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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Logicom, Inc.

Serial No. 75/886,535

John J. Lynch for Logicom, Inc.

Khanh Le, Trademark Examining Attorney, Law Office 104
(Michael Hamilton, Managing Attorney).

Before Cissel, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 4, 2000, applicant, a New York state corporation, filed the above-referenced application to register the mark "LOGICOM" on the Principal Register for "design and development of computer software, programs, systems and networks for others, and computer consultancy and support services in International Class 42." Applicant claimed first use of the mark in connection with the services and first use of the mark in interstate commerce

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in connection with the services at least as early as June of 1985.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark, when used in connection with the services specified in the application, so resembles the mark "LOGICON," which is registered¹ for "analysis, planning, engineering, integration, testing and simulation for information, weapons, command, control, communications and intelligence systems; computer software design for others; updating of computer software; computer system design, integration and consulting services; life cycle engineering; design engineering; engineering consulting services, namely, operations and systems logistics and planning in the nature of determining risks and contingencies and their appropriate responses and outcomes; research services in high energy lasers, advanced imaging technology, nuclear and conventional weapons effects and anti-proliferation strategies, ocean physics, neural networks and human factors engineering," in Class 42, that confusion is likely. The Examining Attorney

¹ Reg. No. 2,244,159, issued on May 11, 1999 to Logicon, Inc., a Delaware corporation.

concluded that confusion is likely because the marks are highly similar and the services are closely related. Additionally, the Examining Attorney required applicant to amend the recitation of services to clarify the indefinite term "support services," and suggested an amended recitation for applicant to adopt, if it is accurate.

Applicant responded by amending the application to adopt the recitation of services suggested by the Examining Attorney: "design and development of computer software, programs, systems and networks for others, and computer consultancy and technical support services, in International Class 42." Applicant also argued that the refusal to register under Section 2(d) of the Act was improper because the actual services rendered by the owner of the registered mark and by applicant under their respective marks are different and are provided to different classes of sophisticated purchasers. Although applicant quoted from registrant's website in support of this contention, no evidence was submitted in support of it.

Although the amended recitation of services provided by applicant had adopted in its entirety the terminology suggested by the Examining Attorney in the first Office Action, apparently upon reconsideration, the Examining

Attorney required further amendment to the recitation-of-services clause, holding that the wording "technical support services" is unacceptably indefinite.

Additionally, the refusal to register under Section 2(d) of the Act was also maintained. In support of the refusal, the Examining Attorney attached copies of pages from the website of the registrant wherein registrant explained the nature of the services it offers. The Examining Attorney asserted that this evidence establishes that the registrant performs the same services as the applicant does and offers the services to both government agencies and commercial consumers.

Applicant responded by amending the recitation of services to the following: "design and development of computer software, programs, systems and networks for others and computer consultation; technical support services, namely, troubleshooting of computer hardware and software problems via telephone, e-mail and in person, in International Class 42." Applicant again maintained that confusion is not likely in the case at hand "in light of the significant differences between the respective services and channels of trade as they relate to Applicant's mark and that of Prior Registrant." Applicant argued that "(w)hile both entities engage in computer system design,

the actual services they provide differ significantly. Prior Registrant's computer consulting and development services are performed in the context of vastly different systems, including those relating to nuclear and conventional weapons and intelligent systems, anti-proliferation strategies, high-energy lasers, advanced imaging technology, ocean physics, neural network and human factoring engineering," whereas "[b]y contrast, Applicant's services are focused on developing customized applications primarily for companies in the New York financial community and other comparable entities such as law firms. As such, these contrasting services define sharply different markets for, and consumers of, Prior Registrant's and Applicant's respective services."

Additionally, applicant asserted that it was not aware of any actual confusion caused by the use of these two marks in connection with the respective services of registrant and applicant.

In the third Office Action, the Examining Attorney accepted the amended recitation of services, but maintained and made final the refusal to register under Section 2(d) of the Act. Restating the basis for the conclusion that applicant's mark and the registered mark are highly similar in appearance, sound, connotation and commercial

impression, the Examining Attorney went on to explain that the issue of whether the services are closely related is determined on the basis of how the services are identified in the application and in the registration, respectively, rather than on the basis of extrinsic evidence that establishes what the services actually are that the applicant and the registrant render under their respective marks. Submitted in support of the refusal was a copy of a page from a dictionary showing that neither "logicon" nor "logicom" are listed therein. The Examining Attorney argued that this evidence supports the conclusion that the marks are similar. His argument seems to be that if the words had meanings and the meanings were different, then the marks might create different commercial impressions, but that because they have no meanings and the terms are similar in pronunciation and appearance, the marks are very much alike.

Applicant timely filed a Notice of Appeal, followed by its appeal brief. The Examining Attorney filed a responsive brief, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the record in this application, in view of the arguments of applicant and the Examining Attorney, as well as the relevant legal

precedents, we hold that the refusal to register must be affirmed because confusion is likely between applicant's mark, as used in connection with the services set forth in the amended application, and the cited registered mark, in connection with the services recited in the registration.

The test for determining whether confusion is likely is well settled. First, we must evaluate the marks themselves for similarities in appearance, sound, connotation and commercial impression. In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Then, we must compare the services to determine if they are related or if the activities surrounding their marketing are such that confusion as to source is likely. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Regarding the marks, the test for confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. As the Examining Attorney points out, the issue is whether the marks create the same overall commercial impression. Visual Information Institute, Inc. v. Vicon Industries, Inc., 209 USPQ 179 (TTAB 1980). The emphasis is on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. Chemetron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979).

When the services of the respective parties are closely related, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is not as great as it would be if the services were not closely related. ECI Division of E Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443 (TTAB 1980).

The marks in the instant case are similar in appearance, pronunciation and commercial impression. "LOGICOM" and "LOGICON" each begin with the term "logic," which is suggestive in connection with computer goods and services, and when the "COM" and "CON" endings are combined with this suggestive term, the resulting marks are quite similar. Especially considering that they will not necessarily be compared on a side-by-side basis by people with infallible memories, their use on the same or closely related goods or services is likely to cause confusion.

A significant legal principle in this case is that our determination of whether the services of applicant and registrant are so closely related that confusion is likely must be made based upon the specific ways that the services are identified in the application and the cited registration, respectively, without limitations or restrictions that are not reflected therein. Octocom

Systems, Inc. v. Houston Computers Services, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Notwithstanding all the argument applicant makes regarding what it perceives as differences between the services applicant actually provides under its mark and the services applicant believes registrant actually renders under its registered mark, when we base our comparison on the services as they are identified in the application and the registration, respectively, we find that they are legally identical. As noted above, the application identifies applicant's services, in part, as "design and development of computer software, programs, systems and networks for others and computer consultation," and the cited registration recites registrant's services as including "computer software designed for others... computer system design" and "consulting services."

As noted above, when marks are used in connection with the same services, the marks do not need to be as similar in order to support a conclusion that confusion is likely as would be the case if the marks were used in connection with different services. In the case at hand we do not even need to apply this principle. Confusion is plainly likely in view of the close similarity of these marks and

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the legal identity of the services with which they are used.

DECISION: The refusal to register under Section 2(d) the Lanham Act is affirmed.