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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Mac Systems, Inc.*

Serial No. 86184962

Mark G. Kachigian of Head Johnson & Kachigian PC,  
for Mac Systems, Inc.

Lee B. Hunt, Trademark Examining Attorney, Law Office 115,  
John Lincoski, Managing Attorney.

Before Bucher, Wellington and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Mac Systems, Inc. (“Applicant”) seeks registration on the  
Principal Register of the mark displayed on the right for

Wireless monitoring for fire alarm and security  
systems in International Class 45.<sup>1</sup>



<sup>1</sup> Application Serial No. 86184962 was filed on February 5, 2014, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as November 15, 2013. The application includes a disclaimer of the words NET WIRELESS MONITORING, and the following description of the mark: “The mark consists of the literal element ‘MAC NET’ in large type and separated between the ‘C’ and ‘N’ with an antenna displaying broadcast waves. The antenna extends upward over the lettering. ‘WIRELESS MONITORING’ is centered in smaller type beneath ‘MAC NET.’”

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with its identified services, so resemble the registered mark **MAXNET** for "central station alarm monitoring services" in International Class 42 as to be likely to cause confusion, mistake or deception.<sup>2</sup>

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We reverse the refusal to register.

## I. Applicable Law

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 Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012); and *In re Majestic Distilling Co., 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 or services. *See Federated Foods, Inc. v. Fort Howard 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.").

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<sup>2</sup> Registration No. 2495710 registered on October 9, 2001, and has been renewed.

A. Relatedness of the Services, Channels of Trade and Conditions of Purchase

We begin with the *du Pont* factor of the relatedness of the services. We base our evaluation on the services as they are identified in the registration and application. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

There is no dispute that both parties offer alarm monitoring services under their respective marks, and that the “central station alarm monitoring” services identified in the registration is broad enough to encompass Applicant’s more narrowly identified “wireless monitoring for fire alarm and security systems.” *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (*citing In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (unrestricted and broad identifications are presumed to encompass all goods of the type described). Indeed, Applicant’s specimen confirms that Applicant’s alarm monitoring services use “redundancy of multiple signal pathways to a central station,” and that “Mac Net signals are received by the central station in 2 seconds or less.” Further, because Registrant’s identification of services is not restricted as to channels of trade or classes of purchasers, the services identified in the registration must be deemed to travel in all channels of trade normal for such services, and be sold to all classes of purchasers, including ordinary consumers seeking protection for their homes and

businesses. *Viterra*, 101 USPQ2d at 1908 (*quoting Hewlett-Packard*, 62 USPQ2d at 1001 (absent restrictions in an application or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.”)). *See also Stone Lion*, 110 USPQ2d at 1161; *In re Linkvest*, 24 USPQ2d 1716, 1716 (TTAB 1992). In other words, there is nothing in the identifications of services to prevent Applicant and Registrant from offering for sale their alarm monitoring services through the same trade channels and to the same purchasers. *See In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012).

The legally identical services, and the similarity between the channels of trade and purchasers are factors that weigh in favor of a finding of likelihood of confusion, and Applicant does not contend otherwise.

#### B. The Similarities and Dissimilarities Between the Marks

Despite the overlap in the identifications of services, we find that confusion is not likely because of the crucial differences between the marks. In comparing the marks, we recognize that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). 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, 108 (TTAB 1975). Further, while we must

consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applying these principles in the present case, we cannot agree with the Examining Attorney's contention that the wording MAC NET in Applicant's mark comprises the dominant feature of the mark, because consumers will not pull these two literal elements from the mark without taking into account the antenna design. The antenna design element of the mark certainly is visually very prominent, and it also is visually integrated with the MAC and NET elements. Indeed, the antenna may be understood as representing the letter "I" and, to the extent consumers view the antenna design in this manner, they would read Applicant's mark as MACINET rather than MAC NET, further distinguishing Applicant's mark from Registrant's mark MAXNET.<sup>3</sup> On the other hand, even if the antenna design is viewed as simply that, and not representing the letter "I," it is such a significant element of the mark that, viewed in its entirety, neither the words nor the design, *per se*, dominates the other in terms of the overall commercial impression created by the mark.

