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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NeoPhotonics Corporation

Serial No. 78331853

Irene Eckert and Kyle T. Peterson of Patterson, Thuente, Skaar & Christensen for NeoPhotonics Corporation.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hohein, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

NeoPhotonics Corporation is the owner of an application to register the mark "NEO" on the Principal Register in standard character form for "optical network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks" in International Class 9.[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

[1] Ser. No. 78331853, filed on November 22, 2003, which is based on an allegation of a bona fide intention to use such mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "NEO," which is registered on the Principal Register by the same registrant in standard character form[2] and in the stylized format reproduced below[3]

NEO

for, in each instance, the following goods in International Class 9, as to be likely to cause confusion, or to cause mistake, or to deceive:

> television, video and audio signal processing, switching and generating equipment, namely, frame synchronizers, audio synchronizers, audio delays, audio embedders/deembedders, audio processors, logo generators and inserters, syncgenerators and inserters, time code generators and inserters, video and audio distribution and processing amplifiers, analog to digital converters, digital to analog converters, color encoders and decoders, clock system drivers, clock displays, automation system comprising computer hardware and software for controlling, monitoring, adjusting, optimizing or operating the aforesaid goods, and broadcast facilities; video and audio noise reducers, video and audio compression systems, namely[,] computer software, hardware and multi-rate coder-decoders, codecs, for decreasing audio, video, television, or data file size or transmission bandwidth and decoding or decompressing compressed content to substantially restore the original audio, video, television or data content; test and reference generators, format converters, converters of standard television and video signals to and from high definition formats, aspect ratio converters, closed caption and other ancillary data

[2] Reg. No. 3,081,094, issued on April 18, 2006, which sets forth a date of first use anywhere and in commerce of April 21, 2001.

[3] Reg. No. 3,081,095, issued on April 18, 2006, which sets forth a date of first use anywhere and in commerce of June 26, 1992; renewed.

> processing equipment, namely, computer hardware, software, and electronic equipment for the insertion, deletion, and/or modification of ancillary data associated with video, audio, or television content; multiplexers, embedders, deembedders and demultiplexers, routers, switchers and switching routers, equipment enclosures, remote control panels, and computer software for controlling and monitoring the aforesaid goods, all for industrial use.

Applicant has appealed and briefs have been filed.[4] We reverse the refusal to register.

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[4] Referring, in its initial brief, to the statement in its request for reconsideration of the final refusal that "[l]ists of distributors and outlets ... can be found on the Registrant's and Appellant's web sites," applicant adds in its initial brief that, "[n]evertheless, the lists of distributors and outlets for Registrant's goods (Exhibit A) and Appellant's goods (Exhibit B) are attached hereto." While the Examining Attorney, in denying the request for reconsideration, made no mention of either applicant's reference to lists of distributors and outlets or the websites on which such allegedly could be found, in his brief the Examining Attorney has objected to consideration of applicant's Exhibits A and B on the basis that such evidence is untimely under Trademark Rule 2.142(d) because it was not submitted prior to the filing of the appeal. Although applicant, in its reply brief, contends that such evidence was made of record with its request for reconsideration because it had "directed the Examining Attorney to the web sites of the Registrant and the Appellant with respect to the lists of distributors and outlets, we sustain the Examining Attorney's objection to the printed lists furnished with applicant's initial brief. As stated in In re Planalytics Inc., 70 USPQ2d 1454, 1457 (TTAB 2004), "[a] mere reference to a website does not make the information of record," the Board pointing out, among other things, that:

> Regarding website information, it is important that the party actually print out the relevant information and [timely] supply it to the examining attorney for several reasons. First, applicant, by referring the examining attorney to its website, acknowledges that there is relevant information on its website. It is applicant's responsibility to provide the information to the examining attorney. Websites often contain voluminous information and links to other websites. ... [T]he applicant [is] to provide information, not simply to send the examining attorney on a scavenger hunt through a website in search of relevant information.
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> In addition, ... [i]nformation on websites is transitory and subject to change at any time at the owner's discretion. .... If applicant intended to put the relevant portions of the website in the record, it is not clear what

