

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
March 22, 2007

Mailed:  
Sept. 21, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

VTech Holdings Limited  
v.  
Varian Semiconductor Equipment Associates, Inc.

---

Opposition No. 91156936  
to application Serial No. 76429802  
filed on July 12, 2002

---

Richard Eugene Dick of Greenberg Traurig, P.C. for VTech Holdings Limited.

Michael Bevilacqua of Wilmer Cutler Pickering Hale & Dorr LLP for Varian Semiconductor Equipment Associates, Inc.

---

Before Grendel, Rogers and Taylor, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

**INTRODUCTION**

Varian Semiconductor Equipment Associates, Inc.  
(applicant) seeks registration on the Principal Register of  
the mark VTECH (in standard character form) for services

**Opposition No. 91156936**

recited in the application as "conducting seminars in the field of semiconductor manufacturing," in Class 41.<sup>1</sup>

VTech Holdings Limited (opposer) has opposed registration of applicant's mark on the ground that the mark, as applied to applicant's services, so resembles opposer's previously-used and registered mark VTECH as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>2</sup> Applicant answered the notice of opposition by denying the salient allegations thereof.

The case has been argued by both sides in their briefs, and an oral hearing was held at which opposer's counsel, but not applicant's, appeared and presented additional arguments.

After careful consideration of the evidence of record and all the parties' arguments, and because we conclude that opposer has failed to establish the existence of a

---

<sup>1</sup> Serial No. 76429802, filed on July 12, 2002. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

<sup>2</sup> In the notice of opposition, opposer also alleged dilution as a ground of opposition. However, opposer presented no evidence or argument in support of this ground. In view of opposer's failure of proof on this pleaded ground of opposition, we dismiss the opposition with prejudice as to such ground.

likelihood of confusion, we dismiss the opposition.

**EVIDENTIARY AND PLEADING ISSUES**

Initially, certain evidentiary and pleading issues require discussion.

**Opposer's Registrations At Issue.**

In the notice of opposition filed on April 21, 2003, opposer, in support of its Section 2(d) claim, alleged ownership of a single registration, i.e., Reg. No. 2029481, of the mark VTECH (in stylized lettering) for various goods in Class 9. That registration was cancelled under Trademark Act Section 8 on October 18, 2003. At trial, under its notice of reliance, opposer did not submit a copy of the pleaded (cancelled) registration, but submitted photocopies of six other registrations, i.e., Reg. Nos., 2782574, 2743825, 2753372, 2743258, 1761498 and 1667461.

These six additional registrations were not pleaded in the notice of opposition. However, applicant has not objected to them on that ground, and in its brief has treated them as being of record. In view thereof, we deem the pleadings to be amended to include opposer's claim of ownership of the six additional registrations. We likewise deem applicant's answer to be amended to deny opposer's

**Opposition No. 91156936**

claim of ownership of the additional registrations. See Fed. R. Civ. P. 15(b).

The copies of the six registrations which opposer submitted with its notice of reliance are not status and title copies, and opposer presented no testimony or other evidence otherwise establishing the status and title of the registrations. In its brief on the case, opposer cited to all seven of the registrations, including the cancelled '481 registration. In its brief, applicant stated that opposer "owns" the seven registrations, but noted specifically that the originally-pleaded '481 registration had been cancelled. Applicant has treated the six existing registrations as being properly of record. In these circumstances, and despite opposer's failure to comply with the requirements for the submission of registrations as set forth in Trademark Rule 2.122(d)(2), 37 C.F.R. §2.122(d)(2), we deem applicant to have waived any objection and to have conceded the status and title of the six additional registrations.<sup>3</sup>

**Opposer's Notice of Reliance.**

On June, 30, 2005, the last day of its testimony period as reset, opposer submitted thousands of pages of documents by a notice of reliance under Trademark Rule 2.122(e), 37

---

<sup>3</sup> The concession as to ownership is explicit. The concession as to status is implicit in applicant's differentiation of the one cancelled registration from the others.

