

Mark: "LINEUP"

App. Ser. No. 88937486

Current Description of Services:

-- "Software as a service (SAAS) services featuring software for analyzing market and customer data for understanding, forecasting and providing predictions of consumer, business, and retail market trends and for use in making business decisions", in Class 042.

Proposed Description of Services:

-- "Software as a service (SAAS) services featuring software for use by businesses in the restaurant industry to analyze historical sales data, weather data, local event data and other external factors to forecast and provide predictions of revenue, and of food and labor requirements of the business", in Class 042.

In the present Office Action, dated August 29, 2020, the Trademark Attorney refused registration of the Applicant's mark based on a likelihood of confusion with the mark in Registration No. 6123596. Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Applicant respectfully traverses the refusal.

The mark in question (the "Registered Mark") is "LINEUP", Registration No. 6123596 (the "Cited Registration"), owned by Lineup Systems Corporation, of Broomfield, Colorado (the "Registrant"), for services identified as "Software as a service (SAAS) services for media industry businesses featuring software for customer relationship management (CRM), order management, financial management, managing and performing accounts receivable and accounts payable tasks, billing, cash collection, accounting, and financial reporting", in Class 42.

The Applicant respectfully submits that the differences in the services provided under these marks and the lack of any evidence as to the relatedness of these services, taken as a whole, fully obviate any likelihood of consumer confusion that might otherwise exist between them.

1. The Services are Not Related

Although both the Applicant's mark and the Registered Mark include the term "LINEUP", identical marks have been held not to be confusing where the goods or services are not related. *See, e.g., Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1220 (TTAB 2011) ("Even if marks are identical, the goods and services must also be sufficiently related and/or the circumstances surrounding their marketing be such that purchasers encountering them would mistakenly believe that they emanate from the same source for us to find that confusion is likely to occur."); *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355-56 (Fed. Cir. 2004) (finding no likelihood of confusion between "THE RITZ KIDS" and "RITZ" where it is "unlikely that consumers would mistakenly believe that Shen, the manufacturer of kitchen textiles, has expanded into children's clothing").

The critical question is whether the services identified in the Applicant's application and the services identified in the Cited Registration are "related." Related has a specific legal definition: "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." *Id.* at 1356. "Looser relationships do not suffice; for example, the mere fact that 'two goods are used together, however, does not, in itself, justify a finding of relatedness.'" *Id.*

The issue of registrability "must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which sales of the goods [or services] are directed. *Octocom Sys., Inc. v. Hous. Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Breaking down the identification of services in the Cited Registration, it includes: (a) a general introductory clause – “Software as a service (SAAS) services” – which provides a general description of the services, followed by (b) a description of the specific field or industry to whom its services are provided, in this case, “media industry businesses”, followed by (c) a description of the specific features that the Registrant provides through its software, namely: (i) “customer relationship management (CRM)”, (ii) “order management”, (iii) “financial management”, (iv) “managing and performing accounts receivable and accounts payable tasks”, (v) “billing”, (vi) “cash collection”, (vi) “accounting”, and (viii) “financial reporting”.

The first aspect of this identification – “Software as a service (SAAS) services” – is identical to the first aspect of the Applicant’s identification of services, as amended by this filing. However, it is no more than an umbrella description, like “retail store services”. “Software as a service” is a recognized term of art in the software field. “Software as a service (or SaaS) is a way of delivering applications over the Internet—as a service. Instead of installing and maintaining software, you simply access it via the Internet, freeing yourself from complex software and hardware management.” *See Exhibit A* submitted herewith. Virtually any company capable of making its software accessible through the internet is able to provide this service. As will be discussed below, this fact alone does not make all internet software related.

The second aspect is the heart of the identification. It makes it clear that the ONLY users of or customers for the Registrant’s software are “media industry businesses”. This is fully consistent with the Registrant’s own website (available at www.lineup.com), which states that the Registrant “caters to many of the biggest, most iconic and innovative media organizations in the world”. As if to prove its point, the Registrant’s website includes a graphic that features the logos many of the biggest media companies in the world, including Gannett, *The New York*

Times, McClatchy, and Hearst Magazines, among many others. (See Exhibit B submitted herewith.)



