

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

FEB. 22, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Arbor Software Corporation

v.

Zellweger Information Systems, Inc., and ArborWay Electronic  
Publishing, Inc., joined as party defendant

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Opposition No. 98,713  
to application Serial No. 74/564,796  
filed on August 23, 1994

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Noemi C. Espinosa of Brobeck, Phleger & Harrison for Arbor  
Software Corporation.

Zellweger Information Systems, Inc. and ArborWay Electronic  
Publishing, Inc., joined as party defendants, pro se.

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Before Seeherman, Quinn and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Zellweger Information Systems, Inc.<sup>1</sup> filed an  
application to register the mark ARBORWAY for "computer

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<sup>1</sup> Applicant submitted a photocopy of an assignment of the  
application from applicant to ArborWay Electronic Publishing,  
Inc., and based thereon the Board, by order dated July 8, 1996,  
joined the assignee as a party defendant. The assignment is not  
of record with the Assignment Branch of this Office.

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software used to create and distribute stand-alone information management systems."<sup>2</sup>

As grounds for opposition, opposer alleges that since April 12, 1991 it has continuously used the common law trademarks and trade names ARBOR and ARBOR SOFTWARE; that opposer has filed applications to register the marks ARBOR for "computer software for use in business database and spreadsheet applications, namely financial consolidation and reporting, product line analysis, sales analysis, performance and variance reporting, planning and budgeting and enterprise information systems,"<sup>3</sup> and ARBOR SOFTWARE for "computer software for use in database and spreadsheet applications and instruction and user manuals sold in connection therewith"<sup>4</sup>; and that applicant's mark, when used on the goods, so resembles opposer's previously used marks, as to be likely to cause confusion, mistake, or deception.

In the answer filed by Zellweger Information Systems, Inc., pro se, applicant admitted the first seven paragraphs of the notice of opposition. These paragraphs included the

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<sup>2</sup> Application Serial No. 74/564,796, filed August 23, 1994, asserting claimed dates of first use and first use in commerce of September 1, 1993 and June 8, 1994, respectively.

<sup>3</sup> Application Serial No. 74/493,732, filed February 23, 1994, with claimed dates of first use and first use in commerce of April 12, 1991. This application issued as Registration No. 1,967,662 on April 16, 1996.

<sup>4</sup> Application Serial No. 74/613,103, filed December 20, 1994, based on intent-to-use. The term "software" is disclaimed. The application currently stands abandoned for failure to respond to an Office action, but applicant has filed a petition to revive which remains pending.

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allegations, and therefore applicant admitted, that opposer is using and has used the common law trademarks and trade names ARBOR and ARBOR SOFTWARE since April 12, 1991 for the goods described in opposer's applications; that opposer filed the applications set forth in the notice of opposition; that opposer's business is substantial and nationwide; that there is no issue as to priority in view of opposer's prior use of the marks ARBOR and ARBOR SOFTWARE; and that opposer has created a valuable reputation and goodwill in its marks, and the marks have become associated in the minds of the relevant purchasing public with opposer. Applicant denied opposer's allegations of similarity of trade channels, likelihood of confusion and damage.

In order to clearly set forth what the record consists of in this case, the following discussion is offered.

During its testimony period opposer submitted two notices of reliance. First, opposer submitted a notice of reliance on its Registration No. 1,967,662 for the mark ARBOR, along with a photocopy of its registration. However, Trademark Rule 2.122(d)(2) requires that the copy must be a current status and current title copy of the registration prepared by the Patent and Trademark Office. A mere photocopy is not sufficient. See *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir.), and TBMP §703.02(a).

Opposer also submitted a notice of reliance on "Applicant's Response To First Set of Interrogatories and Applicant's Production of Documents (including document [sic -interrogatory?] responses 1-14 and the corresponding documents)." However, Trademark Rule 2.120(j)(3)(i) requires that a copy of the involved interrogatories as well as the answers thereto be submitted with the notice of reliance during the offering party's testimony period. Opposer did not attach to the notice of reliance copies of either its interrogatories or applicant's answers thereto<sup>5</sup>.

With regard to any documents produced by applicant and on which opposer intended to rely, generally a party which has obtained documents from another party under Fed. R. Civ. P. 34 may not make the documents of record by way of notice of reliance alone, except to the extent they are admissible under Trademark Rule 2.122(e). In any event, there were no documents attached to this notice of reliance.

During its testimony period applicant offered the affidavit testimony of Paul Zellweger, referring to opposer's consent thereto<sup>6</sup>. (The corporate office held by

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<sup>5</sup> Opposer attached a copy of "Applicant's Response To First Set Of Interrogatories" as an exhibit to opposer's brief on the case. These answers are also inadmissible because submission thereof with the brief is untimely, and because opposer did not provide a copy of the interrogatories to which the answers relate. (In addition, we note that the notice of reliance referred to only Nos. 1-14.)

