

Mailed:
August 4, 2006

This Opinion is Not
Citable as Precedent
of the TTAB

DJF/GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Omega, S.A.
v.
Panchacharam, Shawn

Opposition No. 91117378
to application Serial No. 75282523
filed on April 24, 1997

Jess M. Collen and Jeffrey A. Lindenbaum of Collen Law Associates, P.C. for Omega, S.A.

Steven D. Smit of Graves, Dougherty, Hearon & Moody for Panchacharam, Shawn.

Before Quinn, Rogers, and Kuhlke,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Shawn Panchacharam (applicant) has applied to register the mark OMEGABYTE for goods identified as "computer hardware and peripherals" in Class 9, and "retail computer stores and wholesale distributorships featuring computers" in Class 35. The application is based on applicant's statement of first use of the mark in commerce for the identified goods as early as May 23, 1993 and first use of the mark in commerce for the identified services as early as September 15, 1992.

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Omega, S.A. (opposer) has opposed the application in Class 9, asserting that it is the owner of incontestable Registration Nos. 566,370, for the mark OMEGA, for "watches and parts thereof;" 660,541 for the mark OMEGA and design, for "automatic recording machines and electronic apparatus for use in sporting events...[particular components omitted];" 708,731 for the mark OMEGA and design, for "electronic time recorders for automatic precision timing in science and industry;" 1,290,661 for the mark OMEGA and design, for, among other items, "computer apparatus for checking and controlling the measurement of time and distance for sporting events, ... computers for calculating information in respect of time and distance, storing such information, and making the same available in visual or audible form -- All of which installations contain electronic elements," in Class 9 and "watch cases," in Class 14.¹

Opposer essentially claims its mark is used for a variety of products including computer components used in connection with its goods and software driven products and systems; that it has used OMEGA as a trademark "at least as early as 1919"; that it receives "wide scale recognition" for its mark; that the involved marks OMEGA and OMEGABYTE

¹ In its notice of reliance and brief, opposer also asserted ownership of application Serial No. 78/045,789, for OMEGA and design, for retail store services. As this application was not pleaded, we have not considered it.

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are virtually identical in that only the word "byte" has been added to the end of opposer's mark; and that there exists a likelihood of confusion, mistake or deception because consumers will presume applicant's goods originate from or are endorsed by opposer, because of the similarity of the marks.

Applicant admitted certain allegations related to the filing of applicant's application, but otherwise denies the substantive allegations in the notice of opposition.

Opposer filed a notice of reliance on February 18, 2003.² Applicant submitted no testimony or evidence. Opposer filed a brief on the case, but applicant did not. No oral hearing was requested.

Initially, we note that this application was also opposed by Iomega, Inc., in Opposition No. 91119162. In order to effect an agreement to settle that case, applicant submitted a motion in that case on April 1, 2002 to amend the identification of its goods in International Class 9.³ Iomega, Inc. had agreed to the amendment, but the instant opposer objected, stating the amendment did not address

² The closing date for opposer's testimony period was February 15, 2003, that the 15th fell on a Saturday, and that Monday, February 17, 2003 was a Federal holiday. See 37 CFR §2.195(a)(1).

³ Applicant sought to amend the identification of goods in International Class 9 to read "Computer hardware, namely desktop computers, notebook computers, workstations and servers, excluding removable disk, CD and CD-RW drives and disks and CDs from the foregoing."

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opposer's demands that applicant also amend its identification of services in Class 35.⁴ In light of opposer's objection, consideration of the proposed amendment was deferred until trial pursuant to the authorities cited in TBMP §514.30(a). The Board later entered judgment dismissing Opposition No. 91119162 with prejudice, pursuant to Trademark Rule 2.128(a)(3), after Iomega, Inc. failed to respond to an order to show cause regarding its failure to file a brief in that case. Because we sustain the instant opposition to registration of applicant's mark for the goods in the opposed class, and because the proposed amendment would not, in any event, help avoid a likelihood of confusion, the proposed amendment is denied.

Another procedural matter concerns opposer's uncontested motion to extend time to file its brief. On April 18, 2005, with a certificate of mailing dated April 11, 2005, opposer requested a 30-day extension of time to file its brief, to allow for an effort to finalize a settlement agreement with applicant. *Opposer's Apr. 18, 2005 Motion* at 1. Applicant did not respond to this motion, which is granted as conceded. See Trademark Rule 2.127(a).⁵

⁴ While opposer had not opposed registration of the mark in Class 35, there was nothing improper in opposer specifying that it would not agree to an amendment of the opposed class absent a concurrent amendment of the unopposed class.