**Opposition No. 91156936**

C.F.R. §2.122(e).<sup>4</sup> Opposer submitted no testimony or other evidence at trial.

Broadly categorized, the documents submitted under the notice of reliance include: (1) opposer's own catalogs and other promotional materials relating to its goods, as well as third-party retailer catalogs in which opposer's goods appear; (2) opposer's corporate annual and interim reports for various years; (3) photographs of awards purportedly received by opposer; (4) documents provided by applicant to opposer during discovery; (5) several articles about and mentions of opposer and its business in newspapers, magazines and trade publications; (6) opposer's pleaded registrations; (7) file wrappers of opposer's pleaded registrations; and (8) documents from other TTAB proceedings brought by opposer against third parties.

Prior to the commencement of its own testimony period, applicant filed a motion to strike much of the material

---

<sup>4</sup> We note generally that, in the context of this relatively straightforward Section 2(d) case, opposer's filing of thousands of pages of documents clearly was excessive and unnecessary. This is especially so with respect to the nearly one thousand pages of opposer's marketing materials, the nearly one thousand pages of opposer's corporate annual reports, and the nearly eight hundred pages of the file wrappers of opposer's pleaded registrations.

Particularly in a time when such materials are easily stored as image-based documents in electronic form and printed out at the touch of a button, counsel may find it relatively easy to print and submit numerous documents. Counsel, however, should exercise discretion and restraint and submit at trial, for later discussion in briefing the case, only representative documents that are truly relevant and admissible, not all documents that can be accessed and easily printed.

**Opposition No. 91156936**

submitted with opposer's notice of reliance, on various grounds. In response, opposer filed an amended notice of reliance in which it withdrew certain of the documents applicant had objected to. Applicant, in its reply brief in support of the motion to strike, continued its objections to certain documents submitted by opposer and not withdrawn. Additionally, applicant expressly objected to opposer's notice of reliance in its entirety on the ground that "many of the documents attempted to be placed in the record by the Opposer are not the proper subject of a Notice of Reliance. For whatever reason, Opposer has not taken any testimony in this proceeding, and these documents are not self-authenticating. Applicant will not raise that particular objection with respect to each document and reserves the right to raise that issue in its brief." (Reply brief on motion to strike, at 2.)

In an order issued October 6, 2005, the Board granted applicant's motion to strike as to certain of the specific objections raised by applicant, and deferred ruling on applicant's remaining specific objections until final hearing. The Board did not address applicant's general objection which was based on the impropriety of opposer's submission of many of the documents via notice of reliance.

In its appeal brief on the case, applicant maintained all of its objections to opposer's notice of reliance as set

**Opposition No. 91156936**

forth in its reply brief on the motion to strike. In addition to maintaining its specific objections to specific documents as to which the Board had deferred a ruling, applicant maintained its more general objection that "documents other than the Opposer's registrations cannot be used to prove the truth of the matter contained therein, when submitted by Notice of Reliance without further testimony, and should be stricken." (Applicant's brief, at 1.)

The reference in this statement to documents which "cannot be used to prove the truth of the matter contained therein" appears to confusingly commingle elements of a hearsay objection with the "improper subject of notice of reliance" objection. Notwithstanding this "hearsay" language, and in view of applicant's express contention that the documents should be stricken because they are "submitted by Notice of Reliance without further testimony," we find that applicant has sufficiently and properly maintained its general objection to opposer's notice of reliance evidence on the ground that it is not the type of evidence which may be submitted via notice of reliance. Nor do we deem applicant's maintenance, in the alternative, of its more specific objections to certain documents, to be a waiver of its general objection as to all of the documents on the

ground that they are not properly the subject of a notice of reliance.

We turn now to the merits of that objection, and consider its application to the various categories of documents opposer submitted via notice of reliance.<sup>5</sup> As to those documents which we find to be not properly of record because they cannot be submitted via notice of reliance, we need not and do not reach applicant's alternative, more specific objections (on the ground of hearsay, for example). As to any of the documents which we find to be of a type properly made of record by notice of reliance and as to which applicant has made alternative, more specific objections, we shall address those specific documents and objections *infra* as necessary, in conjunction with our discussion of any such evidence that bears on the underlying merits of the case.

