Paper No. 14
HANAK/md

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Transaction Network Services, Inc. assignee of Omnilink Communications Corporation.

Serial No. 75/100,174

Jennifer A. Albert of Arent, Fox, Kintner, Plotkin & Kahn, PLLC for Transactions Network Services, Inc.

Richard Y. Kim, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney)

Before Hanak, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Transaction Network Services, Inc. (applicant) seeks to register in typed drawing form RETAILINK for "telecommunications equipment for transmitting and receiving digital and analog signals over an integrated services digital network, namely used for voice and data transmissions in

telecommunications applications such as high speed data send/receipt, multiple voice connections, global computer network access, small office, and retail environments." The application was filed on May 7, 1996 with a claimed first use date of March 26, 1996.

The Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark RETAIL LINK, previously registered to Wal-Mart Stores, Inc. for "computer software for use by retail establishments and their vendors with respect to inventory control, pricing and product requirements." Registration No. 1,843,483.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarity of the marks and the similarity 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.")

In this case, the marks are almost identical, and applicant does not argue to the contrary. The fact that the marks are almost identical "weights heavily

against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that applicant has selected a nearly identical mark previously used by registrant "weights [so] heavily against the applicant" that applicant's proposed use of the mark on "goods … [which] are not competitive or intrinsically related [to registrant's goods] … can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993).

Turning next to a consideration of the goods, while they need not be intrinsically related for a finding of likelihood of confusion, we find that, in point of fact, registrant's goods and at least certain of applicant's goods are clearly related. Under such circumstances, there is not a mere likelihood of confusion, but a strong likelihood of confusion.

Registrant's description of goods is reasonably short and easy to understand: "Computer software for use by retail establishments and their vendors with respect to inventory control, pricing and production requirements." Applicant's chosen description of its goods includes telecommunications equipment for data transmissions utilizing computers. Indeed, applicant acknowledges that both its goods and registrant's goods "fall into the broad category of computer related products." (Applicant's brief page 4). Applicant's own chosen description of its goods states that its goods can be utilized in, among other areas, "retail environments." Thus, both applicant's

goods as described and registrant's goods as described involve the use of computers for transmitting data to and from retailers. Under such circumstances, applicant's use of a mark which is virtually identical to registrant's mark is likely to result in confusion.

Applicant argues that in actuality "the Wal-Mart computer software program is an in house program and is only used between Wal-Mart stores and between Wal-Mart and its vendors. Furthermore, the [registrant's] RETAIL LINK software is not purchased. Wal-Mart provides the software programs free of charge to its vendors for use on the Internet to enable its vendors to check inventory and pricing and establish production requirements and to provide the retail link service." (Applicant's brief page 6).

Assuming the correctness of the foregoing statements made by applicant, the problem with applicant's argument is that in proceedings such as this, we must consider the goods as described in applicant's application and registrant's registration. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). As described in the application and registration, the goods are, at least in part, very closely related.

We have taken into account applicant's arguments that the goods of applicant and registrant are "highly technical goods" which are sold to "sophisticated purchasers." (Applicant's brief page 7). However, given the fact that the marks are virtually identical and the fact that at least some of

applicant's goods are closely related to registrant's goods, we find that even sophisticated purchasers would be confused by the contemporaneous use of applicant's mark and registrant's mark.

Decision: The refusal to register is affirmed.

E. W. Hanak

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board