

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Paper No. 21  
Bottorff

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ISCAN Incorporated

v.

DVDO, Inc.

Opposition No. 118,770  
to application Serial No. 75/682,560  
filed on April 14, 1999

Request for Reconsideration

Before Quinn, Bottorff and Drost, Administrative Trademark  
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

This case now comes up<sup>1</sup> on opposer's request for  
reconsideration of the Board's September 19, 2002 decision  
dismissing opposer's Section 2(d) ground of opposition to  
registration of applicant's mark "iSCAN" for "video  
processing equipment, namely, video line doublers."<sup>2</sup>

<sup>1</sup> The Board regrets the delay in addressing this matter.

<sup>2</sup> Opposer's Section 2(d) claim was based on its ownership of a  
registration of the mark ISCAN for "electronic tracking units

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Applicant did not file a response to the request for reconsideration. After careful consideration of opposer's arguments, the Board adheres to its decision dismissing the opposition, but clarifies its previous opinion as follows.

Opposer argues that we erred in approving applicant's request to amend the identification of goods in the application to delete all of the "video processing equipment" goods except for "video line doublers." Opposer contends that the amendment is not proper under Trademark Rule 2.133 because applicant never filed a motion to amend the application, and because opposer never consented to such amendment. However, we remain of the opinion that the amendment was properly allowed. As noted in our opinion, although opposer did not expressly consent to the amendment, opposer's trial evidence was largely, if not exclusively, devoted to the issue of the relatedness of opposer's goods and applicant's video line doublers (as opposed to the other goods identified in the application as published). The Board was justified in finding (and applicant would be justified in assuming) that opposer had implicitly consented to the amendment. *Cf.* Fed. R. Civ. P. 15(b).

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featuring cameras, micro-processors, monitors and digital hardware units," and on its prior use of the same mark on what were identified in the notice of opposition as "eye movement monitoring systems."

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Moreover, even if the amendment were deemed to be unconsented, approval of the amendment was still proper. Applicant timely asserted, as an affirmative defense in its answer to the notice of opposition, its entitlement to registration at least as to the restricted identification of goods. This is an acceptable method of raising the issue. See, e.g., *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863 (TTAB 1991); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); TBMP §514.03 (2d ed. 6/03);<sup>3</sup> and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Reporter 408 (1991). Opposer apparently was not served with the answer, but it had obtained a copy of the answer prior to trial and was aware of the assertion of the affirmative defense. Opposer cannot claim to have been surprised; indeed, as noted above, most if not all of opposer's evidence at trial and the arguments in its brief pertained specifically to the issue of the registrability of applicant's mark for video line doublers, per se.

For the reasons discussed below and at length in our original opinion, we find that record establishes that applicant is at least entitled to registration of its mark

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<sup>3</sup> The Trademark Board Manual of Procedure (Second edition) is available online at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/>

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for video line doublers. Accordingly, we find that amendment of the application to delete all of the goods except "video line doublers" is proper.

In its request for reconsideration, opposer also contends that we erred in deeming applicant's mark to be the stylized mark depicted on page 1 of our opinion, because the mark was published for opposition as a typed mark. Opposer has submitted a copy of the Official Gazette page on which the mark was published, and it in fact appears to depict the mark in typed form. We are at a loss to understand why the mark was published in the Official Gazette as a typed mark; as discussed in footnote 1 of our opinion, prior to publication the application was amended to cancel the original typed drawing and replace it with the special form drawing, and the Office's official automated record for this application depicts the mark in special form.

However, any "error" which resulted from our consideration of applicant's stylized mark (which, after all, is the mark applicant seeks to register) as opposed to a typed mark is inconsequential because our ultimate conclusion as to likelihood of confusion is the same in either case. In our decision, we specifically found that applicant's mark and opposer's mark are similar notwithstanding the stylization of applicant's mark, and

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that the first *du Pont*<sup>4</sup> likelihood of confusion factor weighs in opposer's favor. We continue to deem the marks highly similar, especially given the fact that opposer's registered mark is depicted in typed form, and opposer therefore could display its mark in a manner similar to applicant's stylized mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Nonetheless, for the reasons discussed below and in our original decision, we remain of the opinion that even though the marks are highly similar, opposer has failed to prove its likelihood of confusion claim because it has failed to establish the requisite commercial relationship between its goods and applicant's goods.

We turn now to opposer's arguments on reconsideration regarding the merits of our likelihood of confusion determination. At pages 7-8 of its decision, the Board took judicial notice of an entry from The Dictionary of New Media (1999) which, in relevant part, defined "line doubling" as "a technique useful in home theatre applications for improving the apparent resolution of the broadcast image." The Board continued: "Based on this definition, we find

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<sup>4</sup> *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

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that the 'video line doublers' identified in applicant's application are consumer electronics items designed for use as components in 'home theatre applications.' There is no evidence in the record which shows, or from which it might reasonably be inferred, that 'video line doublers' are marketed or used in fields outside the consumer electronics/home theater field."