---

<sup>5</sup> We need not and do not consider those documents which the Board has already stricken by its October 6, 2005 order, or those documents which opposer has specifically withdrawn in its response to the original motion to strike or in its appeal brief. However, among the documents withdrawn by opposer in its appeal brief are several articles from Business Week magazine (OPP 6405-6433). In its reply brief, opposer has attempted to retract its withdrawal of these documents, contending that the withdrawal was inadvertent and noting that these documents were specifically cited to and relied on by opposer in the body of its main brief. We shall deem these documents to be of record and shall consider them for whatever probative value they deserve.

**Opposition No. 91156936**

The issue under Trademark Rule 2.122(e)<sup>6</sup> is whether the various documents submitted by opposer are "printed publications" or "official records" which, because they are self-authenticating, may be submitted by notice of reliance. Documents which are not self-authenticating printed publications or official records may not be made of record by notice of reliance. We rule as follows:

(1) Opposer's catalogs and promotional materials, and third-party retailer catalogs and advertisements in which opposer's goods appear, are not self-authenticating printed publications or official records and may not be made of record by notice of reliance. See, e.g., *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); and *Minnesota Mining &*

---

<sup>6</sup> Trademark Rule 2.122(e) provides as follows:

*Printed publications and official records.* Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

*Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433 (TTAB 1973). We sustain applicant's objection to all such documents and shall give them no consideration.<sup>7</sup>

(2) Opposer's corporate annual reports, newsletters and other house publications are not self-authenticating printed publications or official records and may not be made of record by notice of reliance. See, e.g., *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767 (TTAB 1980); *Andrea Radio Corp. v. Premium Import Co.*, *supra*; *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, *supra*; and *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407 (TTAB 1975). We sustain applicant's objection to all such documents and shall give them no consideration.<sup>8</sup>

(3) The photographs of awards purportedly awarded to opposer are not self-authenticating printed publications or official records and may not be made of record by notice of reliance. We sustain applicant's objection to all such documents and shall give them no consideration.<sup>9</sup>

(4) The documents applicant produced to opposer during discovery in response to opposer's requests for documents under Fed. R. Civ. P. 34 are not self-authenticating printed publications or official records and may not be made of record by notice of reliance. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. §2.120(j)(3)(ii). We sustain applicant's objection

---

<sup>7</sup> These documents include those numbered as OPP 100-1154, 3913-3933, 6104-1411, 6132-6146, 6401.1-6401.2, 6523, and 6565-6575, as well as any others which fall into this category of stricken documents.

<sup>8</sup> These documents include those numbered as OPP 3000-3961 and OPP 6100-6131, as well as any others which fall into this category of stricken documents.

<sup>9</sup> These documents include those numbered as OPP 1155-1158, as well as any others which fall into this category of stricken documents.

to all such documents and shall give them no consideration.<sup>10</sup>

(5) The copies of articles from newspapers, magazines and trade publications submitted by opposer are deemed to be printed publications and thus are admissible via notice of reliance.<sup>11</sup> We shall consider these articles for whatever they may show on their face, but not for the truth of the matters asserted therein. See, e.g., *Logicon, Inc. v. Logisticon, Inc.*, *supra*; *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310 (TTAB 1975); and *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443 (TTAB 1974).

(6) The copies of opposer's pleaded registrations are official records properly made of record via notice of reliance, and shall be considered. (See discussion regarding these registrations, *supra*.)<sup>12</sup>

(7) The file wrappers and assignment records of opposer's pleaded registrations, to the extent that they are comprised of copies of documents obtained from the Office's official records and are not merely copies of documents from opposer's own files (see *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504 (TTAB 2000); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905 (TTAB 1985)), are admissible via notice of reliance and shall be considered.<sup>13</sup>

(8) The documents from previous TTAB proceedings involving opposer, to the extent that

---

<sup>10</sup> These documents include those numbered as VN 00001-00081, as well as any others which fall into this category of stricken documents.

