

ESTTA Tracking number: **ESTTA494170**

Filing date: **09/12/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Datron World Communications, Inc.		
Entity	Corporation	Citizenship	California
Address	3055 Enterprise Court Vista, CA 92081 UNITED STATES		

Attorney information	Gregory J. Borman, Esq. Smaha Law Group 7860 Mission Center Court Suite 100 San Diego, CA 92108 UNITED STATES gborman@smaha.com Phone:619-688-1557		
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Applicant Information

Application No	85446494	Publication date	08/14/2012
Opposition Filing Date	09/12/2012	Opposition Period Ends	09/13/2012
Applicant	TCI International, Inc. Attn: Contracts 3541 Gateway Blvd. Fremont, CA 94538 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: A complete system for signal monitoring and intelligence applications providing signal survey, detection, classification, acquisition, demodulation, recording, geo-location and analysis of radio frequency signals in high frequency, very high frequency/ultra high frequency, and microwave frequency ranges, comprised of radio frequency receivers, digital converters, configurable drop receivers, signal processors, wideband and narrowband signal data storage, signal database, optional emitter direction finding / geo-location sub-systems, and specialized client and control software for signal collection and analysis for use by militaries and government agencies</p>
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Grounds for Opposition

Other	Likelihood of confusion with another mark. Trademark Act section 2(d)
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Attachments	Notice of Opposition.pdf (9 pages)(86703 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Gregory J. Borman/
Name	Gregory J. Borman, Esq.
Date	09/12/2012

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3 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
4 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

5 In the matter of trademark application Serial No. 85446494
6 For the mark "Guardian"
7 Published in the Official Gazette on August 14, 2012

8 DATRON WORLD COMMUNICATIONS, INC., a California corporation, Opposer;

9 v.

10 TCI INTERNATIONAL, INC., a Delaware corporation, Applicant

11 **NOTICE OF OPPOSITION**

12 Opposer:

13 Datron World Communications, Inc., a California corporation
14 3055 Enterprise Court
15 Vista, California 92081

16 Opposer's Counsel:

17 John L. Smaha, Esq., California Bar No. 95855; jsmaha@smaha.com
18 Gregory J. Borman, Esq., California Bar No. 224888; gborman@smaha.com
19 SMAHA LAW GROUP
20 7860 Mission Center Court, Suite 100
21 San Diego, California 92108
22 Tel: (619) 688-1557; Fax: (619) 688-1558

23 The above-identified opposer believes that it will be damaged by registration of the mark
24 shown in the above-identified application, and hereby opposes the same.

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1 The grounds for opposition are as follows:

2 **I.**

3 **SUMMARY**

4 1. This opposition is made because there exists the registered mark of “Guardian” that is
5 being used in the same industry in which the opposed mark would be used if approved. (The
6 registered mark was registered on July 1, 2003 and was assigned Registration Number
7 2732718, and is referred to herein as the “Guardian Mark”). The applicant artfully describes
8 its products in its application (Serial No. 85446494), but a review of its marketing literature
9 reveals that the applicant’s goods include radio and radio-related equipment that operates in
10 the UHF and VHF bands, which is exactly what the owner of the Guardian Mark’s products
11 consist of. Because the opposed mark is the same word as the Guardian Mark and it is to be
12 used in the same industry, there is a strong likelihood of confusion as to the source or
13 sponsorship of the parties’ respective goods so the application should be denied.

14 **II.**

15 **FACTS**

16 2. The Guardian Mark is owned by Datron World Communications, Inc., of Vista,
17 California (“Datron”). Datron’s website reads, in part and as to its Guardian® products,
18 “Datron’s P25 portable and mobile radios deliver communications interoperability in rapid-
19 response environments where lives are on the line. Designed for First Responders, Public
20 Safety, and Federal users, Datron’s line of radios include conventional analog, P25 Digital,
21 and P25 Trunking solutions.” (*See*, www.dtwc.com/products.)

