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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87126399

MARK: INTELLITRACK



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: TRACK GROUP, INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

18174.61

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant Track Group, Inc. ("Applicant") appeals the trademark examining attorney's final refusal to register the marks INTELLITRACK (design and words) and INTELLITRACK (standard characters) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) on the grounds that the registration of applicant's marks results in a likelihood of confusion with the registered mark INTELITRAC, Reg. No. 2903695. The examining attorney respectfully submits that the refusal to register should be affirmed.

## FACTS

On August 3, 2016, Applicant filed applications under Section 1(b) of the Trademark Act to register the marks INTELLITRACK with design, Serial No. 87126412, and INTELLITRACK in standard characters, Serial No. 87126399, for “software as a service (SAAS) services featuring software for electronic monitoring services for probation and parole agencies and for security and behavioral and re-socialization purposes, namely, remote monitoring of individuals released on probation or parole, all limited to the fields of probation and parole” in International Class 42 and “electronic monitoring services for probation and parole agencies and for security and behavioral and re-socialization purposes, namely, remote monitoring of individuals released on probation or parole, all limited to the fields of probation and parole” in International Class 45.

On November 21, 2016, the trademark examining attorney issued Office actions refusing registration under Section 2(d) of the Trademark Act citing the registration for INTELITRAC (typed drawing, Reg. No. 2903695), for “computer software that combines software and hardware, namely, fingerprint scanners, iris scanners, video surveillance cameras, digital cameras, and radio frequency identification scanners, all used to compile information to be used in real time image recognition, comparison and tracking applications, for use in a wide variety of fields, including identification of objects, and physical security in commercial and residential buildings, hospitals, and airports,” owned by Registrant.<sup>1</sup> Following Applicant’s response filed May 16, 2017, in which Applicant argued that the Section 2(d) refusal should be withdrawn, action on the application was suspended pending the disposition of a prior-filed pending application on June 7, 2017.

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<sup>1</sup> The trademark examining attorney also cited Registration No. 4969550 for the mark INTELETRACK (standard characters), for “security threat analysis for protecting public safety in the nature of analyzing the telephone communication system to detect pre-identified inmate activities; monitoring telephone calls of inmates and notifying law enforcement,” owned by Pay Tel Communications, Inc., and issued an advisory regarding the prior-filed pending application, Serial No. 86317014. The Section 2(d) refusal based on Registration No. 4969500 was later withdrawn, and no refusal was issued with respect to the prior-filed application.

On June 15, 2018, the trademark examining attorney issued Final actions refusing registration under Section 2(d) of the Trademark Act. Applicant filed Requests for Reconsideration on September 11, 2018, once again arguing that the Section 2(d) Refusal based on Reg. No. 2903695 should be withdrawn. The trademark examining attorney issued Reconsideration Letters on October 9, 2018, once again finding the applicant's arguments unpersuasive. Applicant filed Notices of Appeal with the Trademark Trial and Appeal Board (the "Board") on December 10, 2018, which was acknowledged on the same date. On January 9, 2019, Applicant filed its Appeal Brief.

The applications were assigned to a new trademark examining attorney, and Motions to Consolidate were filed January 17, 2019, which were granted January 25, 2019.

### **ISSUE**

The sole issue on appeal before the Board is whether the registration of Applicant's marks, INTELLITRACK (and design) and INTELLITRACK (standard character), results in a likelihood of confusion with the registered mark, INTELITRAC, in Registration No. 2903695.

### **ARGUMENTS**

#### **THE REFUSAL TO REGISTER BASED ON A LIKELIHOOD OF CONFUSION SHOULD BE AFFIRMED.**

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "du Pont factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450

F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The 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.”); TMEP §1207.01.

Here, Applicant’s and Registrant’s marks, INTELLITRACK (design and words) and INTELLITRACK (standard characters) and INTELITRAC (typed drawing) are nearly identical in appearance, sound, meaning, and commercial impression, and the respective goods and services that are highly related because they are sold by the same entities, through the same trade channels and to the same consumers, resulting in a likelihood of confusion.

