

I. SECTION 2(D) REFUSAL – LIKELIHOOD OF CONFUSION



The Examining Attorney has refused registration of the mark **Powered by JLL** in International Classes 9, 35, 36, 37, and 42 because the Examining Attorney believes that it is confusingly similar to CORRIDOR (Reg. No. 3,222,453)¹ and THE CORRIDORS (Reg. No. 1,774,745).² The Applicant's amended identification of goods and services reads as follows:

Class 9:

Downloadable software in the nature of a mobile application for promoting the goods and services of others; downloadable software in the nature of a mobile application for providing access to coupons, discounts, and promotions for the goods and services of others; downloadable software and downloadable mobile applications allowing merchants to transmit, publish, distribute, and share data and information in the fields of coupons, deals, and discount shopping; downloadable software that provides web-based access to applications and services through a web-operating system or portal interface

Class 35:

Research of history of real properties, namely, market research of historical trends in the real estate market

Class 37:

Real estate development services, construction consultation, building construction supervision, building construction and repair, building inspection in the course of building construction

¹ The refusal based on the CORRIDOR registration applies only to the Applicant's goods in International Class 9.

² This refusal applies to all International Classes in the application.

Class 42:

Planning and layout design services for the interior space of retail business establishments, interior design services

The goods and services covered by the cited registrations are as follows:

CORRIDOR (Class 9):

Computer software in the aviation service field, namely, software for tracking aviation services namely labor, parts, services and costs associated therewith, tracking and maintaining inventory conditions, selling price, exchange selling price, quantity, manufacturer, owner of consigned parts, cost, warehouse placement, serial numbers and bin numbers; computer software in the aviation service field, namely, software for monitoring customer quotes, namely labor, parts, services and freight charges and tracking costs, revenue, and gross profits against the customer quotes; computer software for managing line sales and management in the aviation industry, namely managing and tracking aviation storage costs, fuel inventories for refueling, purchasing and receiving fuel, catering, hotel reservations, ground transportation, automatic in-to-plane fees, tracking trip history, tracking scheduled arrivals; computer software in the aviation service field, namely, software for accounting, billing, purchasing and invoicing; computer software for monitoring adjustment pricing relationships with customers and customer classes, pricing for inventory, labor, services, and fuel, and for fixed, list, percentage, and discounting pricing; aviation services computer software for tracking aircraft maintenance history, for tracking sales of inventory, fuel, consignment parts, and services, and tracking orders, backorders, rentals, replacement parts, return authorizations, and inventory exchanges, and managing packing slips, delivery tickets, and shipping logs; aviation services computer software for tracking inventory and material received, and tracking inventory inspection and release designations and acceptance and rejection notifications tracking customer quotes, customer requests for quotes and vendor quotes; aviation services computer software for tracking and managing contact information; aviation services computer software for tracking and managing quotes, scheduling, productivity analysis, and future marketing

THE CORRIDORS (Class 36):

Real estate brokerage services; namely, the development, sale and letting of parcels of land comprising a commercial and industrial park

In refusing registration, the Examining Attorney provided only a brief review of the issues of similarity of marks and the similarity of goods and services. The Examining Attorney must consider all of the *DuPont* factors which pertain to a given examination, however, based on the facts of the case. *Application of E. I. DuPont De Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The Applicant respectfully submits that the refusal of registration should be withdrawn because a careful examination of all the relevant *DuPont* factors demonstrates the absence of any likelihood of confusion between the Applicant's mark and those cited in the registrations.

1. Dissimilarity of the Goods and Services

It is well established that even when two marks are identical – which is not the case here – there is no likelihood of confusion so long as the goods are not “related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350, 1356 (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000)). *See also Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668 (T.T.A.B. 1986) (no likelihood of confusion between identical QR marks for coaxial cable and other electronic goods) and *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (no likelihood of confusion between identical LITTLE PLUMBER marks used in the plumbing field). A close comparison of the parties' identifications of goods and services – particularly as the Applicant's identification of goods in International Class 9 has been amended – makes it clear that there is no likelihood of confusion between the parties' marks.

(a) International Class 9

In Office Action No. 1, the Examining Attorney contends that the parties' goods and services are closely related because the Applicant's “identification of goods in Class 9 is void of any field or function for its software” and “it is [therefore] presumed that applicant's software is

used for the identical purposes and in the same fields and travel in all normal channels of trade, and are available to the same class of purchasers.” Office Action No. 1 at 4. The Examining Attorney also argues that the Applicant’s software, “without any specification as to the function or field of the software, could be used in connection with real estate brokerage, development and leasing. Without any clarification at this point, the software is presumed to be used for the purposes just stated.” *Id.* at 3.

