

This Opinion is Not a
Precedent of the TTAB

Mailed: February 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re THX Ltd.
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Serial No. 90272320
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Jennifer Lee Taylor and Eoin Connolly of Morrison & Foerster LLP,
for THX Ltd.

Danielle Anderson, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Kuhlke, Hudis and Allard,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

THX Ltd. (“Applicant”) seeks registration on the Principal Register of the standard character mark THX ONYX for “dongles being portable digital to analog audio converters and audio power amplifiers for use with headphones” in International Class 9.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to

¹ Application Serial No. 90272320 was filed on October 22, 2020, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

the goods identified in the application, so resembles the mark ONYX, registered on the Principal Register for “audio mixers; analog audio mixers with digital interfaces; audio amplifiers; audio signal amplifiers; audio signal mixers; audio processing and recording equipment in the nature of computer software, computer hardware, and software contained on flash drives for audio mixing and amplification,” in International Class 9,² as to be likely to cause confusion, mistake, or deception.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. The appeal is fully briefed.³ We affirm the refusal to register.

I. Likelihood of Confusion: Applicable Law and Analysis

Trademark Act Section 2(d) prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Our analysis is based on all of the probative evidence of record. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*” – noting the factors to be considered). In making our determination, we consider each

² Registration No. 3742088 was issued on January 26, 2010; renewed.

³ Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

DuPont factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect trademark owners from damage caused by the registration of similar marks for related goods or services that are likely to cause confusion. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”). We discuss below these factors, and the other *DuPont* factors for which there is evidence and argument.

A. Similarity or Dissimilarity of the Marks

1. Strength of the cited ONYX Mark

Before we evaluate the similarity or dissimilarity of the respective marks, we first consider the strength of the cited ONYX mark. The strength of Registrant's mark affects the scope of protection to which it is entitled. Thus, we consider the conceptual strength of Registrant's mark, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength"). The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567.

We begin with the presumption that Registrant's ONYX mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006).

a. Conceptual Strength

We next consider the evidence of record to discern the denotation of ONYX, its direct meaning. The Examining Attorney made of record the following dictionary definition of ONYX:

ONYX (noun) – a translucent chalcedony [a semitransparent crystalline structure having a rock texture] in parallel layers of different colors.⁴

Applicant provided the following additional dictionary definitions of ONYX:

ONYX (1) (noun) – a variety of chalcedony having straight parallel bands of alternating colors; (2) (noun or adjective) – black, especially a pure or jet black; (3) a gemstone that’s especially known for its opaque, all-black variety; (4) a compact variety of calcite used as an ornamental stone; onyx marble; (5) a type of chalcedony that occurs in straight and parallel bands of different colors, often black and white.⁵

Applicant argues that “ONYX would likely be considered highly suggestive of the color of audio equipment, whether ... for audio playback or ... sound recording[,]” or “likely that the commercial impression created by ... [ONYX] is of the product’s value or toughness, or of the color of the product, since ... [ONYX] refers both to a semi-precious stone and the color black.”⁶ Applicant’s arguments regarding the connotation of ONYX, the associations that this word carries with it in the context of the goods at issue, are not supported by the dictionary evidence of record.⁷ “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). There simply is nothing

⁴ Definition of ONYX from MERRIAM-WEBSTER online. Office Action of March 23, 2021, at TSDR 7.

⁵ Definitions of ONYX from DICTIONARY.COM. Office Action Response of October 27, 2021, at TSDR 81, 83-85.

⁶ Applicant’s Brief, 6 TTABVUE 21-22. *See also* Applicant’s Reply Brief, 9 TTABVUE 11.

⁷ Applicant attempts to buttress its argument with the observation that “[t]he evidence ... demonstrates the pervasive use of the color black for all manner of audio equipment.” Applicant’s Brief, 6 TTABVUE 21. Having reviewed the record as a whole, audio equipment is available to consumers in many additional colors to black, such as metallic, white, blue, tan, red, silver, purple and orange.

in the record suggesting that “ONYX” describes any aspect of Applicant’s or Registrant’s types of electronic equipment – how they are manufactured, are used or function.