I. THE APPLICANT AND REGISTRANT’S MARKS ARE SIMILAR IN APPEARANCE, SOUND, MEANING, AND COMMERCIAL IMPRESSION

Applicant’s mark, INTELLITRACK, a word and design mark, and Registrant’s mark, INTELITRAC, a typed drawing, are identical in sound, and highly similar in appearance, meaning, and commercial impression because they are comprised of nearly identical combinations of the word “INTELLI” or “INTELI” and “TRACK” or “TRAC.”

A. *The Marks Are Confusingly Similar.*

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

In the present case, Applicant’s marks consist of INTELLITRACK with the wording and design and INTELLITRACK in standard characters, and the Registrant’s mark is INTELITRAC in a typed drawing format. The wording in Applicant and Registrant’s marks begin with virtually the same prefix, namely, INTELLI and INTELI and end with TRACK and TRAC, which also are almost identical in appearance and sound the same. The marks are thus essentially phonetic equivalents and sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Further, the marks, comprised of a combination of an “INTELLI-” formative prefix and the word “TRACK” or “TRAC,” have identical meanings, namely, suggesting that the goods and services will follow or observe the target using computer technology. June 15, 2018 Office Action, TSDR pp. 5-6.<sup>2</sup> The similarity in sound and appearance between the two marks creates the same overall commercial impression in the mind of the average purchaser, particularly when considered in connection with the applicant and registrant’s respective goods and services.

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<sup>2</sup> The records for the two applications are identical, and so references to TSDR records are references to the prosecution history for both applications, unless otherwise noted.

Although the Applicant's mark consists of a design with the wording INTELLITRACK, the design element does not distinguish the marks in appearance because Registrant's mark is in a typed drawing format and because a typed drawing mark may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, the inclusion of a design in Applicant's mark does not avoid a likelihood of confusion with Registrant's typed drawing mark because the word portion could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Therefore, the marks are confusingly similar.

## II. THE PARTIES' GOODS AND SERVICES ARE RELATED AND PROVIDED BY THE SAME ENTITIES AND TRAVEL THROUGH THE SAME TRADE CHANNELS

Applicant's services and Registrant's goods are related for the purposes of likelihood of confusion because they are offered by the same entities under the same mark, travel in the same channels of trade and are sold to the same classes of consumers. Applicant's services are "software as a service (SAAS) services featuring software for electronic monitoring services for probation and parole agencies and for security and behavioral and re-socialization purposes, namely, remote monitoring of individuals released on probation or parole, all limited to the fields of probation and parole" in International Class 42 and "electronic monitoring services for probation and parole agencies and for security and behavioral and re-socialization purposes, namely, remote monitoring of individuals released on probation or parole, all limited to the fields of probation and parole" in International Class 45. Registrant's services are "computer software that combines software and hardware, namely,

fingerprint scanners, iris scanners, video surveillance cameras, digital cameras, and radio frequency identification scanners, all used to compile information to be used in real time image recognition, comparison and tracking applications, for use in a wide variety of fields, including identification of objects, and physical security in commercial and residential buildings, hospitals, and airports” in International Class 9.

*A. Registrant’s Goods Are Related To Applicant’s Services*

With respect to Applicant’s services and Registrant’s goods, where the marks of the respective parties are virtually identical, as in this case, the degree of similarity or relatedness between the goods and services needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

The compared goods and services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). 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 [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In the present case, the Applicant’s services and Registrant’s goods are related because they are both offered by companies that provide the tracking and monitoring services and the computer software that conducts the monitoring service. As such, these goods and services are sold in the same trade channels and reach the same classes of consumers, including probation and parole agencies.

Therefore, the average consumer is accustomed to seeing the monitoring services and computer software and hardware that compiles the monitoring information emanating from the same source, making these goods and services related for the purposes of likelihood of confusion.

Although applicant argues that the parties' trade channels are limited (4 TTABVue 9), this argument is unpersuasive. Though containing some language regarding its fields, the cited registration does not contain a true limitation. Because its list of fields follow the word "including," which is considered an indefinite word that does not limit the fields to whatever follows, they are not considered an exclusive list. See TMEP § 1402.03(a). Thus, because there are no limitations to the fields, the presumption as to the INTELITRAC mark is that Registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP § 1207.01(a)(iii). Thus, the INTELITRAC mark is presumed to be used for goods for all relevant industries and applications, including those that overlap with applicant's industries.

