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Paper No. 12
RLS/LG

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sonnet Technologies, Inc.

Serial No. 75/600,234

Howard J. Klein of Klein and Szekeres, LLP for Sonnet Technologies, Inc.

Tracey Cross, Trademark Examining Attorney, Law Office 103 (Mike Hamilton, Managing Attorney).

Before Simms, Walters and Drost, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Sonnet Technologies, Inc. (applicant), a California corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark CRESCENDO for computer hardware, namely computer processor performance upgrade cards.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC Section 1052(d), on the basis of Registration No.

¹ Application Serial No. 75/600,234, filed December 7, 1998, based upon allegations of use and use in commerce since December 23, 1997.

Ser. No. 75/600,234

1,344,071, issued June 25, 1985, Sections 8 and 15
affidavit accepted and received, respectively, for the mark
shown below for computer programs.

Applicant and the Examining Attorney have submitted briefs
but no oral hearing was requested.²

It is the Examining Attorney's position that confusion
is likely because the respective marks are very similar and
because registrant's computer programs and applicant's
computer processor performance upgrade cards are both
computer-related items. In this regard, it is the
Examining Attorney's position that registrant's goods are
identified broadly without limitation as to the nature,
type, channels of trade or class of purchasers, so that

² The Examining Attorney has objected to a declaration of
applicant's president submitted with applicant's appeal brief. In
this regard, Trademark Rule 2.142(d) provides, in relevant part,
that the record in an application should be complete prior to the
filing of an appeal and that the Board will ordinarily not
consider additional evidence filed by applicant or the Examining
Attorney after the appeal is filed. The rule further provides
that, after an appeal is filed, if the applicant or the Examining
Attorney desires to introduce additional evidence, the applicant
or the Examining Attorney may request the Board to suspend the
appeal and remand the application for further examination. Here,
applicant's request to suspend and remand, sought in its appeal
brief and reply brief, is untimely. In any event, consideration
of the declaration would not have altered the result we reach
herein.

registrant's goods could encompass all of the types of goods described, move in all normal channel of trade, and be available for purchase by all reasonable purchasers. The Examining Attorney has made of record a number of third-party registrations in support of her argument that the same companies make and sell both computer hardware and computer software. The Examining Attorney has also made of record evidence that the same retail entities and Web sites offer both computer hardware and computer software products. The Examining Attorney has cited a number of cases where the Board has held that confusion is likely where the respective goods were computer hardware and computer software. Finally, the Examining Attorney asks us to resolve any doubt in favor of the prior user and registrant.

Applicant, on the other hand, argues that the respective goods are dissimilar. First, applicant points out that there is no *per se* rule holding that there is always likelihood of confusion between computer hardware and computer software products bearing similar marks. With respect to the goods involved in this appeal--computer programs and computer processor performance upgrade cards--applicant argues that registrant's goods are sold to a very specific category of buyers--financial and estate planning

professionals, who are very sophisticated and knowledgeable purchasers.³ Contrasted to registrant's special purpose application software, applicant's goods are not directed to a narrow market, according to applicant. Applicant argues that vendors of computer software do not generally market computer hardware, and that customers do not expect vendors of specialized computer software to also market computer hardware such as applicant's computer processor performance upgrade cards. Accordingly, applicant maintains that purchasers encountering applicant's goods will not believe that registrant has expanded into computer hardware products. Applicant's attorney also points to the three-year period of concurrent use of the respective marks without any known instances of actual confusion.

Applicant also relies upon cases of the Board in which confusion was not found with respect to computer hardware and software products. For example, applicant quotes from *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985):

³ Applicant makes this argument because the Examining Attorney had earlier cited three registrations against applicant, including the one noted above. Those other two registrations, also held by Comdel, Inc., the owner of the cited registration, and covering the mark CRESCENDO and CRESCENDO PRO, issued for computer software to create presentations that illustrate financial, estate and gift planning consequences of financial and estate planning, including graphic, paint and animation features. The Examining Attorney, in her brief, withdrew the refusal on the basis of those two registrations, but continued refusal with respect to the '071 registration.

As a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized usage in this industry, we think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace. We note that, in the past, tendencies toward applying "per se" rules relating to likelihood of confusion in other fields have been struck down as being too inflexible and contrary to trademark law where each case must be decided based on its own facts and circumstances.

The determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the 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, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks have obvious similarities in sound, appearance and meaning. The marks only differ by the angle design appearing in registrant's mark. *See In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987)[when a mark consists of a word and design, the word portion is more likely to be remembered by purchasers and to be used in calling for the goods]. In sum, the marks, when considered

in their entireties, engender substantially similar overall commercial impressions such that, if used in connection with related goods, confusion would be likely to occur.

With respect to the goods, it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source.

In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Further, the identifications of goods in the application and the cited registration control the comparison of the goods. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)("[T]he question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be."); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, we may not consider registrant's

computer programs to be limited in the manner suggested by applicant.

When the goods are compared in light of the legal constraints cited above, we find that applicant's computer processor performance upgrade cards are related to registrant's broadly identified computer programs. For purposes of the legal analysis of likelihood of confusion herein, it is presumed that registrant's registration encompasses all goods of the nature and type identified, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); and *In re Elbaum, supra* at 640. There are no limitations in registrant's identification of goods and, thus, we must presume that registrant's software may be used in connection with computer upgrade cards. Further, we must presume that registrant's computer programs are purchased by all normal purchasers of these goods. Thus, the goods, as identified, are presumed to travel in the same or similar channels of trade and are presumed to be bought by the same classes of purchasers.

As the Examining Attorney has noted, the record here includes evidence that the same companies offer both

computer hardware and computer software under the same mark. This evidence supports the contention that purchasers, aware of registrant's software, who then encounter applicant's specific computer hardware product, are likely to believe, because of the near identity of the marks, that the goods come from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's attorney has pointed to the absence of any actual confusion between the involved marks in the time since applicant began using its mark. As a *du Pont* factor, the absence of actual confusion weighs in applicant's favor. The probative weight is very limited here, however, by the fact that there are no specifics regarding the extent of use by applicant or registrant. Thus, there is no way to assess whether there has been a meaningful opportunity for confusion to have occurred in the marketplace.

With respect to the *Quadram* case relied upon by applicant, suffice it to say that that case involved specialized and specific hardware and software products, unlike the broadly described software listed in registrant's registration.

We find that purchasers, familiar with registrant's computer programs sold under the mark CRESCENDO and design

Ser. No. 75/600,234

would be likely to believe, upon encountering applicant's computer upgrade cards offered under the nearly identical mark CRESCENDO, that the goods originated with or were somehow associated with or sponsored by the same entity.

Lastly, to the extent that there is any doubt about our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.