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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

PC Club

v.

Enpower Services, Inc.,
substituted for Dairyland
Power Cooperative

Opposition No. 91117511
to application Serial No. 75407949

Ronald M. St. Marie of the Chan Law Group for PC Club.

Shelley J. Safer of Lathrop & Clark LLP for Enpower
Services, Inc.

Before Hairston, Chapman, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 19, 1997, an application,¹ now currently
assigned to Enpower Services, Inc. (applicant), was filed
seeking to register the mark ENPOWER (typed drawing) on the

¹ Application Serial No. 75407949. The application was originally based on an allegation of a bona fide intention to use the mark in commerce. The application was subsequently amended to allege that the mark was first used anywhere and first used in commerce for the services on January 15, 1998. Dairyland Power Cooperative assigned the application to Enpower Services, Inc. in an assignment recorded at Reel/Frame No. 1864/0624.

Opposition No. 91117511

Principal Register for services that were ultimately identified as follows:

Business consulting services rendered to cooperatives and municipal utilities, namely, development of marketing strategy, market research services, market segmentation studies, customer satisfaction and loyalty studies and survey[s], and marketing consultation; cooperative marketing in the field of energy and appliances; and providing energy procurement services for others, and retail outlet services in the field of appliances in International Class 35; and

Consulting services in the fields of power quality, power reliability, energy efficiency, environmentally-friendly energy, energy conservation, and energy management; research and development of new products and services for others in International Class 42.

PC Club (opposer) has opposed registration of the mark on the ground that applicant's mark so resembles its registered mark ENPOWER² for:

Computers, computer printers, video display terminals, keyboards, modems, printed circuit boards for computers, floppy discs, memory devices, namely, floppy disc drives, optical disc readers, magnetic tape readers, optical character scanners, computer data input and storage devices, namely, magnetic and optical memory disc drives and tape storage units, XY plotters, computer mouse, digital pad and pens, computer operating software and manuals sold as a unit with the above, and facsimile machines in International Class 9.

Opposer alleges that the marks are identical and that applicant's mark when used in connection with its services "could lead to confusion and deception within the purchasing

² Registration No. 2,009,265 issued October 22, 1996. Affidavits under Section 8 and 15 have been accepted/acknowledged by the Office. The registration was based on an application that was filed on September 20, 1993, and which alleges a date of first use anywhere and in commerce of August 12, 1993.

Opposition No. 91117511

public as to the origin of all" such services bearing applicant's mark. Notice of Opposition at 3. Applicant denied the salient allegations of the notice of opposition.

The record in this case consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of Shirley Sheum, opposer's Human Resources/Administrative Manager; the trial testimony deposition, with exhibits, of Dale Thielen, applicant's Chief Executive Officer; opposer's notice of reliance; and applicant's notice of reliance.

Applicant has filed a motion to strike portions of Sheum testimony, three of the Sheum exhibits (9, 10, and 11), Document Nos. 1, 22-32 and 42 in opposer's notice of reliance, and references in opposer's brief to unpublished decisions. Generally, applicant's objections include a failure to authenticate documents, failure to lay a proper foundation, and improper use of a Notice of Reliance.³

"Objections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike." TBMP § 533.03 (2d ed. 2003)⁴. See also

³ Opposer has objected to applicant's motion on the merits in its reply brief. The brief also indicates that a formal opposition to the motion to strike was filed. The record does not demonstrate that the opposition was in fact timely filed and, therefore, we will not consider it. However, inasmuch as opposer's reply brief opposes the motion to strike, we do not treat the motion to strike as conceded.

⁴ All references to the TBMP are to this version.

Opposition No. 91117511

TBMP § 707.02(c) (Objections to notices of reliance on substantive grounds should be raised in the brief rather than by motion to strike). Similarly, "when a brief on a case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to its content." TBMP § 539. In addition to the motion to strike, applicant, in its brief, argues that this evidence is inadmissible.

