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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Peak Technologies Group, Inc.

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Serial No. 75/247,107

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Michael S. Walsh for The Peak Technologies Group, Inc.

Frances G. Smith, Trademark Examining Attorney, Law Office  
113 (Meryl Hershkowitz, Managing Attorney).

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Before Hanak, Hohein and Holtzman, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

The Peak Technologies Group, Inc. (applicant) seeks to register NUCLEUS STOCK AUDIT and design in the form shown below for "computer software designed to manage warehouse inventories and computer hardware used therewith, namely, bar code readers and user manuals sold therewith." The application was filed on February 19, 1997 with a claimed first use date of June 1996. In the first office action,

**Ser No. 75/247,107**

the examining attorney required that applicant "disclaim -- the descriptive wording STOCK AUDIT apart from the mark as shown ... because it describes a feature of the goods, namely, that they are computer programs for taking one's inventory, i.e., stock." Applicant responded as follows: "No claim is made to the exclusive right to use STOCK AUDIT apart from the mark as shown."

The examining attorney refused registration pursuant to Section 2(d) of the Trademark Act on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with two marks previously

**Ser No. 75/247,107**

registered to different entities. The first mark is NUCLEIS registered for "computer programs used in connection with managing information for equipment tracking, maintenance processing and materials processing." Registration No. 1,493,948. The second mark is NUCLEUS registered for "computer programs, and computer programs with data processing apparatus, all for use with a computer for data management." Registration No. 1,503,735. When the refusal to register was made final, applicant appealed to this Board. Applicant and the examining attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Because the marks and goods set forth in the two cited registrations are somewhat different, we will begin our analysis with a comparison of the mark and goods of the earlier registration (Registration No. 1,493,948) with applicant's mark and goods. As set forth in the

application, applicant's goods, as previous noted, are "computer software designed to manage warehouse inventories and computer hardware used therewith, namely, bar code readers and user manuals sold therewith." The goods set forth in Registration No. 1,493,938 are "computer programs used in connection with managing information for equipment tracking, maintenance processing and materials processing." Both the application and this earlier registration encompass computer software/computer programs of certain types. Applicant attempts to distinguish its goods from the goods of this earlier registration by arguing that "applicant's goods cover software and hardware, namely bar code readers, designed to manage warehouse inventories, as well as related manuals." (Applicant's brief page 5, original emphasis). Applicant goes on to note that "a bar code reading system for warehouse inventorying also is dissimilar to the goods covered by the NUCLEIS registration, i.e., computer programs used in connection with managing information for equipment tracking, maintenance processing and materials processing." (Applicant's brief page 5). The fact that the application encompasses computer hardware whereas the NUCLEIS registration does not is largely irrelevant in that both the application and this registration encompass computer

software/computer programs. In other words, if there is a relationship between some of applicant's goods and the goods of a cited registration, then depending upon the similarity of the marks, this alone is sufficient for a likelihood of confusion even if applicant's other goods are arguably dissimilar from the goods of a cited registration. Applicant's computer software is designed to manage warehouse inventories, whereas the NUCLEIS computer programs are used in connection with managing information for equipment tracking, maintenance processing and materials processing. Applicant has never taken issue with the examining attorney's statement of the obvious, namely, that "equipment and materials are typically stocked in warehouses." (Examining attorney's brief page 8). Thus, applicant's computer software designed to manage warehouse inventories includes, among other things, computer software/computer programs to manage equipment and materials, things that are typically stored in warehouses and thus are encompassed by the term "warehouse inventories." In short, despite differences in terminology, we find that certain of applicant's goods (computer software designed to manage warehouse inventories) are essentially encompassed by some of the goods included in Registration No. 1,493,948, namely

**Ser No. 75/247,107**

"computer programs used in connection with managing information for equipment tracking ... and materials processing." Thus, the goods of the application and the registration for NUCLEIS are, in part, extremely similar, if not identical.

