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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pure Networks, Inc.

Serial No. 78516218

David A. Lowe of Black Lowe & Graham PLLC for Pure Networks, Inc.

Evelyn Bradley, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Grendel and Holtzman, Administrative Trademark Judges.

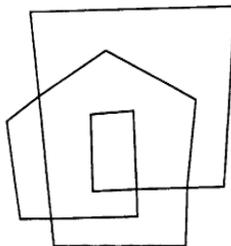
Opinion by Hairston, Administrative Trademark Judge:

Pure Networks, Inc. has filed an application to register the mark shown below for "computer software for connecting computer network users" in International Class 9; and "computer consultation, technical consultation in the field of design and networking of personal computers, technical support services, namely, troubleshooting of computer hardware and software problems, computer network design for others, computer programming for others, and

computer services, namely creating indexes of information, sites and other resources available on computer networks" in International Class 42.¹



The trademark examining attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with the identified goods and services, so resembles the mark shown below, which is registered for "computer services, namely, designing, creating and hosting web sites for others" in International Class 42,² as to be likely to cause confusion, mistake or deception.



¹ Application Serial No. 78516218, filed November 12, 2004, alleging first use anywhere on January 15, 2004 and first use in commerce on February 27, 2004.

² Registration No. 2800679 issued December 30, 2003. This registration also covers services in International Classes 35 and 36, but it is clear that the examining attorney is not asserting a likelihood of confusion with the services in these classes.

Applicant has appealed. Applicant and the examining attorney have filed briefs.

With respect to the marks, the examining attorney argues that the designs are similar because applicant's mark consists of a "quadrilateral-like shape forming a shaded stylized house" and registrant's mark consists of a "quadrilateral-like shape forming a stylized house." (Brief at 4). Further, the examining attorney argues that "the respective goods and services are indeed similar and are all computer-related." (Brief at 6). In support of the refusal, the examining attorney submitted copies of seven use-based third-party registrations of marks that the examining attorney maintains cover computer consultation services, computer network design services, and the services of designing and hosting websites. In addition, the examining attorney made of record the webpages of five companies. According to the examining attorney, the webpages show "that computer software and computer services such as designing and hosting websites of others, computer consultation, and computer network design, are the kinds of goods and services that are likely to emanate from a single source." (Brief at 6).

Applicant, in urging reversal of the refusal to register, maintains that the marks are not similar, and

that it is not enough that the marks have an overall quadrilateral-like shape, as argued by the examining attorney. Further, applicant argues that there is no *per se* rule that all computer goods and services are related for purposes of likelihood of confusion, and that the involved computer goods and services are not related and are not offered in the same channels of trade.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We consider first the similarity of the goods and services. It is settled that the question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in applicant's application

vis-à-vis the goods and/or services recited in the registration, and not in light of what such goods and services are asserted to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1980); Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 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 and/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 and/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 or intended to be 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 and/or services. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In considering the goods and services in this case, we acknowledge that there is no *per se* rule governing likelihood of confusion in cases involving computer goods

and services. See, e.g., *Information Resources, Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1985). As noted, the examining attorney, in support of the refusal, has introduced seven use-based third-party registrations and the webpages of five companies. Although applicant contends that the third-party registrations, in particular, are of limited probative value, the Board has stated that third-party registrations which individually cover a number of different items (and/or services) and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. In re *Albert Trostel & Sons Co.*, 29 USPQ 1783 (TTAB 1993). The registrations submitted by the examining attorney, with the pertinent services indicated, are as follows: Registration No. 2344706, COMMENTUM for computer consultation, design and development of websites for others; Registration No. 2516096, CATCH THE WORLD for computer consultation, design and development of websites; Registration No. 2793740, GEONETRIC for creating, managing and maintaining websites and computer network design for others; Registration No. 2857318, STEINBRANDING for computer network design for others and designing Internet websites for others; Registration No. 2578749, stylized letter "I" for designing and implementing websites

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for others and computer consultation in the field of network design; Registration No. 2596091, METHOD ENGINE for designing and implementing websites for others and computer consultation, namely, designing of computer networks; Registration No. 2715836, THUNDERHAWK for computer network design for others and creating and maintaining websites for others; and Registration No. 2903221, ROOTMODE for computer network design for others and creating, maintaining and hosting websites for others.

The webpages are of the following companies with the pertinent goods and services, as indicated: QA Computer Consulting, computer advice and assistance including web design and web hosting; InfiNet Computer Solutions, computer consulting services, and web site design and hosting; Miles Technologies, computer software, computer networking and website designs; United Computing Resources, network installation and website design and hosting; and GS Communications, computer software, hardware, networking and website design.

We find that Registration Nos. 2793740, 2857318, 2578749, 2596091, 2715836, and 2903221 and the webpages of Miles Technologies, United Computing Resources, and GS Communications suggest that, at the very least, applicant's Class 42 computer network design services and registrant's

services of designing, creating and hosting web sites are the types of services that emanate from a single source. Thus, this evidence provides support of the relatedness of applicant's Class 42 services and registrant's services. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 209 USPQ 986 (CCPA 1981) [likelihood of confusion may be found if there is an overlap in any item in the involved identifications of goods and/or services].

