch services, namely, investigating the unauthorized use of an owner's intellectual property to minimize the unauthorized use of such intellectual property; expert witness services in legal matters and litigation support services in the field of intellectual property; intellectual property consultation; legal support services, namely, intellectual property due diligence services, namely, conducting ownership research on the businesses and intellectual property of others.
SHERIFF CHASE	NA	Game and entertainment software.
SHERIFF RAGE	NA	Game and entertainment software.
AMAZING SHERIFF	NA	Game and entertainment software.
SHERIFF ACADEMY	NA	Game and entertainment software.
DOLPHIN SHERIFF	NA	Game and entertainment software.
REFOG TIME SHERIFF	NA	Computer software for parental control.
WEB SHERIFF	NA	Computer software for optimizing and protecting user's Internet presence and intellectual property.
SHERIFF	NA	Computer software for office management.
SHERIFF SOFTWARE	NA	Software development kit including licensing.
PHONESHERIFF INVESTIGATOR	NA	Computer software for parental control.
SHERIFF'S OFFICE	NA	SAAS provider for sheriff office and law enforcement data management.
FILE SHERIFF	NA	Computer software for file management.

TIME SHERIFF	NA	Computer software for parental control.
DATA SHERIFF	NA	Computer software for security, data encryption, security, and antivirus.
THE SHERIFF APP	NA	Mobile phone application for “custom sheriff apps,” namely, custom iPhone and Android app development for law enforcement agencies.
INTERNET SHERIFF	NA	SAAS provider for enterprise content security.
SHERIFF	NA	Computer software for software protecting the software development process.
SOCIAL SHERIFF	NA	Computer software for managing users Facebook interactions.

We first address the impact of this evidence on the commercial strength and source-identifying capacity of the word “SHERIFF” in the marks. Applicant argues that “the USPTO Register and the marketplace reflect a plethora of SHERIFF-formative marks.” 7 TTABVUE 13. The Examining Attorney argues that “goods and services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods and services at issue,” 9 TTABVUE 9, and that Applicant’s “marketplace evidence is not persuasive in evidencing that the wording ‘SHERIFF’ is diluted with respect to applicant’s and registrants (sic) goods and/or services, because the subject matter and function of the software in the websites are not similar to those at issue.” 9 TTABVUE 12.

We find that the record evidence is insufficient to show that “SHERIFF” is commercially weak or “diluted.” A number of the “SHERIFF” formative marks in the

record are not used in connection with goods and services that are similar to the software goods and services at issue here, including the registered marks for software used by law enforcement personnel, legal consulting services, electronic game programs, and the negotiation and settlement of commercial transactions services, and the common-law marks for game and entertainment software, and software used by law enforcement personnel. The number of pertinent registrations and uses (10) is far smaller than the number of registrations and uses in the *Jack Wolfskin* and *Juice Generation* cases, and Applicant did not show how long or how extensively the third-party marks have been used.

We next consider whether the record evidence demonstrates that SHERIFF has an accepted meaning in the field of computer software and services. The Examining Attorney made of record an *Oxford Dictionary (American English)* definition of “sheriff” as “an elected official in a county who is responsible for keeping the peace.” (September 9, 2015 Office Action). Applicant agrees that this is the literal definition of “sheriff,” but argues that “sheriff”:

also is a known “turn of phrase” in American culture. Throughout every industry, people who diligently guard against security violations or crimes are known as “the sheriff” of their industry. In the context of security software, the word sheriff would instantly create the impression of security and relate it to computer security and encryption. “Sheriff” within the context of computer security and encryption software and software-as-a-service products would have no other meaning. As shown through the extensive third-party evidence provided thus far, many software companies use the word sheriff in the same weak manner.

7 TTABVUE 12. We do not agree with Applicant that the record shows that the word “sheriff” is a “turn of phrase in American culture,” but for the reasons discussed below, we do agree that the record shows that the word “sheriff” as used for protection, monitoring, and security software goods and services generally has a suggestive connotation that lessens the ability of the word to identify a particular source of such goods and services.

