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Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sterling Software, Inc.

Serial Nos. 75/788,509;
75/788,510; 75/788,855;
75/788,856; 75/788,860;
and 75/788,861

Anita Nesser of Baker Botts L.L.P. for Sterling Software,
Inc.

Ronald L. Fairbanks, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 30, 1999, Sterling Software, Inc.
(applicant) filed six intent-to-use applications to
register the following marks (in typed form) on the
Principal Register for the following goods, all in
International Class 9:

(1) EUREKA:INTELLIGENCE

Ser Nos. 75/788,509; 75/788,510; 75/788,855; 75/788,856;
75/788,860; and 75/788,861

For: Computer software for use in connection with enterprise information portals, namely, software for personalized, browser-based, integrated searching, analyzing and creating a wide variety of reports using an organization's internal information and intelligence over computer networks. (Ser. No. 75/788,509)

(2) EUREKA:STRATEGY

For: Computer software for use in connection with enterprise information portals, namely, software for creating and managing large databases and performing calculations on, and generating a wide variety of reports from, such databases, using an organization's internal information over computer networks. (Ser. No. 75/788,510)

(3) EUREKA:ANALYST

For: Computer software for use in connection with enterprise information portals, namely, software that performs high-speed multidimensional analysis on an organization's internal information over computer networks. (Ser. No. 75/788,855)

(4) EUREKA:PORTAL

For: Computer software for use in connection with enterprise information portals, namely, software for providing a single point of network entry for accessing and viewing an organization's internal information and intelligence over computer networks. (Ser. No. 75/788,856).

(5) EUREKA:SUITE

For: Computer software for use in connection with enterprise information portals, namely, software that enables organizations to organize, manage and distribute internally and externally stored information via a global communication network. (Ser. No. 75/788,860)

(6) EUREKA:REPORTER

Ser Nos. 75/788,509; 75/788,510; 75/788,855; 75/788,856;
75/788,860; and 75/788,861

For: Computer software for use in connection with enterprise information portals, namely, software for producing production reports based on an organization's internal information over computer networks. (App. No. 75/788,861).

In each case, the Examining Attorney¹ ultimately refused to register the marks because of the following registration of the mark shown below for "software development and consulting services" in International Class 42:



The registration contains a disclaimer of the word "software" and a statement that the stippling is a feature of the mark and does not represent color. Additionally, we note that affidavits under Section 8 and 15 pertaining to this registration have been accepted and acknowledged, respectively, by the Office. 15 U.S.C. §§ 1058 and 1065.²

After the Examining Attorney made the refusals final, these appeals followed. Both applicant and the Examining Attorney filed briefs. Oral hearings were not requested.

¹ The present Examining Attorney was not the original Examining Attorney in these cases.

² Registration No. 1,913,902, issued August 22, 1995.

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75/788,860; and 75/788,861

Inasmuch as the records and the issue in all six applications are similar, we will consolidate the appeals and issue a single opinion for all marks on appeal. In this opinion, when we refer to portions of the record that are common to all the applications, we will refer to Application No. 75/788,509.

According to the Examining Attorney, "eureka" is a "unique/arbitrary term" (Examining Attorney's Br. at 9). The Examining Attorney argues that it is the dominant portion of applicant's mark, which is identical to the dominant portion of the registered mark. The Examining Attorney points out that the word "software" is disclaimed. He also maintains that the words in applicant's mark are suggestive of an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant goods, and these words do not distinguish the marks in those applications from the cited registration.

The Examining Attorney also found that the goods and services are "highly related." Examining Attorney's Br. at 9. As evidence of this relatedness, the Examining Attorney made of record numerous copies of registrations for the purpose of showing that "one mark [was] used for both the goods of computer software/computer programs and the

Ser Nos. 75/788,509; 75/788,510; 75/788,855; 75/788,856;
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services of development and/or consulting of computer software." Office Action dated December 6, 2000, p. 3 n.1. The Examining Attorney concluded that there would be a likelihood of confusion.

On the other hand, applicant argues that "there are no visual or aural similarities whatsoever between the marks, and the commercial impression engendered by each mark is substantially different." Applicant's Br. at 5. Applicant also maintains that the Examining Attorney "is straining to create a relationship between the Registrant's services and Applicant's goods, while the record (and common sense) dictate otherwise." Applicant's Br. at 7. Applicant concludes that its services "simply do not move in the same channels of trade as Applicant's goods, and they are not offered or sold to the same classes of purchasers," and it submits that the refusal should be reversed. Applicant's Br. at 11.

After considering the records and the arguments of the applicant and the Examining Attorney, the Examining Attorney's refusals to register applicant's marks for the identified goods because they would be likely to cause confusion with registrant's mark for its services are affirmed.

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