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Mailed: August 3, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Panasonic Corporation of North America

Serial No. 78445277

Morton Amster of Amster, Rothstein & Ebenstein LLP for  
Panasonic Corporation of North America.

Joanna M. Dukovcic, Trademark Examining Attorney,  
Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Rogers, Kuhlke and Cataldo, Administrative Trademark  
Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Panasonic Corporation of  
North America to register the mark shown below on the  
Principal Register for "car audio speakers."<sup>1</sup>

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<sup>1</sup> Application Serial No. 78445277, filed July 2, 2004 by  
Matsushita Electric Corporation of America, based on applicant's  
allegation of a bona fide intent to use the mark in commerce.  
Applicant recorded its subsequent name change to Panasonic  
Corporation of North America with the Assignment Branch of this  
Office on January 26, 2005 at Reel 3016/Frame 0418.



The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with applicant's goods, so resembles the mark HIFI.COM, previously registered in standard character form on the Supplemental Register for "retail store and mail order services featuring audio electronic components"<sup>2</sup> as to result in confusion as to the source of those goods and services.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

Applicant argues that the separation of the two word elements in its mark by the Greek PHI symbol "decreases the significance of these elements as the recognized term 'HI PHI'"; that the letter "H" as it appears in applicant's mark "could easily be viewed as an arbitrary design" due to the stylized depiction thereof; that applicant's mark does

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<sup>2</sup> Registration No. 2483911, issued August 28, 2001. We note that at the time of issuance of the cited registration, a mark appearing in standard character form was identified by the term "typed drawing."

not contain the ".COM" element of registrant's mark; and that, as a result, its "highly stylized" mark, "with its dominant PHI symbol in the center and its very unusual lettering," differs in appearance from the mark in the cited registration. (Applicant's brief, page 4) Applicant further argues that its mark is pronounced "HI PHI PHI" and thus is different in sound from registrant's mark.

Applicant argues in addition that its mark "focuses on tradition, and the grandeur of ancient Greece" and thus "conveys to consumers that Applicant's car audio speakers have a classic, timeless quality;" (Applicant's brief, page 5) that, in contrast, the mark in the cited registration "clearly focuses on the late 20<sup>th</sup>/early 21<sup>st</sup> century, and advises consumers that the services covered by the Mark are provided through the Internet;" (Id.) and that, as a result, applicant's mark has a different commercial impression from that of the mark in the cited registration. Applicant asserts that because its mark is intended to be used on goods and the cited mark is used on services, confusion is not likely as to the source thereof; that because the cited mark is registered on the Supplemental Register, it is weak and entitled only to a narrow scope of protection; that in addition, there exists a number of third party registrations containing the term "HI FI" for

consumer electronic products; and that due to the sophistication of the relevant consumers, confusion is unlikely as to the source of applicant's goods and registrant's services.

The examining attorney maintains that the dominant portion of applicant's mark is the wording "HI PHI"; that the dominant portion of registrant's mark is the wording "HIFI"; that the wording ".COM" in registrant's mark has no source identifying function; that, as a result, the dominant portions of the involved marks are phonetic equivalents that sound alike and "cast the same commercial impression." (Examining attorney's brief, page 4) The examining attorney further maintains that because the cited mark is registered in standard character form, it may be displayed in identical stylized lettering to that of applicant's mark. The examining attorney maintains in addition that the marks in the third party registrations relied upon by applicant contain additional, non-generic, wording that distinguishes those marks from each other; but that "there is no such additional auditory, non-generic component that would distinguish the marks at issue in this case" from each other. (Examining attorney's brief, page 5) The examining attorney argues that consumers are accustomed to encountering Greek characters in a variety of

ways; that applicant has introduced no evidence to support its contention that the Greek lettering in its mark suggests any connotation with ancient Greece; and that, as a result, the lettering fails to distinguish applicant's mark from that in the cited registration. The examining attorney also argues that even if the mark in the cited registration is found to be weak, it is still entitled to protection against registration by a subsequent user of the same or similar mark for closely related goods or services. The examining attorney further argues that applicant's "car audio speakers" are a component of electronic audio systems; that applicant's goods thus may be made available through registrant's services; that neither the involved application nor the cited registration is limited as to channels of trade; that, as a result, the goods and services recited therein are presumed to move in normal channels of trade, and are available to all potential customers; and that even if consumers of applicant's goods and registrant's services are sophisticated, they are not immune from confusion as to the source thereof.

