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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The ePublish.com, Inc.

Serial No. 76/110,995

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Before Hanak, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 17, 2000, The ePublish.com, Inc. (applicant)
filed an application to register the mark VOILA (in typed
form) on the Principal Register for goods ultimately
identified as "desktop publishing software" in
International Class 9.¹

¹ Serial No. 76/110,995. The application is based on an
allegation of applicant's bona fide intention to use the mark in
commerce.

The examining attorney ultimately refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark VOILA (in typed form) for goods and services in International Classes 9, 16, 35, 36, 37, 38, 40, 41, and 42.² The goods and services that are relevant to the refusal are set out below:

Computers including lap top computers; ... computer software for use as a spreadsheet for general use, customized computer software for professional use for use in database management, and computer e-commerce software to allow users to perform electronic business transactions via a global computer network, ... word processors; ... data processing and word processing computers, computer monitors and computer terminals, computer printers, computers with computer keyboards and computer monitors, ... computer hardware, namely, memory cards, blank smart cards, namely, electronic chip cards, magnetically coded electronic identification cards, integrated circuits, computer hard drives, computer disk and CD-ROM drives; computer fax modem cards; blank hard computer disks, blank CD-ROMs, and CD-ROMs featuring computer games in International Class 9

Installation, maintenance, and monitoring of ... computer, computer peripheral and devices and appliances; ... installation of computer networks in International Class 37

Computer consultation, namely, consulting with respect to choices, analysis, programming, exploitation of computers ... computer consulting services in computer organization; installation, maintenance and monitoring of computer software systems; ... computer renting/leasing of computer programs through

² Registration No. 2,464,863, issued July 3, 2001. The registration is based on a claim of ownership of French Registration No. 98/730957.

electronic and telecommunications medium; ... design of computer software for others in International Class 42.

When the refusal was made final, applicant filed an appeal.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In 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).

We start our analysis with a comparison of applicant's and registrant's marks. In this case, the marks are for the identical term VOILA in typed form. While the application does not contain a translation of the word, the registration translates the term as "here it is." The word does not appear to be anything other than an arbitrary term when it is applied to the goods and services and that it

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would be a strong mark. Therefore, this factor "weighs heavily against the applicant." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). See also Majestic Distilling, 65 USPQ2d at 1203.

The next factor we consider is whether the goods and services of the applicant and the registrant are related. We must consider the goods and services as they are described in the identification of goods and services in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). To the extent that the goods and services are not restricted in the identifications, we must consider that they move through all normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective

products travel in all normal channels of trade for those alcoholic beverages"). Furthermore, it is not necessary for the examining attorney to establish that the registrant and applicant are competitors.

[G]oods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

See also Shell Oil, 25 USPQ2d at 1689 ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source").

We agree with applicant that "simply because the goods and services in question involve software does not per se require a finding of likelihood of confusion." Brief at 3.

See In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985)

("[W]e think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace"). See also

Information Resources Inc. v. X*Press Information Services,
6 USPQ2d 1034, 1038 (TTAB 1988).

However, in the Quadram and Information Resources cases, the marks were not identical and the goods and/or services were distinct. In this case, not only are the marks identical but registrant's goods and services include a wide variety of computer-related services including leasing and rental of computer programs, designing computer software for others, and computer programming for others for processing of data and corporate text. The examining attorney points out that the programming service "is broad enough to include desktop publishing type services for corporate clients... Registrant's programming services for processing corporate text and applicant's software used for the preparation of corporate electronic brochures and catalogs demonstrate that the goods of registrant and the services of applicant may be marketed to the same class of purchasers." Brief at 6.

The examining attorney has also included evidence consisting of Internet printouts and copies of registrations to show that a company may be the source of both computer software and leasing of computer software. See www.isdweb.com (Integrated Software Design's (ISD) "current packaged software product lines include: On-

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Tap/DOS, On-Tap/VMS;" ISD services include "professional services (Knowledge ON™) incorporating customized software design"). See also www.garden-pos.com (hardware, software, and "leasing resources you need for your Garden Center Software and related technology acquisitions). Also, the examining attorney refers to third-party, use-based registrations to show that "a computer software provider may be involved with software leasing services and/or computer software programming and design." Brief at 5.

In addition to this evidence, it is also very significant that the goods and services in the cited registration are not for a single computer-related product or service. Rather the goods and services include a litany of computer goods and services including computers; laptop computers; computer software for use as a spreadsheet for general use; customized computer software for professional use for use in database management and computer e-commerce software to allow users to perform electronic business transactions via a global computer network computer; memory drives; computer hard drives; CD-ROMs featuring games; consulting with respect to choices, analysis, programming and exploitation of computers; rental/leasing of computer software; design of computer software for others; and printing services.

While applicant argues that the "goods and services represented by Registrant are markedly distinct," it also admits that they are "varied" and "numerous in comparison to the applicant's." Brief at 2. Applicant argues that its "channels of trade are found in the desktop publishing context, i.e., in small and medium office, school, organization or commercial publishing environment." Id. Applicant then tries to limit the registrant to the global telecommunications industry. However, nothing in applicant's identification of goods limits its channels to the trade to small and medium offices or any other environment. Regarding registrant's goods and services, while some goods and services are in the telecommunications industry, e.g., telephone communications services, most are not so limited and it would not be proper to read this limitation into all the other identified goods and services. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration").

Applicant also maintains that the purchases of applicant's "goods are by sophisticated purchasers who

exercise extra care with regard to purchasing such goods.” Brief at 4. It is not clear on what basis applicant maintains that its purchasers are sophisticated. The record does not support a conclusion that desktop publishing software purchasers are more sophisticated than the purchasers of other computer-related products. Almost twenty years ago, the Board held that “whatever the situation may have been a decade or a generation ago, today’s computer buyers cannot be uniformly classified as a technically adept or highly discriminating purchaser group.” In re Graphics Technology Corp., 222 USPQ 179, 181 (TTAB 1984). However, even careful purchasers can be confused when identical marks are used on desktop publishing software and registrant’s various computer goods and services. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) (“We recognize applicant’s attorney’s point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion”). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) (“While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated

purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products”).

Therefore, we hold that when purchasers encounter identical marks on applicant’s desktop publishing software and the numerous computer-related goods and services identified in the registration, they are at a minimum likely to believe that there is some relation between the source of the goods and services. Under these circumstances, confusion is likely.³

Decision: The examining attorney’s refusal to register applicant’s mark VOILA for desktop publishing software because of a prior registration for the identical mark for the identified goods and services on the ground that there would be a likelihood of confusion is affirmed.

³ While applicant’s attorney refers to a lack of actual confusion (Brief at 4), we point out that the application is an intent-to-use application. Even if applicant had used the mark (Brief at 2), the lack of actual confusion is normally not significant. See Majestic Distilling, 65 USPQ2d at 1205 (“The lack of evidence of actual confusion carries little weight”).