

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ab Initio Software Corporation

Serial No. 78118147

Barbara A. Barakat of Wilmer Cutler Pickering Hale and Dorr LLP for Ab Initio Software Corp.

Jason Turner, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Quinn and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On March 28, 2002, Ab Initio Software Corporation (applicant) filed an intent-to-use application to register ENTERPRISE METADATA ENVIRONMENT on the Principal Register, in standard character form, for:

Computer programs for the management and maintenance of a data processing repository for large volumes of data, application programs, and application program execution results; computer programs for communication and processing data among multiple computer systems and operating systems; data processing computer programs for processing large volumes of data, in International Class 9.

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Applicant has disclaimed "METADATA" even though the examining attorney did not require it to do so.

The examining attorney refused registration under Section 2(d) of the Act, 15 U.S.C. § 1052(d), in view of two prior registrations, both for the mark METADATA in standard character form, and both now owned by Metadata Corporation: Registration No. 1409260 for "computer programs" in International Class 9, issued September 16, 1986, and Registration No. 2185504 for "manuals for use with a computerized data manipulative program to create, modify, display, and print record management files" in International Class 16, issued September 1, 1998. The registrant has maintained both registrations to date. Applicant responded to the refusal; the examining attorney made the refusal final; and applicant appealed. For the reasons stated below, we reverse.

Section 2(d) of the 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 . . ." Id.

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 we may consider in determining likelihood of

confusion. We must decide the issue case by case, and one factor may play a dominant role in a particular case. In re E.I. du Pont de Nemours & Co., 177 USPQ at 567. We discuss below the factors relevant here, most importantly, the marks, the goods, the strength of registrant's mark and the sophistication of the purchasers of applicant's goods.

At the outset, we note that registrant's Class 9 goods were identified simply as "computer programs" at a time when such a broad identification was considered acceptable. As noted, the registration issued in 1986. Applicant's identification of its Class 9 goods reflects the specificity now required for such goods. The examining attorney correctly points out that we must construe the goods in the cited Class 9 registration broadly. That is, in the absence of explicit restrictions we must presume that the registration covers all goods of the type described, that those goods travel in all trade channels typical for those goods, and that the goods are available to all typical classes of purchasers for those goods. 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). Accordingly, for the purpose of our determination here, we presume that registrant's goods could encompass

any computer program, including the more specific types identified in the application.

With regard to the strength of registrant's mark, we note applicant's argument that METADATA is a merely descriptive or generic term. However, as the examining attorney points out, we must accord the registered METADATA mark the presumptions which apply to any registration under Section 7 of the Trademark Act, 15 U.S.C. § 1057. Most importantly, we are mindful of the presumption that the registered mark is valid and the presumption of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods specified in the certificate. Id. We are also mindful that we may not entertain a collateral attack on a registration in an ex parte proceeding. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). On the other hand, in our consideration of likelihood of confusion, the du Pont case dictates that we take into account any evidence bearing on the strength of the registered mark.

The evidence of record in this case supports applicant's contention that METADATA is a weak mark. Applicant has provided examples of third-party use of METADATA on Internet web pages. For example, a page at www.asg.com includes the heading "Metadata Repository" and

states, "ASG's metadata repositories are significantly different from others in the market." Another example from www.census.gov, apparently associated with the U.S. Census Bureau, includes the heading "Providing Document Retrieval Through a Metadata Repository at the Census Bureau" and states, "Significant research and development has been accomplished toward developing a logically central repository that organizes statistical metadata."

Based on this and other evidence, applicant argues that "metadata" is a well known descriptive term in the computer field. In the early prosecution of the application the examining attorney had also refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1051(e)(1), on the ground that the entire mark, ENTERPRISE METADATA ENVIRONMENT, was merely descriptive of the goods. In support of that refusal, which was later withdrawn, the examining attorney stated, "'Metadata' is defined by Webopedia.com as 'data about data,' - it describes how and when and by whom a particular set of data was collected." The examining attorney also provided selected results from a Nexis® search including the following excerpt from a 1999 [Journal of Commerce](#) article, "The July-August issue features articles on integrating with Peoplesoft, working with message brokers and

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developing an enterprise metadata plan as well as a link to fatbrain.com for related books on software integration."

Applicant has also made of record two registrations owned by parties other than the owner of the cited registrations for marks which include METADATA, both for computer programs:

Reg. No. 2686624 for METAGETTER - AUTOMATED METADATA EXTRACTION for "computer software for the extraction of descriptive file header (IPTC) information from any file as delimited text, XML or import into ODBC database" with a disclaimer of "AUTOMATED METADATA EXTRACTION"; and

Reg. No. 2801335¹ for END TO END METADATA MANAGEMENT AND ANALYTICS for "software for providing information about computer system environment" with a disclaimer of "METADATA MANAGEMENT AND ANALYTICS."

Applicant also provided copies of six registrations in which "metadata" was used as a term in the identification of Class 9 goods.

In view of the presumptions accorded to a registration noted above, we reject applicant's argument that METADATA is either merely descriptive or generic. Nonetheless, the totality of the evidence in this record presented by both applicant and the examining attorney dictates the

¹ In his appeal brief the examining attorney objected to applicant's inclusion, in its brief, of the full information with regard to this registration. However, applicant had identified and discussed the registration previously and, although the examining attorney had the opportunity to do so, he did not previously object to the evidence as to form or otherwise. Accordingly, we have considered this evidence.

conclusion that "METADATA" is a highly suggestive term for computer programs and that the cited registration is entitled to a limited scope of protection. In concluding so, we have totally discounted the disclaimer of "metadata" applicant volunteered, as well as the disclaimers of "metadata" in the third-party registrations.

Turning to our consideration of the marks overall, to determine whether the marks are confusingly similar we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Both marks include the term METADATA. However, the fact that both marks have this term in common is not a sufficient basis for us to conclude that the marks are confusingly similar. As stated above, this term is highly suggestive. The additional words ENTERPRISE and ENVIRONMENT in applicant's mark are sufficient to distinguish it from the cited mark. We conclude so because the cited mark, METADATA, is entitled to a limited scope of protection. The presence of ENTERPRISE at the beginning of applicant's mark and ENVIRONMENT at the end are, because of their positions, more noticeable than the highly suggestive term METADATA. As a result we find that the marks differ

in appearance, sound, connotation and commercial impression. Accordingly, we conclude that applicant's mark and the cited mark are not similar.

The other du Pont factor relevant here is the sophistication of the purchasers of the goods. In its brief applicant argues that the products identified in its application "would be selected and purchased carefully, after much scrutiny" due to their "expense and sophistication." We note, in particular, that applicant has represented that, "a minimum sale is in excess of \$200,000 and normally involves months of product testing and evaluation by the customer."² On these facts, applicant urges that the personnel charged with the purchase of such products are sophisticated.

We must consider the goods as they are identified in the application, and not necessarily as they are sold by applicant. In view of the identification of goods, we conclude that sophisticated individuals, not the general consuming public, would be the purchasers of goods of the type identified in the application. We conclude further that the sophistication of the purchasers of the goods identified in the application would diminish, if not preclude, any likelihood of confusion.

In summary, we conclude that there is not a likelihood of confusion between applicant's mark and the cited mark based on the totality of the evidence in this case. We conclude so principally on the basis of the cumulative impact of the weakness of registrant's mark, the differences between applicant's mark and the cited mark, and the sophistication of the purchasers of applicant's goods.

Decision: The refusal to register applicant's mark on the ground of a likelihood of confusion is reversed.

² Applicant's September 30, 2004 response, at page 4.