Applicant contends in reply that the mark in the cited registration is registered on the Supplemental Register and thus is deemed merely descriptive; that the examining attorney did not require a disclaimer of any portion of

applicant's mark, nor registration on the Supplemental Register; that, as a result, the examining attorney "has implicitly recognized the different impressions" created by the marks. (Applicant's reply brief, page 3) Applicant further contends that the mark in the cited registration is no longer in use.<sup>3</sup>

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with its reply brief. These exhibits consist of printouts from applicant's Internet website as well as third-party Internet websites; a copy of a December 22, 2003 article from *Twice* magazine; a printed comparison of applicant's mark and the mark in the cited registration; and a printout from a third-party Internet website corresponding to the domain name hifi.com. We find that these exhibits are

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<sup>3</sup> With its reply brief, applicant submitted an exhibit in support of its assertion that the cited mark is no longer in use. First, and as explained in greater detail *infra*, such evidence is untimely. Furthermore, Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration, as is the case herein. See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992). Thus, we have given no consideration to applicant's remarks in this regard.

manifestly untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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.*, *supra*.

First, we turn to the second *du Pont* factor, i.e., the similarity or dissimilarity between the parties' recited goods and services. In making our determination, we look to the goods and services as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16

USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In this case, applicant's goods, identified as "car audio speakers," would appear on their face to be related to registrant's "retail store and mail order services featuring audio electronic components." The examining attorney has made of record with her final Office action a dictionary entry in which "component" is defined, *inter alia*, as "a constituent part: INGREDIENT"<sup>4</sup> in support of her argument that "car audio speakers" are an "audio electronic component." In addition, the examining attorney has submitted with her first and final Office actions

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<sup>4</sup> Merriam-Webster Online Dictionary, available at <http://www.m-w.com>.



articles retrieved from Internet web pages indicating that audio speakers for cars are made available by means of electronic retail services. As such, the record in this case tends to support a finding that applicant's goods are related to registrant's services. See discussion in *In re Gerhard Horn Investments Ltd.*, 217 USPQ 1181, 1182 (TTAB 1983). However, although we must presume that applicant's goods may be sold in retail stores featuring audio electronic components or by a mail order service featuring such goods, we do not presume that registrant would purchase and sell applicant's goods and thereby create confusion (assuming that the marks are similar enough that such an arrangement would result in consumer confusion). In short, while the goods and services are related, we disagree with the examining attorney's contention that confusion might result from registrant's sale of applicant's goods. Nor do we find it reasonable to conclude that consumers familiar with registrant's services would, upon subsequently being confronted with applicant's goods for sale, assume that registrant had expanded its business to include the manufacture and sale of its own brand audio components. First, there is no evidence of record to support such as a natural expansion of registrant's business. Second, if registrant were to begin

to manufacture its own brands of components, it seems logical that it would sell them in their own stores or through their own mail order service, not through others. This is not a case like *Gerhard Horn, supra*, in which a likelihood of confusion was found because the *identical and arbitrary* mark was used for "retail women's clothing store services" and "woven and knit fabrics of cotton, acrylic and polyester," so that consumers would assume some connection "coming upon applicant's services and registrant's goods, even in separate retail locations or through differing channels of trade." *Gerhard Horn*, 217 USPQ at 1182.

We turn now to the first *du Pont* factor, i.e., whether applicant's mark and the mark in the cited registration are similar or dissimilar when compared in their entirety in terms of appearance, sound and connotation. The test, under this *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of

trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, we note that applicant's mark is similar to the cited mark in appearance to the extent that both begin with the identical wording "HI" and respectively contain the related wording "FI" and "PHI." However, the marks are dissimilar in appearance in that applicant's mark prominently contains the Greek "phi" symbol in its center, separating the wording "HI" and "PHI." A potential consumer viewing applicant's mark will be drawn first to the "phi" symbol, displayed in large size and bold presentation, prior to noticing the wording. Even consumers unfamiliar with the Greek alphabet and thus unaware of the meaning of the "phi" symbol would be drawn to what they would perceive as a prominent design element in the center of the mark. As such, the Greek "phi" symbol is the dominant portion of applicant's mark, and its presence therein renders applicant's mark notably dissimilar from that of registrant

in appearance. The marks are further dissimilar in appearance in that the mark in the cited registration contains the wording ".COM," which is absent from applicant's mark.

