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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Hanta Yo Company, Inc.**

Serial No. 75/197,155

Simor L. Moskowitz of Jacobson, Price, Holman & Stern, PLLC
for applicant.

John Tingley, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before **Quinn, Wendel** and **McLeod**, Administrative Trademark
Judges.

Opinion by **McLeod**, Administrative Trademark Judge:

An intent-to-use application has been filed by Hanta Yo
Company, Inc. to register the mark TOPOGUIDE for "computer
software for the creation, storage, retrieval and
manipulation of geographic databases and related demographic,
commercial, topographical, geologic, natural resource,

recreational, educational, travel and navigational data, and accompanying instruction manuals."¹

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to the identified goods, so resembles the previously registered mark shown below for "computer mapping software

TOPO!

for editing, printing and annotating topographical maps of various regions of the world" as to be likely to cause confusion.²

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested. We affirm.

The Examining Attorney contends that the involved marks are similar in overall commercial impression. The Examining Attorney argues that both marks contain the term "topo,"

¹ Application Serial No. 75/197,155, filed November 8, 1996, based upon a bona fide intent to use the mark in commerce under Section 1(b), 15 U.S.C. § 1051(b).

² Registration No. 2,007,737, issued on October 15, 1995, setting forth dates of first use of August 11, 1995.

which is the dominant portion of applicant's mark. According to the Examining Attorney, the term "guide" is more descriptive than the term "topo." The Examining Attorney also claims, among other things, that the parties offer related computer software products for topographical use.

Applicant, on the other hand, argues that confusion is unlikely because registrant's mark is entitled to a narrow scope of protection. According to applicant, the Examining Attorney has improperly dissected the marks and focused on the weak term "topo" as the only common element. Applicant maintains that the term "topo" is merely descriptive or generic of topographical related goods and services, and thus entitled to reduced protection. Applicant notes the coexistence of third-party applications and registrations containing the term "topo" for software products, and submits that consumers are accustomed to seeing and distinguishing between such marks.

While applicant acknowledges that both parties offer computer software concerning topographical subject matter, applicant contends that the involved goods have different purposes, functions and uses. Applicant emphasizes that its computer software is used with geographical "databases" and "data", whereas registrant offers "computer mapping software." (Applicant's Reply Br. at 1-2). Applicant claims

that registrant's "computer mapping software" functions like computer-aided design (CAD) software with pre-existing maps, which is more likely to be of interest to professional cartographers, rather than statisticians. (Applicant's Reply Br. at 4). Because of the asserted "highly technical nature" of the goods and "sophistication" of the purchasers, applicant submits that there is no likelihood of confusion.

In support of its position, applicant relies upon a dictionary definition of the term "topo" to mean "topography" or "1 orig., the accurate and detailed description of a place 2 a) the science of drawing on maps and charts or otherwise representing the surface features of a region, including its relief, rivers, lakes, etc." *Webster's New Old Dictionary*, 1410 (1988). Applicant has also submitted a list of several Internet sites containing the term "topo" and "map."

Before turning to the merits of the appeal, we must address two procedural issues. First, applicant has submitted evidence with its appeal brief, including a computerized search report and copies of exhibits previously submitted during prosecution. Applicant argues, in a footnote in the brief, that the list of third-party applications and registration(s) should be considered by the

Board on appeal.³ In the alternative, applicant requests suspension of the appeal and remand to the Examining Attorney for consideration of the evidence. The Examining Attorney objects to consideration of the evidence.

Second, on December 28, 1999, applicant filed a separate request to suspend the appeal and remand the application for examination of other "newly available evidence." This time, applicant seeks to introduce evidence concerning the prosecution of another application for a mark including the term "topo." Applicant claims that the "new evidence" was unavailable until July 2, 1999.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that if applicant wishes to introduce additional evidence after an appeal is filed, it may file a request for remand. See TBMP §§ 1207.01 & 1207.02. Any request to suspend and remand for additional evidence must be filed prior to the rendering of the Board's final decision on the appeal. In addition, the request must include a showing of good cause (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to

³ Applicant's reliance upon Trademark Rule 2.122 is misplaced. The appropriate rule governing evidence in an ex parte proceeding is Trademark Rule 2.142.

appeal), and be accompanied by the additional evidence sought to be introduced. TBMP § 1207.02.

In this case, we agree with the Examining Attorney that the additional evidence submitted with applicant's appeal brief is untimely.⁴ Applicant's request for remand was buried in a footnote in the brief, and thus it was not noted by the Board until the rendering of this final decision. Moreover, applicant has failed to explain why it was unable to present this evidence prior to filing the appeal.⁵

Applicant's second request for remand is also not well taken. While the discovery of previously unavailable evidence may constitute good cause for remand, applicant has failed to explain the six-month delay between the date the "new evidence" first became available (July 2, 1999) and the filing date of applicant's second request for remand (December 28, 1999). In fact, there is no mention of the

⁴ The Board has, of course, considered the dictionary definition and Internet evidence originally submitted by applicant on January 9, 1998.

