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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sterling Software, Inc.

Serial Nos. 75/788,509;
75/788,510; 75/788,855;
75/788,856; 75/788,860;
and 75/788,861

Anita Nesser of Baker Botts L.L.P. for Sterling Software,
Inc.

Ronald L. Fairbanks, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 30, 1999, Sterling Software, Inc.
(applicant) filed six intent-to-use applications to
register the following marks (in typed form) on the
Principal Register for the following goods, all in
International Class 9:

(1) EUREKA:INTELLIGENCE

Ser Nos. 75/788,509; 75/788,510; 75/788,855; 75/788,856;
75/788,860; and 75/788,861

For: Computer software for use in connection with enterprise information portals, namely, software for personalized, browser-based, integrated searching, analyzing and creating a wide variety of reports using an organization's internal information and intelligence over computer networks. (Ser. No. 75/788,509)

(2) EUREKA:STRATEGY

For: Computer software for use in connection with enterprise information portals, namely, software for creating and managing large databases and performing calculations on, and generating a wide variety of reports from, such databases, using an organization's internal information over computer networks. (Ser. No. 75/788,510)

(3) EUREKA:ANALYST

For: Computer software for use in connection with enterprise information portals, namely, software that performs high-speed multidimensional analysis on an organization's internal information over computer networks. (Ser. No. 75/788,855)

(4) EUREKA:PORTAL

For: Computer software for use in connection with enterprise information portals, namely, software for providing a single point of network entry for accessing and viewing an organization's internal information and intelligence over computer networks. (Ser. No. 75/788,856).

(5) EUREKA:SUITE

For: Computer software for use in connection with enterprise information portals, namely, software that enables organizations to organize, manage and distribute internally and externally stored information via a global communication network. (Ser. No. 75/788,860)

(6) EUREKA:REPORTER

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75/788,860; and 75/788,861

For: Computer software for use in connection with enterprise information portals, namely, software for producing production reports based on an organization's internal information over computer networks. (App. No. 75/788,861).

In each case, the Examining Attorney¹ ultimately refused to register the marks because of the following registration of the mark shown below for "software development and consulting services" in International Class 42:



The registration contains a disclaimer of the word "software" and a statement that the stippling is a feature of the mark and does not represent color. Additionally, we note that affidavits under Section 8 and 15 pertaining to this registration have been accepted and acknowledged, respectively, by the Office. 15 U.S.C. §§ 1058 and 1065.²

After the Examining Attorney made the refusals final, these appeals followed. Both applicant and the Examining Attorney filed briefs. Oral hearings were not requested.

¹ The present Examining Attorney was not the original Examining Attorney in these cases.

² Registration No. 1,913,902, issued August 22, 1995.

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Inasmuch as the records and the issue in all six applications are similar, we will consolidate the appeals and issue a single opinion for all marks on appeal. In this opinion, when we refer to portions of the record that are common to all the applications, we will refer to Application No. 75/788,509.

According to the Examining Attorney, "eureka" is a "unique/arbitrary term" (Examining Attorney's Br. at 9). The Examining Attorney argues that it is the dominant portion of applicant's mark, which is identical to the dominant portion of the registered mark. The Examining Attorney points out that the word "software" is disclaimed. He also maintains that the words in applicant's mark are suggestive of an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant goods, and these words do not distinguish the marks in those applications from the cited registration.

The Examining Attorney also found that the goods and services are "highly related." Examining Attorney's Br. at 9. As evidence of this relatedness, the Examining Attorney made of record numerous copies of registrations for the purpose of showing that "one mark [was] used for both the goods of computer software/computer programs and the

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services of development and/or consulting of computer software." Office Action dated December 6, 2000, p. 3 n.1. The Examining Attorney concluded that there would be a likelihood of confusion.

