

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
January 10, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Information Builders, Inc.

v.

Bristol Technologies, Inc.

Opposition No. 91179897
against Serial No. 78954755

Howard F. Mandelbaum of Levine & Mandelbaum for Information
Builders, Inc.

Roger L. Belfay for Bristol Technologies, Inc.

Before Bucher, Kuhlke and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Bristol Technologies, Inc. sought registration on the
Principal Register of the mark **Bristol Focus** (*in standard
character format*) for goods identified as "computer operating
programs; computers and instructional manuals sold as a
unit; operating system programs" in International Class 9.¹

¹ Application Serial No. 78954755 was filed on August 17, 2006
based upon claims of first use anywhere and first use in commerce
at least as early as July 25, 2006.

Registration has been opposed by Information Builders, Inc. As its grounds for opposition, opposer asserts that under the test of *In re Bose*² recently annunciated by the Federal Circuit, the evidence is clear and convincing that applicant committed fraud on the U. S. Patent and Trademark Office during the application process, and secondly, that given opposer's priority of use, there will be a likelihood of confusion under Section 2(d) of the Trademark Act when applicant's applied-for mark is used in connection with applicant's listed goods because applicant's mark so resembles the following family of **FOCUS** registered marks:

PC/FOCUS

for "diskettes containing a microprocessor program for use in preparation of reports and graphs from data stored in a personal computer" in International Class 9;³

FOCUS

for "computer programs for data base management" in Int. Class 9;⁴

FOCUS FORECASTING

for "consulting services in the field of inventory management and control for businesses including the use of computers and computer techniques in the field of inventory management and

² 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

³ Registration No. 1300245 issued on October 16, 1984; renewed. No claim is made to the exclusive right to use the term "PC" apart from the mark as shown.

⁴ Registration No. 1652265 issued on July 30, 1991; renewed.

	control for businesses" in International Class 35; ⁵
FOCUS FORECASTING	for "computer programs recorded on electronic media, namely tapes or discs, for use by businesses to plan inventory needs and to manage and control inventory" in Int. Class 9; ⁶
WEBFOCUS	for "computer programs for data base management" in Int. Class 9; ⁷
FOCUS	for "computer services, namely, providing online information to facilitate demonstration, test use, and ordering of computer software" in International Class 35; ⁸
WEBFOCUS	for "computer software for database management; computer software for accessing databases by means of global computer networks to generate reports; software development tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer networks; and computer software for accessing and updating databases through global computer networks" in International Class 9; ⁹

⁵ Registration No. 2223450 issued on February 16, 1999; renewed. No claim is made to the exclusive right to use the word "Forecasting" apart from the mark as shown.

⁶ Registration No. 2223457 issued on February 16, 1999; renewed. No claim is made to the exclusive right to use the word "Forecasting" apart from the mark as shown.

⁷ Registration No. 2248562 issued on June 1, 1999; renewed.

⁸ Registration No. 2606298 issued on August 13, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁹ Registration No. 2685249 issued on February 11, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

FOCUS

for "computer software for database management; computer software for use in decision support systems; computer software for use in enterprise reporting and analysis systems and for building applications for the management and tracking of data for enterprise reporting systems; computer database programs for use in connection with decision support, analysis, and reporting programs; computer software development tools for use in developing decision support, analysis, and reporting systems and applications; computer software, namely, client/server reporting, analysis and decision support tools; computerized database, reporting, and analysis software for use on corporate intranet web sites; enterprise server software for use in web based data publishing, reporting, and analysis solutions; computer software for accessing databases by means of global computer networks to generate reports; software development tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer networks; and computer software for accessing and updating databases through global computer networks" in Int. Cl. 9;¹⁰ &

FOCUS

for "business accountability software to insure compliance with governmental requirements and standards" in International Class 9.¹¹

¹⁰ Registration No. 2821942 issued on March 16, 2004; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹¹ Registration No. 2989088 issued on August 30, 2005; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

Although the original and the amended Notices of Opposition also asserted a claim of dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), this allegation has apparently been waived as it was not argued in opposer's final briefing.

Preliminary matter

Opposer argues that applicant's brief was filed in an untimely manner under Trademark Rule 2.128(a)(1). According to this rule, the "brief of the party in the position of defendant ... shall be due not later than thirty days after the due date of the first brief."

According to our order of October 21, 2009, the date set for the close of rebuttal testimony was March 15, 2010. Opposer's brief was filed on its due date of May 14, 2010, while applicant's brief was due June 14, 2010. However, applicant's brief was not served and filed until June 18, 2010. The record contains no indication that applicant requested leave to file its brief late.

