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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Lastar.com, Inc.
v.
Global Manufacturing Solutions, LLC

Opposition No. 91151637
to application Serial No. 76148181
filed on October 17, 2000

B. Joseph Schaeff and Michael G. Frey of Dinsmore & Shohl
LLP for Lastar.com, Inc.

Mark Garscia of Christie, Parker & Hale, LLP for Global
Manufacturing Solutions, LLC.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application was filed on October 17, 2000 by Global
Manufacturing Solutions, LLC (a California limited liability
company) to register on the Principal Register the mark
GOCABLES for goods amended to read as "electronic cable
assemblies and accessories namely connectors, cables,
jack/pins" in International Class 9. The application is

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based on applicant's claimed date of first use and first use in commerce of September 2000.

Lastar.com, Inc. (an Ohio corporation) filed an opposition against this application, alleging that opposer manufactures and sells a wide variety of computer cables and connectivity products (e.g., computer cables, electrical cables, network cables, fiber optic cables, audio cables, video cables, adapters, computer network switches and routers, transceivers, computer interface boards, bulk wire, cable connectors) and offers custom cable manufacturing services all under the mark CABLES TO GO, "used in both text and stylized form incorporating a design" (paragraph 2); that opposer has used its mark CABLES TO GO continuously on goods and services since December 1984; that through extensive sales and advertising over a long period of time, opposer's mark has become widely known throughout the United States and the mark CABLES TO GO has become associated with opposer's goods and services; and that applicant's mark GOCABLES, when used on its goods, so resembles opposer's previously used mark as to be likely to cause confusion, mistake, or deception.

Applicant, in its answer, denies the salient allegations of the notice of opposition.¹

¹ Applicant asserted the affirmative defenses of "laches, acquiescence and estoppel." Applicant stated in its brief (p. 7) that it is no longer pursuing its (footnote continued)

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The record consists of the pleadings; the file of the opposed application; notices of reliance filed by both parties (including some material filed under seal as "confidential"); and the affidavit testimony,² with exhibits, of the following persons:

- (1) Geoffrey Hyman, opposer's president;
- (2) William Diederich, opposer's senior vice president of sales and marketing;
- (3) Mike Lin, applicant's president; and
- (4) the rebuttal affidavit testimony of William Diederich (filed under seal as "confidential").

Both parties have filed briefs on the case.³ Neither party requested an oral hearing.

Evidentiary Matter

Applicant objects to opposer's Exhibit DH, which consists of Section IV of a 1997 Venture Development Corporation Report titled *The U.S. Aftermarket For Computer Accessories, Second Edition* on the basis that it is inadmissible hearsay under Fed. R. Evid. 801(c) and that it is not a "market report" exception to the hearsay rule under

affirmative defenses. Accordingly, the Board will not further consider applicant's affirmative defenses.

² The parties stipulated to the filing of affidavit testimony. See Trademark Rule 2.123(b). Thus, opposer's motions (filed April 7, 2003 and July 21, 2003) and applicant's motion (filed June 4, 2003) for entry of affidavit testimony were unnecessary, and are deemed moot.

³ Opposer's uncontested motion (filed November 3, 2003 (via certificate of mailing) to reopen its time to file a reply brief three days late is granted pursuant to Fed. R. Civ. P. 6(b).

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Fed. R. Evid. 803(17). Applicant requests that we exclude from consideration the exhibit and "all portions of Opposer's Brief and Reply Brief that rely on the report...." (Applicant's brief, p. 29.)

Opposer contends that the report is admissible under Fed. R. Evid. 807, the residual exception to the hearsay rule. Opposer contends that this exhibit meets all the requirements of Rule 807, specifically, that (1) it has the "equivalent circumstantial guarantees of trustworthiness," (2) the statement is offered as evidence of a material fact, (3) the statement is more probative on the point for which it is offered than any other evidence which the proponent can procure through reasonable efforts, (4) the general purposes of the rules of evidence and the interests of justice will be served by admission of the statement into evidence, and (5) the proponent made known to the adverse party sufficiently in advance of trial the proponent's intention to offer the statement, and the particulars thereof, and to provide the adverse party a fair opportunity to meet it.

