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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Athena Archiver, Inc.

Serial No. 78689801

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Before Seeherman, Holtzman and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On August 10, 2005, Athena Archiver, Inc. filed a use-based application for the mark ATHENA ARCHIVER, in standard character form, for computer software ultimately identified as "downloadable computer software, namely, software for archiving electronic data," in Class 9 (Serial No. 78689801). Applicant disclaimed the exclusive right to use the word "archiver."

The Examining Attorney finally refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), because applicant's mark, when used in connection

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with software for archiving electronic data, so resembles the mark ATHENA for "computer programs, and instructional manuals sold therewith, which collectively provide a set of integrated network services; namely, user authentication, file service, messaging service, mail service, network management service, and printer service" as to be likely to cause confusion.¹ The Examining Attorney contends that applicant's mark is likely to cause confusion with the registered mark for the following reasons:

1. The marks ATHENA ARCHIVER and ATHENA are identical except for the addition of the descriptive word "archiver" in applicant's mark;
2. ATHENA is an arbitrary term when used in connection with computer software, and therefore the registered mark is a strong mark entitled to a broad scope of protection; and,
3. The computer software of the applicant and the registrant are related because the registrant's software network could include software for archiving electronic data.

¹ Registration No. 1789164, issued August 24, 1993; Sections 8 and 15 affidavits accepted and acknowledged; first renewal.

On the other hand, applicant contends that the marks will not cause a likelihood of confusion for the following reasons:

1. The name "Athena" has been registered numerous times in connection with software products, and therefore the name "Athena" is weak and entitled to only a narrow scope of protection;²
2. The marks, ATHENA and ATHENA ARCHIVER, when considered in their entirety, are not similar because "Athena" is descriptive.³ Applicant makes the following argument:

The Appellant's mark and the cited mark have the element "ATHENA" in common. However, this commonality of elements is not sufficient to create likelihood of confusion. This is because both portions of the mark are fairly descriptive. There is no one

² Applicant attached to its brief a printout of a trademark search for the mark ATHENA, in Class 9, performed in the LEXIS database. The Examining Attorney did not object to this evidence as being untimely pursuant to Trademark Rule 2.142(d), 37 CFR §21.24(d), nor did she object on the ground that the submission of a search report from a commercial database is not proper evidence of third-party registrations. To make registrations of record, soft copies of the registrations, or the electronic equivalent thereof taken from the electronic records of the U.S. Patent and Trademark Office, must be submitted. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Rather, in her brief, the Examining Attorney discussed the registrations introduced by applicant. Because the Examining Attorney treated this material to be of record, we will consider the registrations for whatever probative value they may have.

³ While we have not recounted each and every one of applicant's arguments in this opinion, we have carefully considered them in reaching our decision.

individual that has an exclusivity to the word "ATHENA". . . .

* * *

Accordingly, while the mark "ATHENA ARCHIVER" must be considered in its entirety, the descriptive portions (sic) "ATHENA" are (sic) given less weight than the combination of the word "ATHENA ARCHIVER" which gives a totally different pronunciation and visual impression to the Appellant's mark as distinguished from the prior cited registration.⁴

3. The computer software described in the application and the cited registration are not similar for the following reason:

[n]o one would confuse a product which is a computer program and instruction manual sold therewith, which collectively provide a set of integrated network services; namely, user authentication, file service, name service, messaging service, mail service, network management service and print service with downloadable computer software, namely software for archiving electronic data. Clearly, the products are totally different products, sold in totally different channels of trade to consumers who are buying the products for totally different purposes.⁵

⁴ Applicant's Brief, pp. 5 and 7. Applicant's assertion that the registered mark is merely descriptive may not be considered because it is an impermissible attack on the validity of the cited registration. *In re Peebles Inc.*, 23 UPSQ2d 1795, 1797 n.5 (TTAB 1992).

⁵ Applicant's Brief, p. 14. Neither applicant, nor the Examining Attorney, introduced any evidence regarding the nature of the software at issue, the channels of trade, the classes of

Likelihood of Confusion

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

A. The strength of the mark ATHENA.⁶

First, we analyze the strength of the mark ATHENA because our finding will effect the scope of protection or exclusivity of use that we accord the cited registration in determining whether applicant's mark is likely to cause confusion. Applicant supports its argument that ATHENA is a weak mark by submitting a search report featuring the following registrations incorporating the name "Athena":⁷

consumers who purchase the software, or the degree of care exercised by such consumers.

