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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aspen Technology, Inc.

Serial No. 76399475

John L. DuPre for Hamilton, Brook, Smith & Reynolds, P.C.
for Aspen Technology, Inc.

Jeri Fickes, Trademark Examining Attorney, Law Office 107
(J. Leslie Bishop, Managing Attorney).

Before Grendel, Drost, and Cataldo, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 24, 2002, applicant Aspen Technology, Inc.
applied to register the mark ASPEN ORION (in typed or
standard character form) on the Principal Register for
goods and services ultimately identified as follows:

Computer software for use in scheduling general
refining in Class 9

Licensing of computer software for refinery scheduling
in Class 35

Consulting and technical support services, namely,
troubleshooting of computer software problems for
general refinery scheduling in Class 42.

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The application (No. 76399475) is based on an allegation of a bona fide intent to use the mark in commerce.

The examining attorney¹ has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark ORION (in typed form) for "computer software for business management of organizations engaged in marketing, distribution, manufacturing, oil and gas, contracting and fabrication" in Class 9.²

When the refusal was made final, applicant filed this appeal.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin by considering the similarities and dissimilarities of the marks in the application and registration. Applicant's mark is ASPEN ORION.

¹ The current examining attorney was not the original examining attorney in this case.

² Registration No. 2,670,372, issued December 31, 2002.

Registrant's mark is simply the single word ORION. The marks in the application and registration are for the words alone without any design or stylization. Neither word, ASPEN or ORION, has any meaning when used in association with the identified goods or services. Obviously, the marks are similar to the extent that they both contain the same word ORION. The marks are different because applicant adds the word ASPEN as the first word of its mark.

Simply adding words to a registered mark does not necessarily eliminate the likelihood of confusion. The Federal Circuit addressed a situation where the applicant sought to register the mark JOSE GASPAR GOLD for tequila and the mark GASPAR'S ALE for beer and ale was cited as a bar to registration. In re Chatam International Incorporated, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). The Court held that "[w]ith respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." Chatam, 380 F.3d at 1343.

More specifically in this case, applicant argues that the addition of its house mark ASPEN avoids confusion. "The ASPEN mark for computer software and services in the

refining process industries, including general refinery scheduling, is well known to identify the source of the goods and services as the Applicant." Brief at 6.

Applicant indicates that it is the owner of twenty-five registrations for the term ASPEN. Brief at 6. However, the addition of a trade name or house mark to a registered mark does not generally avoid confusion. Menendez v. Holt, 128 U.S. 514, 521 (1888). The addition of a house mark may avoid confusion when there are recognizable differences between the common elements of the marks. See Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 152 USPQ 599 (CCPA 1967) (ROCKWOOD BAG-O-GOLD for candy not confusingly similar to CUP-O-GOLD for candy). The board has described the different effects the addition of a house mark to a registered mark can have in a likelihood of confusion case:

[S]uch addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion. On the other hand, where there are some recognizable differences in the asserted conflicting product marks or the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to the assertedly conflicting product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable.

In re Christian Dior, S.A., 225 USPQ 533, 534 (TTAB 1985)
(citations omitted) (Applicant's LE CACHET DE DIOR
confusingly similar to the registered mark CACHET).

In a case that is similar to the present appeal, the board found that there was confusion when applicant sought registration of the term HILL-BEHAN'S LUMBER JACK for retail hardware services and the examining attorney cited the mark LUMBERJACK and design for finished lumber products. In re Hill-Behan Lumber Company, 201 USPQ 246 (TTAB 1978). The board explained that:

And while the term "LUMBERJACK" may possess some suggestive significance as applied to registrant's lumber products and to applicant's lumber yard retail services, it is not descriptive thereof and in no way devoid of the ability to function as a source indicator for the respective goods and services. Any assertion to the contrary would be an affront to both the cited registration and the registration sought by applicant.

