Hearing: Paper No. 27
November 12, 2002 EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Celestica International Inc. (substituted for Celestica North America Inc.) v. CCC Mobile Oy.

Opposition No. 112,405 to Application Serial No. 75/255,206 filed March 10, 1997.

David M. Kelly of Finnegan, Henderson, Farabow, Garrett & Dunner for Celestica International Inc. (substituted for Celestica North America Inc.).

Robert S. Weisbein of Darby & Darby for CCC Mobile Oy.

Before Hanak, Chapmann and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

CCC Mobile Oy (applicant) seeks to register in typed drawing form CELESTA for "computer software for smart phones, personal digital assistants and personal computers to provide communications in digital cellular networks and local data management features." The intent-to-use application was filed on March 10, 1997.

In its Notice of Opposition, Celestica North America Inc. alleged that prior to March 10, 1997 it had used the marks CELESTICA and CELESTICA and design in connection with certain types of computer hardware and the custom manufacture of certain types of computer hardware, and further alleged that the contemporaneous use of CELESTA for applicant's goods and CELESTICA for opposer's goods and services is "likely to cause confusion, or to cause mistake, or to deceive." (Notice of Opposition paragraph 7). While in the Notice of Opposition opposer did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for the opposition.

Applicant filed an answer to the Notice of Opposition which denied the pertinent allegations. In particular, applicant denied the allegations of paragraph 7 of the Notice of Opposition.

At the outset, we note that in footnote 1 of its brief, Celestica North America Inc. requests that Celestica International Inc. be substituted as the party plaintiff because "opposer's pleaded registrations and applications were assigned from Celestica North America Inc. to Celestica International Inc. and recorded before the USPTO." In its brief, applicant has not challenged this request. Indeed, at page 1 of its brief, applicant

identifies opposer as “Celestica International Inc.” Accordingly, the opposer in this proceeding shall be deemed Celestica International Inc.

Opposer and applicant filed briefs. Both were present at a hearing held on November 12, 2002.

As the parties agree, the record in this case is quite sparse. It consists of certified status and title copies of four registrations owned by opposer for the marks CELESTICA and CELESTICA and design. These were properly made of record by means of a Notice of Reliance. (Opposer’s brief page 4; Applicant’s brief page 1). The two registrations for CELESTICA and design cover the identical goods and services as do the two registrations for CELESTICA per se. Because opposer’s mark CELESTICA and design is more dissimilar from applicant’s mark CELESTA than is opposer’s mark CELESTICA per se, we have elected to disregard in our likelihood of confusion analysis the two registrations for CELESTICA and design. Moreover, because at the hearing held on November 12, 2002 the parties agreed that the goods of opposer’s trademark registration for CELESTICA were closer to the goods of applicant’s CELESTA application than were the services of opposer’s CELESTICA service mark registration, we have elected to disregard the latter in our likelihood of confusion analysis.

To cut to the quick, our likelihood of confusion analysis will focus on a comparison of applicant's mark CELESTA in typed drawing form for "computer software for smart phones, personal digital assistants and personal computers to provide communications in digital cellular networks and local data management features" vis-à-vis opposer's mark CELESTICA in typed drawing form for "computer hardware, namely, circuit boards, memory cards and power supplies." Registration No. 2,162,279. Because opposer has properly made of record a certified status and title copy of this Registration No. 2,162,279, priority is not an issue in this proceeding, it rests with opposer. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As noted previously, the record in this case is extremely sparse. Opposer merely made of record certified status and title copies of its four registrations. Applicant made of record no evidence. However, the sparse nature of the record has made it more difficult for this Board to determine whether there exists a likelihood of confusion. Rather than having the benefit of testimony to help explain the nature of opposer's goods and applicant's goods as set forth in Registration No. 2,162,279 and the application, this Board has been forced to resort to

