

THIS DISPOSITION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed: 6/4/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Computer Network Systems, Inc.

Serial No. 76557740

Donna M.D. Thomas and David R. Hale of Astrachan Gunst
Thomas for Computer Network Systems, Inc.

Tasneem Hussain, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Quinn and Grendel, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applicant filed an application to register the mark
PRIORITY PARTNERS for

Franchising services, namely, offering
technical and administrative assistance
in the establishment and/or operation
of a computer consulting and computer
network support business, excluding
computer programming and software
design; distributorships in the field
of computer and network related
hardware and software (in International
Class 35);

Installation, maintenance and repair of computer networks (in International Class 37); and

Computer consultation excluding computer programming and software design; computer network design for others; computer systems analysis; integration of computer systems and networks; monitoring computer systems of others for technical purposes and providing back up computer programs and facilities; technical support services namely troubleshooting of computer hardware and software problems; and maintenance of computer software, namely updating computer software for others (in International Class 42).¹

The trademark examining attorney refused registration in all three classes under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's services, so resembles the previously registered mark PRIORITY for "computer programming, software design, and data processing services in the accounting, marketing and management fields" (in International Class 42)² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have submitted briefs.

The examining attorney maintains that applicant's mark PRIORITY PARTNERS is dominated by "PRIORITY"; this is

¹ Application Serial No. 76557740, filed October 16, 2003, alleging a bona fide intention to use the mark in commerce.

² Registration No. 1237819, issued May 10, 1983; renewed.

identical to the entirety of registrant's mark PRIORITY. Based on third-party registrations covering services of the types rendered by applicant and registrant, the examining attorney contends that the services are related.

Applicant contends that the marks are different, and that its mark is dominated by the term "PARTNERS." Further, applicant argues that the services are different, and that the services are bought by sophisticated business purchasers. Applicant also criticizes the third-party registration evidence submitted by the examining attorney in an attempt to show that the services are related. Also, according to applicant, there has been a period of three years of contemporaneous use of the marks without any actual confusion. Applicant has introduced a dictionary definition of "data processing," and information about registrant and its services, including a press release and excerpts from registrant's website.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., 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 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).

We first turn to compare registrant's mark PRIORITY to applicant's mark PRIORITY PARTNERS. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Nevertheless, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."].

When considering applicant's mark, we find that the word "PARTNERS" is subordinate to the remainder of applicant's mark, namely the word "PRIORITY." Purchasers likely would view the word "PARTNERS" merely as a designation of applicant's type of business (whether the perception is correct or incorrect is irrelevant to our analysis)³ or that applicant will partner with a customer in rendering its services. The dominant portion of applicant's mark, "PRIORITY," is identical to the entirety of registrant's mark. That is to say, applicant has appropriated the entirety of registrant's mark and merely added an insignificant, subordinate word. Contrary to applicant's argument that "PARTNERS" is the dominant portion of its mark, the dominant portion is the word "PRIORITY," which is the first word and most distinctive portion of the mark, and is the portion of the mark most likely to be remembered by prospective purchasers. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988).

In terms of sound and appearance, the marks look and sound similar; applicant's mark begins with "PRIORITY," and

³ In this connection, we take judicial notice of the dictionary definition of "partner": "one that is united or associated with another or others in an activity or a sphere of common interest, especially a member of a business partnership." The American Heritage Dictionary of the English Language (4th ed. 2000).

this is the entirety of registrant's mark. The marks also convey similar meanings, both suggesting that the services rendered thereunder will put the user in a preferential or more important position, or that the entity makes its customers and their needs a priority.⁴ In view of the similarities between the marks, we find that they engender similar overall commercial impressions.

The substantial similarity between the marks PRIORITY and PRIORITY PARTNERS is a factor that weighs heavily in favor of a finding of likelihood of confusion in this case.

We next turn to a consideration of the services. It is not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. In re Melville Corp.,

⁴ Notwithstanding any suggestiveness of the marks, we note the absence of evidence of any third-party uses or registrations in the computer field of marks that are the same as or similar to the marks involved herein.

18 USPQ2d 1386 (TTAB 1991).

According to the dictionary definition submitted by applicant, the term "data processing" means "the preparation of information for processing by computers; the storing or processing of raw data by computers." The American Heritage Dictionary (2d College Ed. 1982).

In considering the services we recognize, at the outset, that there is no per se rule relating to source confusion vis-à-vis computer products and services. See, e.g., *Information Resources, Inc. V. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1985). The Board has acknowledged that 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." *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 1749, 1751 (TTAB 1987).

As applicant is quick to point out, it has excluded "computer programming" and "software design" (two of the three types of services rendered by registrant) from its services identified in Classes 35 and 42. Applicant, while stating that "it is theoretically possible that purchasers of one service might be purchasers of the second," (Reply Brief, p. 3), regards the possibility as remote given the broad field of computers and software. The examining

attorney, in support of the Office's position that applicant's and registrant's services are related, introduced seven third-party registrations that, according to the examining attorney, cover the types of services involved herein. Applicant contends that the registrations are insufficient to establish a relationship between the services, asserting, albeit without any evidence in the record, that there exist registrations and applications for services in the computer field numbering in "the hundreds of thousands." Thus, applicant concludes, the evidence falls short of showing that the services of applicant and registrant are commonly offered by a single source.

Third-party registrations which individually cover a number of different items (and/or services) and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ 1783 (TTAB 1993). Because this is the only evidence bearing on the relatedness of the services, a close inspection of the registrations is necessary.

