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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ForeSight Holdings, Inc.

Serial No. 76258424

Richard R. Alaniz of Black Lowe & Graham PLLC for ForeSight Holdings, Inc.

Elizabeth J. Winter, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Bottorff, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 16, 2001, ForeSight Holdings, Inc. (applicant) applied to register the mark KNOWLEDGE INTEGRATION SERVER (in typed form) on the Principal Register for goods in International Class 9 ultimately identified as:

Computer operating programs; computer software used to connect various computers into a computer network; computer software for use in database management, document processing, and computer security; computer software for searching, accessing, organizing, storing, manipulating, and managing semantic and hierarchical data structures and heterogeneous data, collections of data and information on a wide variety

of computer hardware and across multiple devices, namely workstation, desktop, laptop, handheld, palm¹, and smart phones in a wired and wireless computer network; computer software for use in database management, namely, for active and automated collaborative filtering of data; computer search engine software, namely software for providing semantic transport-driven, query sourced inputs, namely, natural language inputs, across multiple devices, namely workstation, desktop, laptop, handheld, palm, and smart phones in a wired and wireless computer network; computer software for tracking, modeling, developing, deploying, utilizing, retrieving, recording, storing, searching, mining, accessing, managing, publishing, editing and semantic encoding of collections of data, data information workflow and other heterogeneous information or data sources in terrestrial and wireless local and global computer networks; desktop publishing software; computer software for use in exchanging and transporting data among multiple computer applications, operating systems and utility programs; computer software for providing interoperability among different software applications, operating systems and utility programs; computer software for providing user-customizable data presentment via a user interface; computer software for searching, accessing, storing and managing hierarchical data structures and semi-structured and unstructured data in the field of data representation technology, namely structured and unstructured semantically-based software for use in the development of computer programs, programming languages, development kits and compilers; computer software for use in developing, compiling, and executing other computer software on computers, computer networks, and global computer networks; computer software for use in navigating, browsing, transferring information, and distributing and viewing other computer software and information on computers, computer networks, and global computer networks; computer software for use in content-based database management in the field of data representation technology; computer software for use in content-based

¹ The examining attorney notes that the term PALM is a registered trademark, and the examining attorney will require applicant to delete this term if the application is eventually published for opposition.

database management for use as a database management tool in the field data representation technology that may be downloaded from local and global computer networks; downloadable electronic publications in the nature of books, magazines, articles, newsletters, manuals, summaries and reports in the fields of computer and information technology.

The application is based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney² has refused to register applicant's mark on two grounds. First, the examining attorney held that applicant's mark is not registrable under the provisions of Section 2(d) of the Trademark Act because it is likely to cause confusion, to cause mistake, or to deceive as a result of a registration for the mark KNOWLEDGE INTEGRATION for "business operational, organizational and information systems consulting services" in International Class 35.³ 15 U.S.C. § 1052(d).

The examining attorney also refused to register applicant's mark under the provisions of Section 2(e)(1) of the Trademark Act because the examining attorney found that the term KNOWLEDGE INTEGRATION SERVER was merely descriptive of applicant's goods. 15 U.S.C. § 1052(e)(1).

² The current examining attorney was not the original examining attorney in this case.

³ Registration No. 2,364,783 issued on July 4, 2000.

After the Examining Attorney made the refusals to register final, this appeal followed.⁴

Descriptiveness

We address the descriptiveness refusal first. A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"); In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218. See also MBNA, 67 USPQ2d at 1783 ("Board correctly found MBNA's emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how

⁴ We agree with the examining attorney, and we will not consider the new evidence, an Internet search report, that was submitted with applicant's appeal brief. 37 CFR § 2.142(d). We will not take "administrative notice of the evidence." Reply Brief at 4.

the relevant public perceives the marks in a commercial environment"). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

The examining attorney argues that the term KNOWLEDGE INTEGRATION SERVER is merely descriptive because it immediately informs purchasers that its "product functions as a *server*, namely, software the purpose of which is to provide *knowledge integration*." Examining Attorney's Brief at 5. The examining attorney relies on the following printouts from the Internet and the LEXIS/NEXIS database to show that the term is merely descriptive of the goods.

