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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re InOvate Communications Group

Serial No. 76276283

Erin M. Clarke of Owen, Wickersham & Erickson, P.C. for
InOvate Communications Group.

Caroline F. Weimer, Trademark Examining Attorney, Law
Office 115 (Tomas Vlcek, Managing Attorney).

Before Hairston, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On June 25, 2002, InOvate Communications Group filed
an intent-to-use application to register on the Principal
Register the mark KODIAK NETWORKS (NETWORKS is disclaimed)
for goods and services, identified, following amendment as:

wireless telecommunications equipment consisting
of cellular mobile telecommunications switches;
location and equipment registers; packet data
switching and gateways; radio base stations;
radio transmitters, receivers, transceivers;
repeaters; antennas; wireless customer terminal

software for enabling wireless services in mobile telephones, personal digital assistants (PDAS), and portable computers; transmission equipment, namely, microwave radio transmitters, receivers, transceivers, repeaters/regenerators; antennas; compressors, multiplexers; global computer network, telephony, voice, data and computer networking equipment, namely, routers, gateways, bridges, hubs, nodes, servers, firewalls; global computer network terminals and appliances for interconnecting and interfacing with telecommunications networks; telecommunications traffic handling and processing equipment for caching, compression, multiplexing, protocol conversion, load balancing and traffic management; operational support systems comprising computer hardware and software for providing customer service and transferring call records and billing information; network management systems comprising computer hardware and software for tracking all network transactions and sending network alarms; test equipment and performance measurement systems comprising computer hardware and software for analyzing, measuring and optimizing performance of the aforementioned goods; software for operating and controlling the aforementioned goods in International Class 9;

retail and wholesale distributorship services for wireless telecommunications and data networking equipment in International Class 35;

installation, maintenance, and repair of wireless telecommunications networks, apparatus and instruments in International Class 37; and

training services, namely seminars, workshops, and classes for telecommunications and data networking in International Class 41.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on the identified

goods and services, so resembles the registered mark shown below,



for, in relevant part, "communication services, namely electronic transmission of messages and data" in International Class 38,¹ as to be likely to cause confusion, mistake or deception.

Applicant has appealed, and briefs have been filed, but applicant did not request an oral hearing.

At the outset, we note that after briefs were filed, the Board remanded the application to the examining attorney in order that applicant's identification of goods and services could be clarified and the proper appeal fees submitted. Applicant subsequently amended the identification of goods and services and submitted the appropriate fees. We note that as a result of the amendment, applicant deleted services in International

¹ Registration No. 2,029,459, issued January 14, 1997; Section 8 affidavit accepted. The registration contains a disclaimer of the words GROUP, ELECTRONIC COMMERCE PLANNING, and IMPLEMENTATION.

Class 42 (engineering services for telecommunications and data networks) from its application. We point this out because the examining attorney had submitted substantial evidence in the nature of third-party registrations and NEXIS evidence in support of her specific refusal to register these services in view of consulting services in the field of computers in International Class 42 in the cited registration. In addition, both the examining attorney and applicant discussed the issue of likelihood of confusion vis-à-vis these respective services in their briefs on the case. However, inasmuch as applicant has now deleted the Class 42 services from its application, the specific refusal in this regard is moot and we need not consider the arguments and evidence relating thereto.

Rather, we focus on the examining attorney's refusal to register the remaining goods and services in applicant's application, i.e., wireless telecommunications equipment in Class 9; retail and wholesale distribution services in Class 35; installation, maintenance, and repair services in Class 37; and training services in Class 37 in view of the Class 38 services in the cited registration, i.e., communication services, namely, electronic transmission of messages and data.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We consider first the marks. The examining attorney argues that the marks are similar due to the shared arbitrary term KODIAK.

Applicant, on the other hand, argues that the bear claw design and additional wording in the cited mark serves to distinguish the marks.

With respect to the marks, although they must be considered in their entirety, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on

consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id. at 751.

Applying these principles to the marks at issue in this case, it is clear that the distinctive term KODIAK is the dominant, literal and source-indicative element in each of the respective marks. Insofar as applicant's mark is concerned, the disclaimed word NETWORKS is generic or highly descriptive for applicant's type of services. Thus, it is the word KODIAK that dominates applicant's mark.

With respect to registrant's mark, the disclaimed words GROUP, ELECTRONIC COMMERCE PLANNING and IMPLEMENTATION are highly descriptive for the type of services rendered by registrant. Further, the disclaimed words ELECTRONIC COMMERCE PLANNING and IMPLEMENTATION appear in much smaller letters than THE KODIAK GROUP. While the bear claw design in registrant's mark is certainly noticeable, it serves to reinforce the word KODIAK as a type of bear. Also, the word KODIAK is the portion of registrant's mark that purchasers are more likely to remember and use in calling for registrant's

services. In short, it is the word KODIAK that is the dominant portion of registrant's mark.

