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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Soquel Technologies, LLC

Serial No. 78573472

Soquel Technologies, LLC, *pro se*.

Margaret Power, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney)

Before Kuhlke, Taylor and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Soquel Technologies, LLC filed a use-based application for the mark TheNextIndex.com, in standard character format, for services ultimately identified as "online publication of magazines in the field of financial and business analysis via a multi-user global computer information network," in Class 41 (Serial No. 78573472). Applicant disclaimed the exclusive right to use "index.com."

The Trademark Examining Attorney finally refused registration under Section 2(d) of the Trademark Act of

1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the marks NEXT 150 INDEX,[1] NEXT ECONOMY INDEX,[2] and NEXT PRIME INDEX[3] owned by Euronext Indices B.V., and all for the following services set forth below:

> Advertising services, namely, placing advertising for others in the field of stocks, bonds, and other financial instruments; business information, namely, providing statistical information, trade information, and market research and analysis in the field of stocks, bonds, and other financial instruments, in Class 35;
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> Brokerage services in the field of stocks, bonds, mutual funds and debt instruments; price quotations for stocks, bonds, mutual funds, commodities, and other financial instruments; financial analysis and consulting services; operation of a stock exchange; compilation, maintaining and operating a stock index, in Class 36
>
> Publication of books, magazines, periodicals, newsletters, daily lists featuring financial statistics, trade information, market research and analysis, in Class 41.

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the

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[1] Registration No. 2875950, issued August 24, 2004, under Section 44(e) of the Trademark Act of 1946, 15 U.S.C. §1126(e). Registrant disclaimed the exclusive right to use the term "150 Index."

[2] Registration No. 2763215, issued September 16, 2003, under Section 44(e) of the Trademark Act of 1946, 15 U.S.C. §1126(e). Registrant disclaimed the exclusive right to use the term "Economy Index."

[3] Registration No. 2682519, issued February 4, 2003, under Section 44(e) of the Trademark Act of 1946, 15 U.S.C. §1126(e). Registrant disclaimed the exclusive right to use the "Prime Index."

probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. <u>The similarity of the marks in their entireties in terms of appearance, sound, meaning, and connotation</u>.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6

USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.,* 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.,* 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished,* No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.,* 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106, 108 (TTAB 1975).

We begin our analysis of the marks by noting, as indicated above, that although likelihood of confusion must be determined by analyzing the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re*

National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this regard, we find that the word "Next" is the dominant part of applicant's mark TheNextIndex.com. "The" is a definite article. When it is used before a noun (*e.g.,* TheNextIndex.com), it denotes a particular person or thing.[4] In this case, "The" has no trademark significance because it functions only as a term of reference (*i.e.,* it simply emphasizes the "NextIndex"). *See In re The Place Inc.,* 76 USPQ2d 1467, 1468 (TTAB 2005) (the definite article THE is not distinctive, and it adds no source indicating significance to the mark as a whole); *In re The Computer Store, Inc.,* 211 USPQ 72, 73 (TTAB 1981) (the definite article "the" is of no consequence to the mark's registrability).

The word "Index" is descriptive when it is used in the field of financial and business analysis because it means a "statistical composite that measures changes in the economy or in financial markets, often expressed in percentage changes from a base year or from the previous month. Indexes measure the ups and downs of stock, bond, and some commodities markets, in terms of market prices and

[4] The Random House Dictionary of the English Language (Unabridged), p. 1965 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.,* 213 USPQ 594 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

weighting of companies in the index."[5] Moreover, applicant disclaimed the exclusive right to use the term "Index.com" in response to the requirement for a disclaimer because the word "index" is merely descriptive when used in connection with applicant's online publication of magazines in the field of financial and business analysis."[6] Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.,* 60 USPQ2d 1699, 1702 (TTAB 2001). *See also Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'").

