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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Grain Audio, LLC*

Serial No. 85528202

Robert W. Smith and Kelly J. Garrone of McCarter & English, LLP for Grain Audio, LLC.

Melissa Vallillo, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Cataldo, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Grain Audio, LLC (“applicant”) seeks registration of the mark GRAIN AUDIO, in standard characters and with AUDIO disclaimed, for

Audio speakers, audio amplifiers, audio receivers, audio mixers, audio decoders, speakers, compact disc players, MP3 controllers, MP3 players, microphones, audio speakers in the nature of music studio monitors, phonographic record players, audio recording equipment, namely audio recorders, digital LP converters, wireless speakers, wireless audio players, portable audio players, portable speakers, powered speakers, and bookshelf

speakers.”<sup>1</sup>

The examining attorney refused registration of the mark under Section 2(d) of the Act, on the ground that applicant’s mark, when used in connection with applicant’s goods, so resembles the previously-registered mark EGRAIN, in typed format, for

Data processing apparatus and systems, namely, computers and computer networks comprising functional electronic units with electronic circuit substrates; autarchic miniaturized microcomputers capable of build-up and organizing a network autonomously by themselves through wireless communication; microprocessors, computer memories, application-specific integrated circuits (asics); radio frequency (rf) receiver and sender, sensor circuit computer hardware; computer peripherals; electronic display panels and electronic display devices, namely, light-emitting diodes (led's); organic light emitting diodes (oled's); liquid crystal displays (lcd's); computer interface boards; transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers; telephone receivers; transmitters and receivers for electronic, analog, and digital signals, namely, television, radio (rf); network software, namely, network access server operating software<sup>2</sup>

that use of applicant’s mark in connection with applicant’s goods is likely to cause confusion.

After the refusal became final, applicant appealed and applicant and the examining attorney filed briefs. We affirm the refusal to register.

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<sup>1</sup> Application Serial No. 85528202, filed January 30, 2012, based on an alleged intent to use the mark in commerce under Section 1(b) of the Act.

<sup>2</sup> Registration No. 2966216, issued July 12, 2005 under Section 44(e) based on a German registration filed September 17, 2002; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The cited registration also includes services in International Class 42.

**Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also*, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 29 (CCPA 1976) (“The 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.”).

Turning first to the goods and channels of trade, they need not be identical or competitive in order to support a finding of likelihood of confusion. It is enough that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used, to a mistaken belief that applicant’s and registrant’s goods originate from or are in some way associated with the same source or that there is an association between the sources of the goods and services. *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1432 (TTAB 1993); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB

1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ at 832.

Here, applicant's goods are primarily home audio products<sup>3</sup> while registrant's are at least primarily computer and computer network-related products, and applicant therefore argues that the goods are unrelated. Applicant also argues that we should consider extrinsic evidence about registrant's goods, specifically evidence which appears to show that registrant's goods are primarily related to miniaturized computer networks.

While registrant's goods appear to be primarily "technical" in nature, and its identification of goods is indeed quite broad, registrant's identification is neither "vague" nor "unclear," and it does not include goods which we require extrinsic evidence to understand. Accordingly, applicant's reliance on *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010) and *In re Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1990) in support of its request that we consider extrinsic evidence is misplaced, and we decline to consider applicant's extrinsic evidence.

Moreover, while applicant may very well be correct that registrant does not in fact use its mark for products related to those for which applicant seeks

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<sup>3</sup> Applicant submitted the Declaration of Mitchell Wenger, its President ("Wenger Dec.") on this point.

registration, and we are sympathetic to applicant's arguments on this point, it is settled that where, as here, applicant's and registrant's identifications of goods contain no limitations, they are presumed to encompass all goods of the type described, and the goods are presumed to move in all normal channels of trade and be available to all classes of consumers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). We are bound by the parties' identifications and we simply cannot limit the goods, channels of trade or classes of customers to what applicant's evidence shows them to be. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) ("It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods identified in the application vis-à-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be."); *see also, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1637-38 (TTAB 2009) ("we must also analyze the similarity or dissimilarity and nature of the goods based on the description of the goods set forth in the application and the registration at issue ... we may not limit or restrict the trailers listed in the cited registration based on extrinsic evidence").

