

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB FEB. 11, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Management Information Technology Incorporated**

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Serial No. 75/185,582

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**Rochelle D. Alpert and Lynn M. Humphreys** of **Morrison & Foerster LLP** for **Management Information Technology Incorporated**.

**Kathleen M. Vanston**, Trademark Examining Attorney, Law Office 103  
(**Michael Szoke**, Managing Attorney).

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Before **Cissel, Seeherman** and **Hohein**, Administrative Trademark  
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

**Management Information Technology Incorporated** has  
filed an application to register the mark "SQRIBE" for "computer  
software featuring information retrieval and dissemination tools  
for relational database management and accompanying manuals sold  
as a unit."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/185,582, filed on October 22, 1996, based upon an  
allegation of a bona fide intention to use the mark in commerce.  
Although applicant, claiming to have changed its name to SQRIBE  
Technologies Corp., subsequently submitted an amendment to allege use  
which asserts dates of first use of January 17, 1997, it is suggested,

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "SCRIBE," which is registered, by the same registrant, for "computer programs in the form of printed listing, punched cards and magnetic tape"<sup>2</sup> and "computer programming manuals,"<sup>3</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed,<sup>4</sup> but an oral hearing was not requested. We affirm the refusal to register.

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in the event that applicant ultimately prevails, that a certificate of change of corporate name, amendment of its articles of incorporation or other appropriate change of name documentation be recorded against the application in the Assignment Division records of the Patent and Trademark Office so that a registration resulting from the application may issue in applicant's new name. See TMEP §502.01.

<sup>2</sup> Reg. No. 1,029,685, issued on January 6, 1976, which sets forth dates of first use of March 30, 1973; first renewal.

<sup>3</sup> Reg. No. 987,402, issued on July 2, 1974, which sets forth dates of first use of March 30, 1973; first renewal.

<sup>4</sup> It is noted that applicant, with its initial brief, has included a listing of various third-party marks and their associated registration numbers. Although the Examining Attorney has not objected to such evidence on the grounds that it is untimely under Trademark Rule 2.142(d) and is otherwise not properly of record, neither has she treated the evidence as being of record by discussing it in her brief. Trademark Rule 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of an appeal" and that the Board "will ordinarily not consider additional evidence filed ... after the appeal is filed." Accordingly, we have not considered such evidence. Moreover, even if the listing had been timely filed, it is pointed out that in order to make information regarding third-party registrations properly of record, it is necessary to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. However, even if we were to consider the information set forth in applicant's brief, such evidence is basically without any probative value, for purposes of determining the issue of likelihood

Turning first to consideration of the respective goods, applicant concedes that "[t]he Examining Attorney correctly notes that the question of likelihood of confusion must be determined on the basis of the goods set forth in the applicant's application and those in the cited registration, rather than on what any evidence may show those goods to be." See, e.g., In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992). Applicant also properly notes that, as stated in Information Resources v. X\*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988), "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 and/or hardware." Applicant asserts that, in the present case, the identification of registrant's goods "contains an important limitation as to the **nature and type** of the programs" (**emphasis in original**) in that they are "in the form of printed listing, punched cards and magnetic tape." Applicant, since its "manuals are incidental to and have no value separate from the software" with which they are sold, focuses its argument that its goods are "sufficiently different to avoid a likelihood of confusion" on the asserted fact that it "offers its computer software on CD-ROM" and not in any other format.<sup>5</sup>

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of confusion, in the absence of any indication as to the goods and/or services with which the third-party marks are registered.

<sup>5</sup> Although applicant also contends, as supported by the declaration from its Chief Executive Officer, that it "began using its SQRIBE mark at least as early as January 1997, and, since that time, it has not learned of a single instance of [actual] confusion," the purported lack of any incidents of actual confusion is essentially meaningless given the absence of any additional evidence demonstrating extensive

It is well settled, as noted above, that the issue of likelihood of confusion must be determined in light of the goods set forth in the involved application and cited registration and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, as the Examining Attorney accurately observes, any differences in the format or media in which applicant's and registrant's computer software is sold are legally irrelevant to the issue of likelihood of confusion inasmuch as the identification of applicant's goods contains no restrictions as to CD-ROMs and thus must be assumed to include, like registrant's goods, such versions as printed listings, punched cards and, most significantly, with respect to modern programming applications, magnetic tapes.

Similarly, the Examining Attorney is also correct that, in legal contemplation, registrant's computer programs must be considered to encompass applicant's computer software since, in the absence of any stated subject matter limitations, the identification of registrant's goods includes computer programs

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sales and promotional activities by applicant in the same areas as registrant sells and advertises its products. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) and cases cited therein. Consequently, it is simply ludicrous for applicant to assert that "[t]here has been ample opportunity for actual confusion to occur, if it is going to occur at all."

featuring information retrieval and dissemination tools for relational database management. Thus, for purposes of determining likelihood of confusion herein, registrant's goods must be regarded as being identical in part to applicant's goods and no meaningful distinction may be drawn as to the format or media in which they are sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1990); and In re Linkvest S.A., supra. Obviously, if identical software products were to be marketed under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, then, to consideration of the respective marks, our principal reviewing court has noted as a general proposition that, "[w]hen marks would appear on virtually identical goods . . . , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Applicant, however, asserts among other things that its mark and registrant's mark are distinguishable because applicant's "SQRIBE mark was derived from the name of its flagship product, the SQR® Server, an industrial-strength computer software engine for extracting, transforming and distributing data throughout an organization" which, according to

the declaration of applicant's chief executive officer, "is very well-known and well-respected in the industry."<sup>6</sup>

Applicant also urges that the respective marks differ sufficiently in their overall appearance, meaning and commercial impression so as to prevent any likelihood of confusion. In particular, applicant contends that:

Although the SQRIBE mark itself is fanciful, the letters "SQ" in ... the [mark] SQRIBE ... have significance within the information technology industry because they suggest a relationship to "SQL," a well-known acronym for "structured query language." SQL is a computer language that provides a user interface to relational database management systems. For more than a decade, SQL has been considered a standard in the industry. Appellant's products use the SQL language and extensions of this language in formulating structured queries for extracting information from relational databases. ....

