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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190326
Party	Defendant SecurLinx Holding Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TeleTracking Technologies, Inc.,

Opposer,

Opposition No. 91190326

v.

SecurLinx Holding Corporation,

Applicant.

**MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS**

Pursuant to Rule 12(c) of the Federal Rules of Civil Procedure and TBMP § 504, Applicant SecurLinx Holding Corporation (“Applicant”) hereby moves the Board for entry of judgment in its favor dismissing the claims of likelihood of confusion and false suggestion of a connection set forth in the opposition filed by Opposer TeleTracking Technologies, Inc. (“Opposer”) based on the pleadings. The dissimilarity between Applicant’s mark and Opposer’s asserted marks and “family” feature is dispositive of Opposer’s allegation of likelihood of confusion between the marks, and Applicant is therefore entitled to judgment as a matter of law on that claim. Likewise, the dissimilarity between Applicant’s mark and Opposer’s name is dispositive of Opposer’s allegation of false suggestion of a connection, and Applicant is therefore entitled to judgment as a matter of law on that claim.

**BACKGROUND**

Applicant filed an application to register the mark IDTRAC for use on computer software for use in the extraction, analysis, and comparison of biometric information regarding individuals derived from documents, pictures, and databases. (Notice of Opp’n ¶ 6.) Opposer filed a Notice of Opposition to the application, citing its alleged ownership of three common-law trademarks:

(1) PREADMITTRACKING (allowed U.S. federal trademark application no. 78/742,212) for use on computer software providing patient information to hospitals, (2) TELETRACKING (U.S. federal trademark application no.77/242,817) for use in association with consulting services in the health care field and for use on computer software for use in the health care field to enhance operational efficiencies, and (3) TRANSPORTTRACKING for use in providing healthcare information to assist in workflow automation. (Notice of Opp'n ¶ 4.) Opposer further alleges use of a "TRACKING family of marks" for providing healthcare information to its customers. (Notice of Opp'n ¶¶ 3, 5.)

Opposer alleges that Applicant's use of IDTRAC is likely to result in confusion, mistake, or deception with Opposer's TRACKING family of trademarks, or in the belief that Applicant or its products/service are in some way legitimately connected with, licensed, or approved by Opposer. (Notice of Opp'n ¶ 7.) Opposer further alleges that Applicant did not have a bona fide intent to use IDTRAC in commerce in connection with all of the identified goods (Notice of Opp'n ¶ 8), Applicant is not the owner of IDTRAC (Notice of Opp'n ¶ 9), and the application was assigned in violation of 15 U.S.C. § 1060 (Notice of Opp'n ¶ 10). Applicant has filed an Answer.

#### **LEGAL STANDARD FOR JUDGMENT ON THE PLEADINGS**

"A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice."

*Ava Enterprises Inc. v. P.A.C. Trading Group Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008). All

well pleaded factual allegations of the non-moving party must be accepted as true,<sup>1</sup> but conclusions of law are not taken as admitted. *Id.* The Board may take judicial notice of dictionary definitions. *Id.* at 1661 n.4. “All reasonable inferences from the pleadings are drawn in favor of the nonmoving party.” *Id.* at 1660. “A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law.” *Id.* Motions for partial judgment on the pleadings are permitted. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009).

## LEGAL ARGUMENT

### THERE IS NO LIKELIHOOD OF CONFUSION

The marks at issue in this case are so dissimilar that Applicant is entitled to judgment as a matter of law with regard to Opposer’s allegation of likelihood of confusion.<sup>2</sup> “A determination of likelihood of confusion is a legal conclusion based on underlying facts.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1843-44 (Fed. Cir. 2000). The test for likelihood of confusion generally involves consideration of thirteen factors. *See In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). However, “[o]ne DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.” *Ava Enterprises*, 86 USPQ2d at 1660. That

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<sup>1</sup> For purposes of the present motion only, Applicant recognizes that the factual allegations of Opposer must be accepted as true. However, outside of the context of the present motion, Applicant maintains its denials of Opposer’s allegations as set forth in Applicant’s Answer.

<sup>2</sup> Applicant reserves the right to present additional arguments and evidence with respect to likelihood of confusion should Applicant’s present motion be denied.

factor considers the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567.

As to appearance, Applicant’s IDTRAC mark is highly dissimilar to Opposer’s PREAMMITTRACKING, TELETRACKING, and TRANSPORTTRACKING marks. Applicant’s short mark is composed of six letters, whereas Opposer’s lengthy marks have at least double that number of letters – 16, 12, and 17 letters respectively. Applicant’s mark begins with the letter “I,” whereas Opposer’s marks begin with the letters “P” or “T.” Applicant’s mark also begins with the short two-letter prefix “ID,” whereas Opposer’s marks begin with lengthy prefixes having at least double that number of letters – eight (“PREAMMIT”), four (“TELE”), and nine (“TRANSPORT”) letters respectively. These visual differences in the beginnings of the marks are especially significant in evaluating the similarity or dissimilarity of the marks. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009) (stating that “it is the first portion of a mark that is more likely to make an impression on potential purchasers”); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Furthermore, Applicant’s mark ends with the letter “C,” whereas Opposer’s marks all end with the suffix “ING.” Indeed, the only significant similarity in appearance between Applicant’s mark and Opposer’s marks is the use of the four letters “TRAC.” However, Applicant’s mark ends in those letters, whereas they are embedded in the middle of Opposer’s lengthy marks. In short, Applicant’s mark looks different than Opposer’s marks.

