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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ADC Legal Systems, Inc.

v.

United States & International Patent Drawings, Inc.

Cancellation No. 92045721
Registration No. 2833136
Issued April 13, 2004

J. Rodman Steele, Jennifer P. Rabin of Akerman Senterfitt
for ADC Legal Systems, Inc.

United States and International Patent Drawings, Inc. (David
S. Leone, President), *pro se*.

**Before Hairston, Rogers and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

On April 13, 2004, Registration No. 2833136 issued to
respondent United States & International Patent Drawings,
Inc., for the mark DOCUTRACK (typed) for "computer software
for use in tracking and displaying documents in legal
proceedings" in International Class 9. The registration is
based upon an application filed June 13, 2002.

On April 20, 2006, ADC Legal Systems, Inc. filed a
petition to cancel respondent's registration on the ground
that, prior to respondent's first use of its mark,

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petitioner had adopted and used the mark DOCUTRAC "software for document control, namely, document docketing, merging, and storage, and control of time entries and notes." Pet'n ¶ 2-3. Petitioner alleges that the subject registration is likely to cause confusion, to petitioner's detriment. Pet'n ¶ 6. Petitioner also alleges that it is further damaged inasmuch as it has filed an application for registration of DOCUTRAC, which has been refused in view of the subject registration. Pet'n ¶ 9.

Respondent denied the salient allegations of the petition to cancel, and further added that "it is Registrant who is being injured by Petitioner's current use of 'DOCUTRAC.'" Answer ¶ 9.

We grant the petition to cancel.

I. Record

The record consists of the subject registration, the pleadings, and the testimony of Monty L. Helin, President of Petitioner ADC Legal Systems. Attached as evidence to Mr. Helin's testimony were the following exhibits:¹

1. USPTO TESS record of petitioner's application for registration of DOCUTRAC for "software for document control, namely, document docketing, merging, and storage, and control of time entries and notes," alleging dates of first use and first use in

¹ Petitioner variously displays its mark as DOCUTRAC or DocuTrac. When referring to particular uses of petitioner's mark, we have retained the capitalization used by petitioner. When we are not quoting from petitioner's materials, we have retained our usual practice of printing trademarks in capital letters.

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commerce of 1989. Application No. 76598738, filed June 21, 2004.

2. Software Purchase Agreement between petitioner and Curry, Taylor & Carls, PA, dated August 11, 1987. The agreement indicates that "DOCUTRAC Document Generation system" was among the items sold as a part of a "Practice Perfect Foreclosure Case Management System." Total price \$3,150.00.
3. Software Purchase Agreement between petitioner and Winderweedle, Haines, Ward & Woodman, PA, dated December 15, 1987. "Document Generation - DOCUTRAC" is itemized as part of the foreclosure system sold for use in two locations. Total Price \$4,080.00, after discount.
4. Software Support Maintenance Agreement between petitioner and George Adler, P.A. Dated June 4, 1990. Yearly Amount \$549.00.
5. USPTO TESS record for respondent's registration of DOCUTRACK for "computer software for use in tracking and displaying documents in legal proceedings." Filed June 13, 2002, and alleging first use and use in commerce as of July 18, 2002. Registration No. 2833136, issued April 13, 2004.
6. Screen shot from PerfectPractice website, showing a button for access to information on "DocuTrac."
7. PerfectPractice sales brochure, for trial lawyers. Includes information on the DocuTrac module.
8. PerfectPractice sales brochure for foreclosure, bankruptcy, replevin REO and timeshare practitioners. Includes information on the DOCUTRAC module.
9. PerfectPractice sales brochure, for consulting engineers. Includes information on the DOCUTRAC module.
10. Screen shot of PerfectPractice software running with DocuTrac tab available.
11. Screen shot of PerfectPractice online help screen, including a link to help for DocuTrac module.

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Respondent did not appear at Mr. Helin's testimonial deposition, nor did it submit any evidence or a brief on its own behalf.

II. Facts

Petitioner provides goods and services relating to a suite of software case management tools particularly useful for law firms with a document-intensive practice, such as litigation, bankruptcy, and litigation, as well as for some non-legal professions, such as accounting, medicine, and consulting engineers. Helin Dep. 13-14, 16-17, Exh. 6-9. Petitioner's customer base is approximately "99 percent legal." Helin Dep. 13. Petitioner has customers nationwide and occasionally overseas. Petitioner's products are typically sold after a demonstration of the software and an assessment of the customer's needs.