While we do not normally strike testimony and briefs under these circumstances, we will consider applicant's objections to this evidence and the references in opposer's brief. First, we overrule applicant's objection to this evidence on the ground of improper foundation. The record establishes that a proper foundation was laid. Second, applicant argues (Brief at 8) that opposer may not ordinarily submit documents produced by applicant in the course of discovery by notice of reliance such as "Applicant's brochures and printouts of web pages." See TBMP § 704.11 (A "party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible ... as official records ... or as printed publications"). Opposer responds (Brief at 14, emphasis in original) that "many of these documents were produced by Applicant. It is disingenuous

Opposition No. 91117511

for Applicant to now argue they are inadmissible." The documents do appear to have been produced in response to opposer's interrogatory (Opposer's Notice of Reliance, Exhibit 16) and applicant does not allege anything to the contrary. Therefore, we will consider these exhibits. See 37 CFR 2.120(j)(3)(i); M-Tek Inc. CVP Systems Inc., 17 USPQ2d 1070, 1073 (TTAB 1990). Third, inasmuch as applicant has not established that it is appropriate to sanction opposer by refusing to consider opposer's exhibits, applicant's request to sanction opposer by refusing to consider this evidence is denied.

Applicant also objects because it alleges that opposer failed to submit a "current" status and title copy of its registration. Opposer submitted a photocopy of a certified copy of its registration showing the status and title.⁵ Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1461 n.4 (TTAB 1992) ("Opposer, with its notice of reliance, attached copies or facsimiles of the registrations which it sought to order, and the copy of the registration for the mark EDS is a status and title copy prepared and issued by the Office shortly prior to the filing of the opposition. Accordingly, this registration is of record"). Applicant notes that the copy of opposer's registration was

⁵ Opposer's submission of evidence concerning the status and title of its registration with its reply brief is obviously untimely.

Opposition No. 91117511

submitted on October 15, 2002, and the copy is dated December 4, 1998. However, the opposition was filed on February 22, 2000. "Status and title copies filed under notice of reliance must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter." TBMP § 704.03(b)(1). Therefore, the question is whether the period of one year is reasonably contemporaneous with the filing of the notice of opposition. The Board has held that a three-year period was not reasonably contemporaneous with the filing of opposition while a two-month period was reasonably contemporaneous. Compare Hard Rock Café International (USA) Inc. v. Eles, 56 USPQ2d 1504, 1511 (TTAB 2000) with Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144, 146 (TTAB 1979). Whether a copy of a pleaded registration shows "current status and title goes to the issue of the competency of the copies of the registration, per se, as evidence of the plaintiff's ownership and prior rights in the mark shown therein, and not to the issue of the admissibility of the copies, per se." Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072, 1075 (TTAB 1990). Here, there was no issue as to the title of the registration or the subsequent filing of the Section 8 affidavit. Under the facts of this case, we find that the photocopy of the registration is reasonably contemporaneous with the filing

Opposition No. 91117511

of the complaint. Hollister Incorporated v. Downey, 565 F.2d 1208, 196 USPQ 118, 119 (CCPA 1977) ("The registrations show ownership in Hollister on their face. The registrations therefore established a prima facie case of ownership under §7(b), and shifted the burden of going forward to Downey. Downey's answer leaving Hollister to its proofs did not meet that burden. An opposer has a right to rely on a prima facie case as its proof. Absent a contrary showing, such prima facie case will prevail").

Finally, applicant has objected to opposer's reference to unpublished decisions in its brief. In opposer's opposition to applicant's motion to strike (p. 4), opposer admitted that the "objection to the reliance on unpublished decisions is well taken." Therefore, as requested by opposer, we will not consider these decisions.

Priority

Priority is not an issue here in view of opposer's submission with its notice of reliance of a status and title copy of its registration for the mark ENPOWER. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Applicant is a company formed by 89 electric cooperatives in the Upper Midwest to prepare the cooperatives for deregulation "particularly in the areas of

Opposition No. 91117511

marketing to their customers." Thielen dep. at 7. Opposer operates 42 retail stores in California, Arizona, Nevada, Oregon, Washington, Oklahoma, and Ohio that sell, inter alia, computer products. See Sheum dep. at 31-32 and Exhibits 4 - 8. Both applicant and opposer use the mark ENPOWER on their respective goods and services.

