

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

Hearing:
October 25, 2006

Mailed:
March 15, 2007
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cyberchannel Inc.

Serial Nos. 76567272 and 76567273¹

Michael F. Petock of Petock & Petock, LLC for Cyberchannel Inc.

Marlene D. Bell, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney)

Before Seeherman, Rogers and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On December 30, 2003, Cyberchannel Inc. (applicant) filed two applications to register marks on the Principal Register, Application No. 76567273 for the mark LEGALEDGE in standard-character form and Application No. 76567272 for the mark LEGALEDGE SOFTWARE in the form shown here.

¹ Because the appeals involve common issues we will address both appeals in one opinion.

LegalEdge

SOFTWARE

In both applications applicant identifies its goods as "computer software product sold to corporate and government legal departments for criminal case and civil matter management for the customer's internal use" in International Class 9. In Application Ser. No. 76567273 applicant claims both first use of the mark anywhere and first use of the mark in commerce on October 1, 2003. In Application Ser. No. 76567272, applicant asserts its intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), as the basis for registration, and applicant disclaims the word "SOFTWARE."

In both applications, the Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark GRAYCARY TECHNOLOGY'S LEGAL EDGE in standard-character form in Reg. No. 2806382 on the Principal Register for services identified as "providing and (sic) online database containing legal document forms; application service provider featuring software that allows

the online exchange of information, documents, emails, task lists, calendar and databases" in International Class 42. The cited registration issued on January 20, 2004. The registration specifies a date of first use anywhere and a date of first use in commerce in March 2000. The registration includes a disclaimer of "LEGAL."

Applicant argued against the refusals; the Examining Attorney made the refusals final; and applicant appealed. Applicant and the Examining Attorney filed briefs and took part in an oral hearing.

We reverse the refusals in both applications.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to be considered in determining likelihood of confusion.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. Palm Bay Imports Inc. v. Veuve

Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that the marks differ for a number of reasons. First applicant argues that GRAYCARY is the dominant feature of the mark because it is arbitrary and because "... it makes sense to consider 'GRAYCARY' as the source indicating feature of the mark since that part of the mark does in fact indicate the source of Registrant's services, which is the law firm of Gray Cary Ware & Freidenrich, LLP." Applicant's brief at 10. Applicant also notes that "LEGAL" is disclaimed in the registration, and applicant argues that the words "TECHNOLOGY'S LEGAL EDGE" form a descriptive phrase.² Applicant states, "The mark connotes that "Gray Cary" is technology's legal edge.'" Applicant's brief at 7 (emphasis in the original). Applicant argues more generally that the marks differ as to appearance, sound, connotation and commercial impression. The Examining Attorney disagrees and argues that the marks are confusingly similar because they include the common elements LEGAL and EDGE.

² Here applicant asks us to consider materials regarding Gray Cary, including other marks it has registered and the services it offers under those marks. We decline to consider this extrinsic evidence in evaluating how registrant's mark in this case would be perceived. It is beyond the scope of what we may consider. Cf. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986).

In comparing the marks, the threshold issue is whether, as used in the cited mark, GRAYCARY would be perceived as a house mark and TECHNOLOGY'S LEGAL EDGE would be perceived as a product mark.

First, we recognize that there is no per se rule regarding the effect of a house mark or trade name in determining likelihood of confusion. See New England Fish Co. v. The Hervin Co., 511 F.2d 562, 184 USPQ 817 (CCPA 1975). See also Knight Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313, 1315 (TTAB 2005) and cases cited therein. We also note that the Board has held that there is no real difference between cases where the allegedly distinguishing house mark appears in the cited mark rather than the applicant's mark. In re Champion International Corp., 196 USPQ 48, 49 (TTAB 1977). Furthermore, we note the line of "house-mark" cases where the marks were found not to be similar because "... there are some recognizable differences in the asserted conflicting product marks or the product marks in question are highly suggestive or play upon commonly used or registered terms..." Id. (citations omitted).

In this case, applicant argues that TECHNOLOGY'S LEGAL EDGE would be perceived as a slogan, and that LEGAL EDGE, as used in this mark, would not be perceived as an

independent source-identifying product mark. We agree with applicant. That is, we conclude that relevant purchasers would perceive GRAYCARY as a house mark or company name and TECHNOLOGY'S LEGAL EDGE as a slogan referring to the GRAYCARY company name or trade name. GRAYCARY is the dominant element in the cited mark. Moreover, the cited mark, when viewed in its entirety, conveys the impression of the house mark, GRAYCARY, combined with a slogan emphasizing the advantages of technology -- commercial impressions that are absent from applicant's mark. Therefore, when we view the marks as a whole, along with other factors, we conclude that GRAYCARY TECHNOLOGY'S LEGAL EDGE is not confusingly similar to LEGALEDGE or LEGALEDGE SOFTWARE.

In reaching this conclusion, we reject applicant's argument that its display of LEGALEDGE in both of its marks without a space, or the inclusion of the word SOFTWARE in one of its marks, would distinguish its marks from the registered mark. Furthermore, we reject applicant's argument that the disclaimer in the registration somehow distinguishes the marks. The existence of the disclaimer has no bearing on how relevant purchasers will perceive the registered mark. Norton Co. v. Talbert, 202 USPQ 542, 544

(TTAB 1979). Cf. Marriott Corp. v. Fairmont Foods Co., 171 USPQ 58, 63 (TTAB 1971).

