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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Complementary Solutions Inc.

Serial No. 74/599,568

David M. Lockman of Morris, Manning & Martin, L.L.P. for
applicant.

David M. Mermelstein, Trademark Examining Attorney, Law Office
103 (Michael A. Szoke, Managing Attorney).

Before Cissel, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Complementary Solutions Inc. has filed an application
to register the mark "TELEMATE" for "computer software that
monitors and reports information about telecommunications used by
a business".¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, so resembles the

¹ Ser. No. 74/599,568, filed on November 16, 1994, which alleges dates
of first use of April 14, 1986.

mark "TELE-MATE" and design, which is registered, as reproduced below,

TELE-MATE

for a "telephone headset, modular amplifier box,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

Turning first to consideration of the respective marks, we note, as has the Examining Attorney, that the marks are identical in sound and, except for an inconsequential hyphen,³ must be considered as identical in appearance since the stylization of registrant's mark is not so highly distinctive or unusual that it could not be said to be reasonably encompassed as a format in which applicant's mark, although presented in typed form, could appear.⁴ However, although the Examining Attorney also contends--and applicant has not argued otherwise--that the

² Reg. No. 1,889,724, issued on April 18, 1995, which sets forth dates of first use of January 1994.

³ As the Examining Attorney observes in his brief, "[t]his is underscored by applicant's own papers in this matter, which have consistently referred to the ... registrant's mark as 'TELEMATE' (no hyphen)."

⁴ See *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Moreover, "[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all

respective marks are "virtually identical" in commercial impression, we nevertheless find that the marks have subtle differences in connotation, and thus project somewhat different commercial impressions, as applied to the respective goods. Specifically, applicant's "TELEMATE" mark, when used in connection with its monitoring computer software, suggests that its product serves as a mate or companion to a business telecommunications system, while registrant's "TELE-MATE" mark, as applied to its telephone headset and modular amplifier box, implies an item designed to mate or connect to a telephone handset. Thus, notwithstanding the identity of the marks in sound and appearance, the differences in connotation and overall commercial impression, when combined with the differences, as discussed below, in the nature and use of the respective goods and the conditions of their sale, are sufficient to convince us that confusion is not likely to occur.

The Examining Attorney argues, however, that while, admittedly, "[t]he respective goods of the parties are clearly different" as shown by the advertising literature applicant submitted for both its goods and those of registrant, such products are nevertheless closely related items of telecommunications equipment which, even if the end users thereof differ, would still be principally bought by the same class of

reasonable manners in which ... [the word] could be depicted". INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992).

purchasers, namely, telecommunications managers. Specifically, the Examining Attorney maintains that:

Applicant's goods are identified as "computer software that monitors and reports information about telecommunications used by a business." The prior registrant's goods are identified as a "telephone headset, [and a] modular amplifier box." While the further information supplied by applicant about the goods at issue has been useful in determining their nature, it does not limit applicant's identification of goods. For instance,

despite applicant's statement that its goods are highly specialized and sell "typically in the \$1,000 and higher range," there is nothing inherent in applicant's identification of goods which distinguishes them from far less expensive products distributed in mass-market trade channels typical for inexpensive, shareware or free computer software. Applicant's potential purchasers are likewise limited only to "businesses" using "telecommunications" who might be interested in such monitoring and reports, a very broad group of potential customers including, *inter alia*, telemarketers, customer service departments, law firms, and any other business for which telecommunications costs are an important factor.

Registrant's goods are telephone headsets and amplifiers, which permit use of a telephone without the need to hold a handset. Any telephone user is a potential purchaser but such goods are typically used by those whose large volume of calls make the comfort and convenience afforded by a hands-free telephone attractive. Again, such businesses would include telemarketers, customer service departments, and law firms.

In view thereof, the Examining Attorney concludes that (footnote omitted):

[T]he potential purchasers of both [applicant's and registrant's goods] are largely the same. Any business with heavy telecommunications usage is a potential purchaser of both products. Both of the goods as tissue may be purchased as a component of the purchaser's telecommunications system. Both are clearly able to function together as a part of such a system.