Applicant filed a reply brief in support of its motion to exclude certain material and arguments submitted by opposer. The Board, in its discretion under Trademark Rule 2.127(a) regarding reply briefs on motions, has considered

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applicant's reply brief regarding the admissibility of the material under Fed. R. Evid. 807.

Applicant's objection to opposer's Exhibit DH is sustained as the Board finds that the partial report submitted by opposer does not meet the requirements of Fed. R. Evid. 807 as a residual exception to the hearsay rule. See M. Graham, Federal Practice and Procedure: Evidence §7095 (Interim Edition 2001). Specifically, we find that this evidence (one section of a report made by a third-party) does not possess "equivalent circumstantial guarantees of trustworthiness," and we are not convinced either that the evidence is a necessity as being more probative on a point than any other evidence reasonably available to opposer, or that the material fact it is offered to prove is of substantial importance in determining the outcome of this case.

We point out that in the Advisory Committee Notes to Rule 807, the "Report of Senate Committee on Judiciary" stated as follows: "It is intended that the residual hearsay exceptions will be used very rarely, and only in exceptional circumstances." See also, *Conoco Inc. v. Department of Energy*, 99 F.3d 387, 392, __ USPQ2d __ (Fed. Cir. 1996).

With regard to applicant's request that the Board exclude the relevant portions of opposer's brief and reply

brief, the Board does not generally strike a properly and timely filed brief, or any portion thereof, but opposer's arguments in its briefs relating to Exhibit DH will be given no consideration. See TBMP §539 (2d ed. June 2003).

The Parties

Opposer, Lastar.com, Inc., was founded in 1983 under the name Cables To Go, Inc. Although the company's legal name has changed several times, the "CABLES TO GO" name is the name under which it operates its primary connectivity products business. Opposer first adopted and used the name and the term CABLES TO GO in 1984, and has continuously used the term in connection with the sale of a wide variety of cables and connectivity products for computers and other electronic products. Opposer's current products include the following: various computer cables (e.g., printer, modem, mouse, audio, video, data transfer, keyboard, monitor, joystick); various adapters (e.g., keyboard, modular, monitor, parallel, Y-mouse); power protection products (e.g., internal and external power cables, surge protectors, surge strips); cable tools and cable test products (e.g., cable strippers, loopback testers, network installation tool kits, punchdown tools); premise wiring products (e.g., couplers/splitters, keystone inserts, keystone jacks, relay racks, mounting brackets); switches; firewire products; ink

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jet cartridges; and numerous other specific products. Opposer has offered computer cables since 1984. Some of the other products were offered after that date as the technology gave rise to new types of cables and connectivity products.

Opposer has also offered custom cable manufacturing services and cable installation services using the term CABLES TO GO since 1984.

Opposer offers its goods and services for sale through catalogs, direct mailings, and online; and it advertises in magazines such as Computer Shopper, PC Magazine, Computer Reseller News, VAR Business and Cabling Installation & Maintenance. Opposer has exhibited (with its mark CABLES TO GO prominently displayed) at the leading industry trade show, Comdex, every year since 1984. Opposer has been the subject of some media attention in the form of articles in, for example, The Journal Herald (Dayton, Ohio), August 1, 1986; and the Dayton Jewish Chronicle, September 28, 1989.

Its sales figures and advertising expenses for the years 1998-2002 were submitted under seal as "confidential." Suffice it to say that these figures and expenses are substantial (in the millions of dollars).

Opposer is aware of no instances of actual confusion.

Applicant, Global Manufacturing Solutions, LLC, was founded in 1997 and first adopted the mark GOCABLES in May

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1999. Its first use of the mark for electronic cable assembles and accessories, namely, connectors, cables, jack/pins was in Internet banner advertisements around September 1999. Applicant began using the mark GOCABLES for its goods on its own Internet website in December 1999. Applicant began doing business under the name "gocables.com" in February 2000. Its use of the mark GOCABLES for its identified goods has been continuous since 1999.

Applicant distributes product brochures, and it advertises on the Internet and in magazines such as Network World and Communication News. Applicant has not participated in any trade shows.

Applicant's sales figures and advertising expenses for goods sold under the mark GOCABLES for the years 1998-2002 were submitted under seal as "confidential." (Suffice it to say that these figures and expenses are substantially less than those of opposer.)

