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8/30/00

Paper No. 14
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ricoh Company, Ltd.

Serial Nos. 75/354,282; 75/431,988
and 75/431,990

Peter D. Murray of Cooper & Dunham LLP for Ricoh Company Ltd.

Stacey J. Johnson, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Ricoh Company, Ltd. has filed applications to register the mark WAVE PAK¹ and the marks WAVEPAK and design,² the two designs being shown below, all for "image compression software for use in copier and fax machines."

¹ Serial No. 75/354,282, filed September 9, 1997, based on an allegation of a bona fide intent to use the mark in commerce.

Serial No. 75/431,988

Serial No. 75/431,990

Registration has been finally refused in each application under Section 2(d), on the ground of likelihood of confusion with the mark WAVEPAK for "computer hardware, namely, circuit boards, power supplies, and connector cables, and computer programs and user manuals supplied therewith."³

The refusals have been appealed⁴ and applicant's request to consolidate the cases for purposes of briefing and final decision has been granted. Both applicant and the Examining Attorney have filed briefs for the consolidated cases, but an oral hearing was not requested.

² Serial Nos. 75/431,988 and 75/431,990, filed February 10, 1998, based on allegations of a bona fide intent to use the marks in commerce.

³ Registration No. 1,408,293, issued September 9, 1986; Section 8 & 15 affidavits, accepted and acknowledged, respectively.

⁴ The Examining Attorney had also made final the requirement that a stippling statement be inserted in the two applications containing designs. Although applicant failed to address this requirement in its initial brief, applicant filed an amendment adding such a statement in the two applications in conjunction with its reply brief. The Examining Attorney subsequently accepted the statements and thus the requirement is not before us.

Here, as in any determination of likelihood of confusion, two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used, or are intended to be used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

As pointed out by the Examining Attorney, applicant's word mark, WAVE PAK, is nearly identical to the registered mark, WAVEPAK. The space between the two terms in applicant's mark fails to alter the identity of sound and connotation of the marks or to materially affect the appearance of the marks. We also agree with the Examining Attorney that the addition of a wave design in applicant's other two marks does not play a significant part in the commercial impressions created by the marks. If anything, the wave design serves to reinforce the term WAVE and, as argued by the Examining Attorney, "contributes" to the overall similarity of commercial impression of the respective marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994). The respective marks, as a whole, are highly similar, and

applicant's word mark and registrant's mark are nearly identical. Applicant has made no argument to the contrary.

Instead, it is when we look to the similarity or dissimilarity of the respective goods that applicant takes issue with the Examining Attorney. The Examining Attorney takes the basic position that the "computer programs" as identified in the registration encompass all varieties of computer programs and, thus, applicant's more specific image compression software for use in copiers and fax machines is covered thereby, citing *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).⁵

Applicant strongly contends that its software is specific to copiers and fax machines and is not a computer program, as "computer programs" were intended to be covered by the registration. Applicant refers to the specimens in the registration file as evidence that registrant's computer programs were promoted for use in turning a personal computer into a signal analysis workstation having data storage, archiving and analysis capabilities.

Applicant insists that its software, by contrast, is not designed to work on a computer but rather to perform the

⁵ We note that in the final refusal the Examining Attorney made additional arguments with respect to the similarity of the respective goods. In view of our disposition of the case, and since the Examining Attorney made no reference to these arguments in her brief, we find no need to review the arguments here.

operation of image compression on a copier or fax machine. Relying upon prior Board holdings that a relationship is not necessarily established simply because the goods of both parties involve computers and even computer software, applicant argues that consideration must be given here to the specific nature and function of applicant's software, as well as that of registrant's computer programs. Citing *In re Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1990), applicant argues that this is a situation in which reference should be made to the file wrapper of the registration in order to clarify the intended meaning of the broad term "computer programs," and, as a result, to see the differences in the nature of the respective goods.

It is well established that the question of likelihood of confusion must be determined on the basis of the goods as identified in the involved application and the cited registration, rather than on what any evidence may show as to the actual nature of the goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Registrant's goods are identified, in part, as "computer programs." There is no limitation as to type or variety of program or the intended field of use. We do not consider the language "computer programs and user manuals

supplied therewith," as found in registrant's identification of goods, to inherently place a limitation on the use of registrant's programs, such that, as argued by applicant, they are "supplied specifically to operate with the computer hardware." Registrant's goods are identified simply as "computer programs," and thus encompass all computer programs, including software such as applicant's, regardless of the specific function and type of machine in which the software may be intended to be used. The situation here parallels that in the *Linkvest* case, in which we held that the registrant's "computer programs recorded on magnetic disks" encompassed the applicant's more specific computer software for data integration and transfer.

Applicant's reliance upon *In re Trackmobile, Inc.*, *supra*, is misplaced. In that case, the Board found it appropriate to turn to extrinsic evidence because the terms used in the identification of goods were unclear as to the exact nature of the goods involved. The evidence was taken under consideration in order to determine the meaning of the terms in the trade, not the nature of the goods with which the mark was actually being used. In fact, the Board distinctly pointed out that

[i]t is improper to decide the issue of

likelihood of confusion based upon a comparison of applicant's actual goods with registrant's actual goods. If registrant's goods are broadly described in its registration so as to include types of goods which are similar to applicant's goods, then an applicant in an ex parte case cannot properly argue that, in point of fact, registrant actually uses its mark on a far more limited range of goods which range does not include goods which are similar to applicant's goods.
Supra at 1153.

In the present case, there is no vagueness or ambiguity in the goods as identified in the cited registration. The meaning in the trade of the term "computer program" is clear. Distinctions cannot be drawn, as attempted by applicant, with respect to either the goods or the channels of trade based on the nature of the goods with which registrant is purportedly actually using its mark.⁶

Applicant further insists that its software is not a "computer program" or even "computer software," since it is being used with copiers and fax machines, not a computer system. The Examining Attorney has countered this argument by introducing the following dictionary definitions:

software Instructions for the computer. A series
 of instructions that performs a particular

⁶ We note, as pointed out by the Examining Attorney, that, in this case, the specimens in the file wrapper upon which applicant relies, have not been made of record as evidence.

task is called a program.

program A collection of instructions that tell the computer what to do. A program is called *software*, hence, program, software and instructions are synonymous.

software program A computer program (computer application). All computer programs are software. Usage of the two words together is redundant, but common.⁷

Thus, the Examining Attorney maintains that the terms "program" and "software" are used interchangeably to describe sets of instructions to "make electronic products run." Here, she argues, "since the applicant's goods are software, they are accordingly used with computerized goods, albeit those with facsimile and copier functions."

We agree. The fact that applicant's software is being used in copier and fax machines, and not an office computer system, a personal computer, or a "computer system" as envisioned by applicant, does not obviate the fact that the software may function as a set of instructions to a computerized element, a microprocessor, within the particular machine in which it is being used. Applicant has provided no evidence that its software does not function in this manner. Thus, taking the dictionary definitions into account, we have no reason to conclude

⁷ *The Computer Glossary* (7th ed. 1995).

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other than that applicant's software is encompassed by the "computer programs" of registrant.

Accordingly, in view of the high degree of similarity of the respective marks and of the overlapping of applicant's software by registrant's computer programs, we find confusion likely if applicant were to use its WAVEPAK marks on the goods recited in the involved applications.

Decision: The refusal to register under Section 2(d) is affirmed in each of the three applications.

R. L. Simms

B. A. Chapman

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

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