We find that applicant's brief was not filed in a timely manner, and hence, we have not considered its contents. However, inasmuch as applicant has clearly "not lost interest in this matter," we proceed to final judgment on the merits. See TBMP § 801.02(a) (2d ed. rev. 2004).

The Record

In addition to the pleadings, the file of the opposed application is part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

Opposer introduced the following evidence:

- i. Transcript of direct and cross examination
Testimony of Gerald D. Cohen;
- ii. Exhibits 1-87 referred to in the Cohen testimony;
- iii. Plaintiff's Notice of Reliance under Rule
2.120(j) dated November 25, 2009;
- iv. Plaintiff's Notice of Reliance under Rule
2.122(d) dated November 25, 2009; and
- v. Plaintiff's Notice of Reliance under Rule
2.122(e) dated November 25, 2009."

Defendant introduced its Notice of Reliance under Rule 2.122(e) dated January 29, 2010, but took no testimony.

Opposer's standing

"Any person who believes that he would be damaged by the registration of a mark upon the principal register ... may, file an opposition ... stating the grounds therefor." Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a). Thus, a party has standing to oppose in a Board proceeding if it can demonstrate a real interest in the

proceeding. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), citing *Universal Oil Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972).

Opposer uses and has registered a variety of **FOCUS** designations - a term which appears within applicant's mark in connection with computer operating system programs. This is sufficient to demonstrate that opposer has a real interest in this proceeding, and therefore has standing.

Findings of Fact

Opposer

Gerald D. Cohen was one of the three founders of opposer, Information Builders, Inc. ("IBI"), he has been its President since the Company's inception in 1975, and is opposer's witness herein.¹² IBI is a software manufacturer created to exploit the software products of its founders. Since 1975, opposer has grown from a business of five employees occupying a thousand square feet of workspace to a plant of 125,000 sq. ft. where eight-hundred employees work.¹³ As the largest private software company in New York,

¹² Testimony of Gerald D. Cohen at 4.

¹³ *Id.* at 68-69.

IBI has enjoyed annual revenues of \$300 million, of which its various **FOCUS** software products account for one half of the annual sales, i.e., \$150 million.¹⁴

The record contains evidence of free press coverage of IBI and its **FOCUS** software over the years from articles in *Hoover's Profiles* [opposer's exhibit-2], *Software* magazine [opposer's exhibit-6], *Computer Reseller News* [opposer's exhibit-38], *Database Programming and Design* [opposer's exhibit-50], *Enterprising Computing* magazine [opposer's exhibit-51], *Mid-Range Systems* magazine [opposer's exhibit-52], *DEC Professional* [opposer's exhibit-53], *DBMS* [opposer's exhibit-54], *Cranes* [opposer's exhibit-55], *Main Frame Executive* [opposer's exhibit-56], *DM Review* [opposer's exhibit-39], and *Wikipedia.com* [opposer's exhibit-1]. On the occasion of opposer's 25th anniversary, then New York City Mayor Rudolf Giuliani issued a proclamation honoring IBI for its 25 years of software innovation.¹⁵

Opposer's first software product was called **FOCUS**. Later, opposer incorporated the word **FOCUS** into a variety of other software products.¹⁶ In fact, opposer has been

¹⁴ *Id.* at 7.

¹⁵ Testimony of Gerald D. Cohen at 57-59; opposer's exhibit-76.

¹⁶ *Id.* at 5.

delivering software to its customers under the **FOCUS** trademark continuously since 1975.¹⁷ **WebFOCUS** has been used as a trademark of IBI since 1996.¹⁸

In 1975, opposer's **FOCUS** software was designed to manage information and run programs on mainframe computers. Updated versions of this software continue to be sold and are available across many industries.¹⁹ With the arrival of personal computers, opposer developed products marked as **PC/FOCUS** and **PM/FOCUS**,²⁰ followed in 1996 by an Internet version called **WebFOCUS**.

Opposer's **FOCUS** software is not an operating system, but runs in collaboration with many different operating systems (e.g., Windows, UNIX and Linux).²¹ The complete listing of opposer's marks in this record points to a wide diversity of applications.

Opposer provides educational courses, runs hands-on workshops, sponsors local user groups and holds a national

¹⁷ *Id.* at 60-61; opposer's exhibits-77-79.

¹⁸ Opposer's exhibit-80.

