THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Mailed:
September 11, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gary L Avant and Dana A. Avant

Serial No. 78614165

Robert N. Blackmon of Merek, Blackmon & Voorhees, LLC for Gary L. Avant and Dana A. Avant

Ray Thomas, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney)

Before Seeherman, Grendel and Cataldo, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Gary L. Avant and Dana A. Avant, joint applicants, have appealed from the final refusal of the Trademark Examining Attorney to register WISDOM MATRIX in standard character format, with MATRIX disclaimed, for the following services, all in Class 42:

> designing, implementing and maintaining world wide web sites, world wide web applications, and world wide web e-commerce systems for others; computer programming for others; computer

> software development, namely writing and updating of data processing and data management programs for others; consulting services in the field of utilization of computer networks and databases for business and commercial purposes; consulting and computer software design for others in the field of workflow automation; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; installation, maintenance and repair of computer software.[1]

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicants' mark, if used in connection with their identified services, so resembles the mark WISDOM, previously registered for the following goods and services, that it is likely to cause confusion or mistake or to deceive.[2]

> Computer software for sales management, namely, software for creating and maintaining profiles of customers and potential customers, and for maintaining comparative information on the goods and services of competitors; all for use by sales businesses, namely businesses which are engaged primarily in marketing goods and services to others, and all relating to the development and operation of such sales businesses (Class 9);

---

[1] Application Serial No. 78614165, filed April 21, 2005, asserting a bona fide intent-to-use the mark in commerce.
[2] Registration No. 2905385, issued November 30, 2004.

> Computerized database management, relating to the development and operation of sales businesses (Class 35); and
>
> Computer systems consultancy; computer systems analysis; computer programming services for others; computer software design for others; updating of computer software; computer consultancy and advisory services; installation of computer software; all relating to the development and operation of sales businesses (Class 42).

Applicants and the Examining Attorney have filed briefs, and applicants filed a reply brief.[3]

Before addressing the substantive issue in this appeal, we must consider some evidentiary problems. With their appeal brief applicants submitted a number of exhibits, amounting to approximately 60 pages. The Examining Attorney has objected to these exhibits as being untimely.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with

---

[3] Applicants filed their appeal brief two days after the due date for such filing, and requested that their late-filed brief be accepted. The Board did not specifically address applicants' motion, although the granting of the motion was implicit in the fact that the March 21, 2007 order "noted" the brief and forwarded the file to the Examining Attorney for preparation of his brief. This will confirm that applicants' motion to accept their late-filed brief was granted.

the Board by the applicant or by the Examining Attorney after the appeal is filed. None of the materials submitted with applicants' brief was made of record during the prosecution of the application. However, applicants have made certain arguments in their reply brief as to why these exhibits should be considered. With respect to Exhibit 1, which is the file of the cited registration, applicants claim that because applicants quoted from that file in their response to the first Office action, and the Examining Attorney "did not object or otherwise advise applicant that a listing is insufficient to make such registration file history of record at a point when the applicant could cure the insufficiency," reply brief, p. 6, the Examining Attorney waived his objections. Applicants have apparently confused Board policy regarding timely objections to listings of registrations with making an actual file wrapper of record. The quotes from the registrant's arguments during the prosecution of its own application are not a "listing," and the Examining Attorney would have had no reason to know that applicants wished to rely on the entire file wrapper merely by the fact that applicants quoted some statements from that file. Applicant also argues that the Examining Attorney has made the file history of record merely by citing the

registration against applicants' application. Applicants have provided no support for such a position, and we do not accept it. Nor do we accept applicants' argument that the entire file should be treated as of record because "the application in full is readily available to the Examiner by a click of a button (i.e., electronically)." Reply brief, p. 6. Thus, the Examining Attorney's objection to Exhibit 1 is well taken, although the quotes from the file that applicants reported in their response to the first Office action are of record. Further, in their response to the first Office action applicants, referring to a document in the file of the cited registration, stated that:

> a prior registrant of a still active registration to WISDOM, admitted in the later filed registration that multiple users of WISDOM would likely not interfere with each other. See the letter from Westbrook International Ltd. enclosed herewith from the file history of the Examiner's cited registration 2,905,385.

Response filed April 10, 2006. There was no attachment to the response, but the Examining Attorney never advised applicants that it was missing. As a result, we have considered that page of Exhibit 1 consisting of what we have assumed is the letter to which applicants referred. In this connection, we note that applicants misidentified the letter, in that Westbrook International Ltd. is the

name of the owner of the registration that has been cited against applicants' application, and the letter attached to applicants' brief was sent by a company called Robertson. We also note that applicants' characterization of what the letter said is not correct, and that the letter actually says:

> Having circulated your previous communication regarding the Wisdom trademark and received no protestations from my colleagues and staff, I can only assume that there is little belief that your utilisation of the Wisdom brand name will interfere with our product's commercial development. Consequently, we confirm our agreement to your utilisation of the brand name in a product as described in your previous communication. Best wishes for its successful implementation.

