

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Big Data Experts, LLC
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Serial No. 86934136
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Brian J. Hundertmark of Garson Claxton LLC,
for Big Data Experts, LLC.

Sanjeev K. Vohra, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

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Before Bergsman, Ritchie and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Big Data Experts, LLC (“Applicant”) seeks registration on the Principal Register of the mark ONETECHNOLOGY (in standard characters) for “platform as a service (PAAS) featuring computer software platforms on which to build cloud computing applications and services; platform as a service (PAAS) featuring computer software platforms providing data management and data services in the cloud,” in Class 42.¹

¹ Application Serial No. 86934136 was filed on March 9, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as July 25, 2015.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark ONE TECHNOLOGIES (standard characters) for the services listed below as to be likely to cause confusion:

Internet advertising services, in Class 35; and

Design, creation, hosting and maintenance of internet sites for third parties; hosting of digital content on the Internet," in Class 42.²

Registrant disclaimed the exclusive right to use the word "Technologies."

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

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. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*") (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). In any likelihood of confusion

² Registration No. 4158012, registered June 12, 2012; Section 8 affidavit accepted.

analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd* ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir. 2017).

A. The similarity of the marks.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “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) (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); *see also San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

As indicated above, Applicant is seeking to register ONETECHNOLOGY (standard characters) and the registered mark is ONE TECHNOLOGIES (standard characters). The marks are essentially identical. There are two insignificant differences between the marks: (i) Applicant's mark is presented without a space between the words "One" and "Technology" while Registrant's mark has a space between the words; and (ii) Applicant uses the singular form of the word "Technology" while Registrant uses the plural form "Technologies."

Although Applicant's mark is presented without a space, consumers are likely to view and verbalize it as ONE TECHNOLOGY, based on normal English pronunciation. In this regard, we note that in its specimen filed with the application, Applicant displays its mark ONETECHNOLOGY as ONEtechnology, as shown below, thus engendering the commercial impression of two words: ONE and TECHNOLOGY.³



³ Applicant's actual use of its mark undercuts counsel's argument that its mark ONE TECHNOLOGY will be perceived as a single word. Applicant's Brief, p. 4 (4 TTABVue 5).

What We Do

ONEtechnology is a cloud-based platform that helps companies transform the way they do business.

ONE supports everything from data management to building entire applications...all from ONE intuitive platform.

We may look to Applicants' trade dress in analyzing whether the commercial impression engendered by the marks is similar.

Ordinarily, for a word mark we do not look to the trade dress, which can be changed at any time. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968). But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression.

Kenner Parker Toys Inc. v. Rose Art Indus. Inc., 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992); *see also Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ("Applicant's labels support rather than negate that of which opposer complains: that SPICE VALLEY inherently creates a commercial impression which is confusingly similar to that of SPICE ISLANDS."); *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) ("we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression."); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) ("Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.").

Thus, the presence or absence of a space between the two words is an inconsequential difference that even if noticed or remembered by consumers would not serve to distinguish these marks. *See, e.g., Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that DESIGNED TO SELL does not create a distinct commercial impression from DESIGNED2SELL); *Seaguard Corp. v. Seaward Intern'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) ("there can be little doubt that the marks [BEEFMASTER for restaurant services and BEEF MASTER for frankfurters and bologna] are practically identical and indeed applicant has not argued otherwise.").

Applicant uses the singular form of the word "Technology" as part of its asserted mark, and the registered mark uses the plural form "Technologies." Based on governing authority, use of the plural as opposed to the singular form of a term "is almost totally insignificant in terms of the likelihood of confusion of purchasers," *In re Pix of Am., Inc.*, 225 U.S.P.Q. 691, 692 (TTAB 1985). The terms ONETECHNOLOGY and ONE TECHNOLOGIES would share the same meaning or connotation to the relevant consumer. *See Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *Weidner Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014); *In re Pix of Am., Inc.*, 225 U.S.P.Q. at 692 (noting that the pluralization of

“Newport” is “almost totally insignificant in terms of the likelihood of confusion of purchasers.”).