¹⁹ Testimony of Gerald D. Cohen at 5, 8-9; opposer's exhibit-3.

²⁰ Testimony of Gerald D. Cohen at 13-14; opposer's exhibit-7.

²¹ Testimony of Gerald D. Cohen at 71-72.

conference annually in order to promote its **FOCUS** software products on various operating systems.²²

Opposer has published various guides, instruction manuals, periodic newsletters, fact sheets and technical journals directed to its **FOCUS** software, including the Focus Manual, General Information Guides, Fact Sheets, Focus News, and Focus Systems Journal.²³ Since its inception, opposer has vigorously promoted its **FOCUS** products. Initially, it was print advertisements in magazines, later followed by email promotions and online ads. Opposer's annual marketing budget for advertising is \$5-8 million, of which 75% is spent promoting **FOCUS** products.²⁴

IBI has also published customer profiles describing how some of its customers used **FOCUS** software to solve particular business problems. Each profile is reviewed and approved by the involved customer before being published. Examples of the many different business problems solved through the use of **FOCUS** software include monitoring the

²² Testimony of Gerald D. Cohen at 36-43, 54-56; opposer's exhibits 40-42, 45-48.

²³ Opposer's exhibits 3-5, 9, 43-44.

²⁴ Testimony of Gerald D. Cohen at 44-45, 61-62, 71-72; opposer's exhibits 49, 71.

bidding process during an auction of tulips [opposer's exhibit-17]; financial reporting [opposer's exhibit-18]; U.S. Postal Service operations [opposer's exhibit-19]; health care monitoring [opposer's exhibit-26]; construction of an executive information system [opposer's exhibit-27]; containment of thunderstorm damage by an electric utility company [opposer's exhibit-58]; tracking of criminal justice probation programs [opposer's exhibit-59]; truck manufacturing [opposer's exhibit-60]; automobile parts supply maintenance [opposer's exhibit-61]; medical fraud protection [opposer's exhibit-62]; agricultural and construction equipment quality and reliability [opposer's exhibit-63]; water system and pool/spa production and inventory management [opposer's exhibit-64]; custom marketing research information access [opposer's exhibit-65]; graphical sales information systems [opposer's exhibit-66]; manufacture of computer workstations and servers [opposer's exhibit-67]; sales of salt [opposer's exhibit-68]; court case tracking [opposer's exhibit-69]; and insurance brokerage [opposer's exhibit-70].

In addition to paid advertising in print and on the websites of others, opposer advertises its **FOCUS** software on its own website.²⁵

Applicant

Applicant's intentions are to market a combination of computer hardware with its operating system software known as **Bristol Focus**. Its trademark application covering this software is at issue herein.

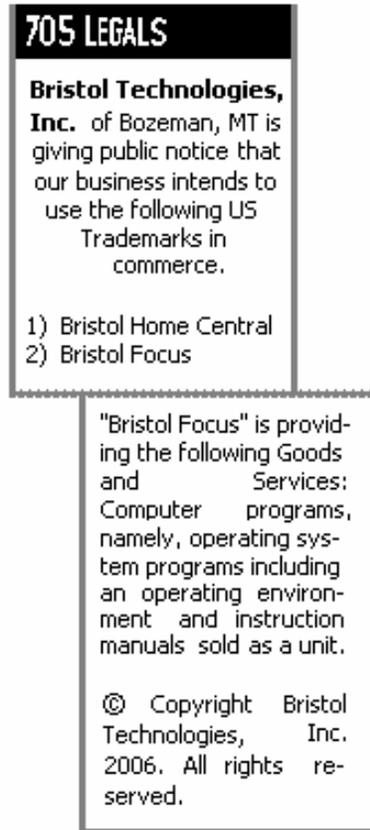
ANALYSIS

Fraud

The first ground for opposition is fraud on the U.S. Patent and Trademark Office during the *ex parte* prosecution of the involved application. The basic timeline underlying this dispute seems fairly straightforward:

²⁵ Testimony of Gerald D. Cohen at 53-54; opposer's exhibit-71-72.

