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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GENBAND Inc.

Serial No. 77627106

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Jr., P.C. for GENBAND Inc.¹

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110 (Chris A. F. Pedersen, Managing Attorney).

Before Holtzman, Zervas and Wolfson, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On December 5, 2008, GENBAND Inc. filed an intent-to-
use application (Serial No. 77627106) to register the mark
S9 (in standard character form) on the Principal Register
for International Class 9 goods ultimately identified as:

Communications network gateways, namely,
electronic equipment hardware and software for
access and security gateway, namely, electronic

¹ On March 14, 2011, well after filing its reply brief, applicant submitted through the TEAS electronic filing system a revocation of power of attorney and appointment of a new attorney, Valerie Verret of Baker Botts L.L.P.

equipment routers and switches, and software for these routers and switches, for access and security control interconnection between carrier-to-carrier, carrier-to-enterprise, and carrier-to-Internet Service Provider (ISP) telecommunications networks; [and] network access gateways in the nature of modularized telecommunications carrier-to-carrier, carrier-to-enterprise, and carrier-to-ISP electronic equipment route and switch controllers, for providing scalable security, management, and policy enforcement infrastructure platform gateways for large-volume multiple concurrent connections.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of Registration No. 3018974 issued to Deep Nines, Inc. for the mark



(registered November 29, 2005) for "computer systems comprised of computer software and hardware for communications systems security, traffic and bandwidth management."²

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is reversed.

² The record does not include a description of registrant's mark.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act 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. 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Marks

Under the first *du Pont* factor regarding the similarity or dissimilarity of the marks, we consider whether applicant's mark and the registered mark, when viewed in their entirety, are similar in appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The examining attorney contends that because applicant's mark is a standard character mark, the marks

"could be presented in the same manner of display, and the fact that the registered mark is stylized does not obviate a likelihood of confusion with applicant's standard character mark." Brief at unnumbered pp. 4 - 5. She maintains that there is no "defined order" to registrant's mark because of the overlapping effect created by the way the letter "S" is cut out of the "9."

It is true that applicant's S9 mark is a standard character form mark and is not limited to any special form or style as displayed on its goods. *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("The drawing in the instant application shows the mark typed in capital letters, and ... this means that [the] application is not limited to the mark depicted in any special form" and hence we are mandated "to visualize what other forms the mark might appear in."). However, its standard character form mark S9 does not extend to a display of the mark as "9S."

To the extent that the examining attorney considers registrant's mark to be an "S9" mark, the marks do not have "the same manner of display." The Board must consider a standard character form mark in "all reasonable manners in which applicant could depict its mark." *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351,

1359 (TTAB 2007). The manner in which the S9 standard character mark may be depicted does not extend to the manner in which registrant depicts the "9" and the "S" of its mark. The manner in which registrant displays the "9" and "S" in its mark is unusual because the "S" is embedded in the leg of the "9," to the right of the mark. The rights accorded to applicant's standard character form mark do not extend to the depiction of the "9" and the "S" in registrant's mark.

In view of the above discussion, we find the appearance of the marks to be dissimilar.

We also find the sound of the marks to be different. In registrant's mark, the "S" is much smaller than the "9" and the "S" is positioned at the far right of the mark, suggesting that it should be pronounced last. Because "nines" is a natural way to articulate the "9" and the "S" portion of the mark, we find that the mark is likely to be pronounced as "dot nines." The sound of "dot nines" differs from the sound of applicant's mark, i.e., "es-nine," due to the differing first elements in each mark.³

³ If consumers would perceive the "dot" portion of registrant's mark as punctuation and not pronounce it, we still find the marks are different in sound because "nines" differs in sound from "es-nine."

Regarding the meaning of the marks, neither mark has any particular meaning. One would be considered as a combination of a symbol (a "dot") and "nines" and the other would be considered as an alpha-numeric combination.

Finally, regarding the commercial impressions of the marks, they too differ. The alpha-numeric combination of applicant's mark imparts a different commercial impression from the commercial impression of registrant's mark which is of a symbol and the plural form of the word "nine."

In view of the differences in the sound, appearance and commercial impression of the marks, we resolve the *du Pont* factor regarding the similarity or dissimilarity of the marks favor of applicant.

The Goods

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as described in the application and cited registration. We do not consider the goods on which the marks have actually been used; we limit our inquiry to the goods set forth in the respective identifications of goods and services.⁴ *Hewlett-Packard Co.*

⁴ Even though applicant filed its application under the intent-to-use provisions of the Trademark Act, the record includes printouts of applicant's webpages discussing applicant's goods and showing applicant's mark. Applicant has also submitted printouts of registrant's webpages. Many of applicant's arguments regarding applicant's and registrant's goods are based on what is stated in the webpages.

v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Our starting point for our analysis under this *du Pont* factor is registrant's broadly-worded identification of goods, which states,

computer systems comprised of computer software and hardware for communications systems security, traffic and bandwidth management.

Registrant's identification of goods essentially involves software and hardware for "computer systems," and specifically, "communications systems" (including telecommunications systems) security, traffic and bandwidth management. This identification of goods broadly includes (i) routers and switches, and (ii) software for routers and switches.

