


Response to Office Action for Serial No. 87/242,244

Connection

The Examining Attorney has refused registration of the mark , (“Applicant’s Mark”), Application Serial No. 87/242,244, in the name of PC Connection, Inc. (respectively, the “Application” and “Applicant” or “PC Connection”) claiming that there is a likelihood of confusion with the registration for the mark CONNECTIONS, Registration No. 2039948, (the “Cited Mark”) in the name of Cadence Design Systems, Inc. (the “Cited Registrant” or “Cadence”) for “computer programming services and consultation services in the field of computer software development” in Class 42 (the “Cited Registration”).

The Examining Attorney’s refusal focuses specifically on the Application’s inclusion of services described as “design and development of computer systems and computer networks for others” and “computer programming.” In response, Applicant has amended the description of services in the Application (the “Amended Description”) by deleting the services cited by the Examining Attorney and any other service descriptions that could be understood as covering the Cited Registration’s “computer programming services and consultation services in the field of computer software development.”¹

It is respectfully submitted that, in light of this amendment, and for the other reasons set forth below, there is no likelihood of confusion between the Cited Mark and the Applicant’s Mark and that the Application should therefore proceed to registration.

I. The Services and Channels of Trade are Different.

As the Examining Attorney states, “When analyzing an applicant’s and registrant’s goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services stated in the application and registration at issue, and not on extrinsic evidence of actual use.” The Examining Attorney’s refusal of registration was based on the overlap between certain limited elements in the Applicant’s original description of services and

¹ Applicant has amended the description of services in the Application to read as follows: “information technology consulting services; technical support services, namely, troubleshooting of computer software problems; integration and configuration of computer systems and computer networks for others; information technology support services, namely, monitoring network systems via information technology service support centers and helpdesks; computer systems analysis; maintenance of computer software; computer virus protection services; managing and protecting electronic messaging systems by means of anti-spam protection and filtering of unwanted e-mails; the provision of firewalls for computer networks; providing a web site featuring temporary use of non-downloadable software for enabling users to review information technology (IT) products and services, submit and approve requisitions for IT equipment and services, and purchase IT equipment and services.”

the services of “computer programming and consultation in the field of computer software development” recited in the Cited Registration.

Considering only the descriptions of services contained in the Cited Registration and the Application (as amended), one must conclude that there is no similarity or relatedness between the services covered by the Cited Registration and the Application and therefore no likelihood of confusion.

Applicant also respectfully submits that, pertinent evidence in the record (as opposed to extrinsic evidence of actual use) must be considered in addition to the descriptions of services contained in the Cited Registration and Application in ascertaining channels of trade and similarity or dissimilarity of goods and services. TMEP §1207.01; *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In considering likelihood of confusion between the Applicant’s Mark and the Cited Mark, the Cited Registrant’s very general description of its services (“computer programming services and consultation services in the field of computer software development”) must therefore be read in the light of the specimen it submitted in support of its application for registration. See Exhibit A. The specimen describes a service called “Connections Program” or the “CADENCE CONNECTIONS Program,” which “foster[s] the development of validated interfaces.” The specimen explains, “Through the program, software suppliers can access Cadence software and support for the development of validated interfaces to Cadence products ...” Thus, the record reveals that Cited Registrant’s CONNECTIONS services are directed to third party software suppliers that offer solutions that complement those of the Cited Registrant, supporting software suppliers in the development of validated interfaces that will work with Cited Registrant’s products.

Services of this kind are not likely to be confused with the services described in the Amended Description, which focus entirely on the logistics, acquisition and management of information technology products and services. Applicant provides to organizations the services of managing and enhancing their existing IT infrastructure. The Cited Registrant provides the services of supporting third party developers in developing interfaces to work with Cited Registrant’s products. In brief: Applicant’s services concern *consumption* of IT products; Cited Registrant’s concern their *production*. Applicant’s services travel through the channels of trade concerned with the acquisition and use of IT products; the Cited Registrant’s travel through the completely different channels of trade concerned with their production.

Although the Applicant and Cited Registrant both provide services to organizations, this does not mean that their customers would overlap or that their channels of trade are similar. “[T]he mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992). Even within a given organization, the personnel responsible for production are likely to be completely different from the personnel responsible for acquisition.

For these reasons, the services described in the Cited Registration and Application are completely different, the services travel through different channels of trade, and marks describing those different services are not likely to be confused.