Comparing the marks in their entireties in terms of appearance, we find them to be dissimilar rather than similar. The design element in Applicant's mark, and the

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<sup>3</sup> The argument that the antenna design may be understood as representing a letter "I" was not raised by Applicant, but we consider this possibility and rationale for distinguishing the marks *sua sponte*. *See, e.g., In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) ("the Board need not find that the examining attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale.") (*citing In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); and *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 343 n.2 (TTAB 1985)). *See also* TBMP § 1217 (2015).

integration of the design element with the terms MAC and NET, create a visual impression that is quite different from the appearance of the registered MAXNET mark. And as noted above, some consumers may view the design element to represent the letter “I” such that Applicant’s mark is MACINET and not MAC NET. Moreover, the additional disclaimed wording WIRELESS MONITORING is another point of difference in the appearance of Applicant’s mark as compared to Registrant’s mark MAXNET. *See Nat’l Data Corp.*, 224 USPQ at 751 (likelihood of confusion analysis requires comparison of marks as a whole, including any disclaimed matter). On balance, we find the marks to be visually dissimilar.

In terms of sound, the marks obviously are similar to the extent that each includes the terms MAC or MAX followed by the term NET. We agree with the Examining Attorney that MAC and MAX sound similar. Again, however, to the extent the antenna may be viewed as representing the letter “I,” Applicant’s mark also would sound different from Registrant’s mark. Further, the additional disclaimed matter in Applicant’s mark, WIRELESS MONITORING, adds to the differences in sound between the two marks.

Considering the two marks in their entireties, we find them to be more dissimilar than similar. The first *du Pont* factor weighs against a finding of likelihood of confusion.

## II. Conclusion

The authority is legion that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely

confusion declines.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)). However, Applicant’s mark is so different from Registrant’s mark that even when used in connection with identical services, confusion is unlikely. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *Mighty Leaf Tea*, 94 USPQ2d at 1259.

In sum, we find the first *du Pont* factor, the differences between the marks, to outweigh the other factors. *See Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.”).

**Decision:** The refusal to register Applicant’s mark



is reversed.

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Bucher, Administrative Trademark Judge, dissenting:

Because I agree with the Trademark Examining Attorney that Applicant’s mark should be refused registration under § 2(d) of the Lanham Act, I vigorously dissent.

This panel is faced with identical services presumably offered through identical trade channels to identical classes of ordinary consumers. Against the combined weight of these three *du Pont* factors, the majority concludes that the sole counterbalancing factor of the dissimilarities of the marks should be dispositive.

Yet the majority acknowledges our precedent that when the involved marks are used in connection with identical services, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21*, 23 USPQ2d at 1700. Moreover, when evaluating these respective marks, it is the quite similar literal portions **MAXNET** and **MAC NET** that would be used by consumers when calling for or discussing Registrant’s and Applicant’s respective services. Such slight differences in pronunciation, connotation and commercial impression normally do not create legally dissimilar marks. See, e.g., *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) ( ~~CAYNA~~ similar to **CANA**); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445-46 (TTAB 1977) (**KIKS** similar to **KIKI**). Given consumers’ imperfect memory of specific marks (also noted by the majority), the other portions of Applicant’s composite mark are not as significant as the majority posits. For example, the involved application appropriately includes a disclaimer of the generic term “Wireless Monitoring.” Furthermore, I find it most confounding that something as ubiquitous as a *wireless icon* would be seen as serving a source-identifying role for *wireless* monitoring services. Even more egregious is the reach by the majority, on its own initiative, to insert at multiple crucial points into the heart of its determination, the possibility that this icon could be perceived as the letter “i” – an argument happily never ventured by Applicant on its own behalf.

In conclusion, given the identical services/trade channels/consumers, and marks that will be referred to respectively as **MAXNET** and **MAC NET**, I would readily find herein a likelihood of confusion.