

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
February 26, 2008  
Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Sapien Technologies, Inc.

Serial No. 78811663

Michael J. Hughes of IPLO - Intellectual Property Law  
Offices for Sapien Technologies, Inc.

Ray Thomas, Jr., Trademark Examining Attorney, Law Office  
102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Bucher and Zervas, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Sapien Technologies, Inc. seeks registration on the  
Principal Register of the following mark:



**SAPIEN**

for goods identified in the application as "computer software development tools; computer software for creating an editor and language-independent development environment for use in writing and editing other software" in International Class 9.<sup>1</sup>

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney asserts that applicant's mark, when used in connection with applicant's recited services, so resembles the mark **SAPIENT** registered in connection with "computer consultation services; custom computer software development services" in International Class 42,<sup>2</sup> and with "computer consultation services; custom computer software design and development services for others; website design and development services for others; providing consultation on the use, integration and operation of computer software programs and the updating of computer software programs services" in

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<sup>1</sup> Application Serial No. 78811663 was filed on February 9, 2006 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

<sup>2</sup> Registration No. 2012848 issued to Sapient Corporation on October 29, 1996; renewed.

International Class 42,<sup>3</sup> as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the substantive issues. We affirm the refusal to register.

In arguing for registrability, applicant argues that there is no likelihood of confusion owing to the differences in the marks themselves, differences in the involved goods and services, and more than a dozen years of contemporaneous usage without any actual confusion within a marketplace of highly sophisticated consumers.

By contrast, the Trademark Examining Attorney contends that the marks are strikingly similar in sound, appearance, connotation and commercial impression, and that applicant's computer software development goods are very closely related to registrant's computer software design and development services.

### **LIKELIHOOD OF CONFUSION**

We turn then to a consideration of the issue of likelihood of confusion. Our determination under Section

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<sup>3</sup> Registration No. 2555676 issued to Sapient Corporation on April 2, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. *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 relationship of the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

### **The Goods and Services**

We turn first to the *du Pont* factor focusing on the relationship of the goods identified in the involved applications and the services recited in the cited registrations. The Trademark Examining Attorney contends that applicant's computer software development tools are very closely related to registrant's services inasmuch as the goods and services in question are all acquired for the common purpose of developing/designing computer software. Nowhere does the Trademark Examining Attorney resort to a *per se* rule that all computer software related goods and services are necessarily so related to each other such that there must be a likelihood of confusion from the use of similar marks in relation thereto.

However, in its reply brief, applicant emphasizes the difference between applicant's goods and registrant's services, arguing as follows:

Examining Attorney Thomas, [in] his brief, cites several cases where goods and somewhat related services were found to be grounds for finding likely confusion. However, in each of the cases cited (groceries, furniture, clothing, trucking, etc.) the consumers in question were casual and represent the general purchasing public. The present case is much different where the consumers of the goods of Applicant are very highly sophisticated and a narrow niche of the market (computer programmers).

Yet the Trademark Examining Attorney had indeed included a citation to cases involving non-casual, niche markets such as the sale and refinishing of office furniture in *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983). See also *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services);

In support of his specific contention that applicant's type of proposed computer software development tools and registrant's kind of computer consultation services, computer software development services and computer software design services are marketed and sold together

under the same mark, the Trademark Examining Attorney has made of record use-based third-party registrations demonstrating that the types of services as recited in registrant's registrations and applicant's identified goods originate with the same source. These registrations, summarized below, have probative value to the extent that they serve to suggest that the goods and services listed therein are of a kind that may emanate from a single source. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

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**MAXCORE** for "**computer software development tools** for use in the fields of digital signal processing, microcontrollers, and processors for embedded processing; computer software for use in design and integration of semiconductors, microcontrollers, processors for embedded processing, and signal processing computer hardware; computer software for simulation of digital signal processing and embedded algorithms" in International Class 9;  
"**computer consultation services** in the fields of modeling, simulation, programming and implementation of embedded control and signal processing systems and semiconductor realizations" in International Class 42;<sup>4</sup>

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<sup>4</sup> Registration No. 2573471 issued on May 28, 2002.