As to sound, Applicant’s IDTRAC mark is also highly dissimilar to Opposer’s PREAMMITTRACKING, TELETRACKING, and TRANSPORTTRACKING marks. Opposer’s marks all begin with consonants, for which part of the breathing channel is constricted during pronunciation to generate audible friction. In sharp contrast, Applicant’s mark begins

with a vowel, which requires no such constriction and therefore generates no such audible friction. This aural difference in the beginning of the marks, like the visual differences described above, is especially significant in evaluating the similarity or dissimilarity of the marks. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009) (stating that “it is the first portion of a mark that is more likely to make an impression on potential purchasers”); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Furthermore, Applicant’s mark has either three syllables (I-D-TRAC) or two syllables (ID-TRAC), depending on whether the “ID” portion of the mark is pronounced with a long “I” as individual letters (*i.e.*, eye dee) or with a short “I” (*i.e.*, id). On the other hand, Opposer’s marks all have more syllables – five, four, and four syllables respectively. In sum, Applicant’s mark sounds different than Opposer’s marks.

With respect to connotation and commercial impression, Applicant’s IDTRAC mark is also dissimilar to Opposer’s PREAMMITTRACKING, TELETRACKING, and TRANSPORTTRACKING marks. Applicant’s mark includes the prefix “ID,” for which one definition is “2: identification” when it functions as an abbreviation. *Merriam-Webster Online Dictionary* (2009) (at [www.merriam-webster.com](http://www.merriam-webster.com)). Opposer’s marks include the prefixes “PRE[-],” for which one definition is “1 a (1): earlier than : prior to : before”; “ADMIT,” for which one definition is “2:b: to accept into a hospital as an inpatient”; “TELE[-],” for which one definition is “1: distant: at a distance: over a distance”; and “TRANSPORT,” for which one definition is “1: to transfer or convey from one place to another.” *Id.* Thus, the meanings that may be associated with the prefixes of Opposer’s marks are entirely different than the meaning that may be associated with the prefix of Applicant’s mark.

There is also a difference in connotation and commercial impression with respect to an arguably “common” element between Applicant’s mark and Opposer’s marks – TRAC[K]. In omitting a “K,” Applicant’s mark conveys a shortened, simplified, streamlined, sleek, and/or modernized impression as compared to the lengthy, conventional, and/or traditional impression conveyed by Opposer’s marks. Opposer’s marks accentuate this difference with the additional inclusion of the suffix “ING” which is absent from Applicant’s mark.

The term TRACK itself also has a multitude of different definitions. *See id.* Combining the meanings of the prefixes mentioned above with any of the different definitions of TRACK invariably results in dissimilar connotations between Applicant’s mark and Opposer’s marks. In sum, Applicant’s mark creates a different overall commercial impression than Opposer’s marks.

There are countless cases in which marks having an arguably common element are nonetheless found to be dissimilar and to have no likelihood of confusion. *See, e.g., AL-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1330-31, 50 USPQ2d 1161, 1175-76 (Fed. Cir. 1999) (MAGNA.DOT mark and MAGNIVISION mark “do not present a similar sound, meaning, or commercial impression,” including having different numbers of words, syllables, and letters); *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 332-33, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) (FROOTEE ICE and design mark dissimilar to FROOT LOOPS mark); *Bulova Watch Co. v. Miller*, 463 F.2d 1376, 1377, 175 USPQ 38, 39 (CCPA 1972) (“UNITRON and ACCUTRON just do not look alike, sound alike or connote alike.”); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1729 (TTAB 2008) (ONE TRUE FIT mark dissimilar to ONE FAB FIT mark); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1725 (TTAB 2007) (GULPY mark dissimilar to GULP family of marks); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1906 (TTAB 2007) (MEMBER LEADING JEWELERS

GUILD and design mark dissimilar to LEADING JEWELERS OF THE WORLD mark); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1340-42 (TTAB 2006) (GENUINE RIDE SKIN CARE and design mark dissimilar to GENUINE SKIN mark). This case is analogous to those cases in that Applicant's mark and Opposer's marks are dissimilar and their use cannot cause consumer confusion.