The only other evidence Applicant made of record to support its challenge to the conceptual strength of Registrant’s ONYX mark is the following third-party registration:⁸

Mark	Reg. No.	Goods
CASECRACKER ONYX	5359755	Audio and video recording systems consisting primarily of cameras, microphones, and computer hardware and software for recording, playback, review and management of recorded content, Cl. 9

Third-party registration evidence goes solely to the cited mark’s conceptual strength or weakness. “[T]hird-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is **commonly registered** for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (emphasis added) (quoted in *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (TTAB 2021)). “Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be conceptually weak because the more descriptive a term is, the less likely

⁸ Office Action Response of October 27, 2021, at TSDR 136-39.

prospective purchasers are to attach source-identifying significance to it.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745-46 (TTAB 2016). “Accordingly, if the common element of two marks is ‘weak’ in that it is generic, descriptive, or highly suggestive of the named goods or services, other matter in the marks may be sufficient to avoid confusion.” *Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *39 (TTAB 2022).

Here, Applicant cites only to one third-party registration of a mark incorporating the term ONYX. This is woefully inadequate to show that marks comprising or including this term are commonly registered for similar goods. In short, the dictionary and third-party registration evidence made of record do not detract from the conceptual strength of Registrant’s ONYX mark.

b. Commercial Strength

Applicant argues it “submitted 12 examples of actual use in commerce of ONYX-formative marks for audio equipment and audio or audiovisual related services[, with evidence] ... demonstrating that use of these ONYX-formative marks is widespread.”⁹ The third-party use examples that Applicant provided are as follows:

	Designation	Third-Party	Nature of Third-Party Use
1	ONYX	BOSS Audio Systems	Amplifiers and speakers ¹⁰
2	ONYX STUDIO	Harman Kardon	Portable wireless Bluetooth speakers ¹¹

⁹ Applicant’s Brief, 6 TTABVUE 16-17.

¹⁰ Office Action Response of September 23, 2021, at TSDR 88-102.

¹¹ Office Action Response of September 23, 2021, at TSDR 104-21.

	Designation	Third-Party	Nature of Third-Party Use
3	ONYX	Campfire Audio	Ear buds ¹²
4	ONYX	Resilient Sounds	Car audio subwoofers ¹³
5	ONYX SERIES	Monoprice	Audio cables ¹⁴
6	ONYX	Samsung	Cinema LED monitors and speakers ¹⁵
7	CASECRACKER ONYX	Cardinal Peak Technologies, LLC	Networked cameras, microphones and audio/visual technology for interview rooms ¹⁶
8	ONYX	Onyx Audiovisual	Engineering, installing, and integrating broadcasting audiovisual equipment (cameras, microphones, audio processors, lighting equipment, monitors or prompters) ¹⁷
9	ONYX	Onyx Audio Video LLC	Sales of audio/video, lighting and security systems ¹⁸
10	ONYX	Onyx Technologies	Sales and installation of audio/video systems (cameras, conference room builds, digital signage, interactive displays) ¹⁹
11	ONYX	Onyx	Sales and installation of home theaters, security systems, cameras, and controllers for thermostats, lighting, shades,

¹² Request for Reconsideration of April 27, 2022, at TSDR 33-35.

¹³ Request for Reconsideration of April 27, 2022, at TSDR 37-55.

¹⁴ Office Action Response of September 23, 2021, at TSDR 123-34.

¹⁵ Request for Reconsideration of April 27, 2022, at TSDR 57-68.

¹⁶ Office Action Response of September 23, 2021, at TSDR 141-44.

¹⁷ Office Action Response of September 23, 2021, at TSDR 146-48.

¹⁸ Request for Reconsideration of April 27, 2022, at TSDR 70-74.

¹⁹ Request for Reconsideration of April 27, 2022, at TSDR 76-77.

	Designation	Third-Party	Nature of Third-Party Use
12	ONYX MS	Onyx MS	tv calibration and audio systems ²⁰ Audio/visual productions, lighting design, live streaming, conference planning, project management, communications services for meetings, events, and exhibit displays ²¹

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). Third-party uses may bear on the commercial weakness of a mark, *Tao Licensing*, 125 USPQ2d at 1057, and may be “relevant to show that [such] a ... relatively weak [mark is] entitled to only a narrow scope of protection.” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).