Applicant was aware of opposer's use of the phrase CABLES TO GO for its goods "through industry knowledge prior to the time Applicant selected the mark GOCABLES." (Applicant's answer to opposer's interrogatory No. 12. See also, applicant's responses to opposer's requests for admission Nos. 3-4.) Applicant received the opinion of counsel as to the availability of the mark GOCABLES and

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regarding opposer's CABLES TO GO mark. (Applicant's answers to opposer's interrogatory Nos. 10 and 13.)

Applicant is aware of no instances of actual confusion.

The Issues

The issues before the Board are whether opposer has established prior rights in its mark,⁴ and if so, whether there is a likelihood of confusion between applicant's mark and opposer's mark.⁵

Standing

Opposer has shown use of the term CABLES TO GO for various cables and other connectivity products, as well as the services of custom cable manufacturing and cable installation. Opposer has therefore established standing.

⁴ Although opposer did not plead trade name rights in the words CABLES TO GO, both parties proceeded as if opposer had done so. We deem the pleadings amended to conform to the evidence under Fed. R. Civ. P. 15(b), that is, to specifically include a claim of trade name rights in the words CABLES TO GO. However, in light of our decision herein based on opposer's trademark and service mark rights in the mark CABLES TO GO, we need not determine whether opposer proved trade name rights. This decision will hereafter generally address only opposer's trademark and service mark rights in the mark CABLES TO GO.

⁵ Applicant contends that the issues in this case are (i) whether opposer has any protectable trade identity rights in the phrase CABLES TO GO because opposer abandoned any such rights in 1997; (ii) whether the unregistered phrase CABLES TO GO is merely descriptive of opposer's goods and services, and lacking in acquired distinctiveness; and (iii) whether there is a likelihood of confusion. While the issues before us are priority and likelihood of confusion, in determining opposer's rights in its unregistered asserted mark, we must necessarily decide the

Priority

A party asserting a claim under Section 2(d) of the Trademark Act must establish prior use of a trademark or service mark, or trade name or other indication of origin. As stated by the Court of Appeals for the Federal Circuit in the case of *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990):

Under the rule of *Otto Roth* [*Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)], a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently, or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43.

Applicant argues that the term CABLES TO GO is merely descriptive, and that opposer has not shown that it acquired distinctiveness prior to applicant's adoption of its mark. Moreover, applicant asserts that even if opposer acquired trademark/service mark rights in CABLES TO GO, such rights were abandoned in 1997 when opposer made a decision to abandon its previous name CABLES TO GO and adopted a new name, CTG and logo, as shown below

questions of abandonment and mere descriptiveness asserted by applicant.



Applicant further asserts that opposer did not resume use of CABLES TO GO until 2001, which is after applicant's filing date of October 17, 2000. As evidence of opposer's admission of the mere descriptiveness of the term CABLES TO GO, and abandonment of the asserted mark, applicant points particularly to opposer's 1997 product catalog (Exhibit X, page 00371) and the following statement of Mike Shane, Chairman, CTG, found therein:

"...we felt we had outgrown our Cables To Go name and look because it too narrowly defines the products and services we provide you. We now refer to ourselves as CTG, the single source supplier for all your data communications, networking, print sharing and connectivity needs."⁶

Opposer argues that this statement is neither an admission that CABLES TO GO is merely descriptive of the involved goods and services nor an abandonment of the mark and name CABLES TO GO. To the contrary, opposer asserts that this statement, and opposer's many uses of CABLES TO GO on that page (and every page) of the catalog show that opposer was adding a mark, not abandoning a mark and using

⁶ Applicant also references other uses by opposer such as those shown in opposer's Exhibit V, a 1997 direct mail piece, and Exhibit W, a 1997 promotional folder.

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only a replacement new mark; and that there are numerous non-descriptive and in fact, clear trademark/service mark uses of CABLES TO GO on that page and throughout that catalog.

With regard to applicant's argument in its brief that the phrase CABLES TO GO is merely (and highly) descriptive of opposer's goods and services, first, we note that applicant did not plead that opposer's mark is merely descriptive as an affirmative defense in its answer. While it is true that an opposer who is asserting common law rights in a mark must show that it functions as a trademark and/or service mark, an applicant should put an opposer on notice that it is taking the position that opposer's mark is merely descriptive by raising it as an affirmative defense. Applicant did not do so in this case.

