

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carlos O. Calderone

Serial No. 78308532

Jeffrey M. Furr, Esq., for Carlos O. Calderone.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney)

Before Seeherman, Drost and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On October 2, 2003, Carlos O. Calderone (applicant), a
citizen of Spain, applied to register the mark shown below
for goods now identified as "audio tape recorders, digital
audio tape recorders, DVD recorders and players, CD
recorders and VHS recorders" in International Class 9.¹

¹ At filing, applicant based the application on both its intent to use the mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and a foreign registration, under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). During prosecution applicant abandoned the Section 44(e) basis. At filing applicant identified its goods as "audio-visual product machines (VHS, DVD, music disc, and CD Rom)." During prosecution applicant amended the identification as indicated.



The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Reg. No. 824369, issued February 21, 1967, owned by SONY Corporation of America, for the mark VIDEO-MAT in standard-character form for "electronic apparatus comprising a video tape recorder, a monitor, and a television camera and sold as a unit (sic)" in International Class 9. The cited registration has been renewed.

The examining attorney issued a final refusal and applicant appealed. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing. We affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." 15 U.S.C. § 1052(d). To determine whether there is a likelihood of confusion, we

must consider all evidence of record bearing on the factors delineated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In addition to those factors, we will also address applicant's and the examining attorney's arguments relating to other factors.

Comparison of the Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

With regard to the marks, Applicant argues as follows:

The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect - sight, sound or meaning - will not automatically result in a finding of a likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. (citation omitted, emphasis in the original)

Applicant argues further:

There are over 900 live marks in International Class 009 which include "Video" as part of the mark. Furthermore, in Class 009 there are several registered marks which consist of the word "Videomat" with only an additional letter or two to differentiate it; these include VIDEOMATE, VIDEOMAKER and VIDEOMAX.

On the other hand, the examining attorney argues as follows:

Comparing the marks, the literal elements in both marks are similar. For instance, VIDEOMATIC and VIDEO-MAT are similar in sound, spelling and connotation. In addition, both marks contain eight identical letters that appear in the same order.

The examining attorney also argues that the word portion of applicant's mark, as opposed to the design element, "is controlling in determining likelihood of confusion in this instance." (citation omitted)

At the outset we note that applicant refers to third-party registrations for the first time in his brief. He did not submit any records in support of his statements. The examining attorney objects to this "evidence" and points out that Trademark Rule 2.142(d) specifies that, "The record in an application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed by the appellant or the examining attorney after the appeal is filed." 37 C.F.R. § 2.142(d). In this case no evidence has been filed in an acceptable form. See In re

Volvo Cars of North America Inc., 46 USPQ2d 1455, 1456 n.2 (TTAB 1998) and other authorities cited in TBMP § 1208.02 (2d ed. rev. 2004). In the absence of any properly submitted evidence of third-party registrations, we have not considered applicant's representations regarding such registrations.²

Turning to the marks, we agree with the examining attorney's conclusion that the literal elements of applicant's mark and the registered mark are similar in appearance, sound, connotation and commercial impression. The letter string "V I D E O M A T" begins each of the marks. It is the entirety of the registered mark; applicant's mark merely adds "IC" to the registered mark. This addition is commonly used merely to change the syntax of a term, and here it does not alter either the appearance, sound, connotation or commercial impression of the registered mark to any significant degree. Consequently "VIDEOMAT" is the beginning and dominant element in both marks. In this case, as in many others, the first part of the mark is most important in evaluating similarity. Palm Bay Imports, Inc. v. Veuve Clicquot, 73 USPQ2d at 1690. See also Presto Products v. Nice-Pak

² Had we considered applicant's "evidence" we would find it unpersuasive.

Products, 9 USPQ2d 1895, 1897 (TTAB 1998) ("It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

We likewise agree with the examining attorney's conclusion that the design element in applicant's mark does nothing to diminish the similarity of the marks. The literal element in applicant's mark, VIDEOMATIC, dominates in spite of the presence of a design element. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Furthermore, the specific display employed in the literal portion of applicant's mark cannot distinguish the marks because the registered mark is in standard-character form, affording the registrant protection for its mark in any reasonable manner of display, including in the lettering used in applicant's mark. In re Melville, 18 USPQ2d 1386, 1387-88 (TTAB 1991). While we are obligated to view the marks overall, and we have, it is appropriate to consider the relative impact of distinct elements within a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985).

In this case, we conclude that the marks of applicant and registrant are highly similar in appearance, sound, connotation and commercial impression when viewed overall.

The Goods, Channels of Trade and Sophistication of
Purchasers

Applicant essentially combines arguments which address factors relating to the goods, the channels of trade and the sophistication of the purchasers.

With respect to the goods, applicant argues:

Applicant has performed an online search (both general and of the products associated with the owner of U.S. Registration Number 0824369) to find the goods associated with U.S. Registration Number 0824369 in order to compare the goods with the goods associated with Applicant's mark, but Applicant could not find any reference to the mark associated with Registration Number 0824369 on any Internet sites. Applicant's goods are units which are sold to business owners, rather than the typical machines found in the average consumer's home. Applicant's goods are a machine with a totally modular structure, allowing each owner to select a configuration specifically designed to meet his/her needs. These units allow a business owner to record advertising spots, trailers, film covers, etc. with high quality image and sound, to reach the business owner's customers with the greatest efficiency.

