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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Genex Corporation, Inc.

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Serial No. 76/074,262

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Sydelle Pittas of Pittas\Koenig for Genex Corporation,  
Inc.

William T. Verhosek, Trademark Examining Attorney, Law  
Office 114 (Margaret K. Le, Managing Attorney).

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Before Hairston, Chapman and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Genex Corporation, Inc. (applicant) filed an  
application to register the mark GENEX (in typed form) on  
the Principal Register for services ultimately identified  
as "export agencies in the field of heavy industrial  
equipment and materials for electronic and telephonic  
communication systems" in International Class 35.<sup>1</sup>

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<sup>1</sup> Serial No. 76/074,262, filed June 20, 2000. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. In its appeal brief, applicant stated that it "agrees to delete the word 'electric' from its recitation" of services. Brief at 4. It then set out the services to read "...

The examining attorney ultimately refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration<sup>2</sup> of the mark GENEX (in typed form) for:

Advertising for others via electronic communications networks in the fields of computers, computing, computer and technology-related services, or entertainment; and procurement services for others, namely, the purchasing and resale of computer hardware, computer software and peripherals in International Class 35.

Production of entertainment and educational material for dissemination by electronic communications networks, namely, animation, motion pictures, music and dialogue, multimedia entertainment or educational software, radio or television shows in International Class 41.

Computer programming for others; developing, hosting, maintaining, or providing the programming for websites and on-line magazines for others on electronic communications networks; custom interactive writing services for others; consultation services regarding computers and electronic communications networks in International Class 42.

After the examining attorney made the refusal final, this appeal followed.

The examining attorney's position is that computer hardware, computer software, and peripherals are common components of electronic and telephonic communication

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electric, electronic and telephonic communication systems." In the event that applicant is ultimately successful in this case, the identification of services should be clarified to reflect the services the examining attorney accepted.

<sup>2</sup> Registration No. 2,304,435, issued on December 28, 1999.

systems. The examining attorney relies on the following evidence for this assertion.

LAN is the internal electronic communication system containing the computer-related hardware and software that employees work with. *Chicago Tribune*, February 23, 1998, p. C7.

[M]ajor computer companies want to build encryption into everything from desktop computers to cellular phones. If that happens, electronic communications systems of every kind would be impervious to eavesdropping. *Boston Globe*, September 13, 1997, p. F1.

Desktop University provides delivery of the ATI training materials through IBM's own electronic communication systems, that works with a mainframe computer... *Los Angeles Business Journal*, August 15, 1994, p. S12.

Electronic communication systems simply do with computers what has been done for tens and even hundreds of years... *Journal of Commerce*, November 7, 1990, p. 2B.

IVoice.com Inc. designs and manufactures voice and computer telephony communications systems. *The Record (Bergen County, NJ)*, June 20, 2001, p. B3.

IDT Corp. said it was offering the first telephone communications system that allows computer users to make calls to regular phones... *Chicago Sun-Times*, August 11, 1996, p. 41.

The deal with Siemens could give IBM an important tie with a company on the cutting edge of central office switches, the newest computer-to-telephone communications system... *Los Angeles Times*, November 13, 1998, p. 2.

In addition, the examining attorney submitted copies of six registrations (Nos. 2,420,943; 2,212,598; 2,078,856; 2,118,827; 1,900,081; and 1,820,788). These registrations

"indicate several entities that are in the exporting and procurement and purchasing business." Brief at 3. The examining attorney argues that because "the identification of the applicant's services is very broad, it is presumed that the application encompasses all services of the type described, including those in the registrant's more specific identification." Brief at 4. The examining attorney held that there was a likelihood of confusion because the marks are identical and the services are related.

Applicant, on the other hand, emphasizes the nature of its services in arguing that there is no confusion. "Applicant's business is arranging for export [only - not import] of 'heavy industrial equipment for electronic and telephonic communication systems,' primarily to Venezuela. The exported goods are massive machines and whole systems used by foreign countries, principally in South America, to build their commercial and public infrastructure and electronic and telephone systems." Brief at 2. Applicant also points out that the registrations the examining attorney refers to contain a separate listing of the services of the export agency and that "business people understand that export services are separate, apart, and different from, procurement and purchasing services."

Brief at 3. Applicant also argues that despite the fact that it has filed an intent-to-use application, the name of applicant's company is Genex Corporation, and there has been no actual confusion since 1997. As a result, applicant submits that the examining attorney's refusal should be reversed.

We affirm the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start our analysis by noting the obvious: applicant's and registrant's marks are identical. Both marks are for the identical word, "Genex," in typed form. The record does not contain any evidence that the mark is

weak or in anyway suggestive of the services of either party.

We now consider whether the services of the parties are related. We must consider the services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods,

the particular channels of trade or the class of purchasers to which the sales of goods are directed").

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). Furthermore, when both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Here, applicant's services involve export agency services in the field of heavy industrial equipment and materials for electronic and telephonic communication

systems. While applicant's declarant states that it "does not deal with individual computers and their peripherals," (Neira declaration, p. 1), registrant's identification of services is not limited to "individual computers," and we cannot read this limitation into the identification of services. Registrant's services are procurement services involving the purchasing and resale of computer hardware. The examining attorney has pointed out that computers are used in the communications and telephonic industry. There is no reason that this identification of services would not include the procurement of mainframe computers used in the electronic and telephonic communication industry. As discussed above, we are constrained to consider the issue of likelihood of confusion based on the services identified in the application and registration.

In addition, there is some evidence in the form of registrations to suggest that the same source may provide both export agency and procurement services. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may

emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

We find that applicant's export agency services and registrant's procurement services are related.

Businesses/consumers familiar with registrant's procurement services of computers are likely to believe that applicant's export agency services concerning heavy industrial equipment come from the same source. This is particularly true when registrant could be procuring computers related to the electronic and telephone communication industry.

Even taking into consideration the fact that purchasers of heavy industrial equipment are likely to be sophisticated purchasers, this would not eliminate the likelihood of confusion when the identical mark GENEX is used on the services of applicant and registrant. Octocom Systems, 16 USPQ2d at 1787. The evidence supports the conclusion that business customers who are familiar with registrant's procurement services would likely believe that applicant's export agency services are in some way associated with registrant.

Finally, we note that applicant's president states that there has been no actual confusion of which he is aware. The absence of actual confusion does not mean there

Ser No. 76/074,262

is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). In addition, applicant has filed an intent-to-use application. There is little evidence of the extent of any use by applicant of its trademark or its trade name, for that matter, and, of course, in an ex parte proceeding, registrant has not had the opportunity to introduce any evidence of confusion.

In this case, we rely on the facts that the marks are identical, there is no evidence that the term "Genex" is weak or even suggestive, the services are the type that the same business could be using, and these services could involve exporting and procuring computers and heavy industrial equipment for the same industries. Our analysis leads us to conclude that there is a likelihood of confusion. While we acknowledge that this conclusion is not free from doubt, we must resolve any doubt in favor of the registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.