<sup>6</sup> For future information, it should be noted that Trademark Rule 2.123(b) was amended, effective October 9, 1998, to require that

the affiant in the defendant corporations was not set forth in the affidavit. However, the record shows that Paul Zellweger is the president of Zellweger Information Systems, Inc.)

Applicant also submitted a notice of reliance on a trademark search report prepared by the private search firm of Thomson & Thomson. Such a search report does not constitute a printed publication or an official record within the meaning of Trademark Rule 2.122(e).<sup>7</sup> See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), and TBMP §707.

In view of the above recitation of the specific evidence submitted by the parties herein and the explanation of the evidence excluded from consideration due to failure to comply with the Trademark Rules of Practice<sup>8</sup>, the record before the Board consists of the pleadings, the file of applicant's opposed application<sup>9</sup>, opposer's applications as admitted by applicant in its answer, and the affidavit testimony of Paul Zellweger, applicant's president.

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stipulations to submit testimony by affidavit be in writing. See the Official Gazette of September 29, 1998.

<sup>7</sup> In order to make third-party registrations of record, the offering party may file photocopies of the registrations along with a timely notice of reliance. See *Weyerhaeuser*, supra.

<sup>8</sup> Even if we had considered all the excluded evidence submitted by both parties, we would reach the same conclusion in this case.

<sup>9</sup> See Trademark Rule 2.122(b)(1).

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The parties briefed the case. No oral hearing was requested.

With regard to the question of priority, applicant has acknowledged that the mark ARBOR is registered to opposer in Registration No. 1,967,662 (Zellweger affidavit, paragraph 7); and applicant treated opposer's registration as of record in its brief (p. 2). Thus, although opposer did not submit a proper status and title copy of the registration, it is of record as admitted by applicant through its testimony and brief. Because opposer owns a valid and subsisting registration of its mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, applicant admitted opposer's priority of use of the marks ARBOR and ARBOR SOFTWARE<sup>10</sup> in its answer to the notice of opposition.

We turn to the question of likelihood of confusion, which we determine under the criteria set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In considering the parties' respective goods, the only evidence of record on this question is the following: the

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<sup>10</sup> Opposer's application for the mark ARBOR SOFTWARE (Serial No. 74/613,103) was filed based on a bona fide intent to use the mark in commerce. However, opposer asserted use of both marks since April 12, 1991 in its notice of opposition, and applicant admitted these facts in its answer.

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goods as listed in opposer's registration for the mark ARBOR, the goods as set forth in the notice of opposition by opposer for its common law mark ARBOR SOFTWARE (the use of which applicant admitted in its answer), the goods as listed in applicant's application, and the affidavit testimony of Paul Zellweger relating to the goods of the parties.

Applicant has submitted testimony and argued in its brief that the goods of the parties, although both are computer software, are unrelated. Specifically, in his affidavit Mr. Zellweger testified, inter alia, that there "are significant functional differences between these two software products" (paragraph 5); that applicant's goods "are used to produce electronic documents previously known as stand-alone information systems", and opposer's goods "are used for data warehousing" (paragraph 5); that the two products could not be substituted for each other; that purchasers of computer software are "sophisticated and well educated" (affidavit, paragraph 3); that applicant advertises and markets its software "as a means to electronic publishing," whereas opposer markets and sells its goods "within the field of data warehousing" (paragraph 6); and that prospective purchasers would not confuse the source of the parties' goods "because the Opposer is not known as a product supplier in electronic publishing" (paragraph 6).

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In determining the question of likelihood of confusion, the Board is constrained to compare the goods as identified in applicant's application with the goods as identified in opposer's registration. If the opposer's goods and the applicant's goods are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual goods of the applicant and opposer are not similar. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985).

Also, regarding the goods, it is well settled that they need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Of course, there is no per se

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rule relating to likelihood of confusion in the computer field. See *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985).

Applicant's goods are identified as "computer software used to create and distribute stand-alone information management systems." With respect to opposer's registered mark, ARBOR, the goods are identified as "computer software for use in business database and spreadsheet applications, namely financial consolidation and reporting, product line analysis, sales analysis, performance and variance reporting, planning and budgeting and enterprise information systems." With respect to opposer's common law mark, ARBOR SOFTWARE, opposer stated in the notice of opposition, and applicant admitted in its answer, that its goods are "computer software for use in database and spreadsheet applications and instruction and user manuals sold in connection therewith."

