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Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calcium Software Limited

Serial No. 78377250

Request for Reconsideration

Edward J. Chalfie of Ladas & Parry for Calcium Software Limited.

Florentina Blandu, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Zervas, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On September 25, 2006, applicant filed a combined request for reconsideration of our final decision mailed on August 25, 2006, and request for suspension of proceedings. In our final decision, we affirmed the examining attorney's refusal to register applicant's MAILPRIMER mark for "[m]ultimedia messaging software; computer software for the

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writing, sending, storage, processing, control, organization and/or management of email and other forms of communication" under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark PRIMER.

At p. 4 of the final decision, we stated "the connotation and commercial impression of applicant's mark taken as a whole is that applicant's PRIMER software is intended to be used in connection with mail." Applicant has challenged this statement, and maintains that "[s]ince applicant's mark is the unitary term MAILPRIMER, not PRIMER, the Board's error in identifying applicant's mark as PRIMER will [sic] was prejudicial to applicant's rights to [sic], denying it a fair opportunity to argue that the two trademarks present significantly different commercial impressions"; "the Board failed to give proper weight to applicant's mark as a whole when comparing it to the mark in the cited registration"; and "the Board erred in stating that the similarities in meaning and commercial impression outweigh the differences in the respective trademarks." Request for reconsideration at pp. 1 - 2.

The passage from our decision that applicant challenges discusses the connotation and commercial impression of applicant's mark in view of its two

components, MAIL and PRIMER, with MAIL at a minimum being a descriptive term. Thus, the Board did not identify applicant's mark as PRIMER; it identified the commercial impression and meaning of the mark in view of the descriptiveness, "at a minimum," of the MAIL component of the mark. Final decision at p. 4. Thus, we find no error in the Board's statement.

Further, applicant's contention that we did not give proper weight to applicant's mark as a whole when comparing applicant's mark to the cited mark is not well taken. At p. 5 of our decision, we stated that "when the marks are considered as a whole, the similarities in meaning and commercial impression outweigh [the] differences", and that "the marks are more similar than dissimilar when considered in their entireties." Thus, we find no error in our consideration of the marks.

Applicant also maintains that we erred in considering the examining attorney's evidence from the www.answyr.com web site because the web site is not actually on www.answyr.com; what actually occurs is that the user is directed to another web site, i.e., www.globalgraphics.com, and that "[t]here is no mention on that web page of the trademark PRIMER, other than the page's title 'PDF viewer for Palm, Pocket PC and Windows CE (Formerly Answyr PDF

Primer).'" Applicant should have challenged the examining attorney's evidence at the time the examining attorney submitted the evidence, not over a year after its submission. By not objecting to the evidence at the time of its submission, we consider applicant to have waived any objection thereto. Further, applicant's submission of the www.globalgraphics.com web page is entirely improper - the Board will not consider new evidence submitted for the first time with a request for reconsideration of a final decision. The record on an appeal should be complete prior to the filing of an appeal. Trademark Rule 2.142(d). See also, TBMP § 1207.01 (2d ed. rev. 2004).

Applicant also contends that more than five years have passed since the registration of the PRIMER mark on September 25, 2001; and requests that "upon reconsideration or re-opening of this ex parte appeal," the Board suspend proceedings pending the cancellation of the cited registration. Applicant cites to TBMP § 1213 in support of its request.

Because the fifth anniversary of the cited registration did not occur until one month after we issued our final opinion, it appears that applicant's strategy in filing its request for reconsideration - which, as discussed above, is without merit - is to extend the

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duration of this case so as to take advantage of Board practice regarding requests for suspension of cases in which the only issue is a Section 2(d) refusal, as discussed in TBMP §1213 (2d ed. rev. 2004). Section 1213 makes clear, however, that the request for suspension must be filed prior to the issuance of the final decision. Because the final decision has been issued, we will not grant applicant's request for suspension.

In view of the foregoing, opposer's request for reconsideration of the Board's decision and its request for suspension are denied, and the Board's August 25, 2006 decision stands.

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