<sup>11</sup> These documents include those numbered as OPP 1162-1184 (The Toy Book); OPP 1185-1187 (Chicago Sun-Times); OPP 6405-6433 (BusinessWeek); and OPP 6214-6339 and OPP 6434-6503 (various electronics industry publications, including Electronic Business). In its appeal brief, opposer withdrew reliance on other articles (including online versions of some of the print articles noted above) submitted as OPP 6145-6213.

<sup>12</sup> These documents are numbered OPP 2788-2799.

<sup>13</sup> These documents are numbered OPP 2000-2787.

they are comprised of copies of documents obtained from the Office's official records and are not merely copies of documents from opposer's own files (see *Hard Rock Café International (USA) Inc. v. Elsea, supra*; *Osage Oil & Transportation, Inc. v. Standard Oil Co. supra*), are admissible via notice of reliance and shall be considered.<sup>14</sup>

With respect to the documents as to which we have sustained applicant's objection (categories (1)-(4) above), we note that even if we had considered these documents, they would not have changed our decision on opposer's Section 2(d) claim.

## **THE MERITS**

### **Opposer's Registrations Summarized.**

We turn now to the merits of the case. As discussed above, we deem opposer's six registrations to be properly of record and find that the evidence of record is sufficient to establish that the registrations are in force and are owned by opposer. These registrations are summarized as follows:

- Registration No. 2782574, which is of the mark VTECH (in stylized form) for a variety of Class 9 goods broadly categorized as telecommunications products such as telephones and answering machines; computers, computer peripherals and computer software products (including software for children's educational toys and learning aids);

---

<sup>14</sup> These documents are numbered OPP 5000-5188.

**Opposition No. 91156936**

and consumer electronics products such as digital cameras, personal digital assistants, and products used for recording and reproducing images and sounds;<sup>15</sup>

- Registration No. 2743258, which is of the mark VTECH (in a different stylized form) for substantially the same goods as those identified in the '574 registration outlined above;

- Registration No. 1667461, which is of the mark VTECH (in standard character form) for Class 9 goods identified as "computers; calculators; computer programs for disk

---

<sup>15</sup> In its entirety, the identification of goods in this '574 registration reads as follows:

telecommunications apparatus and instruments, namely telephones, videophones; telephone answering machines; computing apparatus and instruments, namely, computers, computer monitors, and computer keyboards; computer programs recorded on magnetic or optical media for use in educating children, for use in transmitting and receiving text, sound and images via a global computer network, and for use in operating systems, education, computer games, and handheld personal organizers; computer peripherals, namely, printers, disk drives, memory modules and interface modules; video cards, audio cards, mouse trackballs and joysticks; computer game software; video game machines and toys adapted for use with television receivers, namely, instructional and teaching apparatus in the form of computer controlled educational and instructional toys and activity centers for children, namely electronic educational game machines for children; electronic computer learning aids comprising electronic sound producing computers; apparatus for recording, transmission or reproduction of sound or images, namely, digital cameras, digital video recorders, personal digital assistants, personal digital assistant computers, sound amplifiers, audio players and recorders, compact disc players and recorders, digital video line players and recorders, radios, televisions, audio receivers, video cameras, photographic cameras, video monitors; apparatus for receiving video signals transmitted from satellites; antennas and decoders; parts and fittings for all the aforesaid goods.