“As to commercial weakness, ‘[t]he probative value of third-party trademarks depends entirely upon their usage.’” *Tao Licensing*, 125 USPQ2d at 1059 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693). More particularly, it is “[e]vidence of third-party use **of similar marks on similar goods** that is relevant

²⁰ Request for Reconsideration of April 27, 2022, at TSDR 79-84.

²¹ Request for Reconsideration of April 27, 2022, at TSDR 86-89.

to show ... relative[] [commercial] weak[ness] and ... a narrow scope of protection.”
In re FabFitFun, 127 USPQ2d 1670, 1674 (TTAB 2018) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

Under the guidelines we note above, not all of the third-party use evidence Applicant made of record is relevant. In our view, the third-party uses of “ONYX-formative” names made by Monoprice (audio cables), Cardinal Peak Technologies (networked interview room technology), Onyx Audiovisual (installation etc. of broadcasting audiovisual equipment), Onyx Audio Video (sales of audio/video, lighting and security systems), Onyx Technologies (sales and installation of audio/video systems), Onyx (sales and installation of home theaters, security systems, cameras, and electronic controllers) and Onyx MS (audio/visual productions, lighting design, live streaming, conference planning) do not involve goods that are the same as or similar to those for which Registrant’s ONYX mark has been registered. This leaves five third-party uses that we find pertinent with respect to the commercial strength (or weakness) of Registrant’s mark. Consequently, the relevant third-party use evidence here “reflects a more modest amount of evidence than that found convincing in *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 , 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) [and] *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 , 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)), wherein ‘a considerable number of third parties’ use [of] similar marks was shown.” *In re FabFitFun*, 127 USPQ2d at 1674 (quoting *Juice Generation*, 115 USPQ2d at 1674).

c. Strength of the ONYX Mark: Summary

In an ex parte appeal such as this one, the owner of the cited registration is not a party, and the Examining Attorney was under no obligation to demonstrate consumers' exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). So, the mark's commercial strength, as usual, is treated as neutral. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(ix) (2022). On the other hand, Applicant did not make of record a sufficient number of relevant uses of marks identical or similar to Registrant's ONYX mark for similar goods "to show that [the ONYX] ... mark is relatively weak and entitled to only a narrow scope of protection." *In re FabFitFun*, 127 USPQ2d at 1674 .

In sum, the conceptual and commercial strength of the cited ONYX mark are neutral considerations on this appeal. We thus afford the ONYX mark the typical scope of protection afforded a mark registered on the Principal Register pursuant to Trademark Act Section 7(b), 15 U.S.C. § 1057(b).

2. Comparison of the THX ONYX and ONYX Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB

2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“The 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.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted)). The focus is on the recollection of the average purchaser – here a potential purchaser of the audio electronics products of either Applicant or Registrant – who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison”) (cleaned up; citation omitted).

So long as we “analyze[] the marks as a whole[, i]t is not improper for the Board to determine that, ‘for rational reasons,’ ... [we] give ‘more or less weight ... to a particular feature of the mark[s]’ provided that ... [our] ultimate conclusion regarding ... likelihood of confusion ‘rests on [a] consideration of the marks in their entirety.” *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, *2-3 (Fed. Cir. 2021) (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d

1352, 1357 (Fed. Cir. 2000) and *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

Although we must consider the marks in their entireties, we find the word “ONYX” to be the dominant (because it is the only) portion of Registrant’s mark. We further find that neither term in Applicant’s “THX ONYX” mark is dominant, because each word is (from a conceptual viewpoint) equally strong. Neither “THX” nor (as we discussed above) “ONYX” has any particular descriptive significance in connection with the goods for which Applicant seeks registration.

Applicant argues (to the contrary) that “THX” is the dominant term in its THX ONYX mark because it appears first and because it is strong and distinctive, citing *Palm Bay Imps.*, 73 USPQ2d at 1692.²² While Applicant correctly recites the legal principle from this decision, as Applicant concedes²³ “there is no mechanical test to select the dominant element of a mark.” *Tao Licensing*, 125 USPQ2d at 1059. While the first term in a mark generally may be considered as the feature that will be called for, and so remembered, by consumers, this is not invariably the case and in our view this is not so here.