Moreover, the Internet evidence of record, attached to the first and Final actions, consisting of printouts of several websites, demonstrate that electronic monitoring for use by probation and parole officers is often performed using the registrant's computer software goods. Particularly:

1. **Reliant:** offers software and hardware for remote monitoring and monitoring services for security purposes, and use software and hardware for their monitoring services – <http://reliantmonitoring.com/work/electronic-monitoring-rf/> and <https://bi.com/products-and-services/>. November 21, 2016 Office Action, TSDR p. 10-11.
2. **Comcor:** offers software and hardware for remote monitoring and monitoring services for security purposes, and use software and hardware for their monitoring services – <http://www.comcor.org/electronic-monitoring>. November 21, 2016 Office Action, TSDR p. 12.
3. **2 Watch Monitoring:** offers software and hardware for remote monitoring and monitoring services for security purposes, and use software and hardware for their monitoring services

- <http://2wm.com/affordable-electronic-monitoring/>. November 21, 2016 Office Action, TSDR p. 13.
4. **3M**: software for tracking and fingerprint scanners and retina scanners, radio frequency scanners, promoted as being used for probation purposes – [http://www.3m.com/3M/en\\_US/public-safety-us/applications/parole-probation/](http://www.3m.com/3M/en_US/public-safety-us/applications/parole-probation/); [http://www.3m.com/3M/en\\_US/public-safety-us/applications/house-arrest/](http://www.3m.com/3M/en_US/public-safety-us/applications/house-arrest/); [https://www.3m.com/3M/en\\_US/public-safety-us/](https://www.3m.com/3M/en_US/public-safety-us/). June 15, 2018 Office Action, TSDR pp. 7-22.
  5. **AMERICAN GUARD SERVICES, INC.**: software for monitoring and video cameras, and showing that the services and goods are directed towards probation and other similar security applications – <http://www.americanguardservices.com/industries/security-monitoring>. June 15, 2018 Office Action, TSDR pp. 23-28.
  6. **SENTINEL**: monitoring services offered with monitoring software and hardware, such as RF scanners, for courts, law enforcement, and corrections – <https://www.sentineladvantage.com>; <https://www.sentineladvantage.com/sentineldna/>; <https://www.sentineladvantage.com/rf-patrol/>; <https://www.sentineladvantage.com/monitoring-services/>. June 15, 2018 Office Action, TSDR pp. 29-44.
  7. **NUMEREX**: monitoring services, monitoring software, and computer hardware and software offered for monitoring and tracking purposes for parole and probation applications – <http://numerex.com/solutions/safety-security/electronicmonitoring/>; <http://numerex.com/solutions/safety-security/electronicmonitoring/solution-components/>. June 15, 2018 Office Action, TSDR pp. 45-54.
  8. **MINNESOTA MONITORING**: monitoring services that incorporate radio frequency technology – <http://www.mnmonitoring.com/home-monitoring.html>. June 15, 2018 Office Action, TSDR pp. 55-58.
  9. **BI**: monitoring services offered with monitoring software that works with RF monitoring hardware – <https://bi.com/products-and-services>; <https://bi.com/products-and-services/bi-monitoring-ops>; <https://bi.com/products-and-services/totalaccess-offender-monitoring-web-based-software/>. June 15, 2018 Office Action, TSDR pp. 59-78.

The above evidence establishes that Applicant's services and Registrant's goods are both provided by the same entity via similar or same trade channels to the same classes of consumers. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). Applicant alludes to the Declaration in its Request for Reconsideration in distinguishing Applicant and Registrant's trade channels (4 TTABVUE 6). The

Declaration states that “products and services demanded by the probation and parole industries have specialized and unique requirements” compared to “general purpose goods/services.” September 11, 2018 Request for Reconsideration, TSDR p. 110. However, as established above, Registrant’s services are broadly encompassing due to the wording “including” in its identification, and is likely to also involve the probation and parole industries.

Therefore, the goods and services are thus related for the purposes of likelihood of confusion.

