

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

SEPT. 30,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Starfish Software, Inc.
v.
FileTrak Software, Inc.

Opposition No. 105,884
to application Serial No. 75/014,889
filed on November 6, 1995

Martin R. Greenstein of Techmark for Starfish Software, Inc.
FileTrak Software, Inc., pro se.

Before Quinn, Walters and Bottorff, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant FileTrak Software, Inc. has applied to register the mark FILEKICK on the Principal Register for goods identified as "computer software for file management."¹ Opposer Starfish Software, Inc. has opposed registration on the ground that applicant's mark, as applied

¹ Serial No. 75/014,889, filed November 6, 1995, based on use in commerce. January 21, 1992 is alleged as the date of first use of the mark anywhere, and November 4, 1995 is alleged as the date of first use in commerce.

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to applicant's goods, so resembles opposer's registered mark SIDEKICK,² previously used by opposer in connection with various computer software products, as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).³ Applicant has denied the allegations of the notice of opposition which are essential to opposer's claim. Opposer and applicant filed

² Opposer has pleaded ownership of two Principal Register registrations:

Registration No. 1,334,110, of the mark SIDEKICK for "computer programs"; issued May 7, 1985, Section 8 and 15 affidavit accepted.

Registration No. 2,110,295, of the mark SIDEKICK for "computer software, namely, personal information managers; electronic organizers; desktop organizers; finance and accounting; file transfer; file conversion; databases; database searching and reporting; cardfiles; contact managers; voice data and wireless communication software, namely, e-mail, voice mail, voice messaging, and telephone and facsimile software; word processing; fax processing; database access; data retrieval and processing; remote access; alarms and reminders; multimedia applications software; text and program editing; calendars; time management; schedulers; appointment calendars; notepads and note taking; outlining; windowing; printing and forms management; software for use in the transfer of data by modem; calculators; address books; reference works and information guides; user interface software for accessing and browsing wide area networks; mail merge utilities; import and export utilities; data backup and restore utilities; telephone dialers and directories; and instructional manuals sold as a unit therewith." Issued November 4, 1997.

³ In the notice of opposition, opposer alleged additional grounds of opposition, i.e., that applicant's declaration in the application of ownership of the mark was made in bad faith, and that applicant had not used the mark prior to the application filing date. Applicant denied those allegations in its answer. Opposer has presented no evidence in support of these claims, nor has opposer mentioned these claims in its brief. In view of opposer's failure to prove these additional pleaded claims, they are dismissed with prejudice.

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main briefs on the case, and opposer filed a reply brief. No oral hearing was requested.

The evidence of record in this case consists of the file of applicant's application; the pleadings; and the following materials submitted by opposer under notice of reliance: status and title copies of opposer's pleaded registrations which show that the registrations are in effect and are owned by opposer; excerpts from two computer dictionaries; a copy of an advertisement for opposer's "Sidekick Plus" product, asserted to be from the May 16, 1988 issue of Info World magazine; a printout of a product review of opposer's "Sidekick 95 Deluxe" product from the April 23, 1996 issue of PC Magazine Online; and a printout from ZDNet of an undated product review of opposer's "Sidekick 95" product. Applicant has raised no substantive or procedural objections to consideration of any of opposer's evidence.

Opposer's notice of reliance also includes a printout, from what appears to be opposer's web page, of advertising for opposer's "Sidekick 97" product. This printout is not a "printed publication" which may be introduced by means of notice of reliance. *Cf. Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). However, inasmuch as this printout also was submitted by applicant with its answer to the notice of opposition and with its brief on the case, see

infra, we deem the parties to have stipulated to the introduction of the printout, and accordingly shall consider it.

Applicant submitted no testimony or other evidence during its assigned testimony period. However, applicant had attached numerous exhibits to its answer to the notice of opposition.⁴ Those exhibits were also attached to applicant's brief on the case, along with one additional exhibit consisting of a February 9, 1999 printout of opposer's web page. Opposer has objected to and moved to strike the evidence attached to applicant's answer and brief, on the grounds that the exhibits were not timely submitted and have not been properly made of record. We agree. Accordingly, we grant opposer's motion to strike, and have given no consideration to the exhibits attached to applicant's answer and brief. See TBMP §705.

However, two of the exhibits to applicant's answer and brief also were submitted as evidence by opposer under notice of reliance, i.e., the printout of a product review of opposer's "Sidekick 95 Deluxe" product from the April 23,

⁴ Those exhibits are identified in applicant's answer's "List of Exhibits" as: "Opposer's Sidekick 97 program description"; "PIM PC Magazine review"; "Applicant's program description"; "Applicant's program listing in SoftSeek Web page"; "Applicant's program listing in C/Net download.com"; "PC Magazine's File Utilities Finalists"; "Applicant's Installation program screen"; "Applicant's press release"; "Opposer's mission statement"; "Opposer's on-line product catalog"; and "DropKick program description."

