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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rugged Outdoor Computing, L.L.C.

Serial No. 78335027

H. Roy Berkenstock of Wyatt, Tarrant & Combs for Rugged
Outdoor Computing, L.L.C.

Rebecca Smith, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Holtzman and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Rugged Outdoor Computing
L.L.C. to register the mark ENDURO for "computers, namely,
portable personal computers."¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, if applied to applicant's goods, would so

¹ Application Serial No. 78335027, filed December 2, 2003, based
on an allegation of a bona fide intention to use the mark in
commerce.

resemble the previously registered marks ENDURA² and ENDURA and design³ shown below



both for "semiconductors; semiconductor devices, namely, power regulating integrated circuits for personal computers, file servers, and portable personal computer appliances; integrated circuits; electrical and electronic devices and components, namely, power regulating integrated circuits for personal computers, file servers, and portable personal computer appliances," as to be likely to cause confusion.⁴ The cited registrations are owned by the same entity.

When the refusals to register were made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant acknowledges that there is "admittedly a

² Registration No. 2789174, issued December 2, 2003.

³ Registration No. 2789177, issued December 2, 2003.

⁴ The cited registrations also cover "information services, namely providing technical information in the field of power regulating semiconductors and integrated circuits." The examining attorney's refusal focuses exclusively on the goods listed in the cited registrations.

similarity in the look and sound of the two marks" (Brief, p. 2), but goes on to refer to the existence of several third-party registrations of similar marks, some of which are, according to applicant, in the computer field. Thus, applicant argues, the cited mark lacks a "high level of distinctiveness." (Reply Brief, p. 3). Applicant also contends that prospective purchasers of the respective goods are likely to be sophisticated in the electronics field, and would not assume that the goods emanate from a common source. Further, applicant asserts, the purchasers are different: "The purchasers of [registrant's] components are electronics engineers and technicians who design or repair the particular components" whereas "the purchasers of applicant's goods are users of personal computers, who are familiar with marks relating to the computers themselves, and other than Intel or Microsoft are likely unaware of the circuit components or their related marks on chips or boards inside the computer." (November 22, 2004 Response, p. 2).

The examining attorney maintains that the marks are very similar in that ENDURO and ENDURA are both variations of the term "endure." As to the goods, the examining attorney points out that applicant sells personal computers and registrant provides component parts and accessories for

personal computers. Thus, according to the examining attorney, the goods are related. In this connection, the examining attorney submitted several third-party registrations, each listing goods of the type identified in applicant's application and the cited registrations.

Before turning to the merits of the appeal, we direct our attention to an evidentiary matter. Applicant, in its November 22, 2004 response to the first Office action, made reference to "65 [third-party] registrations including the term ENDURA, 8 of which are in class IC 009, and 3 of which have relation to the field of computers." So as to be clear on this point, applicant simply referred to the registrations in a general way as quoted above. Applicant did not submit copies of the referenced registrations or even a list of the registrations. The examining attorney, in the final refusal (issued in response to applicant's November 22, 2004 communication), was completely silent as to applicant's arguments based on the existence of third-party registrations. In its appeal brief, applicant again simply made a general reference to the third-party registrations; and, again, copies of the registrations were not submitted. In her appeal brief, the examining attorney addressed applicant's argument as follows:

The applicant has referenced third[-] party registrations showing similar marks. Third[-]party registrations are entitled to little weight on the question of likelihood of confusion when considered by themselves. Although the applicant has not provided specific examples of third[-]party registrations, the examining attorney has researched the Trademark Register for similar marks in Class 9. Other marks containing similar terms were found to be for completely unrelated goods. The issue is not whether the other similar marks are used in other registrations for unrelated goods but whether the marks ENDURO and ENDURA for highly related goods are likely to be confused.

Applicant, in its reply brief, again made reference to third-party registrations, but this time applicant specifically listed "18 registrations including the core term 'ENDUR' in class IC 009 [not including the cited registrations] which have relation to the field of applicant's goods." (Reply Brief, p. 2). In each instance, applicant set forth the registered mark, the registration number, and the goods (in abbreviated fashion) covered by the registration.

Trademark Rule 2.142(d) states that the record in an application should be complete prior to the filing of an appeal. Moreover, to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic

records of the Office, should be submitted. In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1456 n. 2 (TTAB 1998). See TBMP § 1208.02 (2d ed. rev. 2004). Although applicant did not follow the correct procedure in making the third-party registrations of record, given the examining attorney's apparent consideration of this evidence, we likewise have considered the list of third-party registrations in reaching our decision.