Some of the third-party registrations and uses in the record appear to use the word “sheriff” in its dictionary sense to identify software that is used by actual law enforcement officials, or that refers to fictitious ones.<sup>6</sup> The others, however, appear to employ the word in a looser, non-dictionary, and colloquial sense of something, or someone (other than an actual law enforcement official), that protects against, or monitors or polices, something other than criminal activity.<sup>7</sup> These include the registered marks ISHERIFF and PHONE SHERIFF, and the marks REFOG TIME SHERIFF, WEB SHERIFF, SHERIFF, PHONE SHERIFF INVESTIGATOR, FILE SHERIFF, TIME SHERIFF, DATA SHERIFF, and INTERNET SHERIFF.

Exemplary uses of “sheriff” in marks for software that protects against or monitors something (without the involvement of law enforcement officials) are shown below:

---

<sup>6</sup> These include the registered marks ISHERIFF and ISHERIFF and design for software used by law enforcement and judicial personnel, the registered mark SHERIFF’S REWARD for gaming software and electronic games, the computer games entitled Sheriff Chase, Sheriff Rage, Amazing Sheriff, Sheriff Academy, and Dolphin Sheriff, and the software products sold under the marks SHERIFF, SHERIFF’S OFFICE and THE SHERIFF APP, which are used by law enforcement officials.

<sup>7</sup> The Examining Attorney tacitly acknowledged this non-literal meaning on appeal. In her appeal brief, the Examining Attorney cited the dictionary definition of “sheriff” and then argued that the “wording ‘CLOUD’ and ‘SECURITY’ [in the subject marks] merely modifies what applicant’s and registrant’s software are presiding over . . .” 9 TTABVUE 7.

CNET > Software > Applications > Data Sheriff (v. 3.0) - box pack > Specs

## Data Sheriff ( v. 3.0 ) - box pack Specifications

★ OVERVIEW    👤 USER REVIEWS    ☰ SPECIFICATIONS



**Data Sheriff ( v. 3.0 ) - box pack**  
Part Number: JS102

**WHERE TO BUY /**

**Data Sheriff ( v. 3.0 ) - box pack**  
Part Number: JS102

Pricing is currently unavailable.

**GENERAL /**

Packaged Quantity	1
Localization	English
Category	utilities
Subcategory	security - data encryption, security - desktop antivirus, utilities - PC diagnostic, utilities - desktop backup / compression / archiving
Package Type	retail
Manufacturer	Jungsoft

**SOFTWARE /**



## SHERIFF

**FLEXIBLE & SECURE SOFTWARE PROTECTION**

Home | Overview | Purchase | Features | Security | Licensing | Contact | Help

★ Free evaluation  
Download Sheriff 3

★ Product overview  
The Sheriff Concept

★ Purchase it  
Still only \$500



**Unrivalled security, flexible licensing and ease of use.**

The Sheriff Software Development Kit (SDK) protects 32-bit & 64-bit Windows applications against illegal copying.

Sheriff offers the convenience of software-based protection - no need for dongles.

Sheriff offers unrivalled security, flexible licensing and ease of use via:

- Windows DLL
- ActiveX (OCX) control

**Windows DLL is ideal for protecting programs written in Visual C++ while the ActiveX control works great with Visual Basic.**

The Sheriff API enables you to completely customise every aspect of Sheriff - no fixed dialog boxes etc.

Sheriff also features Internet Software Registration (ISR), enabling you to distribute licence keys via the web.

Sheriff is competitively priced - a single, royalty-free payment for each product you need to protect.

You can evaluate Sheriff for as long as you like by [downloading the full SDK](#).

(Current Version: 3.1 Released: 10 November 2013)

© Copyright 2008-2014 Licensing Technologies Limited

Exemplary uses of “sheriff” in marks for software that enables private citizens to protect against or monitor something (other than criminal activity) are shown below:

Home > Windows Software > Security Software > Parental Control > Time Sheriff

## Time Sheriff

 <b>Download Now</b> Secure Download	Average User Rating: Be the first to rate this product!		
<b>Quick Specs</b>			
Version: 4.1	Total Downloads: 467	Date Added: Feb. 12, 2010	Price: Free to try (5-day trial); \$44.95 to buy ( <a href="#">Buy it now</a> )
File Size: 1.52MB	Downloads Last Week: 1	Platform: Windows	

### Publisher's Description

From IMonitor Soft:

IMonitor Time Sheriff is a computer time control software and parental control software for parents and small business. It allows you to set individual time limits for each application as allow your kids two hours/day of gaming. Or, completely prohibit the use of certain programs. It also can force kids to take short breaks in computer work to relax the eyes. Do you know that computers can be a real pain for your kids? Sitting for a long time in positions that aren't natural for their body can strain their hands, wrists, back, and eyes. If you are concerned your child may be spending too much time online or playing games IMonitor TimeSheriff will offer a solution. It allows you to set limits on how much time your child spends on the computer or online.