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**DIGITWISE**

for "computer e-commerce software to allow users to perform electronic business transactions via a global computer network; computer game software; **computer software development tools**; computer search engine software; computer software for use in database management, for use as a spreadsheet, for word processing, for desktop publishing, in a wide variety of fields, that may be downloaded from a global computer network; data compression software; website development software; **educational software featuring instruction in computer programming, computer software design and development**, website design and development" in International Class 9;<sup>5</sup>

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**ORIELLE**

for "**computer software development tools** " in International Class 9;  
"technical **consultation** and research in the field of computer science; **product research and development of new software products** for web-based, real-time and distributed systems through federally sponsored research grants; technical consultation and research in the fields of materials science and physics; scientific research in experimental semiconductor physics through federally sponsored research; product research and development; **computer consultation; computer software design** for others" in International Class 42;<sup>6</sup>

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**APPROVA**

for, *inter alia*, "computer software for use in application and database management and integration; communications software for connecting computer network users; **computer software development tools**; computer software for computer and network security; computer software for the management of access to computer and network applications and databases; computer and network monitoring software; in International Class 9;

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<sup>5</sup> Registration No. 2647220 issued on November 5, 2002.

<sup>6</sup> Registration No. 2672633 issued on January 7, 2003.

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*computer software consultation; computer consultation; computer software development and design for others; computer systems analysis; computer network design for others; integration of computer systems and networks; installation of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; technical support, namely, monitoring of network systems" in International Class 42;*<sup>7</sup>

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**GAMMASTREAM**

for "*computer software in the field of software development tools*" in International Class 9; and  
"design, creation, hosting and maintenance of websites for others; *computer software design for others*; and, application service provider services in the fields of education and photography; application service provider services in the field of customer information management" in International Class 42.<sup>8</sup>

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The Trademark Examining Attorney also submitted copies of screen shots drawn from the websites of five different software development companies. These web pages demonstrate that computer software development tools of the type proposed to be sold by applicant are often discussed together with related development services, and in fact, that computer software development professionals often use computer software development tools when providing computer software development services.

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<sup>7</sup> Registration No. 2787614 issued on November 25, 2003.

<sup>8</sup> Registration No. 3011464 issued on November 1, 2005.

SERVICES

  

### SOFTWARE DEVELOPMENT

TRILENT *software development services* support our hardware products and designs. Whether it is in the form of firmware, device drivers, system programming, or a user front-end, our software support rounds out our service offering. Our expertise in software development spans all of major operating systems and programming languages.

...

#### Languages and Tools

Our programs are written in Assembly, C, C++, and Java. We support a range of *software development tools* to ensure the best tool for each particular task.<sup>9</sup>

**Bennet-Tec Information Systems, Inc.**  
Fast, Flexible, Reliable Components for Professional Programmers

  



## Services

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### What we offer - Products & Services:

At Bennet-Tec Information Systems, we use the very latest in Industry standard development tools and technologies to provide a rich set of products and services for Windows platforms at a reasonable cost.

...

- ***Custom Software Development*** - Software specifically tailored to fit your needs. After all, computers are a productivity tool, and your business shouldn't have to accommodate the tools that you use... the tools should invariably accommodate your business. We will make your software solutions work for you, so you don't have to. Our team uses the latest in *software development tools*, and can create any type of application, be it a complex database application, client/server solution, utility, or anything you can think of. Our team programs in a variety of languages including Visual Basic (6.0 & .NET), Access, Visual C++/ANSI C, and more.<sup>10</sup>

<sup>9</sup> <http://www.trilent.net/services/swdesign.html>

<sup>10</sup> <http://www.bennet-tec.com/btcorporate/services.htm>



## Custom software development

Development of customized software is one of our company's main activity [sic]. We are specialized in creation of software projects that solve science-intensive and complex algorithmic tasks in an optimal way.

Our experience of contracting with US, Canadian, German, Swiss and other clients has helped us to understand and adopt western project management practices, and in particular how they apply to software development demands in the west. We at Amic Utilities Inc. strive hard to provide you custom software solutions that will reorient your business for new internet age. For this, we use modern software development platforms, **software development tools** as well as employ latest project management techniques and software engineering practices.

