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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re E.E.P.D. Electronic Equipment Produktion &
Distribution GmbH

Serial No. 75/409,001

Russell D. Culbertson of Shaffer & Culbertson, L.L.P. for
E.E.P.D. Electronic Equipment Produktion & Distribution
GmbH.
D. Beryl Gardner, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before **Cissel**, **Seeherman** and Chapman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 22, 1997, applicant, a corporation of
Germany, filed the above-referenced application to register
the mark "PROFIVE" on the Principal Register for a long
list of goods in Class 9. One basis for the application
was applicant's assertion that it possessed a bona fide
intent to use the mark on these goods in commerce. The
application also was based on applicant's registration in
Germany of the same mark for "electric and electronic

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apparatus, equipment and instruments and their electric and electronic assembly, etc.," in Class 9. A copy of this German registration was submitted.

The Examining Attorney refused registration under Section 2(d) the Lanham Act on the ground that applicant's mark, when used on the goods specified in the application, would so resemble three trademarks registered in the United States that confusion would be likely. All three are owned by the same entity, BASIS International, Ltd., a New Mexico corporation. Reg. No. 2,054,434 issued on the Principal Register on April 22, 1997 for the mark shown below

for "computer programs for use in designing applications used in the field of business data processing," in Class 9. Reg. No. 2,054,433, also issued on the Principal Register the same day, is for the mark shown below

(with a disclaimer of the term "DATA SERVER") for the same goods. The third cited registration was Reg. No. 2,141,774, which issued on the Principal Register on March 10, 1998, for the mark shown below

(with a disclaimer of the word "VISUAL") for "computer programs for use in the development of other computer software for use in spread sheeting and business applications," in Class 9.

The Examining Attorney also held that the identification-of-goods clause in the application as filed was indefinite because some of the terms therein were overly broad.

Applicant responded with a three-page amendment to the way its goods were identified in the application as well as written arguments that confusion would not be likely in view of the cited registered trademarks.

The Examining Attorney was not persuaded by applicant's arguments, however, and the second Office Action made the refusal to register under Section 2(d) of the Lanham Act final. Submitted in support of the refusal were copies of several third-party registrations and copies of pages from applicant's web site. The final refusal also repeated the requirement for a more definite identification-of-goods clause in the application. Several

pages of information were provided, specifying the particular language in the application, as amended, which was deemed to be indefinite.

Applicant responded by filing a notice of appeal, and shortly thereafter, another proposed amendment to the identification-of-goods clause, an amendment deleting Section 1(b) of the Lanham Act as a basis for registration, (leaving Section 44(e) as the sole basis for registration), and more arguments on the issue of likelihood confusion. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the amendments and the arguments submitted by applicant.

Applicant and the Examining Attorney were able to agree on an Examiner's Amendment to the identification-of-goods clause, but the refusal to register under Section 2(d) of the Act was maintained. The application, as amended, identifies applicant's goods as follows:

"electric and electronic apparatus, equipment and instruments and their parts therefor, for regulating and signaling, namely, guiding and navigation systems for trains, airplanes, automobiles, traffic directing systems, traffic routing systems, tracking systems, and tracking systems controlled by satellite transmission; accident memory systems comprising vehicle data recorders; engine control apparatus, namely, electronic processors adapted to monitor engine performance and provide engine control signals; flight analyzers for detecting vehicle position; tachographs; electronic deck logs for recording vehicle

operation records; satellite control apparatus; spacecraft control apparatus; electronic teaching apparatus and instruments, namely, electronic books; electrical transformers; capacitors; electrical cables and wires; electrical wire connectors; electrically lighted displays for advertising purposes; electrical circuits, namely, circuits for regulating and controlling electrical current voltage; electronic apparatus instruments for light current engineering, namely, high frequency transmitters; cash registers; calculators in the nature of calculation machines; automatic vending machines; electronic coin-operated mechanisms; computers; data processors; computer chips; electrical power supplies; computer cable; printed circuit boards for computers, namely motherboards, graphics boards, interface cards, and computer interface boards; data acquisition equipment and data input equipment, namely, computer monitors, computer keyboards, computer mouse, touch pads, touch screens, input display screens, datagloves, dataglasses, video monitors, bar code readers, optical character scanners, image scanners, electric touch sensitive switches, microphones, cameras; data output equipment, namely, printers, plotters, and speakers; data communications and telecommunication equipment, namely, modems, TV-decoder for computers, ISDN accessories, namely digital signal processors; computer hard disk drives, computer memory cards, magnetic tapes drives, computer CD drives, computer floppy disk drives, computer DVD drives, computer memory chips, electronic apparatus for recording, transmission or reproduction of sound or images, namely, video tape decks, audio tape decks, CD players, DVD players, CCDs, tuners, receivers, television sets, amplifiers, loudspeakers, signal processors, mixers, optical disk players, audio visual receivers, graphic equalizer; photographic projectors, image projectors for use with personal computers; apparatus for recording electrical currents and fields, namely, scannographs; NMR-tomography apparatus not for medical use; radiographic apparatus not for medical use; ultrasonic scanning apparatus not for medical use; electric and electronic modules, namely, assembled and unassembled printed circuit boards, circuit boards; electricity conduits, namely, distribution boards and boxes; electric switches; electric and electronic circuits; printed circuits; blank magnetic data carriers; electric and electronic apparatus, equipment and instruments and their parts therefor for weighing, measuring, testing, examining, inspecting, controlling, supervising, namely in the field of the automotive