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1996 issue of PC Magazine Online, and the printout, from what appears to be opposer's web page, of advertising for opposer's "Sidekick 97" product. In view thereof, we deem the parties to have stipulated to the introduction of these materials, and have considered them as evidence of record.

Priority is not at issue in this case, in view of opposer's submission of status and title copies of its pleaded registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The parties' respective goods are legally identical, for purposes of our likelihood of confusion determination. Applicant's goods are "computer software for file management." Applicant's goods are encompassed by the goods identified in opposer's Registration No. 1,334,110, i.e., "computer programs," and they appear to be sufficiently

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related to certain of the goods identified in opposer's Registration No. 2,110,295, e.g., to "computer software" for "file transfer," "file conversion," "database searching and reporting," "data retrieval and processing," and "data backup and restore utilities," that confusion would be likely to result if the products were to be marketed under confusingly similar marks.

Applicant has argued, and it appears from the record, that opposer's actual SIDEKICK product is a "personal information manager" (PIM). On its web page (Item 6 above), opposer advertises its product as "The Best Way to Manage Calendars, Contacts, and Communications," and states that "Sidekick 97 is the #1 best-selling organizer of all time! With full-featured calendars, flexible contact files, and powerful communications capabilities, you'll be able to manage all your activities with ease." Applicant argues that personal information managers such as opposer's are not the same as or related to file management software such as applicant's. However, even if that were true, our likelihood of confusion determination must be made on the basis of the goods as set forth in opposer's registrations, rather than on the basis of what the record might show to be the actual goods upon which opposer uses the mark. See *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re*

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Trackmobile Inc., 15 USPQ2d 1152 (TTAB 1990). As discussed above, applicant's goods are legally identical and/or closely related to the opposer's goods as identified in opposer's registrations.

However, we find that the parties' respective marks, when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression, are so dissimilar that confusion is not likely to result from the parties' contemporaneous use of their marks on their respective goods. This is so, notwithstanding the legal identity and/or relatedness of the parties' respective goods. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Opposer's mark SIDEKICK is comprised of a well-understood and commonly-used word, i.e., "sidekick." We take judicial notice that Webster's Ninth New Collegiate Dictionary (1990), at page 1094, defines "sidekick" as "a person closely associated with another as subordinate or partner." The commercial impression created by opposer's mark is consistent with the normal meaning and connotation of the word "sidekick," and would be immediately understood as such. The April 23, 1996 product review from PC Magazine Online, made of record by opposer under notice of reliance, further corroborates our conclusion regarding the connotation of and commercial impression created by

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opposer's mark. The author states: "Just as every movie hero relies on a trusty sidekick, Starfish Software's \$79.95 Sidekick 95 Deluxe stands ready to serve . . .," and ". . . if you're looking for an information manager without remote access but with flexibility, good looks, and great features, Sidekick is the digital Tonto for you Lone Rangers."

Applicant's mark FILEKICK, unlike opposer's mark SIDEKICK, appears to be a coined term rather than a recognizable common word. The marks are visually and aurally dissimilar, and they have different connotations. The connotation of applicant's mark, as applied to applicant's file management software, is not immediately apparent, but it certainly does not have the same connotation as opposer's mark SIDEKICK. These differences between the marks in terms of sight, sound and meaning suffice to make the marks dissimilar in terms of their overall commercial impression.

Opposer argues that applicant's mark and opposer's mark both include the word KICK; that there is no evidence of any use by third parties of marks which include the word KICK on the relevant goods; and that purchasers may erroneously conclude that FILEKICK and SIDEKICK are part of a family of "KICK" marks for computer software products and/or that the products sold under "KICK" marks originate from a single source. However, opposer's mark is comprised of the unitary

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word SIDEKICK, and opposer's trademark rights are in that unitary word, not necessarily in the components SIDE and/or KICK. We find that opposer's rights in its mark do not extend so far as to preclude applicant from registering the otherwise completely dissimilar mark FILEKICK. We find opposer's contentions regarding the possibility that purchasers will assume the existence of a family of "KICK" marks to be purely speculative and theoretical. "[W]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969).

In short, having considered and balanced the evidence of record pertaining to the relevant *du Pont* factors, we

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conclude that there is no likelihood of confusion in this case.

Decision: The opposition is dismissed.

T. J. Quinn

C. E. Walters

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board