Moreover, the only evidence Applicant provided to show that THX is a commercially strong mark is an historical description of Applicant’s company in

WIKIPEDIA:

THX Ltd. is an American company founded in 1983 by George Lucas and headquartered in San Francisco, California. It develops the “THX” high fidelity audio/visual reproduction standards for movie theaters,

²² Applicant’s Brief, 6 TTABVUE 20.

²³ Applicant’s Brief, 6 TTABVUE 20.

screening rooms, home theaters, computer speakers, gaming consoles, car audio systems, and video games.

* * *

The current THX was created on June 12, 2002 when it spun off from Lucasfilm Ltd. THX was developed by Tomlinson Holman at George Lucas's company, Lucasfilm, in 1983 THX was named after Holman, with the "X" standing for "crossover" or "experiment" as well as in homage to Lucas's first film, THX 1138. The distinctive glissando up from a rumbling low pitch used in the THX trailers, created by Holman's coworker James A. Moorer, is known as the "Deep Note".

The THX system is not a recording technology and it does not specify a sound recording format: all sound formats, whether digital (Dolby Digital, DTS, SDDS) or analog (Dolby Stereo, Ultra Stereo), can be "shown in THX". THX is a quality assurance system. THX-certified theaters provide a high-quality, predictable playback environment to ensure that any film soundtrack mixed in THX will sound as near as possible to the intentions of the mixing engineer.

In 2016, THX was acquired by videogame hardware company Razer Inc., with Razer owning all of THX and its intellectual property.²⁴

Consequently, to the extent that THX has any commercial notoriety at all (based on a single WIKIPEDIA entry), it is in connection with high fidelity audio/visual reproduction standards for movie theaters and screening rooms. No proof has been made of record demonstrating that THX is commercially strong in connection with audio components of the type that Applicant seeks to register in connection with the THX ONYX mark.

Moreover, we find Applicant's addition of "THX" to the registered ONYX mark does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). To the contrary, Applicant's mark incorporates the cited mark in its entirety, thereby increasing the

²⁴ THX Wikipedia page. Office Action Response of September 23, 2021, at TSDR 69.

similarity between the two. *See, e.g., Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (applicant's mark WINEBUD for "alcoholic beverages except beers" likely to cause confusion with BUD for beer); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar).

Additionally, during prosecution, Applicant referred to THX as a house mark.²⁵ Adding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Trademark Act Section 2(d). *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) ("[T]he addition of applicant's [CLUB PALMS] house mark [to registrant's MVP mark] does not eliminate the likelihood of confusion [between the marks CLUB PALMS MVP and MVP]."); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) ("[T]he fact that applicant's [LE CACHET DE DIOR] mark includes the house mark 'DIOR' does not necessarily establish that confusion as to source is unlikely [with respect to the registered CACHET marks].")

It is more likely that the goods promoted and sold under these respective marks, THX ONYX and ONYX, would be attributed to the same source. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) ("Applicant's corporate name is Chica, Inc. As such, to many consumers, applicant's mark for the identical word 'CORAZON'

²⁵ Office Action Response of September 23, 2021, at TSDR 19.

followed by the phrase ‘BY CHICA’ will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON.”). Accordingly, Applicant’s THX ONYX mark and Registrant’s ONYX mark are more similar than they are different. The two marks share the identical term ONYX, and the addition of the THX house mark does not change the overall similar appearance, sound and commercial impression created by the shared term. The first *DuPont* factor supports a finding that confusion is likely.

B. The Similarity or Dissimilarity of the Respective Goods and Channels of Trade

1. Goods

We now turn to the comparison of the goods at issue, the second *DuPont* factor. In making our determination regarding the similarity of the goods, we must look to the services as identified in the appealed THX ONYX Application and the cited ONYX Registration. *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[T]he 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 Prods. Co. v. Johnson Publ’g 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.”).

“Where, ... [however], applicant’s [or registrant’s] description of goods provides basic information, and the goods are of a technical nature, it is entirely appropriate to consider extrinsic evidence to determine the specific meaning of the description of goods” so long as the “extrinsic evidence [is used] to demonstrate the meaning of ... [the] description of goods, [and] **not to restrict or limit the goods.**” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010) (emphasis added). Additionally, “when the description of goods for a cited registration is somewhat unclear ..., it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning **to members of the trade.**” *In re Trackmobile Inc.*, 15 USPQ2 1152, 1154 (TTAB 1990) (emphasis added).

