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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Gemfire Corporation

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Serial No. 75934845

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Charles B. Katz, Esq. for Gemfire Corporation.

Lesley LaMothe, Trademark Examining Attorney, Law Office  
103 (Michael Hamilton, Managing Attorney).

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Before Seeherman, Chapman and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 3, 2000, Gemfire Corporation (applicant)  
applied to register the following mark on the Principal  
Register:

**PhotonIC**

The goods in the application were ultimately  
identified as "electronic display systems, consisting of

display panels and components thereof; computer and display peripherals and computer software for the operation of electronic display systems and display panel functions; integrated optical circuits; integrated optical components which consist of optical waveguides, switches, couplers, modulators, demodulators, optical sensors, multiplexers, demultiplexers, add-drop multiplexers, filters, tunable filters, communication links, transmitters, receivers, amplifiers, attenuators, light sources, optical signal processors and planar optical processors; and integrated optical systems comprised of integrated optical components, namely, attenuators, variable attenuators, optical amplifiers and amplifier light sources" in International Class 9 and "technological and scientific research in the field of optics and optoelectronics; product development for others in the fields of optics and optoelectronics; [and] licensing of intellectual property" in International Class 42.<sup>1</sup>

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act,

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<sup>1</sup> Serial No. 75934845. The application was based on an allegation of applicant's bona fide intention to use the mark in commerce. Applicant's amendment to its identification of goods and services, dated October 30, 2001, was accepted by the examining attorney in the Office Action dated July 23, 2002.

15 U.S.C. § 1052(d), because of a prior registration for the following mark to Pirelli S.p.A.:



The registration (No. 2,248,468) issued on June 1, 1999, for a long list of goods in International Class 9.<sup>2</sup>

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<sup>2</sup> 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,

The registration contains a disclaimer of the term  
"Photonics."

While the original application included a disclaimer of the term "photonic," the examining attorney nonetheless refused registration on the ground that applicant's mark was merely descriptive, in addition to the refusal under Section 2(d).

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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.

Applicant traversed the refusals and, regarding the descriptiveness refusal, applicant argued that:

Applicant's mark is a combination of "photon," which denotes a particular of light, and "IC," which is well-known acronym in the electronics art for an integrated circuit. An IC is a slice or chip of material on which a complex of electronic components and their interconnections is etched or imprinted. Applicant's combination of terms to create the stylized mark **PhotonIC** creates a unitary mark that conveys a unique commercial impression ...

"[P]hotonics" is the technology of generating and harnessing light and other forms of radiant energy whose quantum [is] the photon. It is a relatively new area of technology for which there are numerous applications. Even so, Applicant's mark is not "photonics" or even "photonic" but rather the stylized mark **PhotonIC**.

Finally, in the original application, Applicant disclaimed the term "photonic" because it is not the term "photonic" for which Applicant seeks registration, but rather the stylized **PhotonIC** mark. Similarly, in Pirelli's registration for the PHOTONICS & Design mark cited by the Examiner and discussed below, Pirelli disclaimed the term "photonics" and was issued a registration.

Response dated March 27, 2001 at 2-3 (emphasis in original).

In the next Office action, the examining attorney made the refusal to register under Section 2(d) final but she withdrew the refusal to register under Section 2(e)(1).

The examining attorney was persuaded by applicant's arguments and added that "applicant's disclaimer of "PHOTONIC[]" is not necessary and will not be printed."

Office Action dated July 27, 2001 at 2.

Regarding the remaining refusal under Section 2(d), the examining attorney maintains that the marks are similar and the goods are legally identical. The examining attorney has made it clear that "[r]egistration was refused under Trademark Act Section 2(d), 15 U.S.C. 1052(d), as to Class 9" and not with respect to the services in Class 42. Examining Attorney's Brief at 2. Therefore, the only issue remaining before the board is whether the mark in the cited registration is likely to cause confusion with applicant's mark if the marks are used on the Class 9 goods identified in the application and registration.

After the examining attorney made the refusal final, this appeal followed.

We reverse.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first question we address is whether applicant's and registrant's marks, when compared in their entireties, are similar in sound, appearance, or meaning such that they create similar overall commercial impressions. Each mark is for the word "Photonic," although registrant adds the letter "s" to the end of its mark. We agree with the examining attorney that the difference between the pronunciation of the marks would be slight, even if prospective purchasers recognize applicant's mark as two separate terms as applicant argues.

In addition, "Photonics" is defined as "the study and technology of the use of light for the transmission of information. [1950-55; see PHOTONIC, -ICS; perh. on the model of ELECTRONICS]." *The Random House Dictionary of the English Language (Unabridged)* (2d ed. 1987).<sup>3</sup> The word "photonic[s]" would therefore have the same meaning in applicant's and registrant's mark. This meaning would be a highly descriptive meaning when applied to registrant's and

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<sup>3</sup> We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applicant's optical goods. Indeed, both registrant and applicant have disclaimed the term "photonic[s]." The examining attorney, not applicant, stated that a disclaimer was not necessary, apparently because she viewed the term "PhotonIC" (stylized) as a unitary term.