22 3. Datron’s Guardian® goods include:

- 23
- 24 ○ Portable radios in the VHF and UHF bands (for two examples, see
 - 25 www.dtwc.com/products/public-safety/portable-radios/guardian-2-tri-band and
 - 26 www.dtwc.com/products/public-safety/portable-radios/guardian-vhf);
 - 27 ○ Mobile radios in the VHF band (for one example, see
 - 28 www.dtwc.com/products/public-safety/mobile-radios/guardian-mobile-50w);
 - A remote mount radio (see, [www.dtwd.com/products/public-safety/remote-mount-](http://www.dtwd.com/products/public-safety/remote-mount-radio/guardian-remote-mount-radio)
 - [radio/guardian-remote-mount-radio](http://www.dtwd.com/products/public-safety/remote-mount-radio/guardian-remote-mount-radio)); and

- 1 ○ Desktop radios in the VHF band (for one example, see
2 www.dtwc.com/products/public-safety/desktop-radios/guardian-110w-desktop-radio).

3 4. Datron describes itself thusly on its website: “Datron World Communications, Inc.
4 (DWC) is a privately owned company located in Vista, California. For over 30 years, Datron
5 has been the price-performance leader in the manufacture and supply of tactical military and
6 public safety radio equipment to a diverse worldwide customer base. Today, we do business
7 in over 80 countries backed by an international sales representative network and regional
8 support centers... Datron’s communications equipment includes a comprehensive selection
9 of extremely reliable HF and VHF military voice and data radio products, commercial HF
10 offerings, a complete line of APCO Project 25 compliant radios for the Public Safety market,
11 and a Governmental Solutions Group experienced at integrating your complete
12 communications needs. Datron’s radio products are recognized around the world for their
13 performance, ease of operation, reliability, serviceability and low life-cycle cost...” (See,
14 www.dwtc.com/about-datron.)

15 5. But as to the opposed mark, a press release from the applicant describes its “new
16 Guardian product line” as including “equipment with integrated systems for signal
17 acquisition, storage, I and Q playback, and analysis of wideband and narrowband RF signals
18 in the HF and VHF/UHF frequency ranges... The first Guardian product introduction is
19 scheduled for January 2012 with the availability of the TCI Model 8240 – Guardian™ HF
20 Signal Recorder and Playback System. Additional Guardian V/UHF and dual HF, V/UHF
21 product offerings are scheduled for introductions later in 2012...” (Applicant’s October 4,
22 2011 press release; *see*, www.tcibr.com/?PageID=277.)

23
24 6. And as to the applicant itself, the same press release reads, in part, “TCI International,
25 Inc., provides spectrum monitoring, direction finding, and signal collection solutions to
26 civilian, government, military, and intelligence agencies, as well as antennas for
27 communications and high-power radio broadcasting...” (*Ibid.*) As to the applicant’s
28 corporate parent, the same press release continues, “SPX Communications technology

1 provides innovative RF and spectrum monitoring, direction finding, signal collections,
2 broadcast, wireless communications and wireless infrastructure protection solutions to
3 civilian, government, military and intelligence agencies.” (*Ibid.*)

4 7. Thus, the applicant intends to use its opposed mark on goods to be marketed and sold
5 to military, government, and commercial consumers of radio and radio-related goods.
6 Unfortunately, those are precisely the same consumers to which Datron already markets and
7 sells its Guardian® brand of radio and radio-related goods. So, due to the similarity of the
8 marks, the goods, and the consumers, the application should be denied due to the high
9 likelihood of confusion regarding the goods’ respective sources.
10

11 **III.**
12 **LAW AND ANALYSIS**

13 **A. Right to Oppose**

14 8. Any person who believes that he or she would be damaged by the registration of a
15 mark on the Principal Register may oppose registration by filing a notice of opposition with
16 the Board, and paying the required fee, within 30 days after the date of publication, or within
17 an extension period granted by the Board for filing an opposition. (See 15 U.S.C. § 1063.)
18 The notice of opposition must include a concise statement of the reasons for the opposing
19 party’s belief that the opposing party would be damaged by the registration of the opposed
20 mark, and must state the grounds for opposition. (37 C.F.R. § 2.104(a).)

