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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Boardtown Corporation

Serial No. 76/224,169

Frederick L. Cooper, III of Buker, Jones & Haley, P.C. for Boardtown Corporation.

Henry S. Zak, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Hohein, Chapman, and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Boardtown Corporation (a Mississippi corporation) filed an application on March 14, 2001, to register on the Principal Register the mark WOMBAT HELP DESK SYSTEM for goods amended to read as follows: "computer software programs sold through direct sales channels for use in the field of technical support and help desk management, namely, providing problem ticket tracking, searchable knowledge base, contact management, and sales lead

tracking" in International Class 9. The application is based on applicant's assertion of its bona fide intention to use the mark in commerce on the identified goods. Applicant disclaimed the words "help desk system."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark shown below

for "software in the field of providing multiple-user access to a global computer information network, and software for interfaces, search engines, E-mail, modem and system requirements" in International Class 9,[1] as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in

[1] Registration No. 2,073,962 issued June 24, 1997. See Section 8(c)(1) of the Trademark Act, 15 U.S.C. §1058(c)(1).

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to a consideration of the involved marks, it is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and In re

National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's mark and registrant's mark share the term WOMBAT. It is the dominant feature of both the cited registrant's mark, and applicant's mark. The addition of the highly descriptive words "help desk system" as applied to applicant's computer software programs relating to help desk management, does not detract from the dominance of the word WOMBAT in the commercial impression created by applicant's mark, and does not serve to distinguish applicant's mark from the cited registered mark. Likewise, the presence of the word "NET," which generally connotes the Internet or a network of computers, does not detract from the dominance of the word WOMBAT in the commercial impression created by registrant's mark, and does not serve to distinguish registrant's mark from applicant's mark. In addition, the pictorial representation of a "wombat" emphasizes the dominance of the term WOMBAT in registrant's mark. While applicant's mark includes the words "help desk system" and registrant's mark includes the word "net," we nonetheless find these marks are similar in sound and appearance.

There is nothing in the record to show that the term "WOMBAT" is anything other than arbitrary in relation to

the involved goods.[2] Given the arbitrary nature of the term with respect to both applicant's and registrant's goods, and the dominance that the term has in both marks, it not only connotes essentially the same thing for both applicant's and registrant's goods, but the marks create a very similar overall commercial impression.

As explained earlier, the differences in the marks do not serve to distinguish the marks here in issue. That is, purchasers are unlikely to remember the specific differences between the marks, focusing more on the word WOMBAT (and the picture of a wombat), due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. Purchasers seeing the marks at separate times may not recall these differences between the marks. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

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[2] The Examining Attorney pointed out that "wombat" identifies "an Australian animal." (See, brief, unnumbered page 3, and Final Office action, p. 2). We take judicial notice of The American Heritage Dictionary of the English Language (4th ed. 2000) definition of "wombat" as "n. Any of several stocky burrowing Australian marsupials of the family Vombatidae, somewhat resembling a small bear and feeding mainly on grass, leaves and roots." See TBMP §704.12(a) (2d ed. June 2003), and cases cited therein.

We find that applicant's mark WOMBAT HELP DESK SYSTEM and registrant's mark "WombatNet" and design of a wombat, when considered in their entireties, are somewhat similar in appearance and in sound, and very similar in connotation. The overall commercial impression of each mark is of an animal, arbitrary in relation to the goods, as each mark begins with the word "wombat" and the design element in registrant's mark reinforces this impression. See In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

Turning to the similarities/dissimilarities and the nature of the involved goods, the Board must determine the issue of likelihood of confusion on the basis of the goods and/or services as identified in the application and the registration, and in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See Octocom Systems Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and Squirtco v. Tomy Corp., 697 F.2d 1034, 216 USPQ 937 (Fed. Cir. 1983).

Further, it is well settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001).

In support of his position that these goods are related, the Examining Attorney submitted copies of some third-party registrations, based on use in commerce, to show that applicant's help desk functions for its software, and registrant's software for interfaces, E-mail and modem system requirements are offered under the same mark. (See, for example, Registration No. 2,535,011 for "computer software using artificial intelligence for use in managing help-desk functions, namely, for use in maintaining help-desk logs, for use in processing and tracking third party e-mail inquiries..."; Registration No. 2,026,546 for, inter alia, "computer software for use in the fields of asset

management, help desk support, technical support, ... inventory management, network management, office automation, scheduling, project management, E-mail, telephone inquiries and linkage, information and database retrieval, sales force and contact management, ...”; and Registration No. 1,952,553 for “computer software for use in the fields of information and database retrieval, asset management, help desk support, technical support, ... inventory management, network management, office automation, scheduling, project management, E-mail, ... information and database retrieval, sales force and contact management ....”)

When considering the third-party registrations submitted by the Examining Attorney, it is settled that third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nonetheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, footnote 6 (TTAB 1988).