Opposer argues that because the "video line doublers" identified in applicant's application are not restricted as to fields of use or channels of trade, it was improper for the Board to base its finding as to the nature of applicant's goods on judicial notice taken solely from a specialized dictionary like The Dictionary of New Media. Opposer further argues that the Board erred in finding, based on the dictionary definition, that "video line doublers" are used exclusively in consumer electronic/home theater applications; opposer notes that the dictionary entry says only that line doubling is "useful" in such applications. Opposer has submitted, with its request for reconsideration, new evidence purporting to show that video line doublers are used in applications other than consumer electronics/home theater applications, and argues:

Since the media dictionary definition does not establish that video line doubling is exclusive to home theater applications, Rule 2.01(e) [sic - 201(e)] of the Federal Rules of Evidence commands that the Board consider the additional

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evidence presented herein in determining the propriety of its judicial notice, and the tenor of the matter noticed.

(Request for Reconsideration at 3.)

We are not persuaded of any error in our decision. First, our opinion did not state, nor did we find, that the dictionary evidence of which we took judicial notice establishes that video line doublers necessarily are used exclusively in consumer electronics/home theater applications. We found only that the dictionary evidence shows that video line doublers in fact are used in consumer electronics/home theater applications (a fact which is established by applicant's own use as depicted in its application specimens, and which is true regardless of whether we take judicial notice of the dictionary definition), and that the record is devoid of any evidence which shows, or from which it might be inferred, that any other applications or trade channels for video line doublers exist (a fact which likewise remains true regardless of whether or not we take judicial notice of the dictionary definition). See opinion at pp. 7-8, 15-16 and 20. To the extent, if any, that our opinion might be construed as including a finding that the dictionary definition of which we took judicial notice establishes that video line doublers necessarily are used

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exclusively in consumer electronics/home theater applications, we hereby clarify that we made no such finding.

Rather, our decision was based on the legal presumption that applicant's video line doublers are used in all of the fields and applications which are normal for such goods, and that they are sold in all normal trade channels and to all normal classes of purchasers for such goods. *See, e.g., In re Elbaum*, 211 USPQ 639 (TTAB 1981). We remain of the opinion, however, that opposer failed to present any evidence at trial as to what such "normal" applications, trade channels and classes of purchasers for video line doublers might be, and that opposer therefore provided us with no evidentiary basis for finding that opposer's and applicant's goods are sufficiently related in the marketplace that purchasers are likely to assume the existence of a source connection between the products. As discussed at length in our opinion, opposer's evidence concerning the relationship between the parties' goods consists of testimony showing that the goods share the same "flow diagram" and "core technology," a fact which might be of interest to engineers but which does not prove that confusion among purchasers in the marketplace is likely. Opposer's goods comprise equipment and systems used in and for what appear to be highly specialized eye-tracking and

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target-tracking applications. There is no evidence that video line doublers are competitive with, used together with, complementary to, or otherwise related to opposer's goods. There is no evidence that these goods would be purchased by the same purchasers, that they are sold in the same trade channels, or that they are types of goods which typically are manufactured or marketed by a single source under a single mark or similar marks.

From all that appears on this record, the only "normal" application or trade channel for video line doublers is in the consumer electronics/home theater field, as depicted in applicant's specimens (and as corroborated by the dictionary evidence of which we took judicial notice). Opposer has not argued that we erred in finding no marketplace relationship between video line doublers, as consumer electronics products, and opposer's goods; rather, opposer's argument on reconsideration is that we should not have limited our analysis to the consumer products field but should consider other applications for video line doublers. But even if we assume that other applications, trade channels and classes of purchasers for video line doublers, i.e., those outside the consumer electronics/home theater field, potentially might exist, we cannot make any assumptions as to what they are. It was incumbent on opposer to present evidence at trial as to what such applications, trade channels and

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classes of purchasers are and why their existence supports a finding that applicant's goods are related to opposer's goods in the marketplace. The record is devoid of such evidence, and we therefore stand by our decision that opposer has failed to prove its likelihood of confusion claim.

Finally, we are not persuaded by opposer's contention that Federal Rule of Evidence 201(e)<sup>5</sup> "commands" us to consider the new evidence submitted by opposer. Opposer may not use Federal Rule of Evidence 201(e) as a means of reopening its testimony period or introducing additional evidence in support of its likelihood of confusion claim, i.e., evidence regarding the nature of applicant's goods and their trade channels and classes of purchasers. Such evidence forms part of opposer's case-in-chief which should have been submitted, in proper form, during opposer's testimony period.

Decision on reconsideration: Our previous opinion is clarified to the extent discussed above. Otherwise, our opinion and decision stand. The opposition is dismissed,

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<sup>5</sup> Federal Rule of Evidence 201(e) provides:

**Opportunity to be heard.** A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of

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and applicant's application, as amended, shall proceed to registration in due course.<sup>6</sup>

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prior notification, the request may be made after  
judicial notice has been taken.

<sup>6</sup> The time for filing an appeal of the Board's decision in this case expires two months from the mailing date of this decision denying opposer's request for reconsideration. See TBMP §§902.02 and 903.04 (2d ed.).