⁶ While the "strength" of the cited registration is not specifically listed as a *du Pont* factor, it falls within the penumbra of the "fame" factor because fame for purposes of likelihood of confusion "varies along a spectrum from very strong to very weak." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001).

⁷ The only probative value of third-party applications is to show that the applications were filed.

MARK	REG. NO.	GOODS
ATHENA	3079220	Electronic equipment in the nature of inertial navigation systems, global positioning systems, and autopilot systems all consisting of computers, computer software, transmitters, receivers, and network interface devices and integrated sensor suites, all for use in the field of aviation
ATHENA	3073751	Instruments and apparatus, including software, in the field microlithography
ATHENA SWORD	2867619	Software and electronic games
ATHENA	3104590	Software to assess the environmental implications, energy use and energy requirements related to air emissions of building materials, buildings and construction which may be connected to databases and other information sources
ATHENA TOWER	2770992	Computer workstations, comprising tables and shelves
ATHENA	2570223	Flight control electronics for manned and unmanned aircraft
ATHENA	1815754	Real time computer graphics software
TEL-ATHENA	1617351	Computer software in the fields of telemarketing and market research interviewing

Generally, third-party registrations, in and of themselves, cannot justify the registration of another mark that is so similar to a previously registered mark as to

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cause a likelihood of confusion. Third-party registrations are not evidence of what happens in the market place or that consumers are familiar with the marks. To the extent that such third-party registrations have any probative value in the likelihood of confusion analysis, they are relevant to show that the mark, or a portion of a mark, is descriptive, suggestive, or so commonly registered that the public will look to other elements to distinguish the source of the products identified in the registrations.

AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269-270 (CCPA 1973); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.* 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984). Thus, third-party registrations may be used like dictionaries to demonstrate that the mark conveys a specific meaning. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-695 (CCPA 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

While applicant contends that the registrations prove that ATHENA is descriptive, as we have previously stated, such a position represents an impermissible attack on the

validity of the cited registration.⁸ Moreover, the third-party registrations do not show that the name "Athena" is suggestive of computer software. Applicant does not explain how "Athena" is suggestive. There is no analysis of what qualities, characteristics, features, or functions of the software that "Athena" suggests. The eight (8) third-party registrations of record are for a wide range of computer programs in disparate fields (*i.e.*, software in the fields of navigation systems, microlithography, electronic games, environmental emissions from buildings, graphics software, and telemarketing). The disparate nature of the goods in the third-party registrations do not shed any light on what common significance ATHENA might have for these different goods, or for the registrant's identified goods. Accordingly, we do not believe that the registered mark has been shown to be weak. Moreover, even if we were to deem the protection to be accorded the cited registered mark as being more limited than that for an undiluted mark, the protection still extends to prevent the registration of a mark that conveys the same commercial impression and that is used for related goods. Likelihood of confusion "is to be avoided, as much between 'weak' marks as between 'strong' marks." *King Candy Co. v. Eunice*

⁸ Footnote 4 *supra*.

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King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109
(CCPA 1974).

B. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* 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., supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). *See also, In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (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

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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).

The name "Athena" is the dominant portion of applicant's mark because the word "archiver" is descriptive when it is used in connection with software for archiving electronic data. "Archiver" describes the purpose or function of applicant's software (*i.e.*, it archives). Moreover, applicant disclaimed the exclusive right to use the word "archiver" in response to the Examining Attorney's finding that it is merely descriptive, thereby conceding the descriptive nature of the word "archiver" as applied to software for archiving electronic data. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005). *See also Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). Therefore, the name "Athena" is accorded more weight than the word "archiver" in our comparison of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The significance of the name "Athena" as the dominant element of applicant's mark is further reinforced by its location as the first word of the mark. *Presto Products*

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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).

