

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/438912

APPLICANT: The SCO Group, Inc.

78438912

CORRESPONDENT ADDRESS:

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: UNIX SYSTEM LABORATORIES

CORRESPONDENT'S REFERENCE/DOCKET NO: 3412.3.1

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/438912

This letter responds to applicant's communication filed on August 3, 2005.

The following requirement(s) has been satisfied and is now withdrawn: (1) disclaimer. TMEP §714.04.

For the reasons set forth below, the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), is now made FINAL with respect to U.S. Registration No(s). 1390593, 1392203, and 2241666. In addition, the following requirement(s) is now made FINAL: (1) an acceptable identification of goods and recitation of services and classification of goods and services. 37 C.F.R. §2.64(a).

2(d) Likelihood of Confusion

Registration of the proposed mark is refused again because of a likelihood of confusion with the marks in the following U.S. Registration Nos.: 1390593, 1392203, and 2241666. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.*

A likelihood of confusion determination requires a two-part analysis. First the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Comparison of the Marks

When determining whether there is a likelihood of confusion under Section 2(d), the question is not whether people will confuse the marks, but rather whether the marks will confuse the people into believing that the goods they identify emanate from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. 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 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

In this case, Applicant's mark and the Registered marks all share an identical term, UNIX. The term "UNIX" is the dominant feature of the marks. The mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR GOLD"); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b)(iii).

Therefore, the presence of the highly descriptive wording, "SYSTEM LABORATORIES," in the Applicant's mark is insufficient to overcome the likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The average purchaser of the goods or services is likely to believe that Applicant's goods or services

emanate from the same source as the goods and services under the registered “UNIX” marks. Additionally, Applicant concedes that the marks are substantially similar. Since similarity in any one of these elements is sufficient to find a likelihood of confusion, the marks are confusingly similar. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §§1207.01(b) *et seq.*

Comparison of the Goods and Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, 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 and/or services 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 Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int’l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

In this case, Applicant’s goods and services are “computer software; namely, computer operating system software, computer language compilers, and translators, computer networking software, transaction processing software; graphical user interface software; computer graphics software; computer applications software; data management software; software development tools and environments; computers and computer hardware” and “providing web services.” Registrants’ goods are “computers” and “computer programs”, and “operating system software” and “computer programs for functioning as a compiler, translator and debugger for use with computer languages; computer programs for accessing networks; transaction processing software; graphical use interface software; computer graphics software; and data management software.” Clearly, the goods are related. In fact, applicant’s identification of goods contains goods that are identical to Registrants’ goods, such as “computer software”. In addition, Applicant’s services feature the goods of the Registrant, namely, computer programs and software.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have also held that various electronic goods are sufficiently related to technology related services that a likelihood of confusion exists under Trademark Act Section 2(d), 15 U.S.C. §1052(d) when the marks at issue are otherwise identical or highly similar. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (“electronic transmission of data and documents via electronic terminals” found to be “very similar” to registrations covering facsimile machines, computers, and computer software; “conversion from one media form to another media” found to be similar to registrations covering programs for information manipulation and apparatus for data acquisition and processing); *MSI Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 655, 658 (TTAB 1983) (“computer hardware manufacturing services to the order of or specification of others” held likely to be confused with “electronic ordering systems for gathering and transmitting source data comprising a recorder-transmitter and data receiver” used in connection with identical mark); *See Communications Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 166 USPQ 353 (4th Cir. 1970), *cert. denied*, 400 U.S. 942 (1970) (COMSAT for satellite services and COMCET for computers held likely to be confused in that computers can be

used to receive data transmitted by satellites).

In further support, the Examining Attorney now attached third party registrations that show that computer software and services featuring computer software emanate from the same source under the same mark. See the attached evidence.

Applicant's Indication that the Owner of the Registrations is Part of Applicant/ Applicant's *Wella* Based Claim Insufficient

Applicant argues that all of the marks are now owned by the same entity, The SCO Group, Inc.; however, this information is not reflected in the records of the Office. While applicant has stated that an "owner of the marks has now become part of the Applicant", the applicant, however, still needs to clarify the exact nature of this legal relationship with respect to applicant's legal control. Once this is explained, applicant must then also clarify how the applicant's legal relationship with the Registrants relates to "unity of control" over "use of the respective marks" as between these entities. TMEP section 1201.07(b).

The court in *Wella* viewed "control" and "source" as inextricably linked with "source" encompassing more than a legal relationship between the entities. *In re Wella A.G.*, 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986). The key concern being, to avoid any confusion as to source regardless of the legal relationship of the parties at issue. Thus, the question is whether the specific relationship is such that the two entities constitute a "single source," so that there is no likelihood of confusion. In this regard, since the exact legal relationship between the entities is unclear, applicant should follow the guidelines under TMEP section 1201.07(b) to establish unity of control over use of the respective marks.

If appropriate, one of the following is an acceptable statement to establish a legal relationship and unity of control over the marks, if accurate:

"The SCO Group, Inc. is the sole owner of Caldera International, Inc. and X/Open Co. Ltd. and thus controls the activities and operations, including the selection, adoption and use of the trademarks and service marks." **OR**

"The SCO Group, Inc. is owner of substantially all of the stock of Caldera International, Inc. and X/Open Co. Ltd. and thus controls the activities and operations, including the selection, adoption and use of the trademarks and service mark."

As stated above, the applicant's explanation should generally be presented in an affidavit or with a declaration under 37 C.F.R. §2.20. The following is a properly worded declaration under 37 C.F.R. §2.20.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

At this point, there is a substantial likelihood that consumers will be confused as to the source of the goods and services because of the similarity of the marks and the goods and services. Therefore, the refusal under Section 2(d) is maintained and made FINAL.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following requirements.