The only similarity between the marks is the term that both applicant and registrant have offered to disclaim. Disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). As stated previously, the terms "photonic" and "photonics" have obvious descriptive qualities when applied to the goods of applicant and registrant.<sup>4</sup> "Regarding descriptive terms, [the Federal Circuit] has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846

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<sup>4</sup> Applicant asserts that "the word PHOTONICS is incapable of serving as a distinctive mark (when used in connection with the relevant goods), absent additional features such as the visual stylization in Registrant's mark. Consumers of the relevant goods are not likely to believe that the term PHOTONICS denotes source, and hence will not call for these goods by PHOTONICS alone, doing so would be equivalent to calling for electronic goods by the bare term "electronics." Applicant's Brief at 6-7 (emphasis in original). Previously, applicant admitted that it "disclaimed the term 'photonic' because it is not the term for which Applicant seeks registration, but rather the stylized **PhotonIC**." Response dated March 27, 2001 at 3 (emphasis in original).

(Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). Therefore, the fact that both marks use the same base word is not as significant as it often is in likelihood of confusion cases.

In addition, although both marks have the same basic meaning, applicant goes on to assert that applicant's stylization actually emphasizes that the mark is for the word "Photon" and the term "IC" meaning "integrated circuit."<sup>5</sup> The term "IC" is a term that individuals in the computer field would likely recognize. We agree that the stylization of applicant's mark would create a different, additional meaning when the mark is used on applicant's goods. Therefore, we are not persuaded that the marks in this case would have the same meaning, other than to the extent that the disclaimed term "photonic[s]" appears in both marks.

Next, we compare the appearance of the marks and their overall commercial impression.

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<sup>5</sup> IC is a recognized abbreviation for an integrated circuit. Sippi, *Computer Dictionary* (3<sup>rd</sup> ed. 1984). We take judicial notice of this definition.

# PhotonIC



The only similarity of the marks would be the fact that the marks are for the same basic descriptive word. Registrant's mark is dominated by the letter "P," which is displayed in an unusual elongated style. Registrant's mark is in all upper case letters and thick type, while applicant's mark has an unusual mixture of upper and lower case letters and less prominent type. In addition, applicant has argued that the mark would be viewed as "photon" and "IC." Because of the unusual capitalization of its mark, we find this argument persuasive.

While words often dominate when marks are compared for likelihood of confusion purposes, this is not always the case, particularly when the term is a weak term without much trademark significance. See In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed.

Cir. 1990) (Court held that the marks K+ and design and K+EFF (stylized) for potassium supplements were not confusingly similar when K is the symbol for potassium and "EFF" is an abbreviation for effervescent because "the design of the marks is significantly different"); Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 USPQ2d 1477, 1478 (TTAB 1987) (Marks containing the word "STEVE'S for different types of restaurants held to not be confusingly similar in part because the "design portion of applicant's mark is extremely suggestive of the fact that applicant's restaurant features hot dogs. The highly stylized depiction of humanized frankfurters, prancing arm in arm to musical notes, creates a distinctive commercial impression. Even with the words 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form"). Therefore, we agree with applicant that the marks create overall different commercial impressions because of the differences in their appearances and meanings and because their similarity is confined to a term with a highly descriptive significance for the involved goods.

Regarding the other factors, the examining attorney argues that "the goods are legally identical." Examining

Attorney's Brief at 7. Applicant does not contest the examining attorney's assertion. We add that applicant's "integrated optical components which consist of optical waveguides, switches, couplers, modulators, demodulators, optical sensors, [and] multiplexers..." and registrant's "optical wave guide devices," "multiplexers," and "optical signal switches" appear to involve similar goods or components of goods. Therefore, the goods are, if not overlapping, at least very closely related optical components.

Applicant also argues that the purchasers here are sophisticated purchasers. "The target buyers of the goods - typically manufacturers of optical communication equipment - are highly sophisticated, and purchases of the goods will necessarily involve a deliberate and thorough evaluation of technical features and specifications."

Applicant's Brief at 7. The examining attorney responds by arguing that "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."

Examining Attorney's Brief at 6. We agree that sophisticated purchasers are not immune from trademark confusion. However, the purchasers of these products would

likely understand the descriptive significance of the common term in the marks. Also, there is no evidence that these purchases would be impulsive. Therefore, the fact that thought and deliberation would be involved in making technical purchases by individuals with knowledge of optical components does lessen the likelihood that these purchasers would believe that optical components would originate from a common source simply because the term "photonic[s]" with significantly different stylizations appears on the goods.

When we consider the record in this case and balance the du Pont factors on the question of likelihood of confusion, we conclude that confusion is not likely.

Decision: The refusal to register applicant's mark for the goods in International Class 9 under Section 2(d) is reversed.<sup>6</sup>

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<sup>6</sup> As we noted earlier, there is no refusal to register applicant's mark as to applicant's services in International Class 42.