Home > Windows Software > Security Software > Monitoring Software > PhoneSheriff Investigator

## PhoneSheriff Investigator

 <b>Download Now</b> Secure Download	Average User Rating:  out of 1 votes		
<b>Quick Specs</b>			
Version: 4.0.2	Total Downloads: 2,455	Date Added: Jul. 30, 2015	Price: Free to try (7-day trial); \$79.00 to buy ( <a href="#">Buy it now</a> )
File Size: 3.94MB	Downloads Last Week: 532	Platform: Windows	Product ranking: <b>#10</b> in Monitoring Software

### Publisher's Description

From Retina-X Studios: Monitor your child's iPhone or iPad without Jailbreaking. View activities remotely with PhoneSheriff Investigator software. Monitor Text Messages, Call History, iMessages, WhatsApp Messages, Photos, Contacts, Notes and Safari Bookmarks in one easy location.

PhoneSheriff Investigator Edition is different in that you don't have to Jailbreak the Apple device to use it. All you need to do is purchase the Windows software, install it onto your computer and login using your Apple ID and password.

Nothing needs to be installed onto your child's device. Just access the Apple device you own to enable the cloud storage and backup. Unlike other systems, your Apple ID and password are never sent back to us. That's handled on your own computer by the standalone program.

Therefore your ID is never seen by any third party. Works with any version of Windows

[read more +](#)

### User Reviews

Current Version

All Versions

My rating

These marks use “sheriff” in a non-literal, colloquial sense that “indicates that [SHERIFF] carries a suggestive or descriptive connotation in the [software] industry,

and is weak for that reason.” *Juice Generation*, 115 USPQ2d at 1675. They suggest that software marks containing the word SHERIFF are capable of co-existing without confusion where “the remaining portions of the mark may be sufficient to distinguish the marks as a whole from one another.” *Promark*, 114 USPQ2d at 1244. Against the backdrop of the evidence regarding the SHERIFF-formative, we turn now to the first *du Pont* factor regarding the similarity of the marks.

### C. Similarities Between the Marks

This factor focuses on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “In a particular case, any one of these means of comparison may be critical in finding the marks to be similar.” *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550-51 (TTAB 2010) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “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*, 101 USPQ2d at 1721 (quotation omitted). Because the goods are identical in part and the services are closely related, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *See, e.g., Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed.

Cir. 1992); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

Applicant argues that “given that the marks share only one inherently weak word, SHERIFF, and given the widespread and pervasive use of SHERIFF-formative marks across the relevant marketplaces and classes of goods and services, it is highly unlikely that confusion would result from Applicant’s use of CLOUD SHERIFF in connection with Applicant’s Goods and Services and Registrant’s use of HISOFTWARE SECURITY SHERIFF for Registrant’s Goods and Services.” 7 TTABVUE 8. The Examining Attorney responds that “[c]onsumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning,” 9 TTABVUE 6, and that “the commercial impressions of the marks in their entirety are likely to be confusingly similar, namely, ‘CLOUD SHERIFF’ as cloud computing software for securing one’s computer while ‘HISOFTWARE SECURITY SOFTWARE’ would similarly be viewed as software for security, provided by HiSoftware line of products.” 9 TTABVUE 7. For the reasons discussed below, we agree with Applicant that the differences in the marks, considered against the backdrop of the suggestiveness of “SHERIFF” in association with the relevant goods and services, are sufficient to make confusion unlikely even though the marks are used for identical and very similar goods and services.

