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THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cornerstone OnDemand, Inc.

Serial No. 76617152

Jill Pietrini of Manatt, Phelps & Phillips for Cornerstone
OnDemand, Inc.

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Office 102 (Thomas V. Shaw, Managing Attorney).

Before Walters, Mermelstein and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Cornerstone OnDemand, Inc. has filed an application to register the mark CORNERSTONE, in standard character form, on the Principal Register for "computer software for managing human capital, designing, developing, and providing professional education, professional development, corporate training and executive education, and tracking and

evaluating the completion and progression of such education and training," in International Class 9.¹

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark CORNERSTONE, previously registered for "computer programs and instruction manuals sold as a unit,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

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 E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65

¹ Serial No. 76617152, filed October 21, 2004, based on use of the mark in commerce, alleging first use and use in commerce as of November 8, 2003.

² Registration No. 1511566 issued November 8, 1988 and is now owned by IDEXX Laboratories, Inc. Registrant's declarations under Sections 8 and 15 of the Trademark Act have been accepted and acknowledged, respectively.

USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Regarding, first, the marks, there is no question that the marks are identical and applicant does not claim otherwise. Rather, applicant contends that CORNERSTONE is a weak mark and that its goods are entirely different from the goods in the cited registration.

In support of its position that CORNERSTONE is a weak mark, applicant submitted excerpts from fourteen different websites, thirteen³ of which used the term CORNERSTONE in connection with software and related goods and services. Applicant also submitted copies of eleven different third-party registrations for the mark CORNERSTONE, all of which identify goods unrelated to those involved herein; one third-party registration for the mark CORNERSTONE for

³ One website used the term in connection with the unrelated service of online printing. At least two websites included terms in addition to CORNERSTONE as a mark or company name.

software in the telecommunications industry; and copies of different third-party registrations for CORNERSTONE LOGIC and ANALYTICAL CORNERSTONE, both for software related goods and services in different fields (aviation and pulp and paper industries, respectively).⁴

The examining attorney argues that, even if applicant has established that CORNERSTONE is a weak mark, the registered mark cited herein is entitled to protection; and that, even if consumers can distinguish among similar marks including the term CORNERSTONE, this case involves identical marks.

We agree with applicant that the evidence presented establishes that CORNERSTONE is a term widely used and registered, both among a broad spectrum of goods and services and within the computer field. Thus, we find that CORNERSTONE is a weak mark. Nevertheless, even if CORNERSTONE is a weak mark, it is still entitled to protection against the same or similar mark for closely related goods. *Matsushita Electrical Industrial Co. Ltd. v. National Steel Construction Co.*, 442 F.2d 1383, 170 USPQ 98 (CCPA 1971); *King Kup Candies Inc. v. King Candy Co.*, 288 F.2d 944, 129 USPQ 272 (CCPA 1961).

⁴ Applicant submitted a list of registrations and applications which is of little probative value. The applications are evidence only of their filing and the list includes only marks and registration numbers.

Turning to consider the goods, of particular importance in this case is the precedent that requires the Board to determine the question of likelihood of confusion based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule 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 some 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 therewith, 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 parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

In support of its position that the goods are entirely different, applicant submitted an excerpt from registrant's website indicating that registrant uses its mark to identify software for managing a practice in the field of veterinary medicine. The examining attorney argues that, as the USPTO is bound by the identification of goods as it is written in the cited registration, we must determine that the goods are the same or closely related.

While it would appear from the evidence of registrant's website that registrant's goods identified by the mark CORNERSTONE may, in fact, be limited at this time to the field of veterinary medicine, the examining attorney correctly noted that we cannot read limitations into the registration so that the identified goods are limited to the goods on which registrant is currently using the mark. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Therefore, we must assume that registrant is using its mark on all types of computer programs and manuals therefor. Registrant's broadly worded identification of goods encompasses software

in the areas identified in the application and, thus, we must conclude that the goods are closely related.

The examining attorney cited the relevant decision of the Board in *In re N.A.D., Inc.*, 57 USPQ2d 1872 (TTAB 2000).

The Board made the following statement in that decision:

Registrant's goods are broadly identified as computer programs recorded on tapes or disks, without any limitation as to the kind of programs or the field of use. Accordingly, we must assume that registrant's goods encompass all such computer programs including those which may be intended for the medical field. As such, they may travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) and cases cited therein. When the goods are so viewed, we believe that confusion is likely. . . . While we are sympathetic to applicant's concern about the scope of protection being given to the cited registrations, applicant is not without remedies in its attempt to obtain a registration. Applicant may, of course, seek a consent from the owner of the cited registrations, or applicant may seek a restriction under Section 18 of the Trademark Act, 15 USC §1068. This remedy is available for those who believe that a restriction in the cited registration(s) may serve to avoid a likelihood of confusion. See *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994).

Applicant urges the Board to follow the precedent in *Local Trademark, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) and *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986); however, we find these decisions to be inapposite. The *Local Trademark* case involved substantially similar marks in connection with opposer's advertising services to plumbers, the subject of a

registration, and applicant's liquid drain opener. In dismissing the opposition, the Board noted that the marks are weak and concluded that, as the goods and services are identified in opposer's registration and in the opposed application, "even though opposer's services and applicant's product are or can be marketed to the same class of customers, namely plumbing contractors, these services and goods are so different that confusion is not likely even if they are marketed under the same mark." (Id. at 1158.) In the *Quartz Radiation* case, the Board drew the following conclusion with respect to the respective goods as identified in opposer's registration and the opposed registration:

Although the marks are virtually the same [QR], the products with which applicant uses its mark are quite different from the products of opposer. They are different in nature; they are used for different purposes; they are promoted differently and are purchased by different discriminating purchasers.

(Id. at 1669.) Unlike either of these cases, the goods involved in the present case are very closely related and, as identified in the respective registration and application, directed to all of the same purchasers for such goods through the same normal channels of trade for these goods.

Therefore, we conclude that in view of the identity of applicant's mark, CORNERSTONE, with the registered mark,

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their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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