With regard to sound, we note that applicant's mark is similar to the mark in the cited registration in that "HIFI" is essentially identical in pronunciation to "HI PHI." Moreover, we find no support for applicant's contention that its mark would be pronounced "HI PHI PHI," but consider it rather more likely that consumers would pronounce the wording "HI PHI" and not pronounce the Greek letter in the center of the mark. However, the marks are dissimilar in sound due to the presence of ".COM" in registrant's mark. Thus, regardless of whether applicant's mark is pronounced "HI PHI" or "HI PHI PHI," it differs in sound from registrant's mark, which is pronounced "HI FI DOT COM." In the examining attorney's analysis, registrant's mark has been treated as if the ".COM" portion would be ignored, treatment we find inappropriate. Even disclaimed or descriptive matter in a mark must be considered in assessing similarity of the marks.

With regard to the overall impression conveyed by the marks, we note that the meaning or connotation of a mark must be determined in relation to the recited goods or

services. See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); and *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984). In this case, applicant's mark is similar to that of registrant in that both convey the notion of high fidelity audio equipment. However, the marks are dissimilar in that the top level domain locator ".COM" in registrant's mark strongly conveys the availability of registrant's services via the Internet. Furthermore, the presence of the "phi" symbol in applicant's mark conveys to those who recognize it some Greek connotation, whether that is a timeless quality as argued by applicant or a mathematical significance, as suggested by the examining attorney.

In addition, applicant relies upon several third-party registrations to demonstrate that the term "HI-FI" or "HIFI" for audio-related goods or services is very weak, and thus afforded a narrow scope of protection. Third-party registrations can be used as a form of a dictionary definition to illustrate how a term is perceived in the trade or industry. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or

services." See *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). As shown by applicant's evidence, the term "HIFI" or "HI-FI" has been regarded as merely descriptive in a number of third-party marks, the registrations of which largely include disclaimers of the term "HIFI" or "HI-FI" or appear on the Supplemental Register. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1972). Here, we find the evidence persuasive to show that "HIFI" or "HI-FI" is a weak term as applied to audio components and services related thereto. See Registration No. 2,389,806 for the mark MAGNOLIA HI-FI (HI-FI disclaimed) for "retail store services featuring consumer electronics;" (2) Registration No. 2,564,235 for the mark HIFI WORKS (HIFI disclaimed) for "in wall audio speakers and in ceiling audio speakers;" (3) Registration No. 2,191,623 for the mark HIFI FILTRATION BASS REFLEX SPEAKER (Supplemental Register; HIFI and BASS REFLEX SPEAKER disclaimed) for "audio apparatus, namely, combined radio receiver, cassette deck, compact disc player, mini disc player-recorder, amplifier and speaker system; and mini disc players/recorders;" (4) Registration No. 1,339,790 for the mark BETA HI-FI (Supplemental Register; HI-FI disclaimed) "for stereo video tape cassette

recorders;" and (5) Registration No. 2,471,323 for the mark HERHIFI.COM for "retail store, on-line retail store and mail-order services, all featuring audio electronic and video equipment and accessories, satellite television receiving equipment and accessories, cameras, telephones and electronic clocks."

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities, particularly given the weakness of the common element. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 110 (CCPA 1974). See also *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970); and *Sure-fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958). Thus, the first *du Pont* factor regarding the similarity of the marks favors applicant.

Thus, we find that despite the facial relatedness of the goods and services, opportunities for confusion in the marketplace may actually be more limited than a first glance at the respective identifications might suggest, and the marks are sufficiently dissimilar, particularly in view of the very weak nature of the common elements HIFI and HI

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PHI, that confusion is not likely between applicant's mark and the mark in the cited registration.

Decision: The refusal to register is reversed.