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Paper No. 12
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re xSides Corporation¹

Serial No. 75/683,773

Kevin S. Costanza of Seed Intellectual Property Law Group
PLLC for APPLICANT.

Cheryl L. Steplight, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

xSides Corporation seeks registration of the mark
SIDES for "computer operating software and utilities for
providing graphical user interfaces; computer software
system for accessing computers, computer software,
databases, communications services, and electronic
communications networks; computer software for conducting
and managing financial and commercial transactions;

¹ Although the original application was filed by The Pixel
Company, this application has been assigned to xSides Corporation
as a result of a merger. This assignment has been properly
recorded with the Assignment Branch of the U.S. Patent &
Trademark Office at Reel 2207, Frame 0354.

computer software for transmitting and receiving data, text, graphics, and images; computer software for browsing, searching, messaging and other communications with computer networks and global communication networks," in International 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, if used in connection with the identified goods, would so resemble the registered mark SIDE, as shown below:



for "computer peripherals, namely multimedia cards and parts therefor," also in International Class 9³, as to be likely to cause confusion, to cause mistake or to deceive:

Both applicant and the Trademark Examining Attorney have filed briefs. Although applicant had originally requested an oral hearing, that option was subsequently waived.

² Application Serial No. 75/683,773, filed on April 16, 1999, was based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

³ Registration No. 2,249,852, issued June 1, 1999.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors, which if relevant, should be considered in determining likelihood of confusion.

We turn first to a consideration of the marks. The Trademark Examining Attorney contends that the differences between the respective marks are insignificant:

The applicant's mark, SIDES, is in typed form and the registrant's mark is SIDE in stylized form. The only difference between the marks is the addition of the letter "S" in the applicant's mark... .

(Examining Attorney's appeal brief, p. 4).

By contrast, applicant argues that the Trademark Examining Attorney has failed to compare the marks in their entirities:

When a proper comparison is done, it is apparent that that mark in the cited registration is spelled differently than applicant's mark and incorporates highly stylized font and distinctive parallel lines in each letter of the word. These lines and the bold font used in the mark make a significant impression on consumers, which will lessen the likelihood of confusion in the marketplace.

(Applicant's reply brief, p. 2).

The test, when comparing the involved marks, is not whether applicant's mark can be distinguished from

registrant's mark when subjected to a side-by-side comparison but, rather, whether the marks are sufficiently similar in terms of their overall commercial impression that confusion is likely to result as to the source or sponsorship of the goods offered under the respective marks. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). In both marks, the terms "side" and "sides" bring to mind the same connotations that would normally flow from this common English-language word.⁴

While applicant refers to registrant's mark as "highly stylized," we actually find it to be a clear portrayal of the word SIDE printed in a bold font. By comparison, applicant depicts its SIDES mark in typed capital letters. Accordingly, in deciding the issue of likelihood of confusion, we must consider all reasonable manners in which

⁴ As to the connotation of these respective marks, applicant argues that consumers will associate its SIDES mark with applicant's other marks (XSIDES, MYSIDES and XSIDES.COM) while registrant's SIDE mark will be seen in the context of registrant's IDE multimedia card, especially inasmuch as these particular goods are also known as SuperIDE. In any case, we must compare these specific marks as shown, and as applied to the respective goods as identified in the registration and application. Furthermore, there is no evidence in the record that would permit us to conclude that prospective consumers would make these associations as proposed by applicant.

applicant's mark could be depicted. See Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992), and cases cited therein. One reasonable depiction of applicant's mark would include SIDES having bold, thick letters. Perhaps applicant's use of parallel lines within each letter of its mark, similar to those shown in the cited registration, would not constitute a reasonable depiction, but if the goods herein are found to be related, this design feature in registrant's mark alone would hardly be a sufficient difference on which to have this decision turn.

Based on our analysis of these two marks, when considered in their entirety, we find the marks are similar in sound, appearance and connotation, and are likely to create substantially similar commercial impressions in the minds of prospective purchasers. This du Pont factor weighs in favor of affirming the Trademark Examining Attorney.