We have top class software development professionals like project managers, software engineers and programmers, testers, designers and technical writers with exclusive skill sets for this.

The company gradually introduces into practice SEI-CMM Quality Assurance principles and can duly deliver high-quality products within your budget. All software systems are properly tested and delivered with on-line help subsystems and documentation.

### We provide the following **Custom Software Development Services:**

- Application Re-Engineering
- Complex GUI design and implementation
- Business Applications
- 3D interfaces development
- Custom controls development
- Data migration between various DBMS
- Database design and development
- Distributed data processing
- Games development
- Web-development
- Information System development
- Network development
- Internet/Extranet/Intranet Solutions
- Device Drivers (for WinNT, Win2000/98/95 )
- Product/application customization and support
- Multimedia (music streaming, mp3, sound processing, graphics, animation)
- Systems Integration
- Security and Cryptography
- Localization of software products
- Software testing<sup>11</sup>

<sup>11</sup>

<http://www.amicutilities.com/software-development/>

**Soft Servo**  
SYSTEMS, INC*The Future of Motion Control Has Arrived.*

### ***Our Software Development Tools Provide Ultimate Flexibility***

Soft Servo Systems provides dynamic CNC solutions designed to meet specific industry needs. All of our products are tested extensively by end users to ensure that we achieve the highest levels of quality and innovation. Despite all the preparation that goes into our development process, we know there will always be some customers who require something different in their CNC applications. With this in mind, we have made it easy for users to create or customize their own ServoWorks applications in C/C++ and Visual Studio 6.0 for Windows 2000/XP/XPe.

Customers can program their own GUI or text-based ServoWorks application interface in one of two ways:

1. By using SWAPI, ServoWorks' extensive Motion Control APIs in the Win32 environment, provided in the form of Visual Basic, C/C++, Visual Studio .NET and Delphi. APIs are provided for complete and full access to all real-time processes and resources.
2. By modifying the source code of any ServoWorks GUI application. We offer source code in Visual Basic and C/C++ for customers to use as a basis for customizing their own ServoWorks application. This may be the most efficient way to customize an application to meet exact specific needs.

Users can create a hybrid application of C/C++ and Visual Basic to take advantage of the faster execution time of C/C++ while using Visual Basic to quickly and easily create advanced, professional-looking GUIs.

Soft Servo Systems offers **software development tools** to facilitate development of customized applications capitalizing on ServoWorks technology: the ServoWorks Simulator and the ServoWorks Development Kit (SDK). We also offer **software development services**.<sup>12</sup>

**DDC-I** Bridging the Gap in  
Embedded Software Development

### **Software Engineering Services**

At DDC-I, our job is to help you succeed. Serving the safety critical industry for over 20 years, we offer **software development tools** and custom **software development services** for real-time embedded applications. Our team of experts covers a wide range of software engineering domains with support for legacy systems developed in Fortran and JOVIAL, to modern systems developed in Embedded C++ and Ada 95. Tools include compilers, debuggers and run-time systems for Embedded C++, C, Ada 95, Ada 83 and

<sup>12</sup>

<http://www.softservo.com/DevelopmentOverview.php?catID=3&subID=6>

JOVIAL application development. We offer custom services and training to satisfy your requirements in a timely and reliable manner.<sup>13</sup>

Applicant's PrimalScript Enterprise and Professional software (see JPEG attachments to application papers) is designed to serve the "scripting community." While applicant's emphasis is clearly on the marketing and sale of International Class 9 tools, not surprisingly, part of any solution provided for software developers and IT professionals within a technology client would be applicant's offering, at the very least, on-site scripting training. Clearly, both applicant and registrant are deeply involved in Internet web design for their respective clients. The copies of third-party web pages placed into the record by the Trademark Examining Attorney show that companies using scripting tools like applicant as well as those offering services such as registrant offers rely upon some of the same Windows platform tools such as .NET, Visual Basic Script, and PowerShell. Companies like AMIC Utilities (at footnote 11, *supra*) tout their software development tools as well as "top class software development professionals like project managers, software engineers and programmers, testers, designers and technical

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<sup>13</sup> [http://www.ddci.com/products\\_engnr.php](http://www.ddci.com/products_engnr.php)

writers with exclusive skill sets for this." Similarly, companies such as registrant that provide outsourced consulting and interactive services will have their own custom software development teams working with technology clients, and they will necessarily rely upon existing proprietary software packages, including perhaps those of the kind marketed by applicant.