In any event, “[i]t is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.” *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

For the reader’s convenience, we repeat here Applicant’s goods:

Dongles being portable digital to analog audio converters and audio power amplifiers for use with headphones

and Registrant’s goods:

Audio mixers; analog audio mixers with digital interfaces; audio amplifiers; audio signal amplifiers; audio signal mixers; audio processing and recording equipment in the nature of computer software, computer hardware, and software contained on flash drives for audio mixing and amplification

Applicant argues that the respective goods are different, because they perform different functions and are directed at different consumers.²⁶ The Examining Attorney focuses on the overlap between Applicant's "audio power amplifiers" versus Registrant's "audio amplifiers" and "audio signal amplifiers."²⁷

In support of its position, Applicant made of record the following definitions:

A **preamplifier**, also known as a **preamp**, is an electronic amplifier that converts a weak electrical signal into an output signal strong enough to be noise-tolerant and strong enough for further processing, or for sending to a power amplifier and a loudspeaker. Without this, the final signal would be noisy or distorted. They are typically used to amplify signals from analog sensors such as microphones and pickups. Because of this, the preamplifier is often placed close to the sensor to reduce the effects of noise and interference.²⁸

An **audio power amplifier** (or **power amp**) is an electronic amplifier that amplifies low-power electronic audio signals such as the signal from [a] radio receiver or electric guitar pickup to a level that is high enough for driving loudspeakers or headphones. Audio power amplifiers are found in all manner of sound systems including sound reinforcement, public address and home audio systems and musical instrument amplifiers like guitar amplifiers. It is the final electronic stage in a typical audio playback chain before the signal is sent to the loudspeakers. ... The preceding stages in such a chain are low power audio amplifiers which perform tasks like **pre-amplification** of the signal (this is particularly associated with record turntable signals, microphone signals and electric instrument signals from pickups, such

²⁶ Applicant's Brief, 6 TTABVUE 7-15.

²⁷ Examining Attorney's Brief, 8 TTABUVE 11-16.

²⁸ Description of "preamplifier" from WIKIPEDIA, Office Action Response of September 23, 2021, at TSDR 54.

as the electric guitar and electric bass). ... Most audio power amplifiers require these low-level inputs, which are line level.²⁹

From these definitions, combined with evidence of Registrant's use of the ONYX mark, Applicant argues that "as used by the Registrant, the technical term 'audio amplifiers' should be interpreted in the context of sound recording because Registrant operates in the field of sound recording equipment."³⁰ Because, says Applicant, "Registrant's description of goods relates to sound recording equipment, the term 'audio amplifier' in that description should be understood to mean a preamplifier."³¹ Applicant continues that its "description of goods does not identify preamps; it identifies 'dongles'³² being portable digital to analog audio converters and audio power amplifiers for use with headphones.³³ In contrast to preamps, an 'audio **power** amplifier' boosts an audio signal so that it is strong enough to drive headphones or other types of speakers."³⁴ (Emphasis by Applicant). Applicant concludes that "[u]nlike equipment such as audio mixers and audio interfaces that contain preamps

²⁹ Description of "audio power amplifier" from WIKIPEDIA, Office Action Response of September 23, 2021, at TSDR 56.

³⁰ Applicant's Brief, 6 TTABVUE 8.

³¹ Applicant's Brief, 6 TTABVUE 10.

³² A "dongle" is a "a small device that plugs into a computer and serves as an adapter or as a security measure to enable the use of certain software." Definition of "dongle" from MERRIAM-WEBSTER online. Request for Reconsideration of April 27, 2022, at TSDR 20.

³³ To underscore its point, Applicant made of record captured pages from its website, showing the goods for which registration is sought in connection with the THX ONYX Application. Office Action Response of September 23, 2021, at TSDR 59-67.