- July 25, 2006: The first public usage of the term **Bristol Focus** appeared in the *Bozeman Daily Chronicle* newspaper. To the right is an excerpt from the advertisement associating this term with Bristol Technologies, Inc. and its intended product line.²⁶ Between July 20 and August 17, applicant's only activity claimed in the record in connection with the use of this term was applicant's correspondence with its attorney.²⁷

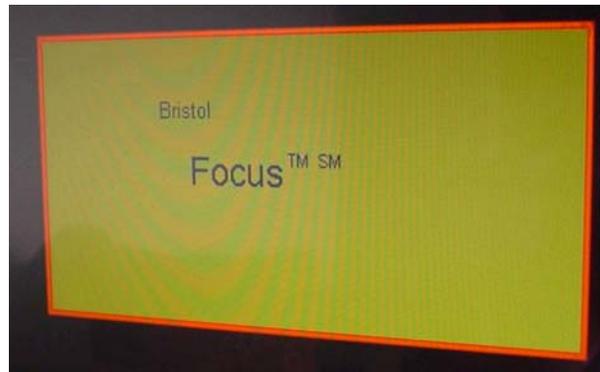


- August 17, 2006: Trademark Application Serial No. 78954755 was filed for registration of the trademark **Bristol Focus** for "computer operating programs; computers and instructional manuals sold as a unit; and operating system programs." The application was executed by David W. Bristol, President of Bristol Technologies, Inc. This application was based on use of the mark in commerce under Section 1(a) of the Trademark Act. The specimen of use was the newspaper ad of July 25, 2006.

²⁶ P. Not. of Rel. I, Interrogatory Answer No. 30.

²⁷ P. Not. of Rel. I, Interrogatory Answer No. 31.

- January 12, 2007: The assigned Trademark Examining Attorney objected to the specimen as unacceptable to show trademark use, and offered the option of an amendment of the application to intent to use under Section 1(b) of the Trademark Act in the event that applicant had not made use of the mark in commerce.
- February 22, 2007: Applicant created an image of the words **Bristol Focus** followed by the designations "TM" and "SM."
- March 26, 2007: Applicant's president, David W. Bristol, photographed this screenprint for use as a specimen of use in commerce.²⁸
- July 15, 2007: The March photograph of the screenprint was filed with the U.S. Patent and Trademark Office as a substitute specimen with a declaration asserting that "[t]he substitute specimen(s) was in use in commerce as of the filing date [August 17, 2006] of the application."
- October 5, 2007: Opposer filed this opposition.
- November 18, 2007: This was the service date of applicant's answers to opposer's first set of interrogatories. Applicant was still in the process of developing proprietary hardware which would use



²⁸ P. Not. of Rel. I, Interrogatory Answer No. 32.

the operating system known as **Bristol Focus**.²⁹ This incomplete combination of computer hardware and software made up applicant's entire product line.³⁰ Applicant had not yet completed the sale of any of its products,³¹ had no distributors, representatives, or salespersons for its products,³² and no license had issued and no use of the products had yet occurred.³³

- March 24, 2008: This was the service date of applicant's answers to opposer's second set of interrogatories. As of this date, the **Bristol Focus** computer operating system program had not yet been completed,³⁴ no orders had been received in response to the earlier advertisement in the *Bozeman Daily Chronicle*,³⁵ and no computer systems bearing the trademark **Bristol Focus** had been shipped by applicant.³⁶

In response to this showing by opposer, applicant argues as follows:

²⁹ P. Not. of Rel. I, Interrogatory Answer No. 1.

³⁰ P. Not. of Rel. I, Interrogatory Answer No. 2.

³¹ P. Not. of Rel. I, Interrogatory Answer No. 7.

³² P. Not. of Rel. I, Interrogatory Answer No. 14.

³³ P. Not. of Rel. I, Interrogatory Answer No. 26.

³⁴ P. Not. of Rel. I, Interrogatory Answer No. 29.

³⁵ P. Not. of Rel. I, Interrogatory Answer No. 27.

³⁶ P. Not. of Rel. I, Interrogatory Answer No. 28.

(1) Applicant believed that running this classified advertisement would constitute use of the mark sufficient to obtain a trademark registration.

(2) The statement of intent-to-use the mark contained in applicant's newspaper advertisement certainly does not rule out the possibility that applicant may have made a *bona fide* use of the mark before the application was filed on August 17, 2006.

(3) Even if the screenprint from the PowerPoint file created on February 22, 2007 was photographed on March 26, 2007, the file contains a copyright notice of 2006, meaning the software could have been demonstrated to clients prior to the filing date.

(4) Clients were unwilling to substantiate meetings with applicant to support its position in this litigation.

(5) The Trademark Examining Attorney asked for a substitute specimen and applicant provided it, thereby satisfying the Office's requirements.

