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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	GEMFIRE CORPORATION	:	BEFORE THE
Trademark:	PHOTONIC	:	TRADEMARK TRIAL
Serial No:	75/934845	:	AND
Attorney:	Charles B. Katz	:	APPEAL BOARD
Address:	2771 East Bayshore Road Suite 600 Palo Alto, CA 94303	:	ON APPEAL

11-19-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #64

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has applied for registration on the Principle Register for the mark, PHOTONIC (stylized) for "electronic display and components thereof, and components for controlling electronic displays; integrated optical circuits, integrated optical components and integrated optical systems" in Class 9 and "technological and scientific research, product development and customization thereof for others; licensing and transfer of intellectual property" in Class 42.

PhotonIC

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), as to Class 9 because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration 2,248,468 as to be likely to cause confusion, to cause mistake, or to deceive.[1]

[1] Registration No., 2,248,468 for the mark PHOTONICS (stylized) for "coaxial cables, data transmission cables, computer cables, power cables, super conductor electrical cables, optical fiber cables and electrical cables for use in telecommunications applications; electrical cable junctions, electrical conductors and replacement parts therefor for submarine and terrestrial use; fiber optic light and image conduits; telecommunications systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; wavelength division multiplexing optical telecommunications systems comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; video, voice and data transmission systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; systems for interactive services distribution comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts therefor. transmitters, receivers and transmission distribution systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts therefor for use in converting electrical signals to optical signals and vice versa; devices for the transmission of optical signals, namely, fiber optics and fiber optic networks comprised of any one or combination of the following - optical cables, optical transmitting stations, optical receiving stations, optical intermediate stations for dividing, multiplexing, selecting, adding, and extracting signals, and replacement parts therefor; optical signal generators, optical signal receivers, optical signal transmitters, optical signal regenerators, optical signal amplifiers, optical signal couplers, optical signal switches, optical fibers and replacement parts therefor; cable television transmitters, cable television distribution networks comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; cable television signal modulators, cable television signal amplifiers, cable television receivers, and replacement parts therefor; optical wave guide devices on a planar optical substrate, namely, optical signal splitters, optical signal modulators, optical signal filters, lasers not for

ISSUE ON APPEAL

The issue on appeal is whether the Applicant's mark when used on or in connection with the identified goods in Class 9, so resembles the mark in U.S. Registration No. 2,248,468, as to be likely to cause confusion, to cause mistake or to deceive.

STATEMENT OF FACTS

The applicant filed an application to register the mark "PHOTONIC" for "(stylized) for "electronic display and components thereof, and components for controlling electronic displays; integrated optical circuits, integrated optical components and integrated optical systems" in Class 9 and "technological and scientific research, product development and customization thereof for others; licensing and transfer of intellectual property" in Class 42. Registration was refused initially under Section 2(e) (1), 15 U.S.C Section 1052(e)(1), on the ground that the mark is merely descriptive of the goods and Section 2(d), 15 U.S.C. Section 1052(d), on the ground that the mark when used on or in connection with the goods in Class 9 so resembles the mark in U.S. Registration No. 2,248,468 as to be likely to cause confusion, to cause mistake or to deceive. The trademark attorney withdrew the Section 2(e)(1) refusal and issued a final refusal under Section 2(d). The applicant filed a request for reconsideration and at the same time the applicant filed a notice of appeal with an insufficient fee. The application remained at the Board, therefore the examining attorney was unable to consider the request for reconsideration until the applicant paid the correct fee at which time the applicant filed an appeal brief. The examining attorney denied the request for

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medical use, multiplexers and replacement parts therefor, optical signal amplifiers and replacement parts therefor, and optical signal modulators and replacement parts therefor

reconsideration and the applicant was allowed sixty days to file a Supplemental brief. The applicant did not respond to the Board's action dated March 7, 2003 and the application was forwarded to the trademark attorney for her brief.

ARGUMENT

Analysis under Trademark Action Section 2(d) is a two step process. First, the mark must be examined for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.* Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG,* 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

THE MARKS ARE SIMILAR

Applicant argues that the question of likelihood of confusion should not be determined upon the fact that the marks sound the same and are pronounced the same but rather that the appearance of the marks is the most important factor and thus if compared side by side, the marks can be distinguished from each other. While it is true that the registrant's mark includes an elongated "P", the commercial impression of the mark is "PHOTONICS" (pronounced *fo-ta-niks*). The elongated