**Opposition No. 91156936**

operating systems; voice synthesis cartridges; mouse input devices; touch tablet input devices; and voltage adaptors”;

- Registration No. 1761498, which is of the mark VTECH (in standard character form) for Class 28 goods identified as “electronic learning aids; namely, electronic educational games for the teaching of children; hand-held electronic games; electronic sound-making activity toys and games; electronic table-top games; and electronic playsets; dolls, toy vehicles; electronic musical toys; toy microphones”;

- Registration No. 2743825, which is of the mark VTECH (in stylized form) for Class 28 goods identified as “toys and games, namely, children’s multiple activity toys; electronic educational game machines for children; musical toys; electronic table top games; hand-held unit for playing electronic toys and games; construction toys; stuffed toys, crib toys; bath toys; dolls and doll accessories; play mats; water toys, namely, toys that float, squirt or carry water;” and

- Registration No. 2753372, which is of the mark VTECH (in a different stylized form) for Class 28 goods which are essentially the same as those identified in the ‘825 registration outlined above.

**Standing.**

Because applicant has conceded the ownership and status of opposer's registrations, we find that opposer has established its standing to oppose registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); see also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

**Section 2(d) Priority.**

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods covered by said registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer has argued, and we will assume that opposer has proven, that it also has prior common law rights in its VTECH mark

in association with its contract manufacturing services which involve the manufacture of products for OEM (Original Equipment Manufacturers) customers. Opposer's design and engineering services are typically provided as part of Opposer's contract manufacturing business. Products produced [by] the VTECH contract manufacturing division include phones, multi-media communication products, television set top boxes, audio equipment, switching mode power supplies, home appliances and wireless products.

(Opposer's main brief at 2-3.)

**Likelihood of Confusion.**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find that applicant's mark VTECH is identical to opposer's VTECH mark in terms of appearance, sound, connotation and overall commercial impression. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the second *du Pont* factor, we consider the similarity or dissimilarity of the parties' respective goods and/or services. It is settled that it is not necessary that the goods and/or services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods and/or services themselves, but

**Opposition No. 91156936**

rather whether they would be confused as to the source of the goods and/or services. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods and/or services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods and/or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Finally, in cases such as this where the applicant's mark is identical to the opposer's mark, there need be only a viable relationship between the respective goods and/or services in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

We find that even under the less rigorous "viable relationship" standard applied in cases where the parties' marks are identical, in this case applicant's services are

**Opposition No. 91156936**

dissimilar and unrelated to opposer's goods and services, for purposes of the second *du Pont* factor.

We first consider applicant's services as compared to opposer's goods. Applicant's services are recited in the application as "conducting seminars in the field of semiconductor manufacturing." Opposer's goods, as identified in opposer's registrations, are consumer electronics products and devices, including telephone products, computer hardware and software products, and children's electronic educational products. We find that opposer's consumer electronics products and devices, on their face, are dissimilar to applicant's "conducting seminars in the field of semiconductor manufacturing."

Opposer argues, however, that opposer's goods and applicant's services are related because they both involve semiconductors. Opposer contends that most if not all of its electronics products use, incorporate or are controlled by semiconductors, a contention that we will assume is true for purposes of this decision. However, we cannot agree with opposer's further contention that because its electronics products and devices use or incorporate semiconductors, opposer itself is "in the semiconductor industry" (reply brief at 12). Nor can we agree with opposer's contention that because the products and devices identified in opposer's registrations incorporate

semiconductors, "each of the Registrations inherently incorporates semiconductors in their respective identification of goods" (main brief at 5), or that the registrations therefore "include semiconductors within their scope of protection" (main brief at 7). Nothing in the record establishes or even suggests that opposer is in the business of manufacturing or marketing semiconductors per se, or that relevant consumers would be likely to assume such a fact merely because opposer's products and devices (like the products of many if not all other electronics products companies) incorporate or utilize semiconductors.

In short, opposer's goods are consumer electronics products, and applicant's services are conducting seminars in the field of semiconductor manufacturing. The mere fact that opposer's goods incorporate semiconductors does not suffice to make opposer's goods similar or related to applicant's services, for purposes of the second *du Pont* factor.