Petitioner's DOCUTRAC software is a software module that works as a part of petitioner's "Perfect Practice," (sometimes "Practice Perfect") case management system. Petitioner's President offered credible testimony about the functions of its software:

The [DOCUTRAC] product offers document merging. It automatically will do tracking by inserting notes into a case management system and appropriate follow-ups to make sure there's been an appropriate disposition regarding any documents that are produced.

Also, it does track where the document is stored. There is a feature where you can access

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the documents utilizing the "view files" feature of the [DOCUTRAC] module.

Helin Dep. at 8.

Petitioner began using the DOCUTRAC mark in connection with its software at least as early as 1987, and its use has been continuous and without interruption since then. The mark appears on the computer screen when the software is running.

Petitioner conducts advertising for Practice Perfect and DOCUTRAC on its own web site, Exh. 6, through advertisements in magazines for the legal profession, such as Trial, Law Office Computing, and Law Technology News, and at conventions, legal seminars, and trade shows, where it sets up booths geared to the appropriate legal sector to demonstrate its software and provide information. Helin Dep. 14-17. Brochures with information on the software are circulated at trade shows and most are available for download from petitioner's website. Helin Dep. 19-21; Exh. 7-9. Petitioner is a member of a number of legal professional associations, including the U.S. Foreclosure Network, American Trial Lawyers, Florida Trial Lawyers, and the American Bankruptcy Institute. Helin Dep. 16-17.

On June 21, 2004, petitioner filed an application to register DOCUTRAC for "software for document control, namely, document docketing, merging, and storage, and

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control of time entries and notes.² Helin Dep. at 6-7; Exh.

1. The examining attorney responsible for petitioner's trademark application cited respondent's trademark registration as a bar to registration of petitioner's mark.

III. Analysis

A. Petitioner's Trademark Rights

In a cancellation proceeding, "petitioner, as plaintiff, must, in the first instance establish prior rights in the same or a similar mark...." *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 313 (TTAB 1978). Thus petitioner bears the burden of showing, by a preponderance of the evidence, that it has used its mark as a trademark, that the mark is distinctive, and that its use has not been abandoned.

Petitioner has established its use of the DOCUTRAC mark as a trademark in connection with specialized software systems for case management. Mr. Helin testified that petitioner sold software systems including the DOCUTRAC software in August and December 1987, and furnished purchase agreements dated August 11 and December 15 of that year. Helin Dep. 9-10, Exh. 2, 3. The mark appears on the screen when the software is running. The testimony further demonstrates that petitioner has been using its mark

² Application No. 76598738, alleging dates of first use and first use in commerce of 1989.

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continuously since that date and that such use has not been abandoned.³ We also find, based on the record, that petitioner's DOCUTRAC mark is distinctive.

B. Standing and Priority

Petitioner's evidence of its prior use of the DOCUTRAC trademark demonstrates that petitioner is not a mere intermeddler, and has a reasonable belief that it would be damaged by the continued registration of respondent's mark. Further, petitioner filed a trademark application that was refused registration in view of the subject registration. Therefore, petitioner has established its standing.

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Respondent filed the trademark application that matured into the subject registration on June 13, 2001. Inasmuch as respondent has not submitted testimony or any other evidence showing its use of the mark prior to June 13, 2001, that is the earliest date upon which respondent may rely for priority. *Home Juice Co. v. Runmlin Co. Inc.*, 231 USPQ 897, 899 n.5 (TTAB 1986) ("Since respondent has introduced no

³ Although Mr. Helin testified that there were earlier sales, Helin Dep. 11-12, as evidenced by a 1990 software maintenance agreement, Exh. 4, the testimony with regard to these sales was vague, and the 1990 software maintenance agreement does not indicate the date on which the software was originally sold. Nonetheless, the agreement is evidence of this particular sale of the software no later than 1990.

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testimony or other evidence, it can claim no date of commencement of its use of the registered mark earlier than the filing date of the application on the basis of which the registration was granted...."), citing *Aluminum, Inc. v. Am. Screen Prod. Co.*, 305 F.2d 479, 134 USPQ 376 (CCPA 1962). Inasmuch as petitioner's date of first use long predates respondent's filing date, priority is unquestionably established on this record.

C. Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re*

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Azteca Restaurant Enter., Inc., 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

1. The Similarity or Dissimilarity of the Marks

In comparing petitioner's mark to the mark in the subject registration, we consider whether the marks, viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Petitioner's mark is DOCUTRAC, while the mark in the involved registration is DOCUTRACK. Respondent's mark is registered in "typed" form and is thus considered without respect to any particular typeface or stylization. Petitioner's exhibits show its mark as used in advertising and on the screen of the relevant software, depicted in plain, upright fonts, the kind which might be commonly used in business communications. Petitioner's DOCUTRAC mark is typically presented in either all capital letters or with a

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capital "D" and "T," *i.e.*, "DocuTrac." Where the mark is visible on the screen of the software as it is running, the latter version is used. Exh. 6, 10-11. While we must judge a common-law trademark as it is used, we find that the examples of petitioner's use in this record do not include stylization or embellishments that would change the impact of the word itself in any significant way.

We find the marks to be identical in pronunciation and meaning, and very nearly so when compared visually. Because the only difference between the marks is the final "K" on respondent's mark, the marks would be pronounced the same, and look almost the same. Further, both marks convey the same connotation - that of something which assists in the tracking of documents.

We conclude that the marks are virtually identical, and that this strongly supports petitioner's claim for cancellation.

2. The Similarity or Dissimilarity of the Goods

Respondent's mark is registered for "computer software for use in tracking and displaying documents in legal proceedings" in International Class 9. Petitioner's testimony establishes that petitioner's DOCUTRAC software is used for tracking both the location of and deadlines associated with a document in the system, and allows notes

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to be associated with the document, all as a part of petitioner's case management system.

On this record, respondent's software appears to be highly similar to petitioner's in that they both provide the function of tracking documents. Although respondent's software also displays documents, and petitioner's software provides "merging" functions, they nonetheless both share the key function of document tracking. While we cannot find that the goods are "indistinguishable," as petitioner urges, it appears that they are indeed highly similar.

The similarity of goods is thus a factor that strongly supports petitioner's claim for cancellation.

3. The similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels.

The subject application identifies respondent's goods as "computer software for use in tracking and displaying documents in legal proceedings" (emphasis added). The primary customers for such goods are undoubtedly those most closely involved in legal proceedings, namely, lawyers and law firms.

Petitioner testified that its goods have a variety of uses and can - and have been - adapted to a range of professional situations. Nonetheless, the testimony was perfectly clear that legal applications are the focus of petitioner's business. Indeed, Mr. Helin testified that

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petitioner's business is "99 percent legal." Helin Dep. 13. Mr. Helin further testified that petitioner advertises in legal magazines and maintains memberships in legal organizations in furtherance of its business.

Given this evidence, we find that the parties share a very substantial overlap in the classes of potential purchasers for their respective goods. Indeed, the customer base for both is nearly coextensive. Confusion is more likely when it is shown that the parties' goods are directed to the same class of customers, as it is almost inevitable that purchasers will be exposed to both marks.

This factor strongly supports petitioner's claim.

4. Conditions of Sale and Buyers to Whom Sales are Made

We doubt that the goods at issue here are purchased casually; petitioner's sales agreements indicate that its DOCUTRAC modules are sold as part of a software system that cost several thousand dollars in 1987. Moreover, purchase and use of such items involves important business decisions. As a result, purchasers might be expected to take considerable care in selecting them. Nonetheless, the marks at issue here are virtually indistinguishable, and they are both used on essentially the same goods. Even the most careful of purchasers would likely have difficulty distinguishing these marks.

This factor is neutral in our analysis.

5. Respondent's "Admission" of a Likelihood of Confusion

We finally note the argument regarding respondent's comment in its answer that "it is Registrant who is being injured by Petitioner's current use of "DOCUTRAC." Answer ¶ 9, see Petitioner's Br. at 13. Opposer contends that this is a tacit admission by applicant that there is a likelihood of confusion. We decline to construe this brief (and nonresponsive) comment in the answer as anything more than a denial of the corresponding allegation in the petition.⁴

IV. Conclusion

After consideration of the entire record, we conclude that petitioner has demonstrated its standing, that it has valid trademark rights in the mark DOCUTRAC, and that those rights are prior to respondent's. Moreover, in light of the virtually identical marks, highly similar goods, and the substantial overlap in the channels of trade and classes of customers for those goods, we conclude that continuance of respondent's registration would give rise to a likelihood of confusion, and that cancellation of respondent's registration is appropriate.

⁴ Paragraph 9 of the petition alleged that "Petitioner is further being injured by the existence of Registration No. 2,833,136 in that Petitioner has filed federal Trademark Application, Serial No. 76/598738 to protect its mark, which protection has been denied because of the existence of Registration No. 2,833,136. The allegation was denied, following which respondent added the comment quoted above.

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Decision: The petition to cancel is GRANTED.

Registration No. 2833136 will be cancelled in due course.