The third aspect of the Registrant’s identification describes the eight different features that the Registrant’s software provides to users and customers, from “customer relationship management (CRM)” through “financial reporting”.

In effect, the Registrant uses the Registered Mark to give its customers (who consist SOLELY of media businesses) access to a software program that those customers can use for a variety of customer and financial management functions.

In contrast, the Applicant’s application (as amended) covers “Software as a service (SAAS) services featuring software for use by businesses in the restaurant industry to analyze historical sales data, weather data, local event data and other external factors to forecast and provide predictions of revenue, and of food and labor requirements of the business”. The Applicant makes this software available to its customers through a website maintained by or on behalf of the Applicant.

Applicant’s software is completely different from and unrelated to the Registrant’s software. In particular, the Applicant’s software is ONLY marketed to customers in the

restaurant industry. The Applicant's software will not be marketed to, and would not be used by, any media businesses.

Moreover, the functions of the Applicant's software are completely different from the functions of the Registrant's software. While the Registrant's software allows its users to perform a variety of customer and financial management functions, the Applicant's software is designed to analyze available data, namely, historical sales data, weather data, local event data and other external factors, to enable the restaurant to forecast and predict revenue and food and labor requirements. The user will then use this information to make business decisions concerning the activities of the restaurant, such as, for example, whether to purchase additional food in anticipation of a surge of customers following a parade or holiday, or whether to hire additional staff for the weekend after Christmas.

In the present Office Action, the Trademark Attorney asserted that "the function or purpose of the respective software services is similar", in that "[t]he registrant's software is for managing customer relationships, which inherently requires the collection and analysis of customer data or information, and the applicant's software is for, among other things, analyzing customer data".

However, Applicant respectfully disagrees. It is true that the Applicant's software analyzes "historical sales data", which may involve transactions with customers, as well as weather data, local event data and other external factors. But that fact alone does not mean that the Applicant's software is "related" to the Registrant's software. The Applicant's software cannot not be used to manage customer relationships, nor is it capable of performing any of the other functions performed by the Registrant's software. Moreover, the Office Action did not include any evidence regarding the relatedness of these two very different types of software. The

only way in which these two types of software are related is that each is made available to its users online. But with the advent of the internet, almost all software is available online. That fact alone does not make all software related.

In essence, the Registrant's software is intended to enable "media businesses" to manage their customers, while the Applicant's software is intended to enable restaurants to make predictions about how much revenue they will earn, how much food they will need, and how to properly staff their restaurant.

The Trademark Trial and Appeal Board (the "Board") has long recognized that "the fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks." *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (finding no likelihood of confusion between "EDSA" used on "computer programs for electrical distribution system analysis and design", and "EDS", used on "computer programming services including the design, implementation and management of electronic data processing programs").

More recently, the Court of Appeals for the Federal Circuit stated that, "given the pervasiveness of software and software related goods in society, it would be inappropriate to presume relatedness [of two marks, both used on software or related goods] on the mere basis of goods being delivered in the same media format". *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (finding no likelihood of confusion between interactive educational CD-ROMs in the pharmaceutical and medical industries and computer software featuring business management applications for the film and music industries).

In *Pointivity v. ChannelVission*, Serial No. 92055731, 2015 BL 142218 (TTAB 2015) [NOT PRECEDENTIAL], the Board went even further, noting that “both Petitioner’s and Respondent’s services are in the field of cloud computing, but given that cloud computing, like computers and the Internet, is fast becoming ubiquitous, the fact that Petitioner’s and Respondent’s services both involve cloud computing in some manner is not a sufficient basis on which to find the services to be related”. *Id.*, at 7 (finding no likelihood of confusion between “CHANNELCLOUD” used for “consulting services in the field of cloud computing” and the same mark used for “application service provider” services, “namely, hosting computer software applications of others”).

