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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pixel Instruments Corporation

v.

Sweven Corporation

Opposition No. 97,136
to application Serial No. 74/460,274
filed on November 18, 1993

Charles R. Rust and Kenneth L. Mitchell of Woodling, Krost
and Rust for Pixel Instruments Corporation.

Laura G. Miller and Brian J. Urban of Woodcock Washburn
Kurtz Mackiewicz & Norris for Sweven Corporation.

Before Seeherman, Hairston and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Pixel Instruments Corporation has opposed the
application of Sweven Corporation to register the mark PIXEL
DUST PRODUCTIONS and design reproduced below,



for "computer consulting services, featuring design and graphic creation services" in class 42.¹ Opposer has alleged, in its amended opposition, that applicant's mark so resembles opposer's previously used trade name and trademark PIXEL for electronic signal processors and engineering consulting services, all of which relate to image processing functions, that if used in connection with applicant's identified services, it is likely to cause confusion. Opposer pleaded ownership of Registration No. 1,409,040 issued September 9, 1986 (affidavits under Sections 8 & 15

¹ Serial No. 74/460,274, filed on November 18, 1993, claiming a bona fide intention to use the mark in commerce. The word "PRODUCTIONS" is disclaimed apart from the mark as shown. We note that applicant filed an amendment to allege use contemporaneously with its application, but the required fee did not accompany the amendment, and the amendment was never acknowledged or approved by the Examining Attorney. Thus, the application published for opposition as an intent-to-use application. If applicant prevails herein, the application will be remanded to the Examining Attorney for consideration of the amendment to allege use. Applicant may elect to have the amendment to allege use considered or it may withdraw the amendment to allege use in favor of filing a proper statement of use. In either case, applicant will be required to submit the prescribed fee.

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accepted and acknowledged, respectively) for the mark PIXEL for "engineering consulting services" in class 42; and Registration No. 1,554,423 issued September 5, 1989 (affidavits under Sections 8 & 15 accepted and acknowledged, respectively) for the mark PIXEL for "electronic signal processors" in class 9. Further, opposer alleged that applicant lacked the requisite bona fide intention to use the applied-for mark in commerce as of the application filing date.

Applicant, in its amended answer, denied the salient allegations of the opposition.

The record consists of the pleadings; the file of the opposed application; the trial testimony of opposer's witness Carl J. Cooper, with related exhibits; and the trial testimony of applicant's witness John H. Heitmann, with related exhibits. Opposer filed a notice of reliance on the discovery depositions of John Heitmann, Thomas Dolby and Michael Scotko, with related exhibits. In addition, applicant submitted, under notice of reliance, opposer's responses to applicant's discovery requests.²

² Applicant also submitted, under notice of reliance, its own discovery responses. However, a response to a discovery request may be submitted and made part of the record by only the inquiring party. See Trademark Rule 2.120(j)(5). Thus, applicant's discovery responses do not form part of the record in this case.

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Both parties filed briefs on the case, but no oral hearing was requested.

Before turning to the record and the merits of the case, we must discuss two preliminary matters. First, we note that in a decision issued December 30, 1999, the Board denied opposer's motion for summary judgment on the issue of applicant's bona fide intent and granted summary judgment in applicant's favor, finding that the evidence of record established applicant's bona fide intent as a matter of law. Opposer, in its brief on the case, has requested reconsideration of this decision.

Trademark Rule 2.127(a) provides that "[a]ny request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof." In view thereof, opposer's request for reconsideration is clearly untimely, and is accordingly denied. However, an appeal of the Board's summary judgment ruling is proper upon issuance of this final decision on the case.

Second, we note that on May 1, 1996 applicant filed a motion to amend its recitation of services from "computer consulting services, featuring design and graphic creation services" to "designing and producing artistic digital format graphics and creating multimedia content and consulting services therefor, not including engineering

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services or engineering consulting services." Opposer objected to the amendment, essentially arguing there was no basis for such an amendment because the record in the case had not been fully developed. The Board, in an order issued August 29, 1996, deferred decision on applicant's motion to amend pending the final decision in this case.

After reviewing the evidence presented at trial in this case, we find that applicant's proposed amendment to its recitation of services is acceptable. That is, the evidence shows that this recitation accurately describes applicant's services and the proposed amendment does not broaden, but instead, restricts the original recitation of services. In view thereof, applicant's amendment to the recitation of services is hereby entered in applicant's application.

Under the circumstances, we will consider the issue of likelihood of confusion vis-à-vis opposer's electronic signal processors and engineering consulting services and applicant's services of designing and producing artistic digital format graphics and creating multimedia content and consulting services therefor, not including engineering services or engineering consulting services.

We turn then to the record and merits of the case. According to opposer's president, J. Carl Cooper, opposer began doing business as Pixel Instruments in 1981. Mr. Cooper testified that opposer sells "audio and video-signal

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processing products . . . that are capable of manipulating, processing and generating images in conjunction with hardware and software, the hardware including computers." (Cooper dep. p. 14). Further, Mr. Cooper testified that opposer "provide[s] what are generically called 'engineering services' relating to technical services, and that includes the full spectrum of things that an engineer might do or technical person might do in terms of designing equipment, operating equipment, [and] producing various products with technical equipment." (Cooper dep. pp 14-15). According to Mr. Cooper, opposer's products are used in a variety of industries, including the broadcast and digital TV industries and digital publishing. As an example of one application for its products, Mr. Cooper testified as follows:

. . . the housing industry will shoot a videotape of a house that's for sale, bring it back, process that raw tape, and then come up with a presentation to be put out either on videotape or over the web showing the house to prospective buyers.

So the people that are involved in that type of manipulation of images are the types of people that are interested in our products.
(Cooper dep. p. 99).

In 2001 opposer billed approximately \$400,000 for its engineering consulting services and sold approximately \$400,000 worth of electronic signal processors. Opposer's promotional efforts have included trade journals

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advertisements and trade shows. Opposer has used the PIXEL trade name and mark in connection with its electronic signal processors and engineering consulting services continuously since 1981.

Applicant took the testimony of John Heitmann, one of its founders and shareholders. According to Mr. Heitmann, applicant began doing business in 1990 designing multimedia presentations for use on laptop computers and in kiosks. Applicant currently performs "graphic design and website development [and] multimedia presentation development." (Heitmann dep. p. 6). Applicant uses "off-the-shelf" software in providing its services. Applicant's clients come from a variety of industries and most are seeking to market their products and/or services to customers via the Internet. Mr. Heitmann testified that applicant has created multimedia presentations for home builders, in particular, and applicant's mark is a creation of combining the word "pixel" and construction "dust."

Thomas Dolby, applicant's president, described one of applicant's design projects as follows:

It was a project for a builder and we had to create digital images of the homes, rendered images of the homes ... [and] rather than the builder building the home and have you touring it, you would do it electronically and you would tour the home with your fingertip using a touch-screen display and graphics that were created by Pixel Dust.

(Dolby discovery dep. p. 7).

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Priority of use is not in issue inasmuch as opposer introduced copies of its pleaded registrations for the PIXEL mark through the testimony of its witness Mr. Cooper and he testified that the registrations are subsisting and owned by opposer. See *King Candy Co. v. Eunice Kings's Kitchen, Inc.*, 496 F.2d 1400, 182 108 (CCPA 1974). Further, the record shows that opposer has used the PIXEL mark and trade name in connection with its electronic signal processors and engineering consulting services since prior to applicant's first use of the applied-for mark and the filing date of applicant's application.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and the differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In an opposition involving the issue of likelihood of confusion, it is incumbent upon the opposer to establish a

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relationship between the goods and/or services of the parties and/or that the conditions surrounding the marketing of the goods and/or services are such that they would be likely to be encountered by the same persons under conditions and circumstances that could give rise, because of the similarity of the marks used in connection therewith, to a belief that they originate with or are in some way associated with the same producer.

