

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 27, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Economic Analysis Group, Ltd.

Serial No. 74/683,774

Marsha Gentner of Jacobson, Price, Holman & Stern, PLLC, for
Economic Analysis Group, Ltd.

Dawnmarie Sanok, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Simms, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 2, 1995, applicant filed the above-referenced
application to register the mark "CASETRACK" on the
Principal Register for goods and services which were
subsequently amended to read as follows: "software for
managing legal services," in Class 9; and "computer
services, namely installation and maintenance of computer
software," in Class 42. Applicant's claim of use of the
mark since July of 1992 was the basis for the application.

This case is now before the Board on appeal from the

final refusal to register based on Section 2(d) of the Lanham Act. The Examining Attorney has held that applicant's mark, as used in connection with the goods and services set forth in the application, so resembles the mark "CASETRAC," which is registered¹ for "printed reports on the status of litigation," in Class 16, that confusion is likely.

Responsive to the refusal to register, applicant made of record copies of reports from a commercial database concerning four third-party registrations which were reported to have been issued to different entities for legal publications, on one hand, and software for use in the legal field, on the other. The two marks in the four registrations are "LAW TALK," and "ON POINT." Based on the coexistence of these registrations, applicant argued that the products and services in the case at hand are so different that confusion is not likely.

Along with a request for reconsideration, applicant submitted copies of the file of the application which matured into the cited registration.² Applicant argued that

¹ Reg. No. 1,599,589, issued on the Principal Register to Williams & Montgomery Ltd. on June 5, 1990. Use since September 1, 1988 was claimed.

² In addition, applicant submitted with its appeal brief a copy of a page from the Official Gazette, May 27, 1997 edition. The entry relates to a registration owned by another third party. Ordinarily, because this evidence was untimely submitted under Trademark Rule 2.142(d), it would not have been considered by the Board. Because the Examining Attorney did not object to it, and in fact considered it and directed argument as to its probative

the specimens submitted with the application and with the affidavit subsequently filed in connection with the registration show that the registrant's reports are only provided to the registrant's own clients, and that therefore it is clear that the goods of the registrant are so different from the goods and services in connection with which applicant uses the mark that confusion is not likely.

Both applicant and the Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the facts of record in this application and the relevant legal principles, we hold that the refusal to register is proper. Confusion is likely because the goods and services set forth in the

value, however, we have considered it as if it had been properly made of record. It does not alter our resolution of this appeal, however. That the Patent and Trademark Office has registered the mark "CaseTrack" for database management software related to health-services and social-services professionals and organizations does not establish that the mark is so weak in the field of services related to the practice of law that confusion is not likely in the instant case. In a similar sense, applicant's reference to Reg. No. 1,548,969, alleged to be another mark which includes the term "CASE TRACKING," does not change the result in the instant case. Although not properly made of record, that registration was also considered and argued by the Examining Attorney, so we too have considered it, but all it shows is that the disclaimed term "CASE TRACKING" has a descriptive connotation with respect to the services set forth in that registration. The suggestive natures of the marks in the case before us are not in question, so applicant's references to these third-party registrations do not establish that the marks at issue in this appeal are not likely to cause confusion when they are used in connection with these goods and services.

application and the cited registration are closely related, if not overlapping, and the marks are essentially the same.

Turning first to consideration of the marks, we note that even applicant does not seriously dispute the fact that these two marks are very similar. The minor difference in spelling is hardly likely to be the basis for anyone to distinguish between the two.

Rather than arguing that differences in the marks allow purchasers to avoid being confused, applicant argues that the registered mark is "weak," and is therefore entitled to extremely narrow scope of protection, which, not surprisingly, according to applicant, does not extend to encompass applicant's goods and services. Applicant argues that its goods and services are significantly different from the goods sold by registrant under the mark, with different trade channels and different, sophisticated purchasers. Further, applicant contends that there has been no actual confusion caused by the two marks, and argues "[t]hat these marks have peacefully existed for such an extensive period irrefutably demonstrates that no likelihood of confusion exists between these marks." (April 29, 1996 response, p.3). We disagree. For the reasons which follow, none of these arguments persuades us that confusion is not likely.