*B. Applicant’s Arguments Are Unpersuasive*

Applicant argues that Registrant’s goods are limited to specific fields, particularly that Applicant’s goods and services relate to tracking hardware, software and related services used by “professional probation and parole officers.” 4 TTABVue p. 9. Applicant further adds that its services have unique requirements that are distinguished from Registrant’s “general purpose goods/services intended for commercial, building, hospital, and airport security”. *Id.* However, Registrant’s goods as identified are not limited to any specific field, despite several fields being listed after the non-exclusive wording “including.” This means that any following limitation, as Applicant applies to “commercial, building, hospital, and airport security” is not a true limitation. Without any limitations on the goods, they are presumed to encompass goods used in all fields, including Applicant’s specified fields of probation and parole.

Thus, because the Registrant’s goods and Applicant’s services are provided by the same entities under the same marks, travel through the same trade channels to the same classes of purchasers, this factor weighs in favor of a likelihood of confusion.

III. THE ALLEGED SOPHISTICATION OF PURCHASERS DOES NOT OBVIATE A LIKELIHOOD OF CONFUSION.

Applicant also argues that the purchasers in the probation and parole industry are “highly sophisticated and discriminating.” However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Indeed, “[h]uman memories even of discriminating purchasers . . . are not infallible.” *In re Research and Trading Corp.*, 230 USPQ 49, 50 (Fed. Cir. 1986), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017) 434 F.2d 1403, 1406, 168 USPQ 110, 112 (CCPA 1970). A sophisticated purchaser is still likely to be confused as to the source of Applicant’s services and Registrant’s goods in the marketplace. Therefore, this factor does weigh against a likelihood of confusion.

#### IV. THE EXISTENCE OF OTHER MARKS DOES NOT WEIGH AGAINST THE LIKELIHOOD OF CONFUSION.

Applicant argues that the registered mark is weak because there are several existing registrations on the Register that are marks comprising a combination of “intell” or its equivalent with “track” or its equivalent spelling. 4 TTABVUE 4-5. However, this argument is unpersuasive.

Applicant has submitted electronic copies of third-party registrations for marks containing the wording INTELL and TRACK, or variations of the same, to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. September 11, 2018 Request for Reconsideration, TSDR pp. 15-109. These registrations appear to be for goods and/or services that are predominantly different from or unrelated to those identified in applicant’s application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or

services. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has "no bearing on the strength of the term in the context relevant to this case." See *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). The registrations submitted by Applicant consist of a variety of goods and services, including color measurement instruments, signal processing equipment, media consoles, software for floor cleaning, motorized golf carts, business marketing services in the field of healthcare, equipment used in converting solar energy to electricity, websites that feature automotive information, secure portable travel bags, financial services in the automobile industry, and metal rollers and room dividers.

September 11, 2018 Request for Reconsideration, TSDR pp. 15-18 (INTELLITRACK for bar code data collection system, namely, bar code computer hardware and software in International Class 9); pp. 19-22 (INTELLITRACS for computer software for analyzing and processing bank transaction data in International Class 9); pp. 27-30 (INTELLI-TRACK for metal rollers for movable partitions and room dividers in International Class 6); pp. 31-34 (INTELLITRACKER for financial services, namely, providing non-downloadable software in International Class 42); pp. 35-39 (INTELLITRAK for signal processors and signal processing equipment in International Class 9); pp. 40-44 (INTELLITRAK for motorized golf carts, off-highway utility vehicles and automobiles in International Class 12); pp. 45-48 (INTELLITRAX for color