dictionary definitions of the terms contained in the identifications of goods set forth in the registration and application.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Marks are compared in terms of visual appearance, pronunciation and meaning (if any). In terms of visual appearance, the two marks, when depicted in typed drawing form, are extremely similar, almost to the point of being nearly identical. Applicant's mark CELESTA consists of the first six letters and the final letter of opposer's mark CELESTICA. In our subjective judgment, a consumer familiar with opposer's mark CELESTICA, upon seeing applicant's mark CELESTA, could easily not notice the fact that the seventh and eighth letters of "opposer's" mark (i.e. the IC) were missing and hence assume that he or she was viewing opposer's mark CELESTICA. This is particularly true when one takes into account that marks are not compared on a

side by side basis. Rather, the test is whether a consumer, having seen opposer's mark and having retained but a general recollection of it, would, upon seeing applicant's mark at a later time, assume that it is opposer's mark.

In terms of pronunciation, we find that the two marks are again extremely similar even if applicant's mark is properly pronounced as having three syllables, and opposer's mark is properly pronounced as having four syllables. Of course, it must be remembered that "there is no correct pronunciation of a trademark." In re Belgrade Shoe Co., 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). Again, while this is a subjective judgment, it is our view that a not insignificant number of consumers could "mispronounce" one or both of the two marks such that the resulting "mispronunciations" would be almost identical.

Finally, in terms of meaning or connotation, we find that both marks lack any meaning to the vast majority of relevant consumers, namely, purchasers of computer hardware and software. In this regard we note that at page 8 of its brief applicant states that "the term 'celestica' has no meaning." We also note that at page 8 of its brief applicant states that "a celesta is a musical instrument." It is true that the word "celesta" is defined as follows:

"a musical instrument consisting principally of a set of graduated steel plates struck with hammers that are activated by a keyboard. [1895-1900]." Random House Webster's College Dictionary (2000). However, it appears that a celesta is a rare if not archaic musical instrument. Applicant has offered no evidence that would even suggest that purchasers and users of computer hardware and software would recognize the word "celesta" as referring to a musical instrument.

Of course, the fact that both opposer's mark CELESTICA and applicant's mark CELESTA lack any meaning does not favor applicant's position. Rather, if anything, it slightly favors opposer's position. Because both marks are arbitrary to purchasers and users of computer hardware and software, this means that these purchasers and users have no way of distinguishing the two marks in terms of meaning.

Before leaving the issue of the meaning of the marks, we wish to make it clear that we reject opposer's contention that the "marks convey the same meaning or connotation." (Opposer's brief page 9). In this regard, opposer argues without any evidentiary support that its mark CELESTICA connotes the word "celestial." Opposer then notes that certain dictionaries, in defining the word "celesta," conclude their definition with the words "see

celestial." Not only has opposer totally failed to provide any evidentiary support that its mark CELESTICA connotes the term "celestial," but in addition, we have just found that very few purchasers and users of computer hardware and software would understand the word "celesta" to refer to a musical instrument, much less to the adjective "celestial."

In sum, we find that the two marks are extremely similar in terms of visual appearance to the point of being nearly identical. In terms of pronunciation, the two marks are likewise extremely similar, although perhaps not to the point of being nearly identical. Finally, the arbitrary nature of both marks means that consumers do not have any meanings to attach to either mark which would enable them to distinguish the two marks.

Turning to a consideration of the goods as set forth in the application and in opposer's Registration No. 2,162,279, we start with the proposition that as the similarity of the marks increases, the respective goods need not be as similar in order to support a likelihood of confusion. For example, when two marks share a "substantial identity," then their use can lead to a likelihood of confusion "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir.

1993). Of course, in the present case the two marks are not identical. However, they are extremely similar, and hence if they were used on related goods, we would find that there exists a likelihood of confusion.

With this proposition in mind, we turn to a consideration of the identification of goods as set forth in the application and the identification of goods as set forth in Registration No. 2,162,279. Applicant seeks to register CELESTA for computer software for, among other goods, personal computers and personal digital assistants to provide communications in digital cellular networks and local data management features. Opposer's CELESTICA computer hardware includes memory cards and power supplies.