Identification and Classification of Goods and Services

The current wording used to describe the goods needs clarification because it does not state the goods with the required specificity. As a reminder, the Applicant must specify the exact function of the software and field of use, if necessary. Applicant may adopt one or more of the following identifications of goods or services, if accurate. TMEP §1402.01:

Computer software, namely, computer operating system software, computer language compilers, and translators; computer networking software; transaction processing software; graphical user interface software; computer graphics software; computer applications software; data management software; software development tools and environments; computers and computer hardware; downloadable software for {specify the function of the programs, e.g., for use in database management, for use as a spreadsheet, for word processing, etc. and, if software is content- or field-specific, the content or field of use} in International Class 9.

Providing web services, namely, providing temporary use of on-line non<http://atlas/netacgi/> - h11<http://atlas/netacgi/> - h13-downloadable software for {specify the function of the programs, e.g., for use in database management, for use as a spreadsheet, for word processing, etc. and, if software is content- or field-specific, the field of use} in International Class 42.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

The requirement is now made FINAL as well.

Response Options

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). See 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Anne M. Farrell/

Trademark Examining Attorney

U.S. Patent and Trademark Office

Law Office 105

(571) 272-9709

anne.farrell@uspto.gov

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

TYPED DRAWING

Serial Number

75081115

Status

REGISTERED

Word Mark

TEN MINUTE TUTOR

Standard Character Mark

No

Registration Number

2222107

Date Registered

1999/02/09

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Sylvan Technology, Inc. CORPORATION OREGON 7435 S.W. 165th Place
Beaverton OREGON 97007

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
computer software for electrical engineering applications, namely,
educational software for teaching electrical engineering concepts and
skills and user manuals sold as a unit. First Use: 1996/02/25. First
Use In Commerce: 1996/02/25.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: providing
computer software that may be downloaded from a global computer
network for electrical engineering applications, namely, educational
software for teaching electrical engineering concepts and skills.
First Use: 1996/02/25. First Use In Commerce: 1996/02/25.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TUTOR" APART FROM THE
MARK AS SHOWN.

Print: Sep 12, 2005

75081115

Filing Date

1996/03/29

Examining Attorney

AXILBUND, MELVIN

Attorney of Record

Dean T. Sandow

Print: Sep 12, 2005

75159315

TYPED DRAWING

Serial Number

75159315

Status

REGISTERED

Word Mark

JAVASERVER

Standard Character Mark

No

Registration Number

2453383

Date Registered

2001/05/22

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Sun Microsystems, Inc. CORPORATION DELAWARE 901 San Antonio Road Palo Alto CALIFORNIA 94303

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: computer software, namely, server computer software and computer software for creating other computer software and instruction manuals sold therewith. First Use: 1997/06/30. First Use In Commerce: 1997/06/30.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: providing computer software, namely computer server software and computer software for creating other computer software that may be downloaded from a global computer network. First Use: 1997/06/30. First Use In Commerce: 1997/06/30.

Filing Date

1996/09/03

Examining Attorney

Print: Sep 12, 2005

75159315

TINGLEY JOHN C

Attorney of Record

SALLY M ABEL

Print: Sep 12, 2005

75161175

DESIGN MARK

Serial Number

75161175

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

ALPHAWORKS

Standard Character Mark

No

Registration Number

2166882

Date Registered

1998/06/23

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

INTERNATIONAL BUSINESS MACHINES CORPORATION CORPORATION NEW YORK Old Orchard Road Armonk NEW YORK 10504

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: computer software for downloading other computer software from a global computer network. First Use: 1996/08/21. First Use In Commerce: 1996/08/21.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: computer services, namely, providing computer software featuring application programs and operating systems that may be downloaded from a global computer network. First Use: 1996/08/21. First Use In Commerce: 1996/08/21.

Filing Date

1996/09/05

Examining Attorney

FICKES, JERI J.

Print: Sep 12, 2005

75161175

Attorney of Record
ALEXANDER TOGNINO

ALPHAWORKS

Print: Sep 12, 2005

76976015

DESIGN MARK

Serial Number

76976015

Status

REGISTERED

Word Mark

SOURCEFORGE

Standard Character Mark

No

Registration Number

2841377

Date Registered

2004/05/11

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

VA SOFTWARE CORPORATION CORPORATION DELAWARE 46939 Bayside Parkway
Fremont CALIFORNIA 94538

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Operating system software; computer software development tools;
downloadable open source operating system and applications software,
namely computer software for use in software development. First Use:
2001/11/24. First Use In Commerce: 2001/11/24.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Providing
computer software development services for others via electronic
communications networks; computer software design for others;
technical support services, namely providing troubleshooting, repairs,
and diagnosis of computer hardware and software problems via
electronic communications networks, telephone and in-person. First
Use: 2001/11/16. First Use In Commerce: 2001/11/16.

Filing Date

2000/05/04

Print: Sep 12, 2005

76976015

Examining Attorney

WINTER, ELIZABETH J.

Attorney of Record

Andrew P. Bridges

SOURCEFORGE

Print: Sep 12, 2005

78054049

TYPED DRAWING

Serial Number

78054049

Status

REGISTERED

Word Mark

OPENADAPTOR

Standard Character Mark

No

Registration Number

2841445

Date Registered

2004/05/11

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Kleinwort Benson Limited CORPORATION UNITED KINGDOM 20 Fenchurch Street London EC 3P 3DB UNITED KINGDOM

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: computer software for the integration of disparate computer systems. First Use: 2001/01/29. First Use In Commerce: 2001/01/29.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: providing computer software development services to others via a global computer network. First Use: 2001/01/29. First Use In Commerce: 2001/01/29.

Filing Date

2001/03/20

Examining Attorney

GOLDEN, BRETT J.

Attorney of Record

Malcolm B. Wittenberg