

In the Office Action, the Examining Attorney refused registration of Applicant's mark on the assertion that a likelihood of confusion was present with respect to U.S. Registration Nos. 2427144 and 3313811. The Examining Attorney also found Applicant's mark to be descriptive of the listed goods. These matters are addressed herein.

I. AMENDED IDENTIFICATION OF GOODS

In connection with the arguments presented with respect to the § 2(d) refusal, discussed further below, Applicant has amended the identification of goods in the present application as follows:

In Class 009: Please amend as follows:

Original: Telecommunications hardware and recorded software for monitoring and alerting remote sensor status via the Internet sold as a unit.

Current: Telecommunications hardware and recorded software for monitoring pressure in gas and water lines and alerting remote pressure sensor status via the Internet sold as a unit.

Applicant asserts that the description of goods has not been expanded beyond those originally itemized in the Application and does not add goods. Accordingly, Applicant believes that the amended description of goods is acceptable and requests entry thereof.

II. REFUSAL UNDER SECTION 2(D)

Registration of the applied-for mark was refused based on the Examining Attorney's finding that the mark was confusingly similar to that of U.S. Registration Nos. 2427144 and 3313811 (hereinafter the "'144 and '811" registrations, respectively). While Applicant does not dispute the Examining Attorney's finding with respect to the asserted similarity of the marks, Applicant does contend that the goods and services of Applicant's mark, as amended, and the registered mark are not sufficiently related to support a finding of likelihood of confusion.

A. Relatedness of Goods and Services

While Applicant acknowledges that compared goods and/or services need not be identical or even competitive to find a likelihood of confusion, Applicant contends, that in the case of the present goods, there is no relation sufficient to give rise to the mistaken belief that the goods and services emanate from

the same source. In particular, the Office Action includes the finding that the present application "uses broad wording to describe telecommunications software for monitoring and alerting remote sensors, which presumably encompasses all goods of the type described, including registrants' more narrow monitoring software." Office Action, at p. 3. In one respect, Applicant notes that the present goods specify that the telecommunication monitor and alert remote *sensor* status, which does not encompass either of the Registrants' goods, which pertain to monitoring computer systems and electronic door access systems and locks, but not sensors.

Additionally, as discussed above, the present goods have been amended to narrow the description of goods to focus more specifically on Applicant's current goods, which relate to hardware and software for monitoring of pressure in water or oil and gas lines. Applicant asserts that these goods are distinct from those described in the cited registrations, which relate to computer system monitoring (the '144 Registration) and facilities management software (the '811 Registration). Applicant notes that the specific monitoring described in connection with the '811 Registration, including access systems, key card entry locks, and the like, give the clear impression and understanding that the goods related to facilities consisting of commercial buildings.

Applicant contends that there is no overlap between the goods associated with the present mark or the asserted registrations. Municipal water operations, as well as commercial or municipal oil and gas operations are very specific in nature with dedicated consumers that would not overlap with those of the software provided by either of the registrants, nor would a consumer of one good be confused by application of the present mark to another of the goods, due to the differing, specific nature of the goods.

Accordingly, Applicant contends that the goods associated with the present mark are recognizably different from those associated with the cited mark.

B. Sophistication of Purchasers and Trade Channels

"Generally, in assessing the likelihood of confusion to the public, the standard used by the courts is the typical buyer exercising ordinary caution. However, when a buyer has expertise or is otherwise more sophisticated with respect to the purchase of the goods and/or services at issue, a higher standard is proper. Similarly, when services are expensive or unusual, the buyer can be expected to exercise greater care in her purchases." When goods and/or services are sold to such buyers, other things being equal, there is less likelihood of confusion. *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 285, 42 U.S.P.Q.2d 1173, (6th Cir. 1997). Although the cited case was decided on the basis

of differences between the marks, it was also noted that "[t]he issue of whether a portion of a mark is dominant turns on the facts of each case" and referred in support of this rule to the case of *Clayton Mark & Co. v. Westinghouse Elec. Corp.*, 356 F.2d 943, 53 CCPA 951, 148 USPQ 672 (1966) stating that in that case, the likelihood of confusion was reduced by the fact that the goods of both parties appeared to be expensive and the type purchased by sophisticated purchasers. Similarly, in the present instance, the goods provided by Applicant to its customers (namely hardware for oil and gas line monitoring), as well as those sold by the Registrants (software for computer system monitoring and building management software) are all sold to trained and/or professional buyers who purchase goods to meet strict specifications and for specific purposes. Accordingly, these customers use a greater level of sophistication and consideration in the decision to purchase, would be more likely to recognize the above-described differences in the goods, and would be less likely to be confused by any assertedly similar mark use.

The conditions under which the purchase of particular goods or services are made, that is whether the purchase is the result of impulse or the result of a careful sophisticated decision making, are to be considered in determining likelihood of confusion. See TMEP Section 1207.01, citing *In re E.I. duPont de Nemours & Co*, 476 F.2d 1357 at 1361-63 (C.C.P.A. 1973). The goods offered by Applicant are of a substantial nature in that they involve the purchase of products used in systems that are installed and operated by trained professionals. In a similar manner, the goods of the registrants are used in different settings, with similar operational requirements. Specifically, with respect to the '811 Registration, building management systems, including entry and security systems, are almost exclusively sold and installed, as well as operated and managed by, trained professionals. Any monitoring software would have to be selected or modified for operability with the specific hardware being monitored. With respect to the '144 Registration, similar requirements would be present in the different context of computer system monitoring. All of these purchases involve a sober and considered decision on the part of the customer. Moreover, both the Registrants' building and computer system monitoring software products and Applicant's water and gas line pressure monitoring hardware are often sold through dealers or distributors directly to purchasing agents or installers.

The nature of both the Applicant's products and the Registrants' products, as well as the circumstances surrounding the decision required to purchase such products greatly lessens the likelihood that any confusion would exist in the mind of a customer regarding the source of Applicant's goods and either of the Registrants' goods. The presence of these facts means that the chance of confusion is remote, even in the unlikely event that a potential customer encountered both Applicant and the registrant. The

purchase of Applicant's goods is not of a nature in which a decision would be made on impulse or without time for consideration and adequate knowledge of the vendor. Accordingly, the chance of any likelihood of confusion is further diminished.

C. No Likelihood of Confusion

Because Applicant's goods and the Registrants' goods are not sufficiently related to give rise to the mistaken belief that the goods emanate from the same source in light of the high level of sophistication of consumers of Applicant's goods, there would be no likelihood of confusion as to the source of the respective goods.

IV. REFUSAL UNDER § 2(e)(1)

In the Office Action, registration of Applicant's mark was also refused on the finding that the MESSENGER mark is merely descriptive of Applicant's goods. Although Applicant contends that a "messenger" connotes a person delivering a physical message such that Applicant's mark is, at best, suggestive of the listed goods, which include electronic hardware and software, Applicant defers further discussion of the § 2(e)(1) refusal pending the Examining Attorney's evaluation of the § 2(d) refusal. In this respect, Applicant indicates that, should the above amendments and remarks overcome the § 2(d) refusal, but that further elaboration on Applicant's position regarding the suggestive nature of the MESSENGER mark would not likely persuade the Examining Attorney, then Applicant may consider amendment to seek registration of the mark on the Supplemental Register.

IV. CONCLUSION

Because there would be no likelihood of confusion between Applicant's mark and that of the asserted marks, and because Applicant's goods are clearly described in a single class of goods, Applicant contends that the present MESSENGER mark is in condition for registration. A notice to this effect is earnestly solicited.