On the other hand, applicant argues that "there are no visual or aural similarities whatsoever between the marks, and the commercial impression engendered by each mark is substantially different." Applicant's Br. at 5. Applicant also maintains that the Examining Attorney "is straining to create a relationship between the Registrant's services and Applicant's goods, while the record (and common sense) dictate otherwise." Applicant's Br. at 7. Applicant concludes that its services "simply do not move in the same channels of trade as Applicant's goods, and they are not offered or sold to the same classes of purchasers," and it submits that the refusal should be reversed. Applicant's Br. at 11.

After considering the records and the arguments of the applicant and the Examining Attorney, the Examining Attorney's refusals to register applicant's marks for the identified goods because they would be likely to cause confusion with registrant's mark for its services are affirmed.

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Evidentiary Issues

Before we consider the likelihood of confusion issue, we must first address several evidentiary issues that have been raised on appeal. When the Examining Attorney initially refused to register applicant's marks, the Examining Attorney relied on 76 third-party registrations to demonstrate that registrant's services were related to applicant's goods. In its Appeal Brief, applicant points out that there are only 73 registrations at issue because two copies of the same registrations were included and two registrations were issued to the same entity. The Examining Attorney now apparently accepts this number because, in his Appeal Brief, he refers to "a representative sampling of seventy-three (73) registrations." Examining Attorney's Br. at 7 n.3.

However, applicant further requests that we disregard 23 of these registrations because they were issued under Section 44(e) of the Trademark Act and were not based on use. Applicant's Brief at 3. Surprisingly, the Examining Attorney persists in arguing that all 73 registrations have probative value. Examining Attorney's Br. at 7 n.3 ("The applicant's request that any of the previously attached evidence be disregarded is without merit"). While the

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Examining Attorney cites In re Mucky Duck Mustard Co. Inc.

for support, we note that this case stands for exactly the opposite point.

In the instant case, however, 11 of the 15 third-party applications and registrations which cover both restaurant services and mustard were filed under the provisions of Section 44 of the Act, that is, they are based on foreign registration rather than on use in commerce, and most of their owners appear to have simply copied large parts of the title (including, in some cases, even the punctuation used therein) of International Class 30. Such registrations and applications are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services, and they have very little, if any, persuasive value on the point for which they were offered.

In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470
n.6 (TTAB 1988).

Therefore, we agree with applicant, and we will not consider the registrations based on Section 44(e) as evidence of the relatedness of the goods and services.

The Examining Attorney then goes on to attempt to submit additional evidence in the same footnote in its brief. Id. at 7-8 n.3 ("Furthermore, as of the date of this brief, there are 448 registrations of the type attached by the original examining attorney – 284 of which did not claim a priority filing date via Section 44(e) of the Trademark Act"). Not unexpectedly, applicant submits that this "'evidence' cannot be considered by the Board."

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Reply Br. at 2. The Examining Attorney has not provided any argument as to how we can consider this evidence on appeal. The record should be complete prior to appeal. 37 CFR § 2.142(d). Of course, we do not take judicial notice of registrations in the Office nor, even if timely submitted, is it sufficient to simply include a list of marks with registration numbers. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"); See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994); In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974). Worse yet is to simply reference a large number of registrations without providing any other details. Therefore, we agree with applicant, and we will not consider this "evidence" in our decision.

Likelihood of Confusion

Now, we address the main issue in this appeal: whether applicant's marks for its goods would be confusingly similar to the registered mark for the identified services. Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In

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considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is whether the marks are similar in sound, appearance, meaning or commercial impression. du Pont, 476 F.2d at 1361, 177 USPQ at 567. Applicant seeks to register the marks EUREKA:INTELLIGENCE; EUREKA:STRATEGY; EUREKA:ANALYST; EUREKA:PORTAL; EUREKA:SUITE; and EUREKA:REPORTER in typed form. The cited registration is for the mark:



Both marks contain the common term "eureka." The Examining Attorney submits that the term is unique and arbitrary. Applicant, on the other hand, agrees that both marks contain the same word "eureka," but it maintains that because "eureka" is defined as "used to express triumph upon finding or discovering something," it is highly

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suggestive when used in connection with computer-related goods or services because these programs are often used "for location and/or discovery of something." Request for Reconsideration, p. 3. We do not agree with applicant that the term "eureka" is highly suggestive when used in connection with computer-related goods or services nor is there any evidence that the term is widely used in this field. Therefore, we agree with the Examining Attorney that the word would not be highly suggestive of applicant's or registrant's goods or services.