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.[5] See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as

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> is in the record. If applicant's ... [action] were to be considered sufficient, it would raise an issue as to what a reviewing tribunal is allowed to consider. Would we be permitted to consider any information on the website regardless of when it was posted?
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> Finally, while we cast no aspersions on applicant's intentions in this case, we observe that applicant's ... [action] is fraught with potential for abuse. In effect, an applicant can deflect the examining attorney from information it has in its possession by simply referring the examining attorney to its website. An applicant controls its own website. To the extent that there is information on the website that is harmful to its claim of registrability, applicant has time to remove that information before it responds to the examining attorney's requirement for information. Second, as discussed above, websites are transitory, and it is not clear what information is on the website at any given time.

70 USPQ2d at 1458.

[5] The court, in particular, pointed out that: "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." 192 USPQ at 29.

applicant's mark and registrant's mark are identical[6] in all respects,[7] the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective goods, along with the related factors of the similarity or dissimilarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made, i.e. "impulse" versus careful, sophisticated purchasing.

As the Examining Attorney properly notes in his brief, where the marks at issue are identical, as is the case herein, "the relationship between the [respective] goods ... need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks," citing In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001); Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981); and TMEP Section 1207.01(a) (5th ed. 2007). Thus, as the Examining Attorney also accurately observes, while it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion, it is still the case that the goods must be related in some manner

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[6] Because applicant's mark is in standard character form (which was formerly known as typed form), it includes any reasonable manner of display thereof, including the stylized format utilized by registrant. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in standard character or typed format is not limited to the depiction thereof in any special form]; and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"].

[7] Applicant, as the Examining Attorney accurately observes in his brief, "does not contest that its mark is identical to the registered marks."

and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

The Examining Attorney, in this regard, maintains that applicant's goods are "sufficiently related" to registrant's goods because, as evidenced by copies of the excerpts he has made of record from "several websites showing that the same fiber optic networks can be used both for communication services and television broadcast" services, it is the case that "applicant's goods that are used in optic[al] communication[s] networks may also be used for television signal processing." Specifically, the Examining Attorney has introduced pages from the "Verizon" website advertising that its "Verizon FiOS TV" is "[p]owered by the most advanced fiber-optic network straight to your home" and that such network also includes "FiOS Internet" service; that the "Comcast" website offers "BUNDLED PACKAGES" of "DIGITAL CABLE" television services, "HIGH-SPEED INTERNET" services and "DIGITAL VOICE" services; and that the "SureWest" website likewise touts "bundled offerings [which] include an array of advanced digital TV, high-speed Internet, local and long-distance telephone, and wireless services" over its "fiber optic network." Moreover,

absent the evidence attached to applicant's initial brief, the Examining Attorney insists that "there is nothing in the record that supports applicant's contention that its goods are in separate channels of trade from the registrant's goods."

Furthermore, the Examining Attorney contends that even if the respective purchasers of applicant's and registrant's goods were the same or similar and were also considered to be sophisticated purchasers in view of the highly technical nature of the respective goods, the fact that customers for such goods are knowledgeable in a particular field does not necessarily mean that they are sophisticated or discriminating in the field of trademarks or immune from source confusion, citing In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Finally, the Examining Attorney asserts that he has "provided evidence that the communications industry and ... television broadcasting services are highly related." According to the Examining Attorney:

> The evidence [of record] shows that the [respective] goods are in the same channels of trade because it shows the purchasers of applicant's goods are the same purchasers of registrant's goods. These websites shows [sic] the class of purchasers for both applicant's goods and the registrant's goods. Companies such as Comcast®, Verizon® and Surewest® will purchase applicant's optical network components to build the infrastructure to provide the broadcast services that ... [they] will provide with the registrant's goods.