measurement instruments in International Class 9); pp. 49-52 (INTELLITRAC for media consoles in International Class 20); pp. 53-56 (ENTELLITRAK for computer software for use in monitoring a company's or agency's employment and/or civil rights cases in International Class 9); pp. 57-61 (THE INTELLIGENT TRACK for electric track lighting units in International Class 9); pp. 62-66 (INTELLITRAK for computer software for use in controlling and monitoring respiratory equipment in International Class 9); pp. 67-70 (INTELLI-TRAX for gears and enclosed drives for industrial machinery in International Class 7); pp. 71-74 (INTELLITRAC for providing a secured-access website to share documents and images featuring automotive and vehicular information in International Class 42); pp. 75-78 (INTELITRACK for equipment used in converting solar energy to electricity in International Class 9); pp. 79-82 (INTELLI-TRACKER for secure portable travel bags in International Class 18); pp. 83-86 (INTELLIGENT PRICE TRACKING for providing commercial information in the field of travel and transportation in International Class 35); pp. 87-90 (INTELLIGENT TRACER for oil prospecting in International Class 42 and chemical additives in International Class 1); pp. 91-94 (INTELETRACK for security threat analysis for protecting public safety and monitoring telephone calls of inmates in International Class 45); pp. 95-98 (INTELLIGENT OPTICAL TRACKING for medical devices consisting of lasers in International Class 10); pp. 99-102 (INTELLI-TRAK for downloadable software program for remote monitoring of floor cleaning in International Class 9); pp. 103-105 (INTELLITRACK for business marketing and promotional services in the field of healthcare in International Class 35); pp. 106-109 (INTELLITRAK for motorized golf carts in International Class 12). Applicant provided no explanation as to why these goods or services should be considered related to the goods and services at issue, and therefore, has not established any dilution. Among the provided third-party registrations, the only one that has any relatedness with the Applicant's services is Reg. No. 2903695, which is the basis for the Section 2(d) refusal in this case. Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording INTELLITRACK or

any variation thereof is weak or diluted. Moreover, it has long been held that each case must be decided on its own merits. See e.g. *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Applicant in its Appeal Briefs argues that the case at present is similar to the issue in *In re Hunke & Jochheim*, where the Board ruled that the applicant's mark HIG-DURABLE was distinguished from the registrant's mark DURABUL because "DURABUL" was a play on "DURABLE" and the addition of HIG distinguished the applied-for mark from the registrant's mark. 4 TTABVUE 7-8. The difference between *In re Hunke* and the present case is that the marks here are INTELLITRACK and INTELITRAC, which are virtually identical in appearance and sound, whereas the *In re Hunke* applicant had a completely distinctive term added to the common term "DURABUL"/"DURABLE".

Applicant also relies on *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974), in arguing against the likelihood of confusion. 4 TTABVUE 6. However, the Court of Customs and Patent Appeals in that case stated that confusion was not likely between KING'S for candy and MISS KING'S for cakes because "the marks are so widely used that the public easily distinguishes slight differences in the marks under consideration as well as differences in the goods to which they are applied, even though the goods of the parties may be considered 'related.'" *King Candy Co.*, 496 F.2d at 1401.

In the present case, the record does not show that the marks INTELLITRACK and INTELITRAC are not used so widely that the public could easily distinguish the slight differences in the marks, such as in KING'S and MISS KING'S. There is no evidence to support this contention. 4 TTABVUE 6. Applicant merely states the law from the *King Candy Co.* case, and, as established above, the cited mark is not weak or diluted, because it is the only mark on the Register with similar enough goods to the applied-for services. Moreover, Applicant's arguments that the Applicant's services are limited only to the fields of probation and parole do not persuade as the Internet evidence of record clearly demonstrates that the services are provided in conjunction with the goods, directed to both probation and parole industries

alongside other industries. Registrant's goods are provided for commercial and residential buildings, hospitals, and airports, and are also used in a "**wide variety of fields**," as it is identified in the Registration (emphasis added).

To the extent that Applicant makes a collateral attack on the registration, asserting that it is a combination of "laudatory" and "descriptive" wording (4 TTABVue 4), such an attack is improper and should not be considered. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (in an appeal of a Section 2(d) refusal, "applicant is not permitted to overcome a refusal by arguing that a cited registration is merely descriptive.").

Therefore, in light of Applicant's unpersuasive argument regarding dilution and the fact that Applicant's marks and Registrant's mark are similar in appearance, sound, connotation and commercial impression, this factor weighs in favor of a likelihood of confusion.

#### V. DOUBT RESOLVED IN FAVOR OF THE REGISTRANT

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). In this case, there is no doubt because the record shows that the marks are virtually identical in appearance, sound, and commercial impression, and Applicant's services are performed using Registrant's goods and these goods and services travel through the same or similar trade channels, such that there is a likelihood of confusion as to the source of the parties' respective goods.

**CONCLUSION**

For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the grounds that the registration of the applied-for marks results in a likelihood of confusion with a registered mark should be affirmed.

Respectfully submitted,

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