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Paper No. 11
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NTT Electronics Kabushiki Kaisha

Serial No. 75/546,159

James R. Menker of Pillsbury Winthrop LLP for NTT Electronics Kabushiki Kaisha.

Irene Williams, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Chapman, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

NTT Electronics Kabushiki Kaisha has filed an application to register the mark SUPERENC, in the stylized form shown below, for “encoders, image data compressors, MPEG-2 encoders, real-time encoders, video encoders, video compressors, video archivers; video encoder LSI (Large Scale Integrated circuit), image data compression LSI (Large Scale Integrated circuit), MPEG-2 encoder LSI (Large Scale Integrated circuit), real-time encoder LSI (Large Scale Integrated circuit), video encoder LSI (Large Scale Integrated circuit)[sic], video

compression LSI (Large Scale Integrated circuit), video archiver LSI (Large Scale Integrated circuit); single-chip encoders, multi-chip encoders.”^{1[1]}

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark ENC, which has been registered for

“wireless communication equipment, namely, CB (Civil Band) radio equipment, radio pagers and cordless telephones; marine radio equipment, namely, headphones, transmitters, receivers, amplifiers, jacks, connectors, battery packs for marine radios, and battery chargers for marine radios; semi-conductor devices, namely, integrated circuits, resistors, capacitors and electrical switches; power supply equipment, namely, batteries and electrical transformers.”^{2[2]}

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

^{1[1]} Serial No. 75/546,159, filed September 1, 1998, based on applicant’s allegation of a bona fide intention to use the mark in commerce.

^{2[2]} Registration No. 2,275,194, issued September 7, 1999, claiming a first use date and first use in commerce date of October 25, 1990.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*^{3[3]} factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the goods involved, we note that registrant's products include "semi-conductor devices, namely, integrated circuits." There is no limitation as to purpose or use of these integrated circuits. Applicant's goods cover a number of integrated circuits for specific purposes, such as a video encoder LSI or an image data compression LSI. Thus, as argued by the Examining Attorney, registrant's integrated circuits encompass the specific integrated circuits of applicant.

Applicant contends that the integrated circuits of registrant are limited to those types which fall within the ambit of semi-conductor devices. The Examining Attorney has demonstrated, however, by means of dictionary definitions that prefacing "integrated circuits" with the term "semi-conductor devices" in no way narrows the range of integrated circuits or the purposes for which they may be used. From these definitions we see that a "semiconductor

^{3[3]} *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

device” may be “a larger unit of electronic equipment comprised of chips” and that the terms “chip” and “integrated circuit” are synonymous.^{4[4]} Thus, “semiconductor device” may be used to refer to any type of electronic equipment comprised of integrated circuits and this would include the specific integrated circuits of applicant. No distinction can be drawn on this basis.

Furthermore, since there are no restrictions in the application or registration as to channels of trade, the goods of each must be assumed to travel in all the normal channels of trade for goods of this nature. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). In view of the overlap in the goods, the present channels of trade must be assumed to be the same.

Turning next to the respective marks, we are guided by the well-established principle that although marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Here the dominant portion of applicant’s mark is the term ENC, which comprises the whole of registrant’s mark. As pointed out by the Examining Attorney, the additional term SUPER is highly laudatory, with little source-indicating significance. Moreover, the stylized version in which applicant presents its mark emphasizes the separation

^{4[4]} A. Freedman, *The Computer Glossary* (8th ed.).

of the mark into two terms, ENC and SUPER. Although the additional term SUPER leads to obvious differences in appearance and sound for the marks as a whole, the overall commercial impressions are highly similar. SUPER might well be interpreted to refer to an expanded or superior line of registrant's ENC integrated circuits.

Applicant argues that the connotations of the marks are dissimilar, in that registrant's mark ENC would be viewed as an acronym for registrant's trade name, Ellen & Co., whereas in applicant's mark the term ENC would be perceived as an abbreviation for the terms "encoder" and/or "encode." There is no evidence of record, however, that ENC is a recognized acronym for Ellen & Co. Thus, there is no evidence to support any readily apparent differentiation in connotation of the two marks. There is nothing to substantiate that ENC, as used by registrant, would be viewed as other than an arbitrary mark. If used in connection with integrated circuits similar to applicant's, the reference to the encoding function of the integrated circuits could well be perceived as the same. Thus, we find no clear distinction between the marks on the basis of connotation.

Applicant further argues that the marks would be pronounced differently, in that the perception of registrant's mark as an acronym for its trade name would result in the pronunciation of the mark as the three syllables E-N-C while applicant's mark would be pronounced as one syllable ENC. In the first place, it is well recognized that there is no one correct pronunciation of a trademark. See *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); *Kabushiki*

Kaisha Hattori Seiko v. Satellite International Ltd., 29 USPQ2d 1317 (TTAB 1991).

While some purchasers may pronounce registrant's mark as the letters E-N-C, others may pronounce it as the single syllable ENC. As we have previously discussed, there is no evidence that registrant's mark would be perceived by purchasers as an acronym, and thus no clear reason for the letters E-N-C to be separately enunciated. For purposes of our analysis, we must assume that ENC in both registrant's and applicant's marks might be pronounced in the same manner.

Accordingly, on the basis of the overlapping of the integrated circuit products of registrant and applicant and the similar commercial impressions created by the marks used by registrant and applicant in connection therewith, we find that confusion is likely.

Decision: The refusal to register under Section 2(d) is affirmed.