

ESTTA Tracking number: **ESTTA776934**

Filing date: **10/15/2016**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Confluence Technologies, Inc.
Granted to Date of previous extension	10/15/2016
Address	600 River Avenue Pittsburgh, PA 15212 UNITED STATES

Attorney information	Jacob H. Rooksby Cohen & Grigsby, P.C. 625 Liberty Avenue Pittsburgh, PA 15222-3152 UNITED STATES iptrademark@cohenlaw.com, jrooksby@cohenlaw.com, khoover@cohenlaw.com Phone:4122974900
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**Applicant Information**

Application No	86891074	Publication date	08/16/2016
Opposition Filing Date	10/15/2016	Opposition Period Ends	10/15/2016
Applicant	Atlassian Pty Ltd Level 6 Sydney, NSW2000 AUSTRALIA		

**Goods/Services Affected by Opposition**


<p>Class 009. First Use: 2003/11/06 First Use In Commerce: 2003/11/06 All goods and services in the class are opposed, namely: Computer software for use on computers and mobile devices for content sharing and collaboration; Computer software for use on computers and mobile devices for business knowledge management and collaboration, task and project management, general work management, project tracking, document management, transmission and receipt of data and images, messaging and conversation based contextual sharing of information, organizing documents, data and information, providing a platform for collaboration, sharing of information, and interactive discussions to other users, and uploading and transferring files; Computer software for use on computers and mobile devices for facilitating the exchange of information via the Internet featuring collaboration tools; Computer software for use on computers and mobile devices for electronic communications, including chats, email and discussions; Downloadable electronic publications, namely, manuals, brochures, newsletters, technical data sheets and product specification brochures in the fields of knowledge management and team collaboration</p>
<p>Class 038. First Use: 2003/11/06 First Use In Commerce: 2003/11/06 All goods and services in the class are opposed, namely: Providing online forums for transmission of messages among computer users concerning business knowledge management and team collaboration; Providing access to databases; Providing user access to computer programs in data networks;</p>

provision of access to a global computer network; Communication services, namely, electronic transmission of data and documents among users of computers

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2612318	Application Date	06/01/2001
Registration Date	08/27/2002	Foreign Priority Date	NONE
Word Mark	CONFLUENCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2001/05/07 First Use In Commerce: 2001/05/07 COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS AND FINANCIAL PORTFOLIOS		

U.S. Registration No.	2562958	Application Date	03/08/2000
Registration Date	04/23/2002	Foreign Priority Date	NONE
Word Mark	CONFLUENCE		

Design Mark	<b>CONFLUENCE</b>
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1991/07/00 First Use In Commerce: 1991/07/00 COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS, AND FINANCIALPORTFOLIOS

Attachments	76265834#TMSN.png( bytes ) 75938015#TMSN.png( bytes ) Opposition _C-G Draft 10.13.16_ Confluence opposing Atlassian.pdf(44350 bytes ) Exhibit A - Confluence.pdf(169261 bytes ) Exhibit B - confluence.pdf(174130 bytes ) Confluence - Exhibit C.pdf(409643 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/jacob h. rooksby/
Name	Jacob H. Rooksby
Date	10/15/2016

ESTTA Tracking Number:

Filing Date:

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

Name:	Confluence Technologies, Inc.
Extension of Time Granted/Due:	September 14, 2016/[October 15, 2016]
Address:	600 River Avenue Pittsburgh, PA 15212 United States

Attorney Information:	Jacob Rooksby Cohen & Grigsby, P.C.
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#### Atlassian Information

Application Number:	86891074	Publication Date:	August 16, 2016
Opposition Filing Date:	September 14, 2016	Opposition Period Ends:	[     ]
Filing Date:	January 29, 2016		
Atlassian:	Atlassian Pty Ltd proprietary limited company (p/l or pty. ltd.) AUSTRALIA Level 6 341 George Street Sydney AUSTRALIA NSW2000		

#### Goods/Services Affected by Opposition


Class 009. First Use: Nov. 06, 2003 First Use In Commerce: Nov. 06, 2003 Computer software for use on computers and mobile devices for content sharing and collaboration; Computer software for use on computers and mobile devices for business knowledge management and collaboration, task and project management, general work management, project tracking, document management, transmission and receipt of data and images, messaging and conversation based contextual sharing of information, organizing documents, data and information, providing a platform for collaboration, sharing of information, and interactive discussions to other users, and uploading and transferring files; Computer software for use on computers and mobile devices for facilitating the exchange of information via the Internet featuring collaboration tools;
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Computer software for use on computers and mobile devices for electronic communications, including chats, email and discussions; Downloadable electronic publications, namely, manuals, brochures, newsletters, technical data sheets and product specification brochures in the fields of knowledge management and team collaboration
Class 038. First Use: Nov. 06, 2003 First Use In Commerce: Nov. 06, 2003 Providing online forums for transmission of messages among computer users concerning business knowledge management and team collaboration; Providing access to databases; Providing user access to computer programs in data networks; provision of access to a global computer network; Communication services, namely, electronic transmission of data and documents among users of computers

