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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87597189

MARK: E8 STORAGE



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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: E8 Storage Systems Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T-13022-US

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE ISSUE

Applicant E8 Storage Systems, Ltd. ("applicant") seeks to register the mark "E8 STORAGE", in standard character form, for "computer software for storage of data and information; computer software that allows software modules in virtual containers to deliver processing of data; rack-mounted computer storage devices, namely, high speed storage sub systems for high performance and high availability storage of electronic data either locally or via a telecommunications network; all the foregoing not intended for end-users and all the foregoing excluding computer software for use in monitoring and responding to computer security breaches and computer anti-virus software". The examining attorney refused registration of applicant's mark under Trademark Act Section 2(d), 15 U.S.C.

§1052(d), based on a likelihood of confusion with U.S. Registration No. 4681429 for the mark “E8 SECURITY”, also in standard character form, for goods and services, in relevant part, “computer software for use in monitoring and responding to computer security breaches; computer anti-virus software; computer security consultancy services”. The sole issue on appeal is whether there is a likelihood of confusion between applicant’s mark and registrant’s mark.

II. STATEMENT OF THE CASE

On September 6, 2017, applicant applied to register the mark “E8 STORAGE”, in standard character form, for goods identified as “computer software for storage of data and information; computer software that allows software modules in virtual containers to deliver processing of data; rack-mounted computer storage devices, namely, high speed storage sub systems for high performance and high availability storage of electronic data either locally or via a telecommunications network; all the foregoing not intended for end-users and all the foregoing excluding computer software for use in monitoring and responding to computer security breaches and computer anti-virus software.” On December 21, 2017, the examining attorney refused registration of applicant’s mark under Trademark Act Section 2(d) because applicant’s mark was considered confusingly similar to the mark found in U.S. Registration No. 4681429. In addition, the examining attorney refused registration under Trademark Act Sections 1 and 45 for failure to show the applied-for mark in actual use in commerce and required applicant to submit additional information about its goods, disclaim descriptive wording in the applied-for mark, and amend the identification of goods. In a response filed January 13, 2019, applicant resolved and satisfied the Sections 1 and 45 refusal as well as the request for information, disclaimer, and amendment of identification of goods requirements. Additionally, applicant set forth reasons as to why the Section 2(d) refusal should be withdrawn. In a final Office action dated July 21, 2018, the examining attorney made final the Section 2(d) refusal. In a request for reconsideration filed January 13, 2019, applicant amended its identification of goods to specifically exclude some of registrant’s goods and reiterated its arguments against the Section 2(d) refusal. On February 1, 2019, the examining attorney accepted the amended identification of goods into the record but denied the request for reconsideration as it related to the Section 2(d) refusal. On January 13, 2019, applicant filed a notice of appeal with the Trademark Trial and Appeal Board (“TTAB”). On April 7, 2019, applicant filed its appeal brief and on April 9, 2019, the TTAB forwarded the file to the examining attorney for her brief.

Comes now the examining attorney and states as follows:

III. ARGUMENT

Applicant’s mark is similar to registrant’s mark because the first and dominant portion of both marks is the identical letter and numerical combination “E8”, creating a confusingly similar commercial impression. When the marks are considered as a whole, the difference in the additional wording is insufficient to obviate the overall similarity. Further, when combined with the relatedness of the associated goods and services, applicant’s mark is likely to cause confusion in consumers who are likely to mistakenly believe that applicant’s goods and registrant’s goods and services come from the same source or are affiliated goods and services from the same entity.

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.

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).

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).

When comparing marks, “[t]he 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 [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St.*

Helena Hosp., 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971)); TMEP §1207.01(b).

1. The Marks Share Identical Dominant Features

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

In this case, the marks at issue both begin with the same lead matter, i.e., “E8”, and thus they are identical in sound and appearance in their most dominant and thus source-indicating features. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”).

