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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Concurrent Technologies Corporation

Serial No. 76/040,747

Janel M. Purnell of Buchanan Ingersoll, P.C. for Concurrent Technologies Corporation.

Jennifer D. Chicoski, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Hohein and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 4, 2000, applicant filed the above-identified application to register the mark "CONCURRENT TECHNOLOGIES CORPORATION" on the Principal Register for "Web page design, creation, hosting and maintenance; programming services, namely, detection and correction of software bugs, viruses and flaws; customization of software for others; global computer network consulting and development services" in Class 42. The basis for filing the

application was applicant's assertion that it had used the mark in commerce.

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 so resembles the mark shown below,



which is registered¹, with a disclaimer of "CONCURRENT COMPUTER," for the following:

"computer systems, sold as a unit or individual parts thereof, comprising--computer hardware; computer software; namely, operating programs, programming tools, compilers and productivity programs, computer programs for use with computer networks and distributed computing, computer programs for use with graphics and data acquisition, and application programs in the fields of simulation and training, signal intelligence and analysis, financial trading, measurement and control, radar and health care; computer peripherals and computer interfaces for use

¹ Reg. No. 1,912,054, issued on Aug. 15, 1995 to Concurrent Computer Corp., a Delaware corporation. Affidavit under Sections 8 and 15 accepted.

in conjunction with high performance and real-time applications" in Class 9;

"manuals, printed pamphlets and books related to computer systems for use in high performance and real-time applications or to hardware and/or computer programs associated with such systems" in Class 16;

"repair, maintenance, and installation services of computer systems used in high performance and real-time applications and of hardware and/or computer programs associated with such systems" in Class 37;

"training services; namely, concerning computer systems for use in high performance and real-time applications for hardware and/or computer programs associated with such systems" in Class 41; and

"consulting and design services for others relating to systems integration and to the use of computer systems for use in high performance and real-time applications and of hardware and/or computer programs associated with such systems" in Class 42.

The Examining Attorney also pointed out problems in the application dealing with the recitation of services and the dates of use, and required applicant to disclaim the descriptive wording "TECHNOLOGIES CORPORATION" apart from the mark as shown.

Applicant responded to the first Office Action by clarifying its dates of use and amending the recitation of services to adopt the wording suggested by the Examining Attorney. As amended, the recitation reads as follows:

"programming services, namely, detection and correction of software bugs, viruses and flaws; computer software design and modification for others; computer consulting in the

Ser No. S.N. 76/040,747

field of web pages and global computer networks; web site design, creation, hosting and maintenance; design, configuration and administration of computers and computer networks, in international class 42." Applicant argued that the requested disclaimer was not called for, and also argued that the refusal to register based on likelihood of confusion was not justified.

The Examining Attorney accepted applicant's amendments to the dates-of-use clause and recitation of services in the application, but maintained and made final the requirement to disclaim the term "TECHNOLOGIES CORPORATION" apart from the mark as shown. She also maintained and made final the refusal to register based on likelihood of confusion.

Submitted in support of her position were several exhibits. One is a copy of a page from applicant's website. It states that applicant "has the technology and the experience to develop Web solutions for any sized business," that applicant "can choose appropriate technology to meet specific needs," and that applicant's "expertise can usher your organization into the world of electronic commerce using Web technologies." The Examining Attorney contended that this language makes it clear that the term "TECHNOLOGIES CORPORATION," when used in

Ser No. S.N. 76/040,747

connection with applicant's services, conveys to potential customers "the purpose and focus of the applicant, the expertise it has and the services it provides."

The Examining Attorney also submitted copies of twenty third-party registrations listing computer-related services in which the terms "TECHNOLOGIES CORPORATION" or "TECHNOLOGIES, INC." are disclaimed, and argued that both words have descriptive connotations in the context of technological services rendered by corporations.

Applicant timely filed a Notice of Appeal, followed by an amendment disclaiming the descriptive term "CORPORATION." Additionally, applicant requested the Board to remand the application to the Examining Attorney for consideration of additional evidence. This evidence included a declaration from applicant's Director of Manufacturing Technology to the effect that the term "TECHNOLOGIES" has become distinctive of applicant's services; dictionary definitions of the terms "computer" and "technologies"; an affidavit from applicant's vice president to the effect that he is unaware of any actual confusion between applicant's mark and the cited registered mark; copies of pages from applicant's website, argued to establish that applicant's customers are sophisticated; and copies of pages from the website of the owner of the cited

Ser No. S.N. 76/040,747

registration, also argued to establish the sophistication of the customers for these computer-related goods and services.

Following the erroneous dismissal of the appeal and subsequent reinstatement of it, the Board suspended action on the appeal and remanded the application file to the Examining Attorney for consideration of the additional evidence submitted by applicant. The Examining Attorney accepted the disclaimer of the word "CORPORATION" and applicant's claim of distinctiveness with respect to the word "TECHNOLOGIES" and accordingly withdrew the requirement for applicant to disclaim the term "TECHNOLOGIES CORPORATION." The refusal to register based on likelihood of confusion, however, was maintained. Attached to her action was a list of applicant's other applications to register its mark for different goods and/or services; a list of four third-party registrations, two of which are on the Supplemental Register, for marks which include the term "CONCURRENT," and copies of information about these registrations retrieved from the Office's database; and a definition from an on-line dictionary of the word "TECHNOLOGIES" as "electronic or digital products and systems considered as a group." The

application was returned to the Board for resumption of action on the appeal.

