

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: May 4, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Casaworks, Inc.,
Assignee of Metrics Technology, Inc.¹

Serial No. 78349045

Vidal A. Oaxaca of Peacock Myers, P.C. for Casaworks, Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Seeherman, Drost and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by the predecessor in
interest of Casaworks, Inc. to register on the Principal
Register the mark shown below



¹ Assignment of application Serial No. 78349045, originally filed by Metrics Technology, Inc. to the above-named applicant was recorded on September 14, 2004 with the Assignment Branch of the United States Patent and Trademark Office at Reel 2935/Frame 0524.

for "Computer hardware and software, namely, a residential gateway for controlling multiple home systems comprising security, lighting, HVAC, audio/video, irrigation, power management, appliances and other systems" in International Class 9.² Applicant has provided the following translation statement: the term "cielo" is the Spanish word for "sky," "ceiling," or "heaven."

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with applicant's goods, so resembles the following marks, previously registered by the same entity:

CIELO

in standard character form, for

transceivers; high frequency signal connectors; optical interconnect modules; optical interconnect network equipment, namely hubs, switches, routers, transceivers and associated components; optical interconnect modules; lasers, light emitting diodes and photodiodes for communication, storage devices, namely devices that use optical components to read or write data, or control position and laser disc players

in International Class 9;³ and the mark shown below

² Application Serial No. 78349045 was filed January 7, 2004, based upon applicant's allegation of use of the mark anywhere and in commerce since August 1, 2003.

³ Registration No. 2599901 issued July 30, 2002. The registration also recites goods in International Class 10.



*Interconnecting the World
at Gigabit Speed*

for

transceivers; high frequency signal connectors; optical interconnect modules; optical interconnect network equipment, namely hubs, switches, routers, transceivers, transmitter and receiver optical subassemblies, transponders, integrated circuits for use with lasers and photodetectors; lasers, light emitting diodes and photodiodes for communication; lasers, light emitting diodes and photodiodes for storage devices, namely devices that use optical components to read or write data or to control position; lasers, light emitting diodes and photodiodes for laser disc players

in International Class 9,⁴ as to be likely to cause confusion. In both registrations, the registrant has provided the following translation: The English translation of the word "cielo" in the mark is "heaven" or "sky."

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Evidentiary Matters

⁴ Registration No. 2460792 issued June 19, 2001.

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with its brief. These exhibits consist of printouts from Internet web pages describing the goods provided under both applicant's and registrant's marks. We agree with the examining attorney that these exhibits are untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal).

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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 and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

Because applicant's mark is most similar to the mark in Registration No. 2599901 for CIELO, we first address the question of likelihood of confusion with respect to this registration. We begin by considering the similarities and dissimilarities between the marks. In coming to our determination, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée 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.

In comparing the marks, we find that the word portion of applicant's mark is identical to the mark in the cited registration in sound, and nearly identical in appearance in that the word portion of applicant's mark is the same as the cited mark. In addition, we note that registrant's CIELO mark is registered in typed or standard character form, and thus is not limited to any special form or style as displayed on its goods. See *Phillips Petroleum Co. v.*

C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 26 (CCPA 1971). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000). As a result, the protection to be accorded registrant's CIELO mark includes the font in which the applied-for mark appears.

In terms of connotation, we find that the connotations of the marks are identical. To the extent that consumers would understand the meaning of the foreign word CIELO, this term has the same meaning in both marks. And for those consumers who are not familiar with this word, CIELO will appear as the identical arbitrary term. In addition, we find that the design element in applicant's mark is insufficient to distinguish it from registrant's CIELO mark.⁵ 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. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For this reason, we consider the word

⁵ We note that there exists disagreement between the examining attorney and applicant as to the nature of the design element in applicant's mark. Applicant identifies it as "a highly stylized design of a house" (brief, p.4) while the examining attorney characterizes it as an "arrow design" (brief, unnumbered p.9). These differing characterizations show that the design element is rather abstract, and provides further support that consumers are likely to refer to the mark by the word CIELO, instead of the unclear design element.

portion, i.e., "CIELO," to be the dominant feature of applicant's mark. We further find that, on the facts before us, and in the absence of any evidence to the contrary, CIELO is a strong mark, and as such is entitled to a broad scope of protection.

In view of the foregoing, we find that, when applicant's mark and registrant's CIELO mark are compared in their entireties, they are sufficiently similar in appearance, sound, connotation and commercial impression that, if used in connection with related goods, confusion would be likely to occur. As such, this *du Pont* factor favors a finding of likelihood of confusion.