⁵ An uncontested motion need not necessarily be granted as conceded. The issue is within the Board's discretion. Opposer's

Opposer's Evidence

Turning now to the evidence presented by opposer's notice of reliance, the Board notes that opposer has submitted the following items: certified copies of four trademark registrations of the pleaded OMEGA or OMEGA and design mark; copies of an application filed January 31, 2001; printouts from opposer's website; LEXIS/NEXIS printouts of trade and consumer publications; and printouts of third-party websites.

Opposer's four certified copies of its trademark registrations are acceptable evidence to show current status and title of the pleaded registrations. See 37 CFR §2.122(d)(2). Opposer's certified copy of its application is technically admissible as a government record. See 37 CFR §2.122(e); TBMP 704.03(b)(2). However, an application for a trademark is generally of very limited probative value. See TBMP 704.03(b)(2); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); and *Glamorene Products Corporation v. Earl Grismer Company, Inc.*, 203 USPQ 1090, 1092 n. 5 (TTAB 1975). More importantly, opposer did not plead ownership of this application in its original or any amended notice of

repeated pursuit of extensions in this case militates against exercise of our discretion to grant the motion. Nonetheless, because this case will be decided on the merits, it is helpful to the Board to have a brief addressing the merits. Accordingly, we grant the motion and consider the brief to be timely filed.

opposition. Accordingly, we have not considered the application.

Opposer has enclosed over a ream of paper comprising printouts from opposer's website. Opposer claims these web page printouts are "website publications" available to the public over the Internet in accordance with 37 CFR §2.122(e). See Opposer's Notice of Reliance at 2. Opposer's assertion fails for several reasons. The term "printed publications" includes items "such as books and periodicals, available to the general public in libraries or of general circulation among members of the public..." See 37 CFR §2.122(e). In contrast, "Internet postings are transitory in nature as they may be modified or deleted at any time without notice" and do not fall within 37 CFR §2.122(e). See discussion in TBMP 704.08. Since Internet material is not considered a "printed publication" for purposes of 37 CFR §2.122(e), it does not self-authenticate and must be introduced into evidence through testimony regarding the nature, source and date of the materials. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (Website page printout not proper subject matter for notice of reliance). No such testimony has been made of record in this case. Finally, the Board notes much of the information submitted from opposer's website comprises promotional literature, catalogs, press

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releases and advertisements for opposer's products. The Board has long held that information such as promotional literature, catalogs, press releases and reprints of advertisements are more properly considered business materials and do not comprise printed publications under Rule 2.122(e). See authorities in TBMP 704.08. Therefore, opposer's website evidence is not properly made of record by its notice of reliance and has not been considered.

Opposer has also submitted a listing of websites where opposer's merchandise is allegedly offered for sale. For the reasons just discussed, these "website publications" are not evidence that may be introduced by notice of reliance and have not been considered.

Opposer has submitted printouts of several published articles retrieved from the LEXIS/NEXIS database. The Board finds these articles are admissible as evidence. Opposer has submitted electronically generated documents that are the equivalent of the printed publications to be considered. See 37 CFR §2.122(e); TBMP 704.08. The excerpts derive from printed publications purported to be from newspapers and periodicals, and are proffered with opposer's notice of reliance to establish the "strength and notoriety" of its marks "among the relevant consuming public and trade." These articles are not hearsay, as they are not submitted for the truth of the matters asserted therein, but merely to

demonstrate the alleged widespread exposure of the public to opposer's marks in the print media. We note that the articles have been marked with the proper source and date of publication in compliance with 37 CFR §122(e). *See, e.g., Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). Finally, we note that these printed publications are only probative for what they show on their face and not the truth of the material they contain. *See* 37 CFR §2.122(e), TBMP 704.08.

Discussion

Opposer has proven that its pleaded registrations are subsisting and owned by opposer. Therefore, we find that opposer has established its standing to oppose. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, Section 2(d) priority is not in issue as to the goods identified in opposer's registrations. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).⁶

⁶ We note that pleaded Registration No. 708731, surrendered by opposer after filing of its notice of reliance, is now cancelled. We also note that Registration No. 1290661, originally registered in five classes, has been maintained through post registration filings only as to certain goods in two classes. The Board will take judicial notice of the current status of a registration made of record. *See Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650 (TTAB 2002); TBMP Section 704.03(b)(1)(A). Our introductory summary of opposer's pleaded registrations lists only the goods remaining in Registration No. 1290661.

Our determination of likelihood of confusion under §2(d), 15 U.S.C. §1052(d), must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering any evidence of record bearing on these factors, we are guided by the principle that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). However, the Board is not required to consider every factor. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350 (Fed. Cir. 2004). Rather, the Board must consider only the factors that are relevant and for which evidence is of record. *Id.* Moreover, any one factor may control a particular case. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531 (Fed. Cir. 1997) (citing *duPont*, 476 F.2d at 1361-62).