Other cases are to the same effect. *See., e.g., Embarcadero Technologies, Inc. v. RStudio, Inc.*, 105 USPQ2d 1825 (TTAB 2013) (finding no likelihood of confusion between “RSTUDIO” used for “computer software for advanced statistical computing using the R computing language and the data from two dimensional datasets” and “ER/STUDIO” used for “entity relationship modeling software for SQL databases”); *Captaris, Inc. v. Captara Corporation*, Serial No. 78458452 (TTAB 2007) [NOT PRECEDENTIAL] (finding no likelihood of confusion between “CAPTARA” used on database management software in the field of financing fixed-assets and “CAPTARIS” used on fax server and document delivery software); *Integrated Device Technology, Inc. v. Management Science Associates, Inc.*, Serial No. 75510183 (TTAB 2001) [NOT PRECEDENTIAL] (finding no likelihood of confusion between “IDT” for “computer software for use in the transfer of files via global computer information networks” and the same mark for “computer programs for use in the design and application of semiconductor devices, microprocessors, and microcontrollers”); *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (finding no likelihood of confusion between

“X*PRESS” for “transmitting news and a variety of general information and data to home and business computers via satellite and cable television lines” and “EXPRESS” for “computer software and services relating to the analysis of information, including financial information”); *Reynolds and Reynolds Co. v. I.E. Sys., Inc.*, 5 USPQ2d 1749 (TTAB 1987) (finding no likelihood of confusion between “ACCULINK” for a “computer program for asynchronous communications use” and family of “ACCU-” prefixed marks used for various computer services and the leasing of computers).

In *Captaris, Inc. v. Captara Corporation*, Serial No. 78458452 (TTAB 2007) [NOT PRECEDENTIAL], the Board stated that, “[w]here, as here, opposer’s software is distinctly different from applicant’s software, it is the opposer’s burden to prove that its software is related in some manner or that the conditions surrounding the marketing thereof are such that they would be likely to be encountered by the same persons under circumstances that give rise to the mistaken belief that they originate with the same source.” *Id.* at 22. The Board went on to find no likelihood of confusion between the mark “CAPTARA” as used on database management software in the field of financing fixed-assets and the mark “CAPTARIS” as used on fax server and document delivery software.

Although this is not an opposition, the Applicant respectfully submits that the same principle applies here. That is, evidence must be provided to demonstrate that these two types of software are related. *See* TMEP Section 1207.01(a)(vi).

In *Captaris*, the Board rejected the argument that “simply because both parties develop business application software, that fax server and delivery software are related to database management software in the field of fixed-asset financing”. *Id.* at 23. Where “there are marked differences between opposer’s software and applicant’s software”, there must be something more

than the mere fact that both types of software can be used by the same business. *See also Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“We recognize that opposer’s data processing/information management services are applied in a wide variety of industries, including banking and insurance. Opposer has not, however, shown that computer-aided manufacturing and computer-aided design services are a part of its data processing or information management services”).

The Applicant’s software is distinctly different from the software provided under the Registered Mark. The Applicant’s software is not intended for “media businesses”. Conversely, the Registrant’s software is not intended for, and the identification of services for the Registered Mark does not encompass, restaurants. In addition, as noted above, the forecasting functions provided by the Applicant’s software are distinctly different from the customer relationship management functions provided by the Registrant’s software. In short, the services provided under the Registered Mark are just not related to the Services identified in the present application, as amended.

2. The Trade Channels are Different

Another factor in a likelihood of confusion analysis is “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *See* TMEP Section 1207.01; *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

However, “if the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold their goods through the same channel of distribution.” 4 *McCarthy on Trademarks and Unfair Competition*, § 24:51 (5th ed.).

