

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

2/27/02

Hearing:  
January 24, 2002

Paper No. 11  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re ERIM International, Inc.

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Serial No. 75/541,700

John G. Posa and Julie A. Greenberg of Gifford, Krass,  
Groh, Sprinkle, Anderson & Citkowski, P.C. for ERIM  
International, Inc.

Catherine Pace Cain, Trademark Examining Attorney, Law  
Office 104 (Sidney Moskowitz, Managing Attorney)

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Before Seeherman, Quinn and Bottorff, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

ERIM International, Inc. has appealed from the final  
refusal of the Trademark Examining Attorney to register  
GEOWORX as a trademark for "computer software for  
generating and managing geo-spatial products, namely the  
conversion of raw remote sensing data into image files for  
the automated extraction of features in standard image

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formats."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark GEOWORKS, previously registered for "publications, namely, books and training manuals regarding computer programs," as to be likely, if used on applicant's identified goods, to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

We affirm the refusal of registration.

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the marks, they are identical in pronunciation and virtually identical in appearance.

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<sup>1</sup> Application Serial No. 75/541,700, filed August 24, 1998, based on an asserted bona fide intention to use the mark in commerce.

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Although the last letters of each mark differ slightly, GEOWORX ending in an "X" and GEOWORKS ending in a "KS," the first six letters are identical and they create the strong similarity in appearance. The marks also have the same connotation. Accordingly, we find that they convey the same commercial impression.

Applicant argues that the final letters of its mark will be noticed because the suffix WORX forms the basis of its family of marks and/or products. Applicant bases this assertion on what appears to be literature for the GEOWORX product in which various features are identified by terms ending in WORX, e.g., ExtractWorx for "automated Feature Extraction to create derived information," DEM Worx to "Create High Quality DEMs" and SARWorx to "Convert Raw SAR Signals in to Image Frame Files." There are several problems with applicant's position. First, applicant's assertion and the product literature submitted by applicant are insufficient to demonstrate that it has a family of WORX marks, or that consumers will likely not be confused because of the presence of the asserted family feature. The exhibit relates only to applicant's GEOWORX product. As noted previously, applicant filed its application based on an intent to use the mark, and the record does not indicate that applicant has commenced use as yet.

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Certainly no amendment to allege use has been filed. Further, there is no indication as to whether the "GeoWorx Product Description" document has been distributed or, if so, to whom and under what circumstances. In short, the record fails to show that applicant has a recognized family of WORX marks.

More importantly, even if applicant could make a showing that it had a preexisting family of WORX marks, it is not relevant because an applicant cannot rely upon its other marks in seeking registration of a particular mark. See **In re U.S. Plywood-Champion Papers, Inc.**, 175 USPQ 445 (TTAB 1972). As discussed in **Baroid Fluids Inc. v. Sun Drilling Products**, 24 USPQ2d 1048 (TTAB 1992), the family of marks doctrine may not be used defensively to justify registration of a mark likely to cause confusion with another mark.

This brings us to a consideration of the goods. We must bear in mind that even when goods or services are not competitive or intrinsically related, the use of marks which are identical can lead to the assumption that there is a common source. See **In re Shell Oil Co.**, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). If the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order

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to support a holding of likelihood of confusion. **In re Concordia International Forwarding Corp.**, 222 USPQ 355, 356 (TTAB 1983).

It is applicant's position that the goods are unrelated, and that the consumers of its goods would not encounter the registrant's goods. Applicant has explained that its computer programs have a "highly specialized application, relating to geo-spatial data processing for use in creating image files in connection with complex military defense and other sophisticated commercial applications relating to geographical image development." Brief, p. 3. It also states that its products are sold at prices that often exceed \$200,000. Applicant further asserts that the registrant's goods are computer manuals "used in relation to cellular telephones and consumer advertisements transmitted to such telephones." Id.

It is well established that it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate

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from or are in some way associated with the same source.