Next, we must compare the marks in their entireties to see if the marks are similar. We agree that the word "eureka" is the only term common to both applicant's marks and the registered mark. Applicant correctly notes that the cited registration is a composite mark containing a design element, applicant's marks contain a colon, and the other wording in the marks is different.

We acknowledge that the marks are certainly not identical although that, of course, does not end the likelihood of confusion analysis. It is well settled that it is improper to dissect a mark. In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. In re National

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Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed.
Cir. 1985).

The differences in type styles between registrant's design mark and applicant's marks are not significant here because applicant's marks are in typed form and, thus, not limited to any special depiction. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000). Nor is the fact that the registrant also has a design in its mark sufficient to distinguish the marks. The design consists simply of the stylized letters "ES." These letters reinforce the connection with EUREKA SOFTWARE, the first letters of the two words in the mark. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, the dominant portion of applicant's THE DELTA CAFE and design mark, held similar in sound, appearance, and meaning to registrant's DELTA mark).

As for the colon in applicant's mark, we find that the colon does not serve to distinguish applicant's marks from the registrant's. The CCPA held that the addition of a hyphen and another digit did not eliminate the similarity of the marks. See Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("The

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addition of the extra 6 and the hyphen has already been held not to avoid likelihood of confusion, and in the absence of some other apparent significance for the term 6-66 we find this conclusion inescapable"). Punctuation often does not significantly change the commercial impression of marks. In re Burlington Industries, Inc., 196 USPQ 718, 719 (TTAB 1977) ("[A]n exclamation point does not serve to identify the source of the goods"). Here, the colon seems to emphasize the significance of the word "eureka" and to indicate that the next word is a subcategory of goods available under the EUREKA trademark.

The only truly significant difference between the marks is the fact that the word following EUREKA in each mark is different: "software" in the registered mark and "intelligence," "strategy," "analyst," "portal," "suite," and "reporter" in applicant's marks. The term "software" is disclaimed in the registered mark and it does not significantly change the commercial impression of the registrant's mark. Disclaimed matter is often given less weight than other elements of a mark. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). Here, when applicant's goods are software and registrant's services are "software development and consulting services," the word "software" would not

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significantly distinguish the marks because both applicant's goods and registrant's services involve software.

The words in applicant's marks also do not serve to distinguish the marks. These words, "intelligence," "strategy," "analyst," "portal," "suite," and "reporter," are highly suggestive of software programs that: use "an organization's information and intelligence;" perform "multidimensional analysis;" are "used in connection with enterprise information portals;" or produce "production reports." The Examining Attorney also pointed out that "suite" is a descriptive term, and commonly disclaimed, for computer software. Application No. 75/788,860, Office Action dated December 6, 2000, p.2 and attached registrations. The Examining Attorney also argues that "strategy does little to distinguish these marks. Strategy is a suggestive term when used in relation to the applicant's goods ['software for performing calculations ... generating reports']". Application No. 75/788,510, Office Action dated December 6, 2000, p. 2 (emphasis omitted). "Strategy" is defined as "[t]he art or skill of using

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stratagems esp. in politics and business." *Webster's II
New Riverside University Dictionary* (1984).³

When we compare the marks in their entirety, we find that they are similar. As we previously discussed, we find that the presence of the colon seems to accentuate the common word "eureka." The suggestive meaning of the additional words in applicant's marks would simply indicate different subspecialties of the software.