NBII infrastructure nodes are targeted as ... providing technology and information science capabilities, including **knowledge integration** and engineering *Online Information Review*, 2000.

In contrast, knowledge management relates to the process of knowledge and expertise discovery, knowledge mapping, **knowledge integration** and knowledge dissemination. *Federal News Service*, June 22, 2000.

Our proprietary **knowledge integration** tool, The MANAGER (TM), supports our consulting practice. www.BCIKnowledgeGroup.com

Development of Data Visualization **Knowledge Integration** Software

Structural engineering researchers ... will join forces ... to produce these multi-function data visualization **knowledge integration** tools.

www.cee.uiuc.edu.

VistaView is the first available task-specific collaborative work space delivered as a decentralized personal portal to promote **knowledge integration** visualization, file sharing and information exchange. *Software Industry Report*, July 22, 2002.

Without such **knowledge integration**, firms are unlikely to attain differential success in technology assimilation.

MIS Quarterly, June 1, 2002.

Carol Bekar, group director of **knowledge integration** at Bristol Myers Squibb.

Information Today, April 1, 2002.

Barbara Miller, director of **knowledge integration** at Dynergy Inc.

InformationWeek, May 28, 2001.

IT can enhance **knowledge integration** and application by facilitating the capture, updating, and accessibility of organizational directives.

MIS Quarterly, March 1, 2001.

Unlike other authors, Grant explicitly considers the issue of **knowledge integration** within networks.

ABI/INFORM, 2000.

His research interests include information systems, **knowledge integration**, and the information industry.

ASAP, September 22, 2000.

The examining attorney also included a definition of "knowledge management" as the "name of a concept in which an enterprise consciously and comprehensively gathers organizes, shares, and analyzes its knowledge in terms of resources, documents, and people skills... Knowledge

management involves data mining and some method of operation to push information to users." SearchCRM.com. "Knowledge integration software" can provide "an organization with an efficient way to capture, maintain and share knowledge in the form of process-centric decision support, training, and risk & metrics management." www.infoday.com. Applicant's information provides the following description of its software: it "semantically links disparate types of information within an organization, and provides nervous system services across supplier and partner boundaries." See Response dated February 28, 2002, Exhibit 1. Applicant's goods are identified, inter alia, as "computer software for use in database management, document processing, and computer security; computer software for searching, accessing, organizing, storing, manipulating, and managing semantic and hierarchical data structures and heterogeneous data, collections of data and information on a wide variety of computer hardware and across multiple devices." The term "knowledge integration" would describe applicant's goods to the extent that they capture, analyze, share and reuse knowledge and information within an organization.

The examining attorney also submitted a definition of a server as "a computer or device on a network that manages

network resources." www.webopedia.com. A server can also be "the program that is managing resources rather than the entire computer." Id. The term KNOWLEDGE INTEGRATION SERVER simply specifies that applicant's "knowledge integration" functions are associated with a computer program or performed on a computer.⁵

We conclude that applicant's mark KNOWLEDGE INTEGRATION SERVER is merely descriptive for at least some of applicant's goods.⁶

⁵ Applicant also lists several registrations for other marks apparently as a justification for registering its marks. Applicant's Brief at 8-9. We start by noting that "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Normally, "the submission of a list of registrations is insufficient to make them of record notwithstanding that they constituted a part of the record in another proceeding before the Board." In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). While the examining attorney has not objected to this list of registered marks, only limited information from the registrations has been included and the marks frequently are spelled as one word. This makes it virtually impossible to determine how the individual component of the mark was treated by the Office. Therefore, this list of registrations has little, if any, relevance to this proceeding.