We now begin our analysis of the issue of likelihood of confusion in which we consider the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must 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 services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we discuss is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. There is no dispute that in this case opposer's and applicant's marks are identical.

Opposition No. 91117511

The second factor we consider is the similarity or dissimilarity of the goods or services as described in the application and registration(s). We must compare the goods and services as described in the application and the registrations to determine if there is a likelihood of confusion. 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").

Applicant argues that opposer "cannot rely on any goods or services not specified in its notice of opposition." Applicant's Brief at 3. Opposer maintains that "the Board may consider goods not listed in the opposition but related to the goods and services for which Applicant seeks to register ENPOWER." Opposer's Brief at 8. We agree with applicant that the notice of opposition only raised the issue of confusing similarity in regard to opposer's registration and there was no pleading of common law rights. To the extent that opposer is relying on common law rights as a bar to the registration of applicant's mark, we will

Opposition No. 91117511

not consider this issue because it was not properly raised in the notice of opposition or tried by consent. Hoover Co. v. Royal Appliance Manufacturing Co., 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) ("This issue was not raised in Hoover's Notice of Opposition and the board did not rule on it. We decline to address it for the first time on appeal").

The next point that applicant raises concerns whether opposer "does not challenge the application as it relates to services in International Class 42." Applicant's Brief at 6. Opposer's arguments focus on applicant's services identified as "retail outlet services in the field of appliances" in International Class 35.⁶ In its reply brief (p. 3), opposer subsequently argues that applicant's "research and development of new products and services for others' could certainly cause confusion with Opposer's products and services if the results of Applicant's 'research and development' produced any of the wide range of products listed in Opposer's ENPOWER registration." It is too late for opposer to raise a new argument regarding the

⁶ Most of applicant's services such as "business consulting services rendered to cooperatives and municipal utilities" and "consulting services in the fields of power quality, power reliability, energy efficiency, environmentally-friendly energy, energy conservation, and energy management" are significantly different from opposer's computer-related goods. Opposer belatedly suggests that a company with opposer's computers may be a customer for applicant's services. As discussed later, the mere fact that a company purchases these goods and services does not indicate that the goods and services are related.

Opposition No. 91117511

International Class 42 goods. TBMP § 801.03 (The reply brief "must be confined to rebutting the defendant's main brief").⁷

Therefore, we now address the issue of whether the goods in opposer's registration are related to applicant's International Class 35 services. Opposer initially argues that the "parties products and services are the same." Opposer's Brief at 14. This is obviously not correct because applicant seeks a registration for services while opposer's registration is for goods.⁸ Therefore, the goods of opposer cannot be identical to the services of applicant.

Next, opposer argues that the parties' goods and services "are, at the very least, complimentary." Opposer's Brief at 15.

Applicant's electric power services, surge protectors, and UPS devices and Opposer's products and services are complimentary. Opposer's products include laptop/notebook and desktop computers and servers. The applicant's primary business is the marketing of electrical services. Any company who sets up a network using Opposer's equipment would obviously need to obtain electricity services to power that network.

Opposer's Brief at 17.

⁷ Furthermore, there is no evidence that applicant's research and development services resulted in "any of the wide range of products listed in Opposer's ENPOWER registration." Reply Brief at 3.

⁸ While opposer argues that it is providing "sales, repair and upgrade services, technical support services, and networking services" under the ENPOWER mark, these services are not reflected in its registration of record.

Opposition No. 91117511

Opposer's argument that people would associate the supplier of electric power with the source of products that run on electricity would make virtually all products that run on electricity related to the various services provided by power companies. There is no evidence that purchasers would simply assume that the sources of electricity and products that run on electricity come from the same, or are associated with, the same source. There is certainly no per se rule that these products and services are related.

