

**THIS DISPOSITION
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

8/30/00

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Opposition No. 105,324

Microsoft Corporation

v.

Cetus Software, Inc.

Before Cissel, Hanak, and McLeod,
Administrative Trademark Judges.

By the Board:

Microsoft Corporation has opposed the application of Cetus Software, Inc. to register the mark STORMWINDOWS for "computer security software, namely, software for hiding and protecting a desktop configuration from unauthorized alterations, including hiding desktop icons, preventing the saving of desktop changes, hiding menu subfolders, settings and control panel pages, disabling the running of various applications, preventing the merging of files, and preventing the addition or deletion of printers."¹ As grounds for the notice of opposition, opposer asserts, in

¹ Application Serial No. 75/106,933, filed on May 20, 1996, and reciting April 15, 1994 as the date of first use and date of first use in commerce on the goods.

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pertinent part of its amended notice of opposition,² that it is in the business of developing and marketing computer programs, computer peripherals, multimedia products and other computer-related products; that opposer has made prior use of the mark WINDOWS for computer programs and related goods; that it owns the following registrations, all for the mark WINDOWS: Registration No. 1,872,264 for "computer programs and manuals sold as a unit; namely, graphical operating environment programs for microcomputers";³ Registration No. 1,875,069 for "cartridges containing software for operating or enhancing the operation of laser printers, which cartridges are to be inserted into the printers, and accompanying software for installation in computers which communicate with the printers";⁴ and Registration No. 2,005,901 for "publications, namely user manuals, instruction guides, reference guides, newsletters,

² Opposer filed its amended notice of opposition prior to applicant's answer. A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course at any time before a responsive pleading is served. See Fed. R. Civ. P. 15(a).

³ Registration No. 1,872,264, issued January 10, 1995 with a claim of acquired distinctiveness under Trademark Act Section 2(f), reciting October 18, 1983 as a date of first use in commerce on the goods. Section 8 and Section 15 affidavits filed.

⁴ Registration No. 1,875,069, issued January 24, 1995, reciting December 30, 1992 as a date of first use in commerce on the goods. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

magazines, books about computer programs";⁵ that opposer has developed extensive good will and customer recognition through substantial sales, advertising, and promotion of goods under its WINDOWS marks; that applicant's goods are closely related to those of opposer; that applicant's goods are designed to work with those of opposer; that applicant's goods are marketed to users of opposer's goods; that applicant adopted its mark STORMWINDOWS intending that consumers would associate applicant's goods with those of opposer; that opposer's mark is famous; and that applicant's mark, when used on its goods, so resembles opposer's mark as to be likely to cause confusion, mistake or deception.

Applicant, in its answer, denies the salient allegations of the notice of opposition.

This case now comes before the Board for consideration of opposer's motion for summary judgment on the ground of priority and likelihood of confusion under Trademark Act Section 2(d). The motion is fully briefed.⁶

In support of its motion for summary judgment, opposer essentially argues there is no genuine issue of material fact that the mark STORMWINDOWS in the application at issue

⁵ Registration No. 2,005,901, issued October 8, 1996 with a claim of acquired distinctiveness under Trademark Act Section 2(f), reciting November 1985 as a date of first use in commerce.

⁶ In addition, opposer has submitted a reply brief which we have considered because it clarifies the issues. Consideration of

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includes the mark WINDOWS in opposer's pleaded registrations; that opposer made use of its mark prior to the earliest date upon which applicant may rely for purposes of priority of use; that opposer's mark WINDOWS is famous and, accordingly, is entitled to a broad scope of protection; that WINDOWS is a strong mark as a result of opposer's 8 billion dollars in sales and 700 million dollars spent in advertisements under the mark; that applicant's goods are designed specifically to work with those of opposer by providing security to opposer's operating systems; and that the goods at issue herein are available in the same channels of trade to the same classes of purchasers.

Opposer has submitted the declarations of Rob Schoeben, Director of Windows Marketing for opposer; and Robert G. Woolston, one of its attorneys. In addition, opposer has submitted printed copies of manuals, packaging, and advertisements for its WINDOWS products; status and title copies of its three pleaded registrations as well as fourteen additional registrations; opposer's first set of interrogatory nos. 5-13; applicant's responses to opposer's first set of interrogatory nos. 1-21; and computer printouts from applicant's internet web site.

reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a).

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In response to the motion for summary judgment, applicant essentially maintains that there are disputed material facts relative to the nature of its goods and their relatedness to those of opposer; the marketing channels of the respective goods; the similarity between the marks; and the resulting likelihood of customer confusion.

