UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Information Builders, Inc.

v.

Techinfocus, Inc.

Consolidated Opposition Nos. 117,490 and 117,505

Allen H. Levine of Levine & Mandelbaum for Information Builders, Inc.

Michael D. Oliver of Bowie & Jensen for Techinfocus, Inc.

Before Hanak, Quinn and Walters, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Techinfocus, Inc. (applicant) seeks to register TECHINFOCUS in typed drawing form and TECHINFOCUS and design as shown below for "software that permits users to transmit over public networks and private networks reports, invoices, marketing information and data in a graphical format that is interactive." Both applications were filed in the summer of 1999 with the same claimed first use date of August 18, 1998.

On February 23, 2000 Information Builders, Inc. (opposer) filed two Notices of Opposition alleging that long before August 1998 it had both used and registered a number of FOCUS marks for computer programs that were extremely closely related to applicant's programs such that the contemporaneous use of opposer's FOCUS marks and applicant's TECHINFOCUS marks would result in purchaser confusion, mistake and deception. In particular, opposer claimed ownership of the following marks: FOCUS, PC/FOCUS, WEBFOCUS, FOCUS VISION and FOCUS FUSION.

Applicant filed Answers which denied the pertinent allegations of the Notices of Opposition. In an order dated February 14, 2001 this Board granted opposer's motion to consolidate the two oppositions in as much as they involved "common questions of law and fact."

Both parties filed briefs. Neither party requested a hearing.

The record in this case is summarized at page 4 of opposer's brief and at page 4 of applicant's brief. With one exception, the parties agree as to what constitutes the record. The one exception is opposer's third Notice of Reliance which at pages 5 and 6 of applicant's brief applicant requests be stricken from the record. Because in its opening brief opposer never relied upon the documents attached to its third Notice of Reliance and because in its reply brief opposer does not discuss applicant's motion to strike, the motion to strike is granted as well taken.

Before turning to the issue of likelihood of confusion, we will discuss the issue of priority. Because opposer has properly made of record its registrations for FOCUS, PC/FOCUS, WEBFOCUS, FOCUS VISION and FOCUS FUSION, priority rests with opposer. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, opposer has established through the testimony of its president (Gerald D. Cohen) that it has used each of the foregoing marks continuously from a date long before August 1998, applicant's claimed first use date. Indeed, opposer first used its mark FOCUS in connection with computer software in 1975. From 1975

through 2001 opposer has sold nearly $3 billion worth of computer software under its FOCUS marks. In addition, during that same period opposer has spent in excess of $47 million advertising its various FOCUS computer software.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods of the parties, it is well settled that in Board proceedings "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Of course, an opposer is not limited to the rights which it derives from its registration(s). An opposer is entitled to establish prior common law rights in a mark, and if an

opposer does so, this mark is taken into consideration in any likelihood of confusion analysis.

With the foregoing in mind, we will now consider the goods of opposer's five FOCUS registrations. All of the registrations depict the five marks in typed drawing form. Opposer has registered FOCUS and WEBFOCUS for "computer programs for data base management." Registration Nos. 1,652,265 and 2,248,562. Opposer has registered PC/FOCUS for "diskettes containing a microprocessor program for use in preparation of reports and graphs from data stored in a personal computer." Registration No. 1,300,245. Opposer has registered FOCUS VISION for "pre-recorded computer programs used to store images in a database." Registration No. 1,478,426. Finally, opposer has registered FOCUS FUSION for "computer software for database management systems." Registration No. 1,965,984.

As previously noted, applicant seeks to register TECHINFOCUS in typed drawing form and TECHINFOCUS and design for "software that permits users to transmit over public networks and private networks reports, invoices, marketing information and data in a graphical format that is interactive." The goods of opposer's registrations for FOCUS, WEBFOCUS and FOCUS FUSION are very broadly described as computer programs (software) for database management.

Database management encompasses a wide array of computer software functions including the transmission of data (i.e. reports and the like) in various formats (including graphical) over both public and private networks. Thus, the goods described in applicant's TECHINFOCUS applications and opposer's registrations for FOCUS, WEBFOCUS and FOCUS FUSION, if not identical, are extremely closely related. Moreover, opposer's president testified that in actual practice opposer has used its mark WEBFOCUS since 1996 to "prepare reports and access information and distribute information through the Internet." (Cohen deposition page 12). Despite differences in terminology, distributing information through the Internet is the same as transmitting over public networks information in the form of reports, invoices, marketing information and data.