The first item in applicant's identification is "communications network gateways." A gateway is defined in the Wikipedia webpages (made of record by applicant with its response to the first Office action) as "in a communications network, a network node equipped for interfacing with another network that uses different protocols." The Wikipedia evidence explains that "[r]outers exemplify special cases of gateways" and "the computers that control traffic between company networks or the computers used by internet service providers (ISPs) to

connect users to the internet are gateway nodes." Clearly, gateways are components of computer systems and computer systems are part of communications networks.

Registrant's identification of goods, which broadly recites "computer software and hardware" pertaining to "communications systems security and traffic management," encompasses gateways for access and security.

Applicant includes use limitations in its identification of goods, specifying that its goods are for "interconnection between carrier-to-carrier, carrier-to-enterprise, and carrier-to-Internet Service Provider (ISP) telecommunications networks." Registrant's identification of goods does not include specific limitations. Rather, registrant specified in its identification that its computer systems are for "communications systems" which, at a minimum, broadly extend to "carrier-to-Internet Service Provider (ISP) telecommunications networks."

Thus, based on the forgoing, we find that applicant's "communications network gateways" lie within or are encompassed by registrant's identification of goods.⁵

⁵ To be clear, our finding is based on the "communications network gateways" in applicant's identification of goods. We may find a likelihood of confusion when only one item in a class of goods is commercially similar to registrant's goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of

We comment on the examining attorney's submission of use-based third-party registrations with her final Office action, and her reliance on such registrations to argue that various trademark owners have adopted a single mark for goods of the kind that are identified in both the application and the registration.⁶ The examining attorney has not specified which goods in each registration support her position. In view of the length of the identifications of goods in many of these registrations, as well as the highly technical nature of the goods involved in this appeal, the examining attorney should have specified which goods she relies on, at least for a representative number of third-party registrations.⁷ We have considered these

MONOPOLY for board games and seeing the mark *on any item that comes within the description of goods set forth by appellant in its application*, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item ..." (emphasis added)).

⁶ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

⁷ See, for example, Registration No. 3730144, which recites the following International Class 9 goods:

computer hardware and software for interconnecting, managing, securing and operating local and wide area networks and telephony systems; telephones, telephone headsets; electronic communication devices, namely, personal digital assistants, pagers, and cellular and wireless telephones; wireless communications devices, namely, wireless LAN hardware and software for the transmission of voice, data, and video; telecommunications equipment, namely, hardware and

registrations, but their probative value is limited by the examining attorney's failure to specify which goods she relies upon; she has not specified which of the listed goods in each registration she believes supports her position.

Trade Channels and Purchasing Conditions

Turning next to the trade channels for both applicant's and registrant's goods, we reiterate our finding above that applicant's goods are encompassed within registrant's broadly-worded identification of goods. We point out too that neither applicant's nor registrant's identifications of goods contain any specific limitations pertaining to trade channels. Because there are no trade channel limitations, we presume that registrant's and applicant's identifications of goods encompass all goods of the nature and type described, and that the identified goods move in all channels of trade that would be normal

software for use in conjunction with managing and operating local and wide area networks; gateway routers in the nature of computer control hardware for use with telephone systems; telecommunications switches for use with telephone systems; call processing software for the transmission of data, video and voice traffic; storage networking products, namely, routers, switches, port adapters, and software used in the operation and management thereof; downloadable instructional materials, namely, books, manuals, printed guides for teachers, test booklets, magazines, newsletters and bulletins in the fields of

for such goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, we do not consider applicant's arguments regarding registrant's and applicant's actual trade channels.⁸ Rather, because of the absence of trade channel limitations in the identifications of goods, we find the trade channels for these related goods (as reflected in the identifications of goods) to be related. We hence resolve the *du Pont* factor regarding trade channels against applicant.

With regard to the *du Pont* factor involving the conditions under which and buyers to whom sales are made, we agree with applicant that purchases of applicant's and registrant's goods would both be made with some care. Both applicant's and registrant's goods are of a type that have a considerable cost and would not be made without

network communications, and managing, operating and using local, wide and global networks.

⁸ Applicant maintains that its goods are marketed to large telecommunications providers, such as Internet and VOIP telecommunications providers, telephone companies and enterprises managing multiple networks with large-scale network-to-network interconnections and "marketing is often direct and through particular channels of these telecommunications operators." Brief at 6. Registrant's goods, on the other hand, are "marketed to business, education, health care and government organizations for computing needs" and are "not marketed for and would not be viable for large telecommunications applications requiring

deliberation and input from technical personnel. This manner of purchasing reduces the likelihood of source confusion.

Balancing the *du Pont* Factors

As discussed above, registrant's goods encompass applicant's goods and applicant's and registrant's trade channels are related to one another. However, because the marks are dissimilar and purchases of both applicant's and registrant's goods are made with care, we find that there is no likelihood of confusion between registrant's mark for its goods and applicant's mark for its goods.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.

management of multiple networks with large-scale network-to-network interconnections." Brief at 7.