The ".com" portion of applicant's mark has no trademark significance as used in applicant's mark. Top-level Internet domain names ("TLD") (*e.g.*, ".com," ".org," ".edu") function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function. The TLD typically signifies the type of entity

[5] *Bloomberg Financial Glossary* (www.bloomberg.com) attached to the September 30, 2005 Office Action.
[6] September 20, 2005 Office Action.

for whom use of the cyberspace has been reserved. For example, the TLD ".com" signifies to the public that the user of the domain name constitutes a commercial entity, ".edu" signifies an educational institution, ".biz" signifies a business, and ".net" signifies an Internet business. Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. *See In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet).

Finally, the significance of the word "Next" as the dominant element of applicant's mark is further reinforced by its location as the first word after the indefinite article "The." *See Presto Products Inc. v. Nice-Pak Products, Inc.,* 9 USPQ2d 1895, 1897 (TTAB 1988)("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America, supra* (upon encountering the marks, consumers must first notice the identical lead word).

With respect to the registered marks NEXT 150 INDEX, NEXT ECONOMY INDEX, and NEXT PRIME INDEX, we also find that the word "Next" is the dominant portion of those marks. First, the word "Next" is the first word of each mark. Second, the terms "150 Index," "Economy Index," and "Prime Index" all appear to be descriptive when used in connection with the services described in the registrations (*e.g.*, brokerage services in the field of stocks, bonds, mutual funds and debt instruments; publication of books, magazines, periodicals, newsletters, daily lists featuring financial statistics, trade information, market research and analysis; etc.). In this regard, the registrant has disclaimed the exclusive right to use the terms "150 Index," "Economy Index," and "Prime Index."

Taken as a whole, the registered marks do not have any descriptive, or suggestive, significance in connection with

financial services or market research and analysis. The word "Next" means "immediately following in time, order, importance, etc.," or the "nearest in relationship or kinship."[7] Accordingly, the registered marks are inherently strong marks.[8]

In light of this framework for analyzing the marks, applicant's mark, TheNextIndex.com, and the registered marks, NEXT 150 INDEX, NEXT ECONOMY INDEX, and NEXT PRIME INDEX, are similar in appearance, sound, meaning, and commercial impression.

B. The similarity or dissimilarity and nature of the services.

Applicant is seeking to register its mark for "online publication of magazines in the field of financial and business analysis." The registered marks are for, *inter alia,* "publication of books, magazines, periodicals, newsletters, daily lists featuring financial statistics, trade information, market research and analysis."

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified

[7] The Random House Dictionary of the English Language (Unabridged), p. 1296 (2nd ed. 1987).

[8] Applicant argued that in light of the meaning of the word "Next," and in considering the marks in their entireties, "the rather generic literal "NEXT" does not hold any more descriptive meaning than the other literals in the Registrant's marks." (Applicant's Brief, p. 2).

in the application and the cited registration. *In re Elbaum,* 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.,* 190 USPQ 47, 48 (TTAB 1976). *See also 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").

The field of financial and business analysis is broad enough to encompass the field of financial statistics, trade information, market research and analysis. In addition, registrant's publication of books, magazines, periodicals, newsletters and daily lists is not restricted in any way, and therefore it may encompass both print publications and online publications. *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"); *In re Linkvest S.A.,* 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum, supra*.

In view of the foregoing, applicant's services are related, if not identical in part, to the registrant's services.

C. The similarity or dissimilarity of likely-to-continue trade channels.

Because the services in the application and the cited registrations are, for all practical purposes, in part identical, we must presume that the channels of trade and classes of purchasers at least in part 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").

D. Balancing the factors.

In view of the fact that all of the relevant likelihood of confusion factors favor finding that there is

a likelihood of confusion and because there is no countervailing evidence that there will be no likelihood of confusion, we find that applicant's mark TheNextIndex.com, when used in connection with "online publication of magazines in the field of financial and business analysis," is likely to cause confusion with the marks NEXT 150 INDEX, NEXT ECONOMY INDEX, and NEXT PRIME INDEX, for the services described in registrant's registrations.

Decision: The refusal to register applicant's mark is affirmed.