2. Additional Descriptive Wording in the Marks is Insufficient to Overcome the Likelihood of

Confusion

The additional wording in the parties’ respective marks, i.e., “STORAGE” in the applied-for mark and “SECURITY” in the registered mark, have been disclaimed by the respective parties as descriptive of their goods and/or services thus, their inclusion in the marks at issue is simply insufficient to obviate the likelihood of confusion. Disclaimed matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Here, the terms “STORAGE” in the applied-for mark and “SECURITY” in the registered mark are less distinctive or significant in terms of indicating the source of applicant and registrant’s respective goods and/or services, rendering “E8” the dominant feature upon which consumers will focus to indicate the source of the parties’ goods and/or services. Because consumers will focus on the same term to indicate the source of the relevant goods and/or services, confusion as to the source of those goods and/or services remains highly likely.

Moreover, the presence of the additional wording in both parties’ marks does little in terms of affecting the confusingly similar overall commercial impression created by the shared identical dominant feature “E8”. 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. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Here, the dominance of the common matter

“E8” is only heightened because the balance of the marks at issue is highly descriptive. Because the marks at issue are both comprised of a combination of the same dominant feature and descriptive wording, consumers would be likely to perceive applicant's and registrant's marks as different product and/or service lines of the same “E8” entity. For example, consumers would see “E8 STORAGE” and “E8 SECURITY” as different computer-related storage products and/or computer-related security products and service lines under the larger “E8” brand. Therefore, consumers would reasonably believe that the marks originate from the same source.

Rebuttal of Applicant’s Arguments against the Similarity of the Marks

Applicant argues that the marks are distinct in sound and appearance because, when considered in their entirety, the wording in the marks at issue highlights that the parties engage in separate commercial fields of activities. However, the parties’ marks share the same, initial source-indicating matter, i.e., “E8”, thus they are actually identical in part in their most significant feature in sound and appearance. Further, even if the inclusion of the additional descriptive terms in the marks at issue suggests a distinction between the types of goods and/or services provided by the parties, any such suggested distinction is irrelevant in terms of commercial impression and the larger likelihood of confusion analysis. The consumer marketplace is replete with entities that offer distinct goods and services under a single source, including the relevant goods and services in this case as shown by the evidence of record. The issue is not likelihood of confusion between particular goods [and services], but likelihood of confusion as to the source or sponsorship of those goods [and services]. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Here, the fact that the wording in the marks may suggest a distinction between the type of goods and services is irrelevant because the parties share identical dominant matter upon which consumers will focus to indicate the source or sponsorship of those goods and/or services. Consumers will perceive the marks at issue as emanating from a single source, i.e., the “E8” brand, which consumers would perceive as the offeror of different types of computer software, computer devices and computer services. Such consumer perception is highly likely because, as reflected by the evidence from and the nature of the marketplace, consumers are accustomed to seeing a single source provide the relevant goods and services.

i. When Viewed in their Entireties, the Marks Create a Confusingly Similar Overall Commercial Impression

When properly viewed in their entireties, the inclusion of the additional terms in the marks at issue actually enhances the likelihood of confusion because they do not change the overall meaning of the marks. Here, both marks feature “E8” which, as shown by the evidence of record, means the fifth letter in the English alphabet and eighth in a set of series. See July 21, 2018 Final Action, TSDR pp. # 2-5; 7-10. When taken together, “E8” denotes the eighth in a set of series designated by the letter “e” or the “E8” series. In the applied-for mark, the evidence of record also shows that the term “STORAGE” means the act of putting things that are not in use in a place where it is available. See July 21, 2018 Final Action, TSDR pp. # 85-89. Thus, in the context of the applicant’s goods the applied-for mark “E8 STORAGE” conveys the commercial impression that consumers will experience the “E8” series of computer-related goods that also relate to storing things. Regarding the registrant’s mark, the evidence of record establishes that the additional term “SECURITY” means the state of being secure. See July 21, 2018 Final

Action, TSDR p. # 92. Thus, when taken together and applied to the registrant's goods and services, the registered mark "E8 SECURITY" conveys the commercial impression that consumers will experience the "E8" series of computer-related goods and services that also relate to securing things. Therefore, the overall commercial impression between the marks is highly similar because both marks convey the impression that the computer-related goods and/or services of the parties' are subsets, either storage or security-related, of the designated "E8" series. Further, because a single source often provides computer storage, computer security and computer consultancy goods and services, consumers will likely mistakenly view "E8 STORAGE" as simply another line of goods offered by the registrant.