³⁴ Applicant's Brief, 6 TTABVUE 10.

and are used during professional sound recording, power amplifiers are used in everyday consumer electronics such as stereos and headphones.”³⁵

The Examining Attorney counters that determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1052 (“The relevant inquiry in an ex parte proceeding focuses on the goods and services **described in the application and registration**, and *not* on real-world conditions.”) (emphasis original) (citing *In re i.am.symbolic*, 123 USPQ2d at 1749).³⁶

We further observe, as did the Examining Attorney,³⁷ that the ONYX Registration uses broad wording to describe audio amplifiers and audio signal amplifiers, which presumably encompasses all goods of the type described, including Applicant’s narrower portable digital to analog audio converters and audio power amplifiers for use with headphones, delivered by way of a dongle. *See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413-14 (TTAB 2018). Thus, Applicant’s and Registrant’s goods are legally identical in part. *See, In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

³⁵ Applicant’s Brief, 6 TTABVUE 11.

³⁶ Examining Attorney’s Brief, 8 TTABVUE 11-12.

³⁷ Examining Attorney’s Brief, 8 TTABVUE 12.

Additionally, to demonstrate that Applicant's and Registrant's goods, "audio power amplifiers" versus Registrant's "audio amplifiers" and "audio signal amplifiers, are not as disparate as Applicant claims, the Examining Attorney made of record captured pages from ENCYLCPEIDA.COM, which states that "[a]ny electronic device that increases the power of an electrical signal whose vibrations are confined to the audio frequency range — the range that can be perceived by the human ear — is an audio amplifier." It further states that "[a]ll devices that transmit, record, or otherwise electronically process voice signals employ audio amplifiers."³⁸ The ENCYLCPEIDA.COM entry goes on to discuss the different types of audio amplification which include both input amplification and output amplification.³⁹

The Examining Attorney also made of record captured pages from the websites HOWSTUFFWORKS, EXPLAIN THAT STUFF and BRITANNICA, to show that the wording "audio amplifiers" is a broad term that encompasses a number of different amplification devices.⁴⁰ The Examining Attorney further provided captured online discussions of "audio signal amplifiers" (Registrant's identified goods) and "audio power amplifiers" (Applicant's identified goods) from WIKIPEDIA, DEWESOFT.COM, ELECTRONICS-TUTORIALS.WS and PEGASWITCH.COM⁴¹ to show that both types of

³⁸ Discussion of "audio amplifiers" from ENCYCLOPEDIA.COM, Denial of Request for Reconsideration of June 6, 2022, at TSDR 9.

³⁹ Denial of Request for Reconsideration of June 6, 2022, at TSDR 10-11.

⁴⁰ Discussions of "amplifiers" at the websites HOWSTUFFWORKS, EXPLAIN THAT STUFF and BRITANNICA, Denial of Request for Reconsideration of June 6, 2022, at TSDR 16-51.

⁴¹ WIKIPEDIA, DEWESOFT.COM, ELECTRONICS-TUTORIALS.WS and PEGASWITCH.COM discussions, Denial of Request for Reconsideration of June 6, 2022, at TSDR 52-101.

devices amplify audio output signals, demonstrating the relatedness of Applicant's and Registrant's goods.

Having reviewed the extrinsic evidence as a whole, we find Applicant's arguments are contrary to the spirit and intent of *Edwards Lifesciences* and *In re Trackmobile*. Applicant offers the WIKIPEDIA discussions of "preamplifier" and "audio power amplifier" not to demonstrate the meaning of the descriptions of goods, but rather restrict or limit the goods. Further, if it was Applicant's intent to provide this extrinsic evidence to show that the description of goods has a specific meaning to members of the trade, as in *In re Trackmobile*, such an effort is inapposite here, where Applicant represents its goods are specifically directed to average consumers and not to audio professionals.⁴² In the end, "Applicant does not dispute that 'audio amplifiers' is a broad term that encompasses a number of different amplifying products[,] while continuing to argue that the meaning of this term can change depending on context of usage."⁴³

Over and above disagreements of technical definitions, however, the Examining Attorney made of record ten active, use-based, third-party registrations of marks registered in connection with the same or similar goods as those of both Applicant and Registrant, showing that the goods listed in those registrations, namely, digital to analog converters, audio amplifiers, signal amplifiers and audio mixers, are of a

⁴² Applicant's Brief, 6 TTABVUE 11.

⁴³ Applicant's Reply Brief, 9 TTABVUE 5.

kind that may emanate from a single source under a single mark.⁴⁴ Although active third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind that may emanate from a single source under a single mark. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (finding that third-party registrations covering both wine and water were probative of the relatedness of those beverages).