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks cited by Opposer as Basis for Opposition

U.S. Registration No.:	2612318	Application Date:	June 1, 2001
Registration Date:	August 27, 2002	Foreign Priority Date:	[N/A]
Word Mark:	CONFLUENCE		
First Use:	May 7, 2001		
In Commerce:	May 15, 2001		
Design Mark:			
Description of Mark:	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS 26.11.21 - Rectangles that are completely or partially shaded 26.17.10 - Lines, zig-zag; Zig-zag line(s)		
Goods/Services:	IC 042: COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS AND FINANCIAL PORTFOLIOS.		

U.S. Registration No.:	2562958	Application Date:	March 8, 2000
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Registration Date:	April 23, 2002	Foreign Priority Date:	[N/A]
Word Mark:	CONFLUENCE		
First Use:	July, 1991		
In Commerce:	July, 1991		
Description of Mark:	NONE		
Goods/Services:	IC 042: COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS, AND FINANCIAL PORTFOLIOS.		

Attachments:	[       ]
	Notice of Opposition

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

Signature:     [       ]

Name:         [       ]

Date:          [       ]

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

Confluence Technologies, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
Atlassian Pty Ltd proprietary limited company	)	
	)	
Atlassian.	)	
	)	
<hr style="width:30%; margin-left:0;"/>		
Serial No.: 86891074	)	
Filed: January 29, 2016	)	
Mark: CONFLUENCE	)	
Published: August 16, 2016	)	

**NOTICE OF OPPOSITION**

Confluence Technologies, Inc., a Pennsylvania corporation, located and doing business at 600 River Avenue, Pittsburgh, PA 15212, United States United States (“Confluence”), believes that it will be damaged by registration of the CONFLUENCE trademark Application No. 86891074 for goods and services in International Classes 9 and 38, and hereby opposes the same on the following grounds:

**COUNT I - TRADEMARK LIKELIHOOD OF CONFUSION**

1. Confluence designs and provides computer and mobile software products and services for the analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products and financial portfolios, along with other software programs and software solutions.

2. In Application Serial No. 86891074, filed on January 29, 2016, Atlassian Pty Ltd (“Atlassian”), sought to obtain registration on the Principal Register for the mark

CONFLUENCE for use in connection with (i) “computer software for use on computers and mobile devices for content sharing and collaboration; Computer software for use on computers and mobile devices for business knowledge management and collaboration, task and project management, general work management, project tracking, document management, transmission and receipt of data and images, messaging and conversation based contextual sharing of information, organizing documents, data and information, providing a platform for collaboration, sharing of information, and interactive discussions to other users, and uploading and transferring files; Computer software for use on computers and mobile devices for facilitating the exchange of information via the Internet featuring collaboration tools; Computer software for use on computers and mobile devices for electronic communications, including chats, email and discussions; Downloadable electronic publications, namely, manuals, brochures, newsletters, technical data sheets and product specification brochures in the fields of knowledge management and team collaboration” in Class 009 and (ii) “providing online forums for transmission of messages among computer users concerning business knowledge management and team collaboration; Providing access to databases; Providing user access to computer programs in data networks; provision of access to a global computer network; Communication services, namely, electronic transmission of data and documents among users of computers” in Class 038 (collectively, the “Similar Goods and Services”).

3. Commencing prior to Atlassian’s filing date, Confluence has been engaged in and continues to be engaged in the manufacture, distribution, sale, advertising and promotion of software products and services for financial and business management tools, along with other software products and related services, under the word mark CONFLUENCE and the design mark CONFLUENCE in the United States.

4. Confluence began using the word mark CONFLUENCE at least as early as July, 1991 and the design mark CONFLUENCE at least as early as May 15, 2001 in connection with consultation relating to software products for the analysis, design, development, support, and maintenance of computer software for managing financial products and related services in the United States.