⁵ Even if the excluded evidence is considered on appeal, we would reach the same result in this case. A computerized list of third-party applications and/or registration(s) ordinarily cannot be considered unless actual copies thereof are made of record. Also, **third-party applications and/or registrations are** entitled to little weight because they do not evidence what happens in the market place or that customers are familiar with them. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973); *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563, 567 (TTAB 1975).

specific date on which applicant first discovered the "new evidence."⁶

Accordingly, applicant's requests for remand are denied, and the above-mentioned evidence has been given no consideration.

Turning to the merits of the appeal, in determining whether there is likelihood of confusion between two marks, we must consider all relevant factors as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d) of the Trademark Act, two of the most important considerations are the similarities between the marks and the similarities between the goods.

With respect to the relatedness of the involved goods, the issue of likelihood of confusion is determined on the basis of the goods as set forth in the application and the cited registration. See *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). It is well settled that the goods need not be identical or even competitive in nature to support a finding of likelihood of

⁶ In any event, the Board is not bound by the decisions of Examining Attorneys in allowing other "topo" marks to be registered. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

confusion. Instead, it is sufficient that **the goods are related** in some manner and/or the **circumstances** surrounding their marketing are such that they would be likely to be encountered by the same classes of purchasers. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

It is true that there are differences between the parties' computer software products. Applicant's computer software is used to create, store, retrieve and manipulate geographic "databases" and "data" related to, among other things, topographical subject matter. Registrant, on the other hand, offers computer "mapping" software for editing, printing and annotating topographical "maps."

Applicant acknowledges, however, that both parties offer computer software products concerning topographical subject matter. Moreover, contrary to applicant's contention, neither applicant nor registrant limited their identification of goods to "statisticians" or "professional cartographers." We must assume, therefore, that the parties offer their goods in the same channels of trade and to the same classes of

customers. See TMEP § 1207.01(a)(iii), citing *In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987).⁷

Furthermore, applicant's identification of goods may be read to encompass the same topographic data or information featured on registrant's topographical maps and vice-versa. Based upon the identifications, it is reasonable to conclude that both products would appeal to consumers interested in computer software products concerning topographical subject matter, and are likely to be promoted in similar ways. In short, we conclude that the parties' computer software products are related for purposes of likelihood of confusion.

In comparing registrant's mark TOPO! with applicant's mark TOPOGUIDE, we find the commercial impressions of the marks to be sufficiently similar that, when used in connection with related software products, consumers are likely to be confused. Both marks include the same term "TOPO", which constitutes the whole of registrant's word mark and the first term in applicant's composite mark. It is a general rule that a subsequent user may not appropriate the entire mark of another as part of a composite mark where that portion is the recognizable and dominant feature of the

⁷ Applicant has made some forays into arguments concerning the level of sophistication of purchasers. (Applicant's Reply Br. at 3, 5 and 10). However, applicant has failed to provide any evidence in support of its position. Accordingly, we have not given these arguments any weight in our determination.

applied-for mark. See *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 432, 117 USPQ 213, (CCPA 1958); *Miller Brewing Co. v. Premier Beverages, Inc.* 210 USPQ 43, 48 (TTAB 1981).

We recognize that the term "topo" may be suggestive when used in connection with the parties' respective goods. However, we agree with the Examining Attorney that the term "topo" is the more dominant portion of applicant's mark, and that applicant has merely added the descriptive or generic term "guide" to registrant's mark. In this regard, we note that at least one court has found the term "guide" to be generic for computer software in general. See *Kegan v. Apple Computer, Inc.*, 42 USPQ2d 1053 (N.D. Ill 1996).

Moreover, it must be remembered that applicant is seeking to register TOPOGUIDE in typed form. This means that applicant's mark is not limited to any special form, and it may be shown in the same lettering size and style as registrant. See Trademark Rule 2.52(a)(1); *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 1378, 170 USPQ 35, 36 (CCPA 1971); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).⁸

⁸ Although registrant's mark includes an exclamation point, we find that this punctuation has no significant effect on the commercial impression of registrant's mark. See e.g. *In re Ervin*, 1 USPQ2d 1665 (TTAB 1986)(use of slanting script and quotation marks in mark THE "ORIGINAL"); *In re Burlington Industries, Inc.*,

To the extent that any of the points raised by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we must resolve that doubt in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*,

196 USPQ 718 (TTAB 1977)(**exclamation point** in CHAMPAGNE! fails to impart separate meaning).

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837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, supra.*

Decision: The refusal to register is affirmed.

T. J. Quinn

H. R. Wendel

L. K. McLeod
Administrative Trademark
Judges, Trademark
Trial and Appeal Board