II. The Mark in the Cited Registration and Applicant's Mark are Different.

The Examining Attorney acknowledges the fundamental rule that marks must be compared in their entireties. TMEP §1207.01(c)(ii). When the marks are compared in their entireties, they create different commercial impressions. Applicant's Mark contains a very distinct graphical element consisting of an arc design over the "onnect" portion of the mark, creating the visual of a bridge. Such design is on top of the mark and the eye is immediately drawn to it. It is both attention-grabbing and quite distinctive. It conveys the impression of unity and of bringing elements together.

In contrast, the mark in the Cited Registration consists of just the word "CONNECTIONS," and as shown in the specimen is used in close proximity to the Cited Registrant's corporate name and logo, Cadence (and design). The Cited Registration coexists with a registration for another "Connections" mark for similar services, namely, Registration No. 4124603 for the mark QONNECTIONS.² This coexistence suggests that the US PTO considers a difference of one letter, in this case a "Q" instead of "C," to be enough to distinguish two marks. The Cited Registration also coexists with a registration for the mark CONNECTION OPEN, Registration No. 3722787, for "computer software design for others; computer software development; customization of computer hardware and software."³ This coexistence suggests that the US PTO considers the addition of another element to the mark CONNECTION, such as the word "OPEN," to be enough to distinguish two marks, even when both marks cover services related to "computer software development" (which is not the case in comparing the Cited Registration with the Application, for the reasons set forth above). Therefore, if the difference of one letter is enough to distinguish two marks, and the addition of another element to a mark is enough to distinguish two marks, then the design element in Applicant's Mark is enough to distinguish Applicant's Mark from the mark in the Cited Registration, particularly in light of the distinct difference in the services they provide. "Third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP §1207.01(d)(iii); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir.

² QONNECTIONS is registered for "Business consulting and business marketing services in connection with the implementation of programs for the purpose of certifying resellers to market and provide software design, development, integration and maintenance services; business research services; providing business consulting and business marketing in connection with the promotion of value-added reseller services in the field of computer software for use by software developers, programmers, distributors, OEMs, and other software resellers; software marketing services for others; reseller services, namely, distributorship services in the field of computer software" in Class 35 in the name of QlikTech International, AB. See Exhibit B.

³ This mark is registered in Class 42 in the name of Randy Morrison. See Exhibit C.

2015)(“More broadly, evidence of third-party use bears on the strength or weakness of an opposer’s mark”); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”)

III. Sophisticated/Discerning Purchasers Reduce Any Likelihood of Confusion.

It is well established that circumstances suggesting care in purchasing minimize the likelihood of confusion. TMEP §1207.01(d)(vii); *In re N.A.D., Inc.*, 754 F.2d 996, 1000 (Fed. Cir. 1985)(“... only very sophisticated purchasers are here involved who would buy with great care and unquestionably know the source of the goods. There would be no likelihood of confusing source merely by reason of the similarity between NARCO and NARKOMED.”) “The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. “careful, sophisticated purchasing” must be considered if there is pertinent evidence in the record.” TMEP §1207.01.

The Examining Attorney’s Office Action failed to take this important factor into consideration. Once considered, it weighs heavily against a likelihood of confusion. It is clear that we are not dealing here with impulse purchases in a check-out line. As shown by the Amended Description and explained above, Applicant’s customers are companies seeking infrastructure services related to the acquisition of information technology products and services. Applicant’s customers are sophisticated in that they have knowledge of information technology solutions, the costs involved in such solutions, and the expertise needed in choosing a service provider for managing the acquisitions of additional information technology products and services. Applicant’s customers are not going to impulsively purchase such services, but instead will proceed with the utmost care in choosing an IT solutions provider. The Cited Registrant’s customers are third parties seeking to develop computer software programs that are compatible with Cited Registrant’s products and solutions. They are not going to choose just any provider of services for support in the development of compatible, validated interfaces to Cited Registrant’s products and solutions. The distinctive design added in Applicant’s Mark, the wide divergence in services, and the sophistication of the consumers all mitigate against any inference of a likelihood of confusion.

For the reasons set forth above, there is no likelihood of confusion between the Application and the Cited Registration and Applicant respectfully requests that the refusal to register the Application be withdrawn. Applicant has met the Examining Attorney’s requirements and requests that the Application be approved for publication.