Opposer's conclusion on fraud is stated concisely in its brief:

Defendant may not have understood when the application was signed on or about August 17, 2006 that running of the classified ad did not constitute use of the mark sufficient to obtain a trademark registration. However, the detailed explanation given by the Examining Attorney in the January 12, 2007 office action followed by

Applicant's fabrication of a new specimen no more than six weeks after learning of the initial refusal constitute[s] clear and convincing evidence that Defendant sought to mislead the Patent and Trademark Office with the July 15, 2007 response which caused the Examining Attorney to pass the application to publication.

Plaintiff respectfully submits that the evidence of intent to deceive the Patent and Trademark Office as to use of the mark is clear and convincing and passes the *Bose* test. Accordingly Opposer requests that the opposition be sustained on the ground of Defendant's fraud.

We agree with applicant that we cannot find fraud based upon applicant's application and jurat as originally filed. Upon discovering that its use basis was questionable, applicant could easily have amended the application to one based upon intent to use under Section 1(b) and in the process, retained the original filing date. However, opposer is correct in arguing that with the filing of the substitute specimen, applicant stated incorrectly, under oath, that the mark as shown on this specimen had been used, sufficient to support registration, in connection with the goods in the application at least as early as the filing date of the application.

According to *In re Bose Corp.*, 91 USPQ2d at 1939, the Court of Appeals for the Federal Circuit made it clear that for a fraud claim to be successful, a plaintiff must prove by clear and convincing evidence that a defendant knowingly made a false statement with the intent to deceive the U. S.

Patent and Trademark Office. *Bose*, 91 USPQ2d at 1941. It also set out the relevant standard for proving fraud:

"Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48, [1 USPQ2d 1483] (Fed. Cir. 1986). ... Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Id. at 1939.

Opposer has demonstrated that the statements made in applicant's statements of use for its substitute specimen were indeed false. In fact, there is as of this late date still no evidence in the file that applicant has yet demonstrated a *bona fide* use of the mark in commerce. On the other hand, in spite of applicant's admissions as to its actual course of conduct, we are reluctant to hold that opposer has "proven 'to the hilt' by clear and convincing evidence" that applicant intended to deceive the U.S. Patent and Trademark Office. See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009).

It is clear to us that applicant's representation to the U.S. Patent and Trademark Office that its mark had been used in interstate commerce prior to the original filing

date as reflected in the substitute specimen was both "false" and "material." Without this misrepresentation, the application would not have published for opposition based on Section 1(a) of the Act.

However, the record does not establish that Bristol Technologies, Inc.'s president, David W. Bristol, at the time of filing the substitute specimen, knowingly made a false representation with respect to use of the mark as shown on these specimens with a willful intent to deceive the U. S. Patent and Trademark Office. Mr. Bristol believed that the statement was true at the time he signed the statement of use. "There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. ... Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim." *In re Bose Corp.*, 91 USPQ2d at 1942.

Viewing the evidence in light of the above legal principles, we find that opposer has not established that Bristol Technologies, Inc. acted fraudulently in order to have its mark published for opposition. Rather, based upon the evidence of record, we find that Mr. Bristol, as a

layperson, had an honest misunderstanding that the above activities represented a legitimate way to document his purported usage of the adopted term³⁷ and that applicant had legitimately used the mark **Bristol Focus** as shown on the substitute specimen. We would not characterize his actions as trying to fabricate a fraudulent specimen. Under the standard set out in *Bose* by our principal reviewing Court, opposer has not met its "heavy burden of proof" in showing fraud. Opposer's claim of fraud is therefore dismissed.

Priority

Opposer has established that it owns valid and subsisting registrations of its pleaded marks. Hence, Section 2(d) priority is not an issue in this case as to the marks therefor and goods and services covered thereby. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).³⁸

³⁷ See *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899 (TTAB 2006).

³⁸ We note in addition that applicant contests neither opposer's standing to bring this proceeding nor its priority of use.

Likelihood of Confusion

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The salient question to be determined is not whether the involved goods and/or services of the parties are likely to be confused, but rather whether there is a likelihood that the relevant purchasing public will be misled to believe that the goods and/or services offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435 (CCPA 1965); and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976).

The Goods

From the time of its initial answer, applicant has argued that the nature of the goods offered by applicant and the goods and services offered by opposer are sufficiently different from each other that no likelihood of confusion can arise. However, it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Opposer's **FOCUS** software programs do not compete with applicant's operating systems. But all users of opposer's **FOCUS** computer software must also use an operating system.

Furthermore, opposer's **FOCUS** software has been designed to run on almost every operating system, and is used with enterprise IT systems in substantially every field of commerce in the United States.