We find, therefore, that applicant's mark and the cited mark, when considered in their entireties, are similar in terms of appearance, sound, connotation and commercial impression.

We next turn to the goods and services involved herein. Applicant, in urging reversal of the refusal to register, argues that it intends to use its mark in connection with goods and services to provide wireless voice systems to wireless carriers around the world, whereas registrant's mark is used in connection with services designed to assist in planning and implementing electronic commerce. Applicant maintains that "e-commerce services are quite different from Applicant's goods and services in the wireless industry." (Reply brief, p. 4). Thus, it is applicant's position that the respective goods and services are not related.

Further, applicant argues that "the sophistication of Applicant's and Registrant's potential purchasers, the care with which purchases are made, and the high cost of the Applicant's and Registrant's goods and services negates any possibility of confusion." (Brief, p. 9).

The examining attorney, on the other hand, argues that:

The nature of the goods and services at issue remains the same: communications goods and services. Whether wireless or land-based, the evidence already of record shows that the goods and services of the parties are highly related and travel in the same channels of trade. (Brief, p. 11)

In support of her position, she has submitted third-party registrations in order to show that goods and services of the type identified in applicant's application, and services of the type identified in the cited registration, can emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

It is true that applicant's goods and services and registrant's services, as identified, can all be broadly described as communications goods and services. However, to demonstrate that goods and services are related, it is not sufficient that a particular term may be found which may generically describe the goods and services. See *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977); *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517 (TTAB 1975).

Further, we are not persuaded by the third-party registrations made of record by the examining attorney that

applicant's wireless telecommunications equipment; retail and wholesale distributorship services; installation, maintenance, and repair services; and training services, on the one hand, and registrant's electronic transmission of messages and data services, on the other hand, are sufficiently related that when sold under similar marks, confusion is likely. In particular, upon close examination of the third-party registrations, we find that none appears to include applicant's type of goods and/or services, and registrant's type of services.

Among the registrations the examining attorney has submitted are:

Registration No. 2,512,835 for NIRAGONO for "electronic transmission of data messages to wireless communication devices via a global computer network;"

Registration No. 2,646,655 for QWEST DSL for "electronic transmission of voice, video, messages and data" and "wireless communication services;"

Registration No. 2,643,863 for FREE2GO WIRELESS for "wireless telecommunications services, namely, the wireless electronic transmission of voice and data;"

Registration No. 2,608,325 for OPTIC MAIL for "telecommunications services, namely electronic transmission of data, video, voice and data communication, images, and documents via computer and communication networks, and global computer networks" and "virtual network telecommunications services, namely providing wireless

telecommunications connections to a global computer network;" and

Registration No. 2,598,845 for MOTIENT and design for "telecommunications equipment, namely telephones and wireless and mobile telephones for voice, data, and fax communications" and "providing business and commercial consultation and advisory services relating to computers, computer software, and communications networks and information technology used in the field of telecommunications generally and wireless communications."

To the extent that the registrations were submitted to show that communication services may be wireless as well as land-based, this does not prove that the specific goods and services involved in this case are related.

We find that the examining attorney has failed to establish that applicant's wireless telecommunications equipment; retail and wholesale distributorship services; installation, maintenance, and repair services; and training services, on the one hand, and registrant's electronic transmission of messages and data services, on the other hand, are similar or related in any way which would result in source confusion, even if they are marketed under similar marks.

The respective goods and services, as identified, are not identical, nor do they appear to be competitive, or complementary, and there is simply no evidence in the

record on which we may base a finding that the goods and services are otherwise related in any way. Applicant's goods and services, in particular, appear to be of a specialized nature which would be used by companies that install, repair and maintain wireless telecommunication networks. There is no evidence that these goods and services and registrant's electronic transmission of messages and data services are marketed in the same channels of trade or to the same classes of purchasers, and there is no basis in the record for concluding that the involved goods and services would ever be encountered by the same purchasers in circumstances which might give rise to a likelihood of confusion.

In sum, we find that there is no likelihood of confusion in this case. On this record, applicant's goods and services and registrant's services, as well as the trade channels and classes of purchasers for those respective goods and services, appear to be too dissimilar and unrelated for any confusion to be likely, even if they are marketed under similar marks.

Decision: The refusal to register under Section 2(d) is reversed.

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