

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

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BAC

8/14/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nomadix, LLC

Serial No. 75/324,415

J. Rick Tache, Esq. of Nomadix, LLC.¹

Jessie W. Billings, Trademark Examining Attorney, Law
Office 103 (Michael Szoke, Managing Attorney).

Before Hanak, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Nomadix, LLC has filed an application to register on
the Principal Register the mark shown below

for "computer hardware, recording media for computers,

¹ Following the submission of briefs in this appeal, applicant's then attorney filed a request for leave to withdraw as applicant's attorney of record, and noted J. Rick Tache as applicant's "Senior Vice President and General Counsel." The request to withdraw as attorney was granted by the Board on December 20, 1999, with correspondence thereafter to be sent to J. Rick Tache at Nomadix, LLC.

namely, partially prerecorded disks and diskettes for use in transferring data, and software for use in transferring data between computers and computing devices and between computers and recording media" in Class 9.²

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 used on its goods, so resembles the previously registered mark shown below

for "PC cards, and communication software for use therewith" in Class 9,³ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is likely.

² Application Serial No. 75/324,415, filed July 14, 1997. The claimed date of first use is September 1995.

³ Registration No. 2,090,036, issued August 19, 1997. The claimed date of first use is March 4, 1996. (The registration was amended under Section 7 of the Trademark Act to delete the word "modems" from the identification of goods.)

Considering first the parties' respective goods, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods as identified in the application with the goods as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case both applicant and registrant sell computer hardware and computer software; applicant's goods

being partially prerecorded disks and diskettes for use in transferring data, and software for use in transferring data, and registrant's goods being PC cards and communication software. With regard to the goods involved before us, we take judicial notice of the following three dictionary definitions⁴:

1. "disk" is defined in the Dictionary of Computer Words (1995) as "[T]he most common medium for permanent data storage. The two types of disks are *magnetic disks* and *optical disks*...." (emphasis in original);

2. "PC card" is defined in Webster's New World Dictionary of Computer Terms (7th ed. 1999) as "[A] credit-card-sized peripheral, such as a network card or modem, that is designed to connect to a PC slot, usually in a portable computer...."; and

3. "communications software" is defined in the Dictionary of Computer Words (1995) as "[S]oftware that enables a computer to communicate through a modem over telephone lines. Communications software can have a variety of features to speed the exchange of data...."

From the last definition listed above, it appears that registrant's communication software involves the exchange of data, and applicant's software expressly involves the transfer of data. Of course, there is no per se rule relating to likelihood of confusion in the computer field.

⁴ See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

See Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988). Based on the sparse information of record before us concerning the involved goods (including the dictionary definitions judicially noticed by the Board), it appears that the goods of both parties, *as identified*, are related.

Applicant argues that the involved goods are sold to careful, sophisticated purchasers. There is no evidence that either disks or PC cards or the related software for each would be purchased by classes of purchasers who are uniquely skilled. Even if the sophistication of the purchasers were established, there are no restrictions in either applicant's or registrant's identification of goods as to purchasers or channels of trade. Therefore, the Board must assume that applicant's goods could move through all the ordinary and normal channels of trade for such goods, and would be offered to all the usual purchasers (i.e., the general public) for such products. See Octocom Systems Inc. v. Houston Computer Services Inc., *supra*, at 1787; and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

We turn next to a consideration of the marks. We acknowledge that the marks, considered in their entirety, are not terribly similar in visual appearance. However,

the word portions of the respective marks, NOMADIX and NOMADICS, are identical in sound. The words in both marks are the portion utilized in calling for the goods, and are most likely to be impressed in the purchaser's memory and to serve as the indication of origin. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *Consumers Building Marts, Inc. v. Mr. Panel, Inc.*, 196 USPQ 510 (TTAB 1977). Moreover, in terms of connotation, the record shows that both marks have the same meaning or connotation in relation to the respective goods. The relevant purchasers would fully understand that the "x" in applicant's mark is a phonetic version of the "cs" in the registrant's mark. That is, applicant's spelling of the word "nomadics" by changing the ending "cs" to a phonetic equivalent "x" simply does not obviate the likelihood of confusion in the minds of purchasers.

The stylized lettering and the design feature of the registered mark (a circle of triangular arrowheads with the "I" in NOMADICS forming the initial triangular arrowheads at both the top and bottom of the "I") and the stylized lettering and design feature in applicant's mark (a partial orbital line) do not offer sufficient differences to create a separate and distinct commercial impression. That is,

the stylistic differences are not sufficient to overcome the likelihood of confusion. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find the dominant origin-indicating part of applicant's mark is very similar in sound, connotation, and commercial impression to that of the registered mark.

Applicant argues that the word "nomadic" is a dictionary term which means "characteristic or suggestive of a people of nomads or their way of life" (see e.g., Webster's Third New International Dictionary), whereas applicant's mark is a coined word. We are not persuaded that the purchasing public would make this distinction, especially in view of the phonetic equivalency between "cs" and "x" with both indicating plurals.

Likewise, applicant's argument regarding the number and nature of similar marks in use on similar goods is unpersuasive. Regarding the twelve listings submitted by applicant, six are pending trademark applications, and are of no probative value. Applicant's listing of six third-party registrations for marks which include the word NOMADIC indicate the registrations are for unrelated matters such as, educational services relating to travel tours in Mongolia and worldwide; portable walls, podiums and frame ceilings; roof racks and carriers for motor

vehicles; and tires, inner tubes and wheels for vehicles.⁵ Applicant did not submit any third-party registrations of the mark NOMADIC[S] in the relevant field of computer hardware and computer software; and in any event, third-party registrations are not evidence of third-party use or that the purchasing public is aware of these marks.

Even if applicant had shown that the cited mark is weak, such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

According to applicant, there have been no instances of actual confusion. However, there is no information of record regarding the respective sales, nor is there any information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

While we have no doubt in this case, if there were any

⁵ We note that the item "tires, inner tubes and wheels for vehicles" is in a registration based not on use in commerce, but rather based on Section 44 of the [Trademark Act](#).

doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Accordingly, because of the similarity of the parties' marks; the relatedness of the parties' goods; and the sale of the parties' goods through the same channels of trade to the same classes of purchasers; we find that there is a likelihood that the purchasing public would be confused when applicant uses NOMADIX and design as a mark for its goods.

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

E. W. Hanak

B. A. Chapman

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board