The Goods

Turning now to our consideration of the recited goods, we note that it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In*

re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In considering the goods we note that, as identified above, applicant's goods are "Computer hardware and software, namely, a residential gateway for controlling multiple home systems comprising security, lighting, HVAC, audio/video, irrigation, power management, appliances and other systems." We take judicial notice of the following definition of "residential gateway:" "a device that allows multiple devices access to the Internet through a single high-speed connection."⁶ Thus, applicant's goods may be described as computer hardware and software that allow a user to access and control multiple home systems via the Internet. The goods identified in Registration No. 2599901, while not specifically directed to control of various home systems, are not limited to any particular field of use. We look then to the evidence of record to

⁶ Webster's New Millennium(tm) Dictionary of English, Lexico Publishing Group, LLC (2003-2006). The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982); *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

determine whether a relationship exists between registrant's goods and those of applicant.

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for goods that are identified in both the application at issue and the cited registration. *See, for example:*

Registration No. 2543008 for, *inter alia*, switches, residential gateways, namely, electronic devices that provide distributed switching for the delivery of multimedia services;

Registration No. 2573273 for, *inter alia*, residential gateways and routers;

Registration No. 2597389 for, *inter alia*, residential gateways and routers;

Registration No. 2782474 for, *inter alia*, residential gateways, home gateways, video gateways, namely, electronic devices, namely, routers and switches; and

Registration No. 2543008 for, *inter alia*, switches and residential gateways, namely, electronic devices that provide distributed switching for the delivery of multimedia services.

Third-party registrations which individually cover a number of different items and which are based on use in

commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). In this case, it appears that registrant's general purpose goods may be used as components of applicant's more specialized goods or applicant's and registrant's goods otherwise may be used together as components of larger electronic systems. In its brief applicant, while arguing that registrant's goods are used by different end users from those who would purchase its own goods, acknowledges that registrant's goods

are of the type that are ubiquitous (i.e. electronic and computer parts.) Such a general category of components is found everywhere. Applicant's goods are field and consumer specific.

(brief, p. 13). Although the identification of goods in the cited registration does not specify that the goods are used for control of electronic home systems, because the identification does not limit the uses for the goods, we must consider them as being appropriate for use in such systems. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). As a result, we find that the goods are related such that consumers could, because of the similarity of the marks,

mistakenly believe that they originate from the same source.

In short, the foregoing evidence demonstrates the related nature of the goods at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

We are not persuaded by applicant's arguments that its goods are marketed to different end users from those of registrant. It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In this case, neither the goods identified in the subject application nor the cited Registration No. 2599901 contains any limitations as to the marketing channels or prospective purchasers thereof. Furthermore, because the evidence of record demonstrates that both applicant's and registrant's goods may emanate from the same source and be used together, they are likely to be purchased by the designers, contractors and installers of systems incorporating such goods, as well as the ultimate consumers thereof.

Accordingly, both applicant's and registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Therefore, in this case, we find that the same consumers would purchase both applicant's and registrant's goods and they would be sold in the same channels of trade such as home electronics stores and electrical supply stores.

Sophistication of Purchasers

The final *du Pont* factor discussed by applicant and the examining attorney is that of the conditions of sale. Applicant asserts that registrant's goods would be purchased by careful and sophisticated users. However, sophisticated purchasers are not necessarily knowledgeable

in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). Moreover, in view of the third-party registrations, sophisticated purchasers would be aware that both applicant's and registrant's goods are of a type which may emanate from a single source, and therefore are likely to believe that these goods, if sold under the same or a confusingly similar mark, emanate from the same source. There is no evidence in the record as to the cost of the switches and routers identified in the cited registration, but even if we assume that some degree of care were exhibited in making the purchasing decision, applicant's mark is so similar to registrant's CIELO mark that even careful purchasers are likely to assume that the marks identify goods emanating from a single source.

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

Conclusion

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced CIELO mark would be likely to believe, upon encountering applicant's goods rendered under the applied-

Ser No. 78349045

for mark, 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. See *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 165, 223 USPQ 1289 (Fed. Cir. 1984).

Having found that applicant's mark is confusingly similar to registrant's CIELO mark in cited Registration No. 2599901, we need not and do not consider the similarity or dissimilarity between applicant's mark and the mark in cited Registration No. 2460792.

Decision: The refusal of registration under Trademark Act Section 2(d) is affirmed as to Registration No. 2599901.