Quite to the contrary, the application, as amended, makes it clear that the Applicant seeks registration of the CORRIDOR POWERED BY JLL design mark in International Class 9 only in connection with a specific kind of software – a downloadable mobile application that enables user to get coupons, discounts, and promotions from third-party merchants, and enables such merchants to offer their deals to prospective buyers. Accordingly, the Applicant’s amended application, by its own terms, expressly does not encompass the Registrants’ equally specific aviation servicing software or commercial real estate brokerage services, and the Applicant’s proposed software is not so “related in the mind of the consuming public” to the Registrants’ goods and services as to engender a likelihood of confusion. *Shen Mfg. Co.*, 73 U.S.P.Q.2d at 1356.

In contrast to the Applicant’s discount-promoting mobile app for consumers, Continuum Applied Technology, Inc., owner of the CORRIDOR mark, uses its mark in connection with a modular enterprise software application for the aviation services industry. Continuum Applied Technology’s clients are aviation service providers that range from airports and other fixed-base operators to aircraft repair stations, distributors, and flight departments. See **Exhibit A** (printouts from the Continuum Applied Technology website and LinkedIn page). The purpose, function,

and intended users of Continuum Applied Technology's software have nothing in common with those of the Applicant's mobile app.

In a similar vein, the commercial real estate brokerage services rendered by The Alter Group, Ltd., owner of the THE CORRIDORS mark, likewise are far removed from the Applicant's consumer-facing coupon app. The Alter Group develops, sells, and leases office park properties to corporations and institutions. For example, the company's CORRIDORS PHOENIX development features 1.4 million square feet of office space and an on-site hotel. *See Exhibit B* (printouts from The Alter Group's website for the CORRIDORS PHOENIX development and the company's corporate website). As a result, contrary to the Examining Attorney's assertion, there is no meaningful nexus between the Applicant's mobile app and The Alter Group's commercial real estate brokerage services.

Quartz Radiation, 1 U.S.P.Q.2d 1668, is instructive on the issue. In *Quartz Radiation*, the Trademark Trial and Appeal Board held that there was no likelihood of confusion created by the two parties' use of the identical mark, QR, even though both trademark owners operated within the electronic goods industry. *Id.* at 1669. The applicant sold coaxial cable for use by cable television companies. The opposer manufactured mercury vapor lamps, infrared heaters, and other parts for office copy machines. The Board found that the opposer's products were "almost completely removed from applicant's goods." *Id.* The Board reasoned that confusion would not be likely because "[a]lthough the marks are virtually the same, the products with which applicant uses its mark are quite different from the products of opposer. They are different in nature; they are used for different purposes; they are promoted differently and are purchased by different discriminating purchasers." *Id.* The Board observed that while "all of the machines in which opposer's goods are used operate on electricity, as do the television sets or

computers with which applicant's cables are used, ... this is as close as the products of the parties get." *Id.*

In the instant case, the Applicant and the Registrants address vastly different needs put forth by their respective clients. The Applicant's mobile app software apprises users of the latest deal and discounts. In sharp contrast, Continuum Applied Technology's enterprise software enables aircraft servicers to track maintenance deadlines, work orders, regulatory compliance records, aircraft and aircraft part sales and rental orders, and fuel sales. The Alter Group helps corporations like Google, Salesforce, and WeWork to purchase or lease iconic headquarters and office space. The differences between the Applicant's and the Registrants' goods and services are so significant as to virtually eliminate the likelihood of confusion.

(b) International Classes 35, 37, and 42

The Applicant's services in International Classes 35, 37, and 42 concern technological, engineering, and business intelligence aspects of real estate. As the Applicant's identifications of services make clear, the Applicant intends to provide market research, construction consultation, building inspection, building construction, layout planning, and interior design services in the field of real estate. All of these services stand in stark contrast to The Alter Group's commercial real estate brokerage services, which are *financial* – not technical – in nature. While both the Applicant's and The Alter Group's services relate to real estate, to quote the Board in *Quartz Radiation*, that is "as close as the products of the parties get." *Id.* The Applicant provides technological, engineering, construction, inspection, design, and market research expertise. In contrast, The Alter Group merely rents out or sells office space to corporate and institutional tenants. Just as in *Quartz Radiation*, the respective parties' services are different in nature, are used for very different purposes, and are purchased by very

discriminating parties. Although both parties' services involve real estate, that tenuous common ground is insufficient to show that confusion is likely to occur.

2. Sophistication of Potential Purchasers

It is a basic principle of trademark law that the more costly the goods or services, the more careful and discriminating will be the potential buyers' purchasing behavior. In turn, the more discriminating the purchaser, the less likely it is that he or she will be confused as to the origin of the good or services. *See DuPont*, 476 F.2d at 1361; *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1202, 1206 (1st Cir. 1983) ("there is always less likelihood of confusion where the goods are expensive and purchased after careful consideration"). "It has been repeatedly stated that the level of purchaser sophistication is important and often dispositive" in evaluating the likelihood of confusion. *Tricia Guild Assoc. Ltd. v. Crystal Clear Indus., Inc.*, 38 U.S.P.Q.2d 1313, 1315 (T.T.A.B. 1994).