It is well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and the cited registration.

See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). However, even though the marks at issue at identical, it is still the case that where, as here, the respective goods on their face are distinctly different, it is incumbent upon the Examining Attorney to present evidence showing that there is at least a viable commercial relationship between the respective goods in order to establish that contemporaneous use of the marks at issue would be likely to cause confusion. See, e.g., In re Opus One Inc., supra, *citing* In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689-91 (Fed. Cir. 1993). We agree with applicant that, in this instance, the Examining Attorney has failed to meet his burden of proof.

Applicant, by way of background, asserts in its initial brief that, as to the respective goods, it is the case that (italics in original):

> Registrant's goods (hardware) are used in association with processing, switching and generating television, video and audio signals. The products, as noted in the identification of goods, are electronics that are generally used in the production of television and video programming, such as electronic devices used to synchronize audio with the appropriate video/picture frame (frame synchronizers). The goods associated

with Registrant's mark are not the signals themselves; provision of television and radio programmes [sic] belongs to International Class 041. As noted in Registrant's identification of goods, Registrant's goods can be used to create and insert a logo in the programming (log generators and inserter), to generate time codes and insert the time codes (time code generators and inserters), to convert standard television and video signals to and from high definition formats (format converters) and to convert an aspect ratio picture to another aspect ratio picture (aspect ratio converter).

Registrant's goods are generally used in broadcast production and post production facilities, for example, news control rooms where news programs are created, including inserting pre-recorded video. These facilities require Registrant's analog to digital converters and digital to analog converters to produce their products. These facilities actually make the programming, and are not merely distributors of programming. As noted above, the goods/equipment associated with Registrant's mark is used to synchronize frames of video with audio, to generate and insert logos for placement on programming (e.g. NBC peacock), and includes video and audio compression systems, and closed caption processing equipment, for example. Registrant provides its products to create a fully integrated environment for the streamlined production and processing of content in professional television program production and video program operations. The Registrant's goods are not associated with optical network components.

Appellant's mark is associated with *optical* network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks. ... Appellant's goods are intended for use in fiber optic networks (infrared wavelengths, waveguides, transport of information). It is noteworthy that Appellant's goods are *optical* network components, that is, components associated with *optical* fibers, as indicated in the identification of goods' use of the term "*optical*." Hence, it is understood since the goods are all associated with an

> *optical* network, that the components would all be optically-oriented, for example, the splitter would likely be a beam splitter, because the splitter is associated with an *optical* network.
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> Applicant's goods are utilized in communications networks, such as computer and communications networking, using optical fibers. Applications include fiber optic connections to homes and buildings linking computers, and high speed Internet connections. Appellant's goods are based upon light technology. Hence, the goods associated with the two marks are very different, are based on different technology, and are used for very different applications and purposes.

In view thereof, applicant persuasively argues in its initial brief that there simply is not a viable commercial relationship between the goods at issue (italics in original):

> As discussed above, Registrant's goods of television, video and audio signal processing, switching, and generating equipment, as well as the other goods listed in the identification of goods, are distinct as compared to Appellant's goods of *optical network components*, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters. The products associated with Registrant's mark do not compete with the goods associated with Appellant's mark. The nature of the products is also distinct, with Registrant's good (hardware) generally used in the production of programming, as compared to Appellant's goods (*optical* components) generally used in communications networks. These factors weigh against a finding of a likelihood of confusion.