5. Based on its longstanding and continuous use of the CONFLUENCE design and word marks, Confluence filed (i) on June 1, 2001, Application Serial No. 2612318 to register the CONFLUENCE design and word mark (the “Confluence Design Mark”) and, (ii) on April 23, 2002, Application Serial No. 2562958 to register the CONFLUENCE word mark (the “Confluence's Word Mark” and together with the Confluence Design Mark, the “Confluence Marks”), each with the United States Patent & Trademark Office (“USPTO”) and each for use in connection with “Computer software consulting services regarding the analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products, and financial portfolios,” in International Class 42. A current printout of information from the USPTO electronic database records showing the current status and title information for the Confluence Word Mark from the USPTO website is attached as Exhibit A. A current printout of information from the USPTO electronic database records showing the current status and title information for the Confluence Design Mark from the USPTO website is attached as Exhibit B.

6. Long prior to Atlassian’s adoption and use of the CONFLUENCE mark on computer software and online forums, Confluence was actively engaged in interstate commerce in the business of creating, manufacturing, selling, distributing and advertising of computer software products and related consulting services for business and financial operations and for internet and online marketing bearing the Confluence Marks.

7. During the examination of a previous application made to the USPTO by Atlassian on August 12, 2008 in Serial No. 79061333, the USPTO Examining Attorney cited the Confluence Marks in its Office Action of December 9, 2008 (the “2008 OA”), as potential Section 2(d) bars to the registration of another similarly designed mark, "CONFLUENCE," in International Classes 009, 038, and 042. Notably, the mark in the past application and the mark in the present application filed by Atlassian are identical. The Examining Attorney in the 2008 OA explicitly asserted that the Confluence Marks were identical in appearance to the applied-for-mark and thus likely to cause optical

confusion. The Examining Attorney in the 2008 OA stated that "[r]egistration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2598342, 2562958, 2612318 and 2519420. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq." The Examining Attorney in the 2008 OA further asserted that the goods and services of Atlassian and Confluence were "highly related" in that both provide computer software and computer software related services." See Exhibit C.

8. Confluence has expended a significant amount in developing and in advertising and promoting the Confluence Marks and products and services, and has distributed a significant amount of products and services bearing the Confluence Marks in the United States. As a result of such efforts and expenditures, as well as the high quality of its goods and services, the Confluence Marks have come to represent extremely valuable goodwill to Confluence.

9. On information and belief, and based upon the allegation in paragraph 7, above, Atlassian's adoption of the CONFLUENCE trademark in connection with computer software and services was and has continued with full knowledge of Atlassian's use of the Confluence Marks, at the time that Atlassian filed Application No. 86891074 for registration of the CONFLUENCE mark for such software products and services. Indeed, Atlassian was able to overcome the 2008 OA and achieve registration of the CONFLUENCE mark in Serial No. 79061333 only after requesting that its goods and services description in Classes 009 and 038 of that application be amended to include the following language, which is contained in the goods and services descriptions of the Confluence Marks that were cited as Section 2(d) obstacles in Atlassian's initial application: in Class 9 "none of these goods being computer software ... for managing mutual funds, financial benefit plans, pooled investment products or financial portfolios" and in Class 38 "not being services relating to the provision of access to computer databases or rental or access time to global computer networks ... for managing mutual funds, financial benefit plans, pooled investment products or financial portfolios." See Exhibit D.

10. On information and belief, the earliest date of actual or constructive use of the CONFLUENCE mark for the goods and services specified in the subject application upon which Atlassian can rely is November 6, 2003, as asserted in the subject application.

11. Confluence's priority in the identical Confluence Marks is earlier than any priority that Atlassian can establish in its CONFLUENCE mark as set forth in Paragraph 5, above.

12. Atlassian's alleged adoption and use of the applied-for CONFLUENCE mark for the applied-for computer application software and related services has been without the consent or permission of Confluence.

13. The specified goods and services in connection with which Atlassian seeks registration of the CONFLUENCE mark in Application Serial No. 86891074 are similar and/or closely related to the goods and services that Confluence offers in connection with the Confluence Marks.

14. The goods and services for which Atlassian seeks registration of the CONFLUENCE mark in Application Serial No. 86891074 are likely to be marketed to the same or related customers and through the same or related channels of trade in which Confluence provides its goods and services in connection with the Confluence Marks.

