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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ChanneLinx.com, Inc.

Serial No. 75/779,288

John E. Vick, Jr., of Dority & Manning, P.A. for
ChanneLinx.com, Inc.

John D. Dalier, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Simms, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 19, 1999, ChanneLinx.com, Inc. (applicant)
filed an application to register the mark CHANNELINX.COM
(in typed form) on the Principal Register for services
ultimately identified as follows:

Computerized online services for enabling electronic
commerce in the fields of building materials and
supplies, petroleum-related chemicals, industrial
equipment and supplies, manufacturing equipment, and

construction equipment and supplies in International Class 35;¹

Network installation services for enabling electronic commerce in the field of building materials and supplies, petroleum-related chemicals, industrial equipment and supplies, manufacturing equipment, and construction equipment and supplies In International Class 37; and

Software maintenance services for enabling electronic commerce in the field of building materials and supplies, petroleum-related chemicals, industrial equipment and supplies, manufacturing equipment, and construction equipment and supplies in International Class 42.²

The Examining Attorney³ ultimately refused to register applicant's mark for three reasons. First, the Examining Attorney held that applicant's mark, when used on the identified services, so resembles the mark shown below for "computer hardware and software used in data transfer and data communications applications" in International Class 9 that there is a likelihood of confusion under Section 2(d) of the Trademark Act.⁴ 15 U.S.C. § 1052(d).

¹ Applicant proposed this identification for the services in International Class 35. The identification of services currently reads: "Advertising and sale of products by way of electronic commerce on the internet, including the sale and procurement of building materials and building supplies in electronic commerce." The Examining Attorney's requirement for applicant to amend its identification of services is one of the issues on appeal.

² Serial No. 75/779,288. The application contains an allegation of a date of first use and a date of first use in commerce of June 16, 1999.

³ The current Examining Attorney was not the original Examining Attorney in this application.

⁴ Registration No. 1,862,275 issued November 15, 1994. The registration issued to Computer Network Technology Corporation.

CHANNELink

The registration contains a disclaimer of the words "Channel Link," and the mark registered under the provisions of Section 2(f) of the Trademark Act.

Second, the Examining Attorney refused to register applicant's mark because of a registration of the mark CHANNELINK (in typed form), owned by a different party, for "educational services, namely, offering seminars and training others in the use and operation of computers and related equipment" in International Class 41.⁵

Third, because the Examining Attorney determined that the identification of services was indefinite for the International Class 35 services, he required applicant to amend those services.

On November 20, 2000, the Office received a combined Section 8 & 15 affidavit for this registration (certificate of mailing dated November 15, 2000). There is no indication in the file of any response to applicant's submission.

⁵ Registration No. 2,244,349 issued May 11, 1999. The registration issued to NEC Technologies, Inc. The registration also contains a second class of services that are not relevant to this appeal: "promoting the sale of the goods of others through the administration of incentive awards" in International Class 35.

After the Examining Attorney made the refusals final, this appeal followed. Both applicant and the Examining Attorney filed briefs.⁶ An oral hearing was requested and scheduled, but ultimately the oral hearing was cancelled at applicant's request. See Applicant's Letter dated January 7, 2002.

I. Requirement to amend the identification of services

We first address the Examining Attorney's requirement for an amendment to the Class 35 identification of services. The amended identification of services at the time of the Examining Attorney's final Office action read:

Advertising and sale of products by way of electronic commerce on the internet, including the sale and procurement of building materials and building supplies in electronic commerce.

The Examining Attorney objected to this identification of services on the ground, inter alia, that it was "indefinite because the applicant uses the wording 'including' and 'sale.'" Office Action dated June 2, 2000,

⁶ There was an unusual twist to this appeal inasmuch as applicant submitted an amendment to the identification of services and additional evidence in November 2000. Apparently, the submission was never associated with the file and applicant and the Examining Attorney filed their briefs and based their arguments on different identifications of services and different evidence in the record. When this became apparent, applicant requested a remand to the Examining Attorney to consider its missing submission, which was granted by the Board on May 25, 2001. The Examining Attorney accepted the submission but maintained the refusals to register under Section 2(d) and the requirement for a

p. 5. In the brief (p. 12), the Examining Attorney again objected to the identification of services on the ground that it contained the indefinite words "including" and "sale." Applicant subsequently filed a "Motion to Suspend Appeal and Remand for Further Examination Pursuant to 37 CFR § 2.142(d)" because it became apparent to applicant that its amendment and evidence had not been associated with the file and had not been considered by the Examining Attorney. That paper contained a further amendment to the identification of services in International Class 35:

Computerized online services for enabling electronic commerce in the fields of building materials and supplies, petroleum-related chemicals, industrial equipment and supplies, manufacturing equipment, and construction equipment and supplies.

After the Board remanded the case, the Examining Attorney addressed the requirement for an amended identification of services as follows:

Finally, the amended identification of services in International Class 35 is again rejected. The FINAL requirement that the applicant must amend its identification of services in International Class 35 is maintained and continued.

Office Action dated August 8, 2001, p. 2.

While we understand the Examining Attorney's requirement for applicant to amend the current

more definite identification of the services in International Class 35. See Office Action dated August 8, 2001.

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identification of services because it contains such terms as "including" and "sale," we note that applicant has attempted to overcome these objections by submitting an amended identification of services for International Class 35 that meets the Examining Attorney's objections. Inasmuch as the Examining Attorney has not articulated any reason for his objection to the proposed amended identification of services and we are unaware of any objection, we reverse the requirement for a further amendment to the proposed amended identification of services in International Class 35. We will refer to this most recent amendment to the identification of services when we refer to applicant's Class 35 services in this appeal.

II. Refusal based on Registration No. 1,862,275

We now address the first refusal under Section 2(d) of the Trademark Act. The Examining Attorney refused to register applicant's mark because he determined that it was confusingly similar to Registration No. 1,862,275.

Applicant has applied to register the mark CHANNELINX.COM in typed form while the cited mark is for the mark:

CHANNELink

Both the cited registrant's mark and applicant's mark are for the phonetically similar common term "Channelink." Applicant spells its mark with an "x" instead of a "k." Applicant adds the top-level domain (TLD) term ".com" to its mark. In addition, the registrant displays its mark in a block letter style. While the word portions of the marks are very similar, we must compare the marks in their entireties. Here, we note that the registration contains a disclaimer of the words "Channel Link" and that it issued under the provisions of Section 2(f) of the Trademark Act. Registrant does not claim any rights in the words "Channel Link" and instead relies on the design of "Channel" in capital letters telescoped with "ink" in small letters together with the block lettering design for acquired distinctiveness. The Federal Circuit has held that it "must be remembered that [registrant's] trademark consists of highly stylized letters and is therefore in the gray region between pure design marks which cannot be vocalized and words which are clearly intended to be." In re

Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

We also add that applicant's and registrant's marks are not identical. Some differences are barely noteworthy. Applicant adds a ".com" to its mark, and it spells the "link" portion of the mark differently than registrant. However, other differences are significant. Unlike registrant's mark, applicant's mark is not stylized. It is well settled that it is improper to dissect a mark. In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Another important feature is the disclaimer in the cited registration. Disclaimed matter is often given less weight than other elements of a mark. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). Because of the disclaimer and the registration of registrant's stylized design under Section 2(f), we do not find that that the term "channelink" is entitled to a broad scope of protection.

Next, we consider the services of applicant and registrant. Applicant's services involve computerized

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online services, network installation services and software maintenance services for enabling electronic commerce in the fields of materials and supplies, petroleum-related chemicals, industrial equipment and supplies, manufacturing equipment, and construction equipment and supplies.

Registrant's services are computer hardware and software used in data transfer and data communications applications.

We must consider the goods and services as they are described in the identification of goods and services in the applications and registration. "Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be." In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997)(punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987).

While we realize that both applicant's and registrant's goods and services involve computers, this fact does not establish that goods or services are necessarily related.

It is important to note that, in order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue herein beyond the fact that each involves the use of computers. In view of the fact that computers are useful and/or are used in almost every facet of the world of business, commerce, medicine, law, etc., it is obvious that distinctions must be made.

Reynolds and Reynolds Co. v. I.E. Systems Inc., 5 USPQ2d 1749, 1751 (TTAB 1987). The Board has clearly held that there is no pre se rule that all computer hardware and/or software are related. Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988).

The Examining Attorney has submitted copies of several registrations "showing entities offering and using the same mark on or in connection with computer hardware, computer installation and computer software." Examining Attorney's brief at 6. However, the specific question here is not whether computer hardware, computer installation and computer software are related but whether applicant's computer services involving building, chemical, and construction fields are related to registrant's hardware and software in the data transfer and data communications applications fields. We are not convinced that these fields are related.