⁶ See, e.g., Computer operating programs; computer software used to connect various computers into a computer network; computer software for use in database management, document processing, and computer security; computer software for searching, accessing, organizing, storing, manipulating, and managing semantic and hierarchical data structures and heterogeneous data, collections of data and information on a wide variety of computer hardware and across multiple devices. A mark is properly refused registration if it is descriptive of any of the goods in the identification of goods. Accord In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 (TTAB 2002) ("[I]f applicant's mark BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable").

Likelihood of Confusion

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and 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).

First, we turn to the similarity of the marks. Both marks begin with the same two words “Knowledge Integration.” As we discussed previously, the term “knowledge integration” is certainly not a unique or arbitrary term when used in association with computer hardware, software, and related services. The only difference between the marks is applicant’s addition of the word “Server.” Inasmuch as a server is “a computer or device on a network that manages network resources” and “a program that is managing resources rather than the entire

computer," and applicant's goods include computer operating systems, programs, and software, the term would obviously have at least some descriptive significance. When we compare the marks as a whole, KNOWLEDGE INTEGRATION and KNOWLEDGE INTEGRATION SERVER have clear similarities in appearance and sound. The descriptive word "server" would not significantly distinguish the marks. Also, the marks would have similar meanings and commercial impressions. Applicant's mark merely emphasizes that the "knowledge integration" is associated with a server. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). While we have considered that the common terms in the marks may not be strong or unique terms in the trade, we conclude that the marks in their entirety are similar.

Next, we address whether the goods and services as they are identified in the application and registration are related. 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"). Registrant's services are "business operational, organizational and information systems consulting services." Applicant's goods include computer operating programs and computer software for use in database management, document processing, and computer security. There is evidence that business-related services and computer programs and software come from the same source. See, e.g., www.BCIKnowledgeGroup.com ("Our proprietary knowledge integration tool, The Manager™, supports our consulting practice"); www.riptideweb.com ("Riptide helped to productize the software and services offerings"); ASAP July 22, 2002 ("VistaPortal Software, Inc., a software and professional services company that provides solutions for knowledge management and decision-making for the enterprise"); and ASAP, February 9, 2000 (IMC, "a high-end, document-conversion service bureau that does business with the federal government, is adapting Open Text's LiveLink Web-based collaborative document management and Invention Machine Corp's Co-Brain semantic processing software for federal government and private sector SMB-hosted apps"). The excerpts suggest that software and

services originate from the same source. Indeed, some of the articles indicate that knowledge integration software and business consulting services in the field of knowledge integration are associated with the same source. Also, two of the references indicate that employees at Bristol Myers Squibb and Dynergy are identified as directors of knowledge integration. These officials would likely be prospective purchasers of both applicant's software and registrant's consulting services, which indicates that prospective purchasers would, at least, overlap.

While applicant argues that "the buyers of such goods and services are very sophisticated" (Applicant's Brief at 6), and we will assume that they are, even sophisticated purchasers can be confused when marks as similar as KNOWLEDGE INTEGRATION and KNOWLEDGE INTEGRATION SERVER are used on the identified goods and services. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible"). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated

purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). Here, even sophisticated purchasers who are familiar with KNOWLEDGE INTEGRATION business information systems consulting services would likely believe that KNOWLEDGE INTEGRATION SERVER, inter alia, computer operating programs; computer software used to connect various computers into a computer network; computer software for use in database management, document processing, and computer security, and electronic downloadable newsletters in the fields of computer and information technology are associated with the same source. This is particularly true when there is evidence that software and consulting services similar to applicant's and registrant's originate from the same source.

Finally, we note that:

If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant. The rule is usually applied in inter partes cases but it applies equally to ex parte rejections.

In re Pneumatiques, Caoutchouc Manufacture et Platitudes Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973). See also Dixie Restaurants, 41 USPQ2d at 1535

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Therefore, when we consider that the marks are very similar and the goods and services are related, we conclude that there is a likelihood of confusion.

Decision: The refusals to register the mark on the grounds of mere descriptiveness and likelihood of confusion are affirmed.