Purchaser Sophistication

Applicant also argues that there is no likelihood of confusion because the purchasers of its goods are sophisticated. Applicant argues that its products are expensive, and applicant argues further, "The goods of Applicant are sold to careful, sophisticated buyers. The decision to purchase Applicant's goods is carefully made by corporate and government legal departments and is well thought out." Applicant's brief at 9. Applicant also argues that registrant's services, too, are purchased by careful, sophisticated purchasers. The Examining Attorney disagrees and notes that even sophisticated purchasers are not immune from trademark confusion, citing In re Decombe, 9 USPQ2d 1812 (TTAB 1988) and In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983).

We conclude that the applicant's goods, as identified in the application, are specialized and more expensive than goods which would be purchased on impulse. Furthermore, we conclude that the purchasers, legal professionals, are relatively sophisticated.

Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers favors a finding of no likelihood of confusion.

The Goods and Services

We conclude here that applicant's goods and the services identified in the cited registration, though different in some respects, are related. However, overall we conclude that there is not a likelihood of confusion because the differences between the marks and the sophistication of the potential purchasers outweighs the similarity in the goods and services. Therefore, our discussion of the goods and services must be viewed in that broader context.

The goods and services of applicant and registrant need not be identical to find a likelihood of confusion under Trademark Act Section 2(d). The goods and services need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods and services originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and services, and the channels of trade for the goods and services, we must

consider the goods and services as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Applicant argues that its goods and registrant's services are sufficiently different to preclude confusion. Applicant states, "... Applicant's mark is for goods while the cited registration is for services." Applicant's brief at 3. Applicant also places great emphasis on its allegation that the registrant is a law firm. Applicant argues further that, unlike the registrant, it does not provide any type of online database service or fee-based service.

The Examining Attorney argues, "The Applicant's goods are computer software for use in the legal field and Registrant's services are computer services relating to the legal field. Thus, they are CLEARLY related." Examining Attorney's brief at unnumbered page 6 (emphasis in the original). The Examining Attorney also argues that the goods and services at issue could serve similar purposes.

To support her position, the Examining Attorney has submitted third-party registrations which cover both the type of goods in the application and the type of services

Ser No. 76567272

in the cited registration. For example, those registrations include:

Reg. No. 3033313 for the mark THE NEXT GENERATION IN LEGAL SOFTWARE for goods including "computer software, namely, software for managing attorney dockets by creating reminders to notify users of impending work project deadlines for use in law firms and instruction manuals sold as a unit therewith" in International Class 9 and for services including "design for others of computer software for use in law firms" in International Class 42; and

Reg. No. 3040507 for the mark WHERE EVERY CASE IS A PRIORITY for goods including "computer software for use in the legal field featuring litigation management, insurance claim management and insurance claim processing" in International Class 9 and for services including "providing temporary use of non-downloadable web-based computer software for use in the legal field featuring litigation management, insurance claim management and insurance claim processing" in International Class 42.

First, we cannot consider extrinsic material, such as applicant's arguments and evidence that the registrant is a law firm engaged primarily in the rendering of legal services. In re Bercut-Vandervoort & Co., 229 USPQ at 764.

Also, we reject applicant's overly broad arguments that goods are unrelated to services. See MSI Data Corp. v. Microprocessor Systems, Inc., 220 USPQ 655, 658 (TTAB 1983); Corinthian Broadcasting Corp. v. Nippon Electric Co., Ltd., 219 USPQ 733 (TTAB 1983). Rather, we must look to the identifications of goods and services and the

relevant probative evidence to determine whether the goods and services are related.

The third-party registrations referenced above, and the others submitted by the examining attorney, suggest that the types of goods and services of applicant and registrant may emanate from the same source under the same mark. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Accordingly, we conclude that the goods and services of applicant and registrant, though different in some respects, are related.

Actual Confusion

Applicant argues briefly that there has been no actual confusion between its marks and the mark of the registrant. We do not consider this factor to be significant in this case. First, there is no evidence of the extent to which there has been an opportunity for confusion. More importantly, in an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Other Arguments

Applicant has also argued that we should permit registration of its marks because its predecessor owned registrations, which have lapsed, for the LEGALEDGE marks which coexisted for a time with the cited registered mark. This Board has generally rejected the premise that evidence that similar marks previously "coexisted" on the register precludes a refusal which is otherwise proper. We must consider the refusals before us on the merits without regard to actions taken by examining attorneys in other applications. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); See also In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994). Therefore, we reject this argument.

Conclusion

In conclusion, based on all evidence of record in these appeals bearing on the du Pont factors, we find that there is no likelihood of confusion between applicant's LEGALEDGE and LEGALEDGE SOFTWARE marks and the cited GRAYCARY TECHNOLOGY'S LEGAL EDGE mark. We conclude so principally due to the differences between the marks and the sophistication of the purchasers of applicant's goods.

Decision: In each application, the refusal to register under Trademark Act Section 2(d) is reversed.