[W]hile applicant and registrant are both in the computer field, applicant is seeking registration for

a specific, specialized piece of peripheral computer hardware, namely buffers. The cited registration, on the other hand, relates to a specific, specialized type of applications software, namely, computer programs in the field of energy conservation and management. While there exists the possibility that those users of registrant's specialized software could also conceivably have a need for applicant's buffers in order to store data, we do not believe that this possibility of overlap in the computer field is significant enough to warrant a finding of likelihood of confusion as to source especially where, as here, applicant has presented a declaration from its president (uncontroverted by any opposing evidence) as to the differences in marketing and otherwise, between applications software designed for a specific practical application and other types of "systems" or "utility" software designed to help the computer or its peripherals operate. The evidence of third-party registrations introduced by the Examining Attorney to show the same mark used in connection with computer hardware and software appears to be limited to "systems" or "utility" type software, as opposed to applications software. Remembering that applicant's goods are not software at all, we are persuaded that even in the event a customer of registrant's applications software is exposed to applicant's buffers, that customer would not be likely to believe the respective goods emanated from the same source, since those are products associated with disparate parts of the computer field.

In re Quadram Corp., 228 USPQ 863, 865-66 (TTAB 1985).

Similarly in this case, applicant is seeking registration for a particular type of computer service. Applicant's identification of services indicates that, for these services, the primary customers would be the owners or operators of building, construction, and related businesses. Applicant's specimens indicate that "ChanneLinx.com enables enterprises to easily communicate

and conduct business across network boundaries with vertical markets." Registrant's services are directed to data transfer and data communications applications. Applicant's declarant stated that "[t]he customers to which [registrant] sells its 'CHANNELink' products are likely to be those persons who need very sophisticated computer services such as storage area networks. The customers likely to be interested in purchasing such sophisticated computer technology are persons engaged in the MIS [management information systems] departments of large corporations." Holliday declaration at 7, paragraph 21. We are mindful of the requirement that we consider the services as they are set out in the identification of services. However, because registrant's identification of services is not entirely clear, we have considered the evidence of registrant's services to determine what the identification of services would mean in the trade. See In re Trackmobile, Inc., 15 USPQ2d 1152, 1153-54 (TTAB 1990) ("The terms 'mobile railcar movers' and 'light railway motor tractors' are somewhat vague to members if this Board who possess no special knowledge of such equipment... [W]hen the description of goods for a cited registration is somewhat unclear, as in the case herein, it is improper to simply consider that description in a vacuum and attach all

possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade").

When we consider the services of applicant and registrant, we do not consider them to be related. While both services are computer services, the potential overlap of customers is de minimis.

In sum, the marks in this case, while similar, are not identical. Applicant's services are directed to the operators of building, construction, and related businesses. These purchasers would not be likely to encounter registrant's data communications applications hardware and software, which would be directed towards information technology professionals. When we consider the marks in their entirety and the goods and services in the application and registration, we conclude that there is not a likelihood of confusion.

III. Refusal based on Registration No. 2,244,349

The Examining Attorney also determined that applicant's CHANNELINX.COM and the second registered mark, CHANNELINK, are confusingly similar. Both marks are depicted in typed form, and the Examining Attorney argues that they are "virtually identical in spelling, appearance and commercial impression." Examining Attorney's brief at

5. The Examining Attorney noted that the first nine letters are the same. The Examining Attorney further held that despite the differences in the next letter, "k" and "x," and the addition of a top level domain name, ".com," the "marks create the same overall impression in that both contain the phonetic equivalent term CHANNELINK." Id.

Applicant argues that the marks are spelled differently and it emphasizes the ".com" of its mark. Applicant maintains that they have different commercial impressions. Regarding the services, applicant notes that it is not seeking registration of its mark for educational training services, that its services cost between \$5,000 to in excess of a million dollars, and that the potential customers are sophisticated. Applicant also asserts that there has been no actual confusion.

Because we agree with the Examining Attorney, we affirm the refusal to register because of the cited '349 registration.

In likelihood of confusion cases, we must consider the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), keeping in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is whether the marks are similar in sound, appearance, meaning or commercial impression. du Pont, 177 USPQ at 567.

One difference between the two marks is the presence of the ".com" in applicant's mark. This addition at the end of applicant's mark does not readily distinguish the two marks.

The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com... [C]ompanies strongly prefer that their domain name be comprised of the company or brand trademark and the suffix .com.

Sporty's Farm L.L.C. v. Sportsman's Market Inc., 202 F.3d 489, 53 USPQ2d 1570, 1572 (2d Cir. 2000).

As a result, the ".com" portion of marks has not been given much significance. See Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1558 (9th Cir. 1999) (observing that the differences between the mark "MovieBuff" and the domain name "moviebuff.com" are "inconsequential in light of the fact that Web addresses are not caps-sensitive and that the '.com' top-level domain signifies the site's commercial nature").

