GREENBERG
ATTORNEYS AT LAW
TRAURIG

September 10, 2001

Attorney Docket No. 46250.010300

VIA FIRST CLASS MAIL

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

Submitted herewith please find a Response to First Office Action with respect to Applicant Sterling Software (U.S.), Inc.'s application for the mark **ONTIME:DISPATCH**, Serial No. 76/122,042 and a return postal card acknowledging receipt hereof.

If any additional fees are required in connection with this filing, please charge Deposit Account No. 50-0653.

Respectfully Submitted,

TRADEMARK MATTER
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE WITH SUFFICIENT POSTAGE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT COMMISIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513
ON 9/10/01

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McLean, VA 22102
(703) 749-1300

cc: Ms. Kellie S. Keifer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Trademark Application	)	
	)	
Sterling Software (U.S.), Inc	)	Examining Atty.: Matthew H.
	)	
Serial No.: 76/122,042	)	Law Office: 104
	)	
Filed: September 1, 2000	)	Our Ref. No.: 46250.010300
	)	
Mark: **ONTIME:DISPATCH**	)	

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RESPONSE TO FIRST OFFICE ACTION

This is in response to the First Office Action dated March 19, 2001 (the "Office Action"). In the Office Action, the Examining Attorney refused registration on the ground that Applicant's mark **ONTIME:DISPATCH** (the "Mark") is confusingly similar to Registration No. 1,625,682. The Examining Attorney also refused registration on the ground that the identification of services is indefinite because the Applicant uses the wording "relating to" instead of "namely."

LIKELIHOOD OF CONFUSION:

There Is No Likelihood Of Confusion Between The Mark And Registration No. 1,625,682.

The Examining Attorney is incorrect in concluding that there is a likelihood of confusion between Applicant's Mark and Registration No. 1,625,682. Applicant's goods are "computer software for synthesizing and/or displaying air carrier operational data," while its services are "computer services for others relating to design and implementation of software for synthesizing and/or displaying air carrier operational data." Registrant's goods, on the other hand, are "computer programs for schedule management, and manuals sold therewith."

The Examining Attorney concludes without any evidence that "[s]ince both marks

contain an identical term and both goods involve computer programs a likelihood of confusion exists between the two marks." Applicant respectfully disagrees with the Examining Attorney. The only term that the descriptions of goods for the Mark and Reg. No. 1,625,682 both include is the word "computer." Furthermore, Applicant and Registrant's use of their respective marks demonstrates that consumers are not likely to be confused. Applicant uses its Mark for software that "integrates dynamic air traffic control (ATC) and airline data" – software that is clearly targeted at airports and airlines. (**Exhibit A**). Registrant uses its mark for computer software to coordinate employee "work schedules and meetings" – software that is targeted at the personal/retail consumer. (**Exhibit B**). The channels of trade and targeted customers are completely different.

The fact that the Mark and Reg. No. 1,625,682 both involve computers and software is insufficient to find a likelihood of confusion.

> [T]he Board has cautioned that there is no per se rule that confusion will always be found as between any and all items of computer hardware and software. . . . As the computer becomes widely accepted as a common tool used in all phases of businesses and professions, **it becomes possible for a trademark on computer products targeted at a specialized market to coexist without confusion with a somewhat similar trademark used on computer products targeted at a quite different specialized market. . . .** Thus, the Trademark Board and the Federal Circuit "have rejected the view that a relationship exists between goods and services simply because each involves the use of computers."

4 J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:44 at 24-65 (4th Ed. 2000). In *Amicus Communications, L.P. v. Hewlett-Packard Co., Inc.*, 1999 WL 495921 (W.D. Tex. June 11, 1999), the court addressed whether the plaintiff, which had registered the mark PAVILION for providing on-line communication services to affinity groups over the Internet, could allege the existence of a likelihood of confusion by the defendant's use of the same mark for the manufacture and sale of personal computer systems. The court noted that the plaintiff's

services required users to register to gain access, while the defendant did not restrict its sales of personal computers to specific individuals or groups. *Amicus*, 1999 WL 495921 at *12.[1] Finding no likelihood of confusion merely because both marks involved computers, the court observed:

> More to the point, there are other instances of personal computers and internet services companies sharing names. For example, Presario is the name of a leading personal computer marketed by COMPAQ and Presario.com is an unrelated consulting company which offers advice on systems integration. Indigo is the name of a work station marketed by Silicon Graphics and unrelated Indigo.com markets science-related equipment. ASPIRE is the name of a personal computer and unrelated to ASPIRING TECHNOLOGIES provides web page development and internet services. VERSA is the name of [a] notebook computer and unrelated Versa.com provides internet publishing and marketing services. Poweredge is a sub-brand of Dell Computers and unrelated Poweredge.com provides internet site hosting. Pavilion Technologies, Inc. in Austin, Texas markets software under the name Pavilion. The Trademark Trial and Appeal Board has rejected plaintiff's premise that all computer hardware, software and internet services are "closely related" when it noted that: "[T]here must be some similarity between the goods and services beyond the fact that each involves the use of computers." The Trademark Trial and Appeal Board has held the fact that the two parties provide computer programs in and of itself "does not establish a relationship between good[s] 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. . . . The computer filed [sic] has become too large and too fragmented for a *per se* rule.

Id. at *12-13. *See also In re Quadram Corp.*, 228 U.S.P.Q. 863 (T.T.A.B. 1985) (no likelihood of confusion between software for energy conservation [FASER] and hardware buffers [MICROFAZER]); *Information Resources v. X*Press Info. Svs.*, 6 U.S.P.Q.2d 1034 (T.T.A.B. 1988) (no likelihood of confusion between news service transmitted through cable television to a personal computer [X*PRESS] and specialized information analysis computer programs [EXPRESS]); *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460 (T.T.A.B. 1992) (no likelihood of confusion between general data processing services [EDS] and computer

[1]The virtually identical situation exists in the present case. Access to Applicant's services requires registration and a password, whereas the goods sold under Reg. No. 1,625,682 are not restricted to any particular individual or group.

assisted design for electrical power systems [EDSA]) and *Aries Sys. Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926 (T.T.A.B. 1992) (no likelihood of confusion between computer programs for encyclopedic information [INFORMATION FINDER] and computer programs for retrieval in specialized medical databases and sold to physicians [KNOWLEDGE FINDER]).

AMENDMENT OF RECITATION OF SERVICES

Applicant amends its recitation of services as follows:

"computer services for others, namely, the design and implementation of software for synthesizing and/or displaying air carrier operational data" in International Class 42.

CONCLUSION

Based on the above, Applicant has responded to all outstanding issues relating to the above-referenced application. Applicant respectfully requests that the mark **ONTIME:DISPATCH** be allowed to proceed to registration.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: 9/10/01

By: _____

Richard E. Kurtz, Jr., Esq.
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