Although applicant argues that its purchasers are particularly sophisticated, the identified goods are not limited in the application to the high-priced systems described [with]in the application. But even if applicant's goods were marketed only to "telecommunications managers," there is no

evidence that such persons do not also buy telecommunications *equipment* such as the registrant's headsets. Applicant's assertion that only those who purchase "paper, ink pens, and other office supplies" are the registrant's potential purchasers is unsupported by the record. Furthermore, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Telecommunications managers, as well as purchasers of other office software and equipment, are subject to confusion.

Applicant, in an effort to convey the marketplace realities underlying the decisions to purchase its goods versus those sold by registrant, has furnished as additional evidence the declaration, with supporting exhibits, of its president, Richard Mauro. In his declaration, Mr. Mauro states among other things that, while he has been in his current position for just over two years, he has "been in the computer/telecommunications

industry for 32 years"; that applicant makes and sells call accounting systems under the Telemate mark; that he oversees and directs the sales and marketing of such systems; and that, as indicated in an accompanying article from the July/August 1989 issue of Procomm Enterprises Magazine entitled "Call Accounting-- Select The Right System For You":

[C]ustomers of call accounting systems obtain leads for possible sources of call accounting systems. They then further investigate the features of the system and its compatibility with their equipment by conferring with sales representatives. An important component of the information provided to the purchaser involves identification of the source of the

call accounting program. This identification of source is important so [that] the purchaser may ascertain whether the source is capable of performing the installation and support for the call accounting system.

Mr. Mauro further avers in his declaration that, from his experience, "the typical purchaser of a call accounting system is a telecommunications manager with prior experience in telecommunication equipment and computer systems for such equipment"; that as evidenced by an attached article from the March/April 1990 edition of Edge magazine and as confirmed by his experience, "the typical purchasing decision for a call accounting system requires at least weeks, and probably months, before a sale is consummated"; that "[d]uring this time, there is a substantial interaction between the source of the call accounting system and the purchaser to provide information regarding the compatibility of the call accounting system with

the purchaser's equipment and the capabilities of the call accounting system"; and that an accompanying copy of applicant's March 1996 "Telemate Sales and Marketing Guide" provides "information [which is] presented to the sales staff for Telemate call accounting systems," "indicates the targeted consumers for the Telemate call accounting systems to be telecommunications managers for major corporations and other phone-intensive businesses," lists "[t]he problems ... addressed by telecommunications managers and the features of the Telemate systems which meet these needs" and "includes information regarding the source of the Telemate call accounting systems".

The Examining Attorney, as applicant points out in its reply brief, has largely ignored the factual information in Mr. Mauro's declaration, choosing instead to find applicant's computer software for monitoring and reporting business telecommunications uses and registrant's telephone headset and modular amplifier box to be closely related principally on the basis that such products are items of "telecommunications equipment." The mere fact, however, that a term may be found which encompasses the respective goods does not mean that customers will view the goods as related in the sense that they will assume that they emanate from or are associated with a common source. See, e.g., *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977) and *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975).

Here, as applicant points out in its initial brief, "the evidence of record shows that Applicant's software is used on a computer coupled to a PBX [("Public Branch Exchange")] or key system in order to perform the specialized functions required for monitoring and managing telecommunications for a business,"⁵ while "the [registrant's] 'telephone headset, modular amplifier box' ... is used at a telephone handset, does not monitor any telecommunications function and does not manage any telecommunication costs for a business." In short, as applicant further points out, "[t]he functions of the two goods as described in the application and registration are not related or complementary" and are, instead, so diverse that they would not be regarded by actual or prospective purchasers as coming from or sponsored by the same source merely because they arguably are subsumed under the broad rubric of "telecommunications equipment".⁶

⁵ As additionally explained by applicant, the evidence indicates that:

A key system is a simplified controller which performs functions similar to a PBX for a phone system having a few number of telephones. The computer and PBX are used in proximity to one another and are not accessible to telephone users. Rather, a PBX and a computer executing Applicant's software are part of a telecommunications facility which is typically stored in a area where there is limited access and environmental controls to protect the equipment. Consequently, Applicant's software does not execute on the computer of a user who would use a telephone headset in order to achieve hands free operation of a telephone for computer screen viewing and control.