**In re International Telephone and Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978). Further, we must compare the goods based on the identifications in the application and the cited registration, rather than on what the evidence shows the goods to be. **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); **In re Elbaum**, 211 USPQ 639 (TTAB 1981).

Thus, although applicant may assert that the registrant's books and training manuals regarding computer programs may relate solely to cellular telephones and consumer advertisements transmitted to such telephones, for purposes of our determination we must deem those books and training manuals to be used for all types of computer programs, including programs such as the applicant's software for generating and managing geo-spatial products, as well as other highly specialized and sophisticated computer programs.

Thus, the goods of applicant and registrant must legally be deemed to be complementary products which can be sold in the same channels of trade to the same classes of consumers.

Moreover, the Examining Attorney has made of record a number of third-party registrations which show that

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registrants have adopted a single mark for both computer software and books and training manuals for computer programs. See, for example, Registration No. 2,324,275 for "computer software for use in processing and analyzing remote sensing, geographic, cartographic and other spacial [sic] information and accompanying instruction or user manuals sold as a unit"; Registration No. 2,375,677 for, inter alia, "computer hardware and computer software for application and operating system functions for use in commercial interaction in the field of global computer networks" and "printed matter, namely, books, brochures and instructional manuals, all relating to commercial interaction applications in the field of global computer networks"; Registration No. 2,309,960 for, inter alia, "digitized maps and computer CD-Rom software and instructional manuals sold as a unit for mapping, graphical depiction, display, analysis and annotation of digitized maps for airborne, land, and marine navigation"; Registration No. 2,342,672 for, inter alia, "computer software for desktop publishing" and "manuals, books and magazines for use with computer software for desktop publishing"; Registration No. 2,356,040 for, inter alia, "educational computer software for use in training on computer applications" and "printed manuals, namely,

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reports, books magazines and manuals featuring computer software and computer information"; Registration No. 2,327,832 for, inter alia, "computer software for use in printing hardcopy output" and "computer hardware and software manuals"; Registration No. 2,258,957 for, inter alia, "computer programs for desktop to host communications" and "computer program manuals for desktop to host communication programs" and Registration No. 2,255,934 for, inter alia, "software for monitoring, managing and performing diagnostics relative to network management systems" and "technical manuals, users' manuals, and other descriptive written materials associated with software for monitoring, managing, and performing diagnostics relative to network management systems."

Third-party registrations which individually cover a number of different items and which are based on use in commerce<sup>2</sup> serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

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<sup>2</sup> We have given no weight to those third-party registrations submitted by the Examining Attorney which are based on Section 44 of the Trademark Act.

Comparing the goods in light of the above-noted legal principles, we find that applicant's computer software for generating and managing geo-spatial products is sufficiently related to books and training manuals regarding computer programs that, when both are sold under the nearly identical marks GEOWORX and GEOWORKS, confusion is likely.

We recognize applicant's contention that the purchasers of its product are sophisticated and discriminating, a contention that the Examining Attorney does not dispute. Although this factor favors applicant, it is outweighed by the similarities between the marks and the goods.

In finding likelihood of confusion, we note applicant's assertion that the identification of goods in the cited registration "cannot be interpreted as covering virtually every field in which computers are employed." Reply brief, p. 2. We acknowledge that this is a very broad identification which might not be sufficiently definite if the application were being examined today. Although we are required by Section 7 of the Trademark Act, as well as the relevant case law, to give this broad identification full force, applicant is not without remedies in its attempt to obtain a registration.

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Specifically, applicant may seek a consent from the owner of the cited registration, or applicant may seek a restriction in the cited registration, pursuant to Section 18 of the Act, that may serve to avoid a likelihood of confusion. See, **Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG**, 34 USPQ2d 1266 (TTAB 1994).

Finally, to the extent that any doubt exists on the issue of likelihood of confusion, it is well settled that such doubt must be resolved against the newcomer and in favor of the prior user. **In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes**, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.