or stylized letter "P" in the registrant's mark does not change the pronunciation of the mark or the commercial impression. With regard to the applicant's mark, the upper case letters IC preceded by the letters "Photon" does not result in a different pronunciation of the mark. The applicant asserts that its mark is pronounced "*fo-tan-i-see*" rather than "*fo-tan-nik*" yet offers no evidence whatsoever that the consuming public will make that distinction. It is well settled that there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. Thus, "correct" pronunciation cannot be relied upon to avoid a likelihood of confusion. *Kabushiki Kaisha Hattori Tokeiten v. Scuotto,* 228 USPQ 461 (TTAB 1985); *In re Great Lakes Canning, Inc.,* 227 USPQ 483 (TTAB 1985); *In re Mack*, 197 USPQ 755 (TTAB 1977). The marks in question clearly could be pronounced the same. Furthermore, even if there was a slight difference in the pronunciation, that, in and of itself, would not obviate a likelihood of confusion. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecommunications & Electrical Association,* 222 USPQ 350 (TTAB 1983). Marks that are substantially phonetically equivalent are confusingly similar. Similarity of sound is particularly relevant where verbal communication of the marks is part of the selling process. *Pan American Life Insurance Co. v. Federated Mutual Insurance Co.,* 226 USPQ 914 (TTAB 1985). Differences in design or stylization may not serve to avoid confusion in instances where the marks are likely to be referred to verbally. *Giant Food, Inc. v. Nations Foodservice, Inc.,* 218 USPQ 390, 395 (Fed. Cir. 1983). Furthermore, prospective purchasers are unlikely to analyze the marks to the extent that the applicant suggests.

A side-by-side comparison of the marks is not the proper test in determining the issue of likelihood of confusion since such a comparison is not the ordinary way that a prospective customer will be

exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of a trademark or service mark. *Envirotech Corp.* v. *Solaron Corp.,* 211 USPQ 724, 733 (TTAB 1981); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975 and *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

The applicant's argument seems to be that if there are any dissimilarities in the marks, or in other words, if they are not identical, then a Section 2(d) refusal cannot be maintained. There is no requirement under Section 2(d) that the marks be identical. The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.*

With regard to the argument that the purchasers are sophisticated, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.,* 221 USPQ 558 (TTAB 1983). TMEP §1207.01(d)(vii).

THE GOODS ARE LEGALLY IDENTICAL

It is well settled that the issue of likelihood of confusion between marks must be determined based on the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

The applicant intends to use its mark on, "electronic display and components thereof, and components for controlling electronic displays; integrated optical circuits, integrated optical components and integrated optical systems" in Class 9. The registrant uses its mark on, "coaxial cables, data transmission cables, computer cables, power cables, super conductor electrical cables, optical fiber cables and electrical cables for use in telecommunications applications; electrical cable junctions, electrical conductors and replacement parts therefor for submarine and terrestrial use; fiber optic light and image conduits; telecommunications systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; wavelength division multiplexing optical telecommunications systems comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical

repeaters, optical filters, optical fibers and replacement parts thereof; video, voice and data transmission systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; systems for interactive services distribution comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts therefor. transmitters, receivers and transmission distribution systems comprised of any one or a combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts therefor for use in converting electrical signals to optical signals and vice versa; devices for the transmission of optical signals, namely, fiber optics and fiber optic networks comprised of any one or combination of the following - optical cables, optical transmitting stations, optical receiving stations, optical intermediate stations for dividing, multiplexing, selecting, adding, and extracting signals, and replacement parts therefor; optical signal generators, optical signal receivers, optical signal transmitters, optical signal regenerators, optical signal amplifiers, optical signal couplers, optical signal switches, optical fibers and replacement parts therefor; cable television transmitters, cable television distribution networks

comprised of any one or combination of the following - optical signal generators, optical signal regenerators, optical signal receivers, optical signal transmitters, optical signal distributors, optical signal converters, optical signal multiplexing and demultiplexing, optical amplifiers, optical repeaters, optical filters, optical fibers and replacement parts thereof; cable television signal modulators, cable television signal amplifiers, cable television receivers, and replacement parts therefor; optical wave guide devices on a planar optical substrate, namely, optical signal splitters, optical signal modulators, optical signal filters, lasers not for medical use, multiplexers and replacement parts therefor, optical signal amplifiers and replacement parts therefor, and optical signal modulators and replacement parts therefor."

The goods of both parties comprise optical components, optical integrated circuits and are used in the same field or industry. The evidence in the record indicates that the applicant specializes in applying semiconductor- type processing technology to optical platforms for creating high performance telecom components. The registrant's good include telecommunications systems comprised of various optical components and products used in the telecommunications industry. Since the identification of the applicant's goods is very broad, it is presumed that the application encompasses all goods of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available for all potential customers. TMEP §1207.01(a)(iii).

The applicant has not argued any distinction between the goods suggesting that the only issue on appeal appears to be the similarities between the marks.

It is the Trademark Attorney's opinion that the contemporaneous use of these very similar marks used in connection with the respective goods, is likely to cause confusion, to cause mistake and deceive.

Finally, the examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

CONCLUSION

Based upon the foregoing, the Trademark Attorney respectfully requests that the Trademark Trial and Appeal Board affirm the refusal to register under section 2(d), 15 U.S.C 1052(d).

Respectfully submitted,

Lesley LaMothe
Trademark Attorney
Law Office 103
703-308-9103 ext. 487

Michael Hamilton
Managing Attorney
Law Office 103