ii. Differences in Syllables, Pronunciation and Appearance are Insufficient to Overcome the Likelihood of Confusion Due to the Similar Overall Commercial Impression

Applicant argues that because mere distinctions in syllables, pronunciation and appearance have been found sufficient to distinguish marks in other cases, the wording distinction in the marks at issue is compelling enough to overcome confusion. However, each case is decided on its own facts, and each mark stands on its own merits. *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d at 1793 n.10 (quoting *In re Boulevard Entm't*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003)). Moreover, marks with different numbers of syllables, pronunciation and/or appearance will cause confusion where they present a similar commercial impression. If the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., In re Detroit Athletic Co.*, ___ F3d ___, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (affirming TTAB's finding that the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are nearly identical in terms of sound, appearance and commercial impression, and noting that, while "the words 'Co.' and 'Club' technically differentiate the marks, those words do little to alleviate the confusion that is likely to ensue"); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (affirming TTAB's holding that contemporaneous use of appellant's mark, VEUVE ROYALE, for sparkling wine, and appellee's marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, noting that the presence of the "strong distinctive term [VEUVE] as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE"). Here, the shared dominant and thus primary source-indicating matter of the marks, i.e., "E8", is strong, distinctive matter, especially when viewed in the context of the remaining highly descriptive additional matter "STORAGE" and "SECURITY" respectively. Further, when viewed in their entirety with the non-dominant features discounted, the marks become identical. Thus, despite the additions of descriptive terms, the marks at issue remain identical in terms of their most prominent feature and when properly viewed in their entirety create a confusingly similar overall commercial impression.

iii. Applicant's Citation of Case Law Fails to Support a Finding that Confusion is Not Likely in this Case

In further support of its argument that the marks are distinguishable because of the parties' respective inclusions of additional terms, applicant cites various case law wherein the courts found no likelihood of confusion between marks with slight or no differences in appearance and/or sound, however, these cases are all factually distinguishable from the case at hand. First, the TTAB in *In Re Sears*,

Roebuck & Co. and *In Re Sydel Lingerie Co.* found no likelihood of confusion because the marks “CROSS-OVER” vs. “CROSSOVER” and “BOTTOMS UP” vs. “BOTTOMS UP” had different meanings when applied to the goods at issue in those cases, and as a result created different commercial impressions. Second, the marks in *Jewel Co. v. Jewelcor Inc.* and *Ashe v. Pepsico Inc.*, i.e., “JEWELCOR” vs. “JEWEL” and “ADVANTAGE ASHE” vs. “ADVANTAGE”, are distinguished by the inclusion of distinctive wording that also significantly changes the commercial impression. However, in the present case, as noted above, given the identical dominant feature and the parties’ mere additions of descriptive terms, the parties’ marks have similar meanings when applied to the respective goods and services and thus create a highly similar overall commercial impression. Therefore, because, unlike those cases, the marks here are identical in part and are not combined with any distinctive wording that would create a different meaning or impression, the applicant’s reliance on those cases is misplaced and the Board should find that the marks are confusingly similar.

B. The Goods and Services of the Parties are Closely Related

Applicant’s goods are closely related to registrant’s goods and services because they are frequently provided by a single source under one mark. In this case, applicant’s goods are various computer storage software and computer storage devices, in International Class 9, with full listing above.