Turning to a consideration of the marks, we note at the outset that when the goods of the application and registration are extremely similar, the degree of similarity of the marks necessary to support a finding of likelihood of confusion declines. Century 21 Real Estate v. Century Life, 970 F.2d 874, 23 USPQ2d 1698, 1700 Fed. Cir. 1992).

In this case, applicant has taken the entire mark of Registration No. 1,493,948 (NUCLEIS); altered it ever so slightly by changing the second to the last letter from an I to a U; and added to it two subordinate features: (1) the descriptive wording STOCK AUDIT, and (2) a simple circle design. This slight alteration involving the substitution of the letter U for the letter I becomes all the more insignificant when one takes into account that the plural form of the word "nucleus" is "nuclei." The American Heritage Dictionary of the English Language (3d ed. 1992).

It is well established "that one may not appropriate the entire mark of another and avoid a likelihood of

confusion by the addition thereto of descriptive or otherwise subordinate matter." Bellbrook Dairies v. Hawthorn-Mellody Dairy, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958). We find this legal proposition likewise applies to a situation, as is the case here, when one appropriates the entire mark of another and alters it ever so slightly.

Moreover, not only has applicant essentially just added the descriptive wording STOCK AUDIT and a simple circle design to the mark of Registration No. 1,493,948, but in addition, applicant depicts its mark with the NUCLEUS portion in very large lettering on one line and the STOCK AUDIT portion in much smaller lettering on a second line.

Given the extremely close similarity between certain of applicant's goods and certain of the goods for which NUCLEIS is registered, we find that there exists a likelihood of confusion resulting from the contemporaneous use of applicant's mark and the mark NUCLEIS, which is the subject of Registration No. 1,493,948. This is particularly true because applicant depicts its mark with the NUCLEUS portion in large lettering on one line, and the STOCK AUDIT portion in much smaller lettering on a second line.

Turning to a consideration of the second registration cited by the examining attorney, namely, a Registration No. 1,503,735, we find that there also exists a likelihood of confusion resulting from the contemporaneous use of the mark which is the subject of this registration and applicant's mark. Obviously, in this case applicant has adopted the registered mark NUCLEUS in its entirety and has not even slightly altered said registered mark. Moreover the goods of this second registration are very broadly described as "computer programs, and computer programs with data processing apparatus, all for use with a computer for data management." At page 5 of its brief, applicant concedes the very broad description of goods of this second registration and furthermore concedes that "most, if not all, computer software 'manages' information." Thus, applicant has implicitly conceded that the computer software/computer programs set forth in its description of goods would be encompassed by the description of goods set forth in Registration No. 1,503,735 for NUCLEUS. Accordingly, we find that there also exists a likelihood of confusion resulting from the contemporaneous use of applicant's mark and the mark NUCLEUS.

A few final comments are in order. Without providing any evidentiary support whatsoever, applicant argues, at

pages 6 and 7 of its brief, that the trade channels for its goods and the goods of the cited registrations are different; that the buyers of the respective goods are sophisticated purchasers; that the two registered marks are not famous; and that there has been no actual confusion. Because applicant has failed to provide evidentiary support for the foregoing arguments, we have not given them any weight.

As for applicant's argument that "the coexistence of the NUCLEIS and NUCLEUS registrations for more than ten years is probative evidence that any potential confusion would be de minimis," we simply do not understand applicant's reasoning. (Applicant's brief page 7). Obviously, confusion does not arise from the mere existence of registrations within the PTO. Confusion arises in the marketplace when very similar marks are used on very similar goods or services. If applicant is implicitly arguing that because the mark NUCLEUS was allowed to be registered despite the existence of the registration for the mark NUCLEIS and hence its mark should register, we simply note that this is no justification for permitting applicant's mark to be registered when clearly applicant's mark, when used in the marketplace, would cause confusion with the two previously registered marks.

**Ser No. 75/247,107**

Decision: The refusal to register is affirmed as to both cited registrations.

E. W. Hanak

G. D. Hohein

T. E. Holtzman  
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Judges, Trademark Trial and  
Appeal Board