21 9. Here, Datron has the right to oppose the application because it will be damaged by the
22 confusion likely to be born of another’s use of its Guardian Mark in Datron’s own industry.
23

24 **B. Likelihood of Confusion**

25 10. No trademark by which the goods of the applicant may be distinguished from the
26 goods of others shall be refused registration on the principal register on account of its nature
27 unless it ... (d) Consists of or comprises a mark which so resembles a mark registered in the
28 Patent and Trademark Office, or a mark or trade name previously used in the United States

1 by another and not abandoned, as to be likely, when used on or in connection with the goods
2 of the applicant, to cause confusion, or to cause mistake, or to deceive... (15 U.S.C. § 1052;
3 emphasis added.)

4
5 11. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is the statutory basis for a
6 refusal to register due to likelihood of confusion with another mark. Section 2(d) applies
7 regardless of whether registration of the mark is sought on the Principal Register or the
8 Supplemental Register.

9 12. A refusal under § 2(d) is normally based upon the conclusion that the applicant's
10 mark, as used on or in connection with the specified goods or services, so resembles a
11 registered mark as to be likely to cause confusion. (See TMEP §1207.02 concerning
12 application of the §2(d) provision relating to marks that so resemble another mark as to be
13 likely to deceive.)

14
15 13. The issue is not whether the respective marks themselves, or the goods or services
16 offered under the marks, are likely to be confused but, rather, whether there is a likelihood of
17 confusion as to the source or sponsorship of the goods or services because of the marks used
18 thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Pub'g Co., Inc.*, 473 F.2d 901, 902,
19 (C.C.P.A. 1973) (“[T]he question is not whether people will confuse the marks, but rather
20 whether the marks will confuse people into believing that the goods they identify emanate
21 from the same source”); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1316 (Fed. Cir.
22 2003) (“...mistaken belief that [a good] is manufactured or sponsored by the same entity ... is
23 precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”); *In re Shell Oil*
24 *Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (“The degree of
25 ‘relatedness’ must be viewed in the context of all the factors, in determining whether the
26 services are sufficiently related that a reasonable consumer would be confused as to source or
27 sponsorship.”); *Hilson Research, Inc. v. Society for Human Resource Management*, 27
28 USPQ2d 1423, 1429 (TTAB 1993) (“Although confusion, mistake or deception about source
or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior

1 user's mark is cause for refusal; likelihood of confusion encompasses confusion of
2 sponsorship, affiliation or connection.”).

3
4 14. In the seminal case involving §2(d), *In re E. I. du Pont de Nemours & Co.*, the U.S.
5 Court of Customs and Patent Appeals discussed the factors relevant to a determination of
6 likelihood of confusion. 476 F.2d 1357 (C.C.P.A. 1973). In setting forth the factors, the court
7 cautioned that, with respect to determining likelihood of confusion, “[t]here is no litmus rule
8 which can provide a ready guide to all cases.” *Id.* at 1361. Not all of the factors are relevant
9 and only those relevant factors for which there is evidence in the record must be considered.
10 *Id.* at 1361-62.; *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, (Fed. Cir. 2010) (“Not
11 all of the *DuPont* factors are relevant to every case, and only factors of significance to the
12 particular mark need be considered.”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315,
13 (Fed. Cir. 2003) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, (Fed. Cir. 1997));
14 *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, (Fed. Cir. 2000). Furthermore, the
15 significance of a particular factor may differ from case to case. *See du Pont*, 476 F.2d at
16 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533
17 (noting that “any one of the factors may control a particular case”).