Registrant’s goods and services are “computer software for use in monitoring and responding to computer security breaches; computer anti-virus software” in International Class 9; and, in relevant part, “computer security consultancy services” in International Class 42. The evidence of record shows that applicant’s goods and registrant’s goods and services are closely related in that they are commonly provided by the same entity under the same mark. 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). For example, the First Office action issued on December 21, 2017 included webpage printouts showing the featured goods and services of the type identified in the application and registration, including:

- *ibm.com* website (December 21, 2017 Office action, TSDR pp. 5-42)
IBM website offering software for data storage and computer security software.
- Hewlett Packard websites (December 21, 2017 Office action, TSDR pp. 43-56)
Hewlett Packard websites offering software for data storage, software that allows software function capabilities related to data, computer security advisory services, and computer security software.
- *Veritas.com* website (December 21, 2017, Office action, TSDR pp. 57-65)
Veritas website offering computer storage appliance, software for data storage, software that allows function capability related to data, and computer security advisory services.

- Dellemc.com website (December 21, 2017, Office action, TSDR pp. 66-73)
Dell website offering software for data storage, software that allows software function capability related to data, and computer security software and advisory services.
- Microsoft.com website (December 21, 2017, Office action, TSDR pp. 74-81)
Microsoft website offering software for data storage and security-related computer software advisory services.

Further, the examining attorney also attached to the Final Action dated July 21, 2018, additional webpage printouts showing the featured goods and services of the type identified in the application and registration, including:

- Ibm.com website (July 21, 2018 Final Office action, TSDR pp. 18-22)
IBM website offering software for data storage and computer security software.
- Netapp.com website (July 21, 2018 Final Office action, TSDR pp. 23--37)
Netapp website offering software for data storage and software for data storage, security and antivirus protection.
- Vmware.com website (July 21, 2018 Final Office action, TSDR pp. 38-48)
Vmware website offering software for data storage, software for security, and security consultancy services.
- Hpe.com website (July 21, 2018 Final Office action, TSDR pp. 49-58)
Hewlett Packard website offering software for data storage, software that allows software function capabilities related to data, computer security advisory services, and computer security software.

This evidence demonstrates that consumers are accustomed to seeing a single entity offer the relevant goods and services under a single source. Given the identical source-indicating matter in the marks at issue and the fact that the relevant goods and services are commonly provided in the marketplace by a single source, a consumer could mistakenly believe that the relevant goods and services emanate from the same source.

Finally, the record also contains numerous third-party registrations showing that the goods and services of both applicant and registrant are closely related because they are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii). For example:

- “RUGGED. RELIABLE. READY” Registration No. 5501841

Class 9 goods, including computer storage devices, namely, high-speed storage subsystems for storage and backup of electronic data; Class 42 services, including computer security consultancy; (July 21, 2018 Final Office action, TSDR pp. 77-55)

- “COPSYNC” Registration No. 5283909
Class 9 goods, including computer software for storing data and information and computer software pertaining to security matters in educational institutions;
(July 21, 2018 Final Office action, TSDR pp. 72-79)
- “CLOUD PROCESSOR” Registration No. 4618925
Class 9 goods including computer security software and computer data processing software;
(July 21, 2018 Final Office action, TSDR pp. 63-65)
- “SUNGUARD AVAILABILITY SERVICES” Registration No. 4694503
Class 9 goods computer software for use in the fields of data storage and computer security; Class 42 services, including computer security consultancy;
(July 21, 2018 Final Office action, TSDR pp. 66-68)
- “CM BROWSER” Registration No. 5056339
Class 9 goods, including computer antivirus software, computer security software and computer software for electronic storage of data;
(July 21, 2018 Final Office action, TSDR pp. 69-71)
- “NORTON SECURED” Registration No. 4365342
Class 9 goods, including computer software for storage of data and information and computer security-related software; Class 42 services, including computer security consulting.
(July 21, 2018 Final Office action, TSDR pp. 80-84)

The combined evidence thus establishes that the goods and services of the parties are closely related in the marketplace and that they are likely to emanate from a common source.

Rebuttal of Applicant’s Arguments against Relatedness of the Goods and Services

Applicant argues that specific goods at issue are not related because they differ in their functions, i.e., computer software for storage provided by the applicant versus computer software for security provided by the registrant. However, as previously noted, the fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In*

re Majestic Distilling Co., 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

Moreover, applicant's argument against relatedness of the goods and services is singularly focused on the parties' respective computer software goods and completely ignores its storage device goods and the registrant's computer consultancy services. Therefore, applicant concedes the relatedness of its computer software and storage device goods and the registrant's computer consultancy services.

