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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Electro-Brand, Inc.

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Serial No. 77038241

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Robert S. Beiser, of Vedder Price P.C., for Electro-Brand, Inc.

Stephen Aquila, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Walters, Zervas, and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark Judge:

Electro-Brand, Inc. filed an application to register the mark "ENCORE" in standard character format for "television sets, videocassette recorders, DVD players and recorders, CD players, MP3 players and combinations thereof," in International Class 9.<sup>1</sup> The trademark examining attorney refused registration of the marks under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles

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<sup>1</sup> Application Serial No. 77038241, filed November 7, 2006, pursuant to Section 1(b) of the Trademark Act, 15 USC §1051(b), claiming a bona fide intent to use in commerce.

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the mark shown below, registered for "electronics, namely DVD players, blank CD-ROMS for data, music and video recording, wireless modems, LAN (local area network) computer cards for connecting portable computer devices to computer networks, video graphics accelerator cards, sound cards, and computer monitors," in International Class 9,<sup>2</sup> that when used in connection with applicant's identified goods, they will be likely to cause confusion:



Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney

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<sup>2</sup> Registration No. 3127857, issued August 8, 2006, claiming first use and first use in commerce on September 1, 2004, and disclaiming the exclusive right to use "electronics" apart from the mark as shown.

filed briefs. For the reasons discussed herein, the Board affirms the final refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We consider each of the factors as to which applicant or the examining attorney presented arguments or evidence.

#### The Marks

Both applicant's and registrant's marks contain the word "ENCORE." The word "ENCORE," defined as "used to demand an additional performance,"<sup>3</sup> is arbitrary as applied

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<sup>3</sup> American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000). The Board may take judicial notice of dictionary definitions not included in the record. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.* 213 USPQ 594, 596 (TTAB 1982), *aff'd* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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to consumer electronics. Registrant has disclaimed the only other word in its mark, "ELECTRONICS." Disclaimed or descriptive matter is generally considered less dominant for purposes of finding a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1956, 224 USPQ 749, 752 (Fed. Cir. 1985) ("The precedential decisions which have stated that a descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion reflect the reality of the market place.").

Registrant's mark does contain color and a design element, which it has described as follows:

The color(s) red, black and white are claimed as a feature of the mark. The color(s) red appears in the background behind the letter "e," the color white appears in the letter "e" and in the background of the entire mark, and the color black appears in the words "encore electronics."

However, where a mark consists of words as well as a design, the words are generally dominant because the words will be used to call for or refer to the services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). This is true of applicant's mark, whose "e" design merely highlights the first letter of both words in its mark.

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when

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subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant argues that it has priority of use of the mark "ENCORE" over registrant. However, applicant may not launch what is essentially a collateral attack on the validity of the cited registration via this *ex parte* appeal. Applicant submitted portions of the application file for the cited registration and notes that applicant's prior registration for the mark "ENCORE"<sup>4</sup> for other electronic goods was initially cited as a bar to registration by the examining attorney during the

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<sup>4</sup> Registration No. 1079745 for "portable and home radios, clock radios, radio, phonograph and tape player combos, auto, home and portable cassette and 8-track recorders and players, walkie-talkies and CB transceivers" in International Class 9, issued December 20, 1977 and claiming first use and first use in commerce on March 1, 1963.

application pendency of the cited registration. In a section of its brief entitled "What is Good for the Goose is Good for the Gander," applicant argues that since the cited registration issued despite the existence of applicant's prior registration, so should applicant be allowed to register its "ENCORE" mark for the goods covered in this application.

The examining attorney objected to this evidence as being submitted for the first time in applicant's brief, in violation of Trademark Rule 2.142(d), 37 CFR Rule 2.142(d). Since applicant actually submitted the evidence in response to an office action, the objection is overruled and we consider the evidence for whatever probative value it may have. The evidence shows that, to overcome the Section 2(d) refusal, registrant argued that the design element in its mark is dominant. While registrant may indeed consider the design elements of its mark to be dominant, the evidence submitted by applicant does not show the examining attorney's reasons for allowing the cited registration to issue. Furthermore, not only are we not privy to all of the facts involved therein, but we are not bound by either applicant's position or the examining attorney's decision in that case. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Finally, applicant argues that there are third-party registered marks containing the word "ENCORE," and that therefore the cited registration is weak. We do not find

applicant's evidence to be probative of the weakness of the registered marks however. Two of the marks are for clearly unrelated goods and the other two are applicant's own registrations. Furthermore, even a weak mark is entitled to protection against registration of confusingly similar marks. See *Giant Food Inc. v. Roos and Mastacco, Inc.*, 218 USPQ 521 (TTAB 1982). The marks are substantially similar, sound the same, and are likely to give a similar commercial impression. In view of the foregoing, we find that the first *du Pont* factor weighs heavily in favor of finding a likelihood of consumer confusion.

The Goods and Channels of Trade

Preliminarily, we note that the more similar the marks at issue, the less similar the goods need to be for the Board to find a likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the goods to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Moreover, goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that

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they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The goods in the present application overlap with those in the cited registration, with both including "DVD players." So the goods are in part identical. The examining attorney also submitted evidence of third-party registrations wherein the same mark is registered for the goods identified in both the application and the cited registration. These third-party registrations serve to suggest that these goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Therefore, we find that the remaining goods listed in the application and registration are related.

Applicant argues that it targets sophisticated consumers. Applicant does not offer any evidence in support of this point, however, and, since the identifications of goods do not contain any limitations, these identical and related goods are likely to travel

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through the same trade channels and be purchased by the same classes of purchasers. Moreover, the goods are primarily electronics that are purchased by the general consumer. To the extent that the general consumer encompasses persons who are particularly knowledgeable about these electronics items, even a sophisticated consumer is not immune from source confusion. *See Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). Since the marks are substantially similar and the goods are in part identical, even a careful, sophisticated consumer is not likely to note minor trademark differences. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000). Accordingly, we find that the second, third and fourth *du Pont* factors weigh in favor of finding a likelihood of consumer confusion.

#### Balancing the Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that the marks are substantially similar; the goods are identical in part and otherwise related; and they are likely to be sold through the same channels of trade to the same classes of purchasers. Accordingly, we find a likelihood of confusion between applicant's mark and the mark in the cited registration for the identified goods.

Decision: The refusal to register is affirmed.