Next, we turn to the issue of whether applicant's goods and registrant's services are related. "[I]t is well established that a "relatedness" which speaks to a likelihood of confusion may occur not only where goods are involved but can exist between products on one hand and services dealing with or related to those products on the other hand." MSI Data Corp. v. Microprocessor Systems, Inc., 220 USPQ 655, 658 (TTAB 1983) (Computer hardware manufacturing services to the order of or specification of others held related to electronic ordering system for gathering and transmitting data comprising a recorder-transmitter and data receiver). See also Safety-Kleen Corp. v. Dresser Industries, 518 F.2d 1399, 186 USPQ 476

³ We take judicial notice of this dictionary definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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(CCPA 1975) (Maintenance services found related to parts for cleaning units). Relatedness may exist even if the products and services are not competitive "if they could come to the attention of the same types of customers suggesting a common origin." MSI Data, 220 USPQ at 658.

To determine whether the goods and services are related, we must consider the goods and services as they are described in the identification of goods and services in the applications and registration.⁴ "'Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be.'" Dixie Restaurant, 41 USPQ2d at 1534 (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987). See also Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Here, the services in the registration are identified broadly as "software development and consultation services." Contrary to

⁴ Applicant's evidence regarding registrant's actual services, submitted with applicant's request for reconsideration, does not limit the scope of the registration.

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applicant's argument, the Examining Attorney is not "straining to create a relationship" between applicant's goods and registrant's services. Applicant's Br. at 7. Obviously, these services can involve developing software and providing consulting services for software involving enterprise information portals. Canadian Imperial Bank, 1 USPQ2d at 1816 (Board properly considered "whether, in the entire market for that service (banking services), there was a likelihood of confusion").

While the identifications of applicant's goods in its six applications are different, they are all for "computer software for use in connection with enterprise information portals, namely, software for ... on an organization's internal information over computer networks."⁵ In this case, the Examining Attorney has made of record dozens of third-party registrations based on use in commerce to show that the goods of the applicant and the services of registrant often are marketed under the same marks. See Mucky Duck Mustard, 6 USPQ2d at 1470 n.6 (Although third-party registrations "are not evidence that the marks shown

⁵ Application No. 75/788,860 does not use the language "over computer networks." Instead it contains the language "via a global communications network" in the identification of goods. We do not view this difference to have a significant effect on the issue of the relatedness of the goods and services.

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therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). These registrations support the Examining Attorney's position that the goods and services are related. See, e.g., Reg. No. 2,306,921 ("computer software for use in the field of engineering..." and "consultation services and computer software development for others in the field of engineering..."); No. 2,305,105 ("computer software, namely, inventory tracking software..." and "computer consultation services, namely, customer software and development..."); No. 2,303,524 ("computer software for developing custom-based software applications..." and "design development installation and maintenance of computer software..."); and No. 2,302,680 ("computer software, namely, integrated human resources, payroll, benefits, and job requisition software packages" and "computer consultation, namely, consulting services ... involving business management software systems"). Even sophisticated purchasers would be likely to be confused if applicant's and registrant's services were used on such closely related goods and services. Octocom Systems, 16 USPQ2d at 1787.

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Applicant cites Reynolds and Reynolds Co. v. I.E. Systems, Inc., 5 USPQ2d 1749 (TTAB 1987), and argues that “[n]ot everything involving the use of computers is necessarily related.” Applicant’s Br. at 7. We agree. In that case, the very specific and different software of the applicant and the opposer were not so closely related that confusion was likely. Unlike the cited case, the goods and services here are much more closely related.

In this case, we find that EUREKA is a strong term that dominates applicant’s and registrant’s marks. There is no basis to find that the word is weak or highly suggestive of the goods and services. While there are differences in the marks, these differences are eclipsed by the common feature “EUREKA.” The goods and services are related such that purchasers familiar with registrant’s ES EUREKA SOFTWARE and design software development and consultation services would likely believe that there is a common source for computer software for use in connection with enterprise information portals offered under the marks EUREKA:INTELLIGENCE, EUREKA:STRATEGY, EUREKA:ANALYST, EUREKA:PORTAL, EUREKA:SUITE, and EUREKA:REPORTER.

Decision: The refusals to register applicant’s marks under Section 2(d) of the Trademark Act are affirmed.