We turn next to opposer's contention that its services, i.e., its contract manufacturing services (and associated design and engineering services) rendered to OEM customers, are similar and related to applicant's semiconductor manufacturing seminar services, for purposes of the second *du Pont* factor. In its brief, opposer asserts that its services involve the manufacture or production by opposer,

**Opposition No. 91156936**

at the request of its OEM customers, of electronics products opposer identifies as "phones, multi-media communication products, television set top boxes, audio equipment, switching mode power supplies, home appliances and wireless products." (Main brief at 2-3.)

Again, opposer is not in the semiconductor industry; it neither manufactures nor markets semiconductors, per se. The record does not support a finding that any relevant purchaser would be likely to assume that opposer's contract manufacturing services are related to applicant's semiconductor manufacturing seminars merely because the products opposer manufactures for its OEM customers include or incorporate semiconductors. This sole point of commonality between the respective services is far too tenuous to establish that the services are similar or related for purposes of the second *du Pont* factor.

Additionally, we find opposer's "natural expansion" argument to be unpersuasive. Opposer contends that relevant purchasers would assume, upon encountering applicant's semiconductor manufacturing seminar services, that opposer, in the natural course of the expansion of its business, has entered the semiconductor manufacturing seminar business. Opposer points out that applicant itself has expanded or intends to expand from its primary business of manufacturing semiconductors into the new and related business of

**Opposition No. 91156936**

conducting seminars in the field of semiconductor manufacturing. The obvious flaw in opposer's argument is that unlike applicant, opposer is not in the business of manufacturing semiconductors. Opposer is in the business of manufacturing and marketing consumer electronics products. The mere fact that opposer's products incorporate semiconductors is not likely to lead anyone to believe that opposer has expanded from the consumer electronics manufacturing business into the semiconductor manufacturing seminar business. Moreover, opposer has presented no evidence that any other consumer electronics products manufacturer has expanded into the business of conducting seminars in the field of semiconductor manufacturing, much less evidence showing that such expansions are so common that relevant purchasers would naturally expect or assume that opposer has made such an expansion.

In short, we find that opposer's goods and services are dissimilar and unrelated to the services recited in applicant's application. The second *du Pont* factor weighs against a finding of likelihood of confusion.

Under the third *du Pont* factor, we consider the similarity or dissimilarity of the trade channels for the parties' respective goods and services, and, relatedly, the similarity or dissimilarity of the classes of purchasers of the respective goods and services.

**Opposition No. 91156936**

As opposer itself contends, applicant's seminar services are marketed to semiconductor manufacturers and are rendered at semiconductor industry trade shows. Opposer's consumer electronics goods are marketed to ordinary consumers in ordinary retail trade channels, and its contract manufacturing services are marketed to OEM manufacturers in trade channels which are normal for such services. There is no evidence to support a finding that there is any overlap in the trade channels in which applicant's and opposer's respective goods and services are marketed, or that the classes of purchasers for the respective goods overlap.

Opposer argues that "Applicant's services are directed to the very class of consumers (semiconductor manufacturers) who sell semiconductors to Opposer. Such companies are likely to deal with both Opposer and Applicant and, therefore, are highly susceptible to confusion." (Opposer's brief at 13.) Similarly, opposer argues that applicant's services are marketed to semiconductor manufacturers, the same manufacturers who "manufacture and solicit the sale of microprocessors to Opposer. Thus, such companies are likely to deal with both Opposer and Applicant." (Opposer's brief at 15.)

This argument is wholly unpersuasive. On its face, it acknowledges that semiconductor manufacturers, the

**Opposition No. 91156936**

purchasers of applicant's seminar services, are opposer's vendors or suppliers, not opposer's customers or potential customers. Opposer does not market its goods and services to the semiconductor manufacturers who are the purchasers of applicant's services, but rather to ordinary consumers and to OEM manufacturers. In direct contrast, applicant does not market its services to the ordinary consumers and OEM manufacturers who are the purchasers of opposer's goods and services, but rather to semiconductor manufacturers. Simply put, the parties market their respective goods and services to different purchasers, in different marketing channels. The fact that a semiconductor manufacturer is likely to "deal with" both opposer (as a semiconductor vendor) and applicant (as a seminar customer) is far too tenuous to support a finding, under the third *du Pont* factor, that the parties' respective goods and services are likely to be encountered by the same purchasers in circumstances that would give rise to a likelihood of confusion. We find that the third *du Pont* factor weighs against a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider the conditions of purchase, including the sophistication of purchasers. We find that the semiconductor manufacturers to whom applicant markets and renders its seminar services are sophisticated and knowledgeable purchasers, a fact which