Turning first to applicant's "weak mark" theory, we note that there is no support in the record for the

contention that the registered mark is weak in source-identifying significance. There can be little doubt that anyone with an ordinary understanding of the English language would recognize that both applicant's and registrant's marks, as used in connection with the goods and services set forth in the application and the cited registration, are suggestive of keeping track of cases. The third-party registrations argued by applicant do no more than echo this fact. This suggestiveness, however, does not create a situation in which the registered mark is not afforded protection. Even suggestive marks, when registered on the Principal Register, are entitled to protection against registration of similar marks for related goods and services.

In resolving the question of whether confusion is likely, the Board must consider the goods and services as they are identified in the application and the cited registration, respectively, without any limitations or restrictions which are not reflected therein. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). Applicant's attempt to limit or restrict the registration in this ex parte proceeding is an impermissible collateral attack on the validity of the registration. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We are therefore not concerned with applicant's allegations

that the goods which registrant actually markets under the registered mark differ from the goods as they are identified in the registration.

The same principle applies to applicant's contentions that the registered mark is merely descriptive of the goods set forth in the registration. This is also an impermissible collateral attack on the validity of the registration. See: *In re White Swan Ltd.*, 8 USPQ2d 1534 (TTAB 1988); and *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971).

Applicant argues that its goods and services are quite different from the goods specified in the cited registration, so that even if we do not find the registered mark to be weak, confusion as to source is not likely. If we ignore applicant's attempt to limit its goods and services beyond the language it used in the application, however, and we also ignore applicant's attempt to restrict the goods of the registrant to what applicant contends registrant actually markets under the registered mark, and, instead, we compare the goods and services only as they are identified in the application and the registration, respectively, we find that there is a close relationship, if not overlap, between them. Applicant has used broad language to describe its software, and that language encompasses software that would produce the kind of reports

that are specified in the cited registration. The application reads "software for managing legal services." The registration specifies "printed reports on the status of litigation." Applying reason and the ordinary meanings to the words used in these statements, as we must, it is obvious that the issuance of reports on the status of litigation would be considered to be one facet of managing legal services. Put differently, it would not be unreasonable to expect that applicant's software, which is used for the management of legal services, would be able to generate reports on the status of litigation.

In fact, the specimens submitted with the application indicate as much. The advertisement states that applicant's software keeps track of legal matters, and provides information about each such matter, including a listing of legal fees accrued, a chronological record of events and activities, critical date information, and the content, location, and check-out history of paper files relating to the particular legal matter. A report providing "pertinent information about each matter," as applicant's specimen puts it, would include information concerning the status of a legal matter that is being litigated. If a law firm or a client corporation with many legal matters pending at any given time were to encounter reports on the status of litigation and software capable of generating such reports

both being marketed under marks as similar as "CASETRACK" and "CASETRAC," confusion would surely be likely to occur.

Applicant's contention that registration is supported by the third-party registrations to different entities for both legal publications and software for use in the legal field is without merit. The mere existence of such registrations does not establish, for the purposes of the instant appeal proceeding, that the particular goods and services set forth in this application and the registration which has been cited as a bar to it, both of which are different from what is purported to be listed in the four third-party registrations, are not related goods and services. As discussed above, the plain meanings of the words used in the application and registration indicate otherwise.

We also find that confusion is likely with respect to the services identified in the application as "computer services, namely installation and maintenance of computer software." The broad wording of these services in the application encompasses the installation and maintenance of the software for managing legal services which applicant markets under the same mark. For the reasons set forth above, confusion is likely when these very similar marks are used on both that software and the litigation status reports specified in the cited registration. The same reasoning

leads to the conclusion that confusion is also likely when the same similar marks are used in connection with the installation and maintenance of the software that would be used to produce the litigation status reports and the printed reports themselves.

That no actual confusion has come to applicant's attention is not determinative of the issue of whether confusion is likely in this case. It is well settled that in resolving an appeal of a refusal to register based on Section 2(d) of the Trademark Act, the issue before the Board is whether confusion is likely, not whether it has actually occurred. Proof of actual confusion is not a prerequisite to a finding of likelihood of confusion. *Towers v. Advent Software Inc.*, 17 USPQ2d 1471 (TTAB 1989).

In summary, confusion is likely because the marks at issue here are very close to the same, and the goods identified in the cited registration, namely printed reports on the status of litigation, are just the type of thing one would expect applicant's software for managing legal services to be able to generate. Accordingly, the refusal

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to register under Section 2(d) of the Lanham Act is affirmed as to both classes of services set forth in the application, and registration to applicant is refused.

R. L. Simms

R. F. Cissel

E. W. Hanak
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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