We find that the marks are similar in their entirety as to appearance, sound, meaning and commercial impression. This *du Pont* factor therefore favors a finding of likelihood of confusion.

B. The similarity or dissimilarity and nature of the services and established, likely-to-continue channels of trade.

Applicant is seeking to register its mark for “platform as a service (PAAS) featuring computer software platforms on which to build cloud computing applications and services; platform as a service (PAAS) featuring computer software platforms providing data management and data services in the cloud,” and the cited mark is registered for, *inter alia*, “design, creation, hosting and maintenance of internet sites for third parties; hosting of digital content on the Internet.”⁴

We start this part of our analysis by defining the term “platform as a service.”⁵

The Examining Attorney defines “platform as a service” as follows:

⁴ Under this *du Pont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the description of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015) (“it is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.”); *In re i.am.symbolic, llc*, 116 USPQ2d at 1409.

⁵ Neither Applicant, nor the Examining Attorney, submitted any evidence defining or explaining the meaning of the term “platform as a service.” Nevertheless, both Applicant and the Examining defined the term, uncorroborated by any evidence, in their briefs. Under the circumstances, we deem the respective definitions or explanations to be stipulated into the record.

Platform as a service (PAAS) is a cloud computing model that delivers applications over the Internet ultimately allowing its users to design or create a new application.⁶

Applicant defines “platform as a service” as set forth below:

PaaS [platform as a service] and APaaS [Application Platform as a Service] are a category of cloud computing services that provides a platform on which clients can develop, operate, and manage applications without the need for clients to deal with the complexities of building and maintaining an infrastructure associated with the development of an application. Basic characteristics of a PaaS include:

- Services to develop, test, deploy, and maintain applications in the same integrated development environment;
- User interface creation tools for the creation, modification, testing, and deployment of different user interface scenarios
- Multi-tenant architecture where multiple concurrent users utilize the same development application
- Built-in scalability of deployed software
- Integration with web services and databases via common standards
- Support for development team collaboration.⁷

Applicant’s platform as a service allows clients to design, develop, and generate their own applications with individualized features to, *inter alia*, perform data

⁶ Trademark Examining Attorney’s Brief (6 TTABVUE 6).

⁷ Applicant’s Brief, p. 2 (4 TTABVUE 3).

management, predictive business analysis and decision automation through the Internet.⁸

Applicant provides software that allows others to build data processing applications executed through the Internet while Registrant designs, builds and hosts websites for other. It is logical that a company providing platforms for building Internet software applications also would build those software applications for others, as well as offer website design and creation services to access those software applications. In this regard, the Examining Attorney submitted copies of 17 use-based third-party registrations for both services. Third-party registrations based on use in commerce that individually cover a number of different services may have probative value to the extent that they serve to suggest that the listed services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Representative registrations, with relevant portions of the identifications, are listed below.⁹

Mark	Reg. No.	Services
BLUEGLASS	3993956	Platform as a service featuring computer software platforms for Internet advertising; Computer software development in the field of Internet advertising; Web publishing, namely, creating a website and uploading it onto an Internet server.

⁸ *Id.*

⁹ August 9, 2016 Office Action (TSDR 10-67). Citations to TSDR are in the .pdf format.

Mark	Reg. No.	Services
ACTURA	4011873	<p>Platform as a service featuring computer software platforms for business process management, customer retention management, enterprise content management, web portals, internet advertising and e-commerce;</p> <p>Design and development of software for business purchasing functions and advertising;</p> <p>Design, creation, hosting and maintenance of Internet sites for third parties.</p>
BUY KEEP SELL	4232165	<p>Platform as a service featuring computer software platforms to facilitate vendors and customer communication and to conduct retail transactions in the field of online retail store services;</p> <p>Mobile application development; creating social media, mobile computing, and web e-commerce application software and online platforms for others;</p> <p>Design, creation, hosting, and maintenance of website for others.</p>
CENSHARE	4556335	<p>Provision of Platform as a Service featuring computer software platforms for processing data;</p> <p>Design and development of computer software; computer project management; designing computer software;</p> <p>Design, creation, hosting, and maintenance of Internet sites for third parties.</p>

