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**This Opinion is Not
Citable as Precedent of
the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Empower Technologies, Inc.

Serial No. 78413033
Serial No. 78413043

Richard R. Alaniz and David A. Lowe of Black Lowe & Graham PLLC for Empower Technologies, Inc.

Ronald Fairbanks, Trademark Examining Attorney, Law Office 117 (Loretta Beck, Managing Attorney).

Before Seeherman, Quinn and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Empower Technologies, Inc. (applicant) has applied to register LINUXDA in standard character form (Serial No. 78413033) and the mark set forth below (Serial No. 78413043):



The logo for LinuxDA EMBEDDED. The word "LinuxDA" is written in a large, bold, sans-serif font. Above the letter "i" in "LinuxDA" are several short, curved lines radiating upwards, resembling a signal or antenna. Below "LinuxDA" is a thick, dark horizontal line that spans the width of the text. Underneath this line, the word "EMBEDDED" is written in a smaller, all-caps, bold, sans-serif font.

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The applications seek registration of the respective marks on the Principal Register, based on use of the marks in commerce. First use and first use in commerce of LINUXDA is asserted to have occurred in April 2000, while first use and first use in commerce of the LINUXDA EMBEDDED mark is asserted to have occurred in July 2001. There is a disclaimer of "embedded" in the LINUXDA EMBEDDED application. The amended identification in each application reads as follows:

Computer software and hardware, namely, operating system programs, handwriting recognition computer software, personal information management computer software, data synchronization programs, electronic books featuring technology-related subjects recorded on computer media; computer game software, server software, mobile communications software and application development tool programs for personal and handheld computers; computer software for use in database management, namely, for the management of personal and business information; computer hardware and computer peripherals, namely, modems, computer cables, computer styli; mobile and embedded computers, namely handheld computers with wireless e-mail and wireless access to electronic communications networks; tablet computers, mobile telephones, pagers; instruction manuals sold therewith as a unit for all the aforesaid.

The examining attorney has refused registration of each of the marks, in view of the prior registration of the mark LINUX (Registration No. 1916230) for goods identified as "computer operating system software to facilitate

computer use and operation."¹ See Trademark Act Section 2(d), 15 U.S.C. § 1052(d). That registration issued September 5, 1995 and was renewed in 2005. When the refusal of registration was made final in each application, applicant appealed. The appeals have been fully briefed and because they present a common issue, the Board has chosen to issue this single decision.

The first question to be addressed concerns procedure and evidence. In each case, in the final office action refusing registration, the examining attorney stated, "The applicant has not provided a written consent from the registrant as of the time of this Final Office action." The examining attorney had not discussed any such consent in the initial office action; nor did applicant address the subject in its response to that action. We can only surmise that the examining attorney made the point because of the statement, quoted below, that appears on applicant's specimen in the LINUXDA EMBEDDED application. In its appeal briefs, the applicant did not address the subject of

¹ The examining attorney also refused registration under Section 2(d) based on LINUX NETWORKX (and design) (Registration No. 2896522), registered by another entity, for "computer hardware and software in the field of operating and enhancing high performance and high availability computers, multiple computers or computer networks." This registration includes a disclaimer of rights in "Linux Networks." However, the citation of that registration was withdrawn by the examining attorney in his brief.

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a consent from the registrant. The examining attorney, however, again addressed the issue in each of his briefs:

Finally, the specimen of use provided by the applicant clearly provides the following:

© 2003 Empower Technologies, Inc. All rights reserved. PowerPlay and LinuxDA are trademarks of Empower Technologies, Inc. The registered trademark Linux® is used pursuant to a license from Linux Mark Institute, authorized licensor of Linux Torvalds, owner of Linux trademark on a worldwide basis.

This licensing relationship shows ownership of the mark LINUX with the named registrant. A licensing agreement typically suggests that sole control over use of a term rests with the licensor. It is to be noted that as of the time of the final Office action, applicant had not provided a duly authorized, written consent from the registrant to use of the Linux mark for registration purposes.

Applicant then submitted, with each reply brief, a photocopy of a document entitled "LINUX® SUBLICENSE." The agreement is between the LINUX MARK INSTITUTE (hereinafter may be referred to as LMI) and applicant. In the description of the record in each reply brief (p. 2), applicant stated:

In the Brief, the Examining Attorney references a consent to use license the Applicant has with the owner of U.S. Registration No. 1,916,230. The Applicant submits hereto as evidence in support of its application for registration the license agreement and other argument, and respectfully requests the TTAB to reverse the Examining Attorney's refusal, or in the alternative, to

suspend and remand the application for further examination.

It is clear from applicant's reply briefs that it is relying on the sublicense agreement submitted therewith (1) as evidence in support of its argument that there is no likelihood of confusion and the examining attorney's refusal should therefore be reversed and (2) as the basis for an alternative request that we construe the sublicense agreement as if it were an expression of consent by the owner of the cited registration to applicant's registration of the applied-for marks.