Accordingly, despite applicant's arguments to the contrary, we find that it has failed to rebut this *prima facie* showing that applicant's goods are related to registrant's services, and this *du Pont* factor favors a finding of likelihood of confusion.

### **The marks**

Yet another critical *du Pont* factor that the Trademark Examining Attorney and applicant discuss in their briefs involves the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we agree with applicant that the marks must be compared in their entireties under a Section 2(d) analysis, nonetheless, one feature of a mark may be recognized, based

upon quite rational reasons, as more significant in creating a commercial impression. In this context, greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J. M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987). When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); and *Amoco Oil Co. v. Amerco Inc.*, 192 USPQ 729 (TTAB 1976).

Accordingly, we do not find that the Trademark Examining Attorney has completely discounted the design element of applicant's proposed mark, but that the less significant design element cannot overcome the dominance of the literal portion, **SAPIEN**.

Obviously, the literal portions of the respective marks are identical but for the fact that registrant has a

final letter "t." We find that the literal portions of the marks are highly similar in terms of appearance; both begin with the letters S•A•P•I•E•N. The dissimilarity in appearance which results from the difference in registrant's mark's final letter is outweighed by the similarity which results from the fact that both marks begin with the same six letters. In our judgment, a consumer familiar with registrant's mark **SAPIENT**, upon seeing applicant's mark **SAPIEN**, could easily not notice the fact that the seventh letter of registrant's mark was missing and hence assume that he or she was viewing registrant's mark **SAPIENT**. This is particularly true when one takes into account that marks are not compared on a side-by-side basis. Rather, the test is whether a consumer, having seen registrant's mark and having retained but a general recollection of it, would, upon seeing applicant's mark at a later time, assume that it is registrant's mark.

In terms of pronunciation, we find that the two marks are again extremely similar even if applicant's mark is properly pronounced as having a hard "t" sound at the end. Applicant's mark sounds exactly like the cited registered mark except for the addition of the "t" sound at the end of registrant's mark, which may or not be distinctly

pronounced by purchasers inasmuch as it must be remembered, "there is no correct pronunciation of a trademark." *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). Again, it is our view that a not insignificant number of consumers might well "mispronounce" one or both of the two marks such that the resulting "mispronunciations" would be almost identical. Accordingly, this slight difference is greatly outweighed by the overall aural similarity between the marks.

In terms of connotation, applicant has cited to dictionary definitions to show that the word "sapiient" means "wise or having the capacity to reason." Furthermore, applicant argues that its mark has no meaning. However, we note that in terms of etymology, the same Latin root, "*sapiēns*," is responsible for the word "sapiient" and the word "sapiens," the second word of *Homo sapiens* (or "wise man"). While the singular form, "sapien," arguably has no dictionary meaning, we agree with the Trademark Examining Attorney that consumers will likely assume that these remarkably similar words share the same root meanings, and as a result, they create similar commercial impressions, particularly in the context of cutting-edge

software development performed, in part, by other software.<sup>14</sup>

Viewing the marks in their entireties, we find that any subtle dissimilarity between the marks in terms of connotation is outweighed by the fact that the marks look and sound essentially the same, and create quite similar commercial impressions. Hence, this *du Pont* factor too weighs in favor of a finding of likelihood of confusion.

### **Class of purchasers and Channels of trade**

As to the *du Pont* factor focusing on the channels of trade, the Internet evidence produced by the Trademark Examining Attorney supports the conclusion that these goods and services may well travel through the same channels of trade so as to be encountered by some of the same purchasers. Nonetheless, applicant argues that it sells "... highly specialized computer software directed at programmers, while ... [registrant's] services ... are directed at those who do not wish to do their own programming, but rather wish to have programming done for them ..."