Exhibit 2 consists of 14 third-party registrations for WISDOM marks. Two of these registrations, Nos. 2377363 and 2308357, are of record because the Examining Attorney, in responding to applicants' argument in their response to the first Office action, included copies of the registrations with his final Office action. As for the other registrations, applicants assert that they should be considered because they have either been made part of the record by the Examining Attorney, or because of the Examining Attorney's failure to previously object to them. It is applicants' position that the registrations were made

part of the record by the Examining Attorney because the search strategy in the application file shows that the Examining Attorney searched for all "non-dead" applications and registrations that included the term WISDOM, and the search results show that the Examining Attorney viewed 400 of the hits and 219 of the images. As a result, applicants assert that the records of the registrations were "in front of the Examiner and were effectively 'electronically' attached to the file history of the Application by this action as assuredly as if the Applicant has [sic] electronically submitted scanned copies of the registrations for review by the Examiner." Reply brief, p. 7. We are not persuaded by this argument. Board practice is very clear as to how third-party registrations are to be made of record: by submitting soft copies of the registrations, or their electronic equivalent, during prosecution/examination of the application, not by speculating about what registrations an Examining Attorney might have viewed.[4] See TBMP §1208.02 and cases cited therein ("to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO

[4] It is unclear on what applicants base their position that merely viewing material makes it of record. Certainly they have pointed to no cases to support it.

record, or a copy taken from the electronic records of the Office, should be submitted").

Nor has the Examining Attorney waived any objection to the third-party registrations merely because applicants stated, in their response to the first Office action, that "there are at least 26 other registrations that include WISDOM." This is not a "listing" of registrations that would trigger a requirement for the Examining Attorney to advise applicants that a listing is insufficient to make the registrations of record, particularly since applicants actually identified two registrations by number elsewhere in their response.

This brings us to the substantive issue, namely, whether applicants' mark is likely to cause confusion with the mark that is the subject of Registration No. 2905385. Our determination of this issue 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).

Turning first to the du Pont factor of the similarity of the goods and services, we note that applicants have applied to register their mark for services in Class 42, while the cited registration is for goods in Class 9 and for services in Classes 35 and 42. The Examining Attorney takes the position that applicants' mark is likely to cause confusion with the registered mark in all three classes, and has submitted evidence and argument to that effect. Because the refusal must be affirmed if we find likelihood of confusion with respect to the goods or services in any of the three classes of the registration, we have limited our discussion herein to the similarity of the services in Class 42, which services are the closest to applicants'.

The Class 42 services identified in the cited registration are "computer systems consultancy; computer systems analysis; computer programming services for others; computer software design for others; updating of computer software; computer consultancy and advisory services; installation of computer software; all relating to the development and operation of sales businesses." Applicant's services, as identified, are "designing,

implementing and maintaining world wide web sites, world wide web applications, and world wide web e-commerce systems for others; computer programming for others; computer software development, namely writing and updating of data processing and data management programs for others; consulting services in the field of utilization of computer networks and databases for business and commercial purposes; consulting and computer software design for others in the field of workflow automation; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; installation, maintenance and repair of computer software." Thus, both applicants and the registrant have included in their identifications "computer programming for others" and "installation of computer software." We recognize that all of the registrant's services are "relating to the development and operation of sales businesses," but because applicants have not limited their computer programming services and installation services, such services can relate to sales businesses as well. Further, applicants' updating of data processing and data management programs can include data processing and data management programs for sales businesses, and therefore is legally identical to the "updating of computer software"

relating to sales businesses identified in the cited registration, while applicants' consulting services in the field of design, selection, implementation and use of computer hardware and software systems and their consulting services in the field of utilization of computer networks and databases for business and commercial purposes would be encompassed by the registrant's computer systems consultancy and computer consultancy and advisory services for sales businesses.

Applicants assert that the Examining Attorney has taken an impermissibly broad reading of the registrant's services, pointing out that with respect to the Class 35 services, the registrant has defined "sales businesses" as "namely businesses which are engaged primarily in marketing goods and services." This definition is not in the identification of the Class 42 services, and it presents an interesting theoretical question as to whether it should apply to the other classes in the registration, all of which refer to "sales businesses." We need not answer that question here, however, because even if such definition were included in the identification, applicants' "computer programming for others" and their "installation of computer software" would still encompass services for "businesses which are engaged primarily in marketing goods and

services," as would the updating of data processing and data management programs and consulting services in the filed of utilization of computer networks and databases for business and commercial purposes and their consulting services in the field of design, selection, implementation and use of computer hardware and software systems. That is, these services as identified could be rendered to "businesses which are engaged primarily in marketing goods and services."

