

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Breach Security, Inc.

Serial No. 78668939

Kathleen A. Pasulka of Procopio Cory Hargreaves Savitch LLP
for Breach Security, Inc.

John E. Mikos, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Grendel, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Breach Security, Inc. to register the mark WEBDEFEND in standard character form on the Principal Register for the following goods, as amended: "Network security appliance that prevents security breaches in web applications" in International Class 9.¹

¹ Application Serial No. 78668939 was filed July 12, 2005, based on applicant's assertion of its bona fide intent to use the mark in commerce.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used on its goods, so resembles the mark WEBDEFENDER, previously registered on the Principal Register in typed or standard character form for "computer software for controlling access to resources on global computer information network through one-time password token based authentication" in International Class 9,² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v.*

² Registration No. 2947022, issued May 10, 2005.

Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We begin by considering the similarities and dissimilarities between the marks. In our likelihood of confusion analysis, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). 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 their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

In this case, applicant's mark, WEBDEFEND, comprises the majority of the cited mark, WEBDEFENDER. The only difference between the marks is the presence of the letters "ER" at the end of the registered mark. Consumers are not likely to note or remember such a minor difference that barely affects either the pronunciation or appearance of the marks. As such, applicant's mark is nearly identical to the mark in the cited registration in appearance and

sound. We note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). Further, both marks connote goods that provide security or defense for products accessing a computer network or web. Thus, despite the fact that the applicant's mark lacks the last syllable of the mark in the cited registration, the marks WEBDEFEND and WEBDEFENDER are highly similar in appearance, pronunciation, connotation and commercial impression.

In support of its argument that the mark in the cited registration is weak and thus entitled to a narrow scope of protection, applicant submits printed copies of pending trademark applications from a private database (trademark.com) as well as a printed summary of the results of a search of the term "defender software" on the Google Internet search engine.³ We note, however, that an application made of record in a Board ex parte proceeding is of very limited probative value, and is evidence only of

³ Inasmuch as the examining attorney did not object to applicant's submission of third party applications taken from a private database with its response to the first Office action, we will consider them of record for such probative value as they may have. See TBMP §1208.02 (2d ed. rev. 2004) and the authorities cited therein.

its filing. See *In re Phillips-Van Heusen Corp.* 63 USPQ2d 1047, 1049 n.4 (TTAB 2002). In addition, the listed applications submitted by applicant are for marks that are more dissimilar from registrant's mark than the mark in the application at issue herein. Similarly, the Google search summary is of very limited probative value in that there is too little information contained therein to determine the nature and extent of use of the marks referenced therein. In addition, of course, there is no way to know what effect, if any, these purported uses of "DEFENDER" marks may have had in the minds of consumers. See *Carl Karcher Enterprises Inc. v. Star Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995). Thus, we find applicant's argument and evidence unpersuasive.

Nonetheless, and as noted above, both applicant's WEBDEFEND mark and registrant's WEBDEFENDER mark connote goods that provide security for products accessing a computer network. Applicant's goods, as identified, prevent security breaches in computer network applications. Registrant's goods, as identified, control access to resources on computer networks through password authentication. Thus, we find that both marks, on their faces, are somewhat suggestive as applied to their respective goods. As a result, we find that registrant's

mark is entitled to a narrower scope of protection than that afforded to a more distinctive mark. *See, for example, Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

In view of the similarities between the marks, and their relative weakness notwithstanding, this *du Pont* factor favors a finding of likelihood of confusion.

The Goods

We next turn to the similarity or dissimilarity between applicant's goods and the goods identified in the cited registration. In his discussion of the relationship between the goods, the examining attorney states as follows:

There is no indication in the record as to the precise nature of applicant's "network security appliance." It is plausible that it either consists of or utilizes computer software to accomplish its purpose of securing the web applications. The registrant's goods are computer software. Accordingly, registrant's identification of goods without limitation should be accorded due deference and must be considered to be closely related to applicant's goods.

(Brief, p. 7). We note, however, that registrant's computer software is not identified without limitation, but rather is used specifically "for controlling access to resources on global computer information network through one-time password token based authentication." Thus, we

are not persuaded by the examining attorney's conclusory statement that applicant's "network security appliance" must be found to be related to the goods identified in the cited registration.

In support of his contention that the goods are related, the examining attorney has submitted copies of several third-party registrations. However, the third-party registrations submitted by the examining attorney fail to yield a single registration in which the same mark is used to identify a "network security appliance" or, for that matter, any sort of goods that prevent security breaches, and registrant's goods. While the third-party registrations make reference to goods that are similar to those identified in the cited registration, they do not refer either to the goods recited in the challenged application or to similar goods used for the purpose of providing computer network security. In short, none of the evidence submitted by the examining attorney demonstrates or suggests that applicant's goods and registrant's goods emanate from a common source. Thus, in the present case, there is insufficient evidence to support the examining attorney's conclusory statement that registrant's goods and applicant's goods are related. Nor are applicant's goods, as identified, so closely related to registrant's goods

that we may find upon the face thereof that they are complementary or that a viable relationship exists between them. Furthermore, because it is not clear that applicant's goods consist in whole or in part of computer hardware, we are not persuaded by the examining attorney's argument that our previous case law compels a finding that such goods are related to those of registrant.

Based on this record and the mere conclusory statement of the examining attorney, we see the likelihood of confusion claim asserted by the examining attorney as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967). Further, we are not persuaded that applicant's goods are within the normal field of expansion for registrant's recited goods. Simply put, there is nothing in the record to support a finding that

purchasers are likely to believe that registrant will expand its goods to encompass the goods identified in the application at issue. Cf. *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). Accordingly, based upon the record before us this *du Pont* factor weights heavily against a finding of likelihood of confusion.

In reaching our decision on likelihood of confusion we have not relied upon applicant's arguments regarding sophistication of purchasers. In that regard, we note that, as identified, applicant's goods as well as those of registrant may well be used by sophisticated purchasers. However, there is no evidence of record that either registrant's or applicant's goods would be purchased only by highly sophisticated persons. Further, it is settled that even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988).

In view primarily of the lack of evidence of a relationship between applicant's goods and the goods identified in the cited registration, we find that the examining attorney has not met his burden of demonstrating that a likelihood of confusion exists between applicant's goods and those of registrant.

Ser No. 76587886

Decision: The refusal of registration is reversed.
Accordingly, the involved application will be forwarded for
publication in due course.