Applicant's Brief, at 4 However, applicant's

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<sup>14</sup> In this overall context, arguably the overall commercial impressions of the two marks are made more similar in that applicant's imagery within its composite "Sapien" mark suggests a beam of insight (or wisdom) from an unseen mechanism, directly into the programmer's brain.

identification does not contain any limiting language about the trade channels for its goods, and we must presume that they are sold to all consumers. Furthermore, where the relevant consumer is comprised of, for example, both IT professionals and corporate executives who are not IT professionals, the standard of care when purchasing the goods and services is equal to that of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) [as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285, 60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)]. The standard of care in this likelihood of confusion analysis is equal to registrant's purchasers since they are the least sophisticated. Moreover, the fact that either applicant's or registrant's non-corporate purchasers may well be relatively sophisticated or knowledgeable in the field of computer programming does not necessarily mean that they are sophisticated or knowledgeable in the field of marks or immune from source confusion when quite similar marks are used in connection with closely-related goods and services. See *In re*

*Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Therefore, the relative computer programming savvy of some of the relevant prospective consumers does not obviate the likelihood of confusion in this case.

**Period of contemporaneous use without actual confusion.**

Turning our attention to another *du Pont* factor, applicant makes an unsupported assertion that it has not encountered any instances of actual confusion between its mark and registrant's mark despite over twelve years of contemporaneous use. While the absence of any instances of actual confusion over a significant period of time is a factor indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by the registrant under its mark. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Although the record includes a few details about applicant's use of its mark, the record is silent as to the extent of registrant's use. Thus, we are at a significant disadvantage to ascertain, with any degree of accuracy, whether there have been opportunities for

confusion to have occurred. Accordingly, this factor has not entered into our analysis as a mitigating factor.

### **Market interface between applicant and registrant**

In its reply brief, applicant argues as follows:

"It is also noted that the Examining Attorney discounts entirely the long coexistence of the marks in the marketplace, with no known instances of consumer confusion. It is implied that the only way to overcome the presumption of confusion applied by the Examining Attorney is to provide a consent agreement. Applicant disagrees that such a consent agreement is a requirement and burden to be placed upon applicants for registration, who are entitled to a fair evaluation of the circumstances. Given the positions take[n] in this matter, it is far from clear that even such a document would sway the present Examining Attorney. However, Applicant notes for the Board that Applicant has indeed attempted to contact the Registrant in the hope of obtaining such a consent, but has received no reply at all, neither positive nor negative. Applicant contests the presumption of intent on part of the Registrant to contest in *ex parte* cases and notes that a full opportunity is presented post publication if Registrant indeed has such an intent."

Applicant's reply brief at 3.

While applicant is correct in noting that registrant's explicit consent to applicant's use and registration of the involved mark is not a requirement that the United States Patent and Trademark Office can place on an applicant, our

primary reviewing court compels us to make a consent agreement into a dominant factor in our final determination of likelihood of confusion. See *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Amalgamated Bank v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270 6 USPQ2d 1305 (Fed. Cir. 1988); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *In re United Oil Mfg. Co.*, 508 F.2d 1341, 184 USPQ 490 (CCPA 1975); and *In re Superior Outdoor Display, Inc.*, 478 F.2d 1388, 178 USPQ 151 (CCPA 1973). Irrespective of the final position of the Trademark Examining Attorney, clearly, in the face of such admonitions from our reviewing court (and its predecessor), the presence of such an agreement between applicant and registrant containing valid indications that confusion was unlikely to occur in the instant case could well have been a significant determinative factor in this tribunal's decision on this *ex parte* matter.

**Conclusion:**

We find that applicant's computer software development tools are very closely related to registrant's services; that we must presume that these goods and services are sold to similar consumers through overlapping channels of trade; that the computer programming savvy of prospective

consumers will not obviate the likelihood of confusion in this case; and that under the circumstances of this case, the absence of any instances of actual confusion over a dozen year of contemporaneous usage is not a mitigating factor herein.

*Decision:* The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.