We also concur with applicant's assertion that, in light of the differences apparent from the goods on their face and the lack of any evidence to the contrary from the Examining Attorney, the respective goods would be marketed and sold in different channels

of trade to different customers. Specifically, as applicant contends in its initial brief:

> The channels of trade for the goods associated with Registrant's marks and Appellant's mark are distinct. The channels of trade are distinct, to a large extent, because the goods are distinct. Registrant's goods are sold through specialty outlets. The specialty outlets include professional post resellers, broadcast resellers, videotek [sic] resellers, and system integrators. These specialty outlets may provide an integrated system (e.g. a digital master control panel for a television station) that incorporates the Registrant's products or may make equipment recommendations or sales that include Registrant's products.
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> Applicant's goods are sold through specialty distributors to the communications market. ....
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> The distinct nature of the channels of trade for the goods associated with Registrant's goods, as compared to the channels of trade associated with Appellant's goods, works against finding a likelihood of confusion.

Again, the Examining Attorney has offered no evidence to suggest to the contrary.

Additionally, applicant points out in its initial brief that the actual and prospective purchasers for the respective goods are dissimilar. In particular, applicant maintains that (italics in original):

> The purchasers of the products associated with the Registrant's marks are distinct from the purchasers of the goods associated with the Appellant's mark. The purchaser's [sic] of the goods associated with the Registrant's mark are, for example, television studios (programming production facilities), professional video facilities involved in post production, editing, and so on, and businesses supplying systems (e.g., system integrators) to facilities such as

> corporations (e.g. for a media room) and television stations. Here, the purchasers would exhibit a high degree of care in purchasing the goods because, for example, the goods must be fit for the purpose (e.g. as part of a post-production system for synchronizing audio with the video; converting an aspect ration picture to another aspect ration picture; providing closed captioning), and must be compatible with the equipment already in place. Hence, if the facility does not have the expertise, then a system integrator may be involved in recommending equipment and assisting the television studio, video post-production studio, or other such facility, in the purchase of the proper equipment. In either case, with assistance or not, the purchaser of Registrant's goods is one knowledgeable in the goods and a sophisticated purchaser.
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> Further, the cost associated with the Registrant's goods would be relatively expensive. It is important to note that the Registrant's goods are directed to industrial use, not the home consumer, and hence the goods are directed to the professional user and not the home amateur. Thus, great care would be taken in making the purchase, at least due to considerations of cost, fitness for use, and compatibility with the other components in a production system.
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> Purchasers of Appellant's good are generally in the communications industry using the products (e.g. *optical* components), for example, to network computers or create high speed Internet connections with computers. Here, too, the purchasers would exhibit a high degree of care ... to ensure that the product is capable of performing the desired function, as expected. The cost of the product and the network it may be part of may be reasonably expensive, and "down time" may be even more expensive.

As is readily apparent from applicant's arguments, its goods and those of registrant are distinctly different products which would be marketed through specifically different channels of trade to different classes of highly sophisticated purchasers.

In consequence thereof, it is highly unlikely that the respective goods would be encountered by the same purchasers under circumstances which could give rise to the mistaken belief that such goods originate from a common source, notwithstanding the identity of the marks at issue. We agree instead with applicant that the evidence furnished by the Examining Attorney fails to substantiate his contentions that "the communications industry and ... television broadcasting services are highly related" and that, in particular, the respective goods "are in the same channels of trade because ... [such evidence] shows the purchasers of applicant's goods are the same purchasers of registrant's goods" in that "[c]ompanies such as Comcast®, Verizon® and Surewest® will purchase applicant's optical network components to build the infrastructure to provide the broadcast services that ... [they] will provide with the registrant's goods."

Specifically, while applicant concedes in its reply brief that the previously mentioned pages from the "Verizon," "Comcast" and "SureWest" websites "may show use of a fiber optic network for *delivering* television signals and providing access to the Internet, for example," applicant also accurately observes that "the website printouts do not show use of Appellant's products for television signal *processing*" (italics in original). Thus, as applicant notes, "a fiber optic network may carry television signals, for example, to a home, but [it] does not *process* television signals" (italics in original). Applicant's goods, therefore, find applications which "include fiber optic connections to homes and buildings linking computers, and high

speed Internet connections," serving "as a conduit facilitating passage and delivery of these signals." By contrast, registrant's goods, as applicant observes in its reply brief, "focus more on television signal processing" and, as previously mentioned, "are used in professional video facilities involved in post-production, editing, and so on; in newsroom control rooms, and generally in the *production* of television and video programming, not in *distribution* of television programming" (italics in original). As a consequence of the fact that applicant's goods pertain to optical components for communications networks while registrant's goods relate to television signal processing, applicant persuasively points out in its reply brief that:

> As such, potential purchasers of Appellant's goods would likely be companies in the field of communications who are concerned with communication transmission (i.e. Comcast®, Verizon® and Surewest®) whereas potential purchasers of Registrant's goods would likely be involved in television production and editing (NBC, Worldwide Pants Incorporated). Further, the Examining Attorney has not shown that companies such as Comcast®, Verizon® and Surewest® use ... or require equipment like registrant's goods to provide television programs .... Consequently, the Examining Attorney has not shown that the purchasers of Appellant's goods are the same purchasers of Registrant's goods.

Similarly, while the Examining Attorney also made of record pages from the websites of Ram Electronics, NexTag and Communications & Energy Corporation illustrating various products used with audio/video, cable television and satellite television systems such as diplexers, antennas, multiswitches, signal splitters, RF splitters, modulators, amplifiers and filters, and

cables and F-connectors, applicant accurately observes in its initial brief that the goods shown "are made of coaxial cable or are for use with coaxial cable" and that "[n]owhere in the supplied pages are *optical fibers* noted or *optical network components* (italics in original). Thus, "the supplied pages do not address Appellant's goods" and hence fail to demonstrate any relationship thereof to goods like those of registrant.

It accordingly appears, as set forth by applicant in its initial brief, that as to the evidence which is properly of record, the Examining Attorney "has misunderstood the nature of the Registrant's goods and Appellant's goods, and their respective uses." In particular, applicant tellingly notes that (underlining and italics in original):

> The Examining Attorney appears to have mistaken the provision of <u>services</u>, such as television program distribution to the home and Internet connection to the home, with Registrant's and Appellant's *goods*. .... For example, the Comcast® web page ... shows that Comcast® offers cable television services, i.e., is a television program distributor, (which is distinct as compared to creating television programming and requiring Registrant's goods, such as a logo generator and inserter or an audio synchronizer). Further, companies may provide cable television services (that is, distribute television programming to the home), telephone service (to the home), and Internet connection (to the home). However, it is the <u>services</u> that may travel through similar channels of trade (through "the cable guy" and coaxial cable). This provision of services is distinct as compared to Registrant's and Appellant's goods, which each travel through different channels of trade.

Finally, even if the record contained evidence demonstrating that those who create television programming and/or

audio/video content, and hence would be likely to utilize registrant's goods in connection therewith, also maintain their own optical communications network, and thus would be likely to use applicant's goods as components thereof, it would still be the case, as set forth in, for instance, Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983), that in order for a likelihood of confusion to exist, "it must be based on confusion of some relevant person; i.e., a customer or user, and there is always less likelihood of confusion where goods are ... purchased and used by highly specialized individuals after careful consideration." Here, it is manifest that none of the goods at issue are consumer items which would require the exercise only of ordinary care in their procurement. Instead, the commercial and industrial products at issue on their face are not only distinctly different goods sold for specifically different purposes, but they clearly would be bought only by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation rather than on impulse. As our principal reviewing court has pointed out, such "sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care." Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

We accordingly conclude on this record that in the absence of a showing of a viable commercial relationship between applicant's and registrant's goods, the contemporaneous use by

applicant of its "NEO" mark in connection with "optical network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks," would not be likely to cause confusion with registrant's use of the identical mark "NEO," in either standard character or stylized form, in connection with various items of "television, video and audio signal processing, switching and generating equipment ... for industrial use."

Decision: The refusal under Section 2(d) is reversed.