18 15. Although the weight given to the relevant *du Pont* factors may vary, the following two
19 factors are key considerations in any likelihood of confusion determination:

- 20 ○ The similarity or dissimilarity of the marks in their entirety as to appearance, sound,
21 connotation and commercial impression.
- 22 ○ The relatedness of the goods or services as described in the application and
23 registration(s).

24 *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (C.C.P.A.
25 1976).

26
27 16. As should be clear from the foregoing, there is no mechanical test for determining
28 likelihood of confusion and “each case must be decided on its own facts.” *Du Pont*, 476 F.2d
at 1361. In some cases, a determination that there is no likelihood of confusion may be

1 appropriate, even where the marks are similar and the goods/services are related, because
2 these factors are outweighed by other factors, such as differences in the relevant trade
3 channels of the goods/services, the presence in the marketplace of a significant number of
4 similar marks in use on similar goods/services, or the existence of a valid consent agreement
5 between the parties.

6 17. Here, the applied for mark would be used in the commercial, police, and military
7 radio industry, which is the precise industry in which Datron uses its Guardian Mark.
8 Because there would be two “Guardian” product lines within the same industry on very
9 similar products, the consumer would likely confuse the source of the goods. Therefore, the
10 application should be denied.
11

12 **C. 1207.01(a) Relatedness of the Goods**

13 18. In assessing the relatedness of the goods and/or services, the more similar the marks at
14 issue, the less similar the goods or services need to be to support a finding of likelihood of
15 confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993). If the marks of the
16 respective parties are identical or virtually identical, the relationship between the goods
17 and/or services need not be as close to support a finding of likelihood of confusion as would
18 be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207.

19 19. Because the opposed mark is the exact same word as the Guardian Mark, and because
20 the opposed mark would be used in the same industry, there need not be a precise match
21 between the goods. Thus, even if the applicant’s “Guardian products” are not radios that are
22 identical to the Datron Guardian® products, the application should be denied. And even if
23 the applicant’s goods are not radios at all, but rather are comprised of hardware and/or
24 software that receives and/or analyzes radio signals, the fact that they are related to radio
25 technology and are marketed to military, government, and commercial customers render the
26 applicant’s goods close enough to Datron’s Guardian® goods to make a denial appropriate.

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1 **D. 1207.01(a)(i) Goods Need Not Be Identical**

2 20. In a §2(d) determination, the goods and/or services do not have to be identical or even
3 competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs., LLC*, 95
4 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368
5 (TTAB 2009). The issue is not whether the goods and/or services will be confused with each
6 other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C.*
7 *Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). “[E]ven if the goods in question are different
8 from, and thus not related to, one another in kind, the same goods can be related in the mind
9 of the consuming public as to the origin of the goods. It is this sense of relatedness that
10 matters in the likelihood of confusion analysis.”); *In re Shell Oil Co.*, 992 F.2d 1204, 1207
11 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403-04
12 (C.C.P.A. 1975). It is sufficient that the goods and/or services of the applicant and the
13 registrant are related in some manner or that the conditions surrounding their marketing are
14 such that they are likely to be encountered by the same persons under circumstances that,
15 because of the marks used in connection therewith, would lead to the mistaken belief that
16 they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*,
17 229 F.3d 1080 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services
18 and ONLINE TODAY for an electronic publication likely to cause confusion); *In re Martin’s*
19 *Famous Pastry Shoppe, Inc.*, 748 F.2d 1565 (Fed. Cir. 1984) (holding MARTIN’S for wheat
20 bran and honey bread, and MARTIN’S for cheese, likely to cause confusion); *In re Toshiba*
21 *Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (holding VANTAGE TITAN for MRI
22 diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion);
23 *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (holding ENYCE for custom
24 automotive accessories, and ENYCE for various urban lifestyle clothing items and
25 accessories, likely to cause confusion); *In re Corning Glass Works*, 229 USPQ 65 (TTAB
26 1985) (holding CONFIRM for a buffered solution equilibrated to yield predetermined
27
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