In order for us to consider the material submitted by applicant with its reply briefs, it must first be of record, and to be of record the applications would have to be remanded to the Examining Attorney. See 37 C.F.R. §2.142(d) (the record in an application to be considered on appeal should be complete prior to the filing of the appeal). Accordingly, we consider the request for remand first.

As applicant has correctly noted, when presented with a true consent to registration, the Board will generally suspend an appeal and remand a refused application to the examining attorney, no matter how late the stage of the

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appeal, so that the examining attorney may consider the consent. See TBMP § 1207.02 (2d ed. rev. March 2004). The Board policy providing for suspension of an appeal and remand to allow for consideration of a consent agreement even late in the course of an appeal is an acknowledgement, as the TBMP states, that a consent agreement may be "inherently difficult and time-consuming to obtain" and may only become available for filing late in the course of an appeal. However, that is not the situation presented by applicant's submission of the sublicense agreement, which bears signatures dated June 5, 2002 by the Linux Mark Institute and June 13, 2002 by applicant. These dates are almost two years prior to the filing date of the involved applications and more than four years prior to applicant's submission. Applicant has not provided any explanation as to why it waited until the filing of its reply briefs to submit the agreement. This delay is particularly egregious because, as indicated above, the Examining Attorney had stated in the final office action that applicant had not provided a written consent from the registrant. Applicant could have filed a request for reconsideration of the final refusal and submitted the agreement at any time within six months of the issuance of that final office action, including with the filing of its notice of appeal, and the

agreement would have been of record. However, applicant did not do so. We find that applicant has not demonstrated good cause for remanding the application to the Examining Attorney at this point in the appeal, and the request for remand is denied.

Even if the materials submitted with applicant's briefs were of record, they would not affect the outcome of these appeals. There is a difference between a license agreement and a consent agreement. As noted by Professor McCarthy:

A consent agreement is neither an assignment nor a license. It is not an assignment because neither party is assigning any rights of ownership in their mark to the other. It is not a license because party A is not granting a right to use to Z in return for payment of royalties. In a license, the licensee is engaging in acts which would infringe the licensor's mark but for the permission granted in the license. In that event, quality control is essential. But in a consent, the consentee is permitted to engage in defined actions which do not infringe the consentor's mark, and the agreement implicitly or explicitly recognizes that. Thus, a consent agreement needs no quality control. If, in fact, party A "consents" to Z' s usage which is an infringement, then it would be a "license" which requires quality control to be valid and to prevent abandonment or loss of priority.

A consent agreement does not require quality control because by the very essence of the agreement, the parties recognize that concurrent usage does not lead customers to link the goods or services of the parties. Whereas a license brings the parties together into a common public image and a joint enterprise, a consent agreement

keeps the parties apart at a defined distance. A license integrates, while a consent differentiates.

2 McCarthy on Trademarks and Unfair Competition § 18:79 (4th ed. Electronic version updated September 2006).

We find the sublicense agreement submitted by applicant in each application to be only a license to use. By its terms, it is a license, not a consent. Because, as stated above, a licensee is engaging in acts which would infringe the licensor's mark but for the permission granted in the license, the fact that applicant has entered into a license with the owner of the cited registration is an indication that applicant recognizes that its use of its applied-for marks would otherwise be infringing, i.e., that applicant's use of its marks is likely to cause confusion. Further, even if we were to regard the document as a consent, rather than a license, it does not reference in any way that applicant has a right to register the subject marks.

In application Serial No. 78413043 applicant has submitted, along with the sublicense agreement, a reprint of Frequently Asked Questions (FAQs) from the Linux Mark Institute's web site. Again, applicant has provided no explanation as to why it delayed until the filing of its reply brief to submit this reprint, and therefore the

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request for remand with respect to this material is also denied as lacking a showing of good cause. Further, as with the sublicense, even if this material were of record, it would not change the result herein. Applicant points to one question and answer as asserted support for its contention that the owner of the cited registration is not averse to licensees registering their respective marks that include the term LINUX. At best, the particular question and answer on which applicant relies may create some ambiguity about the intent of the owner of the cited mark and LMI in regard to registration rights, if any, of those who enter into a sublicense agreement. On the other hand, other questions and answers appear inconsistent with a purported right of a sublicensee to register its mark. Moreover, the sublicense agreement states, "the terms of the License are not subject to negotiation." See Recital B. In our view, this means that LMI considers the document to be complete and unalterable. It would be contrary to such intent for this Board to reinterpret what LMI views as a complete and unalterable agreement through reference to parol evidence such as the FAQs submitted by applicant.

Because the sublicense agreement was not made of record at an appropriate time in either application, and because applicant has not shown good cause for suspension

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and remand, the agreement (and FAQs submission) is not part of the record and shall not be considered in our determination of whether there is a likelihood of confusion. We now turn to that issue.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); see also, In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the fact that the goods are, in part, legally identical and otherwise related. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

In regard to the involved goods, there can be no question that they are, in part, legally identical. The mark in the cited registration is registered for "computer operating system software to facilitate computer use and operation." Applicant seeks registration of each of its

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marks for an array of goods that includes "computer software and hardware, namely, operating system programs." Applicant has argued that it focuses on software and hardware for "embedded" computing, but it is well-settled that "the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the [goods or] services as described in an application or registration." See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(internal quotation marks omitted). "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." Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Accordingly, we must consider the goods to be, in part, legally identical. Moreover, it is clear that other items in applicant's identification of goods are application programs or software that would have to work in conjunction with an operating system. In this respect the goods are complementary and related.