We take judicial notice of the definitions of the following terms from the Microsoft Press Computer Dictionary (1997): (1) "stand alone" is defined as "of, pertaining to, or being a device that does not require support from another device or system, for example, a computer that is not connected to a network"; (2) "information management" is defined as "the process of defining, evaluating, safeguarding, and distributing data within an organization or a system"; and (3) "system" is defined as "any collection

of component elements that work together to perform a task. Examples are a hardware system consisting of a microprocessor, its allied chips and circuitry, input and output devices, and peripheral devices; an operating system consisting of programs and data files; or a database management system used to process specific kinds of information."<sup>11</sup>

Given the broad dictionary definitions of "information management" (a broadly defined computer term involving the whole process of collecting, evaluating, distributing, and providing security for data) and "system" (any collection of component elements working collectively to perform a task), and applicant's non-specific, broad language in its identification of goods, it appears that the parties' goods overlap, or are otherwise related. Stated another way, applicant's goods could include a stand-alone information management system which handles such matters as financial data, analysis, budgeting and reporting. Therefore, applicant's goods, as set forth in its involved application, encompass those set forth in opposer's registration. Likewise, opposer's goods, as identified in the pleaded registration, are computer software for use in business applications, and applicant's software used to create or

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<sup>11</sup> The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), and TBMP §712.01.

distribute stand-alone information management systems could include information management relating to business applications. That is, the involved computer software, as identified, could be used by the same business entities for related purposes.

Applicant's argument that the parties' respective goods serve different specialized functions and are sold to sophisticated purchasers through separate channels of trade is not persuasive because there are no limitations in either applicant's identification of goods or opposer's registered identification of goods as to purchasers or channels of trade.<sup>12</sup> See Peopleware Systems, supra.

We find that the applicant's goods and opposer's registered goods *as identified* are closely related computer software which can be used, at least in part, to create information systems.

Looking to applicant's goods vis-a-vis opposer's goods under its common law trademark ARBOR SOFTWARE, these are also related or overlapping computer software products. Even though the goods sold under opposer's common law trademark do not include a listing of specific business

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<sup>12</sup> Applicant's affidavit testimony (as well as the arguments in its brief) appears to be directed to showing that the purchasing public can distinguish between these goods. However, the question is not whether the purchasing public is likely to confuse the goods, but whether they are likely to confuse the source of the goods. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

applications, nonetheless, applicant's identification of goods is not restricted and, as worded, it could encompass the goods for which applicant has admitted opposer uses the mark ARBOR SOFTWARE ("computer software for use in database and spreadsheet applications and instruction and user manuals sold in connection therewith"). Again, with respect to applicant's argument that these respective goods are specialized, there is no restriction in applicant's identification of goods so limiting the goods, the trade channels or the purchasers.

Turning then to a consideration of the marks, opposer's marks ARBOR and ARBOR SOFTWARE, and applicant's mark ARBORWAY all include the word ARBOR, which is an arbitrary term in relation to computer software.<sup>13</sup>

Marks must be considered in their entirety; but in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *In re National Data*

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<sup>13</sup> The American Heritage Dictionary defines "arbor" as "1. a shady, garden center or bower, often made of rustic work or lattice-work on which vines, roses, or the like are grown. 2. obsolete. an orchard or garden."; and in the second definition "1. an axis or shaft supporting a rotating part of a lathe. 2. a bar for supporting cutting tools. 3. a spindle of a wheel, as in watches and clock. 4. archaic. a tree."

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Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case the word ARBOR is opposer's entire registered mark; and is the dominant portion of opposer's common law mark, ARBOR SOFTWARE, which obviously includes the generic word "software"; and is the first component of applicant's mark ARBORWAY. Thus, the common significant element in the parties' marks is the same arbitrary and memorable word, ARBOR.

The marks are similar in sound, appearance and connotation. Purchasers may assume that ARBORWAY is just a variant of opposer's ARBOR and ARBOR SOFTWARE marks, used to identify another of opposer's software products, and would assume that applicant's goods come from the same source as opposer's goods.

In his affidavit testimony Paul Zellweger referred to the following third-party registrations: (1) ARBOR for a computer software billing system (Registration No. 1,944,396); (2) ARBOR PHOTO SYSTEM in International Class 9 (Registration No. 1,970,987); (3) ARBORWARE in International Class 9 (Registration No. 1,914,662); and (4) THUIA (which translates as 'Arbor Vitae which is a type of tree') in International Class 9 (Registration No. 1,630,651).

We are not persuaded that we should reach a different outcome as a result of these third-party registrations. First, we note that for three of the registrations,

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applicant has not supplied any information as to the goods<sup>14</sup>, only that they are in Class 9, so they have virtually no probative value in terms of indicating that ARBOR has a suggestive significance for particular goods. The mark, THUIA, which refers to ARBOR VITAE, is clearly different in commercial impression from the opposer's and applicant's marks. As for ARBOR for a computer software billing system, the evidence of this single third-party registration is wholly inadequate to show that opposer's marks ARBOR and ARBOR SOFTWARE for opposer's goods is weak.

Decision: The opposition is sustained, and registration to applicant is refused.

E. J. Seeherman

T. J. Quinn

B. A. Chapman  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

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<sup>14</sup> The Board does not take judicial notice of registrations. See *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978).