Thus, for purposes herein, the "LUMBERJACK" marks of the parties are identical. In such a situation, the addition of applicant's house mark "HILL-BEHAN'S" thereto is not deemed sufficient to distinguish the marks as a whole and to avoid confusion in trade. This is especially so when one considers that a trademark or a service mark identifies an anonymous source so that the average consumer in the marketplace is, more often than not, unaware of the producer of the goods sold under a mark and often doesn't care, so long as the quality of the goods identified by the mark remains the same. Thus, if those individuals familiar with registrant's "LUMBERJACK" products were to encounter "HILL-BEHAN'S LUMBER JACK" stores at which lumber products are sold, there is nothing to preclude them from assuming that "HILL-BEHAN" is the source of the "LUMBERJACK" products and has

established retail outlets to market them. Whether it be confusion of source or sponsorship, the likelihood of such confusion is there and, as a consequence, registrant's registered mark is a bar to the registration sought by applicant.

Id. at 249-50.

As noted above, a "trademark or a service mark identifies an anonymous source." In this case, purchasers familiar with the registered mark ORION are simply likely to believe that the previously anonymous source has chosen to identify itself.

Those already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that "sassafras" is some sort of house mark that may be used with only some of the "SPARKS" goods. Conversely, those familiar with only applicant's mark would, upon encountering the registered mark on related goods, assume that all "SPARKS" products come from a single source, and that that source was in some instances further identified with the words "by sassafras."

In re Apparel Ventures, Inc., 229 USPQ 225, 226 (TTAB 1986). See also In re C.F. Hathaway Co., 190 USPQ 343 (TTAB 1976) (HATHAWAY GOLF CLASSIC for knitted sports shirts confusingly similar to GOLF CLASSIC for men's hats).

Therefore, when we compare the marks in their entirety to determine whether they are similar in sound, appearance, meaning, and commercial impression, we conclude that the identity of the common term ORION outweighs the difference of the addition of applicant's house mark ASPEN.

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The only difference between the marks is that the previously unidentified source is now likely to be considered to be ASPEN. Such a difference does not avoid confusion.

Next, we consider whether the goods and services of the applicant and registrant are related. Applicant's goods are:

Computer software for use in scheduling general refining in Class 9

Licensing of computer software for refinery scheduling in Class 35

Consulting and technical support services, namely, troubleshooting of computer software problems for general refinery scheduling in Class 42

Registrant's goods are "computer software for business management of organizations engaged in marketing, distribution, manufacturing, oil and gas, contracting and fabrication" in Class 9. "Computer software for use in scheduling general refining" and "computer software for business management of organizations engaged in ... oil and gas" are very closely related. Applicant's senior vice-president has described "general refining" as "the refining of petroleum crude oil into fuels (e.g., gasoline, jet, diesel, heating oil), lubricants, and materials for further petrochemical processing." Doyle declaration at 2. Both

applicant's and registrant's goods and services would be used in the same industry, the oil and gas industry.

Applicant argues that registrant's "suite of products is used to create, maintain, manage, and syndicate contracts and price lists. Orion Enterprise provides a workflow approval process that encourages automated processes, thereby reducing costs, optimizing operations, and eliminating human error." Brief at 4 (internal quotation marks omitted). To the extent that applicant is attempting to read limitations into the registrant's goods, we must reject this argument. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 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 the sales of goods are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Both applicant's software for use in scheduling general refining and registrant's software for business management of oil and gas organizations could be used in the refining industry. Even if this software does not overlap, it would be closely related. As the examining attorney argues, applicant "has provided no clear explanation as to why business management processes would not include both event-based scheduling and day-to-day scheduling, nor why 'business management' for organizations engaged in oil and gas would not in the normal course include general refining scheduling and technical operational matters." Brief at unnumbered pp. 9-10.

Regarding the services, the examining attorney submitted several registrations that show that software and licensing and troubleshooting software services are associated with the same entity. See, e.g., Registration Nos. 2,802,241 (software and troubleshooting); 2,695,011 (software, licensing, and troubleshooting); and 2,688,189 (software and licensing).³ 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

³ We have not considered the examining attorney's evidence to the extent that it consists of pending applications. Olin Corp. v. Hydrotreat, Inc., 210 USPQ 62, 65 n.5 (TTAB 1981) ("Introduction of the record of a pending application is competent to prove only the filing thereof").

