

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Date: 1/4/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Maximum Publishing LLC

Serial No. 78375142

Melody B. Wirz of Dunlap, Coddling & Rogers for applicant.

Richard F. White, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Quinn, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Maximum Publishing LLC to register the mark PC BUG DOCTOR ("PC BUG" disclaimed) in standard character format for "computer software that fixes software errors on a computer."¹

The trademark examining attorney refused registration pursuant to Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods,

¹ Application Serial No. 78375142, filed February 27, 2004, asserting first use anywhere and first use in commerce on January 15, 2003.

so resembles the previously registered mark PC-DOCTOR for "computer software for diagnosing computer hardware functioning, efficiency, operation and problems" as to be likely to cause confusion.²

When the refusal to register was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant argues that the marks are different, highlighting the differences in sound and appearance. Further, applicant states that the term "PC DOCTOR" is weak. Applicant also contends that the goods are different, asserting that the examining attorney has not shown that any entity, except for one large corporation, regularly provides both of the types of software involved herein. Applicant also contends that the trade channels for its goods and registrant's goods are different in that applicant's software is available as a download from the Internet whereas registrant's software may be ordered online, but is not available for downloading. Further, applicant claims that its goods, costing \$39.99 for the basic version, are sold to individual computer users for

² Registration No. 2140150, issued March 3, 1998 under Section 2(f); combined Sections 8 and 15 affidavit accepted and acknowledged.

their home computers, while registrant's goods, with prices starting at \$499.00, are purchased by manufacturers, developers, support personnel and service personnel associated with large companies. In connection with its weak mark argument, applicant relies upon two third-party registrations.³

The examining attorney maintains that the marks are nearly identical, and that the addition of the term "BUG" in applicant's mark is insufficient to distinguish the mark PC BUG DOCTOR from registrant's mark PC-DOCTOR. The examining attorney introduced dictionary definitions for "PC" and "bug." The examining attorney also contends that the goods are related and, in this connection, submitted portions of web sites retrieved from the Internet, including applicant's and registrant's, showing that these entities offer both software for fixing software problems and software for fixing hardware problems.

³ Applicant also submitted a listing showing it to be a leader, based on numbers of hits of unique visitors to its web site, among Internet web sites. The listing was offered for the first time in applicant's appeal brief. The examining attorney objected to the "evidence" as untimely. The objection is sustained. Trademark Rule 2.142(d). Accordingly, the listing has not been considered in our determination. We hasten to add that, even if considered, the listing does not compel a different result on the merits.

Our determination of the issue of likelihood of confusion 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). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's mark PC BUG DOCTOR and registrant's mark PC-DOCTOR look and sound alike. The marks are similarly constructed in that both begin with PC⁴ and end with DOCTOR. The only material difference between the marks is the presence of BUG in applicant's mark. The term BUG, in the context of computers, means "a programming error that causes a software application or computer system to perform erratically, produce incorrect results, or crash

⁴ As shown by the dictionary definition submitted by the examining attorney, the letters PC mean "personal computer." www.netlingo.com.

altogether." www.netlingo.com. Given the descriptiveness of this term as used in connection with applicant's goods, and the fact that it has been disclaimed, the addition of BUG in applicant's mark does not serve to sufficiently distinguish it from registrant's mark. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) [COMMCASH and COMMUNICASH are similar in sound, appearance and meaning]. The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto. See Alberto-Culver Co. v. Helene Curtis Industries, Inc., 167 USPQ 365, 370 (TTAB 1970). The present case is no exception. As to meaning, both marks convey the same connotation, namely that the software will fix problems with personal computers. Further, given that doctors treat "bugs" in a literal sense, both marks engender the same overall commercial impression, that is, the software, functioning as a "doctor," will treat a personal computer for a "PC bug."

Further, in finding that the marks are similar, we have kept in mind the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. See, e.g., In re M. Serman &

Company, Inc., 223 USPQ 52 (TTAB 1984); and Gastown Inc. of Delaware v. Gas City, Ltd., 187 USPQ 760 (TTAB 1975). The proper test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the overall similarities and dissimilarities engendered by the involved marks.

In contending that there is no likelihood of confusion, applicant asserts that the cited mark is weak, relying on third-party registrations and a listing of third-party Internet addresses comprising, in part, "pcdoctor" and variations thereof. The two third-party registrations of the marks PC/DOCTOR and ASK DOCTOR PC are of limited probative value in our likelihood of confusion analysis. As often stated, this evidence does not establish that the registered marks are in use or that the public is familiar with them. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). The same deficiencies exist with respect to the Internet addresses.

We next turn to a comparison of the goods. In considering the goods, it is not necessary that they 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 from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). The issue of likelihood of confusion must be determined on the basis of the goods as set forth in the application and the cited registration. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra at 1815-16.

Applicant's "computer software that fixes software errors on a computer" and registrant's "computer software for diagnosing computer hardware functioning, efficiency, operation and problems" are commercially related. Both products are diagnostic software, albeit applicant's software deals with software problems whereas registrant's software deals with hardware problems. Although applicant relies to a great extent on this distinction, the record suggests that it is insufficient to avoid a likelihood of confusion.

The examining attorney submitted excerpts from the Internet web site of Symantec Corporation showing that this

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third party sells software that addresses both software and hardware issues. Also made of record is Symantec's registration of SYMANTEC, Registration No. 2205386, covering software for both software and hardware applications. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) [third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source]. In addition, registrant's web site indicates that registrant's "diagnostic products allow end users to quickly troubleshoot hardware and software problems." Although applicant's web site touts that "PC Bug Doctor will repair every error on your computer anytime you need it," we agree with applicant that there is nothing in the record to indicate that any of applicant's products address computer hardware problems.

Applicant's attempts to distinguish the goods on the bases of trade channels and classes of consumers are of no relevance. Applicant states that its software costs \$40, is purchased by individual users, and is available as a download from the Internet; registrant's software, on the other hand, costs approximately \$500, is purchased by

manufacturers and developers associated with large companies, and is not available by download. The problem with these distinctions is, of course, that neither the cited registration nor the involved application include any such limitations. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981)["[W]here the goods in a cited registration are broadly described and there are no limitations in the identifications of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers."]. Thus, we must presume that the goods move through all reasonable trade channels to all customary purchasers. As identified in the cited registration and involved application, there is an overlap in trade channels and purchasers.

The similarities between the marks and the goods, and the similarities in trade channels and purchasers, favor a finding of likelihood of confusion. We conclude that purchasers familiar with registrant's computer software for diagnosing computer hardware functioning, efficiency, operation and problems sold under its mark PC-DOCTOR would

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be likely to believe, upon encountering applicant's PC BUG DOCTOR mark for computer software that fixes software errors on a computer, that the goods originate from or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., supra; and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.