Applicant submitted its appeal brief², the Examining Attorney submitted her brief on appeal, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

The sole issue before the Board in this appeal is whether confusion is likely between applicant's mark, "CONCURRENT TECHNOLOGIES CORPORATION," for services which include computer software design and modification, and the cited registered mark,

² Applicant submitted copies of printouts from the Office's TESS and TARR systems with its brief. The information therein relates to one pending application and one registration owned by applicant, both for the word mark here sought to be registered. The Examining Attorney has objected to our consideration of this evidence because it was not submitted before the record closed with the filing of the Notice of Appeal. Trademark Rule 2.142(d) states that the record should be complete with the filing of a Notice of Appeal, but in this case, we are allowing this evidence into the record even though it was submitted after that time because all the evidence does is update information properly made of record by the applicant earlier. In her December 9, 2002 denial of applicant's request for reconsideration, applicant listed a number it owned. All the objected-to evidence does is provide details of two of those applications and confirm that in the intervening time, one application proceeded to registration and the other one was published for opposition. This information plainly was not available earlier, so we are allowing applicant to make it of record at this time. We hasten to note, however, that its probative value is insignificant, in that the Board is not bound by decisions made during the examination of applications which are not before us in this appeal.



for services which include the design of computer hardware and software.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case the *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression and the similarity of the goods or services with which they are used.

In view of the apparent overlap of the services, the issue of whether confusion is likely turns on whether applicant's mark and the registered mark are so similar that they are likely to be confused. We hold that when these two marks are compared in their entireties, they are not so similar that confusion is likely.

Although it is well settled that in determining whether confusion is likely, the marks in question must be considered in their entireties, it is nonetheless appropriate, under certain circumstances, to recognize that

Ser No. S.N. 76/040,747

one feature of a mark may have more significance in creating the commercial impression engendered by that mark. Greater weight may be given to that dominant feature in determining whether confusion is likely. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976).

The Examining Attorney takes the position that each of the marks at issue is dominated by the same term, "CONCURRENT," and therefore that the overall commercial impressions engendered by the marks are similar. The Examining Attorney, notwithstanding her apparent acceptance of applicant's position with respect to the acquired distinctiveness of "TECHNOLOGIES," argues that the words "TECHNOLOGIES CORPORATION" have very little, if any, source-identifying significance in connection with applicant's services, and that, in a similar sense, neither the descriptive term "COMPUTERS" nor the design element in the registered mark contributes much to the overall commercial impression generated by that mark. Despite arguing that "CONCURRENT" dominates the cited registered mark, the Examining Attorney seems to take the position that the term is disclaimed in the cited registration because it is descriptive of registrant's goods and services. She refers to an on-line dictionary definition

Ser No. S.N. 76/040,747

of "CONCURRENT" as meaning "operating or occurring at the same time," which presumably leads to the conclusion that a concurrent computer is one which performs concurrent processing, that is to say, one which simultaneously processes more than one command at a time. The Examining Attorney contends that, in any event, the connotation "CONCURRENT" has with respect to registrant's products and services is the same connotation it has in connection with the applicant's services, so the marks create similar commercial impressions.

We disagree with her basic premise that the only common element in these two marks, the word "CONCURRENT," is the dominant element of either mark. Instead, if we adopt the argument put forward by the Examining Attorney that this word has the same significance in applicant's mark that it has in connection with the registrant's mark, we must conclude that it is therefore either merely descriptive or highly suggestive in connection with the respective computer and software design services. As such, it can hardly be characterized accurately as the dominant component of either mark.

With the entire literal portion of the registered mark disclaimed, the design element is clearly the dominant and source-distinguishing portion of that mark. In view of:

(1) the descriptive significance of "CONCURRENT" in connection with registrant's goods and services and, by the Examining Attorney's argument, its weakness as an element of applicant's mark, (2) applicant's disclaimer of "CORPORATION", and (3) applicant's claim of distinctiveness with regard to "TECHNOLOGIES," the dominant element of applicant's mark would appear to be "TECHNOLOGIES."

In short, we find no support for adopting the conclusion urged by the Examining Attorney, that these two marks are similar in their entireties, when registrant's mark is dominated by a distinctive design, applicant's mark is dominated by the apparently distinctive term "TECHNOLOGIES," and the only element common to both marks is a descriptive term (for registrant) or a highly suggestive one (for applicant). When these two marks are considered in their entireties, the similarities in appearance, pronunciation and connotation are not sufficient to make confusion likely.

We should emphasize that our conclusion that confusion is not likely is not based on applicant's arguments with regard to applicant's other applications to register its mark, on the third-party applications or registrations, or on the asserted sophistication of the purchasers of the products and services involved in this case. The

Ser No. S.N. 76/040,747

information of record regarding applications and registrations of marks which include the term "CONCURRENT" are not evidence of use of such marks or that the consuming public is familiar with their use, so that information is entitled to very little weight in resolving the question of whether or not confusion is likely. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983); National Aeronautics and Space Administration v. Record Chemical Co., 185 USPQ 563 (TTAB 1975). Of course, consistent administration of the Lanham Act is a goal of this agency, but, as noted above, the Board is neither necessarily aware of how other applications have been treated at the examination level of the Office nor bound by decisions made there. In re AFG Industries, Inc. 17 USPQ2d 1162 (TTAB 1990). Additionally, although applicant argues that customers for computer hardware and software design are sophisticated purchasers with regard to these relatively expensive services, it is well settled that knowledge and sophistication with respect to particular products and services does not necessarily translate into the ability to avoid being confused by the use of similar marks in connection with closely related goods and/or services. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

Ser No. S.N. 76/040,747

DECISION: The refusal to register under Section 2(d) of the Lanham Act on the ground of likelihood of confusion is reversed.