⁶ Thus, as applicant further observes in its brief:

The simple point is: one buys a telephone headset and modular amplifier box to conduct a telephone conversation at a handset without having to pickup and

Furthermore, in the case of applicant's computer software products, it is clear that such goods would be bought by knowledgeable and sophisticated purchasers under circumstances which would dispel whatever confusion, if any, there might initially be as to whether such goods share the same source or sponsorship as registrant's telephone headsets and associated modular amplifier boxes. Here, as applicant stresses in its main brief, the evidence of record demonstrates that "the purchasers of Applicant's software are typically telecommunications managers with specialized knowledge and skills while the buyers of telephone headsets and modular amplifier boxes are persons making buying decisions based on criteria similar to buying paper, ink pens and other office supplies." Applicant's goods, unlike registrant's products, are also typically purchased after an extended period of several weeks to many months during which the customer is actively engaged with a sales representative of applicant in order to ascertain that the monitoring software

hold the hand receiver. One buys Applicant's software to install on the computer which is interfaced to a PBX or key system to generate accounting data from the PBX information, detect fraudulent use of a telecommunication facility or track inventory and services necessary to support the telecommunication facility. All of these features are part and parcel of the software to monitor and manage telecommunications for a business. Examiner [Mermelstein] cannot permissibly conclude that the goods are related because they both are used in some aspects of the telephone industry. There is no *per se* rule that goods which relate to a broad industry are likely to cause confusion. In re Quadram Corp., 228 U.S.P.Q. 863 (TTAB 1985) (*Per se* rule regarding relatedness of hardware and software in computer industry is too rigid and ignores marketplace realities). See also Information Resources,

under consideration meets the needs of the particular business and will operate as designed on its telecommunications system. By contrast, purchasers of registrant's comparatively less expensive goods require relatively little technical knowledge in order to be assured of acquiring products which are functionally compatible with the telephone headsets used by the business as part of its telecommunications system.

Thus, as applicant further contends in its initial brief, the "Examiner's position that the telecommunications managers for most corporations and businesses in the United States also purchase telephone headsets and modular amplifier boxes is unreasonable given the evidence demonstrative of the very different decision which must be made to purchase Applicant's software." The Examining Attorney's assertion that business purchasers of applicant's goods are generally extensive users of telephones, and thus may also need to have their telephone users enjoy the hands-free convenience provided by registrant's products, does not mean that the respective items are purchased by the same individuals. As emphasized by our principal reviewing court in *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), "the mere purchase of the goods ... of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers" leading to

Inc. v. X*Press Information Services, 6 U.S.P.Q.2d 1034 (TTAB 1988).

a likelihood of confusion inasmuch as "likelihood of confusion must be shown to exist not in an *institution*, but in 'a customer or purchaser,'" *citing* Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 UPSQ 786, 790 (1st Cir. 1983) ["[i]f likelihood of confusion exists, it must be based on the confusion of some relevant person; *i.e.*, a customer or purchaser"]. The evidence of record indicates, however, that an appreciable commonality of individual purchasers does not exist.

Finally, even if there is a small number of purchasers with the requisite knowledge to buy applicant's telecommunications monitoring and reporting software and who would also make the purchasing decisions regarding telephone accessory items like registrant's goods, confusion as to origin or affiliation is still not likely due to the degree of care required to be exercised in selecting applicant's goods and the extended period of interaction prior to consummating such a sale. Although it is, of course, the case that, as asserted by the Examining Attorney, even sophisticated purchasers are not necessarily immune from source confusion, the evidence presented herein and the subtle but significant differences in connotation between the respective marks convince us that the possibility of such confusion is at best remote. As stated in *Witco Chemical Co., Inc., v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 164

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USPQ 43, 44-45 (CCPA 1969), and which is quoted in *Electronic Design & Sales*, supra at 1391:

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.

It is accordingly our conclusion that applicant's "TELEMATE" mark, when used in connection with computer software that monitors and reports information about telecommunications used by a business, does not so resemble registrant's "TELE-MATE" and design mark for a telephone headset and modular amplifier box that there is a likelihood of confusion.

Decision: The refusal under Section 2(d) is reversed.

R. F. Cissel

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board