Mark	Reg. No.	Services
CLOUDSOLV	4795478	<p>Platform as a Service featuring software for use in providing integrated telecommunications services, VOIP services, video conferencing services, and data sharing services;</p> <p>Providing online non-downloadable software for use in providing integrated telecommunications services, VOIP services, video conferencing and data sharing services;</p> <p>Design, creation, hosting, and maintenance of website for others.</p>

Applicant's argument that the services at issue are different activities misses the point.¹⁰ In determining whether the services are related, it is not necessary that the services be similar or competitive in character to find that they are related; it is sufficient for such purposes that services are related in some manner or that conditions and activities surrounding marketing of these services are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (Fed. Cir. 2012); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corporation v. Alza Corporation*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corporation v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978). As we noted above, a client interested in developing a software application performed

¹⁰ Applicant's Brief, pp. 5-7 (4 TTABVUE 6-8).

through the Internet also may be interested in having a website designed, created and hosted to access that software application. In that scenario, not only would the services be related, but they would move in the same channels of trade.

Applicant argues, to the contrary, that it renders very specialized services to a select group of clients with specialized needs.

Applicant's services are marketed solely through direct solicitation. These businesses are global, multi-billion dollar enterprises that have the technological resources to create their own applications for their specialized needs, but who can benefit from an outside sources for specialized Platform as a Service (PaaS) and Application Platform as a Service (APaaS) services.¹¹

This contention is unavailing because there is no limitation in the identification of services indicating that Applicant's services are marketed through direct solicitation to global, multi-billion dollar enterprises that have technological resources to create their own applications for their specialized needs. In an *ex parte* proceeding, we are required to give full sweep to Applicant's identified services. We may not limit, by resort to extrinsic evidence, the scope of the services identified in the subject application. *In re Dixie Restaurants Inc.*, 105 USPQ2d, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Morton-Norwich Prods., Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984); *In re Heat Mirror Assoc.*, 219 USPQ 1015 (TTAB 1983); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

¹¹ Applicant's Brief, p. 7 (4 TTABVUE 8).

C. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.

Applicant argues that neither Registrant’s PaaS services nor Applicant’s website services are impulse purchases.

Rather, prior to engaging the services of Registrant, a client will visit the Registrant’s website, review other websites that Registrant has created, discuss with Registrant the features that the client wants for its website, and negotiate the terms of the services to be provided and the cost. Likewise, prior to engaging the services of Applicant, a client will have multiple online and personal demonstrations of Applicant’s services, review the technical specifications of Applicant’s services, engage in one-on-one meetings with Applicant to prepare plans for the development of software for the features that the client needs, and negotiate the terms of the services to be provided and the cost resulting in a contract that is reviewed at multiple levels by the client’s teams, including information technology groups, finance groups, and legal counsel.¹²

However, there is no actual proof to support these contentions. We have only Applicant's counsel’s statements as to the sales process and the resulting degree of consumer care. Putting aside whether a declaration from outside counsel could ever qualify as acceptable proof of these sort of facts,¹³ the record is devoid of any foundational information about counsel’s investigation of, or understanding of, Applicant’s business, that would put him in a position to make statements regarding the marketing of the services at issue, which in this case is essential to our analysis

¹² Applicant’s Brief, p. 9 (4 TTBVUE 10).