We now turn to consider the substantive refusal of registration under Section 2(d). Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to consider the marks. In determining the similarity or dissimilarity of the marks, we must

compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

Applicant has applied to register ENDURO in standard character form; thus, it is not relying on any particular stylization for the mark. One of registrant's marks is ENDURA, also in standard character or typed form. The marks are very similar in appearance; ENDURO and ENDURA differ only in the last letter, both last letters being vowels. The marks also are very similar in pronunciation, differing only slightly in the sound of the last syllable; purchasers may easily confuse the "o" sound of applicant's mark and the "a" sound of registrant's mark.⁵ As to meaning, both ENDURO and ENDURA are variations of the term "endure." The terms suggest that the goods sold thereunder are built for endurance, that is, that the goods endure.

⁵ Indeed, applicant readily admits "a similarity in the look and sound of the two marks." (Brief, p. 2).

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Given the similarities between ENDURO and ENDURA, the marks convey virtually identical overall commercial impressions.

Registrant's logo mark also has been cited as a bar under Section 2(d) of the Act. The cited mark is for ENDURA in lower case letters, along with a design feature. In comparing the marks, we find that ENDURA is the dominant element of this cited mark, and it accordingly deserves more weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In registrant's logo mark, the design feature is relatively nondescript. If a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). For these reasons, we consider ENDURA to be the dominant feature of the registered mark.

We further find that, when the marks are compared in their entireties, they are similar in appearance. Registrant's mark, as noted above, includes a subordinate design, and the letters comprising ENDURA are in lower case. Applicant's mark is in standard character form, and ENDURO and ENDURA differ only in the last letter, both last letters being vowels. As pointed out above, ENDURO and ENDURA also are very similar in pronunciation, differing only slightly in the sound of the last syllable; purchasers may easily confuse the "o" sound of applicant's mark and the "a" sound of registrant's mark. As to meaning, both terms suggest that the goods sold thereunder are built for endurance, that is, that the goods endure. Notwithstanding the presence of the design and the use of lower case letters in registrant's mark, the marks engender similar overall commercial impressions.

We have considered applicant's argument that the cited mark is weak, taking into account the existence of certain third-party registrations. The presence of these registrations falls short of demonstrating that ENDURA is a weak term in this industry. Several of the marks include other elements (see, e.g., ENDUROSCOPE and ENDUROFLEX) and/or cover goods different from the ones herein; further, of the five ENDURA registrations, three cover goods

(shelves and cabinets for audio-visual equipment; electrical wall plates; and accessories for video cameras) different from the type of computer goods involved herein. See Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Fed. Cir., June 5, 1992) [probative value of third-party registrations is significantly diminished when the marks cover goods far removed from the types of goods being compared]. In any event, as "to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) [emphasis in original].

Insofar as the goods are concerned, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels

of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). It is worth noting in the present case that "the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion. If the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983). This principle is especially applicable when comparing applicant's mark ENDURO with registrant's mark ENDURA in typed form.

In comparing the goods, we recognize at the outset that there is no *per se* rule mandating that likelihood of confusion is to be found in all cases where the goods in question involve computer software and/or hardware. Information Resources, Inc. v. X*PRESS Information

Services, 6 USPQ2d 1034 (1988), citing *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985). Nevertheless, applicant and registrant are both providing highly related goods. Applicant intends to sell portable personal computers while registrant is selling parts for personal computers.

In attempting to show the relatedness of personal computers, the examining attorney introduced several third-party registrations, based on use in commerce, covering both personal computers and parts therefor, such as semiconductors and integrated circuits.⁶ Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

There are no limitations in the respective identifications of goods, and we presume that applicant's personal computers and registrant's parts for personal computers travel in the same channels of trade, and that

⁶ We would be remiss if we did not point out that many of the registrations submitted by the examining attorney are based on foreign filings under Section 44. This is a recurring oversight made by examining attorneys, and the present case illustrates yet again an examining attorney's failure to weed out any foreign registrations issued under Section 44. As made clear by the Board's case law and TMEP § 1207.01(d)(iii) (4th ed. 2005), third-party registrations, in order to be probative on this point, must be based on use in commerce.

the goods are bought by the same classes of purchasers. These purchasers would include both ordinary consumers and sophisticated purchasers.

Applicant argues that the relevant purchasers of the goods are sophisticated, but concedes that it has not offered any evidence in support of its argument. (Brief, p. 3). While there is no evidence on this du Pont factor, even assuming that purchases are carefully made, we find that the substantial similarity of the marks and the similarity between the goods clearly outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. The fact that purchasers may be sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated in the field of trademarks or immune from source confusion. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories

even of discriminating purchasers...are not infallible."].
See also In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We conclude that purchasers familiar with registrant's "semiconductors; semiconductor devices, namely, power regulating integrated circuits for personal computers, file servers, and portable personal computer appliances; integrated circuits; electrical and electronic devices and components, namely, power regulating integrated circuits for personal computers, file servers, and portable personal computer appliances" sold under registrant's ENDURA marks would be likely to believe, upon encountering applicant's mark ENDURO for "portable personal computers," that the goods originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 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.