We also note that the goods recited in opposer's PC/FOCUS registration – essentially programs for use in preparation of reports and graphs from data stored in a personal computer – are extremely similar to the goods for which applicant seeks to register TECHINFOCUS in that before one can transmit data in a graphical format (applicant's goods) one must first prepare the graphs from data stored in a computer, including a personal computer. Likewise, the goods of opposer's registration for FOCUS

VISION – essentially computer programs to store images in a database – are likewise very closely related to applicant's goods for the same reasoning.

A factor closely related to the similarities of the goods is the similarity of the trade channels. In this regard, we note that at pages 16 and 17 of its brief, applicant concedes that its applications and opposer's registrations contain no restrictions as to trade channels and that "consumers might see both [opposer's and applicant's] marks in the same context." Moreover, neither the applications nor the registrations contain any limitation as to the cost of the goods. Indeed, the record reveals that in actuality applicant intends to market its software for about $200 and that opposer sells certain of its software for as little as $395. In sum, we find that at least certain of opposer's goods are functionally identical to applicant's goods, and that in addition the goods of both parties are marketed through the same trade channels at approximately the same price range to the same end users.

Turning to a consideration of the marks, we note at the outset that when the goods are very closely related, as is the case here, "the degree of similarity [of the marks] 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).

To begin with, we note that applicant's two marks and opposer's five marks all contain the word FOCUS. As applied to computer software or indeed computers in general, the word "focus" has no meaning. Microsoft Computer Dictionary (5th ed. 2002). To be clear, the aforementioned dictionary does define the word "focus" as follows: "In television and raster-scan displays, to make an electron beam converge at a single point on the inner surface of the screen." Likewise, this dictionary defines the acronym FOCUS as follows: "See Federation on Computing in the United States."

Applicant has made of record third-party registrations containing the word FOCUS for various computer products. In light of the foregoing, applicant argues at page 19 of its brief that "opposer's scope of protection for the FOCUS Marks, as a matter of law, should be narrow."

The problem with applicant's argument is that applicant has made of record absolutely no evidence whatsoever showing that any of these registered third-party marks are in use, much less they have been used so extensively such that consumers of computer software have

become conditioned to distinguish slight differences in various FOCUS marks. See Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) ("But in the absence of any evidence showing the extent of use of any of such marks or whether any of them are now in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.")(original emphasis). Indeed, the only evidence of record dealing with the issue of whether third-parties have used FOCUS as part of their marks for computer software or for any type of computer products is the testimony of opposer's president. In this regard, Mr. Cohen testified at page 44 of his deposition that "there are no other trademarks that include FOCUS on computers today, that I'm aware of."

In analyzing applicant's two TECHINFOCUS marks, we note that applicant has taken the arbitrary term FOCUS and merely added to it the highly suggestive, if not descriptive, wording TECHIN. In this regard, we note that at page 15 of its brief, applicant explains that its TECHINFOCUS marks were derived by "combining the first syllable of 'Technology,' the word 'in' and 'Focus.'" As applied to computer software, the word "technology" or its

shortened form “tech” is highly suggestive, if not descriptive, of computer software.

Likewise, opposer’s marks WEBFOCUS and PC/FOCUS contain at the beginning of the marks highly suggestive, if not descriptive, terms as applied to computer software, namely, WEB and PC. In view of the foregoing, we find that consumers familiar with opposer’s FOCUS, WEBFOCUS and PC/FOCUS marks would, upon seeing TECHINFOCUS on extremely similar if not identical computer software, assume that TECHINFOCUS was yet another of opposer’s FOCUS marks. This is true even with regard to applicant’s TECHINFOCUS and design mark inasmuch as the design in said mark does little to distinguish it from opposer’s marks FOCUS, WEBFOCUS and PC/FOCUS.

Of course, it need hardly be said that to the extent that there are doubts on the issue of likelihood of confusion, said doubts must be resolved in favor of opposer as the prior user. Century 21 Real Estate, 23 USPQ2d at 1707; In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993).

Decision: The oppositions are sustained.