Accordingly, we find that applicants' services are, in part, legally identical to the services identified in the cited registration.[5] As such, they must be presumed to travel in the same channels of trade and be rendered to the same classes of consumers. These du Pont factors favor a finding of likelihood of confusion.

Applicants have pointed out that some of the services listed in their identification are not found in the cited registration. This argument is unavailing. It is not necessary to show that all of the goods or services listed in a class are identical to or related to the goods or services listed in a cited registration. Likelihood of

[5] In view of our finding that the services are in part identical we need not discuss the third-party registrations made of record by the Examining Attorney which show the relatedness of other services listed in the application.

confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

This brings us to the similarity of the marks, keeping in mind that when marks would appear in connection with virtually identical services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, as our principal reviewing court has observed, "[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark." Id.

Here the cited mark is WISDOM, while applicants' mark is WISDOM MATRIX. Applicants have disclaimed the word MATRIX. However, despite their disclaimer, applicants have argued that this term is not descriptive of their services, and that their mark "is a composite of two relatively equal parts, WISDOM and MATRIX." Brief, p. 11. Applicants state that their "voluntary disclaimer of MATRIX cannot be the basis for concluding that MATRIX is highly descriptive of Applicants' services." Reply brief, p. 3. However, applicants did not voluntarily disclaim MATRIX. Rather, the Examining Attorney required that applicants disclaim this word "because the term merely describes the nature of the proposed computer-related services." First Office action.[6] Applicants did not dispute this assessment, but provided the disclaimer. As a result, there was no need for the Examining Attorney to submit further evidence in support of his position that MATRIX is a descriptive term. Applicants' compliance with a requirement cannot be considered to be "voluntary." Thus, applicants' agreement

---

[6] With this action the Examining Attorney submitted definitions of "matrix" taken from the Dictionary.com website as meaning, inter alia, "Computer Science: The network of intersections between input and output leads in a computer, functioning as an encoder or a decoder," The American Heritage Dictionary of the English Language, 4th ed. © 2000; "Fanciful term for a cyberspace expected to emerge from current networking experiments; the totality of present-day computer networks," The Free On-line Dictionary of Computing, © 1993-2005.

to the Examining Attorney's requirement for a disclaimer on the basis that MATRIX is merely descriptive of their services is a concession that the term is descriptive.

In comparing the marks, therefore, it is appropriate for us to give greater weight to the word WISDOM in applicants' mark, since it is this word, rather than the descriptive term MATRIX, which has greater source-identifying significance. WISDOM in applicants' mark is, of course, identical to the cited mark, WISDOM. The additional word MATRIX in applicants' mark does not change the appearance or pronunciation or connotation of the word WISDOM, and the marks are identical in this respect. The additional descriptive word MATRIX in applicants' mark does not serve to distinguish it from WISDOM. Therefore, when we compare the marks in their entireties, but give appropriate weight to the stronger source-identifying element WISDOM in applicants' mark, we find that they are similar in appearance, pronunciation, connotation and commercial impression. See In re Chatam International Inc., 380 F.3d 71, 71 USPQ2d 1944 (Fed. Cir. 2004 (JOSE GASPAR GOLD for tequila likely to cause confusion with GASPAR'S ALE for beer and ale); In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS, with COMBOS disclaimed, for combination plates of food items as a part

of restaurant services likely to cause confusion with MACHO in stylized form for specialty prepared sandwich as a part of restaurant services).

We note applicants' argument that the cited mark is weak, and the registration is entitled to a limited scope of protection. The only evidence of record on which applicants base this assertion consists of two third-party registrations, one of which, No. 2377363, is for WISDOM for "charitable fundraising services namely, providing management of and access to donor data to non-profit organizations over the global computer network" and the other, No. 2308357, is a cancelled registration for WISDOM for "database management computer software, and accompanying documentation sold as a unit, to provide integrated agricultural pest, fertilizer, and crop management systems." Third-party registrations are not evidence that the marks shown therein are in use or that the public is aware of them. See AMF Incorporated v. American Leisure Products, Inc., 177 USPQ 268, 269 (CCPA 1973) ("little weight is to be given such registrations in evaluating whether there is likelihood of confusion."). We recognize that third-party registrations may be used in the manner of dictionary definitions, to show that a term has a significance for particular goods or services. However, we

are unable to conclude from these two registrations, which are for different services from those at issue herein, that WISDOM has a suggestive meaning that would limit the scope of protection to be accorded the cited registration. Further, even if we were to consider the cited mark as "weak," weak marks are still entitled to protection from the registration of a highly similar mark for identical services. See In re Colonial Stores, Inc., 216 USPQ 793 (TTAB 1992); see also King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks.)