"When marks would appear on virtually identical goods or services, the degree of similarity [between marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these means of comparison may be critical in finding marks to be similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 (TTAB 1988); see also, In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988). In fact, "the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark." In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983). In addition, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed

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portions thereof, "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 the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, the entirety of the registered mark is LINUX. Applicant has taken this mark and, in one case, merely added the initials DA, which applicant itself promotes as meaning Digital Appliance; and applicant also promotes its goods as based on the LINUX operating software of the owner of the cited registration. In the other case, applicant has added not only the initials DA, but also the disclaimed word "embedded" and some minor design elements. In each case, LINUX constitutes the dominant portion of applicant's mark. The following are excerpts of record from applicant's website that illustrate the way in which applicant stresses the significance of the LINUX portion of its marks:

LinuxDA refers to the suite of Linux-based software and related hardware products developed and owned by Empower Technologies Inc. The DA stands for **Digital Appliance**, the product category into which Empower Technologies has chosen to embed its innovative Linux-based

operating system, resulting in the creation of the name and brand LinuxDA.

LinuxDA O/S - A Linux-based operating system for digital appliances.

(emphasis in original)

Applicant's stress on the "Linux-based" nature of its products, and its explanation to prospective purchasers that DA "stands for Digital Appliance" and is a "product category" belies applicant's contention that purchasers would view DA, rather than LINUX, as the dominant element in its LINUXDA mark. This analysis is equally applicable to applicant's LINUXDA EMBEDDED mark; and because applicant disclaims the descriptive term "embedded," LINUX is also the dominant term in that mark.

In view of the identical or otherwise related nature of the involved goods and the fact that applicant's marks include and stress the element that is the entirety of the mark in the cited registration, we conclude that the likelihood of confusion is clear. To provide a complete analysis of applicant's remaining arguments to the contrary, however, we note that applicant asserts that LINUX is a term "used by tens-of-thousands of sellers in the relevant marketplace," and is therefore a "weak" portion of such marks and would not be utilized by

consumers to differentiate one user's goods from another's goods. The examining attorney argues in response that applicant has misunderstood the law, that the term is not weak merely because it may be used by others to indicate that their goods are based on, or compatible with, the LINUX operating software, and he asserts that the term has not been registered by other entities.

Even if we were to accept applicant's argument as correct, the support for the argument is lacking. All that applicant offered in support of the argument was the first page of the results of a search on the Google search engine for the term "linux software." Applicant did not provide reprints of any of the web pages themselves, only the excerpts appearing on the search results page. There is little, if any, basis for concluding, based on this truncated material, that others are using LINUX as a mark or element thereof. See In re Remacle, 66 USPQ2d 1222 n.2 (TTAB 2002) ("The Examining Attorney's print-out of the results of an Internet search by the Yahoo search engine are of little probative value, largely because insufficient text is available to determine the nature of the information and, thus, its relevance."). Moreover, it appears from the excerpts that the uses are informational, i.e., the term "linux" is used to indicate that products

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utilize or are compatible with LINUX operating software. There is nothing in the excerpts that establishes that others use the LINUX mark as part of their own composite marks.

Another argument applicant has advanced is that the consumers of its embedded computing products are sophisticated buyers, not general consumers. However, as already discussed, we are bound to assess the likelihood of confusion issue based on the identifications in applicant's applications and the cited registration. Applicant's identification does not limit its products to embedded computing applications. Also, when there are no limits on channels of trade or classes of consumers in identifications, and there are none in the involved identifications, we must assume that the goods can be marketed to all typical classes of consumers for such goods and through all customary channels of trade for such goods. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

We recognize that computers are ubiquitous, that the degree of sophistication of computer users may vary widely, and that many may be particularly sophisticated in the use of operating systems. Based on these identifications, however, we cannot assume that the respective types of operating system software are of a type that would be sold

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only to professional buyers. We note, in this regard, that the Google search results list submitted by applicant includes, among its listing of "sponsored links," a link to information on a LINUX-based laptop available at Wal-Mart for under \$500 and another link to "Linux for Newbies. TUX-The first magazine for the new Linux user." These listings at least suggest that LINUX-based software is available for use even by general consumers. Whether we consider prospective purchasers to include general consumers or not, however, we note, "even technically sophisticated and careful purchasers ... are not necessarily expert in trademark evaluation or immune from source confusion." See In re Pellerin Milnor Corporation, 221 USPQ 558, 560 (TTAB 1983).

In sum, because the goods are in part identical and otherwise related, because there are no restrictions on the goods as to type, class of consumer or channel of trade, and because the applicant's marks stress the term that is registrant's mark, there is a likelihood of confusion among consumers.

Decision: The refusals of registration under Section 2(d) of the Trademark Act are affirmed.