In support of its position, applicant has submitted printed copies of screen displays from its own, as well as third-party, internet web sites offering trial copies of applicant's goods; printed copies of product information and a license agreement available on applicant's web site concerning its goods; printed copies of screen displays that appear during installation of applicant's goods; printed copies of documentation files from applicant's goods; and printed copies of screen displays of the help files and a registration form regarding applicant's goods.

In reply, opposer essentially argues that there are no material issues in dispute regarding the fact that applicant's goods are designed and intended to be used with those of opposer; that the application at issue herein contains no limitations concerning channels of trade; that, as a result, applicant's arguments regarding the existence of a genuine issue of material fact as to the differing trade channels between the goods are without merit; and that applicant's arguments regarding lack of confusion as to the

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source of the goods raise no genuine issues of material fact.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA, supra*.

After a careful review of the record in this case, we find that there are no genuine issues of material fact and

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that opposer is entitled to judgment as a matter of law.⁷

We note that priority of use is not at issue in this proceeding inasmuch as opposer has pleaded ownership of Registration Nos. 1,872,264, 1,875,069 and 2,005,901 and introduced status and title copies thereof, and because applicant has not filed a counterclaim for cancellation of those registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

Turning to the question of likelihood of confusion, we find that there is no genuine issue of material fact for trial.

It is well established that the test for determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison, but rather whether they so resemble one another as to be likely to cause confusion. See *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). In the instant case, applicant has appropriated in its entirety opposer's WINDOWS mark. See *Philips Petroleum Company v. Jet-Aer Corporation* 157 USPQ 98 (TTAB 1968). Furthermore, because the application for STORMWINDOWS is in typed drawing form, applicant's use of the STORMWINDOWS mark is "not

⁷ As a preliminary matter, we note that there is no genuine issue as to opposer's standing. Opposer attached to its notice of opposition status and title copies of its three pleaded registrations. See 15 U.S.C. § 1063(a). See also TBMP § 303.

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limited to the mark depicted in any special form." See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Accordingly, in any likelihood of confusion analysis, we "must consider all reasonable manners in which [the word STORMWINDOWS] could be depicted." See *INB National Bank v. Metrohost*, 22 USPQ2d 1585, 1588 (TTAB 1992). Thus, applicant's typed drawing of STORMWINDOWS would, upon registration, afford applicant a scope of protection which encompasses all reasonable manners in which the word STORMWINDOWS could be depicted, including depicting the STORM portion of the mark in smaller lettering than that used for the WINDOWS portion of the mark. Moreover, in addition to its three pleaded registrations, opposer has introduced evidence that it owns a "family" of WINDOWS formative marks, and asserts that, because of the nature of applicant's mark it would be assumed by purchasers familiar with opposer's marks that the defendant's mark comprised a member of that "family". See *Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464 (TTAB 1983). Thus, while applicant argues that there are differences in the parties' marks, applicant has offered no evidence of a genuine issue of material fact as to whether the public's perception of the involved marks differ as a result thereof. In any event, the similarities between the involved marks

outweigh any differences between them in the likelihood of confusion analysis.

Turning next to the relatedness of the parties' goods, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Herein, the record reflects that applicant's computer security application software is designed and marketed specifically for use with opposer's operating system software. For example, an informational computer text file provided by applicant with copies of its goods indicates that "StormWindows [TM] for Windows 95 will allow the authorized user to add several types of protections to the desktop and system of a Windows 95 computer." (Applicant's response to motion for summary judgment, Exhibit 9). Moreover, the record reflects that applicant provides different versions of its goods for use with different versions of opposer's WINDOWS operating system software.

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(Declaration of Robert G. Woolston, Exhibit 20). As such, it is clear that the parties' goods are related and complementary in nature, likely to be encountered and used by the same classes of purchasers. We find therefore that there is no genuine issue of material fact that the goods of the parties are sufficiently related that when sold under the involved marks, confusion is likely.

We note applicant's assertions regarding both the different marketing channels for the parties' goods, and the lack of potential customer confusion due to the repeated indication of applicant as the source of the goods during their downloading, registration, and running. However, such assertions are unpersuasive given the lack of a genuine issue as to (1) opposer's priority and (2) the similarities in the parties' marks and goods.

In sum, applicant has failed to disclose any evidence that points to the existence of a genuine issue of material fact on the issue of likelihood of confusion.

We find that there are no genuine issues of material fact and that opposer is entitled to judgment as a matter of law. In view thereof, opposer's motion for summary judgment is granted, the opposition is sustained, and registration to

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application Serial No. 75/106,933 is refused.

R. F. Cissel

E. W. Hanak

L. K. McLeod
Administrative Trademark
Judges, Trademark Trial
and Appeal Board