It should not be surprising that consumer confusion is likely when the respective goods are operating system software and unrelated general application software. *Eclipse Associates Limited v. Data General Corporation*, 894 F.2d 1114, 13 USPQ2d 1885 (9th Cir. 1990). We find these two types of computer software to be related closely enough such that those acquainted with applicant's software (e.g., database management software) would readily conclude that operating system software bearing a similar mark emanates from, or is sponsored by or affiliated with, the same source. This critical *du Pont* factor favors the position of opposer.

Trade Channels

Inasmuch as neither the identification of goods in the application nor the listing of goods and services in opposer's various registrations include any limitations with respect to trade channels, we assume that both parties' goods will move through the same trade channels, namely all trade channels normal for computer software in International

Class 9. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

There is not sufficient support in the record to conclude, as applicant argues, that operating system software is offered only in conjunction with the sale of computer hardware, while opposer's software will always be offered separately from hardware installations. Thus, we resolve this factor in opposer's favor.

Strength of opposer's marks

While we agree with applicant that we cannot determine from this record exactly where opposer ranks relative to the other large players in the various markets in which opposer competes, the information we do have about opposer's volume of sales, magnitude of advertising, and thirty-five years of use clearly supports the conclusion that its **FOCUS** mark is strong and quite well-known in this field. Accordingly, with our eye on the *du Pont* factor of the renown of opposer's mark, while we are reluctant to declare this mark "famous," the factor does tilt slightly in opposer's favor in light of how well-known it has become since 1975.

Opposer's **FOCUS** mark appears to be arbitrary in this field, and there is no indication in the record of third-parties using this term in connection with software. In fact, the record demonstrates how vigilant opposer has been

in hundreds of *inter partes* proceedings before this Board, litigating to protect its rights in its **FOCUS** marks for a wide range of goods and services extending even beyond computer software.

On the other hand, opposer refers frequently to its "family of **FOCUS** marks." The family of marks doctrine has applicability in those situations where the plaintiff has established a family of marks characterized by a single feature such that the defendant's subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that the defendant's mark is yet another member of plaintiff's family. *See Blansett Pharmacal Co. Inc. v. Carmick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); and *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307, 311-312 (TTAB 1978). However, it is well settled that mere adoption, use and registration of a number of marks having a common feature for similar or related goods or services does not in itself establish a family of marks. Rather, in order to establish a family of marks, it must be demonstrated that the marks asserted to comprise the family, or a number of them, have been used and advertised in promotional material

or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

While the record shows that opposer has registered marks such as **FOCUS**, **PC/FOCUS**, **PM/FOCUS**, **FOCUS FORECASTING**, and **WebFOCUS**, and opposer has submitted examples of its product literature, promotional flyers, website pages and advertising, these materials do not show use of all or even a significant number of the registered marks together. As a result, consumers who view these materials will not recognize that the single term "Focus" indicates a family. The record, therefore, fails to show that opposer has widely used and promoted together its registered marks in such a manner as to create public recognition coupled with an association of common origin predicated on the term **FOCUS**. Having failed to establish that they own a family of **FOCUS** marks, opposer must rely on its individual marks for its likelihood of confusion claim. Among opposer's claimed marks, the one closest to applicant's mark is the word mark, **FOCUS**, alone. Accordingly, we will concentrate the remainder of our

discussion on this mark, which opposer has clearly shown functions as its house mark.

The marks

Applicant's mark consists of two words - applicant's president's surname, followed by the word "Focus." In effect, applicant has taken opposer's house mark and added a surname as a prefix. Even without a showing by opposer of a family of **FOCUS** marks, a prospective computer software customer acquainted with opposer's **FOCUS** products, upon seeing applicant's mark used in connection with operating system software, may very well believe that it is a new product line from opposer. Certainly, with respect to the connotations and commercial impressions of the respective marks, while a surname is generally not considered to be inherently distinctive upon its introduction, the arbitrary term "Focus" was inherently distinctive in 1975, and has only grown stronger as opposer's source-indicator for software over the past thirty-five years. Hence, this critical *du Pont* factor also favors a finding of likelihood of confusion.

Conclusion

We conclude, based upon a preponderance of the evidence, and particularly in view of the similarities between the marks, the strength of opposer's various **FOCUS** marks, and the relatedness of the respective goods as identified in the identifications of goods and services, that there is a likelihood of confusion when **Bristol Focus** and **FOCUS** are used contemporaneously on the parties' software.

Decision: The opposition is sustained based upon the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.