15. In consideration of the above, the CONFLUENCE mark is confusingly similar to the Confluence Marks.

16. Based on the foregoing, Atlassian's intended adoption, use, distribution, offer for sale, and sale of computer application software and related services bearing the CONFLUENCE mark are likely to cause confusion, mistake or deception as to the origin of the goods and services among the relevant consuming public such that the public is likely to believe that Atlassian's products and services originate with Confluence, are

licensed by Confluence, or are sponsored, authorized, endorsed, or are otherwise related to Confluence.

17. For the aforementioned reasons, Altassian's Application No. 86891074 should be refused registration.

PRAYER FOR RELIEF

WHEREFORE, Confluence prays that this Opposition be sustained, that Application No. 86891074 be rejected, and that registration of the CONFLUENCE mark for the goods specified therein be refused.

Date: October 14, 2016

Respectfully submitted,

By: \_\_\_\_\_

Jacob H. Rooksby  
Maria E. C. Indovina  
Cohen & Grigsby, P.C.  
625 Liberty Ave.  
Pittsburgh, Pa 15222

*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

JOHN M. KIM  
IPLA, LLP  
4445 EASTGATE MALL  
SUITE 200  
SAN DIEGO, CA 92121

on this 14th day of October, 2016.

COHEN & GRIGSBY, P.C.

By: \_\_\_\_\_  
Jacob H. Rooksby  
Maria E. C. Indovina  
Cohen & Grigsby, P.C.  
625 Liberty Ave.  
Pittsburgh, Pa 15222  
Telephone: 412-297-4839  
Fax: 412-209-0672

*Attorneys for Opposer*

# Exhibit A

# Exhibit B

# Exhibit C



# Exhibit D

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# CONFLUENCE

<b>Word Mark</b>	CONFLUENCE
<b>Goods and Services</b>	IC 042. US 100 101. G & S: COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS, AND FINANCIAL PORTFOLIOS. FIRST USE: 19910700. FIRST USE IN COMMERCE: 19910700
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75938015
<b>Filing Date</b>	March 8, 2000
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	August 28, 2001
<b>Registration Number</b>	<b>2562958</b>
<b>Registration Date</b>	April 23, 2002
<b>Owner</b>	(REGISTRANT) Confluence Technologies, Inc. CORPORATION PENNSYLVANIA 600 River Avenue Pittsburgh PENNSYLVANIA 152125935
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Noland J. Cheung

**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20111217.  
**Renewal** 1ST RENEWAL 20111217  
**Live/Dead Indicator** LIVE

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**C O N F L U E N C E**

<b>Word Mark</b>	CONFLUENCE
<b>Goods and Services</b>	IC 042. US 100 101. G & S: COMPUTER SOFTWARE CONSULTING SERVICES REGARDING THE ANALYSIS, DESIGN, DEVELOPMENT, TECHNICAL SUPPORT, AND MAINTENANCE OF COMPUTER SOFTWARE FOR USE IN MANAGING MUTUAL FUNDS, FINANCIAL BENEFIT PLANS, POOLED INVESTMENT PRODUCTS AND FINANCIAL PORTFOLIOS. FIRST USE: 20010507. FIRST USE IN COMMERCE: 20010507
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	26.11.21 - Rectangles that are completely or partially shaded 26.17.10 - Lines, zig-zag; Zig-zag line(s)
<b>Serial Number</b>	76265834
<b>Filing Date</b>	June 1, 2001
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	June 4, 2002
<b>Registration Number</b>	<b>2612318</b>
<b>Registration Date</b>	August 27, 2002
<b>Owner</b>	(REGISTRANT) Confluence Technologies, Inc. CORPORATION PENNSYLVANIA 600 River Avenue Pittsburgh PENNSYLVANIA 152125935
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED

**Attorney of Record** Noland J. Cheung  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20111217.  
**Renewal** 1ST RENEWAL 20111217  
**Live/Dead Indicator** LIVE

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/061333

**MARK:** CONFLUENCE

**\*79061333\***

**CORRESPONDENT ADDRESS:**

Sparke Helmore, Law; Attn: Annick  
Vincen  
PO Box Q1164  
QVB Post Office  
SYDNEY NSW 1230  
AUSTRALIA

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** ATLISSIAN PTY  
LTD

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:**

**INTERNATIONAL REGISTRATION NO. 0983128.**

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c).

**WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:**

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and
- (2) **Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).

37 C.F.R. §§10.1(c), 10.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. A response signed by an unauthorized foreign attorney is considered an incomplete response. *See* TMEP §§602.03, 712.03.

**THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

**SECTION 2(d) – LIKELIHOOD OF CONFUSION REFUSAL**

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2598342, 2562958, 2612318 and 2519420. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* *See the enclosed registrations.*

The applicant's mark is "CONFLUENCE" in stylized form for "computer software distributed online or recorded and downloadable, computer programs and recorded software distributed online or recorded and downloadable; pre-recorded, electronic publications, including those sold and distributed online; electronic newsletters; instructional materials in electronic form supplied on line, accessories, parts and fittings for all of the aforesaid goods in this class," "provision of access to computer databases; rental of access time to a computer database" and "consulting services in the field of design and development of computer software; services of an application service provider, namely, hosting software; computer software design; installation, modification and maintenance of computer software; computer system design and analysis; data hosting services; data conversion of computer programs and data; consultancy services in the field of computers and software; providing information and consultancy services in respect of the above services, including by electronic means via a global computer network."

The registrants' marks are:

**CONFLUENCE** in typed form for "computer software that models the operation of a water supply system under certain weather, streamflow, and demand conditions which is used to evaluate alternative future municipal water supply strategies."

**CONFLUENCE** in typed form for "computer software consulting services regarding the analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products, and financial portfolios."

**CONFLUENCE** with design for "computer software consulting services regarding the analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products, and financial portfolios."



**CONFLUENCE TECHNOLOGIES** in typed form for “computer software consulting services regarding the analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products, and financial portfolios.”

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int’l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

### Similarity of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In this case, applicant’s mark, **CONFLUENCE**, is confusingly similar to the registered marks, **CONFLUENCE**, **CONFLUENCE** with design **CONFLUENCE TECHNOLOGIES**. With respect to the applicant’s mark and the registered marks **CONFLUENCE**, the marks are all identical in sound, appearance, meaning and overall commercial impression. Moreover, there are no other literal or design elements by which purchasers can distinguish between applicant’s mark and the registered mark. When purchasers call for the goods and services, they are likely to be confused as to the source of the goods and services by the similarities between the marks. .

Moreover, applicant’s mark, **CONFLUENCE**, and the registered marks all share the common dominant wording, **CONFLUENCE**. The Trademark Trial and Appeal Board (TTAB) has held that the first word, prefix, or syllable in a mark is typically the dominant portion because consumers are generally more inclined to focus on this portion of 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); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Moreover, the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Optical Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01 (b)(ii)-(b)(iii). In the present case, applicant’s mark does not create a distinct commercial impression because it contains the same common wording as registrant’s mark. Additionally, purchasers encountering the marks are likely to believe that the applicant’s goods and services merely represent new products and services offered by the registrants and be confused as to the *source* of the goods and

services by the use of similar marks. Accordingly, a likelihood of confusion exists under Section 2 (d) of the Trademark Act.

### Relatedness of the Goods and Services

Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

In this instance, the applicant's goods and services are highly related and could encompass the goods and services provided by the registrant. In this case, both the applicant and the registrant are providing computer software and computer software consulting services. Here, the applicant has not placed any restrictions on the field of use or the channels of trade of the computer software and computer software consulting services. Thus, applicant's computer software could be used to “*models the operation of a water supply system under certain weather, streamflow, and demand conditions which is used to evaluate alternative future municipal water supply strategies*” and therefore be identical to the computer software provided by the registrant. Moreover, applicant's computer software consulting services could be used for the “*analysis, design, development, technical support, and maintenance of computer software for use in managing mutual funds, financial benefit plans, pooled investment products and financial portfolios,*” and be identical to the services provided by the registrant.

When the application describes the goods and services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the application encompasses all goods and services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant's argument that its goods are sold only in its own retail stores is not persuasive . . . . There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold.”); TMEP §1207.01(a) (iii).

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). In this case, purchasers encountering the applicant's mark, **CONFLUENCE** and the registrants' marks, **CONFLUENCE**, **CONFLUENCE** with design **CONFLUENCE TECHNOLOGIES** all for computer software and computer software consulting services are likely to believe that the goods and services originate from a common source due to the confusingly similar marks and the highly related nature of the goods and services.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and 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, 1025 (Fed. Cir. 1988). Therefore, with the contemporaneous use of confusingly similar marks, consumers are likely to reach the mistaken conclusion that the goods are related and originate from a common source. As such, registration is denied under Section 2(d) of the Trademark Act.

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If applicant chooses to respond to the refusal to register, then applicant must also respond to the following requirements.