The Examining Attorney also made of record screen captures from ten third-party websites showing that the same entities market and sell the same or similar goods as those of both Applicant and Registrant under the same mark:⁴⁵

- EARMAN – portable headphone amplifiers and desktop amplifiers.⁴⁶
- KORG – portable digital-to-analog converter (“DAC”) for high resolution playback and recording as well as analog audio mixers.⁴⁷
- APOGEE – portable USB DAC and headphone amp, as well as audio interfaces for audio processing and recording.⁴⁸

⁴⁴ Third-party registrations, Denial of Request for Reconsideration of June 6, 2022 at TSDR 243-264 (U.S. Reg. Nos. 5563550, 5338308, 5216702, 5611440, 4677731, 6113862, 6100171, 6566566, 5680160 and 6579920).

⁴⁵ We find as not relevant the websites of B&H, CRUTCHFIELD, WORLD WIDE STEREO and SWEETWATER, made of record by the Examining Attorney, to show the relatedness of Applicant’s and Registrant’s goods. The goods promoted for sale on these websites are not offered under the same mark, but rather under the marks of different manufacturers. While these websites demonstrate that Applicant’s and Registrant’s types of goods travel in overlapping (online) trade channels, this is not the same as demonstrating product relatedness under applicable case law.

⁴⁶ EARMAN website, Office Action of March 23, 2021, at TSDR 46-61.

⁴⁷ KORG website, Office Action of October 27, 2021, at TSDR 18-36.

⁴⁸ APOGEE website, Office Action of October 27, 2021, at TSDR 37-74.

- UNIVERSAL AUDIO – an audio interface that is portable, which includes a headphone amplifier as well as a variety of other audio interfaces.⁴⁹
- SONY – pocket-sized personal DAC headphone amplifier as well as a digital audio mixers.⁵⁰
- SHURE – variety of analog or digital mixers and interfaces as well as a portable listening amplifiers with DAC conversion for headphones.⁵¹
- AUDIO TECHNICA – headphone amplifiers and audio mixers.⁵²
- CENTRANCE – DAC amplifiers and audio mixers.⁵³
- MONOPRICE – USB DAC amplifiers, audio mixers and audio interfaces.⁵⁴
- ROLLS – headphone amplifiers, mixers and interfaces.⁵⁵

Evidence that “a single company sells the goods ... of both parties, if presented, is relevant to the relatedness analysis.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *see also In re Integrated Embedded*, 120 USPQ2d 1504, 1514 (TTAB 2016) (“[Third-party] websites [made of record] demonstrate that ... [goods] of the type offered by both Applicant ... and Registrant are marketed and sold together online under the same marks.”).

The evidence of record shows Applicant’s goods are legally identical to at least some, but not all, of Registrant’s goods; and related to some, but not all, of Registrant’s other goods. However, it is sufficient for a finding of likelihood of

⁴⁹ UNIVERSAL AUDIO website, Office Action of October 27, 2021, at TSDR 75-96.

⁵⁰ SONY website, Office Action of October 27, 2021, at TSDR 97-109.

⁵¹ SHURE website, Office Action of October 27, 2021, at TSDR 110-21.

⁵² AUDIO TECHNICA website, Denial of Request for Reconsideration of June 6, 2022, at TSDR 102-17.

⁵³ CENTRANCE website, Denial of Request for Reconsideration of June 6, 2022, at TSDR 133-50.

⁵⁴ MONOPRICE website, Denial of Request for Reconsideration of June 6, 2022, at TSDR 173-99.

⁵⁵ ROLLS website, Denial of Request for Reconsideration of June 6, 2022, at TSDR 200-06.

confusion as to a particular class if relatedness is established for any item of identified services within that class. *Tuxedo Monopoly*, 209 USPQ at 988. Under the second *DuPont* factor, we find Applicant's and Registrant's goods to be identical or otherwise related, which in turn supports a finding that confusion is likely.