Electronic Design and Sales Inc. v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (No confusion between battery chargers and power supplies and computer services); Falk Corp. v. Toro Manufacturing Corp., 493 F.2d 1372, 1378, 181 USPQ 462, 467 (CCPA 1974) ("Toro cannot prevail merely on the ground that 'rubber element shaft couplings' may be contained in some of Toro's machines"). Nor is there any basis in this case to hold that applicant's power related services and applicant's computer products are related.

Opposer also argues that "Applicant has sold surge suppression and UPS [uninterruptible power supplies]." Opposer's Brief at 17. These products may be sold through "retail outlet services in the field of appliances." They may also be sold directly to consumers or to one of applicant's cooperatives as part of applicant's services.

Opposition No. 91117511

We emphasize that applicant is not applying for the mark ENPOWER for surge suppressors or uninterruptible power supplies. In fact, applicant's witness stated unequivocally that it has not used the mark ENPOWER on products. Thielen dep. at 26 ("Q. Did EnPower Services sell any products that carried the EnPower brand name? A. No, they did not.").

Therefore, the question is whether prospective purchasers would believe there was an association between opposer's computer products and applicant's retail outlet services in the field of appliances. Even if we assume that surge suppressors and uninterruptible power supplies are sold in retail outlets in the field of appliances, we find that the relatedness of these products and services is remote. Electronic Design & Sales, 21 USPQ2d at 1392 ("[O]pposer urges that the likelihood of confusion that persons who use opposer's data processing and telecommunications services at work and who buy batteries at retail stores would be confused as to the source. The extension of 'relevant persons' to this group is untenable in this case"). Similarly here, the likelihood that people familiar with opposer's computer products and applicant's retail outlets in the field of appliances, would notice that applicant's outlets sell surge protectors, and therefore assume that the source of opposer's computers is associated with applicant's appliance outlet is remote.

Opposition No. 91117511

There is certainly no rule that all computer products and services are related. In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985) (“[W]e think that a per se rule relating to source confusion vis-a-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace”). See also Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d at 1463 (“All computer software programs process data, but it does not necessarily follow that all computer programs are related. Given the ubiquitous use of computers in all aspects of business in the United States today, this Board and its reviewing Court have rejected the view that a relationship exists between goods and services simply because each involves the use of computers”); Hasbro Inc. v. Clue Computing Inc., 66 F. Supp.2d 117, 52 USPQ2d 1402, 1406 (D. Mass. 1999), aff’d, 232 F.3d 1, 56 USPQ2d 1766 (1st Cir. 2000) (Court held that it would be “an extraordinary stretch to assert that Hasbro’s technical support to game users is similar in any meaningful way to the ‘computer consulting services’ provided by Clue Computing”). Even if applicant is providing surge protectors as part of its services, it is again difficult to see that a potential customer will associate applicant’s services with opposer simply because surge protectors of third parties are provided as part of

Opposition No. 91117511

applicant's services and surge protectors can also be used with opposer's computers.

Opposer also argues that appliances are defined as "an instrument or device designed for a particular use; specifically: a household or office device (as a stove, fan, or refrigerator) operated by gas or electric current." Opposer's Brief at 14. Opposer's definition is so broad that it includes virtually any and all devices in a home or office that use gas or electricity. Opposer then argues that its "products fall under this definition." Opposer's Brief at 14. A determination that goods are related is not a simple matter of finding a definition that can be stretched to include registrant's goods and then concluding that applicant's services include selling those goods. Electronic Data Systems Corp. v. EDSA Micro, 23 USPQ2d at 1463 ("[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both"). Accord In re Trackmobile, Inc., 15 USPQ2d 1152, 1153-54 (TTAB 1990) ("[W]hen the description of goods for a cited registration is somewhat unclear, as in the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade").