1. Applicant's Amendment to its Identification does not Obviate the Likelihood of Confusion

Applicant argues that its amendment to its identification of goods to explicitly exclude the intended users of its goods and the registrant's computer software goods sufficiently distinguishes the relevant goods and establishes that there is no overlap between the relevant goods. Applicant's amendment, however, does not establish any distinction or lack of overlap between the relevant goods. First, consumers do not see identifications of goods and services, rather, they encounter trademarks and service marks as well as goods and services in the marketplace. Second, the evidence of record establishes that the relevant goods and services are often sold and/or provided under a single source. Thus, contrary to applicant's assertion that there is no overlap between the parties' respective goods and services, the evidence of record establishes that the manner by which the identified goods and services are marketed and sold could give rise to the mistaken belief that the relevant goods and services emanate from the same source. Third, applicant's argument again does not address all of its goods against the registrant's services, and therefore concedes the relatedness of its goods and the registrant's services. Fourth and finally, applicant's continued reliance on any apparent distinctions between the goods and services is irrelevant as the issue is likelihood of confusion as to the source or sponsorship of the goods and services. Here, the evidence of record establishes that confusion as to the source of the goods and services is likely.

2. Sophistication of Purchasers

Applicant further argues that the consumers of the goods at issue are sophisticated and thus not likely to be confused. However, applicant's argument also does not address the relatedness of its goods and the registrant's services. Moreover, 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).

3. The Standard of Care is not High Enough to Prevent a Finding of a Likelihood of Confusion

In its brief, applicant contends that due to the nature of the goods, purchasers will exercise sufficient care to prevent any confusion. Again, applicant's argument fails to address the relatedness of the registrant's services versus applicant's goods. Moreover, applicant has provided no evidence as to the degree of care taken by consumers of the type of goods and services provided by either applicant or registrant. Both applicant's and registrant's goods and/or services are identified in a manner that includes those provided to the general public. Where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods [and services] is that of the least sophisticated potential

purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163).

4. Purchase Price of Specific Goods

Applicant argues that the goods are not related because its software goods command a significantly higher price point which further supports that consumers of its products exercise a higher degree of care in their purchasing decisions. However, there is no limitation in its application (or in the cited registration) as to price. Moreover, the evidence demonstrates that the relevant goods and services are readily accessible via webpages located on the Internet, a pervasive medium, and thus are widely available consumer products and services. Given this wide availability, the potential for consumer confusion remains likely.

5. Applicant's Citation of Case Law Fails to Support a Finding that the Goods and/or Services Are Unrelated in this Case

To further support its claims that the goods at issue are not related, applicant cites *In Re Software Design, Inc.*, 220 USPQ 662 (TTAB 1983) and *In Re Reach Electronics, Inc.* 175 USPQ 734 (TTAB 1972) where the TTAB found no likelihood of confusion based upon an analysis of the cumulative differences between the marks and goods and services at issue in those cases. The facts in those cases, however, are simply not present in the instant case. First, in *In Re Software Design, Inc.*, the marks in that case, i.e., "DOX" vs. "DOC'S", were found sufficiently different in appearance, meaning and commercial impression as they contained dominant terms that had differences in spelling and punctuation. As a result of such spelling distinction, the marks had substantially different meanings and connotations when considered in relation to the relevant services. Whereas in this case, as discussed above, the marks are highly similar in sound and appearance because they share the identical dominant feature "E8" that elicits the exact same meaning. Further, the distinguishing elements in the marks at issue in the present case are the highly descriptive terms "STORAGE" and "SECURITY" that only serve to enhance consumer focus on the shared identical dominant feature "E8" thereby enhancing the likelihood of confusion as to the source of the parties' goods and/or services. Second, the services at issue in *In Re Software Design, Inc.*, were found to be different in nature, however, in this case, the relevant software goods at issue are identical in nature. Moreover, the evidence shows that consumers are accustomed to accessing and/or seeing the relevant software goods, as well as the computer device goods and consulting services via a single source website or direct telephone contact of such single source. Therefore, an analysis of the cumulative similarities of the marks as well as the goods and services at issue in this case support a finding of likelihood of confusion.