**Opposition No. 91156936**

diminishes any likelihood of confusion. Opposer concedes that semiconductor manufacturers are knowledgeable and sophisticated, but then goes on to contend that this knowledge and sophistication on the part of applicant's purchasers actually weighs in favor of a finding of likelihood of confusion. Opposer argues that applicant's purchasers are in fact so knowledgeable about the electronics industry that they are likely to know that opposer markets its electronics goods and services under the VTECH mark. This argument, though somewhat novel, is unpersuasive. Even assuming that semiconductor manufacturers are aware of opposer and its VTECH products and services, such awareness does not mean that they are likely to assume that opposer is the source of or affiliated with applicant's completely unrelated and dissimilar semiconductor manufacturing seminar services. We find that the fourth *du Pont* factor weighs against a finding of likelihood of confusion.

The fifth *du Pont* factor requires consideration of the fame of opposer's mark. We find that the evidence of record fails to establish that opposer's mark is famous. There is no competent evidence showing opposer's revenues or promotional expenditures in connection with its mark. The fact that opposer has been the subject of a few articles in the press over the years does not suffice to establish that opposer's mark is famous. Opposer argues that it has

**Opposition No. 91156936**

consistently policed its mark in litigation before the Board, and that such policing is evidence of the fame of its mark. We disagree. Opposer's apparently vigorous policing of its mark in other proceedings before the Board might be proof of opposer's litigiousness, or of the unwillingness of the defendants in those cases to undergo the expense of defending opposer's actions, but we cannot conclude that it is evidence of the fame of opposer's mark. We find that the fifth *du Pont* factor is neutral in this case.

To the extent that there is any evidence at all in the record pertaining to the remaining *du Pont* factors, we find those factors to be neutral in this case, not weighing significantly in either party's favor in our likelihood of confusion analysis.

Upon balancing all of the *du Pont* factors for which there is evidence in the record, we conclude without any doubts that there is no likelihood of confusion. The parties' marks are identical, which means that there need be only a viable relationship between the parties' respective goods and/or services to support a finding of likelihood of confusion. However, we find that the evidence of record fails to establish that even such a viable relationship exists.

Essentially, opposer's argument boils down to the fact that the parties' respective goods and services both involve

**Opposition No. 91156936**

semiconductors in some manner. Even assuming that is true, the fact that opposer's electronics products incorporate semiconductors does not suffice to make opposer's products, or opposer's contract manufacturing of such products, similar or related to applicant's seminar services in the field of semiconductor manufacturing. Likewise, the parties' customers and trade channels are completely dissimilar. The fact that semiconductor manufacturers (the relevant class of purchasers in this case, according to opposer) are at the same time both customers of applicant's semiconductor seminar services and suppliers or vendors of semiconductors to opposer does not suffice to establish a finding of likelihood of confusion. On this record, opposer does not manufacture or market semiconductors, much less conduct seminars about semiconductor manufacturing. Nor does opposer market any goods or services to semiconductor manufacturers. There is no basis in the record for concluding that semiconductor manufacturers, or anyone else, are likely to mistakenly assume that a source or other connection exists between opposer and applicant merely because both parties' goods and/or services might be said to have something to do with a product as ubiquitous as semiconductors.

"We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de

**Opposition No. 91156936**

minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."

*Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

In this case, we find that the likelihood of confusion alleged by opposer is so tenuous and hypothetical that it cannot suffice to preclude registration of applicant's mark.

Decision: The opposition is dismissed.