### **AMENDMENT TO IDENTIFICATION OF GOODS / RECITATION OF SERVICES REQUIRED**

The applicant seeks registration for a variety of goods and services in multiple International Classes. A number of items in applicant's identification of goods and services are indefinite and require clarification. Applicant must clarify the identification of goods and services to specify the common commercial or generic name for the goods and/or services. If there is no common commercial or generic name, then applicant must describe the nature of the goods and services as well as their main purpose, channels of trade, and the intended consumer(s). TMEP §1402.01.

Additionally, the wording "*accessories, parts and fittings for all of the aforesaid goods in this class*" in the identification of goods is indefinite and must be (1) clarified to specify the common commercial or generic name for the goods, or (2) deleted. TMEP §§1402.01 and 1402.03(a). This wording constitutes an open-ended "catch-all" word or phrase and is not acceptable because it fails to identify specific goods.

In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant uses indefinite words such as "**accessories**," "components," "devices," "equipment," "materials," "**parts**," "systems" or "products," such words must be followed by "namely," followed by a list of the specific goods identified by their common commercial or generic names. *See* TMEP §§1402.01, 1402.03(a).

In the identification, applicant must use the common commercial or generic name for the goods, be specific and all-inclusive, and avoid using indefinite words or phrases. *Id.*

Applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application or within the scope of a previously accepted amendment to the identification. 37 C.F.R. §2.71(a); TMEP §§1402.01 and 1402.03(a).

Recommended changes have been highlighted in **bold** and suggestions for amending applicant's identification of goods and services are in brackets.

**PLEASE NOTE:** If applicant adopts the recommended identification of goods and services, applicant must remove any brackets from the identification of goods and services and incorporate the bracketed information into the amended description. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

Applicant may adopt the following identification of goods and services, if accurate:

**International Class 009:** Downloadable computer software for \_\_\_\_\_ [applicant to specify the function of the software, e.g., communicating with users of hand-held computers, processing digital music files, organizing and viewing digital images and photographs, etc.] distributed online; computer software for \_\_\_\_\_ [applicant to specify the function of the software, e.g., for application and database integration, for wireless content delivery, for manipulating digital audio information for use in audio media applications, etc.]; computer programs and recorded software for \_\_\_\_\_ [applicant to specify the intended use of the computer programs and recorded software, e.g., for editing images, sound and video, for pre-recorded games, for using the internet and the worldwide web, etc.] and distributed online; pre-recorded, electronic publications in the nature of \_\_\_\_\_ [applicant to specify the form of the electronic publications, e.g., books, magazines, manuals, etc.], including those sold and distributed online; electronic publications, namely newsletters in the field of \_\_\_\_\_ [applicant to indicate the subject matter, e.g., medicine, science, entertainment, music, etc.] recorded on computer media; instructional materials in electronic form in the nature of \_\_\_\_\_ [applicant to specify the form of the electronic instructional materials, e.g., books, journals, manuals, etc.] in the field of \_\_\_\_\_ [applicant to indicate the subject matter, e.g., medicine, science, entertainment, music, etc.] supplied on line.

**International Class 038:** Provision of access to computer databases; rental of access time to a global computer networks.

**International Class 042:** Consulting services in the field of design and development of computer software; service of an application service provider, namely, hosting software applications of others; computer software design; installation, modification and maintenance of computer software; computer software system design and analysis; data hosting services, namely, \_\_\_\_\_ [applicant to specify the generic or common commercial name for the data hosting services e.g., acting as an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data, interactive hosting services which allow the user to publish and share their own content and images on-line, etc.]; data conversion of computer programs and data, not physical conversion; consultancy services in the field of computers and software; providing information and consultancy services in the fields of design and development of computer software, computer software system design and

**analysis and data hosting services**, including by electronic means via a global computer network.

TMEP §1402.01.

Identifications of goods and/or services can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

**ADVISORY – 66(a) APPLICATIONS – CLASSIFICATION FOR GOODS/SERVICES CANNOT BE CHANGED**

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau in the corresponding international registration. TMEP §§1401.03(d), 1904.02 (b).

**RESPONSE GUIDELINES**

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/teas/index.html>.

Applicant may wish to hire a trademark attorney to assist in prosecuting this application because of the legal technicalities involved. The Office, however, cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

Please be advised that **the only attorneys who can practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and
- (2) **Canadian agents/attorneys** who represent applicants residing in Canada and who have received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).

37 C.F.R. §§10.1(c), 10.14; TMEP §602.

Foreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys. TMEP §602.06(b). Filing written communications, authorizing an amendment

to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. A response signed by an unauthorized foreign attorney is considered an incomplete response. *See* TMEP §§602.03, 712.03.

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**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.