Accordingly, we turn not to extrinsic evidence but instead to the identifications of goods in the application and cited registration, and agree with the

examining attorney that the goods *in applicant's and registrant's identifications*, if not those in connection with which applicant and registrant are actually using their marks, are in part legally identical and in part related. Specifically, registrant's "transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers" encompasses applicant's "audio receivers" and these goods are therefore legally identical. We accept applicant's invitation to take judicial notice that "telecommunications" are defined as "the transmission of information, as words, sounds, or images, usually over great distances, in the form of electromagnetic signals ...,"<sup>4</sup> and need no evidence to recognize that in a typical home stereo system such as those applicant offers, the "sounds" generally do not travel "over great distances" but instead merely travel the short distance between, for example, a CD player and an audio receiver and between the audio receiver and stereo speakers. Nevertheless, applicant's definition establishes that telecommunications do not always travel great distances, rather they "usually" do so. Perhaps more importantly, given recent advances in Internet speed and audio distribution, and the number of homes with high speed Internet access, nothing in registrant's identification of goods would preclude it from offering audio receivers which could distribute, in a consumer's home, music which has electronically traveled "great distances." In other words, while there may in fact be "real world" differences between registrant's "audio receivers" and applicant's "audio receivers," any such differences are not reflected in registrant's identification of goods and we

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<sup>4</sup> Applicant's Reply Brief at 6.

must therefore find that registrant's and applicant's "audio receivers" are legally identical.

Furthermore, registrant's identification of goods includes "computer peripherals," and the examining attorney has introduced website printouts which establish that some "computer peripherals" are related to applicant's goods, such as computer speakers and microphones, and other audio-focused products which interact with computers. Office Action of November 6, 2012. Again, while it may very well be true that registrant's actual "computer peripherals" are unlike the home audio-focused computer peripherals featured in the examining attorney's evidence, we may only consider limitations explicitly stated in registrant's identification of goods, and here there are none.<sup>5</sup> Furthermore, the examining attorney also relies on evidence that a number of marks are registered to different owners for certain of applicant's goods on the one hand (such as "loudspeakers," "stereo amplifiers," "CD players," "Earphones" and "audio receivers" ) and goods related to registrant's on the other (such as "computers," "cable modems," "computer

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<sup>5</sup> We note that "computer peripherals" in applicant's identification of goods is preceded and followed by a semicolon and therefore stands alone, without limitation.

In the cited registration's identification of services, the "providing banquet and social function facilities for special occasions" are services separated by a semicolon from the "restaurant and bar services." Under standard examination practice, a semicolon is used to separate distinct categories of goods or services. We find that here, the semicolon separates the registrant's "restaurant and bar services" into a discrete category of services which is not connected to nor dependent on the "providing banquet and social function facilities for special occasions" services set out on the other side of the semicolon.

*In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013).

software to control and improve computer and audio equipment sound quality,” “Computer storage devices, namely, flash drives” and “audio equipment, namely wireless radio transmitters”). *Id.* “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *See, In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998); *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

In short, as set forth in the identifications in the application and cited registration, the goods are in part legally identical and in part related. And neither applicant’s nor registrant’s identifications contain any limitations as to their channels of trade. Therefore, both the similarity of the parties’ goods and their channels of trade weigh in favor of a finding of likelihood of confusion.

Turning next to the marks, we must compare them “in their entirety as to 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, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). The test



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 so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991).

Of course, one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature of a mark in determining its commercial impression. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.”).

Here, applicant’s mark and registrant’s mark share the term GRAIN, and the additional elements of applicant’s and registrant’s marks are subordinate thereto. In fact, AUDIO is merely descriptive of applicant’s products. Similarly, the “E” prefix in registrant’s mark is descriptive or suggestive of registrant’s products. In fact, the examining attorney has introduced evidence that the letter “e” may be used as an abbreviation for “electronic,”<sup>6</sup> and audio products may be generally classified as a subset of “electronics.” *See also, In re SPX Corp.*, 63 USPQ2d 1592, 1596 (TTAB 2002). Furthermore, the letter “E” in registrant’s mark modifies GRAIN and

