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Paper No.

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re **DLI Engineering Corporation**  
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Serial No. 75/725,579  
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**Donald L. Otto** of **Renner, Otto, Boisselle & Sklar, LLP** for **DLI Engineering Corporation**.

**Rebecca Gilbert**, Trademark Examining Attorney, Law Office 113  
(**Meryl Hershkowitz**, Managing Attorney).  
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Before **Seeherman, Hohein** and **Holtzman**, Administrative  
Trademark Judges.

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

**DLI Engineering Corporation, d.b.a. PREDICT/DLI**, has  
filed an application to register the mark "SMARTMACHINE" for  
"computer software and hardware for predicting maintenance  
needs of industrial machinery."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/725,579, filed on the Principal Register on July 8,  
1999 and amended to the Supplemental Register on June 5, 2000, which

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 "SMART MACHINES," which is registered for "computer programs and programs [sic] manuals all sold as a unit,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

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

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.<sup>3</sup>

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alleges a date of first use anywhere of November 1, 1998 and a date of first use in commerce of December 1, 1998.

<sup>2</sup> Reg. No. 1,468,041, issued on the Principal Register on December 8, 1987, which sets forth dates of first use anywhere and in commerce of August 15, 1984; combined affidavit §§8 and 15. The word "SMART" is disclaimed.

<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of

Here, inasmuch as applicant's goods, as discussed below, are identical in part and otherwise closely related to registrant's goods, the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entireties. Moreover, as pointed out in *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), ["[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."]

Turning, as a preliminary matter, to consideration of the respective goods, applicant asserts that its "computer software and hardware ... are integrated to predict the maintenance needs of industrial machinery [and] are clearly not encompassed by the computer programs of the cited registration." It is well settled, however, that that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registration. 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.

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differences in the essential characteristics of the goods and differences in the marks."

Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, and as pointed out by the Examining Attorney, "where a registrant's goods are broadly identified as computer programs ..., without any limitation as to the kind of programs or the field of use, it is necessary to assume that the registrant's goods encompass all such computer programs, and that they would travel in the same channels of trade normal for those goods and [would be purchased by] all classes of prospective purchasers for those goods." See, e.g., In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Here, it is plain that the "computer programs and programs [sic] manuals" set forth in registrant's registration encompass the "computer software ... for predicting maintenance needs of industrial machinery" listed in applicant's application and that registrant's goods, in view thereof, are also closely related to the "computer ... hardware for predicting maintenance needs of industrial machinery" identified in such application. Accordingly, because in legal contemplation registrant's goods are identical in part and otherwise closely related to applicant's goods, the contemporaneous use of the same or substantially

similar marks in connection therewith would be likely to cause confusion.

Turning, therefore, to consideration of the marks at issue, applicant concedes that, "[a]dmittedly, appellant's mark is substantially the same as the registered mark except that the registered mark is in plural form with a space between the words SMART and MACHINES." Applicant maintains, however, that the respective marks are weak, and consequently are entitled to only a narrow scope of protection, in that "as evidenced by the numerous [NEXIS] articles attached to the first Office Action," the term 'smart machine' is used to refer to a machine with intelligent capabilities."<sup>4</sup> In particular, applicant contends that as to registrant's "SMART MACHINES" mark, registrant "admitted [that] 'SMART' was merely descriptive of computer programs by disclaiming 'SMART'" and, thus, "the wording 'MACHINES' is clearly the dominant portion" of the cited mark, while as to applicant's "SMARTMACHINE" mark, such designation "is merely descriptive." Applicant concludes, therefore, that since registrant's mark is distinguishable from applicant's mark by the suggestive term "MACHINES," confusion is not likely to occur.

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<sup>4</sup> Such articles were made of record in support of a refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), of mere descriptiveness, which refusal was overcome by applicant's amendment of the application to the Supplemental Register.

We agree with the Examining Attorney, however, that because the respective marks are "nearly identical," differing only "by a space and a pluralization," there is a likelihood of confusion. The differences in such marks, which applicant admits are "substantially the same," are inconsequential when the marks, as they must be, are considered in their entireties. See, e.g., Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) [there is no material difference, in a trademark sense, between the singular and the plural form of a word]. Moreover, as the Examining Attorney persuasively points out, when the marks at issue are used in connection with computer programs, it is simply "illogical to argue that MACHINES is weak in reference to applicant's mark and dominant in relation to the cited registered mark." Furthermore, notwithstanding the mere descriptiveness inherent in applicant's "SMARTMACHINE" mark and the disclaimer of the word "SMART" in registrant's "SMART MACHINES" mark, the marks project essentially the same overall commercial impression when utilized in connection with, respectively, applicant's computer software and hardware for predicting maintenance needs of industrial machinery and registrant's computer programs and manuals utilized for the same purpose. See, e.g., Industria Espanola De Perlas Imitacion, S.A. v. National Silver Co., 459 F.2d 1049, 173 USPQ 796, 798 (CCPA 1972)

[because the issue of likelihood of confusion must be resolved upon a consideration of the marks in their entireties, "[d]isclaimed material forming part of a trademark cannot be ignored in determining whether the marks are confusingly similar"].

Accordingly, we conclude that customers and prospective purchasers, familiar with registrant's "SMART MACHINES" mark for computer programs and program manuals all sold as a unit, would be likely to believe, upon encountering applicant's substantially identical "SMARTMACHINE" mark for computer software and hardware for predicting maintenance needs of industrial machinery, that such identical in part and otherwise closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source.

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