In any event, we find that CABLES TO GO is an inherently distinctive mark, and that, even if it were not, opposer's admissible evidence demonstrates that it has acquired distinctiveness.

Applicant essentially argues that the above-quoted statement in opposer's 1997 catalog is an admission by opposer that CABLES TO GO is merely descriptive of opposer's goods and services; and that consideration of the mark itself shows that the mark is merely descriptive as it would be understood by purchasers to mean that opposer's products

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are "cables to be purchased and taken out." (Applicant's brief, p. 18.)⁷

Opposer's position is that its mark is inherently distinctive, or in the alternative, that it has acquired distinctiveness prior to applicant's first use.

Opposer contends that it has not admitted and does not admit that its mark CABLES TO GO is merely descriptive on its face; rather, it asserts that its mark is inherently distinctive because it is suggestive of the goods and services as indicating the ready availability of the goods and services from opposer, and that, even if the words "to go" have a particular meaning with regard to food and beverages ordered from restaurants (as argued by applicant referring to, inter alia, an interview with opposer's chairman, Mike Shane in a printed publication interview made of record as opposer's Exhibit DK), the words "to go" do not

⁷ Applicant refers in its brief to dictionary definitions of "to go" and "go" (pp. 19 and 34, respectively). Although applicant did not enclose copies of the dictionary pages, opposer did not object thereto, and treated the arguments on the merits. Thus, we have considered these dictionary definitions set forth by applicant.

Applicant also argues that the word "go" has a specialized meaning with regard to computers and e-commerce, specifically that it is "a command for an online service to switch the user to a particular forum or section," citing to the case of GoTo.com Inc. v. Walt Disney Co., 202 F.3d 1199, 53 USPQ2d 1652, 1657 (9th Cir. 2000). (Brief, p. 34.) There is no evidence of a specialized meaning of the word "GO" with regard to the involved goods and services in the case now before us. In addition, the cited case involved a claim under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a), and a preliminary injunction, and the Appellate Court discussed a possible connotation of "go" in relation to the strength of GoTo.com Inc.'s mark.

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carry any such meaning outside of that industry (e.g., a store clerk would not ask if a purchaser wanted a record, tape or CD "to go").

We find that the statement by opposer in its 1997 catalog cannot reasonably be read as an admission by opposer that its name and mark (used since 1984) is merely descriptive.

Nor is there any evidence that the phrase "TO GO" carries the same meaning for the involved goods that it carries for the take-out restaurant business. Moreover, there is certainly no convincing evidence that the phrase "CABLES TO GO" as a whole is merely descriptive. Thus, we find the phrase CABLES TO GO is inherently distinctive, not merely descriptive. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505 (CCPA 1980).

Based on this record and opposer's uses of the phrase CABLES TO GO, we find the mark is inherently distinctive in relation to opposer's goods and services.⁸

We also find that the evidence submitted by opposer (generally as part of the first affidavit testimony of William Diederich) clearly establishes its use of the words CABLES TO GO as a trademark for cables and as a service mark for custom cable manufacturing as of 1984 with continuous

⁸ Moreover, in the interest of thoroughness of the decision, we find that, even if it were not inherently distinctive, it had acquired distinctiveness prior to 1999.

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use since that date. Opposer has established continuous use of the word mark CABLES TO GO both alone and as part of a composite mark. Use of multiple marks in relation to goods

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and services is not precluded under the law. See General Foods Corporation v. Ito Yokado, Ltd., 219 USPQ 822(TTAB 1983).

We disagree with applicant's interpretation of the statement in opposer's 1997 catalog as proving that opposer abandoned use of its CABLES TO GO mark. The quoted statement by opposer cannot be reasonably interpreted as a clear abandonment by opposer of the name and mark CABLES TO GO, especially as, on the very same page of the 1997 catalog, opposer uses the term as the name of a division and as a mark. Even if opposer had *in fact* ceased use of CABLES TO GO as a trade name, (which it did not do), there is ample evidence of use of the phrase as a trademark and as a service mark for approximately fifteen years prior to applicant's proven first use of the mark GOCABLES in 1999. (See the affidavit of applicant's president, Mike Lin.)

