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This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Toshiba America Business Solutions, Inc.

Serial No. 76525244
Serial No. 76525481

Susan L. Mizer of Tucker Ellis & West LLP for Toshiba America Business Solutions, Inc.

Sean Crowley, Trademark Examining Attorney, Law Office 116 (Michael Baird, Managing Attorney) (Serial No. 76525244).

Melvin T. Axilbund, Trademark examining attorney, Law Office 113 (Odette Bonnet, Managing Attorney) (Serial No. 76525481).

Before Bucher, Rogers and Cataldo, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Toshiba America Business Solutions, Inc. (applicant) has applied to register the mark ENCOMPASS, for goods identified as "computer software, namely software and programs in the field of quantitative and qualitative document management for businesses, specifically, software

and programs for analysis of document imaging, management and output device requirements to improve document management and output document functionality and reliability," in Class 9 (Serial No. 76525244), and for services identified, following amendment, as "computer services, namely providing temporary use of on-line nondownloadable computer software and computer programs in the field of quantitative and qualitative document management for businesses, specifically, software and programs for analysis of document imaging, management and document functionality and reliability," in Class 42 (Serial No. 76525481).

The applications were filed based on applicant's stated intention to use the mark in commerce for the identified goods and services. The mark has been refused registration by each of the respective examining attorneys, in view of the prior registration of the mark ELITE ENCOMPASS (Registration No. 2891154) for "software for electronic document management for use by corporate, government and professional service organizations," in Class 9. See Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). When the examining attorneys made their respective refusals of registration final, applicant appealed from each refusal.

Applicant and the examining attorneys filed separate briefs in each case. In view of the common issue presented by the appeals, the Board has chosen to issue this single decision.

Our determination under Section 2(d) is based on 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 Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); see also, 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, key considerations are the similarities of the marks and the related nature of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks").

To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73

USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these means of comparison may be critical in finding marks to be similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 (TTAB 1988); see also, In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988). In fact, "the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark." In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983).

In essence, applicant contends that the marks are visually and aurally different because the registered mark includes the term ELITE, while applicant's mark does not. Further, applicant contends, "other marks held by Registrant" include the term ELITE and consumers would therefore draw an association between ELITE ENCOMPASS and registrant's company name. We construe this as an argument that the marks have different connotations.

The examining attorneys, in contrast, view the marks as similar because ENCOMPASS is the entirety of applicant's mark and they contend it is the dominant element in the registered mark. They both contend that applicant, as the latecomer, cannot avoid a likelihood of confusion with a previously registered mark merely by deleting one of its two words and proposing to use the remaining word. They

both also note that applicant has not provided any support for its contention that registrant has registered the word ELITE in other marks, and they both assert that prospective consumers would be most likely to view ELITE as a laudatory term modifying the term ENCOMPASS. Therefore, the examining attorneys contend that consumers would view the respective marks as identifying computer programs and software of different quality levels but having the same source or sponsorship. In support of this contention, each of the examining attorneys has requested, and we grant the requests[1], that we take judicial notice of a dictionary definition of "elite": "the choice or best of anything considered collectively, as of a group of class of persons"[2]; and "the choice part … the best of a class."[3]

We agree with the assessment of the examining attorneys, and cannot accept the speculation of applicant that prospective consumers will be conditioned through some pattern of use by registrant to perceive the ELITE element in registrant's mark not as a laudatory term but instead as

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[1] See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

[2] Random House Unabridged Dictionary (1997), reproduced at www.infoplease.com/dictionary/elite.

[3] Merriam Webster's Collegiate Dictionary, p. 374 (10th ed. 1996).

a dominant house mark. As noted by the examining attorneys, there is no support for this contention in the record and, in any event, even if we could assume that ELITE is used as a house mark by registrant, it would still have the same laudatory connotation.

Examining Attorney Crowley has also requested, and we grant the request, that we take judicial notice of a dictionary definition of "encompass": "1. to form a circle about; encircle; surround" "2. to enclose; envelop" "3. to include comprehensively."[4] ENCOMPASS is a term that is suggestive of software or computer programs that are all encompassing in their management of electronic documents. While not entirely arbitrary in relation to the involved goods and services, the term is inherently distinctive. Moreover, the combination of ELITE and ENCOMPASS is even more distinctive, as the former is an adjective but, in registrant's usage, is not used to modify a noun. The combination of the adjective "elite" and the verb "encompass" is slightly incongruous and makes for a more distinctive mark. This only enhances the likelihood that consumers will find ELITE ENCOMPASS and ENCOMPASS similar, if used in conjunction with related goods or services.