industry, manufacturing industry, foodstuff industry, agriculture, aeronautics, astronautics, astronomy, oil refining, packaging industry, chemical refining, chemistry, medical engineering, genetic engineering, biochemistry, seafaring, research of materials, geology, electrical power engineering, electrical power distribution, chronometry, and optical systems, microscopes; metrology instruments. International Class 9.

The Board resumed action on the appeal and applicant filed its brief. The Examining Attorney filed a brief in support of the refusal to register and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

The sole issue presented by this appeal is whether confusion is likely between applicant's mark, in connection with the goods specified in the application, as amended, and each of the cited registered marks, in connection with the goods specified in those registrations.

As is frequently the case when the issue is likelihood of confusion, in the instant case, a key consideration is the similarity between the cited registered marks and the mark sought to be registered. Notwithstanding applicant's arguments to the contrary, we find that applicant's mark is similar to each of the three cited marks because each registered mark consists of or is dominated by "PRO 5" or a close approximation of "PRO 5," and applicant's mark, "PROFIVE," is identical in pronunciation to this term and

creates a commercial impression which is very similar to the commercial impressions created by the cited registered marks.

The reason we cannot agree with the Examining Attorney that confusion would be likely if applicant were to use its mark in connection with the specific items of computer hardware listed in the application is that the Examining Attorney has not established that these items are related to the computer software products listed in the cited registrations in such a way that the use of these similar marks in connection with both would likely lead to confusion.

It has been the law for some time now that there is no per se rule that confusion will necessarily result when similar marks are used in connection with both computer hardware and computer software. In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985); and Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988). In order to support refusing registration under Section 2(d) where the goods in the application and the cited registration are respectively software and hardware, the burden is on the Trademark Examining Attorney to make of record evidence that establishes that the goods are sufficiently related such that confusion is likely.

In the instant case, the Examining Attorney attempted to satisfy this requirement, but the evidence she relies on simply falls short of establishing that the goods in the application are commercially related to the goods specified in the cited registrations in such a way that the use of these similar marks on them is likely to cause confusion.

The evidence consists of copies of several third-party registrations and copies of two pages from applicant's web site. Although the Examining Attorney contends in her brief (p. 6) that the third-party registrations show "...that a single owner provides the applicant's goods and the registrant's goods," the registrations she made of record do not even show that goods of the type identified in the application are provided by the same entities which provide the kinds of products listed in the cited registrations. As applicant points out, the third-party registrations in question were submitted by the Examining Attorney with the final Office Action of March 5, 1999, for the expressed purpose of showing "that a single source provides both computer programming services and computer software." (p. 3). This they do, but the commercial relationship between programming services and software is not the issue before us in this appeal. The products listed in the cited registrations are computer software, but applicant's goods,

as identified in the application, are all items of computer hardware.

In a similar sense, the excerpted pages from applicant's web site are equally unpersuasive of the proposition the Examining Attorney sought to prove. Although she contends that this evidence shows "that applicant provides both computer hardware and computer programming software," (brief p. 6), what it actually shows is that applicant can develop and produce specialized circuit boards. This is a far cry from establishing that applicant produces both the specific hardware items listed in the application and the goods listed in the cited registrations, i.e., specialized software used to develop other software for use in business data processing and other applications.

Without evidence in support of her contentions, the Examining Attorney has left the Board with no basis upon which to agree with her conclusion that the products listed in the application are commercially related to those recited in the cited registration. Thus, even though the marks used on all these goods are similar, on this ex parte record, we cannot find that confusion would likely result from applicant's use of its mark on the goods listed in the application.

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Accordingly, the refusal to register under Section 2(d) of the Lanham Act is reversed.

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