Also, the slightly different spelling of "channelinx" and "channelink" is not significant because it results in a very similar look and sound of the mark. The use of a phonetic equivalent with a slight misspelling does not result in a term with a markedly different appearance from a registered mark. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("There is little room to debate the similarity between ROPELOCK and ROPELOK in appearance"). The only slight difference in pronunciation may be the difference between a singular or plural sound, which would not result in any significant change in the commercial impression of the marks. Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 342 (CCPA 1957) ("There is no material difference in the trademark sense between the singular and plural form of the word 'Zombie' and they will therefore be regarded as the same mark"). In addition, the meaning of the two marks does not distinguish them. Both would have a similar meaning of a "channel link" or "channel links."

Regarding the relatedness of the services, the Examining Attorney's brief addressed the issue of likelihood of confusion based on the identification of services before it was amended. After a remand to consider the new identification of services and additional evidence,

the Examining Attorney maintained the refusals under Section 2(d). The Examining Attorney's reasoning is set out below:

The applicant's amended identification of services in International Class 37 and 42 are accepted and made of record. However, this amended identification has no impact on the FINAL refusal or brief as written and the refusal under Section 2(d) is maintained and continued. The fact that the goods and services of the parties differ is not controlling in determining a likelihood of confusion. The issue is not likelihood of confusion between particular goods and services, but likelihood of confusion as to the *source* of those goods and services. See In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984), and cases cited therein.

In addition, the examining attorney must determine whether there is a likelihood of confusion on the basis of the goods and services as they are identified in the application and registration. If the cited registrations describe goods and services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registrations encompass all goods and services of the typed described, that they move in all normal channels of trade, and that they are available to all potential purchasers.

Finally, the amended identification of services in International Class 35 is again rejected. The FINAL requirement that the applicant must amend its identification of services in International Class 35 is maintained and continued.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written, since no new facts or reasons have been presented which are significant and compelling with regard to the point at issue.

Office Action dated August 8, 2001 at 1-2 (emphasis in original).

We must consider the goods and services as they are described in the identification of goods and services in the application and registration. See Dixie Restaurants, supra. See also Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed").

Applicant's services include "network installation services for enabling electronic commerce in the field of building materials and supplies, petroleum-related chemicals, industrial equipment and supplies, manufacturing equipment, and construction equipment," and software maintenance and similar services. Registrant's services include "offering seminars and training others in the use and operation of computers and related equipment." The Examining Attorney has submitted copies of several registrations to show that computer-related installation, maintenance, and other services are offered under the same mark as computer training services. See e.g., Registration

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No. 2,348,519 (installation and upgrade of computer networks and computer systems and computer education training services); No. 2,340,207 (installation, maintenance, repair and refurbishing of used computers and training in the use of computer hardware and software); No. 2,315,334 (installation, maintenance and repair of computer systems, designing and hosting web sites for others and courses of instruction in the field of computers); and No. 2,316,065 (installation of computer networks, website design and training in the use and operation of computer systems). These registrations are some evidence that computer installation, maintenance, and other services and computer training services are offered by the same party under the same mark. These registrations support the Examining Attorney's position that the services of applicant and registrant are related. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

We find that the registrant's services of offering seminars and training others in the use of and operation of computers are related to applicant's computer-related services. Also, unlike the other cited registrant, the '349 registrant has not limited its identification of services to any particular field and the services would include training others in the operation of computers in the field of building materials and supplies, petroleum-related chemicals, industrial equipment, and construction equipment and supplies. In addition, even if the purchasers of applicant's and registrant's services are sophisticated, they would likely be confused when applicant's CHANNELINX.COM mark and registrant CHANNELINK mark are used on these closely related services. Octocom Systems, 16 USPQ2d at 1787. Finally, even if there is no actual confusion, the lack of actual confusion does not establish that there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). In this ex parte proceeding, we have no information from the registrant.

Applicant's computer services and registrant's educational services include offering services in the same field. When the very similar marks CHANNELINX.COM and

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CHANNELINK are used on these related services, we conclude that there is a likelihood of confusion.

Decision: The refusal to register applicant's mark under Section 2(d) because of Registration No. 1,862,275 and the requirement for a further amendment to the proposed identification of services in Class 35 are reversed. The refusal to register applicant's mark under Section 2(d) on the ground that applicant's mark for its services is confusingly similar to the mark CHANNELINK for the services in Registration No. 2,244,349 is affirmed.