We find that applicant's asserted evidence does not prove that opposer abandoned CABLES TO GO as a trade name; and that there is no evidence that opposer abandoned use of its mark CABLES TO GO for its goods and services.

Although applicant asserts opposer made changes to the mark, it is clear that in opposer's CTG CABLES TO GO and design mark, both the "CTG" portion and the "CABLES TO GO" portion create separate commercial impressions, and

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purchasers will still notice the word portion and recognize it as a separable element of the composite mark.

In sum, we find that: (i) opposer's mark is inherently distinctive (or if upon appellate review it is necessary, that opposer has established acquired distinctiveness), (ii) opposer did not abandon its mark CABLES TO GO, and (iii) opposer has established continuous use thereof as a trademark and service mark since 1984, which is well prior to applicant's proven first use in 1999. Therefore, with regard to the issue of priority and opposer's claim of common law rights in the mark CABLES TO GO for goods such as cables and services such as custom manufacture of cables, opposer has established its priority.

Likelihood of Confusion

Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Based on the record before us in this case, we find that confusion is likely.

We consider first applicant's goods and opposer's goods and services. The record clearly shows that the parties

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offer at least some identical goods (e.g., electronic accessories, namely, cables), and that applicant's "electronic cable assemblies and accessories namely connectors, cables, jack/pins" are highly related to opposer's custom cable manufacturing services and its cable installation services; and that these goods and services travel through the same trade channels. In fact, applicant stated the following in its brief (p. 31, footnote 5):

Applicant submits, for purposes of this proceeding only, that with respect to *DuPont* factors (2) and (3) [the similarity or dissimilarity and nature of the goods or services and the similarity or dissimilarity of trade channels], Applicant's and Opposer's goods and services are similar and have been sold through similar channels of trade.⁹

"When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

With regard to the purchasers, we find that the purchasers and potential purchasers for both parties' products are essentially the same, with evidence showing both parties offer their products to original equipment manufacturers, as well as the general public.

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As to the conditions of sale, as both parties agree, there is little evidence on this du Pont factor, but it is clear that both parties sell dozens of different types of cables and other connectivity products for computers and other electronic products; that these various cables have different applications and configurations; and that the parties' goods are relatively inexpensive (some less than \$2.00 each). Although purchasers and potential purchasers will presumably need to purchase the correct cable for the particular product or use for which it is intended, the care that they take will be directed to the size and/or nature of the cable rather than the trademark thereon. We therefore find that this factor favors opposer.

We turn next to consideration of the similarities or dissimilarities of the marks. As previously discussed, opposer has established common law rights in the mark CABLES TO GO. Applicant applied for its mark in typed form as GOCABLES. Obviously, the marks are not identical, but both parties' marks include the word "cables" (generic for some of the goods) and the word "go."

Applicant asserts that its mark is all one word and will not immediately be recognized as having the two components "go" and "cables." We disagree; in fact, it can

⁹ In applicant's footnote 5, we note that applicant agreed with opposer that du Pont factors 9-13 are "of limited significance" and "do not need to be addressed."

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easily be read by consumers as the two words "GO CABLES." Moreover, it is permissible for the Board to consider applicant's trade dress or actual use of the mark for the purpose of determining whether applicant's mark projects a confusingly similar commercial impression to opposer's mark. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Virtually all of applicant's uses of its mark which are in this record (including the specimen in its application file) show that applicant uses the mark as "GoCables." Thus, applicant intends that its customers perceive the mark as two words, "GO CABLES."

It is well settled that marks must be considered in their entireties because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of one mark to another to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

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Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

In this case, both applicant's and opposer's marks share the words "cables" and "go." Applicant has transposed the order of the words and removed the word "to" used by opposer. However, these differences do not serve to distinguish the marks. These marks, although not identical, are similar in sound and appearance.

The connotation created by both applicant's mark GOCABLES and opposer's mark CABLES TO GO would be similar in that both phrases connote the idea of readily available cables or an easy means to obtain cables. Applicant's mark could even be viewed by consumers already familiar with opposer's mark as a variation of opposer's mark.

