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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Image Sciences, Inc.

Serial No. 74/676,406

Harold E. Meier of Gardere & Wynne, L.L.P. for Image
Sciences, Inc.

Angela Lykos, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney)

Before Sams, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Image Sciences, Inc. has appealed the refusal of the
Trademark Examining Attorney to register DOCUWORKS as a
trademark for "computer software utility programs for
document creation, production and manufacture; namely, file
transfer identification, conversion from one font to another
and graphic enablers."¹ Registration has been refused
pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Application Serial No. 74.676,406, filed May 18, 1995, based
on an asserted bona fide intention to use the mark in commerce.

1052(d), on the ground that applicant's mark so resembles the mark DOCWORX, previously registered for "computer software in the application of document management and document image processing, and computer hardware and peripherals in a networked communication environment, including laser printers, image scanners, computer processing units, optical disc juke boxes, monitors and related instruction manuals sold as a unit,"² that, if applicant were to use its mark on its identified goods, it is likely to cause confusion or mistake or to deceive.

The case has been fully briefed, and applicant and the Examining Attorney represented their positions at an oral hearing.

We affirm the refusal of registration.

In any determination of likelihood of confusion, two key factors are the marks and the goods. Turning first to the goods, the cited registration includes "computer software in the application of document management and document image processing." Applicant's goods are "computer software utility programs for document creation, production and manufacture, namely file transfer, identification, conversion from one font to another and graphic enablers."

The Examining Attorney takes the position that applicant's goods, as identified, would be encompassed

within the computer software identified in the cited registration. In its appeal brief applicant, although it recognized that, to the extent they are applicable, the factors enumerated in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) must be considered, never discussed the factor of the similarity or dissimilarity of the goods. In its reply brief, applicant has merely stated that applicant's software is distinguishable from the registrant's software and hardware, without any discussion of how or why.

We agree with the Examining Attorney that applicant's computer software would be encompassed within the identification of the registrant's computer software. Applicant has specified that its software programs are used for file transfer and identification; these operations fall under the general category of document management, which is the subject of the registrant's identified computer software.

Applicant has pointed out that "there is no per se rule mandating that likelihood of confusion is to be found in all cases where the goods or services in question involve computer software," or that confusion must be found "in all cases involving any and all items of computer hardware and any and all types of computer software sold under similar

² Registration No. 1,824,212, issued March 1, 1994.

marks." Reply brief, p. 3. We agree with applicant on these points, but here we find that applicant's and registrant's software are in part identical because both, as identified, cover document management, i.e., file transfer and identification.

This brings us to a consideration of the marks. DOCUWORKS and DOCWORX are extremely similar in appearance, pronunciation, connotation and commercial impression. Obviously, there are some differences, in that applicant's mark includes the letter "U" and the cited mark uses WORX instead of WORKS. However, we do not think that these differences are sufficient to distinguish the marks and avoid confusion if they were used on legally identical software. In particular, we are not persuaded by applicant's argument that the "U" in its mark is distinctive. "DOC" is the first three letters, and "DOCU" is the first four letters of the word "document": thus, in both marks these initial portions, for software dealing with document identification and transfer, or document management, suggest the same thing. Consumers are not likely to note or remember that one mark begins with "DOCU" while the other begins with "DOC." As for the remainder of the marks, although "WORKS" is spelled with a conventional spelling in applicant's mark, and is spelled as the phonetic equivalent "WORX" in the registered mark, again, consumers

are not likely to note or remember this slight difference. Under actual marketing conditions consumers do not necessarily have the opportunity to make side-by-side comparisons, and instead they must rely on hazy past recollections. See **Dassler KG v. Roller Derby Skate Corp.**, 206 USPQ 255 (TTAB 1980).

At the oral hearing applicant argued that because "worx" is not an actual word, it has no recognized meaning and no recognized pronunciation. We are not persuaded by this argument. Although we acknowledge that "worx" is not a word, consumers will view "worx" as the phonetic and connotative equivalent of "works." In this connection, we would point out that the pronunciation of the letter "X" is "eks."³

Applicant has also asserted that "DOC" is a highly suggestive and commonly used prefix for marks because applicant's "computer search of trademark records discloses in excess of 1,179 registered marks beginning with the prefix 'DOC'." Brief, p. 5. As the Examining Attorney noted, applicant has failed to make any of these purported third-party registrations of record. Therefore, we have no way of knowing what goods or services are shown in the registrations, or what commercial impression the "DOC"

³ The Random House Dictionary of the English Language, 2d ed., unabridged, © 1987.

portion may convey because we do not know the rest of the marks. Having said this, we acknowledge that "doc" has a suggestive significance with respect to both applicant's and the registrant's software, but that significance is the same in both marks. Further, our finding that the marks are similar is not based on merely the fact that they both begin with "DOC," but on the similar commercial impressions of the marks in their entireties.

Finally, applicant asserts that the purchasers of applicant's goods are sophisticated and that they would exercise care in making their purchasing decisions. Applicant has not provided any information about the kinds of people who would purchase its product, nor the cost of such software and, as its goods are identified, applicant's software could be used by anyone with a computer and a need for document management. Such users are not necessarily sophisticated purchasers. Moreover, even if we were to assume that applicant's and the registrant's identified software programs were bought by sophisticated purchasers, given the legal identity of the goods, and the close similarity of the marks, the likelihood is that consumers will not notice the minor differences between the marks, or, if they do notice these differences, will assume that the marks are minor variations of each other, indicating origin of the products in a single source.

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Decision: The refusal of registration is affirmed.

J. D. Sams

E. J. Seeherman

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board