

THIS OPINION IS  
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THE TTAB

Mailed: May 21, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Soft Solutions S.A.  
v.  
Solid Software Solutions, Inc.

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Opposition No. 91164984

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Richard Sybert and Maha Sarah of Gordon & Rees LLP for Soft  
Solutions S.A.

Solid Software Solutions, Inc., pro se.

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Before Holtzman, Walsh and Bergsman, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Solid Software Solutions, Inc., has filed an  
application to register the mark SOLID SOFTWARE SOLUTIONS (in  
standard character form) for "computer software development,  
computer software consultation, computer software design and  
programming for others" in Class 42.<sup>1</sup> The wording "Software  
Solutions" has been disclaimed.

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<sup>1</sup> Application Serial No. 78370663, filed February 19, 2004, based on an  
allegation of a bona fide intention to use the mark in commerce.

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Opposer filed a notice of opposition alleging that it is the prior user and owner of Registration No. 2926310 for the mark SOFT SOLUTIONS (in typed form) for the following goods and services:

Software related products, namely, software for retail merchandise management and decision support (in Class 9); and

Creation and development of software; product research and development; computer software consultation; technical support services, namely, troubleshooting of computer hardware and software problems; computer programming for others (in Class 42).

Opposer claims that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered mark for the above goods and services as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant filed an answer arguing the merits of the likelihood of confusion claim, and in particular the differences in the marks, but essentially denying the salient allegations in the opposition.

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on a status and title copy of its pleaded registration.

Applicant did not take any testimony or offer any other evidence in its own behalf.<sup>2</sup> Only opposer filed a brief.

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<sup>2</sup> Applicant filed a paper entitled "Rebuttal Brief" during the period assigned to applicant for taking testimony. The brief does not constitute evidence in the case, and it is untimely as a brief on the case. Accordingly, this paper has not been considered.

**Priority**

Opposer has made of record a copy of its pleaded Registration No. 2926310 for the mark SOFT SOLUTIONS showing current status of the registration and ownership in opposer.<sup>3</sup> Thus, opposer's standing has been established, and its priority with respect to the registered mark for the goods and services identified therein is not in issue.<sup>4</sup> King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

**Likelihood of confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion 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, however, two key considerations are the similarities or dissimilarities between

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<sup>3</sup> Issued February 15, 2005.

<sup>4</sup> Opposer argues in its brief that it is also the owner of an additional registration, Registration No. 1540191 for the mark SoftSolutions for "computer programs contained on magnetic media, and written instruction manuals accompanying the programs supplied as a unit." However, this registration was not pleaded in the notice of opposition, nor in any event did opposer introduce a status and title copy of the registration or otherwise attempt to properly make the registration of record. This unpleaded registration has not been considered. We also note that opposer introduced no evidence of common law use of its pleaded mark SOFT SOLUTIONS, and contrary to opposer's belief, the registration itself is evidence only of use of the mark as of the filing date of the underlying application. See Section 7(c) of the Trademark Act; and Brewski Beer Co. v. Brewski Brothers Inc., 47 USPQ2d 1281 (TTAB 1998). Therefore, opposer's unsupported arguments relating to common law use of this mark have not been considered.

the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We will focus our attention on a comparison of the marks as applied to the parties' respective services.<sup>5</sup>

Applicant's services are "computer software development, computer software consultation, computer software design and programming for others." The services identified in opposer's registration are "creation and development of software; product research and development; computer software consultation; technical support services, namely, troubleshooting of computer hardware and software problems; computer programming for others." The services in this case are, in substantial part, identical. The registration encompasses virtually all, if not all, of the services identified in the application.

In view of the directly competitive nature of the services, and because there are no restrictions as to their channels of trade or classes of purchasers, the services must be deemed to be sold in the same channels of trade and directed to the same purchasers. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000); and *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

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<sup>5</sup> If there is no likelihood of confusion between the marks as applied to the parties' services, there would be no likelihood of confusion as to opposer's less similar goods.

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We turn then to a comparison of opposer's mark SOFT SOLUTIONS with applicant's mark SOLID SOFTWARE SOLUTIONS. Opposer argues that applicant has merely added two descriptive terms, SOLID and WARE to opposer's mark, and that the resulting differences do not overcome the similarity of the marks in sound, appearance or commercial impression. Opposer contends that SOFTWARE is merely descriptive of computer software development and consultation, and is therefore entitled to little weight. In addition, opposer contends that in view of applicant's statements in its answer that applicant will provide "'Solid' or robust solutions for our customers" and that the term SOLID "refers to Applicant's services," applicant has admitted that the term SOLID is descriptive of its services and that, as a result, that word, too, is entitled to little or no weight in the analysis.

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842 (Fed. Cir. 2000). The mere fact that applicant's mark incorporates all the elements of opposer's mark does not necessarily compel a finding that the two marks are confusingly similar. See, e.g., *New England Fish Company v. The Herwin Company*, 184 USPQ 817 (CCPA 1975) ("there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product

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mark"). Instead, "each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark." *Id.* We find that the marks SOFT SOLUTIONS and SOLID SOFTWARE SOLUTIONS when considered in their entirety, are not similar in sound, appearance, meaning, or in their overall commercial impression.

