

Hearing:  
October 16, 2001

1/17/02

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE  
TTAB

Paper No. 12  
DEB

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Frank J. Real

Serial No. 75/779,525

Patrick T. Henigan of Graeff Henigan & Dugan, P.C. for  
Frank J. Real.

Heather L. Stone, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Frank J. Real, a United States citizen and a resident  
of the Commonwealth of Pennsylvania, sought registration on  
the Principal Register for the mark DATAGUARD for services  
recited, as amended, as "electronic data vaulting services  
in the nature of electric data storage," in International  
Class 39.<sup>1</sup>

<sup>1</sup> Serial No. 75/779,525, filed August 18, 1999, was based  
upon applicant's allegation of a *bona fide* intention to use the  
mark in commerce.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, as used in connection with the recited services, is likely to cause confusion, to cause mistake or to deceive consumers, in view of the prior registration of the mark DATAGUARD for "computerized business information system providing protection, storage and retrieval services," in International Class 42.<sup>2</sup>

When the refusal was made final, applicant appealed. Both applicant and the Trademark Examining Attorney have filed briefs and applicant requested an oral hearing that was held before this panel on October 16, 2001. We affirm the refusal to register.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the similarities of the services. Federated Foods,

---

<sup>2</sup> Registration No. 1,070,439, issued July 26, 1977; Section 8 affidavit filed and Section 15 affidavit acknowledged; renewed.

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

We begin our analysis by turning to a comparison of the respective marks. Inasmuch as both service marks are for the term DATAGUARD in the form of a typed drawing, we find that applicant's mark is identical to the cited registered mark in terms of sound, meaning and overall connotation. Accordingly, viewing the marks in their entireties, we find that the marks present identical overall commercial impressions.

We turn next to a consideration of the similarity between applicant's services, as recited in the application, and the services recited in the cited registration. It is not necessary that these respective services be identical in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services 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 producer or that there is an association or connection between the producers of the respective services. See In re Melville

Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

According to registrant's Internet home page (made of record by applicant), we learn the following:

In today's data-driven world, information is the lifeblood of business. The management of vast quantities of information, as well as the protection of vital records during catastrophic events - from fires, floods, and power outages, to theft, employee sabotage, terrorism and computer viruses - is the most essential risk management concern for corporations that rely on **DATAGUARD CORP.** for off-site data security. For over two decades, **DATAGUARD CORP.** has been the leading off-site data storage vendor in the New York metropolitan area, serving the needs of financial institutions, Fortune 500 companies and other organizations.

Registrant's Web site goes on to describe the physical transportation of information media via its fleets of customized data vans. By contrast, applicant argues that its services involve the electronic vaulting of data via telecommunications lines. While registrant's and applicant's respective mechanisms for storage, protection and retrieval (or recovery) of computerized data are clearly different (e.g., physical transport of computerized storage media versus moving the data over telecommunications lines), the purpose served is identical. These are both extant services designed to provide data

protection for data intensive organizations. Applicant and registrant both provide their customers with some form of off-site storage of data. This type of contingency has become routine given the prohibitive costs to a business of losing its data in a natural disaster or other emergency situations. In fact, the entire record supports the conclusion that these two methods for backing-up and retrieving computerized information are alternative methods for achieving the same result. Applicant's argument that sophisticated business persons would not be confused by the difference between these services is clearly not determinative of the question of likelihood of confusion.

We also bear in mind that the greater the degree of similarity between the respective marks, the lesser the degree of similarity required in the respective services in order to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applying these principles to the facts of this case, we find that applicant's services are sufficiently closely related to registrant's services that confusion is likely to result from the concurrent use of these identical marks.

Given identical marks and the relatedness of the services as discussed above, we agree with the Trademark Examining Attorney that the possible sophistication of purchasers would not prevent a likelihood of confusion. There is no support in the record for applicant's assertions regarding the purported sophistication of purchasers. Moreover, services of the type involved herein undoubtedly are offered to a wide range of consumers, not all of whom are necessarily knowledgeable in the field of backing-up and retrieving computerized information.

To the extent that applicant is arguing that DATAGUARD is a weak mark, the record contains no evidence that this mark is weak in the field of backing-up and retrieving computerized information. Even assuming *arguendo* applicant's point that "data guard" is a suggestive term in this context, even a relatively weak mark is entitled to protection when the identical mark is used on closely related services. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982).

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed.

Serial No. 75/779,525

Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc.,  
748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.