Opposition No. 91117511

We find that "appliance" can also be defined as "an instrument, apparatus, or device for a particular purpose or use" and "a piece of equipment, usually operated electrically, esp. for use in the home or for performance of domestic chores, as a refrigerator, washing machine or toaster."⁹ In determining whether there is a likelihood of confusion, "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." Witco Chemical Co. v. Whitefield Chemical Co., 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969). Here, the term "appliance" would more likely be associated by consumers with refrigerators, washing machines, and toasters as the definition above suggests. The record does not show that an "appliance repair" store would typically be expected to repair computers and servers simply because they may be included in the definition of appliances as instruments or devices designed for a particular purpose. Similarly, a retail outlet in the field of appliances would not be expected to sell computers simply because they meet the same definition. In this case, there is no evidence that

⁹ *Random House Dictionary of the English Language* (unabridged) (2d ed. 1983). We take judicial notice of this definition and opposer's and applicant's definitions attached to the briefs. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.,

Opposition No. 91117511

applicant is selling computers (see, e.g., Thielen Ex. 7), and the fact that computers may come within the ambit of a broad definition of appliances does not mean that there is anything more than a de minimis possibility of confusion in this case.

Several arguments made by the parties require comment although they have not affected our decision herein. Regarding the channels of trade, opposer argues that the trade channels are similar because both entities sell their services through "direct solicitation to customers and via the internet." Opposer's Brief at 20. Since virtually all products and services can be sold through the Internet and by direct solicitation, this does not establish that the channels of trade for the goods and services are similar.¹⁰ Furthermore, the fact that the same companies may purchase applicant's services and opposer's products is not determinative. Electronic Design & Sales, 21 USPQ2d at 1391 ("[A]lthough the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers").

213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁰ The fact that opposer's and applicant's web addresses are very similar is not an issue for this opposition proceeding.

Opposition No. 91117511

Applicant argues that the purchasers of opposer's goods and applicant's services are careful and sophisticated. While many of applicant's prospective purchasers of its consulting and business services (cooperatives and municipal utilities) would undoubtedly be careful, sophisticated purchasers, it is equally clear that many purchasers of opposer's computer products and applicant's retail outlet services in the field of appliances would be ordinary, non-sophisticated purchasers. In re Graphics Technology Corp., 222 USPQ 179, 181 (TTAB 1984) ("[W]hatever the situation may have been a decade or a generation ago, today's computer buyers cannot be uniformly classified as a technically adept or highly discriminating purchaser group").

Opposer argues that its mark is strong. However when we consider the evidence that opposer has submitted (see, e.g., Opposer's Brief at 22 for a summary),¹¹ we cannot conclude that opposer's mark is particularly strong. Opposer operates 42 stores in seven states. Its evidence of sales, advertising, and use indicates that, at best, opposer's mark has achieved some modest success in the marketplace.

Finally, regarding the concurrent use of the marks in the marketplace, both applicant and opposer acknowledge that there has been no actual confusion. See Opposer's Brief at

23; Thielen dep. at 14-15. Certainly, the absence of actual confusion does not demonstrate that there is no likelihood of confusion and we conclude that neither this factor, nor the factor regarding applicant's right to exclude others from use of its mark, favor either party.

When we consider the factors relevant to the issue of the likelihood of confusion, we determine that there is no likelihood of confusion in this case. Likelihood of confusion is decided upon the facts of each case. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In re Shell Oil Co., 992 F.2d 1204, 26 USPQ 1687, 1688 (Fed. Cir. 1993). The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Id.; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

While we have given significant weight to the fact that the marks are identical in this case, opposer's goods and applicant's services are significantly different. There is little evidence that opposer's mark is strong or that it is entitled to a broad scope of protection. The channels of trade do not directly overlap and it is unlikely that prospective purchasers would assume that applicant's services and opposer's goods originate from, or are associated with, a common source. See Electronic Design &

¹¹ Much of this evidence was submitted under seal and marked as

Opposition No. 91117511

Sales, 21 USPQ2d at 1392-93 (“[T]he potential for confusion appears a mere possibility not a probability”). Similarly, we hold herein that there is no likelihood of confusion between applicant’s and opposer’s marks when they are used on the identified goods and services in the application and registration.

DECISION: The opposition to the registration of applicant’s mark is dismissed.

“confidential.”