The Examining Attorney also submitted evidence in the form of several pages from various Internet web sites showing that manufacturers and distributors of software provide software which performs various functions, including those such as the e-mail and modem interface requirements in registrant's identified goods as well as the technical support and help desk management in applicant's identified goods. See, for example, the following:

> "Project Insight—Project Management Software: ... MS Project Integration, MS Office Integration, Auto-Alerts, Email Notifications..." www.project-management-software.org;
>
> "Autotask Better Manage People, Projects, Time & Costs Introducing AutotaskPSA 100% Web-based PSA [Professional Services Automation] Software Solution Features ... Project Management ... Attendance Tracking ... HelpDesk/Service Desk ..." www.autotask.com;
>
> Tarka – The Integrated ISP [Internet Service Providers] Management Software for ISPs ... Tarka integrates your email, web, authentication and access servers to provide a single point of administration for your entire network. ... manages the following common ISP services: Dial-in accounts... Mail accounts, including mailboxes, aliases, and virtual domain accounts, ... Tracking of usage and statistics... Billing by e-mail... www.netcraft.com; and

> Blue Ocean Software A Division of INTUIT® Blue Ocean Software Delivers Track-It!5.0 ... New features include increased scalability, expanded asset management functionality, added reporting capability, and enhanced security.
> ...
> "Track-It! Is the world's most widely used asset management and help desk solution... www.blueocean.com.

Based on this record, we find that the Examining Attorney has presented a prima facie case that the respective goods are related within the meaning of Section 2(d) the Trademark Act, as interpreted by the Courts and the Board.

Regarding the channels of trade/purchasers/conditions of sale du Pont factors, applicant strongly urges that the Examining Attorney erred by "failing to properly consider the respective channels of trade and standard of care regarding the purchasing decision." (Applicant's brief, p.3.) Specifically, applicant acknowledges that the channels of trade are not limited in the registration, but applicant contends that the Examining Attorney did not address the facts set forth in the July 2001 declaration of applicant's president, William Ford. Mr. Ford avers that applicant's goods are designed for use by Internet service providers and other professional service providers, and are not marketed to the general public; that its goods are sold

solely through applicant's direct sales force; that applicant's goods are "relatively expensive, ranging in price from approximately $3000 to $10,000 at the present time" (paragraph 4); that its goods are marketed to sophisticated purchasers acting on behalf of customers who purchase with great care and only after careful examination; and that applicant's sales cycle takes about 30-60 days involving substantial negations culminating, if successful, in a contract as required by applicant.

Applicant then argues as follows (applicant's brief, p. 6):

> In summary, despite the fact that the respective parties sell products within the same broad field, and even to the same customers, and further that some of the functionality of some of the components of the respective products is similar, such facts do not, by themselves establish relatedness, similarity of trade channels or overlap of customers. Other factors, such as the <u>respective channels of trade</u>, the <u>relatively high standard of care</u> exercised by purchasers, and the <u>limitation on Applicant's relevant market</u> dictated by Applicant's product design features, should also be given the weight required by law in order to give proper consideration to the practicalities of the commercial world, and not to mere theoretical possibilities of confusion, or mistake, or with de minimus situations. Accordingly, if the factors indicated in Applicant's Declaration are given proper consideration and weight, when

> coupled with Applicant's direct channels limitation, there should be no likelihood of confusion with the mark cited by the Examiner.

(Emphasis in original.)

The Examining Attorney contends that both applicant's and registrant's computer software programs could require support services, personnel training and some degree of customization in that while the cost of registrant's goods is not of record, those goods could be expensive or vary in cost; and that registrant's goods could also require negotiations to create a software package compatible with the customer's needs. However, he maintains that there is a likelihood of confusion as explained below (brief, unnumbered page 6):

> Finally, sophisticated customers or purchasers, while knowledgeable in a particular field, would not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks, particularly where the computer software is in a related field, marketed under similar marks, each having the identical arbitrary wording as the major or most notable component of each mark.

We first note that applicant's identification of goods is specifically limited by the language "sold through direct sales channels," but it is not otherwise restricted. Registrant's goods, as identified, are broadly worded and the identification is not restricted as to either trade

channels or purchasers. Thus, registrant's goods may be sold through all the normal trade channels and to all the usual classes of consumers for such goods. See Octocom Systems Inc. v. Houston Computer Services, Inc., supra; Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, supra; and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

While we agree that the purchase of the involved computer software would be made after careful consideration, nonetheless, we find that, this factor does not negate a finding of likelihood of confusion. Even assuming the purchasers and/or users of these goods are sophisticated, this does not mean that such consumers are immune from confusion as to the origin of the respective goods, especially when sold under very similar marks. See Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999); and In re Decombe, 9 USPQ2d 1812 (TTAB 1988). That is, even relatively sophisticated purchasers and users of these computers software programs could believe that these goods come from the same source, if offered under the involved substantially similar and arbitrary marks. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir.

1990); and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

In this case, applicant's goods and those of registrant could be encountered by consumers in circumstances that would give rise to the belief that both parties' goods come from or are associated with the same source. For example, consumers might consider the WOMBAT HELP DESK SYSTEM products of applicant to be additions to the product line of registrant, who already sells computer software for multiple-user access to the Internet and for, inter alia, interfaces, E-mail and modem and system requirements under a mark which includes the arbitrary word WOMBAT, as well as the pictorial representation of a wombat. See Dan Robbins & Associates, Inc. v. Questor Corporation, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Finally, to the extent we have any doubt on the question of likelihood of confusion, it must be resolved against applicant as the newcomer, because the newcomer has the opportunity to avoid confusion and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.