In *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992), for example, the Court of Appeals for the Federal Circuit held that there was no likelihood of confusion between virtually identical marks (E.D.S. for battery chargers and power supplies for medical instruments, and EDS for computer services provided to the medical and other industries). The court made particular note of the sophistication of the customers at issue, commenting that confusion was less likely because "both opposer's services and applicant's goods are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source." *Id.* at 1392.

Analogous to the customers at issue in *Elec. Design & Sales*, the Applicant's customers and prospective customers are sophisticated investors, institutions, and corporations that exercise a high degree of care in engaging the Applicant's engineering, construction, and design services. Similarly, the Registrants' customers – Continuum Applied Technology's airports, fixed-base

operators, and aircraft repair stations and The Alter Group’s corporate and institutional tenants – also exercise a great deal of care when considering procuring the goods and services of the Registrants.

Considering the tremendous level of expense involved and the substantial potential for liability stemming from making a “wrong” decision when it comes to building construction and inspection, aircraft maintenance, or real estate investment, the parties’ sophisticated customers invest significant time and deliberation in their decision to retain the Applicant or either of the Registrants.

The level of investigation that would be undertaken by the parties’ customers before ordering their goods or services, together with the ongoing nature of the customer-service provider relationship inherent in the parties’ businesses, greatly reduces the likelihood of confusion.

3. Dissimilarity of the Marks



The Examining Attorney’s conclusion that the Applicant’s Powered by JLL mark is confusingly similar to Continuum Applied Technology’s CORRIDOR and The Alter Group’s THE CORRIDORS is predicated solely on the fact that both the Applicant’s and the Registrants’ marks possess the term “corridor” in common. By excluding the other wording in the marks from consideration, the Examining Attorney has contravened the well-established anti-dissection rule.


The anti-dissection rule, as enunciated by the federal courts and the Trademark Trial and Appeal Board, requires that, in comparing the marks’ appearance, sound, and meaning, one must

look to the *overall impression* created by the marks and not merely compare their individual features. *Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093 (8th Cir. 1996) (citing *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987)). This is true even when the marks comprise an identical element, and even where the shared element may be considered “dominant.” *Id.* Indeed, it is a clear violation of the anti-dissection rule to isolate any single element present in the respective marks and conclude that a likelihood of confusion exists solely upon that element, while ignoring all the other elements that comprise each mark as a whole. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981). As stated by the U.S. Supreme Court, “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety...” *Estate of P. D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-546 (1920) (emphasis added). In other words, it is the overall impression created by the totality of the elements in the Applicant’s mark that must be compared to the totality of the overall impression of the Registrants’ marks.

When compared in their entireties, the Applicant’s *four-word design* mark



and the Registrants’ *one- and two-word* CORRIDOR and THE CORRIDORS marks differ appreciably in appearance and pronunciation. The presence of the

well-known JLL house brand and the  design element in the Applicant’s mark further distinguishes the marks and contributes to an overall commercial impression that is distinct from those of the Registrants’ marks. The likelihood of confusion between the three marks therefore

is reduced, notwithstanding the single shared element, “corridor,” particularly in light of the other *DuPont* factors relevant to the instant case.

4. Fame of the Cited Marks

There is no indication that the Registrants have achieved any particular fame in the cited marks. Accordingly, this *DuPont* factor also weighs in favor of the Applicant.

5. Variety of Goods

There is no indication that the Registrants have used CORRIDOR or THE CORRIDORS on a “family” of marks. Consequently, this factor also favors the Applicant.

6. Right to Exclude Others

Because the CORRIDOR POWERED BY JLL design mark is inherently distinctive as applied to the Applicant’s goods and services, the Applicant has the right to exclude others from using the mark on similar or related goods and services where such use would be likely to confuse the consuming public. Accordingly, this *DuPont* factor weighs in the Applicant’s favor.

II. CONCLUSION

In light of the dissimilarities between the parties’ commercial activities, the sophistication of potential purchasers, the distinctions between the marks, the absence of fame of the cited marks, the lack of evidence that the Registrants use the cited marks as part of a “family” of marks, and the Applicant’s right to exclude others, confusion with the cited marks (Reg. No. 3,222,453 for CORRIDOR and Reg. No. 1,774,745 for THE CORRIDORS) is unlikely, and the citation of these registrations should be withdrawn.

The Applicant submits that this application is in proper condition for publication, and respectfully requests that the application be forwarded.