Considering first the relationship between opposer's electronic signal processors and applicant's design services, opposer contends that they are related because its electronic signal processors "provide a 'frame grabber' operation for capturing and manipulating images just like the 'frame grabber' used by [applicant]" in rendering its services. (Brief, p. 14). Further, opposer maintains that applicant's services include taking analog images and converting them to digital images and that opposer's electronic signal processors perform just this function.

However, opposer has presented no evidence that any companies market and sell electronic signal processors and design services under the same or similar marks. It is not enough, for purposes of likelihood of confusion, that opposer's electronic signal processors perform image functions and that applicant, in rendering its design

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services, uses equipment that performs image processing functions.

Further, while we recognize that opposer's electronic signal processors and applicant's design services, not being restricted in any way in the involved identifications, may be marketed to some of the same classes of purchasers, this does not establish that the goods and services are related. See e.g. *Electronic Research Associates, Inc. v. Chart-Pak, Incorporated*, 158 USPQ 357 (TTAB 357) (TTAB 1968) [The fact that different products may be sold to same purchaser is considered on question of likelihood of confusion but this single factor cannot be conclusive on such issue since purchaser is also a prospective purchaser for widely divergent goods]. A publishing firm may indeed purchase opposer's electronic signal processors for use in its business and hire applicant to design its web page. However, the record is devoid of any probative evidence to show why purchasers would be likely to assume that these distinctly different goods and services emanate from the same source. The obvious differences between opposer's electronic signal processors, which are highly technical in nature, and applicant's design services are so great that purchasers are not likely to assume a common source for these goods and services. In short, opposer has failed to meet its burden of proving a relationship between its

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electronic signal processors and applicant's design services. Likelihood of confusion must be established on sound, viable, grounds rather than on supposition and surmise. As the Court stated in *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969):

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations, but with the practicalities of the commercial world with which trademark laws deal.

With respect to opposer's engineering consulting services and applicant's design services, inasmuch as applicant has amended its recitation of services to specifically exclude engineering services and engineering consulting services, there is no overlap between the parties' respective services. Moreover, opposer has not established on this record that the parties' respective services are otherwise related.

Further, we find that the respective marks and trade name are not similar in sound, appearance, connotation and overall commercial impression. Although opposer's mark and trade name consists solely of PIXEL and applicant's mark begins with PIXEL, this word is highly suggestive of opposer's electronic signal processors and applicant's design services. We judicially notice that "**pixel**" is defined in Webster's Universal Encyclopedic Dictionary

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(2002) as "any of the small discrete elements that together constitute an image (as on a television screen)." Thus, its inclusion in opposer's mark and trade name and in applicant's mark is not a basis for finding the marks and trade name in their entirety to be similar. Rather, when we consider the marks and trade name in their entirety, applicant's mark PIXEL DUST PRODUCTIONS and design is different in appearance, sound, connotation and overall commercial impression from opposer's mark and trade name PIXEL. The marks and trade name look and sound different to the extent that applicant's mark includes the words "DUST PRODUCTIONS" and a prominent design, while opposer's mark does not.

In terms of connotation, opposer's PIXEL mark and trade name as applied to its electronic signal processors, in particular, would be understood to mean, or to refer to, the image processing function of such goods. On the other hand, applicant's PIXEL DUST PRODUCTIONS and design mark, as applied to its design services, brings to mind "pixie dust" and suggests that the images applicant creates are somewhat magical. This connotation is reinforced by the prominent design in applicant's mark consisting of the dust like appearance of scattered pixels.

In sum, opposer's PIXEL mark and trade name and applicant's PIXEL DUST PRODUCTIONS and design mark are

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different in sound, appearance and connotation and create different commercial impressions. In reaching this conclusion, we have considered the highly suggestive nature of the word "pixel" as applied to opposer' goods, in particular, and applicant's services. Further, this record does not establish that opposer's electronic signal processors and engineering consulting services are related to applicant's services of designing and producing artistic digital format graphics and creating multimedia content and consulting therefor, not including engineering services or engineering consulting services. Thus, we hold that confusion is not likely in this case.

Decision: The opposition is dismissed and the application will be remanded to the Examining Attorney for consideration of applicant's amendment to allege use.