¹³ *Cf. In re DeBaun*, 687 F.2d 459, 214 USPQ 933, 934 & n.4 (CCPA 1982) (“we need not evaluate the weight to be given to the attorney's declaration with respect to statements more appropriately made by appellant”); *In re Nat’l Distiller & Chem. Corp.*, 297 F.2d 941, 132 USPQ 271, 274 (CCPA 1962).

of the registrability of the mark. *Cf. In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (where appellant argued that the magazines at issue deal with unrelated subject matter, the court held that “[s]tatements in a brief cannot take the place of evidence.”); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298, 302 (CCPA 1974) (where patent claims were rejected for the insufficiency of disclosure under Section 112, the response of appellant was argument in lieu of evidence leading the court to hold that “argument of counsel cannot take the place of evidence lacking in the record.”); *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983) (applicant argued without corroborating evidence that its brochure would be recognized as an offer of services leading the Board to hold that “[u]nfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence”); *Spin Physics, Inc. v. Matsushita Electric Industrial Co., Ltd.*, 168 USPQ 605, 607 (TTAB 1970) (“The arguments and opinions of counsel for applicant are wholly insufficient to overcome the facts established by the Sugaya report.”). *Compare In re Valenite Inc.*, 84 USPQ at 1348 (appellant submitted the declaration of its director of marketing who testified that appellant’s customers regularly order its products by contacting the customer service department by telephone).

Nevertheless, we agree with Applicant that “[t]he purchase of their services is not like harried parents picking up a candy bar for their child in a supermarket check-

out lane,”¹⁴ and we find that this *du Pont* factor weighs somewhat against finding likelihood of confusion.

D. Applicant’s family of “One” formative marks.

Applicant argues that because it markets its services through a family of “One” formative trademarks (*e.g.*, ONEadmin, ONEanalysis, ONEanalytics, *etc.*), “when taken together with their distinctive use of the common word ‘ONE’ in upper case letters and the following items in lower case letters, leads to recognition in clients and potential clients that the common characteristics are indicative of a common origin of the services.”¹⁵ However, a family of marks argument is not available in an *ex parte* appeal.

In an *ex parte* appeal, the focus of the likelihood-of-confusion analysis must be the mark applicant seeks to register, not other marks applicant may have used or registered. In other words, a family-of-marks argument is not available to an applicant seeking to overcome a likelihood-of-confusion refusal. *In re Lar Mor International, Inc.*, 221 USPQ 180 (TTAB 1983) (“In reaching the conclusion of no likelihood of confusion, we have given no weight to applicant’s argument ... that it owns a family of French-word marks all beginning with the word ‘TRES’...”); *In re Ald, Inc.*, 148 USPQ 520, 521 (TTAB 1965) (“Likewise, in view of the specific prohibition of Section 2(d) of the Statute, the fact that applicant may possess a ‘family’ of marks characterized by the term ‘ALD’ is of no particular significance herein if the mark for which applicant now seeks registration, ‘ALDPRESS’, when considered in its entirety, is confusingly similar to the previously registered mark ‘ALLPREST’.” (footnote omitted)). *See also In re U.S. Plywood-Champion Papers, Inc.*, 175 USPQ 444, 446 (TTAB 1972) (“Applicant’s ownership and registration of marks other than the mark

¹⁴ Applicant’s Brief, p. 9 (4 TTABVUE 10).

¹⁵ Applicant’s Brief, p. 11 (4 TTABVUE 12).

sought to be registered herein is immaterial and irrelevant to the specific issue before us, and cannot justify the registration of what could be a confusingly similar mark.” (citations omitted)).

In re Cynosure, Inc., 90 USPQ2d 1644, 1645-46 (TTAB 2009).

E. Analyzing the factors.

Despite the fact that the relevant consumers may exercise a somewhat higher degree of purchasing care, we find that because of the near identity of the marks, the relatedness of the services and the channels of trade, Applicant’s mark ONETECHNOLOGIES (standard characters) for “platform as a service (PAAS) featuring computer software platforms on which to build cloud computing applications and services; platform as a service (PAAS) featuring computer software platforms providing data management and data services in the cloud” is likely to cause confusion with the registered mark ONE TECHNOLOGY (standard characters) for “design, creation, hosting and maintenance of internet sites for third parties; hosting of digital content on the Internet.”

Decision: The refusal to register Applicant’s mark ONETECHNOLOGYIES is affirmed.