Applicant’s mark and the cited mark have the word “SHERIFF” in common, but “likelihood of confusion cannot be predicated on dissection of a mark, that is, on only

part of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.” *Id.*

We find that “SHERIFF” is the dominant portion of Applicant’s mark because the word “CLOUD” that precedes it is merely descriptive of Applicant’s goods and services,<sup>8</sup> and has been disclaimed. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming finding that “DELTA,” not the disclaimed word “CAFE,” was the dominant portion of the mark THE DELTA CAFE). In the cited mark, however, we find that “HISOFTWARE,” which the Examining Attorney calls the registrant’s “house mark,” 9 TTABVUE 7,<sup>9</sup> is the dominant portion,

---

<sup>8</sup> The Examining Attorney made of record a dictionary definition of “cloud” as “a loosely defined term for any system providing access via the Internet to processing power, storage, software or other computing services, often via a web browser. Typically these services will be rented from an external company that hosts and manages them.” *Free Online Dictionary of Computing* (July 21, 2015 Office Action). In the context of Applicant’s goods and services, the word “CLOUD” in its mark describes that Applicant’s software and services are provided over the Internet.

<sup>9</sup> Applicant and the Examining Attorney disagree about whether HISOFTWARE is a house mark, but that disagreement is more semantic than substantive and we need not resolve it to decide the appeal. Assuming that HISOFTWARE is a house mark, the cases cited by the Examining Attorney for the proposition that “[l]ikelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by including a house mark if the dominant portion of both marks is the same,” 9 TTABVUE 7-8, are distinguishable. Unlike the situation here, those cases involved the applicant’s addition of *its* house mark to the registered mark, as well as marks whose common elements were also their dominant elements. *In re Chica, Inc.*, 84 USPQ2d 845, 1848-49 (TTAB 2007) (addition of BY CHICA to registered CORAZON mark did not avoid a likelihood of confusion where CORAZON was the dominant element of the marks); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB

not “SHERIFF.” The first word “HISOFTWARE” is the key source-identifying element because the elements that follow are the disclaimed word “SECURITY” and “SHERIFF,” which, as discussed above, is suggestive and has limited source-identifying capacity.<sup>10</sup>

Turning to a comparison of the marks in their entireties, the cited mark HISOFTWARE SECURITY SHERIFF and Applicant’s mark CLOUD SHERIFF differ in appearance and sound. The Examining Attorney does not address the issue of similarity in sound, but argues that “marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression.” 9 TTABVue 8. The only similar term in the marks is “SHERIFF,” however, and as discussed above, that word is suggestive when used in connection with software goods and services, including encryption and security software. Where the common element of two marks is weak because it is suggestive of the subject goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation*, 115 USPQ2d at 1674-75; *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). We find that HISOFTWARE SECURITY SHERIFF and CLOUD SHERIFF do not have other

---

1986) (addition of BY SASSAFRAS to registered SPARKS mark did not avoid confusion where SPARKS was the dominant element of the marks).

<sup>10</sup> The registrant’s use of “SHERIFF” in its mark is similar structurally to the use of the word in the third-party software marks discussed above such as ISHERIFF, PHONESHERIFF, DATA SHERIFF, and INTERNET SHERIFF, which use the word “SHERIFF” after a modifier that describes a particular type or use of the software.

commonality when considered in their entirety. CLOUD SHERIFF may create the impression of a particular type of software for cloud applications, but it does not create the impression that the source of that software is the company that produces software sold under the cited mark HISOFTWARE SECURITY SHERIFF. This *du Pont* factor does not support a finding of a likelihood of confusion.

### **Conclusion**

On the basis of the record as a whole, “we find, because of the suggestiveness of [SHERIFF] and the third-party use of this term in connection with [software], the mere fact that the parties’ marks both contain the term [SHERIFF] is not a sufficient basis on which to find likelihood of confusion.” *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1077 (TTAB 2011) (ZU ELEMENTS for printed products, leather goods, and clothing found not be confusingly similar to ELEMENT and ELEMENTALITY for same goods due to suggestiveness and weakness of “ELEMENT” formative). In balancing the *du Pont* factors, we find that the differences in the marks in appearance, sound, meaning, and commercial impression, when considered in their entirety, are sufficient to make confusion unlikely even though the marks are used on identical and closely related goods and services.

**Decision:** The refusal to register is reversed.