

HEARING:  
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Paper No. 14  
DEB

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Cybernet Systems Corporation

Serial No. 75/476,392

John G. Posa and Julie A. Greenberg of Gifford Krass Groh Sprinkle Anderson & Citkowski, P.C. for Cybernet Systems Corporation.

David T. Taylor, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Cybernet Systems Corporation has appealed from the refusal of the Trademark Examining Attorney to register NETMAX for "computer software for use in installing and operating a multi-protocol computer network and user manuals sold as a unit,"<sup>1</sup> in International Class 9.

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 NETMAXER for

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<sup>1</sup> Application Serial Number 75/476,392 was filed on April 29, 1998. The application was based upon an allegation of use and use in commerce since December 18, 1996.

"operating system utility computer programs and user guides sold together as a unit,"<sup>2</sup> also in International Class 9, that, as used on applicant's identified goods, it is likely to cause confusion, to cause mistake or to deceive.

The appeal has been fully briefed and at applicant's request, an oral hearing was conducted before the Board. We affirm the refusal of registration.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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).

We turn first to a consideration of the similarity or dissimilarity of the respective marks, in their entireties as to appearance, sound, connotation and commercial impression. While the Trademark Examining Attorney contends that they are "nearly identical," applicant disagrees, arguing as follows:

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<sup>2</sup> Registration No. 2,002,834, issued on September 24, 1996.

The cited mark is NETMAXER. While the obvious components of this mark are NET and MAX, the cited mark is given an "ER" ending to create the impression that the mark refers to a noun - the thing that does the "maximizing." There being no such accepted thing as a MAXER, it is clearly coined and unique. In contrast, the subject application is for the suggestive combination of NET and MAX, to create NETMAX, clearly alluding to the positive brand quality of "maximizing" rather than to a noun which is "MAXER."

The Trademark Examining Attorney counters that inasmuch as the only difference is applicant's deletion of registrant's -ER suffix, the marks are indeed quite similar as to their sound, appearance and connotation. Further, because the average consumer retains only a general impression of trademarks, these marks have a similar overall commercial impression.

We find that these two marks - NETMAXER and NETMAX - look and sound very much alike due to the fact they share the same first two syllables, NET•MAX. Yet applicant attempts to draw a fine distinction between the connotations and commercial impressions of these two marks based upon applicant's deletion of registrant's final syllable. However, the dividing line between "the thing that does the 'maximizing' " and "the positive brand quality of 'maximizing' " will be lost on the average consumer. Upon encountering these marks, prospective consumers will

likely not focus on the differing parts of speech, but rather will come away with a vague sense of "maximizing one's network." Thus, we agree with the position taken by the Trademark Examining Attorney that the marks are similar in overall connotation and commercial impression.

As to the strength of the marks, "net" is suggestive of a computer network. Sometimes "net" refers to a network that transmits data over large distances, or a Wide Area Network (WAN), of which the Internet is the largest network in existence. Other times, "net" refers to a Local Area Network (LAN), which usually occupies only a single building or small campus. We agree with applicant that both "Maxer" and "Max" suggest the word "maximizing." Hence, although registrant's mark may be deemed to be somewhat suggestive, there is no evidence in the record that third parties have adopted or used similar terminology on the same or related goods. Hence, the du Pont factor regarding the number and nature of similar marks in use on similar goods also points toward an affirmance herein.

We turn then to a consideration of the similarity or dissimilarity and nature of the goods as described in the registration and application. While applicant argues that the respective goods "are not in any way similar" (brief p. 3), the Trademark Examining Attorney takes the position

that they are "highly related" items of computer software. The record contains dictionary definitions of computer terms, general LEXIS/NEXIS articles discussing computer software products, as well as printouts from specific Web sites discussing registrant's and applicant's goods.

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods as identified in the application with the goods as identified in the registration. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In comparing and contrasting these two types of software, we note that both are identified rather broadly. Accordingly, while applicant contends they are "not in any way similar" and the Trademark Examining Attorney finds them "highly related," we find that "computer software for use in installing and operating a multi-protocol computer network" appears on its face to be related to "operating system utility computer programs."

Given the divergence of positions between applicant and the Trademark Examining Attorney, we look more closely

at the specific nature and function of the respective computer programs.

According to the record, registrant is a developer and vendor of systems software ("operating system utility computer programs"). Its NETMAXER software determines how data moves from one processor to another within a private LAN. In late-February 1995, registrant announced:

... a bandwidth optimization product that will reduce the amount of network traffic between [Novell's] NetWare for SAA servers and mainframe applications. NetMaxer cuts LAN-to-host network traffic by storing on the client the application screens and transmitting only the parts of the screen changed during operation ... .

("LAN WORLD Briefs," Network World, March 6, 1995, p. 1).

This data stream optimization technology is targeted to customers having a mainframe computer linked to remote servers via a LAN. By greatly reducing network traffic, registrant claims the user gets faster response times, reduced telecommunications costs and a more efficient use of one's hardware.