Applicants also point to statements made by the owner of the cited registration when it was prosecuting its own application, and seeking to avoid a rejection based on another party's registration. As noted previously, the file of that registration is not of record, so we have not considered the papers from that file that were submitted with applicants' appeal brief, but only the statements from the file that applicants quoted in their response to the first Office action, which was applicants' only submission other than their appeal papers.

The quoted statements follow (the bracketed language is applicants':

> Each of the cited [WISDOM] registrations is for the identical mark WISDOM. The coexistence of these four WISDOM registrations, all covering software, shows that the public is accustomed to seeing WISDOM used for software by different entities. Words such as SMART, INTELLIGENT, and WISE are commonly used in the field of computer software, and the cited marks are thus not entitled to a broad scope of protection with respect to the goods covered by the registrations."
>
> All of the [WISDOM] registrations cover goods which would typically be sold to sophisticated specialists who are not susceptible to confusion. None of the software in question would be purchased on impulse, or without careful consideration of the nature and quality of the company standing behind the software.

And, as we indicated previously, we have treated of record the letter in the file of the cited registration from the Robertson company, in which they agreed to the registrant's "utilisation of the brand name in a product."

With respect to the present registrant's statements during the prosecution of its application, such statements are facts that:

> may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of

> reaching his own ultimate conclusion on the entire record.

Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). Here, the registrant's comment that third-party registrations show that the public is used to seeing WISDOM used for software is incorrect. As we have previously noted, the existence of third-party registrations is not evidence that the marks shown therein are in use, or that the public is familiar with them. The registrant also makes the statement that WISE, SMART and INTELLIGENT are commonly used, and that the owners of the registrations cited against it are not entitled to a broad scope of protection with respect to the goods covered in the registrations. Of course, the mark at issue herein is WISDOM, not WISE, SMART or INTELLIGENT, and we are concerned here with services, rather than goods. On this record, there is no evidence that third parties use WISDOM marks in connection with services relating to computer software and the like. We certainly cannot extrapolate from the registrant's comments that this is the case. And, as we stated above, even weak marks are entitled to protection from the use of similar marks on identical services.

Nor can we treat the letter by the Robertson company as an indication that those familiar with the field believe there is no confusion between the present applicants' use of their mark for their identified services and the cited registrant's use of its mark for its identified goods and services. The letter only indicates that the Robertson company does not have a concern about confusion between the cited registrant's "product" and the Robertson company's own mark or goods and services. We have no information from this letter as to what the Robertson company's mark or goods or services are, and this company's assessment about likelihood of confusion between the registrant's use and its own use has virtually no probative value with respect to whether competitors believe there is likelihood of confusion between the use of applicants' mark for their identified services and the registrant's mark.

The one "fact" in the quoted language that we consider significant is that the registrant implies that consumers of its goods would be careful and sophisticated purchasers. We would agree the registrant's services, since they all relate to "the development and operation of sales businesses," would be purchased by businessmen who would exercise care in choosing their vendors. Similarly, applicant's services are of a complicated-enough nature

that those who obtain them will select them with care. This du Pont factor of the conditions of purchase favors applicants.

However, this factor is not sufficient to outweigh the factors of the similarity of the marks and the legally identical services. Even if consumers note that applicants' mark includes the word MATRIX, they are not likely to view this additional word as indicating a different source of the services. Rather, they are more likely to treat WISDOM MATRIX, when used in connection with legally identical services, as a variation of the WISDOM mark, and to consider that both marks identify services emanating from a single source.

Finally, we note that applicants have asserted one additional du Pont factor as being relevant to our decision herein, namely, the nature and extent of any actual confusion. Applicants state that "on information and belief, there has been no instances of actual confusion between Registrant's mark and Applicant's mark." Brief, p. 21. However, applicants filed their application based on an asserted intention to use their mark, not on actual use, and there is no information in the record that applicants have even commenced use, let alone evidence to show that there has been sufficient and geographically

coextensive use of both applicants' and the registrant's mark for us to conclude that there has been an opportunity for incidents of confusion to occur if confusion were likely. And we categorically reject applicants' suggestion that the "consent" from Robertson to the registrant provides any evidence whatsoever as to whether confusion would occur between the use of applicants' and the registrant's marks. Thus, we treat this du Pont factor as neutral.

Decision: The refusal of registration is affirmed.