

Paper No. 24  
PTH

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

APRIL 17, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re **New Paradigm Software Corporation**

---

Serial No. 74/467,612

---

**Philip Furgang** of Furgang & Milde, LLP for **New Paradigm Software Corporation**.

**Margaret Le**, Trademark Examining Attorney, Law Office 109  
(**Deborah Cohn**, Managing Attorney).

---

Before **Simms**, **Seeherman** and **Hairston**, Administrative  
Trademark Judges.

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

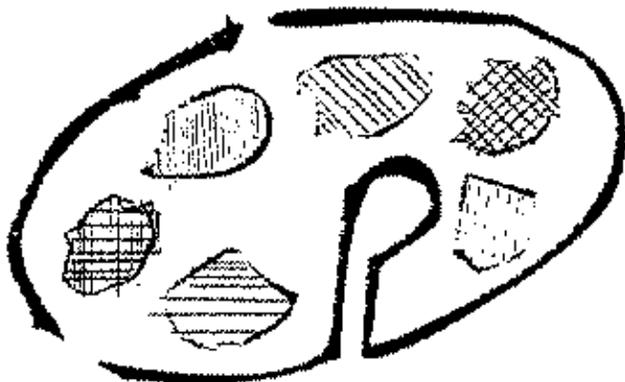
On December 9, 1993 New Paradigm Software Corporation  
filed an intent to use application to register the mark  
shown below,



for goods which were identified as "computer programs and manuals sold as a unit."<sup>1</sup> In her first office action, the Examining Attorney required that applicant amend the identification of goods to specify the function of the computer programs. In response thereto, applicant amended the identification of goods to "database driven software and manuals therefor." However, the amended identification of goods was unacceptable, and the Examining Attorney, in her second office action, stated:

The amendment to the identification of goods is not sufficient. The identification remains indefinite as "data driven software" is not a specific function of the software. The applicant must amend the identification to identify the exact function of the software. The following wording may be adopted, if accurate: computer software for use to [please identify exact function] and manuals sold as a unit.

Applicant then amended the identification of goods to "computer software capable of having its functionality changed in real time by changing the data in a configuring



requently amended to  
first use in commerce of  
the colors red, blue,

database and manuals therefor."

The Examining Attorney has finally refused registration on the ground that "[t]he identification of goods remains unacceptable as indefinite."

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.

According to the Examining Attorney, applicant's sales brochure clearly shows that applicant's computer software allows software applications to share information even when they are operating on different hardware platforms and operating systems. Thus, it is the Examining Attorney's position that applicant's identification of goods should be amended to set forth this specific function.

Applicant, however, contends that its software is patented or is the subject of pending patent applications in at least 34 countries; that the sales brochure provided to the Examining Attorney explains "only one formative or configuration" of applicant's computer software; and that applicant should not be required to restrict its identification of goods to this one embodiment. In support of its position, applicant relies on the following paragraph of TMEP Section 804.03:

As long as a broad term identifies with reasonable certainty what goods or services are intended to be covered, it will be reasonable, from a commercial viewpoint to consider that the mark has been used for all

the related goods or services, which fall in the designated group.

The problem with applicant's argument is that it ignores subsection (b) of TMEP Section 804.03 titled *Identifying Computer Programs with Specificity*.<sup>2</sup> TMEP Section 804.03, on which applicant relies, consists of several paragraphs, and applies to identifications of goods generally. We note that applicant has taken the above paragraph from Section 804.03 out of context.

Turning then to TMEP Section 804.03(b), it provides, in relevant part:

Any identification of goods for computer programs or comparable goods must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid unnecessary issuance of refusals on this basis where the actual goods of the parties are not related and there is no conflict in the marketplace. (citation omitted)

. . . . .

If an applicant asserts that the computer programs at issue serve a wide range of diverse purposes, that is, if applicant is, in effect, asserting that the mark is used as a house mark for a full line of computer programs, the applicant must submit appropriate evidence to substantiate such

---

<sup>2</sup> We note that it was not until her appeal brief that the Examining Attorney cited TMEP Section 804.03(b) as authority for the requirement to amend the identification of goods to specify the function of the computer software. In the first and second office actions, no authority was cited, and in the final office action, TMEP Section 804 was cited. This section covers application requirements generally. The better practice would have been for the Examining Attorney to cite TMEP Section 804.03(b) in the first office action.

a broad identification of goods.

In this case, we agree with the Examining Attorney that applicant's identification of goods is not sufficiently specific. While applicant has set forth an operating feature of its computer software (i.e., capable of having its functionality changed in real time by changing the data in a configuring database), it does not appear that this information would be helpful to an Examining Attorney in a likelihood of confusion determination. Rather, in the absence of additional language which sets forth the particular function of applicant's computer software (i.e., allows software applications to share information even when they are operating on different hardware platforms and operating systems), we believe it would be difficult, if not impossible, to make determinations with respect to likelihood of confusion.

Finally, to the extent that applicant is asserting that its computer software serves a wide range of purposes, and thus a broad identification of goods is appropriate, this assertion is not supported by the sales brochure, and applicant has failed to submit any other evidence which would support such an assertion.

Serial No. 74/467,612

Decision: The refusal to register is affirmed.

R. L Simms

E. J. Seeherman

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board

Serial No. 74/467,612