2. Channels of Trade and Potential Consumers

The third *DuPont* factor "considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *In re Detroit Athletic*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USPQ at 567). The trade channels factor considers the modalities and means (e.g., print, media, store aisles or shelves, or online) by which the respective services are marketed, see *In re Majestic Distilling*, 65 USPQ2d at 1204, sold or distributed in relative proximity, see *Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

Because Applicant's goods are legally identical, in part, to Registrant's goods, we must therefore presume that the channels of trade and potential consumers are also identical in part. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

As to the remaining goods, "[i]n the absence of meaningful limitations in either the application or the cited registration[], [we] properly presume[] that the [respective] goods travel through all usual channels of trade and are offered to all

normal potential purchasers.” *In re i.am.symbolic*, 123 USPQ2d at 1750. This presumption, however, is not a substitute for evidence. The Examining Attorney indeed has supplied the proof we require, in the form of 14 third-party websites showing that the same entities market and provide the same or similar goods as those of both Applicant and Registrant under the same mark through the same trade channels.⁵⁶ Additionally, “Applicant concedes that “the goods [of Applicant and Registrant] may sometimes be sold through the same retailers.”⁵⁷

The record therefore shows that both Applicant’s and Registrant’s types of goods are marketed and sold through the same website sources, as Applicant acknowledges. The third *DuPont* factor, related and overlapping trade channels, supports a finding that confusion is likely.

C. Sales Conditions

“The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *See Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *DuPont*, 177 USPQ at 567). Applicant argues that “Registrant uses the ONYX mark in connection with audio recording equipment such as audio mixers and audio interfaces. The consumers of such goods would be highly sophisticated, and even the least sophisticated would likely only purchase such

⁵⁶ See the Third-party websites of B&H, CRUTCHFIELD, WORLD WIDE STEREO, SWEETWATER, EARMAN, KORG, APOGEE, UNIVERSAL AUDIO, SONY, SHURE, AUDIO TECHNICA, CENTRANCE, MONOPRICE, and ROLLS cited and discussed above.

⁵⁷ Applicant’s Brief, 6 TTABVUE 15.

equipment after careful consideration and research.”⁵⁸ Applicant supports this argument with references to Registrant’s website (made of record by Applicant) and two third-party audio electronics retailers’ sites (made of record by the Examining Attorney) noting the audio professionals to whom Registrant’s products are directed, as well as the expense of some of Registrant’s product offerings.⁵⁹ On the other hand, Applicant recognizes that “consumers of Applicant’s goods ... [are] average consumers of personal electronics,” “Applicant’s THX ONYX product retails for” a few hundred dollars, and that “third-party portable digital to analog converters and headphone power amplifiers [competitive products] retail for similar prices.”⁶⁰

The problem we have with Applicant’s argument is that we cannot resort to extrinsic evidence to restrict the prices of Applicant’s or Registrant’s goods or to distinguish the goods. *See In re Bercut- Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

Additionally, the fact that purchasers may be 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. *See, e.g.*,

⁵⁸ Applicant’s Brief, 6 TTABVUE 24.

⁵⁹ Captures from Registrant’s website, Office Action Response of September 23, 2021, at TSDR 30-44. Captures from CRUTCHFIELD and SWEETWATER websites, Denial of Request for Reconsideration of June 6, 2022, at TSDR 158-63, 229-33.

⁶⁰ Applicant’s Brief, 6 TTABVUE 24-25, referencing Applicant’s THX ONYX website (Office Action Response of September 23, 2021, at TSDR at 150-58), and the CRUTCHFIELD website (Denial of Request for Reconsideration of June 6, 2022, at TSDR 151-55).

Stone Lion, 110 USPQ2d at 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Even sophisticated purchasers are susceptible to source confusion, especially in cases such as this one involving similar marks and identical or otherwise related goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion*, 110 USPQ2d at 1163), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019).

Considering the evidence as a whole, we find the fourth *DuPont* factor, sales conditions, to be neutral in our analysis of whether confusion is likely.

II. Likelihood of Confusion: Balancing the Factors

Considering the record as a whole, we afford the registered ONYX mark the typical scope of protection given to a mark registered on the Principal Register. Based on the elements of appearance, sound, meaning and commercial impression, the THX ONYX and ONYX marks are more similar than different. Applicant’s and Registrant’s services are identical in part, otherwise related and travel in overlapping trade channels. These factors support a finding that confusion is likely. Customer sophistication and purchaser care are neutral considerations in our analysis. On balance, we find confusion is likely between Applicant’s and Registrant’s marks for the identified goods.

Decision:

The refusal to register Applicant's THX ONYX mark on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d) is affirmed.