Opposer argues it holds “numerous registrations and applications for its OMEGA marks for computer and electronic devices,” noting “Plaintiff’s Registration No. 1,290,661 specifically includes computers.” *Opposer’s Brief* at 7. Opposer’s statement overlooks the stated limitations of the

registration to particular types of computers. Nonetheless, "[t]he 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 [and an opposer's pleaded registration] 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 *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Board must presume that the goods of the applicant include all goods of the type encompassed by the applicant's identification and that the goods of applicant and opposer are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant's broad description of goods as "computer hardware and peripherals" encompasses a broad range of products which may be sold to many different purchasers in any channel of trade. Thus, notwithstanding the limitation in opposer's Registration No. 1290661 to particular types of computers, applicant's broad, general identification must be read to include the more specific type of computers

identified in opposer's registration, i.e., "computer apparatus for checking and controlling the measurement of time and distance for sporting events... [and] computers for calculating information in respect of time and distance, storing such information, and making the same available in visual or audible form." Accordingly, the parties' goods are, in part, legally identical. We would make the same finding even on applicant's proposed amended identification.

As for classes of consumers and channels of trade, we note that there are no limitations as to either in the involved identifications. Accordingly, not only are the goods presumptively identical in part, they also are presumptively marketed to the same consumers through the same channels of trade.

We now turn to the marks themselves, keeping in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The similarity or dissimilarity of marks is analyzed by comparing marks, in their entirety, as to appearance, sound, connotation and commercial impression. *duPont, supra*; see also, *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While the marks are compared in their entireties, "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 entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In composite marks, such as opposer's OMEGA and design mark, words tend to dominate over designs, because words would be used to request products or services by name. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). Thus, in opposer's OMEGA and design mark, the word OMEGA is a more dominant element. Further, we note that the design in opposer's mark $-(\Omega)-$ is the Greek symbol known as "omega,"⁷ which reinforces the dominance of the literal portion of the mark.

Applicant's mark includes the entirety of the dominant element of opposer's mark, OMEGA, and merely adds BYTE to form a compound word. We take judicial notice that "byte" is "a generic term to indicate a measurable portion of

⁷ We take judicial notice of the Alphabet Table listed in *Webster's Ninth New Collegiate Dictionary*, p. 76 (Fredrick C. Mish, ed., 1983).

consecutive binary digits."⁸ Because BYTE will likely be viewed as descriptive or highly suggestive when used in conjunction with computer goods, it will not lend much, if any, source indicating capacity to the compound OMEGABYTE. The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto. Thus, "if the dominant portion of both marks is the same, the confusion may be likely notwithstanding peripheral differences." See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (HEWLETT PACKARD and PACKARD TECHNOLOGIES); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE and RESPONSE CARD); and *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS). See also, discussion in TMEP § 1207.01 (b)(iii) (4th ed. 2005). The present case is no exception and we find the addition of BYTE, as a suffix to opposer's "OMEGA" is insufficient to distinguish applicant's mark "OMEGABYTE" from opposer's registered trademarks for "OMEGA."

⁸ We take judicial notice of Charles J. Sippl & Roger J. Sippl's *Computer Dictionary* at 54 (3rd ed. 1984).

Typical consumers are likely to retain a general rather than specific impression of trademarks or servicemarks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd. No. 92-1086 (Fed. Cir. June 5, 1992). In this case, even if consumers did note the differences in the marks, because the marks share the identical dominant term there would still be a likelihood of confusion. *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983)(Comparing applicant's mark GIANT HAMBURGERS and design with opposer's GIANT and GIANT and design marks, the court noted that nothing in applicant's mark indicated source or origin and purchasers were left to speculation; and court reasoned that a person familiar with opposer's products "would likely conclude that the word 'GIANT' in applicant's mark refers to opposer as the sponsor, source and origin of applicant's products").

Turning now to the issue of consumer care, the Board has received no evidence as to the amount of consumer care involved in purchasing applicant's or opposer's goods. While the parties' respective goods are likely to encompass at least some relatively expensive goods and may be purchased with more care, many of the items encompassed by applicant's identification would not necessarily be expensive. In any event, opposer is correct that "customer sophistication does not equate to trademark sophistication."

Opposer's Brief at 8. In this case, even if the parties' customers were considered sophisticated, the parties' nearly identical marks and legally identical goods support a conclusion that confusion would be likely as to origin, endorsement or sponsorship. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical 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."].

To the extent there is any doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

In light of the legally identical nature of at least some of the goods, great similarity of the marks, and legally identical trade channels and classes of consumers, we hold there is a likelihood of confusion.

Decision: The opposition is sustained and registration to applicant of the mark OMEGABYTE in International Class 9 is refused. The application shall proceed to registration only in the unopposed Class 35.