Although the dissimilarity of the marks is dispositive with respect to the issue of likelihood of confusion in this case, Applicant acknowledges that the Notice of Opposition alleges certain facts regarding the goods and services of the parties. The similarity or dissimilarity and nature of the goods or services is another factor for consideration in analyzing likelihood of confusion. *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567. Here, Applicant's goods relate to software dealing with biometric information, whereas Opposer's goods and services relate to software and consulting and informational services dealing with patient and healthcare information.

To the extent Opposer may be alleging likelihood of consumer confusion with an asserted "TRACKING family of marks" rather than any particular individual marks, Opposer's allegations fail as a matter of law. "Simply using a series of similar marks does not of itself establish the existence of a family." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In order to establish a family of marks:

[I]t must be shown by competent evidence, first, that ... the marks containing the claimed "family" feature, or at least a substantial number of them, were used and promoted together ... in such a manner as to create public recognition coupled with an association of common origin predicated on the "family" feature; and second, that the "family" feature is distinctive (i.e., not descriptive or highly



suggestive or so commonly used in the trade that it cannot function as a distinguishing feature of any party's mark).

*Truescents*, 81 USPQ2d at 1338 (quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)). Opposer has not alleged that its individual marks were used and promoted together to create an association of common origin predicated on “TRACKING,” nor can Opposer possibly show that “TRACKING” is distinctive given that Opposer’s marks all deal with the tracking of patient and healthcare information. Furthermore, Applicant’s IDTRAC mark is so dissimilar to “TRACKING” that their use cannot cause consumer confusion. The dissimilarities include the numbers of letters, the beginnings, the endings, the overall visual appearances, the numbers of syllables (assuming IDTRAC has three syllables), the overall aural differences, differences in connotation and commercial impression, and other differences as touched upon above in relation to Opposer’s individual marks. Applicant is therefore entitled to judgment as a matter of law with regard to Opposer’s allegation of likelihood of confusion.

#### **THERE IS NO FALSE SUGGESTION OF A CONNECTION**

Opposer’s allegation that Applicant’s use of IDTRAC is likely to result in the belief that Applicant or its products/service are in some way legitimately connected with, licensed, or approved by Opposer<sup>3</sup> fails for the same reason that its allegation of a likelihood of confusion fails – Applicant’s IDTRAC mark is simply too dissimilar to Opposer’s TELETRACKING mark, and therefore is also dissimilar to Opposer’s name, TeleTracking Technologies, Inc.<sup>4</sup>

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<sup>3</sup> Applicant assumes that Opposer’s allegation in this regard refers to opposition to registration of Applicant’s mark under Section 2(a) of the Trademark Act.

<sup>4</sup> Applicant reserves the right to present additional arguments and evidence with respect to false suggestion of a connection should Applicant’s present motion be denied.

Section 2(a) of the Trademark Act prohibits registration of “matter which may . . . falsely suggest a connection with . . . institutions.” This requires proof that, among other things, “applicant’s mark is the same or a close approximation of opposer’s previously used name or identity.” *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). Applicant’s IDTRAC mark is not the same or a close approximation of Opposer’s TELETRACKING mark for reasons discussed above with regard to the likelihood of confusion analysis, and therefore Applicant’s mark is also not the same or a close approximation of Opposer’s name or identity – TeleTracking Technologies, Inc. – for the same or similar reasons. *See id.* (“For the same reasons we found that the two marks are not similar for purposes of the likelihood of confusion analysis, we find here that applicant’s mark is not a close approximation of opposer’s identity.”). Applicant is therefore entitled to judgment as a matter of law with respect to Opposer’s claim of false suggestion of connection.

### **CONCLUSION**

The single DuPont factor of the dissimilarity of the marks is dispositive in this case with regard to Opposer’s allegation of likelihood of confusion. Applicant’s mark is so dissimilar to Opposer’s asserted marks and “family” feature that Applicant is entitled to judgment as a matter of law on this claim. No genuine issue of material fact exists as to likelihood of confusion because Applicant’s mark and Opposer’s asserted marks and “family” feature are completely distinct in appearance, sound, connotation, and commercial impression.

The dissimilarity of Applicant’s mark and Opposer’s name is dispositive with regard to Opposer’s allegation of false suggestion of a connection. Applicant’s mark is so dissimilar to Opposer’s name that Applicant is entitled to judgment as a matter of law on this claim. No genuine issue of material fact exists as to false suggestion of a connection because Applicant’s

mark and Opposer's name are completely distinct in appearance, sound, connotation, and commercial impression.

Because of the dissimilarity between Applicant's mark and Opposer's marks, "family" feature, and name, there is no genuine issue of material fact as to Opposer's claims of likelihood of confusion and false suggestion of a connection, and Applicant is therefore entitled to judgment as a matter of law dismissing those claims.

Dated: August 26, 2009

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on the 26th day of August, 2009, I served the foregoing “Motion for Partial Judgment on the Pleadings” upon the following counsel, by mailing a true and complete copy thereof via First Class Mail, postage prepaid, in an envelope addressed as follows:

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