However, we are not persuaded by the evidence introduced by the examining attorney that applicant's Class 9 goods, i.e., computer software for connecting computer network users, and registrant's services of designing, creating and hosting web sites are related goods and services. None of the third-party registrations covers these goods and services and only two of the company webpages refer to computer software and web site design and hosting. In short, this limited evidence is insufficient to establish the relatedness of applicant's Class 9 computer software for connecting computer network users and registrant's services of designing, creating and hosting web sites.

Insofar as the channels of trade and classes of purchasers are concerned, applicant argues that its computer network design services are rendered in the

consumer and industrial electronic products fields whereas registrant's services of designing, creating and hosting web sites are rendered in the real estate field. However, neither applicant's nor registrant's identification is limited as to channels of trade or classes of purchasers. Thus, we must presume that applicant's computer network design services and registrant's services of designing, creating and hosting web sites of others move in all normal channels of trade for services of these types and that they are available to all potential customers. In view of the relatedness of applicant's computer network design services and registrant's services of designing, creating and hosting web sites, the customers and channels of trade for the respective services are consequently deemed to be the same.

Applicant further asserts that the conditions under which and buyers to whom sales of the services at issue are made is a factor which mitigates any likelihood of confusion. According to applicant, the target purchasers of the respective services are sophisticated and discriminating purchasers. Apart from the fact applicant has offered no support for its contention, we note that individual consumers may have need for computer network design services. Indeed, applicant has stated that its

computer network design services are offered to consumers, and applicant's specimen webpage indicates that such services are for the "home networking market." Moreover, insofar as registrant's services of designing, creating and hosting web sites are concerned, individual consumers may also avail themselves of these types of services. We have no basis on which to conclude that consumers would exercise anything more than ordinary care when selecting the respective services. Nonetheless, even assuming that purchasers of the respective services are sophisticated and discriminating purchasers, the fact that purchasers are sophisticated and knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See, e.g., *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

In view of the foregoing, we find that if applicant's computer network design services and registrant's services of designing, creating and hosting web sites are rendered under the same or similar marks, confusion as to the source of sponsorship of such services would be likely to occur.

Turning then to a consideration of the marks, inasmuch as the respective marks are design marks which cannot be

pronounced, the issue of likelihood of confusion must be decided primarily on the basis of the overall visual similarity of the marks. This essentially comes down to an "eyeball test" as explained at 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23.25 (4th ed. 2006) as follows (footnote omitted):

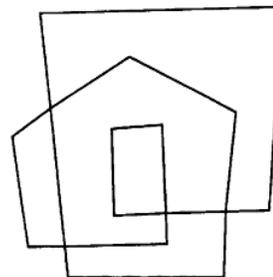
Because a picture is worth a thousand words, there is little in the way of guidelines to determine that degree of visual similarity which will cause a likelihood of confusion of buyers. Obviously, for picture and design marks (as opposed to word marks), similarity of appearance is controlling. There is no point in launching into a long analysis of the judicial pros and cons regarding visual similarity of marks. Regarding visual similarity, all one can say is 'I know it when I see it.'

Thus, the similarity of design marks is determined by considering the overall impression created by the marks as a whole rather than by simply comparing individual features of the marks. Applicant's and registrant's design marks are reproduced below:

Applicant's mark



Registrant's mark



In comparing applicant's mark with registrant's mark in their entireties, we are of the view that the overall commercial impression created by applicant's mark when compared with registrant's mark is very similar. Both marks consist of a pentagonal or house-like design connected to and surrounded by a quadrilateral-like design.

While there are specific differences in the marks (e.g., applicant's mark includes shading within the pentagonal or house-like design and a pronounced roof design), these differences are not likely to be recalled by purchasers seeing the marks at different times. Under actual marketing conditions, consumers do not have the luxury of side-by-side comparison of the marks, and further, we must consider the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks encountered. Thus, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973).

Viewing the involved marks in this light, it is obvious that there are marked resemblances in the overall design format and commercial impression thereof. In reaching our decision herein, we have not overlooked

applicant's contention that this case is similar to Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404 (TTAB 1988) where the Board held that the use of a pentagonal design mark for real estate property management services was not likely to cause confusion with another pentagonal design mark for real estate brokerage services. The Board found that the respective pentagonal design marks created different visual impressions, and that pentagonal design marks, which may be perceived as a design of a house, are suggestive of services in the real estate field.

The present case is distinguishable because applicant's and registrant's marks create visually similar impressions and are not simply pentagonal designs, and there is no evidence to indicate that pentagonal designs are suggestive of goods and/or services in the computer field.

Accordingly, we conclude that purchasers and prospective customers familiar with registrant's design mark for computer services, namely, designing, creating and hosting web sites for others, would be likely to believe, upon encountering applicant's design mark for computer network design services, that such services emanate from or

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are otherwise associated with or sponsored by the same source.

However, we are not persuaded by the record in this case that confusion is likely with respect to registrant's services and applicant's computer software for connecting computer network users.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to the services in International Class 42 and reversed as to the goods in International Class 9.