In *General Aniline & Film Corp. v. H.R.L. Inc.*, 136 USPQ 386 (TTAB 1962), the Board considered an opposition to an application for the mark “GAF” for goods described as “additives for motor oil or fuel for the purpose of dissolving deposits of varnish, resins, gums, and carbon in internal combustion engine”. Opposer owned several registrations that included the term “GAF” for various industrial chemicals, including dyestuffs, solvents, antioxidants and surfactants. Opposer contended that the goods were related in that they were chemically similar. The Board disagreed. In finding no likelihood of confusion, the Board held that “Opposer’s industrial chemicals and applicant’s colloidal graphite additive for motor oil or fuel are neither closely related nor would they be likely to move through the same trade channels to the same class or purchasers and . . . therefore, purchasers of the respective products would have no logical basis for assuming that such products emanate from a common source”. *Id.* at 388.

More recently, in *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006), the Court of Appeals for the Federal Circuit found no likelihood of confusion between the mark “M2 COMMUNICATIONS” (with all rights in “Communications” disclaimed), as used on interactive educational CD-ROMs in the pharmaceutical and medical industries, and the mark “M2”, as used on computer software featuring business management applications for the film and music industries. Despite the obvious similarities between these marks and the fact that both were used on goods related to computers, the Federal Circuit found no likelihood of confusion. In doing so, the court noted that “the parties’ channels of trade and purchasers [were] different”. All of M2 Software’s customers were in the “music or entertainment industries”. In contrast, “M2 Communications deals only with pharmaceutical and medical customers, and all of its marketing is directed towards those fields.”

The Federal Circuit went on to note that “[t]he unrelated nature of the parties’ goods and their different purchasers and channels of trade are factors that weigh heavily against M2 Software. It is difficult to establish likelihood of confusion in the absence of overlap as to either factor.” *Id.* at 1948.

See also Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (finding no likelihood of confusion between “EDS” used in connection with data processing services provided to medical insurers and “E.D.S.” (in a stylized format) used on batteries and power supplies sold to makers of medical equipment, such as bedside alert systems and crib monitors, even though both marks are used “within the medical field”); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1221 (TTAB 2011) (“CALYPSO CAPITAL MANAGEMENT” for equity investment management and fund services held not related to “CALYPSO” for computer software used by financial institutions where there was no evidence that the involved software and investment services were “ever offered by a single company”).

In the present application, the Applicant’s customers for its service are limited to restaurants. These businesses will be able to use the Applicant’s service to make predictions about the future, such as how much revenue will my restaurant earn over Memorial Day weekend, or how many chicken wings should I buy for my restaurant for the day before the Super Bowl, or how many employees should work the night of the local college’s graduation day.

In contrast, the software provided under the Registered Mark is offered ONLY to “media industry businesses”, such as the *New York Times*, the *Washington Post* or Fox News. There is absolutely no overlap between the prospective customers for these services. Accordingly, as in

General Aniline & Film Corp., the Applicant respectfully submits that there is “no logical basis for assuming that such [services] emanate from a common source”. 136 USPQ at 388.

3. The Record Does Not Include Evidence that the Services are Related

TMEP Section 1207.01(a)(vi) provides that “[t]he examining attorney *must* provide evidence showing that the goods and services are related to support a finding of likelihood of confusion” (*emphasis added*). Except for the assertion of relatedness – which the Applicant denies – the Trademark Attorney has not provided any evidence whatsoever that the services provided by the Applicant are related to the services provided under the Registered Mark.

Because both parties provide software to their customers through the internet, this essentially means that the Trademark Attorney must demonstrate that the Applicant’s software is related to the software provided under the Registered Mark.

As discussed above, this is simply not the case. The Applicant’s software is completely unrelated to the software provided under the Registered Mark, and the customers for the Applicant’s software are completely different from the customers for the software provided under the Registered Mark.

Summary

In sum, the Applicant respectfully submits that the differences between the services provided under the Applicant’s mark and those provided under the Registered Mark, the differences in the channels of trade and customers for each service, and the complete lack of any evidence demonstrating the relatedness of these services, taken as a whole, are such as to obviate any likelihood of confusion that might otherwise exist between these marks. For the reasons set forth above, the Applicant respectfully submits that it should be permitted to register its mark “LINEUP” for use in connection with the services covered by this application, as amended.

Accordingly, the Applicant respectfully submits that the refusal of registration under Section 2(d) is in error and should be withdrawn.