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 Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001) and In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). We agree that registrant's software and applicant's services are related. Customers who are familiar with registrant's software for business management of organizations in the oil and gas industry would likely draw the conclusion that licensing and troubleshooting software services for refining scheduling are somehow associated with the same source.

It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could 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 between the producers of each [party's] goods or services." In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Therefore, we find that applicant's goods and services are related to the registrant's goods.

Another point applicant argues is that the purchasers in this case are sophisticated. In his declaration (p.3), Mr. Doyle assert that its "customers are sophisticated and knowledgeable, and thus unlikely to purchase its products on impulse." The sophistication of prospective purchasers can help avoid a determination that confusion is likely. However, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). Here, even sophisticated purchasers would likely assume that there is an association between the goods and services of applicant and registrant. Inasmuch as the only difference between the marks is the presence of applicant's house mark, these purchasers are likely to assume that the source of registrant's software has simply identified itself for the goods and services of applicant.

Applicant also argues that the "number and nature of similar marks in use on similar goods shows that consumers

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will not be confused." Brief at 5. We are not persuaded by applicant's argument. First, applicant's evidence of these marks consists of a list of registrations and applications. This list of applications and registration numbers in Class 9 contains only the mark and the status. The "submission of a list of registrations is insufficient to make them of record." In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). Second, including evidence for the first time with applicant's brief is normally untimely. In re First Draft Inc., 76 USPQ2d 1183, 1192 (TTAB 2005) ("Submission of the TARR printout with its appeal brief, however, is an untimely submission of this evidence"). Third, even if third-party registrations were properly made of record, they would not demonstrate that the term ORION was weak. "Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of

what happens in the market place or that customers are familiar with them").

Fourth, regarding most of the registrations and applications, applicant has merely submitted a list of marks in Class 9. The simple fact that the marks are all classified in Class 9 is of no significance in determining whether there is a likelihood of confusion. The classification system is "for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights." 15 U.S.C. § 1112. Therefore, even if we could consider third-party registrations, applicant's list would not even support applicant's basic point that there are other ORION marks registered for similar goods. Class 9 is a large class and the simple fact that goods appear in that class hardly indicates that the goods are related. Even with computer programs, the Office requires specificity in the identification of goods because the fact that the goods are in Class 9 and they are both computer programs does not mean that there is a likelihood of confusion. See TMEP § 1402.03(d) (4th ed. rev. April 2005):

Any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of

registration under 15 U.S.C. §1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace. See In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992). Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as "computer programs in the field of medicine" or "computer programs in the field of education" should not be accepted unless the particular function of the program in that field is indicated.

Finally, the examining attorney has discussed two registrations for which applicant has provided the identification of goods and we will consider this information to be of record. Certainly, the presence of these registrations does not support the registration of other marks. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987) ("Finally, applicant has noted that there are on the register four other marks containing the designation ... and argues that therefore said marks should be afforded a narrow, restricted scope when determining the likelihood of confusion issue. There is a basic flaw in applicant's reasoning... [T]he third party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark") (parenthetical and internal quotation marks omitted). Also, these registrations for software for "designing, simulating and operating a production facility" and "a collection of software to assist formulators and technologists in

monitoring and tracking chemical compositions and providing for the calculation of various elements in chemical compositions" are not as closely related as the goods in the cited registration. Applicant's goods are for oil refining and the cited registration is also in the oil and gas industry. Therefore, it is much more likely that the same purchasers would encounter both applicant's and registrant's goods and services.

The last argument that applicant makes is that there has been no actual confusion. The Federal Circuit has held that the "lack of evidence of actual confusion carries little weight." Majestic Distilling, 65 USPQ2d at 1205. The absence of actual confusion does not mean 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); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). While we have considered applicant's assertion in its brief and the Boyle declaration that there has been no actual confusion, it does not persuade us that, in this ex parte case where the registrant has not had the opportunity to submit evidence, there is no likelihood of confusion.

Thus, when we compare the mark ASPEN ORION with registrant's ORION mark, the identical term ORION would

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dominate the marks. The marks' similarity in sound, appearance, meaning, and commercial impression outweigh the difference. Therefore, a significant number of potential purchasers are likely to assume that there is some connection or association between the sources of the goods and services.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.