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[4] Random House Unabridged Dictionary (1997), reproduced at www.infoplease.com/dictionary/encompass.

Notwithstanding applicant's contention that prospective purchasers of the involved computer programs or software may be sophisticated, a contention we address infra, consumers nonetheless have an imperfect recollection of marks. "Human memories even of discriminating purchasers ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Therefore, consumers familiar with registrant's ELITE ENCOMPASS products, when confronted with the similar ENCOMPASS products or services, may not recall that registrant's mark included the laudatory term ELITE. On the other hand, consumers confronted with registrant's mark after having seen applicant's mark, may simply conclude that registrant's products are a higher level of the products or services offered by applicant.

In sum, we agree with the contentions of the examining attorneys that the marks are similar, particularly in their connotation and overall commercial impression. We now turn to consideration of the involved goods and services, keeping in mind that "the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or

registration." In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(internal quotation marks omitted). Thus, it is irrelevant, notwithstanding applicant's argument in each brief, that its mark "ENCOMPASS is also used in connection with computer programs for resource usage monitoring, tracking and account management." Applicant also fails to explain how purported use of the applied-for mark on additional computer programs would affect the analysis of likelihood of confusion when the involved marks would be used, respectively, in conjunction with the identified computer programs and services of applicant and the identified software of registrant.

Applicant argues in each of its briefs that its "services range in price from approximately, several hundred dollars to tens of thousands of dollars and are marketed to [for example]" major accounting firms and major automotive facilities.[5] Therefore, applicant asserts in

[5] Even though one of applicant's applications seeks to register the ENCOMPASS mark for goods, both briefs use the word services. We construe the argument in Serial No. 76525244 as if it employed the word goods. Also, the argument in one of the applications references "major accounting firms, for example" as a class of customers, while the other references "major automotive facilities, for example." Given the similarity in the nature of applicant's goods and services, we construe the respective arguments broadly, and as asserting that these two classes of customers would be potential customers for both applicant's goods and services.

each brief, "it is extremely likely that the vast majority, if not all, of the relevant buyer class is composed solely of professional buyers." Even if, applicant argues in the alternative, the "purchasing class" is not considered to consist solely of professional buyers, the "products at issue are likely to be considered 'expensive'" and the prospective purchasers should be assumed to be not merely "reasonably prudent" but "discriminating."

First, there is nothing in the record to establish the cost of applicant's goods or services, or the class of customers for them.

Second, even though applicant's respective identifications are restricted to goods and services "for businesses," and we can therefore assume that they would include "major" businesses of the sort to which applicant has referred, we must construe the goods and services as also being marketed to smaller businesses, including, for example, sole proprietorships or consultants that would have need of computer programs or services costing as little as a few hundred dollars. Thus, we are unable to assume, as applicant apparently has, that all prospective purchasers of its goods or services will be professional purchasing managers or heads of large information technology sections of large companies.

Third, although registrant's identification limits classes of customers to "corporate, government and professional service organizations," we must assume these classes to include small corporations, smaller local governments and smaller professional services organizations. Again, we cannot, therefore, conclude that registrant's goods would only be purchased by professional purchasing agents for large entities or by heads of information technology sections of such entities. In short, we agree with the examining attorneys that the involved goods and services must be considered to be marketed to prospective purchasers of varying degrees of sophistication, alike only insofar as each purchaser would have need of computer programs or services making such programs available on-line, for document management. As already noted, even discriminating purchasers may suffer from imperfect recollection of marks and be confused as to source. In re Research and Trading Corp., 230 USPQ at 50.

Even if discriminating purchasers recognized the presence of ELITE in registrant's mark, or its absence from applicant's marks, such purchasers likely would assume there to be some common source or sponsorship, as there is nothing in the record to suggest that ENCOMPASS is widely used for document management software or related services.

Purchasers need not conclude that goods or services come from the same source to be confused, as it is sufficient to find a likelihood of confusion when purchasers may conclude that there is some common sponsorship or authorization. In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

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