The cited marks, by contrast, are based on an actual word, utilizing the traditional and accepted spelling of that word, and meaning "an official or public writer acting usu[ally] as a clerk or keeper of accounts." *Webster's Third New World International Dictionary* 2041 (3d ed. 1976). Unlike Appellant's fanciful SQRIBE mark, these marks do not suggest use of "structured

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<sup>6</sup> Applicant additionally maintains that its "SQRIBE mark is part of a family of marks, which includes the previously-mentioned SQR®, as well as INSQRIBE and TRANSQRIBE, both ... for 'computer software featuring information retrieval and dissemination tools for enterprise data management and accompanying manuals sold as a unit.'" Aside from the absence, however, of any persuasive evidence that applicant has in fact created such a family which is recognized by the purchasing public, see *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991), it is pointed out that the sole issue before us is whether the mark which applicant seeks to register so resembles registrant's mark that, when used in connection with the respective goods, confusion is likely. Consequently, even if applicant were to demonstrate that it has established a family of marks characterized by the terminology "SQR" and/or "SQRIBE," it would not aid or otherwise entitle applicant to the registration which it seeks. See, *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052 (TTAB 1992); and *In re Lar Mor Int'l, Inc.*, 221 USPQ 180, 183 (TTAB 1983).

queries," nor do they connote any special meaning within the information technology industry. Thus, Appellant's marks [sic] and the [mark in the] cited registrations differ significantly in sight, meaning, and very importantly, in the commercial impression they convey.

In addition, while apparently conceding that its mark and registrant's mark are highly similar in sound, applicant insists that such "[p]honetic similarity is inconsequential". This is because, according to applicant, its goods "are not advertised on television or radio, and prospective purchasers are likely to encounter the marks visually rather than orally.

We agree with the Examining Attorney, however, that applicant's "SQRIBE" mark and registrant's "SCRIBE" mark "are essentially phonetic equivalents." Applicant's attempt to minimize such fact ignores the fact that, while it does not presently advertise its computer programs and associated manuals on television or radio, there would appear to be no reason why it could not do so in the future if conditions warrant. Moreover, there is nothing in the nature of its goods, as identified in the application, which would preclude its promoting its mark aurally as well as visually. Furthermore, even assuming that the initial letters "SQR" in applicant's "SQRIBE" mark would bring to mind, among those knowledgeable about applicant and the field of software engines, its "SQR" server, the fact remains that in terms of appearance the marks at issue herein, "SQRIBE" and "SCRIBE," are substantially identical. In view thereof, and inasmuch as applicant's mark, when pronounced, is susceptible to having the same connotation as registrant's mark, it is plain

that the marks at issue project essentially the same commercial impression. Contemporaneous use of the marks "SQRIBE" and "SCRIBE," in connection with legally identical computer programs and associated software manuals, would therefore be likely to cause confusion as to the origin or affiliation of such products.

Applicant counters, however, by arguing that the conditions of sale of its goods and the sophistication of the purchasers of such products preclude any likelihood of confusion. Specifically, as supported by the declaration from its chief executive officer, applicant maintains that:

Here, purchasers of Appellant's products typically are corporate information professionals, who have specialized knowledge regarding sophisticated computer software, databases, and information retrieval systems. Because information systems serve a very critical function in organizations, Appellant's products are typically purchased after an extended period of at least several weeks during which the customer works very closely with one of Appellant's sales representative[s] who assists the customer in determining which products in Appellant's line will best meet the needs of that customer's business. Appellant's products are carefully scrutinized by prospective purchasers, and any purchasing decisions are made only after careful consideration, testing and evaluation of Appellant's products. ....

Applicant likewise insists that, because registrant's goods are computer programs, "buyers of computer programs generally are also likely to be discerning" and thus "are likely to exercise care when deciding whether to buy Registrant's SCRIBE software products."

While the purchase of applicant's goods undoubtedly involves a high level of care, due to the fact that typically they must fulfill critical business information retrieval requirements and would not be inexpensive, the fact that corporate information specialists and other purchasers of applicant's and registrant's goods would be knowledgeable and discriminating consumers when it comes to selecting specialized computer software "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Thus, even careful and discriminating customers, who are familiar or acquainted with registrant's mark "SCRIBE" for computer programs, including those with information retrieval and dissemination tools for relational database management, and the computer programming manuals associated therewith, would be likely to believe, upon encountering applicant's substantially identical mark "SQRIBE" for its computer software featuring information retrieval and dissemination tools for relational database management and accompanying manuals sold as a unit, that such legally identical goods emanate from, or are sponsored by or affiliated with, the same source.

**Decision:** The refusal under Section 2(d) is affirmed.

E. J. Seeherman

**Ser. No.** 75/185,582

E. W. Hanak

G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board