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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re L-3 Communications Titan Corporation

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Serial No. 78479699

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LLP for L-3 Communications Titan Corporation.

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Office 104 (Chris Doninger, Managing Attorney).

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Before Drost, Kuhlke, and Bergsman, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 7, 2004, L-3 Communications Titan  
Corporation<sup>1</sup> (applicant) applied to register the mark  
INSYTE, in standard character form, on the Principal  
Register, for the following goods: "Video asset management  
software program to capture, display, annotate, store,  
transmit, and retrieve video data, and create derivative  
video data, locally and across networks" in Class 9.

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<sup>1</sup> The application was originally filed by the Titan Corporation  
but on November 9, 2005, a document indicating that the original  
applicant had merged into the present entity was filed.  
Reel/Frame No. 3191/0806.

**Ser. No. 78479699**

The application (Serial No. 78479699) contains an allegation of applicant's bona fide intention to use the mark in commerce.

The examining attorney<sup>2</sup> has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of Registration No. 1,061,149 (issued March 15, 1977, second renewal) for the identical mark INSYTE, in typed form, for "computer programs recorded on magnetic media or discs" in Class 9 and "computer programming reference manuals" in Class 16. The examining attorney argues that the marks are identical and that registrant's "broadly stated 'computer programs recorded on magnetic tapes on discs' in the Class 9 identification of goods in the cited registration is presumed to include the more narrowly stated identification of 'video asset management software program ...' in Class 9 in the instant application." Brief at unnumbered p. 4.

Applicant argues that its INSYTE products will be used in connection with "aircraft operational software as well as weapon system, mission planning, and tactical simulation/stimulation technology." Brief at 3. Applicant maintains that registrant "provides software that functions

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<sup>2</sup> The current examining attorney was not the original examining attorney in this case.

as a 'reporting tool,' and which is used in the Unisys computer environment and designed for end-users and programmers." Brief at 5.

Inasmuch as the issue in this case is likelihood of confusion, we look at the evidence in light of the factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We point out that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider concerns the similarities or dissimilarities of the marks. Here, this factor is straightforward because the marks are identical. There are no differences inasmuch as the wording in the marks is the same, INSYTE, and the marks are depicted in typed or standard character form. This factor strongly favors the examining attorney's position. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[W]hen goods or services are not competitive or intrinsically

related, the use of identical marks can lead to an assumption that there is a common source").

We now look at the next factor, which involves our consideration of the relationship between applicant's and registrant's goods. Registrant's goods are identified as "computer programs recorded on magnetic media or discs" and "computer programming reference manuals." Applicant's computer software program is specifically limited to video asset management software program to capture, display, annotate, store, transmit, and retrieve video data, and create derivative video data, locally and across networks. Applicant has included evidence that shows the goods on which applicant and registrant apparently use their marks.

However, when we address the question of whether goods are related, we must compare the goods as they are described in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the

sales of goods are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods") and In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark as applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be").

The essential question here is whether applicant's broadly defined computer programs encompass applicant's specifically described software program.<sup>3</sup> The board has previously addressed the question of how to interpret broad, computer-related identifications of goods.

Registrant's goods are broadly identified as computer programs recorded on magnetic disks, without any

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<sup>3</sup> "Software" is defined as "the programs used to direct the operation of a computer, as well as the documentation giving instructions on how to use them." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant's goods encompass all such computer programs including those which are for data integration and transfer. We must also assume that they would travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods. In re Elbaum, 211 USPQ 639 (TTAB 1981). So viewed, we agree with the Examining Attorney that registrant's goods encompass applicant's computer programs.

In re Linkvest S.A., 24 USPQ2d 1716, 1716 (TTAB 1992). See also In re N.A.D. Inc., 57 USPQ2d 1872, 1874 (TTAB 2000)

("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").

Because registrant's identification of goods contains no limitations, we are not permitted to read limitations into this identification of goods. 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"). Inasmuch as there are no limitations in registrant's identification of goods, we must assume that

registrant's computer programs include video asset management computer programs to capture, display, annotate, store, transmit, and retrieve video data, and create derivative video data, locally and across networks. Similarly, we add that registrant's computer programming reference manuals are related because we must also assume that these manuals involve video asset management computer programming reference manuals.

Furthermore, because of the identical or otherwise highly related nature of the goods, we must assume that the channels of trade and purchasers are the same. Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Applicant also argues that "Registrant's identification of goods is overly broad and would no longer constitute an acceptable identification." Brief at 5. While these broad

identifications of goods are no longer accepted by the Office (TMEP § 1402.03(d) (4<sup>th</sup> ed. April 2005), they were routinely accepted by the Office when the application for the cited registration was filed in 1975 and issued in 1977. Therefore, as the board in Linkvest and N.A.D. indicated, we must consider the goods to be as broad as they are described in the registration's identification of goods.

The board has discussed the options that an applicant has when it is faced with a cited registration that contains a broad identification of goods for computer programs.

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 U.S.C. § 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). Compare Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992) (no likelihood of confusion between specifically identified computer services and programs in different fields—computer data processing programming/information management services and computer programs for electrical distribution system analysis and design).

N.A.D., 57 USPQ2d at 1874.

Section 18 (15 U.S.C. § 1068) specifically permits the Office in opposition and cancellation proceedings to

"modify the application or registration by limiting the goods or services specified therein."

Applicant also refers to the fact that there have been "no instances of actual confusion." Request for Reconsideration at 11. However, its application is based on its intent to use and even applicant admits that its use "in interstate commerce began very recently." Brief at 4. This unsupported statement hardly demonstrates that there has been a significant opportunity for confusion to occur. Furthermore, the "lack of evidence of actual confusion carries little weight." In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

We conclude that applicant's and registrant's marks are identical. Registrant's broadly described computer programs recorded on magnetic media and discs would overlap and include applicant's video asset management software programs. Furthermore, because of the overlapping nature of the goods, we must also assume that the purchasers and channels of trade are the same. Even highly sophisticated purchasers would likely be confused if the same mark were used on these overlapping goods and highly related goods. Under these circumstances, we must assume that confusion is likely.

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Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.