We turn next to the goods of applicant and registrant. Applicant argues that its goods are directed primarily to enterprises, where purchasing decisions are made by sophisticated individuals after consultation with applicant. However, the identification of goods, on its face, is in no way restricted. Furthermore, as pointed out

by the Trademark Examining Attorney, even sophisticated purchasers are not immune from source confusion when two marks are quite similar.

Moreover, registrant's computer cards must be assumed to travel in all channels of trade to all prospective purchasers, and this would include everyone from large enterprises to individual computer users.

As the Trademark Examining Attorney has pointed out, it is not necessary that goods are the same or that they be directly competitive in order for there to exist a relationship that would support a Section 2(d) finding.

Cooper Industries, Inc. v. Repcoparts U.S.A. Inc., 218 USPQ 81 (TTAB 1983). While we subscribe to no *per se* rule that all computer software and hardware are related, likelihood of confusion can nevertheless exist if the registrant's goods and applicant's goods bear some clear relationship. In the present case, we find that such a relationship exists. Those within a corporate enterprise acquainted with applicant's software (e.g., software that allows such companies to place a constant presence on each employee's computer monitor, for example) would readily conclude that multimedia cards (SCSI cards, I/O adapters, etc.) bearing an identical or similar mark emanate from, or are sponsored by or affiliated with, the same source. Hence, this

du Pont factor too weighs in favor of affirming the Trademark Examining Attorney.

As to the du Pont factor dealing with the number and nature of similar marks in use on similar goods, applicant contends the marks are sufficiently different because "side" (or "sides") is a weak term when used for computer related goods and services. In support of this argument, applicant points to dozens of trademark applications and federal registrations for marks, which in some form include the word "SIDE."

In its response to the initial Office action refusing registration, applicant submitted search results derived from www.micropatent.com having bibliographical data on fifty-five pending applications⁵ and issued registrations. Because this list containing issued registrations was derived from a commercial search service list rather than soft copies of the registrations or printouts from the U.S. Patent and Trademark Office electronic database, they were not properly made of record. However, even though these third-party registrations on which applicant attempts to rely have not been properly made of record [In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983); and

⁵ We note that the pending, third-party trademark applications are of virtually no evidentiary value on this point.

Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992)], the Trademark Examining Attorney failed to object to this curable defect at the time of her final Office action, so we consider this potential objection to have been waived.

Then, with its appeal brief, applicant submitted a second batch of bibliographic data from another commercial search service (www.trademark.com) comprising twenty-six pending applications and issued registrations. In addition to repeating the aforementioned defect, this exhibit was attached to applicant's appeal brief, and hence was untimely. The record must be complete prior to the time of the appeal. See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, we have not considered this particular evidence in reaching our decision.⁶

However, it is well settled that the earlier third-party registrations that we have permitted into the record do not stand as evidence that any of the marks are in use in commerce or that purchasers are conditioned to distinguish between the marks by focusing on components other than the shared element. AMF Inc. v. American

⁶ We should add, however, that there was significant overlap with the fifty-five records submitted earlier containing third-party registrations that we have chosen to review.

Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973).

Moreover, we note that most of these third-party marks involve specialized computer products (e.g., for processing manufacturers' warranties, for storing and retrieving health care records, for transmitting and receiving radio signals, or for use in finance, accounting or banking, etc.) entirely unrelated to the goods involved in this case. Even when the goods are more closely related to the goods of applicant and/or registrant, the marks are quite dissimilar from SIDE or SIDES alone (e.g., IRONSIDE, THE OTHER SIDE, OUTSIDE VIEW, SIDEKICK, SIDEWALK, SIDEWRITER, SIDEWINDER, SIDE ARM, etc.). In fact, virtually all of the third-party, composite marks listed by applicant have some other distinctive matter combined with the word SIDE in ways that create very different commercial impressions.

In conclusion, on this record, we find the respective marks to be quite similar, we have no reason to conclude that the registered mark is weak in this field, and we find the respective goods to be related.

Decision: The refusal to register is affirmed.