In comparing the two marks, we note that the applicant's mark contains the registrant's entire mark (*i.e.*, ATHENA). Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) ("the fact that [applicant's] mark herein [PERRY'S PIZZA] incorporates the descriptive term 'pizza' as part of the mark presented for registration does not obviate the likelihood of confusion with the mark of the cited registration [PERRY'S]"); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Manufacturing*

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Company, Inc., 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages is likely to cause confusion with LITTLE LADY for doll clothing because "the word 'buggy' is clearly descriptive of applicant's doll carriage products" and "would fail to alter the perceived identity of the dominant and more arbitrary 'LITTLE LADY' and 'LIL' LADY' elements of these marks").

We are not persuaded that the addition of the word "archiver" to applicant's mark is sufficiently distinctive to differentiate applicant's mark from the registered mark in any meaningful way. In fact, the addition of the word "archiver" in applicant's mark may increase the likelihood of confusion because customers and potential customers may mistakenly believe that applicant's software is an expansion of the registrant's "integrated network services" and that both products emanate from the same source.

In view of the arbitrary nature of the registered mark ATHENA, the lesser weight to be accorded the descriptive word "archiver" in applicant's mark, and applicant's incorporation of the entire registered mark in its mark, we find that the similarities between the marks far outweigh the differences. Considering the similarities between the marks, a purchaser who sees one mark and later encounters the other on related software is likely to view the marks

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as variations of each other, representing a single source. Accordingly, we conclude that the marks ATHENA and ATHENA ARCHIVER are similar in appearance, sound, meaning, and commercial impression.

C. The similarity or dissimilarity and nature of the goods.

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). Moreover, the greater the degree of similarity between the applicant's mark and the mark in the cited registration, the lesser the degree of similarity between the goods in the application and the cited registration that is required to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

It is well settled that the goods of the applicant and the registrant do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods are

related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source.

In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods in the cited registration are "computer programs . . . which collectively provide a set of integrated network services; namely, user authentication, file service, messaging service, mail service, network management service, and printer service." The word "integrated" has the following meanings (emphasis in the original):

1. combining or coordinating separate elements so as to provide a harmonious, interrelated whole: *an integrated plot; an integrated course of study.*
2. Organized or structured so that the constituent units function cooperatively; *an integrated economy.*⁹

⁹ Dictionary.com Unabridged (v 1.1) based on the Random House Unabridged Dictionary (2006). See also The Computer Glossary, p. 199 (7th ed. 1995) ("a collection of distinct elements or components that have been built into one unit"). *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n. 3 (TTAB 2002).

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"Integrated network services" would, therefore, be a network that combines several applications (e.g., user authentication, file service, messaging service, mail service, network management service, and printer service) into a single unit. Applicant's software for archiving electronic data is a type of application that could potentially be integrated into registrant's network of computer programs. In other words, the mail received and sent through the "mail service" as part of the registrant's "integrated network service" is something that would be archived (e.g., archiving email messages). Thus, the software of the applicant and registrant are complementary, and could be marketed under circumstances giving rise to the mistaken belief, because of the similarity of the marks, that they emanate from the same source.

In view of the foregoing, we find that the similarity and nature of the goods favors a finding that there is a likelihood of confusion.

See also, 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).

D. The similarity or dissimilarity of established, likely-to-continue trade channels.

As noted in footnote 5 *supra*, neither the Examining Attorney, nor the applicant, submitted any evidence regarding channels of trade or classes of consumers. However, as we discussed in the previous section, applicant's software and registrant's software are complementary products, and therefore can be marketed to the same classes of customers. For example, consumers using registrant's software might buy/obtain a license for applicant's archiving software as an accessory to the "mail service." Because the classes of consumers are the same, this *du Pont* factor favors a finding of likelihood of confusion.

E. Balancing the factors.

The *du Pont* factors require to us to consider the thirteen factors for which evidence has been made of record. The Court of Customs and Patent Appeals, the predecessor to our reviewing court, has observed that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Because of the

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similarity of the marks ATHENA and ATHENA ARCHIVER, the similarity of the software identified by each mark, and the absence of any evidence that militates against confusion,¹⁰ we conclude that there is a likelihood of confusion. To the extent that any doubt might exist as to the correctness of this decision, we resolve such doubt against the applicant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1998).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.

¹⁰ As previously discussed, the third-party registrations do not persuade us that ATHENA is a weak mark for the registrant's identified software.