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When considered in their entirety, we find that applicant's "GOCABLES" mark and opposer's "CABLES TO GO" mark are similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Opposer acknowledges that there is little evidence of record regarding the fame of its mark, but opposer contends that its mark "if not famous, at least enjoys a level of recognition greater than competitive marks in the same field," and that it "is at least very well known in the computer products industry." (Brief, pp. 30 and 31.) Opposer bases this assertion on its many years of use and its substantial annual advertising expenses and annual sales figures. Applicant, on the other hand, contends that opposer's mark is merely descriptive and is entitled to a narrow scope of protection; and that the years of use and advertising and sales figures do not establish consumer recognition of the mark.

We agree that this record does not establish that opposer's mark is famous (a point virtually conceded by opposer). However, we find that the record does establish opposer's mark CABLES TO GO is a well-known mark in the field of cables and other related connectivity products for

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computers and other electronic products.¹⁰ (The record does not show that opposer's mark is as well known for its services.) See Bose Corporation v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). Thus, opposer's mark is entitled to a broad scope of protection.

Turning to the du Pont factor of the number and nature of similar marks in use on similar goods, applicant argues that "the evidence shows that many companies sell computer cables under similar business names and marks." (Brief, p. 40). The evidence submitted by applicant on this point consists of (i) the affidavit testimony of its president, Mike Lin, in which he avers that he printed out pages from three web sites, www.cables.com, www.cablesdirect.com, and www.gotcables.com; and (ii) applicant's notice of reliance on the application file history of opposer's pending application (Serial No. 76407549) wherein a third-party registration for the mark CABLE TO-GO (in stylized lettering) for a "travel kit for satellite receiving equipment comprising,..."¹¹ was cited against opposer's application, and a third-party application (Serial No. 75496372) was noted for the mark CABLES DIRECT for "wholesale ordering services in the field of computer

¹⁰ As we have previously stated, we reject applicant's position that opposer's mark is merely descriptive.

¹¹ Registration No. 2016838, issued November 19, 1996 and was cancelled under Section 8 of the Trademark Act, 15 U.S.C. §1058, in 2003. (The word "cable" is disclaimed.)

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hardware and online ordering services featuring computer hardware."¹² Opposer submitted printouts of a Google search list for "cables.com" and of a QwestDex search list for "go in Texas and surrounding area," both carried out by applicant; and reports from two private companies showing the results of searches of the terms "GOCABLES" and "GO CABLES," both ordered by applicant.¹³

The third-party uses from the Internet are of names or marks with the word "cable(s)" or "go"; but none includes third-party use of both words, "cable(s)" and "go." Thus, the record is devoid of third-party uses of marks which include the words "cable(s)" and "go" for the involved goods and/or services. As for the third-party registrations, the existence of third-party registrations is not evidence of use of those marks in the marketplace or that consumers are familiar with them. Moreover, one of the third-party registrations (for CABLE TO-GO in stylized lettering) is for goods which are different from opposer's and applicant's, while the other (for CABLES DIRECT) is for a mark whose only similarity to the instant marks is the inclusion of the generic word "cable." We find that this factor favors opposer.

¹² This third-party application issued under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f) as Registration No. 2770520 on October 7, 2003 to Du International, Inc.

¹³ Applicant admitted the authenticity of these documents.

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Applicant argues that there have been no instances of actual confusion, despite meaningful opportunity therefor in three years of simultaneous use. We do not agree that three years use is a particularly lengthy time period for there to have been meaningful opportunity for actual confusion. In addition, given the inexpensive price of the involved goods, it is entirely possible that consumers would not report instances involving actual confusion of the marks. Thus, the absence of actual confusion is not surprising. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). This du Pont factor is neutral.

Finally, to the extent we have doubt as to whether confusion is likely, we resolve that doubt against the newcomer (applicant) and in favor of the prior user (opposer). See *In re Pneumatiques, Caoutchouc Manufacture*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973) ("If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant.") See also, *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d

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1889, 1892 (Fed. Cir. 1991); *In re Hyper Shoppes*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290-1291 (Fed. Cir. 1984).

Decision: The opposition is sustained, and registration to applicant is refused.