The addition of other matter to one of two otherwise similar marks has been found sufficient to distinguish the marks as a whole under circumstances where: (i) there are recognizable differences in the asserted conflicting term [see, for example, *North American Corp. v. Eisenund Drahtwerk Erlau AG*, 176 USPQ 540 (TTAB 1973), *aff'd*, 182 USPQ 172 (CCPA 1974) (ERLAU ROCK-STANDARD not confusingly similar to ROCKWELL STANDARD)]; or (ii) the shared term is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services [see, for example, *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services)]; or (iii) the marks in their entirety convey significantly different meanings or commercial impressions [see, for example, *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984) (HOBO JOE'S for restaurant services, suggesting a particular individual hobo named "Joe," not confusingly similar to HUNGRY

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HOBO for restaurant services, suggesting an anonymous person of that kind in need of a meal)].

All of these circumstances are present in this case. The asserted conflicting portions of the marks are different, and this difference combined with the addition of the word SOLID in applicant's mark SOLID SOFTWARE SOLUTIONS significantly changes the meaning and commercial impression created by SOFT SOLUTIONS. We take judicial notice of the definition of the word SOLUTION as "An application of computers and software to a particular problem."<sup>6</sup> Thus, the phrase SOFTWARE SOLUTIONS, the asserted conflicting term, is descriptive of applicant's computer-related services, and although it encompasses opposer's entire mark, it constitutes only a subordinate part of applicant's mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark"). It is the additional word SOLID that is dominant in conveying the meaning and commercial impression of applicant's mark as a whole. We take judicial notice of the relevant definitions of "solid" in the context of applicant's services as meaning "RELIABLE able to be relied or depended upon" and "of a

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<sup>6</sup> *The New Penguin Dictionary of Computing* (Penguin Books 2001). The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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substantial character; not superficial, trifling, or frivolous."<sup>7</sup> Based on these definitions, applicant's mark suggests reliable and stable software solutions that customers can depend on to meet their needs.<sup>8</sup>

Opposer's mark SOFT SOLUTIONS, on the other hand, suggests almost an opposite meaning of SOLID as applied to software solutions, or at least an entirely different meaning. Opposer has offered no meaning for its mark, but we take judicial notice of the definition of "soft" in computer terms as "Temporary or changeable, as opposed to hard (permanently wired, physically fixed, or inflexible)."<sup>9</sup> Therefore, SOFT could suggest changeable or flexible solutions for software problems, a meaning which differs substantially from SOLID solutions for software problems. To the extent that the term SOFT in opposer's mark would be perceived simply as an abbreviated form of "software," the overall meaning of the mark would be descriptive as we noted

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<sup>7</sup> *Microsoft Encarta College Dictionary* (2001) and *Webster's Encyclopedic Unabridged Dictionary of the English Language* (1996), respectively.

<sup>8</sup> Applicant has disclaimed exclusive rights to "SOFTWARE SOLUTIONS" presumably because it is descriptive, and we agree that it is. Opposer, by arguing that the word SOLID is also descriptive is in effect alleging that applicant's entire mark is merely descriptive of applicant's services, which essentially constitutes an additional, and moreover, unpleaded ground for opposition. Accordingly, opposer's arguments in this regard have been given no consideration. We will assume for purposes of the likelihood of confusion analysis that the word SOLID is not merely descriptive. In any event, we find that this word only suggests a quality of the services.

<sup>9</sup> *Webster's New World™ Computer Dictionary* (2003). See also *Microsoft Computer Dictionary* (5<sup>th</sup> ed. 2002) defining "soft" as "In computing, temporary or changeable. For example, a soft error is a problem from

earlier, and the addition of SOLID would be sufficient to readily distinguish that meaning. See, e.g., *In re Merchandising Motivation, Inc.*, supra.

Furthermore, there are recognizable differences in sound and appearance between SOFTWARE SOLUTIONS and SOFT SOLUTIONS, the asserted conflicting portions of the marks, and the addition of the word SOLID to applicant's mark greatly enhances the aural and visual differences. The marks begin with two different words, and they do not have the same number of words or syllables. Applicant's mark is three words with seven syllables, and opposer's mark is two words with four syllables.

We also note that opposer's mark SOFT SOLUTIONS is suggestive, if not highly suggestive, of opposer's services, and as such it is entitled to a more limited scope of protection than an arbitrary mark. *Home Decorators, Inc. v. Ekco Products Company*, 292 F.2d 296, 130 USPQ 153 (CCPA 1961); and *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006). It is well settled that a finding of likelihood of confusion "cannot be predicated upon the presence in each mark of a weak or suggestive term when the remaining portions of those marks differ in appearance, sound and/or meaning." *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981). See also *Tektronix, Inc. v. Daktronics Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Insta-Foam Products, Inc. v. Instapak*

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which the system can recover, and a soft patch is a temporary program

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Corporation, 189 USPQ 793 (TTAB 1976) aff'd unpubl. (CCPA 1977); and Season-All Industries, Inc. v. Spring Hill Fuel Co. 152 USPQ 515 (TTAB 1966).

We find in this case that the overall differences in the marks SOLID SOFTWARE SOLUTIONS and SOFT SOLUTIONS, far outweigh their similarities.

Finally, although we have no evidence or argument on this point, we believe it is reasonable to assume that the purchasers of at least computer software consultation services would include ordinary purchasers and users of software products. In any event since the description of services is not restricted, we must construe the services as encompassing all consumers who would normally use computer software consultation services and software products. These purchasers, while perhaps not discriminating or sophisticated, would be likely to exercise some degree of care in their purchasing decisions, thereby making them less prone to confusion. However, we find that even purchasers exercising only ordinary care in the purchase of these services would be able to readily distinguish these marks.

Notwithstanding the identity of the services in this case, we conclude that the dissimilarity of the marks makes confusion unlikely.

**Decision:** The opposition is dismissed.

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fix that hold only while the program is running."