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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intek Technologies, Inc.

Serial No. 74/621,349

Jason A. Bernstein of Bernstien & Associates for Intek
Technologies, Inc.

John Dalier, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney)

Before Sams, Simms and Hanak, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Intek Technologies, Inc. (applicant), a Georgia corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark VIVID for "computer software, and instruction manuals, sold together as a unit, for use as tools in designing client server applications."¹ The Examining Attorney has refused

¹ Application Serial Number 74/621,349, filed January 17, 1995, based upon applicant's bona fide intention to use the mark in commerce. On March 25, 1996, applicant filed an amendment to allege use asserting use in commerce since April 20, 1995.

registration under Section 2(d) of the Act, 15 USC Section 1052(d), on the basis of Registration Number 1,686,103, issued May 12, 1992, for the mark VIVID for "computer programs and instruction manuals sold as a unit used in the production and manipulation of graphic displays." Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.²

It is the Examining Attorney's position that confusion is likely because of the identity of the respective marks and because of the similarity of registrant's computer programs and applicant's computer software. More particularly, the Examining Attorney argues that the description of goods in the cited registration encompasses computer programs used by both ordinary consumers or end-users and by programmers alike. The Examining Attorney argues that it is common for computer software manufacturers to produce different software products and sell such software for use by both ordinary consumers and by programmers. In support of this argument the Examining Attorney has submitted a number of third-party registrations showing that the same entity has registered a mark for both

² We sustain the Examining Attorney's objection to the new matter (a brochure) submitted for the first time with applicant's brief. However, our decision on the merits would be no different if we had considered it.

software for use by ordinary consumers and for use by programmers.³

Applicant, on the other hand, maintains that its goods are not directed to the average personal computer user but rather that its software is an application development product designed to increase productivity of application developers who are designing client/server projects. Further, applicant contends that graphic display software manufacturers are not likely to expand into client/server areas because these products are not "natural neighbors" and that only rarely does such a company, such as Microsoft, realize such an expansion.

The Applicant's goods are software and instruction manuals, sold together as a unit, for use as tools in designing client server applications. The software functions as a manufacturing tool for the makers of client server software. Specifically, the application enables programmers to program network servers to run a system of individual PC's. It is a highly technical area which does not primarily involve the creation of graphical user interfaces or graphical displays. Applicant's [sic] market their product through a catalog titled "Programmer's Paradise," and through direct marketing efforts by placing advertisements in computer trade magazines such as "Byte" and "Client Server Journal." These computer trade journals and catalogs are targeted primarily to those that program software and develop applications as opposed to those that are simply end users of applications.

³ Among these, the Examining Attorney notes the following registered marks in his appeal brief: INTELLICORP for "computer program instruction and documentation software manuals for software users and programmers"; AXIANT for "computer programs used for assisting professional programmers and end-users"; and GW-BASIC for "computer programs prerecorded on tapes, disks, diskettes, cartridges and cassettes; and computer programs and programmer's references and user's guide manuals sold as a unit."

The registrant's goods, which comprise software for the production and manipulation of graphic displays, would appear to pertain to software to be used in the area of graphic arts including possibly creating such graphic displays as banners, posters, kiosks, and the use of graphic images to produce these items. The users of these goods are unlikely to be programming in the client server environment.

Applicant's Amendment and Remarks, filed December 11, 1995, p. 2.

In arguing that its goods are targeted to programmers and technical people that develop applications, applicant's attorney contends that its customers are sophisticated and discriminating. Applicant's attorney also points out in his brief that there have been no instances of actual confusion since applicant's first use.

As both attorneys acknowledge, in an appeal the issue of likelihood of confusion between two marks must be determined on the basis of the goods as they are identified in the application and the cited registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ 1813 (Fed. Cir. 1987). In this regard, assuming that applicant's computer software and instruction manuals are sold to programmers or others involved in developing applications, as the Examining Attorney has pointed out the description of goods in the cited registration--computer programs and instructions manuals sold as a unit in the production and manipulation of graphic displays--is not

limited with respect to potential purchasers or channels of trade. In this regard, we see no reason why registrant's goods should not be construed to include computer programs sold to programmers as well as to end-users. In this regard, we note that the description in the registration indicates that those computer programs are used in the "production" of graphic displays. Suffice it to say that the language in the registration is broad enough to encompass software used as a tool by programmers or developers to produce or create graphic displays. Accordingly, and even acknowledging that computer programmers may be relatively sophisticated purchasers and users, we believe that such persons, aware of registrant's VIVID computer programs used in the production and manipulation of graphic displays, who then encounter applicant's computer software for designing client server applications sold under the identical mark, are likely to believe that the goods come from the same source.

Decision: The refusal of registration is affirmed.

J. D. Sams

R. L. Simms

E. W. Hanak
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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