By way of comparison with registrant's software, applicant's goods are designed for a "multi-protocol" computer network. While the goods clearly have an Internet-centric (WAN) focus, their value grows out of the fact that they are usually deployed in the context of

multiple processors connected to the customer's private LAN.<sup>3</sup>

However, applicant argues that the Trademark Examining Attorney has glossed over the sharp contrast in the nature of these two types of computer software. While the goods of registrant are operating system *utility*<sup>4</sup> programs, applicant argues that its goods are specific *application* software.<sup>5</sup> That would have us thinking of useful things like word processors, spreadsheets and relational databases.<sup>6</sup> However, applicant's screen prints, the pages drawn from the Internet and the NEXIS excerpts all indicate that applicant's software is much more like an operating

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<sup>3</sup> The Trademark Examining Attorney has submitted for the record a definition of "protocol" as "the agreed-upon format for transmitting data between two devices." A "protocol" is very similar to a human language. Just as many languages exist, many protocols also exist. This definition page goes on to identify several standard protocols from which programmers can choose, such as ATM (Asynchronous Mode Transfer), IPX (Internetwork Packet eXchange) and the Internet protocol, TCP/IP (Transmission Control Protocol/Internet Protocol). <http://webopedia.internet.com/TERMS/p/protocol.html>. Applicant's goods are designed for a "multi-protocol" computer network, namely, a network connecting devices programmed using different languages or protocols.

<sup>4</sup> Utility: A program that performs a very specific task, usually related to managing system resources. Operating systems contain a number of utilities for managing disk drives, printers and other devices. <http://webopedia.internet.com/TERMS/u/utility.html>.

<sup>5</sup> Applicant's brief, at page 2, says: "In contrast [to registrant's operating system utility programs], the goods of the Applicant are specific *application* software." (emphasis in original).

<sup>6</sup> <http://webopedia.internet.com/TERMS/u/utility.html>.

system or a collection of specific utilities than applicant would have us believe.

Specifically, applicant's "thin server" software packages run on top of the Linux open-source operating system. Applicant has created a market for its proprietary, shrink-wrap software because it conceals some of the complexities of working with Linux and overcomes Linux handicaps. The file shows that applicant offers three separate packages - *FileServer*, *FireWall* and *WebServer* - or all three rolled into one *Professional* version of the software. *FileServer* lets one share files and printers and perform backups. *FireWall* is a firewall and router package that provides a single point of access for a customer's network as well as Web browsing capabilities. Finally, the *WebServer* installs a Web, e-mail and FTP (File Transfer Protocol) server. Applicant points out that no other software is needed with its thin-server series as "each NetMAX product installs the included [Linux] operating system and all supporting software. No other software is required."<sup>7</sup>

Applicant argues that its software "does not 'manage computer resources' in the way an operating system would"

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<sup>7</sup> <http://netmax.com/products/products/html>.

(applicant's reply brief, p. 2). Yet, as seen above, the record clearly shows that applicant's software is an enhancement that adds ease and convenience to the Linux operating system software. Applicant's customers use this software to turn a PC into a "thin server." Hence, applicant is not selling application software (e.g., word processor, spreadsheet or database). Rather, it is targeting customers in need of an operating system and wanting a network that is simple to administer across multiple platforms (e.g., Windows, Macintosh and Unix).

Next, applicant contends that operating system *utility* software and application software move through different marketing channels. In addition to the fact that we find it misleading to apply these broad labels to these respective goods, there is no evidence to support this conclusion as to separate channels of trade. In the absence of any express restrictions in the registration certificate, we must assume that registrant's goods travel in all the usual channels of trade for such goods, which in this case would include at retail, through online resellers and directly from registrant. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Similarly, the record shows that applicant relies upon retail distribution, through online resellers and directly from applicant.

In determining who comprises applicant's relevant purchasers, we note that applicant is pursuing a broad market of users, but especially the small- to medium-sized businesses that may be looking for inexpensive and simplified ways to achieve an online presence. While registrant's goods are in no way restricted as to class of purchasers, the excerpt above from Network World suggests that medium-sized business all the way to the largest of enterprises would be potential customers for this product. Accordingly, we have identified a significant slice of the population - medium-sized businesses having a mainframe computer, a number of personal computers and other processors/servers connected to a LAN, who also want simple Internet access - as comprising an overlapping customer base for both applicant and registrant.

Furthermore, in considering the du Pont factor focusing on the conditions under which, and buyers to whom, sales are made, applicant's goods do not fit the extremes of impulse purchases or of highly expensive goods. In any case, there is certainly no evidence in the file that business persons falling into this category of information systems consumers are necessarily sophisticated in the high-tech field of servers, software and computer networking.

In finding a likelihood of confusion herein, we are clearly not saying that these two items of software are competitive or have any of the same functionalities. Furthermore, while the same enterprise may want the touted benefits of both of these products, we do not know if they are necessarily compatible with each other on the same computer system.<sup>8</sup> On the other hand, we are convinced that these two software packages are similar enough that if sold under these similar trademarks (NETMAXER and NETMAX), for the medium-sized business person wanting to have an efficient computer network (LAN) connected to the Internet (a WAN), the extent of potential confusion is substantial indeed.

Decision: The refusal to register is affirmed.

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<sup>8</sup> It is not clear from this record whether or not registrant's Novell NetWare-related software could be made compatible with applicant's open-source Linux based products on the same enterprise-wide system, nor is the answer to this question critical to our decision under the Lanham Act herein.