Similarly, in *In Re Reach Electronics, Inc.*, the marks at issue, "REAC" and "REACH", were found to be sufficiently different in sound, appearance, and commercial impression because the single letter difference between the marks there created two distinct terms with clearly distinguishable pronunciations and meanings. Again, in the present case, the standard character

marks feature dominant terms that have absolutely no distinctions in appearance, sound, meaning, connotation or commercial impression. Applicant's attempt to analogize cases wherein the marks at issue sound similar but are also so distinguished in meaning, connotation and commercial impression, provides no basis for the registrability of the applied-for mark over a registered mark with which it shares an identical dominant feature and an overall confusingly similar commercial impression.

Finally, applicant also relies upon *NEC Electronics, Inc., v. New England Circuit Sales, Inc.*, 722 F. Supp. 861 (D. Mass. 1989) to support its claims that the goods at issue are unrelated. However, the facts in that case involved infringement of the rights of an owner of a federally registered mark based upon use in the marketplace of wording similar to the registered mark in conjunction with prominently displayed wording that identified the name of an entity. That case did not involve an applicant seeking registration of a mark identical in part to a federally registered mark, and as a result, is not germane to the issues presented in this case.

6. Applicant's Stated Distinctions Between the Goods and the Parties' Sales and Marketing

Practices Does not Establish Distinct Trade Channels

Applicant's reliance on evidence extrinsic to the identifications of goods and/or services to support its own explanation of the exact nature of its software goods and the purposes for and users of the registrant's goods, has no bearing on the relatedness of the goods and services at issue. When analyzing an applicant's and registrant's goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Here, applicant's perceived distinctions relating to the nature of its goods and the registrant's marketing and sale activities cannot overcome the actual evidence of record which, as noted above, establishes that the relevant identified goods and services are commonly provided by a single source via a singular website. The evidence further shows that consumers are accustomed to encountering the relevant goods and/or services in the marketplace by accessing a singular entity via its website or direct telephone contact and thus travel in the same trade channels. The evidence supports that members of the relevant industry have determined that the same consumer who seeks to store its data via computer software and computer storage devices, will also seek to protect its data via computer security software and computer security consultation services. Thus, contrary to applicant's claims regarding the distinctions between the nature, trade channels, and marketing activities for the goods and services, the trade and marketing channels of the goods and services are indeed the same.

Furthermore, applicant's conclusion that an automatic finding of relatedness should not occur simply because the parties both identify software in their respective identifications of goods and/or services mischaracterizes the reasons why the goods and services at issue are related and ignores the relatedness of all of its goods and the registrant's services. The relevant goods and services are considered legally related because the parties' offer computer software, computer devices and/or computer

consulting services that are frequently provided by the same entity, marketed under the same mark, sold or provided through the same trade channels, used in the same fields of use, and complementary in terms of purpose or function.

Accordingly, when the marks are considered in light of all the factors discussed above, confusion as to the source is likely.

IV. CONCLUSION

The dominant portion of applicant's mark, i.e., "E8 STORAGE", and registrant's mark, i.e., "E8 SECURITY", are identical. The difference between the marks, i.e., the additional terms "STORAGE" in the applied-for mark and "SECURITY" in the registered mark, is insufficient to distinguish these marks because they are identical in their most prominent feature and remain confusingly similar in terms of overall commercial impression. The goods and services at issue are also closely related and this fact, in addition to the evidence made of record by the examining attorney, demonstrates that the goods and services travel in the same channels of trade. Applicant's failure to address the issues of the relatedness of its goods and the registrant's services constitutes a concession on applicant's part that its goods and the registrant's services are indeed related. It is again noted that, even if there were some doubt about likelihood of confusion in this case, 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). Therefore, the refusal to register "E8 STORAGE", in standard characters, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), should be affirmed.

Respectfully submitted,

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