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<sup>6</sup> Office Action of November 6, 2012 (<http://dictionary.cambridge.org/dictionary/british/e>).

therefore draws additional attention thereto. Because the terms AUDIO and E are merely descriptive or at best suggestive of the goods in question, these elements of the marks are entitled to less weight than the shared term GRAIN. *See, Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data*, 224 USPQ at 752). In short, because the marks both contain the dominant term GRAIN, they look and sound similar and convey similar meanings, namely, “grain audio” and “electronic grain.” While we recognize that there are also differences between the marks, we are mindful that because the marks will appear on legally identical goods, the degree of similarity necessary to support a conclusion of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). This factor therefore also weighs in favor of a finding of likelihood of confusion.

Applicant and the examining attorney argue over whether the relevant consumers are sophisticated and likely to exercise care in purchasing applicant’s and registrant’s goods such that confusion is unlikely. Applicant takes the position that its goods are “relatively expensive,” and not “impulse purchases,” because they range in price “from approximately \$99 to \$999,” the “average price of one of the Applicant’s speaker systems is \$250” and applicant’s customers exercise care because “they often need to determine whether the Applicant’s products are

compatible with their existing audio equipment before purchasing the equipment.” Wenger Dec. ¶ 6. Applicant also argues that because of their “highly specialized and technical nature,” registrant’s goods “are also likely to be expensive.” Applicant’s Appeal Brief at 13. The examining attorney argues that both applicant’s and registrant’s goods may “be purchased by individuals for use in their homes.” Examining Attorney’s Appeal Brief at 14. While applicant’s goods are not particularly expensive relative to other home audio products, they are certainly not impulse purchases and applicant’s argument that its customers will take care in ensuring that applicant’s equipment is compatible with their other audio equipment or with a particular room in their homes is well-taken. We also accept that customers will exercise care in purchasing registrant’s goods, due to their technical nature. However, it is settled that even sophisticated purchasers are not immune from source confusion. This is especially true where, as here, they are faced with legally identical goods and similar marks. *See, In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988). This factor therefore does not outweigh the similarity of the marks, legally identical goods and overlapping channels of trade.

There is no relevant evidence or argument concerning the remaining likelihood of confusion factors, and we therefore treat them as neutral.

### **Conclusion**

After considering all of the evidence of record as it pertains to the relevant *du Pont* factors, including applicant's arguments and evidence, even if not specifically discussed herein, we find that confusion is likely based on the legal identity of the goods, the overlapping channels of trade and similarities between the marks, even assuming that the relevant purchasers are sophisticated. To the extent that applicant's arguments raise any doubt concerning the likelihood of confusion, we resolve any such doubt in registrant's favor. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe*, 223 USPQ at 1290.

One final note is in order, given our recognition that there may in fact be "real world" differences between the goods which are not reflected in the cited registration's identification of goods. As we stated in *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1384 (TTAB 2012), we must "decide this *ex parte* appeal based on the information on the face of the cited registration; we do not read in limitations." However, as we also stated in *Cook Medical Technologies*,

applicant was not without possible remedies here, including seeking a consent from the owner of the cited registration, or seeking a restriction of the registration under Section 18 of the Trademark Act, 15 U.S.C. § 1068. Although we are sympathetic to applicant's concerns about the scope of protection being given to the cited registration, applicant did not avail itself of the remedy afforded by Section 18 that gives the Board the equitable power to cancel registrations in whole or in part, or to "otherwise restrict or rectify...the registration of a registered mark." See Trademark Rule 2.133(b). See also TBMP § 309.03(d) and cases cited therein. A party in applicant's position can file a petition for cancellation of the cited registration, requesting a restriction or

modification of registrant's description of its mark on the basis that the description is “ambiguous or overly broad and not specific to the mark actually used” in the marketplace. ... Such a claim can be used to modify overly broad identification of goods (for example, “computer programs”). *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1954-55 (TTAB 2009), *citing In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000). However, the Board will not entertain claims to modify overbroad descriptions of marks unless the proposed modification will avoid a finding of likelihood of confusion between the parties’ marks. *The Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998).

*Id.* at 1384.

**Decision:** The refusal to register applicant’s mark is affirmed.