The examining attorney submitted seven use-based third-party registrations covering various services in the computer field. Those registrations, with the pertinent services indicated, are as follows: Reg. No. 2428698,

Ser No. 76557740

TRIZETTO for "computer diagnostic services and inspections of computer networks; maintenance of software for others in the nature of updating software" in Class 42 (the same as or similar to applicant's Class 42 services), and "custom computer programming services for others, including database development, information archival and retrieval services; computer software design services" (the same as or similar to registrant's services); Reg. No. 2458918, SYKES for "computer hardware maintenance services" in Class 37, and "technical support services to users of computer software and hardware; software maintenance for others" in Class 42 (the same as or similar to applicant's Class 37 and 42 services, respectively), and "computer programming, software design and development, and data processing consulting" (the same as or similar to registrant's services); Reg. Nos. 2607773 and 2721126 for INNOVANTAGE and CDI CORPORATION, respectively, for "short term computer hardware and software maintenance" in Class 42 (the same as or similar to applicant's Class 42 services) and "data processing services" and "computer software design services for others" (the same as or similar to registrant's services); Reg. No. 2706085, EXTOL for "software maintenance for others" in Class 42 (the same as or similar to applicant's Class 42 services), and "computer

Ser No. 76557740

programming and software design" (the same as or similar to registrant's services); Reg. No. 2921035, COGITA for "wholesale and retail distributorships and wholesale and retail store services featuring computer software, hardware and peripherals; distributorships in the field of computer software, hardware and peripherals; business management services relating to computer software, hardware and peripherals" in Class 35, "installation, maintenance and repair of computer hardware," "installation, repair and maintenance of network systems consisting of computer hardware and peripherals" in Class 37, and "installation, maintenance and repair of computer software" in Class 42 (the same as or similar to applicant's Class 35, 37 and 42 services, respectively), and "computer software design and computer programming services for others" (the same as or similar to registrant's services); and Reg. No. 2939635, WORKPLACE MESSAGING for "technical support services, namely troubleshooting of computer hardware and computer software problems; integration of computer systems and networks; installation, updating and maintenance of computer software; computer systems analysis" in Class 42 (the same as or similar to applicant's Class 42 services), and "computer software design for others; computer programming

Ser No. 76557740

for others" (the same as or similar to registrant's services).

The registrations suggest that applicant's services in each of Classes 35, 37 and 42 and registrant's services in Class 42 are of types that may emanate from a single source under the same mark. As can be seen from this evidence, all of the seven registrations list services in Class 42, while some list services in both Classes 37 and 42. With respect to Class 35, we note that only one of the registrations, Reg. No. 2921035, lists services in this class. Although this registration does not list franchising services, the recitation of services does include a type of distributorship services in Class 35 (applicant's identification of services includes both franchising and distributorship services), as well as the types of services rendered by registrant. Thus, this registration provides support of the relatedness of applicant's Class 35 services and registrant's services. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion may be found if there is an overlap in any *item* in the involved identifications of goods and/or services].

We find that applicant's services in Classes 35, 37 and 42 and registrant's services are sufficiently related

that, when rendered under the substantially similar marks PRIORITY and PRIORITY PARTNERS, confusion is likely to occur among the relevant purchasers. These purchasers, familiar with registrant's services rendered under the mark PRIORITY, would be likely to believe, upon encountering applicant's services under the mark PRIORITY PARTNERS, that applicant's services are "partner" or associated services with those already offered by registrant.

Applicant argues that the customers for the respective services are not the same; that "they are business people seeking network support services from Applicant, and business people within the insurance industry seeking computer programs and software design and data processing services from registrant." (Reply Brief, p. 4). Applicant, relying on portions of registrant's website, attempts to limit registrant's customers to insurance agents and carriers. Registrant's recitation of services, however, is not so limited; the only limitation on the services is that they are directed to the "accounting, marketing and management fields." The issue of likelihood of confusion must be determined on the basis of the services identified in the application and the cited registrations. In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB 1999). Further, applicant may not

restrict the scope of registrant's services by relying on extrinsic evidence. *Canadian Imperial Bank of Commerce v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Given that applicant's services are not restricted as to customers, the services must be construed as broad enough to encompass customers in the accounting, marketing and management fields.

Applicant also contends that purchasers of the involved services are sophisticated. Even assuming arguendo that purchases of applicant's and registrant's services would involve a deliberate decision,⁵ this does not mean that the purchasers are immune from confusion as to the origin of the respective services, especially when, as we view the present case, the substantial similarity of the marks and the similarity between the services outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50

⁵ Applicant's franchising services and distributorship services in Class 35 necessarily would involve sophisticated purchasers.

Ser No. 76557740

(Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."].

Applicant's assertion that there have been no instances of actual confusion does not compel a different result here. The relevant test is the likelihood of confusion, and it is unnecessary to show actual confusion in establishing likelihood of confusion. In *re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). In any event, the involved application is based on an intention to use the mark. Although applicant states in its brief, filed June 23, 2006, that there has been a three-year period of contemporaneous use, there is no supporting evidence for this statement, and given that the application was filed in October 2003 based on an intention to use the mark, there is some question as to the accuracy of that statement. Even if use has commenced, the record is devoid of any evidence pertaining to the nature and extent of the use by applicant and registrant and, thus, we cannot ascertain whether there has been ample opportunity for confusion to arise.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that

Ser No. 76557740

doubt is required to be resolved in favor of the prior registrant. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register in all three classes is affirmed.