In order to gain a better understanding of certain terms contained within the two identifications of goods, this Board has independently consulted a dictionary of its own choosing, namely, the Microsoft Computer Dictionary (5th ed. 2002). Not only is this work extremely comprehensive, but in addition it is quite timely in that it was published this year. The term "personal computer" is defined as simply "a computer designed for use by one person at a time." A "laptop" is defined as "a small, portable personal computer that runs on either batteries or AC power, designed for use during travel." While this

dictionary has no listing for the term “personal digital assistant,” it does define PDA as an “acronym for Personal Digital Assistant. A light-weight palmtop computer …”

Turning to a consideration of some of the terms contained in opposer’s registration, we note that a “memory card” is defined as a “memory module that is used to extend RAM storage capacity … in a portable computer, such as a laptop, notebook or handheld PC.” A “power supply” is defined as “an electrical device that transforms standard wall outlet electricity … into lower voltages … required by computer systems. Personal computer power supplies are rated by wattage.”

In essence, applicant’s identification of goods makes it clear that applicant provides computer software to owners of personal computers and personal digital assistants to enable these devices to provide communications in digital cellular networks and local data management. Opposer’s pertinent registration covers memory cards and power supplies, items that can be attached to various personal computers to expand their storage capacity or to enable them to plug into a standard wall outlet for their electrical supply.

In view of the foregoing, we find that certain of the goods set forth in the application and certain of the goods

set forth in the pertinent registration are clearly related. To elaborate, applicant's goods are computer software for personal computers and personal digital assistants to enable these devices to provide communications in digital cellular networks and local data management. Certain of the goods of the pertinent registration – namely, memory cards and power supplies – can likewise be used by owners of personal computers to enhance their storage capacity and to operate their personal computers from a standard wall outlet. In short, the same consumer could purchase CELESTA computer software for his personal computer to provide communications in a digital cellular network and likewise purchase a CELESTICA memory card to enhance his personal computer's storage capacity. Given the fact that the two marks are extremely similar, we find that this personal computer owner could easily assume that the CELESTA computer software and the CELESTICA memory card bore the same mark, or at an absolute minimum, emanated from the same source.

Of course, to the extent that there are doubts on the issue of likelihood of confusion, this Board is obligated to resolve doubts in favor of opposer whose rights in the mark CELESTICA are superior to those of applicant in the mark CELESTA. Century 21 Real Estate Corp. v. Century Life

of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); Shell Oil, 26 USPQ2d at 1691.

Three final comments are in order. First, at page 10 of its brief applicant argues that the channels of trade are different in that its "computer software is directed to end-user consumers," whereas "component products such as those offered by opposer are directed to manufacturers." While certain of opposer's goods, such as circuit boards, could not be installed on personal computers by end-user consumers, the dictionary definitions make clear that opposer's memory cards and power supplies could easily be installed on personal computers by ordinary end-user consumers.

Second, applicant also argues at page 10 of its brief that opposer's customers are sophisticated in that they "are likely to have an understanding of circuit boards, memory cards and power supplies, and are likely purchasing agents for manufacturers of finished computer products." (emphasis added). Not only has applicant offered no evidence to support this contention, but as just noted, the dictionary definitions make clear that memory cards and power supplies could be installed on personal computers by ordinary users.

Third, at page 11 of its brief, applicant argues that "opposer's mark is not famous." As noted, opposer offered no evidence other than its four registrations. If opposer wished to establish that its mark is famous, it had the burden of doing so. However, we wish to make it clear that in determining that there exists a likelihood of confusion, we have not considered opposer's mark to be famous.

Decision: The opposition is sustained on the basis that the contemporaneous use of applicant's mark CELESTA for certain of applicant's goods and opposer's mark CELESTICA for certain of the goods set forth in its Registration No. 2,162,279 is likely to result in confusion.