Applicant states further:

Applicant's goods are sold to professionals in order to be integrated in their business, or sold to professionals that create new businesses with Applicant's goods. These units are available in several different models with several different options, are approximately the same size as a bank's automatic teller machine (with some models being larger), and are rather expensive. These units are not units which would be purchased by the general public nor are they units which would be purchased as an 'impulse' buy, but rather would be purchased after a thorough review of the options and models available in consideration with the needs of the professional and his/her business.

On the other hand, the examining attorney argues, ". . . the marks of both the applicant and registrant, as identified in the application and registration, identify goods that appear to serve an identical function, recording. As the application also reveals, video recorders, as well as audio tape recorders and DVD recorders emanate from the same source under the same mark." The examining attorney also argues that the protection afforded by the registration extends to products within the registrant's logical zone of expansion.

Once again we must begin by addressing applicant's reference to Internet searches he conducted. Here also, applicant refers to this for the first time in his brief, and applicant has not provided any documentation related to these searches. Again, the examining attorney has objected to this evidence. Here too, the evidence is both untimely and not in proper form. Accordingly, we have not considered it. See 37 C.F.R. § 2.142(d); In re Trans Continental Records Inc., 62 USPQ 1541 (TTAB 2002) and other authorities cited in TBMP § 1207.01 et seq. (2d ed. rev. 2004).

In any event, in considering the goods, we must consider the goods as identified in the application and

registrations and, in the absence of any restrictions, assume that the goods travel in all trade channels appropriate for such goods. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Applicant identifies his goods as "audio tape recorders, digital audio tape recorders, DVD recorders and players, CD recorders and VHS recorders." The cited registration covers "electronic apparatus comprising a video tape recorder, a monitor, and a television camera and sold as a unit (sic)." Applicant's goods include "VHS recorders" which appear to fall within the broader term "video recorders" included in the registration.

Furthermore, the examining attorney's point is well taken, that is, the goods of applicant and registrant perform identical functions, recording. While it appears that the registrant's goods are sold as a multi-component package, the fact remains that applicant's goods, as identified, can fulfill the same function as specific components within that package, and therefore, may be interchangeable with specific goods identified in the registration. Thus, a consumer familiar with the registrant's use of its mark on its goods, who may then see applicant's highly similar mark on a component of the

goods registrant sells as a unit, is likely to assume the registrant is selling the component separately.

Applicant also argues that the technology employed in his products was not available in 1967 when the registration issued. Whatever technology might have been used in registrant's goods at that time, the registration does not limit registrant's rights to specific technology. Thus, it is possible that the goods registrant now sells under its mark employ technology similar to that used by applicant. In any event, whether or not applicant's goods employ technology which did not exist at the time the cited registration issued, because applicant's and registrant's goods perform the same or similar functions, they are overlapping or closely related.

It is not necessary to invoke the "zone of expansion" doctrine, as the examining attorney suggests, in this case to reach this conclusion. Applicant's goods are, at least in part, of the same type and description as those of the registrant. Thus, we need not conclude that relevant purchasers of registrant's goods are likely to believe that registrant has expanded its goods to include goods of a different type that are similar to the goods identified in applicant's application.

Applicant devotes much of his argument to a discussion of the restricted trade channels for his goods, that is, the fact that the goods would be sold to businesses or professionals who are sophisticated consumers, and the fact that his goods are "rather expensive."³ However, neither the application nor the registration at issue here include any restrictions as to the channels of trade. Accordingly, we cannot take into account the asserted limitations in the actual trade channels of applicant. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986)(extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected). We must assume that applicant's "audio tape recorders, digital audio tape recorders, DVD recorders and players, CD recorders and VHS recorders" and registrant's "electronic apparatus comprising a video tape recorder, a monitor, and a television camera and sold as a unit (sic)" would travel in all normal trade channels for such products and reach all potential purchasers of such products. Applicant's goods, in particular, audio and video tape recorders and DVD players, are clearly items that the general public would

³ Applicant has not indicated what he means by "rather expensive." In the final analysis it would not be relevant because we must confine our consideration to the nature of the goods, including cost, as identified in the application.

purchase and use. While registrant's identified apparatus appears to be designed for people with a more serious interest in video taping, consumers for this product too would include the general public. Therefore, we conclude that applicant's goods and registrant's goods could travel through the same trade channels and could reach the same purchasers.

Even if we were to assume that applicant's customers were limited to businesses and professionals, as applicant argues, we must assume that these same individuals are potential purchasers of registrant's goods. Furthermore, even sophisticated purchasers such as those identified by applicant are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

Here, because of the strong similarity of the marks and the relatedness/overlapping nature of the goods, sophisticated and careful purchasers, if they notice the difference in the marks at all, are still likely to view the products as emanating from the same source. Accordingly, we conclude that the sophistication of relevant purchasers does not diminish the likelihood of confusion in this case.

Actual Confusion

Applicant also argues that there has been no actual confusion: "The Applicant has been using the VIDEOMATIC

mark for the past several years throughout the world without any actual confusion between its mark and the mark in U.S. Registration number 0824369." Applicant also argues that he has registered his mark in several other countries. First, neither use nor registration of applicant's mark outside the United States is relevant for purposes of our determination. Applicant has neither alleged in his application nor argued that he has used his mark in the United States. Therefore, there is no evidence that there has been an opportunity for actual confusion. Furthermore, particularly in an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Therefore, we find applicant's argument regarding actual confusion unpersuasive.

In conclusion, after considering all evidence of record bearing on the du Pont factors, we conclude that there is a likelihood of confusion in this case. We conclude so principally because the marks of applicant and registrant are highly similar and because the goods of applicant and registrant are overlapping or closely related.

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Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed.