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

Proceeding	92050789
Party	Defendant Hewlett-Packard Development Company, L.P.
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I hereby certify that on the date shown below, this correspondence is being deposited electronically with the Trademark Trial and Appeal Board.

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Dated: April 20, 2011

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

NARTRON CORPORATION,

Petitioner,

v.

HEWLETT-PACKARD DEVELOPMENT
COMPANY, L.P.,

Respondent.

Cancellation No. 92050789
Registration No. 3,600,880
Registration Date: April 7, 2009
Mark: **TOUCHSMART**
RESPONDENT'S TRIAL BRIEF

REDACTED

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INTRODUCTION

For over three years now, the SMART TOUCH and TOUCHSMART marks have been used concurrently, but the parties agree there has been no actual confusion. This is not surprising, given that these marks are used in connection with dramatically different goods that are sold to sophisticated consumers in different markets.

Petitioner Nartron Corporation (“Petitioner” or “Nartron”) sells electronic proximity sensors and switching devices under the SMART TOUCH mark. These goods are component parts used by other companies such as car manufacturers to build end products for consumers. These end products are ultimately sold under the manufacturer’s brand, not the SMART TOUCH mark. On the other end of the spectrum are HP’s TOUCHSMART personal computers with hardware, display screens and monitors. These goods are sold to lay consumers and businesses together as a finished product. None are sold as component parts or even intended to be or marketed to be used in manufacturing other products. No car manufacturer buying Nartron proximity sensors and switching devices has the slightest doubt what company he or she is dealing with when making that purchase. And there is no chance that the buyer of an HP TOUCHSMART computer has any doubt about the source of that product. Nartron has virtually no visibility at all in the consumer marketplace. Simply put, HP and Nartron are not competitors with respect to the goods identified in the parties’ respective registrations. Under these circumstances, confusion is more than highly unlikely.

The circumstances of purchase and typical consumers also demonstrate that confusion is unlikely. The purchasers of specialized component parts and high-end computers are not likely to be confused even by very similar marks because they typically are sophisticated and discerning customers. Where, as here, the goods are relatively expensive, these customers will make carefully considered choices, not impulse purchases. Further, the channels of trade for the parties’ respective goods are also entirely different: [REDACTED]

[REDACTED] HP’s TOUCHSMART products, on the other hand, are sold by retailers such as Best Buy and Office Depot, on HP’s own website, or through negotiated agreements with businesses in certain targeted vertical markets. There is virtually no overlap between the market for Nartron’s component parts

1 and that for HP's personal computers.

2 HP has been marketing products with the "SMART" suffix as part of its brand for over 16
3 years. Its marks include PHOTOSMART, MEDIASMART, COLORSMART and ZOOMSMART.
4 The naming of HP's touch-screen PC had everything to do with this line of previous products and
5 nothing whatsoever to do with Petitioner. Indeed, the principals of the HP TOUCHSMART group
6 had never even heard of Nartron or its SMART TOUCH components when they launched the HP
7 TOUCHSMART PC, nor have they ever encountered them in any commercial transaction, proposed
8 or actual. Their only awareness of Petitioner is due to this action.

9 In the absence of any actual confusion, and in light of the dissimilarity of the goods, the
10 customers, the channels of trade and the marks themselves, the Board should find that there is no
11 likelihood of confusion.

12 **DESCRIPTION OF THE RECORD**

13 HP's record in this case consists of the following:

- 14 • The pleadings in this case.
- 15 • The files of the registrations at issue (U.S. Registration No. 1,681,891 and U.S.
16 Registration No. 3,600,880).
- 17 • The testimony deposition of John Washeleski, taken on September 2, 2010 and filed on
18 October 18, 2010 (docket no. 28), and Exhibits 1-30 and 100.¹ Mr. Washeleski's
19 testimony deposition is cited as "Washeleski page:line" or "Washeleski Ex. ___."
- 20 • Petitioner's Notice of Reliance and Exhibits 1-17, filed on September 23, 2010 (docket
21 nos. 22-25).
- 22 • Respondent's Notice of Reliance and Exhibits 1-85, filed on November 22, 2010 (docket
23 nos. 29-33).
- 24 • The testimony deposition of Ashley Frankart, taken on November 2, 2010 and filed on
25

26
27 ¹"Exhibits which are marked and identified at the deposition will be deemed to have been
28 offered into evidence, without any formal offer thereof, unless the intention of the party marking the
exhibits is clearly expressed to the contrary." 37 C.F.R. §2.123(e)(2).

1 December 1, 2010 (docket nos. 37-38), and Exhibits 1-8. Ms. Frankart's testimony
2 deposition is cited as "Frankart page:line" or "Frankart Ex. ___."

- 3 • The testimony deposition of Jean Neumann, taken on November 2, 2010 and filed on
4 December 15, 2010 (docket nos. 39-40), and Exhibits 1-14. Ms. Neumann's testimony
5 deposition is cited as "Neumann page:line" or "Neumann Ex. ___."
- 6 • Petitioner's Rebuttal Notice of Reliance and Exhibits 1-5, filed on January 20, 2011
7 (docket no. 43).

8 9 STATEMENT OF ISSUES

10 Is Respondent's mark TOUCHSMART, used in connection with personal computers,
11 computer hardware, computer monitors and computer display screens, likely to be confused by the
12 sophisticated purchasers of its products with Petitioner's mark SMART TOUCH, used in connection
13 with electronic proximity sensors and switching devices?

14 15 STATEMENT OF FACTS

16 **A. Nartron Sells Component Parts To Sophisticated Manufacturers Under The** 17 **SMART TOUCH Mark For Use In Products Such As Cars That Are Ultimately** 18 **Sold To Consumers Under A Different Mark.**

19 On May 22, 1991, Nartron filed Application Serial No. 74/168,921 for SMART TOUCH for
20 use in connection with "electronic proximity sensors and switching devices" in International Class
21 009.² The SMART TOUCH mark was registered on April 7, 1992 (U.S. Registration No.
22 1,681,891), with a reported first use in commerce on January 7, 1988. *See* Petitioner's Notice of
23 Reliance, Ex. 1. The only goods identified in the SMART TOUCH registration are electronic
24 proximity sensors and switching devices. *Id.*

25 _____
26 ²Petitioner has conceded that it does not separately sell switching devices under the SMART
27 TOUCH mark. Testimony Deposition of John Washeleski 65:22-24. It does, however, sell
28 electronic proximity sensors and switching devices *together* under the SMART TOUCH mark (*id.* at
65:25-66:2), just as HP sells personal computers, computer hardware, computer monitors and
computer display screens together under the TOUCHSMART mark as an all-in-one personal
computer.

1 Electronic proximity sensors and switching devices are component parts that are used mainly
2 by car manufacturers but also other original equipment manufacturers to build finished products for
3 consumers. Testimony Deposition of John Washeleski (“Washeleski”) 11:17-20, 33:17-34:9, 36:16-
4 37:9, 37:15-38:1 & Ex. 2 (“Applications include automobile [instrument panel], radio and HVAC
5 controls”), Ex. 4 (“carmakers are beginning to replace analog dials and controls with touch-screen
6 displays”), Ex. 7 (instrument panel design with Smart Touch® Centerstack³), Ex. 8 (“Applications
7 include automobile [instrument panel], radio and HVAC controls”), Ex. 9 (“capacitive sensing
8 interface technology creates new automotive design opportunities”), Ex. 11 (listing “Nartron Firsts,”
9 including “First solid state vehicular switches” under the Smart Touch mark), Ex. 16 (“capacitive
10 switching interface technology creates new automotive design opportunities. . . . Applications
11 include automobile [instrument panel], radio and HVAC controls”), Ex. 18 (showing automobile
12 window control application), Ex. 19 (showing various automobile applications). The diagrams in
13 various Nartron documents also illustrate that SMART TOUCH sensors are merely one component
14 part of a larger finished product. See Washeleski Ex. 2 at 2 (illustrating Nartron’s iQ Power HMI
15 assembly), Ex. 8 at 2 (illustrating centerstack assembly), Ex. 9⁴ at 2 (Figure 2 shows a capacitive
16 sensor matrix in an instrument panel substrate).

17 Customers of the SMART TOUCH sensors and switches are “the makers of products who
18 then incorporate those sensors into their products.” Washeleski 57:7-9; see also *id.* at 68:14-16
19 (Nartron’s customers are “other businesses and manufacturers of products”). John Washeleski,
20 Nartron’s sole witness, is the Senior Vice President of Engineering at Nartron and interacts with
21 Nartron’s sales department on a daily basis. *Id.* at 5:12-19, 6:1-2, 55:13-21. Mr. Washeleski was
22 only able to name two Nartron customers who purchased electronic proximity sensors from Nartron
23 in 2010: E1, a fire truck manufacturer, and Ford. *Id.* at 60:14-25, 72:11-16. [REDACTED]
24 [REDACTED]

25
26 ³In an automobile, the “centerstack” is “the area above your shifter in the center of the console
27 that has your navigation, your HVAC, radio, you know, type of controls for the vehicle.”
28 Washeleski 9:9-14.

⁴Washeleski Exhibit 9 is an abstract for an article for SAE’s 2009 World Congress. The
acronym “SAE” stands for Society of Automotive Engineers. Washeleski 19:11-13.

1 [REDACTED]
2 [REDACTED] The sales cycle
3 is lengthy: in some cases a month, or even a year. *Id.* at 70:20-71:3. In addition to the contract or
4 purchase order, Nartron also typically enters into confidentiality agreements with potential
5 customers. *Id.* at 71:8-14, 72:18-25.
6

7 **B. HP Sells High-End Personal Computers Under The TOUCHSMART Mark To**
8 **Sophisticated Individuals And Businesses For Use In The Home And Customer-**
9 **Facing Areas.**

10 On June 4, 2007, HP filed Application Serial No. 77/197,146 for TOUCHSMART for use in
11 connection with “personal computers, computer hardware, computer monitors, computer display
12 screens” in International Class 009. The examining attorney did not cite Nartron’s SMART
13 TOUCH mark in his examination of HP’s application. The TOUCHSMART mark was registered
14 on April 7, 2009 (U.S. Registration No. 3,600,880), with a first use in commerce on January 29,
15 2007. Respondent’s Notice of Reliance, Ex. 1. The TOUCHSMART mark is always preceded by
16 the HP house mark (“HP”). Testimony Deposition of Jean Neumann (“Neumann”)⁵ 8:21-9:2;
17 Testimony Deposition of Ashley Frankart (“Frankart”)⁶ 23:20-22; *see also, e.g.*, Frankart Exs. 1, 4,
18

⁵Jean Neumann has worked at HP (formerly at Compaq) since 2000. Neumann 4:7-12. Her
19 career has evolved from production administration, where she was responsible for product
20 packaging and in-box documentation, to Creative Operations Manager for the Personal Systems
21 Group. *Id.* at 4:13-25. The Personal Systems Group is a global business unit encompassing a
22 variety of products—desktop and notebook PCs, calculators, and other non-printer products—for
23 both commercial and consumer customers. *Id.* at 5:1-8. Ms. Neumann currently works on naming
24 products, packaging for these products, and creating different types of deliverables, such as product
25 demos, videos and other marketing materials. *Id.* at 5:13-18. She is responsible for approving new
26 names from a branding perspective and for reviewing marketing materials to ensure compliance
27 with the worldwide brand guidelines for a particular product. *Id.* at 5:19-6:2. For the HP
28 TOUCHSMART products, Ms. Neumann worked on the TOUCHSMART name itself, the original
product launch, packaging and marketing materials, and product demos. *Id.* at 6:6-14. She works
with and supports HP’s sales team, and has accompanied the sales team on at least one sales call. *Id.*
at 41:2-8, 45:16-46:4.

⁶Ashley Frankart has worked at HP since August 2007. Frankart 3:16-4:2. She started as the
Marketing Communications Manager for the commercial desktop group, preparing marketing
communication materials for new product launches. *Id.* at 4:5-11. In that position, Ms. Frankart
was responsible for working with the product managers to identify value propositions and key
messages. *Id.* at 4:12-21. She created PowerPoint presentations, messaging documents, data sheets
and other materials to help communicate the value of a particular product to HP’s customers. *Id.*
Once these materials were approved, Ms. Frankart distributed them to the regional marketing teams
(continued . . .)

1 6. Use of the TOUCHSMART mark without HP’s house mark would violate HP’s brand guidelines.
2 Frankart 23:20-22.

3 HP has used and continues to use a series of other marks with the suffix “SMART.” These
4 marks include PHOTOSMART (U.S. Registration No. 2,362,503), MEDIASMART (U.S.
5 Registration No. 3,665,225), COLORSMART (U.S. Registration No. 2,057,747), and
6 ZOOMSMART (U.S. Registration No. 2,232,611). Respondent’s Notice of Reliance, Exs. 2-5, 51-
7 52; Neumann 9:5-10:25 & Ex. 3. Most recently, HP has applied to register COPYSMART (U.S.
8 Trademark Application No. 77/826,570). Respondent’s Notice of Reliance, Ex. 6. The
9 TOUCHSMART mark was expressly intended to “continue that line of family of products to build
10 on the reputation that [it] had gained from those different product lines.” Neumann 9:3-10:25,
11 67:24-68:9.

12
13 **1. HP’s TOUCHSMART Consumer Products Are Marketed To Computer-
14 Savvy Families And Individuals.**

15 The goods identified in the TOUCHSMART registration are not marketed or sold separately
16 under the TOUCHSMART mark; rather, they are all sold together as a finished product: an all-in-
17 one touch-capable personal computer. Neumann 11:7-15, 68:10-19; Frankart 12:21-13:12. As the
18 name implies, an all-in-one personal computer is a computer that places the traditional PC tower in
19 the back of the display screen so that there is only one single unit that includes the actual computer,
20 monitor and display screen all in one. Frankart 6:17-7:1, 9:14-24, 11:13-21 & Exs. 1, 4, 6 (HP
21 micro sites for HP TOUCHSMART PCs). None of the goods listed in the TOUCHSMART
22

23 _____
24 (. . . continued)

25 and then worked with the sales team to take those products to market. *Id.* In August 2009,
26 Ms. Frankart moved from the commercial side to the consumer side. *Id.* at 4:22-5:4. Her duties on
27 the consumer side are very similar to her previous duties on the commercial side. *Id.* at 5:5-10. She
28 continues to prepare the same types of deliverables—presentations, data sheets, key messaging
documents—but for HP’s consumer platforms instead of its commercial platforms. *Id.* On both the
commercial and the consumer side, Ms. Frankart has prepared marketing and messaging materials
for the HP TOUCHSMART PCs and has reviewed HP TOUCHSMART product press releases for
key messages and content. *Id.* at 5:11-17, 9:20-10:6, 20:1-7. Ms. Frankart also worked on
marketing materials for the commercial HP TOUCHSMART PCs and was involved in identifying
potential customers for those products. *Id.* at 16:15-17:10.

1 registration are sold as component parts for use in manufacturing other products. Neumann 11:17-
2 20, 68:17-19; Frankart 13:13-19. [REDACTED]

3 [REDACTED]

4 The original HP TOUCHSMART personal computer was released in January 2007. Neumann
5 7:16-8:20 & Ex. 2; Respondent’s Notice of Reliance, Ex. 50. It was “meant to be used in a
6 communal area within the house, whether it be a kitchen or an entryway, somewhere that the entire
7 family could access calendars, perhaps in the kitchen where you could access recipes”

8 Neumann 13:16-22. [REDACTED]

9 [REDACTED]

10 [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 [REDACTED]

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 [REDACTED]

26 [REDACTED]

27 ⁷Exhibits 6 and 7 to Ms. Neumann’s testimony deposition were produced in discovery in
28 response to Petitioner’s First Set of Requests for Production; no motion to compel was filed in this case.

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[REDACTED]

HP TOUCHSMART products are sold at brick-and-mortar retail stores and online. Neumann 35:7-10. The starting prices for HP TOUCHSMART PCs range from \$799.99 to \$1699.99. Neumann 14:3-25 & Ex. 5 (\$849.99 for HP TOUCHSMART notebook PC); Frankart 8:13-18, 9:3-10, 11:3-12, 12:3-20 & Ex. 2 (\$1079.99 for HP TOUCHSMART 600xt series PC), Ex. 3 (\$1699.99 for HP TOUCHSMART 600 Quad series), Ex. 5 (\$1099 for HP TOUCHSMART 9100 Business PC), Ex. 7 (\$799.99 for HP TOUCHSMART 300z series PC). The starting price is the base price, which increases as customers add options such as a higher operating processor, more memory, graphic cards, etc. Neumann 15:1-6; Frankart 8:19-23.

2. HP’s TOUCHSMART Commercial Products Are Marketed To The Hospitality, Retail, Health Care And Education Sectors.

HP also sells HP TOUCHSMART products to large businesses, which HP refers to as “enterprise customers,” [REDACTED] Neumann 37:4-13; Frankart 21:16-22:3. [REDACTED]

[REDACTED]

[REDACTED] For the HP TOUCHSMART commercial PCs, HP has targeted only a few specific vertical markets. *Id.* As Ms. Frankart testified, “It’s not just take these and put them in every office in your business because it is a really expensive PC for that, so that’s why we have these targeted segments that we are going after.” *Id.* at 21:25-22:3.

The target industries for the HP TOUCHSMART commercial PCs are the education, health care, hospitality and retail industries. *Id.* at 16:18-17:10; *see also* Neumann 38:10-14 (examples of enterprise customers that use HP TOUCHSMART PCs include the hospitality and restaurant industries). Education is targeted because using touch is intuitive for children; in the health care

1 setting, HP TOUCHSMART computers can provide easy access to information for patients; and in
2 the hospitality and retail settings, HP TOUCHSMART PCs can be placed in customer-facing areas
3 to help HP's customer's reach their own customers in a new way. Frankart 15:23-17:10. For
4 example, the Marriott hotel might use a TOUCHSMART PC in its lobby as an information kiosk or
5 virtual concierge for guests. Neumann 38:18-22; Frankart 15:23-16:2. A restaurant might use
6 TOUCHSMART PCs for the wait staff to place orders. Neumann 38:15-17. A retail example is
7 Priscilla of Boston, a high-end bridal boutique, which puts HP TOUCHSMART PCs in their
8 customer-facing areas so that customers can interact directly with the dresses by scrolling through
9 them and actually seeing models wearing and walking in them. Frankart 16:3-11 & Ex. 8 at HP
10 000155. The "virtual bartender" is another way that HP TOUCHSMART PCs are being used by
11 businesses: a customer can walk up and input the number of guests he expects and different types of
12 alcohol, and the "virtual bartender" will make recommendations as to the brand of alcohol and types
13 of mixers that go well with it. *Id.* at 21:5-15.

14 No HP TOUCHSMART products are specifically targeted to the automotive industry,
15 although HP discussed a potential use for HP TOUCHSMART PCs in dealerships for customers to
16 interact with. Neumann 38:23-25; Frankart 17:11-21. HP does not market or sell HP
17 TOUCHSMART products to manufacturers for use as part of a car or as component parts.
18 Neumann 39:1-3, 39:8-40:1; Frankart 16:12-14, 17:22-24.

20 C. The Instant Proceedings.

21 On April 9, 2009, Nartron filed the above-captioned petition to cancel HP's TOUCHSMART
22 registration, asserting, *inter alia*, that "the mark and goods as described in HP's registration are so
23 closely related to Petitioner's mark and goods, [that] confusion and deception as to the origin of
24 Respondent's goods bearing the mark would occur, all to the damage and detriment of Petitioner."

26 ARGUMENT

27 Petitioner bears the burden of proving likelihood of confusion by a preponderance of the
28 evidence. *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377, 380, 144 U.S.P.Q. 249, 251 (8th

1 Cir. 1965). Whether a likelihood of confusion exists is a question of law, based on underlying
2 factual determinations. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d
3 2027, 2028-29 (Fed. Cir. 1993). The Board determines whether there is a likelihood of confusion
4 after considering the applicable *DuPont* factors. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d
5 1357, 1361-62, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). “[T]he question of confusion is related not
6 to the *nature* of the mark but to its *effect* ‘when applied to the goods of the applicant.’ The only
7 *relevant* application is made in the marketplace. The words ‘when applied’ do not refer to a mental
8 exercise, but to all of the known circumstances surrounding use of the mark.” *DuPont*, 476 F.2d at
9 1360-61, 177 U.S.P.Q. at 567 (quoting 15 U.S.C. §1052(d)) (emphases in original).

10 Not all of the *DuPont* factors are relevant here. *See In re Majestic Distilling Co.*, 315 F.3d
11 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the *DuPont* factors may be
12 relevant or of equal weight in a given case, and ‘any one of the factors may control a particular
13 case’”) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 U.S.P.Q.2d 1531, 1533 (Fed.
14 Cir. 1997)). We have focused only on the factors relevant to the Board’s consideration of the
15 likelihood of confusion in this case: (1) the similarity or dissimilarity of the marks in their entireties
16 as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity
17 and nature of the goods or services as described in the registrations; (3) the similarity or dissimilarity
18 of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom
19 sales are made, *i.e.*, “impulse” versus careful, sophisticated purchasing; (6) the number and nature of
20 similar marks in use on similar goods; (7) the nature and extent of any actual confusion; and (8) the
21 length of time during and conditions under which there has been concurrent use without evidence of
22 actual confusion. *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Each of these factors strongly
23 disfavors a finding of likelihood of confusion here.

24
25 **I.**

26 **PETITIONER HAS CONCEDED THAT THERE IS NO EVIDENCE**
27 **OF ANY ACTUAL CONFUSION.**

28 For over three years now, consumers have been exposed to the SMART TOUCH and

1 TOUCHSMART marks and no actual confusion has been detected. This is a “powerful indication”
2 that the TOUCHSMART mark does not cause a meaningful likelihood of confusion. *Nabisco, Inc.*
3 *v. PF Brands, Inc.*, 191 F.3d 208, 228, 51 U.S.P.Q.2d 1882, 1897 (2d Cir. 1999), *abrogated on other*
4 *grounds*, 537 U.S. 418 (2003).

5 Nartron has been using the SMART TOUCH mark in commerce since December 1986.
6 Washeleski 25:21-27:8. HP has been using the TOUCHSMART mark in commerce since January
7 2007. Neumann 7:16-21 & Ex. 2; Respondent’s Notice of Reliance Ex. 50. Despite over three
8 years of concurrent use, there is no evidence of any actual confusion. Indeed, Nartron has conceded
9 that it “is not presently aware of any instances of actual confusion.” Respondent’s Notice of
10 Reliance, Ex. 84 (Petitioner’s Response to Respondent’s First Set of Interrogatories) at Nos. 19-21.
11 Petitioner noted that “case investigation and discovery [we]re continuing,” but in the 11 months
12 since Petitioner signed its discovery responses, it has not supplemented those responses or identified
13 any instances of actual confusion. HP likewise is not aware of any actual confusion between the
14 SMART TOUCH and TOUCHSMART marks, or between Nartron and HP. Neumann 45:5-10;
15 Frankart 25:11-14. Indeed, the two companies never intersect in the marketplace.

16 Therefore, the seventh and eighth *DuPont* factors—here, the absence of any actual confusion
17 over a three-year period—weigh heavily against a finding of likelihood of confusion. *Brookfield*
18 *Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1050, 50 U.S.P.Q.2d 1545, 1553-54 (9th
19 Cir. 1999) (“We cannot think of more persuasive evidence that there is no likelihood of confusion
20 between these two marks than the fact that they have been simultaneously used for five years
21 without causing any consumers to be confused as to who makes what”).

22 II.

23 **THE GOODS IDENTIFIED IN THE REGISTRATIONS ARE** 24 **DISSIMILAR AND ARE NOT ENCOUNTERED IN THE SAME** 25 **ENVIRONMENT BY CONSUMERS.**

26 A finished product sold to consumers and businesses is very different from a component part
27 sold to manufacturers and incorporated into other products. Even if the marks at issue here were
28 identical, confusion would be unlikely because the goods are so different and because consumers are

1 unlikely to encounter them in the same environment. *Reynolds & Reynolds Co., v. I.E. Sys., Inc.*, 5
2 U.S.P.Q.2d 1749, 1751 (T.T.A.B. 1987) (holding that likelihood of confusion requires “some
3 similarity between the goods and services at issue . . . beyond the fact that each involves the use of
4 computers”).

5 To determine whether the goods are similar, the Board must examine the relatedness of the
6 goods (*DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567), that is, whether the goods at issue can be
7 related in the mind of the consuming public as to the origin of the goods. *Shen Mfg. Co. v. Ritz*
8 *Hotel Ltd.*, 393 F.3d 1238, 1244, 73 U.S.P.Q.2d 1350, 1355-56 (Fed. Cir. 2004). The question
9 “must be decided on the basis of the identification of goods or services set forth in the application
10 [or registration], regardless of what the record may reveal as to the particular nature of applicant’s
11 goods, the particular channels of trade, or the class of purchasers to which sales of the goods or
12 services are directed.” *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1359, 56
13 U.S.P.Q.2d 1351, 1355 (Fed. Cir. 2000). However, the Board may consider extrinsic evidence to
14 remove uncertainty as to the nature of the goods identified in the registrations. *In re Trackmobile*
15 *Inc.*, 15 U.S.P.Q.2d 1152, 1153-54 (T.T.A.B. 1990). Where, as here, the goods are not themselves
16 related, analysis of this factor turns on whether “the marks identifying the respective products of
17 [respondent] and [petitioner] would ever be encountered by the same persons in an environment
18 where a likelihood of confusion could occur.” *Chase Brass & Copper Co. v. Special Springs, Inc.*,
19 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978).

20 Even identical or nearly identical marks have been found unlikely to cause confusion in light
21 of the different set of prospective consumers to which they cater or the minimal risk that consumers
22 would link the goods as to origin. *See, e.g., M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d
23 1378, 1381, 78 U.S.P.Q.2d 1944, 1946 (Fed. Cir. 2006) (claimed goods were destined exclusively
24 for the music/entertainment industry, and the pharmaceutical/medical industry, respectively;
25 “paramount to this case is the industry-specific focus of the parties’ claimed goods”); *Local*
26 *Trademarks, Inc. v. Handy Boys Inc.*, 16 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1990) (no likelihood of
27 confusion between LITTLE PLUMBER for liquid drain opener and LITTLE PLUMBER for
28 plumbing-related advertising services); *Autac Inc. v. Walco Sys., Inc.*, 195 U.S.P.Q. 11, 15-16

1 (T.T.A.B. 1977) (no likelihood of confusion where manufacturers who buy respondent's AUTAC
2 temperature regulators do not buy petitioner's AUTAC retractile cords except for resale).

3 Here, the goods are different, the markets are different, and the customers are different. There
4 is no likelihood of confusion.

5
6 **A. The Goods Identified In The Registrations Are Different And Unrelated.**

7 The goods identified in the TOUCHSMART registration (U.S. Registration No. 3,600,880)
8 are "personal computers, computer hardware, computer monitors, [and] computer display screens."
9 Respondent's Notice of Reliance, Ex. 1. The goods identified in the SMART TOUCH registration
10 (U.S. Registration No. 1,681,891) are "electronic proximity sensors and switching devices."
11 Petitioner's Notice of Reliance, Ex. 1. Petitioner sells electronic proximity sensors and switching
12 devices together under the SMART TOUCH mark (Washeski 65:25-66:2), just as HP sells
13 personal computers, computer hardware, computer monitors and computer display screens together
14 under the TOUCHSMART mark. Neumann 11:7-15, 68:10-19; Frankart 12:21-13:12.

15 Electronic proximity sensors and switching devices are component parts used by car
16 manufacturers and other original equipment manufacturers in manufacturing other products.
17 Washeski 11:17-20, 33:17-34:9, 36:16-37:9, 37:15-38:1 & Ex. 2, 4, 7-9, 11, 14, 16, 18, 19; *see*
18 *also id.* Ex. 3 ("Nartron has worked with Chrysler to install the Smart Touch technology in some of
19 its auto show vehicles"), Ex. 13 ("We at Nartron are committed to our role as a member of your
20 team. We welcome your use of our capabilities as we support your success"). Indeed, these goods
21 are so oriented toward future applications that they are not priced individually; instead, they are
22 priced by "application." *Id.* at 63:1-3 (cost of a single electronic proximity sensor "[d]epends on the
23 system, what they [the customer] wanted to do").

24 By contrast, the goods listed in the TOUCHSMART registration are sold as a finished product
25 to consumers and businesses for use in the home and customer-facing areas. Neumann 11:7-15,
26 37:4-13, 68:10-19 & Exs. 3, 4; Frankart 12:21-13:19, 15:23-16:11, 17:6-10, 21:1-2 & Exs. 1, 4, 6;
27 Respondent's Notice of Reliance, Ex. 42.

28 Nartron concedes the fundamental dissimilarity of the parties' respective goods when it asserts

1 that HP TOUCHSMART PCs “use embedded capacitors” and “[t]hese embedded sensors
2 (capacitors) and their associated circuits *are* the ‘electronic proximity sensors and switching
3 devices’ of Nartron’s ‘891 registration.” Petitioner’s Trial Brief 17. There is no competent
4 evidence that HP TOUCHSMART PCs actually contain electronic proximity sensors and switching
5 devices.⁸ Even if they did, this fact would establish the *dissimilarity* of the goods, not their
6 similarity. The typical consumer buying an HP TOUCHSMART personal computer has no
7 exposure to that product’s internal components, let alone the source of such internal components.
8 *See Shen Mfg. Co.*, 393 F.3d at 1244, 73 U.S.P.Q.2d at 1355-56 (“That two goods are used
9 together . . . does not, in itself, justify a finding of relatedness. . . . [T]hat finding is part of the
10 underlying factual inquiry as to whether the goods and services at issue . . . can be related in the
11 mind of the consuming public as to the origin of the goods”) (citation and internal quotation marks
12 omitted).

13 Nartron’s attempt to look beyond the goods identified in the SMART TOUCH registration to
14 “product applications” (*see* Petitioner’s Trial Brief 4-6) also fails. It is well-established that the
15 similarity of the goods must be assessed based on the registrations, not on use. *M2 Software, Inc.*,
16 450 F.3d at 1382, 78 U.S.P.Q.2d at 1947 (relatedness of the goods turns on consideration of “the
17 applicant’s goods as set forth in its application, and the opposer’s goods as set forth in its
18 registration”). The only goods identified in the SMART TOUCH registration are electronic
19 proximity sensors and switching devices. Petitioner’s Notice of Reliance, Ex. 1. Nartron does not
20 include computers—or any other finished product for end consumers—on the list of goods in the
21 SMART TOUCH registration. *Id.*

22
23 **B. The Respective Markets And Customers Do Not Overlap.**

24 It is highly unlikely that a person would encounter electronic proximity sensors and switching
25

26 ⁸The document upon which Petitioner relies, Exhibit 5 of Petitioner’s Notice of Reliance and
27 Exhibit 15 to Mr. Washeleski’s deposition, is inadmissible to the extent it is offered for the truth of
28 the matter asserted—that HP uses embedded capacitive sensors in its computers—because it is
hearsay and does not fall within any exception to the hearsay rule. *See* Section VII, *infra*.

1 devices in the same environment as personal computers because both the goods themselves and their
2 respective purchasers are so different. Typical purchasers of electronic proximity sensors and
3 switching devices are “the makers of products who then incorporate those sensors into their
4 products.” *Washeski* 57:7-9; *see also id.* at 68:14-16 (Petitioner’s customers are “other businesses
5 and manufacturers of products”). Nartron does not advertise its electronic proximity sensors and
6 switching devices on television, and any print advertising is limited to trade magazines such as
7 *Automotive News*. *Id.* at 66:25-67:7.

8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]

18 HP uses a variety to media to advertise its TOUCHSMART PCs, including television
19 commercials, online advertising, print ads in newspapers and magazines, product demos and videos,
20 and special events—all of which are oriented towards end consumers. *See Neumann* 26:13-24,
21 28:1-31:16 & Exs. 8, 9, 10, 11. Other recent partnerships include a partnership with Interscope
22 Records and the rap star Dr. Dre for a new and HP-exclusive beat audio program, and a product
23 placement deal with Project Runway, a reality television show about fashion. *Frankart* 18:23-19:8.

24 [REDACTED]
25 [REDACTED]

26 _____
27 ⁹Communication pillars” are the basic foundation for HP’s messaging frameworks—the
28 concepts HP wants to be sure are highlighted and communicated about its products. *Neumann* 25:9-12.

1 [REDACTED]
2 [REDACTED] There is no evidence that
3 Nartron's SMART TOUCH sensors and switches are advertised on these or similar websites.

4 Consumer- and home-oriented publications such as The New York Times, Computer Shopper,
5 PC Magazine, Kitchen & Bath Business, and USA Today have reviewed the HP TOUCHSMART
6 computers. *See, e.g.*, Respondent's Notice of Reliance, Exs. 43-51; Frankart 23:13-16. The nature
7 of these publications illustrates the perceived consumer-oriented market for HP TOUCHSMART
8 products, *i.e.*, families and individuals who will use HP TOUCHSMART computers in their homes.
9 *See, e.g.*, Respondent's Notice of Reliance, Ex. 47 ("While in the Kitchen, Stir the Stew and Surf the
10 Web"). There is no evidence that Nartron's proximity sensors and switching devices have been
11 reviewed in these or similar publications, and to Respondent's knowledge, they have not. Frankart
12 23:13-19.

13 The target industries for HP TOUCHSMART commercial PCs are education, health care,
14 hospitality and retail. *Id.* at 16:18-17:10; Neumann 38:10-14. The Marriott hotel, for example,
15 might use an HP TOUCHSMART computer in its lobby as an information kiosk or virtual concierge
16 for guests. Neumann 38:18-22; Frankart 15:23-16:2. Priscilla of Boston, a high-end bridal
17 boutique, puts HP TOUCHSMART computers in their customer-facing areas so that customers can
18 interact directly with the dresses and actually see models wearing them. Frankart 15:23-16:11, 17:6-
19 10 & Ex. 8 at HP 000155. HP's key competitors in this market are Apple, Dell, Acer, Sony and
20 other large computer manufacturers that sell touch-capable all-in-one personal computers. Neumann
21 44:12-16; Frankart 22:22-23:5. Nartron is not a competitor of HP. Neumann 44:19-20; Frankart
22 23:10-12.

23 No HP TOUCHSMART products are specifically targeted to the automotive industry,
24 although HP discussed a potential use for HP TOUCHSMART computers in car dealerships for
25 customers to interact with. Neumann 38:23-25; Frankart 17:11-21; *see also* Frankart 21:1-2
26 ("customer facing areas is where [the HP TOUCHSMART commercial PC] is really targeted"). HP
27 does not market or sell HP TOUCHSMART products to manufacturers for use as part of a car or as
28 component parts. Neumann 39:1-3, 39:8-40:1; Frankart 16:12-14, 17:22-24. Petitioner's

1 unauthenticated examples of HP’s “substantial product presence in the automotive industry” and
2 “HP brochures specific to the automotive industry” (Petitioner’s Trial Brief 8, 17 (citing
3 Washeleski, Exs. 20, 28)) are irrelevant for the simple reason that they do not relate to
4 TOUCHSMART products.¹⁰ [REDACTED]

5 [REDACTED]
6 [REDACTED] Petitioner has not proven otherwise. That
7 Petitioner would assert as evidence the fact that automobile makers buy computers—very
8 sophisticated and expensive ones—from HP under brand names different from TOUCHSMART,
9 reveals much about how lacking the case is in merit.

10 In *Chase Brass & Copper Co. v. Special Springs, Inc.*, 199 U.S.P.Q. 243 (T.T.A.B. 1978), the
11 Board determined that the simultaneous use of an *identical* mark for distributor springs and brass
12 rods—both sold to automotive manufacturers—would not create a likelihood of confusion, because
13 one was a finished product and the other was “a semi-finished product that would require machining
14 and/or other processing and would lose its trademark and the identity conveyed thereby by the time
15 it reached a finished state” *Id.* at 245. Under those circumstances, and even more so in this
16 case, there is very little chance that “the marks identifying the respective products of [respondent]
17 and [petitioner] would ever be encountered by the same persons in an environment where a
18 likelihood of confusion could occur.” *Id.*; see also *In re Unilever Ltd.*, 222 U.S.P.Q. 981, 983
19 (T.T.A.B. 1984) (finding no likelihood of confusion between CLAX for industrial laundry
20 detergents and CLAK for alkaline cleaner for food processing plants because the products were “not
21 competitive with each other, nor [we]re they purchased by the same people under circumstances that
22 would give rise to the mistaken belief that one source was responsible for both products”).

23 In sum, Nartron’s SMART TOUCH component parts are very different from, and unrelated to,
24 HP’s TOUCHSMART personal computers, and the division between manufacturers and end
25 consumers is stark. Under these circumstances, confusion is unlikely. The Board is “not concerned

26 _____
27 ¹⁰And, in any event, HP’s \$2 billion contract with GM (Petitioner’s Notice of Reliance,
28 Exs. 7-9) only serves to show that confusion is unlikely. When a company enters into a \$2 billion contract, one can be sure they know who they are dealing with.

1 with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations
2 but with the practicalities of the commercial world” *Autac Inc.*, 195 U.S.P.Q. at 16 (citation
3 and internal quotation marks omitted). Accordingly, this second *DuPont* factor strongly disfavors a
4 finding of likelihood of confusion.

6 III.

7 THE CIRCUMSTANCES OF PURCHASE AND THE
8 SOPHISTICATION OF THE CUSTOMERS ALSO DEMONSTRATE
9 THAT CONFUSION IS UNLIKELY.

10 Unlike the purchase of a newsstand magazine or a pack of gum, neither Nartron’s nor HP’s
11 claimed goods are purchased casually by unsophisticated buyers. Nartron’s electronic proximity
12 sensors and switching devices are typically sold to “the makers of products who then incorporate
13 those sensors into their products.” *Washeski* 57:7-9; *see also id.* at 68:14-15 (Nartron’s customers
14 are “other businesses and manufacturers of products”). This type of customer is a sophisticated
15 purchaser who is held to a higher standard of care for purposes of determining likelihood of
16 confusion. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:101 (4th
17 ed. 2009) (“*McCarthy on Trademarks*”) (“Where the relevant buyer class is composed solely of
18 professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists
19 for consumers”).¹¹

19 [REDACTED]
20 [REDACTED]
21 [REDACTED]

22 [REDACTED] [REDACTED] These discussions typically require confidentiality
23 agreements. *Id.* at 72:18-25. The sales process could take months, or even a year, and culminates in

24 _____
25 ¹¹When buyers are wholesalers or manufacturers who buy the product in order to incorporate
26 it into a consumer item, the relevant buyer class consists of the sophisticated wholesalers or
27 manufacturers, not the ultimate consumers of the finished product. *See, e.g., Cont’l Plastic*
28 *Containers v. Owens Brockway Plastic Prods., Inc.*, 141 F.3d 1073, 1080-81, 46 U.S.P.Q.2d 1277,
1282 (Fed. Cir. 1998) (holding that wholesale buyers of one gallon plastic jugs in which juice is sold
were unlikely to be confused by the trade dress of defendant’s jugs because they are sophisticated
and the sale is the result of long-term negotiations).

1 a written contract or purchase order. *Id.* at 70:20-71:3, 71:8-14.

2 [REDACTED]

3 [REDACTED]

4 [REDACTED]

5 [REDACTED]

6 [REDACTED] *see also* Frankart 22:18-21 (the HP

7 TOUCHSMART PC “is definitely a premium desktop PC at the high end of the stack”). These

8 computers are too expensive to be impulse purchases; starting prices range from \$799.99 to

9 \$1699.99, and these prices increase as customers add options such as a higher operating processor,

10 more memory, graphic cards, etc. Neumann 14:3-15:6 & Ex. 5; Frankart 8:13-23, 9:3-10, 11:3-12,

11 12:3-20 & Exs. 2, 5, 7. A consumer does not buy expensive, high-end products casually, but rather

12 only after careful consideration. 4 *McCarthy on Trademarks* §§23:96-97.

13 On the commercial side, the contact at the customer company is usually the IT manager or

14 chief technology officer, both of whom typically are sophisticated when it comes to technology and

15 computers, and who will have done research regarding HP’s and its competitors’ products.

16 Neumann 43:11-20, 44:5-9; Frankart 15:11-20. The sales process involves a dedicated sales team

17 that meets with the customer in-person in order to understand its technology needs and recommend

18 solutions. Neumann 40:5-16; Frankart 14:1-6, 14:20-22. The sales representative or team dedicated

19 to a particular customer usually has an established relationship with that customer. Neumann 40:17-

20 20; Frankart 13:23-14:6. And like the consumer PCs, the commercial HP TOUCHSMART PCs are

21 expensive. Frankart 21:25-22:3 & Ex. 5 (\$1099 for HP TOUCHSMART 9100 Business PC).

22 [REDACTED]

23 [REDACTED]

24 The sophistication of the purchasers and the high degree of care that both types of purchasers

25 would typically exercise in buying either an expensive personal computer or specialized component

26 parts for a particular product application, make confusion highly unlikely. *See Chase Brass &*

27 *Copper*, 199 U.S.P.Q. at 245 (automotive industry professionals encountering goods at issue were

28 likely “personnel highly skilled and knowledgeable in a particular phase of a manufacturing process

1 and well acquainted with various products and trademarks that they would encounter in the
2 particular field of production for which they are responsible”); *Pignons S.A. de Mecanique de*
3 *Precision v. Polaroid Corp.*, 657 F.2d 482, 489, 212 U.S.P.Q. 246, 252 (1st Cir. 1981) (no likely
4 confusion between plaintiff’s expensive (\$550-\$1,400) ALPA cameras and defendant’s less
5 expensive (\$188-\$233) ALPHA cameras: “Sophisticated consumers may be expected to exercise
6 greater care”); *Gen. Controls Co. v. HI-G, Inc.*, 212 F. Supp. 152, 158, 136 U.S.P.Q. 570, 575 (D.
7 Conn. 1962) (lack of likelihood of confusion “emphasized by the fact that most of the defendant’s
8 products are sold to manufacturers for incorporation into complicated machines”). Thus, the fourth
9 *DuPont* factor also weighs heavily against a finding of likelihood of confusion.

11 IV.

12 THE REASONABLE CHANNELS OF TRADE FOR THE PARTIES’ 13 RESPECTIVE GOODS ARE ENTIRELY DIFFERENT.

14 The absence of express limitations on channels of trade in the SMART TOUCH and
15 TOUCHSMART registrations creates the presumption that the identified goods move through all
16 *reasonable* trade channels for such goods. The *reasonable* trade channels for “electronic proximity
17 sensors and switching devices” are not comparable to the *reasonable* trade channels for “personal
18 computers, computer hardware, computer monitors, computer display screens.” *See, e.g., Cognis*
19 *Corp. v. Hana Co.*, No. 76558733, 2007 WL 683786, at *9 (T.T.A.B. Feb. 28, 2007) (not
20 precedential) (citing “fundamental dissimilarity” in trade channels and customers between finished
21 toner and ink products “obviously intended for home and office use by businesses and general
22 consumers” and synthetic lubricant products for industry consumers). This factor further supports a
23 determination that there is no likelihood of confusion.

24 [REDACTED]
25 [REDACTED]
26 [REDACTED] SMART TOUCH
27 goods are not sold at Best Buy, Target, WalMart or Office Depot. *Id.* at 71:19-25; *see also*
28 Respondent’s Notice of Reliance, Exs. 74-79. Mr. Washeleski does not know whether Nartron’s

1 SMART TOUCH goods can be purchased online or over the phone. Washeleski 71:4-7, 71:15-18.

2 HP TOUCHSMART computers, by contrast, are typically purchased in retail stores—brick-
3 and-mortar or online—or from HP’s own website. Typical retail partners include Best Buy, J&R,
4 Office Depot, Office Max, Staples and other similar retail stores. Neumann 35:11-18, 36:11-37:2 &
5 Ex. 13; Frankart 22:7-11. HP’s website provides detailed information about the HP
6 TOUCHSMART products through product-specific micro sites and HP’s general shopping site.
7 Frankart 7:25-8:12 & Exs. 1-7. The micro sites provide product images, video demos, awards and
8 reviews, while the hp.com shopping page provides specifications and technical information about
9 the product. *Id.* at 6:4-10, 7:25-8:6. From a product micro site, customers can link directly to the
10 hp.com shopping page, where they can purchase the product online. *Id.* at 8:7-12. Businesses might
11 also purchase HP TOUCHSMART PCs through negotiated agreements with HP sales
12 representatives. Neumann 40:5-16; Frankart 14:1-6, 14:20-22. Either way, there is virtually no
13 overlap between these channels and the industry-specific channels in which electronic proximity
14 sensors and switching devices typically move.

15 As a large company, HP obviously provides many goods and many services, some of which
16 may well be expected to move in the same channels of trade as electronic proximity sensors and
17 switching devices. Indeed, the 10-K report that Nartron relies on (Petitioner’s Notice of Reliance,
18 Ex. 12) lists a wide range of business units responsible for numerous products and services
19 immediately before the list of trade channels that Nartron quotes in its trial brief. The list of trade
20 channels in the Form 10-K is irrelevant where, as here, the normal trade channels *for the goods*
21 *identified in the relevant registration*—HP TOUCHSMART personal computers—are retail stores.
22 *See, e.g., In re RAM Oil, Ltd., Nos. 77280977, 77280981, 2009 TTAB LEXIS 586, at *11-*12*
23 *(T.T.A.B. Sept. 3, 2009) (not precedential) (presuming parties’ goods and services—oil and gas*
24 *exploration and production services versus fuel and filling station services—“move in all channels*
25 *of trade normal for those goods and services,” but making logical inference that “how and to whom*
26 *these goods and services are sold are likely to be different”).*

27 This third *DuPont* factor weighs against a finding of likelihood of confusion, but even if the
28 channels of trade were presumed to be identical, the respective goods are so different that confusion

1 is still unlikely.

2
3 **V.**

4 **THE MARKS THEMSELVES DIFFER IN APPEARANCE, SOUND,**
5 **CONNOTATION AND COMMERCIAL IMPRESSION.**

6 **A. The SMART TOUCH And TOUCHSMART Marks Are Dissimilar.**

7 The Board should consider the similarity of the marks with respect to appearance, sound,
8 connotation and commercial impression. *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. To begin
9 with, Nartron's SMART TOUCH mark and HP's TOUCHSMART mark differ in their appearance.
10 SMART TOUCH is a two-word mark consisting of two five-letter words; TOUCHSMART is a
11 single ten-letter word mark. While they may share the same letters, the inverse arrangement and the
12 single-word format of HP's mark renders its appearance substantially different from that of
13 Nartron's SMART TOUCH mark. *See, e.g., In re Akzona Inc.*, 219 U.S.P.Q. 94, 95-96 (T.T.A.B.
14 1983) (SILKY TOUCH and TOUCH O' SILK readily distinguishable in appearance); *In re Grow*
15 *More, Inc.*, No. 78122114, 2005 WL 2543629, at *2 (T.T.A.B. Sept. 26, 2005) (not precedential)
16 (GROW MORE and MORGRO marks look different).

17 In addition, the TOUCHSMART mark is always preceded by the HP house mark ("HP").
18 *Neumann* 8:21-9:2; *Frankart* 23:20-22; *see also, e.g., Frankart Exs. 1, 4, 6.* Use of the
19 TOUCHSMART mark without HP's house mark would violate HP's brand guidelines. *Frankart*
20 23:20-22. HP's use of its well-known house mark reduces the weight given to any similarity in the
21 marks and makes confusion even less likely. *See Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d
22 623, 634, 641, 63 U.S.P.Q.2d 1659, 1664-65, 1670 (6th Cir. 2002) (presence of well-known house
23 mark reduced the weight of the similarity of the marks for medical thermal imaging service;
24 dismissal affirmed); *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46, 55 U.S.P.Q.2d 1051,
25 1054 (2d Cir. 2000) (affirming dismissal and holding that junior user's use of its house mark
26 "significantly reduces, if not altogether eliminates, the likelihood that consumers will be confused as
27 to the source of the parties' products"); *Pristine Indus., Inc. v. Hallmark Cards, Inc.*, 753 F. Supp.
28 140, 18 U.S.P.Q.2d 1214 (S.D.N.Y. 1990) (use of defendant's own well-known house mark in

1 connection with the disputed mark is a strong factor pointing to no likely confusion).

2 The SMART TOUCH and TOUCHSMART marks also do not sound alike. The aural
3 emphasis is on the first term—“SMART”—in Nartron’s mark and on the first syllable—
4 “TOUCH”—in HP’s mark. *In re Grow More, Inc.*, 2005 WL 2543629, at *2 (“because of the
5 reversal of the terms comprising the marks, the marks [GROW MORE and MORGRO] sound
6 different”); *In re Akzona Inc.*, 219 U.S.P.Q. at 95-96 (SILKY TOUCH and TOUCH O’ SILK
7 readily distinguishable in sound).

8 The marks also diverge in their connotation and consumer impression. While in some cases a
9 transposition of terms in a mark does little to change the connotation, that is not the case here, where
10 the reverse sequence in TOUCHSMART emphasizes the term—“TOUCH”—as a verb and can be
11 understood as an imperative sentence urging the consumer to touch smartly (comparable in that
12 regard to Apple’s former slogan THINK DIFFERENT). HP’s mark thus assumes a different
13 connotation from Nartron’s adjective- and noun-focused SMART TOUCH mark. *See, e.g., Murphy,*
14 *Brill & Sahner, Inc. v. New Jersey Rubber Co.*, 102 U.S.P.Q. 420, 420 (Comm’r Pats. & Trademarks
15 1954) (recognizing adjective connotation for TOPFLITE as used in connection with shoe soles, but
16 locating no meaning for FLITE TOP as used in connection hosiery except that “it may suggest that
17 there is something different about the top of the sock or stocking”; “[t]he marks are alike only in that
18 they are reverse combinations of the same words”); *Marriott-Hot Shoppes, Inc. v. Hedwin Corp.*,
19 161 U.S.P.Q. 742, 744 (T.T.A.B. 1969) (“‘TABLE TALK’ suggests dinner conversation or the like
20 whereas ‘TALK O’ THE TABLE’ is more or less of a laudatory term . . .”); *In re Akzona Inc.*, 219
21 U.S.P.Q. at 96 (SILKY TOUCH conveys impression that products are silky to the touch; TOUCH
22 O’ SILK suggests that products contain some silk); *In re Mavest, Inc.*, 130 U.S.P.Q. 40, 41
23 (T.T.A.B. 1961) (“While ‘SQUIRETOWN’ is a substantial transposition of the registered mark
24 ‘TOWN SQUIRES,’ it is clear that these marks create distinctly different commercial impressions”);
25 *McCallum-Legaz Fish Co. v. Frozen Food Forum, Inc.*, 118 U.S.P.Q. 178, 179 (Comm’r Pats. &
26 Trademarks 1958) (FROSTY SEAS for frozen sea food products has different commercial
27 impression from SEAFROST for frozen fish: cold sea water vs. white frost crystals).

28 Moreover, the similarity or dissimilarity of the marks is not evaluated in a vacuum. In the

1 BANKAMERICA case that Nartron relies on, the Board considered the relationship of the parties’
2 services and concluded that, *given the substantial similarity of services* offered in connection with
3 the marks (as stipulated by the parties), the differences between the marks were not enough to
4 preclude a likelihood of confusion. *Bank of America Nat’l Trust & Sav. Ass’n v. The American*
5 *Nat’l Bank of St. Joseph*, 201 U.S.P.Q. 842, 845 (T.T.A.B. 1978); *see also Century 21 Real Estate*
6 *Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992)
7 (when marks are used in connection with identical goods, “the degree of similarity necessary to
8 support a conclusion of likely confusion declines”). Likewise, the strength of a mark bears on the
9 significance of the similarities and differences of another mark. *See, e.g., King Candy Co. v. Eunice*
10 *King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974) (“the public
11 easily distinguishes slight differences in the marks” where the marks are “non-arbitrary” in nature or
12 “widely used”). In this case, the disparate claimed goods and the “non-arbitrary” nature of the
13 SMART TOUCH mark amplify the dissimilarities of the marks themselves.

14
15 **B. Where, As Here, The Common Elements Consist Of Common Words Of Everyday**
16 **Usage, Even Slight Differences Are Enough To Make Confusion Unlikely.**

17 It is well-established that where the common elements in a mark consist of common words of
18 everyday usage, or where the marks are otherwise non-arbitrary in nature, even slight differences are
19 enough to render confusion unlikely. *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 1957-58
20 (T.T.A.B. 2006) (where definitions confirmed that “box”—the marks’ common element—is highly
21 suggestive, consumers likely to notice differences between the marks); *King Candy Co.*, 496 F.2d at
22 1401, 182 U.S.P.Q. at 110 (no likelihood of confusion between KING’S for candy and MISS
23 KING’s for cakes; confusion unlikely where “the marks are of such non-arbitrary nature or so
24 widely used that the public easily distinguishes slight differences in the marks under
25 consideration”); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401-02, 167
26 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (common element of marks—PEAK—was “simply a common
27 noun or adjectival word of everyday usage in the English language” with “laudatory or suggestive
28 indication”; consumers unlikely to confuse PEAK PERIOD for deodorant with PEAK for

1 dentifrice). Here, the terms “smart” and “touch” are common words of everyday usage, and their
2 combination does not constitute a distinctive mark when used in connection with Nartron’s or HP’s
3 claimed goods.

4
5 **1. “Smart” And “Touch” Are Descriptive, Particularly In The Context Of**
6 **Technology Products.**

7 The term “smart” has a specific, widely recognized meaning in the context of technology
8 products and other devices. Respondent’s Notice of Reliance, Ex. 80 (definition of “smart” from the
9 Oxford English Dictionary) ¶10(c) (“Of a device: capable of some independent and seemingly
10 intelligent action”). “In computer technology, [“smart” is] a relative term, indicating how
11 sophisticated a program or machine is and how many capabilities it has. A ‘smart missile’ is one
12 that is guided electronically, as opposed to a non-hi-tech missile; ‘smart modems’ have more
13 capabilities and can be programmed to make more decisions than earlier modems.” *Id.*, Ex. 81
14 (definition of “smart” from the Computer User Online Dictionary) at 1; *see also id.*, Ex. 82
15 (definition of “smart” from the Merriam-Webster Online Dictionary) ¶¶7(b)-(c) (operating by
16 automation <a *smart* machine tool>; INTELLIGENT). It is not surprising that numerous
17 registrations using “smart” in International Class 009 include a disclaimer of any exclusive right to
18 use that term. *See, e.g.*, Respondent’s Notice of Reliance, Exs. 22-31 (registrations), 53-67
19 (showing use).

20 The Board has specifically considered the use of the term “smart” in connection with
21 technology products and has recognized its descriptive nature in that context. *See, e.g., In re Finisar*
22 *Corp.*, 78 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 2006) (observing that, in connection with technological
23 devices, the term “smart” consistently “tells the consumer that the product is highly automated and
24 capable of computing information”), *aff’d*, 223 Fed. App’x 984 (Fed. Cir. 2007); *In re Cryomedical*
25 *Scis. Inc.*, 32 U.S.P.Q.2d 1377, 1378 (T.T.A.B. 1994) (“The ‘computer’ meaning of the term
26 ‘smart,’ as is the case with many ‘computer’ words, is making its way into the general language”);
27 *In re Nartron Corp.*, 2000 TTAB LEXIS 566, at *8-*9 (T.T.A.B. Aug. 21, 2000) (not precedential)
28 (affirming refusal to register Nartron’s SMART VOV mark, concluding that the term “smart” in

1 connection with the valves at issue “immediately describes, without conjecture or speculation, a
2 significant characteristic or feature of those goods, namely, that the variable orifice valve has some
3 type of computational or logic ability used in operating or controlling the valve”); *Nartron Corp. v.*
4 *STMicroelectronics, Inc.*, 305 F.3d 397, 404, 64 U.S.P.Q.2d 1761, 1765 (6th Cir. 2002) (affirming
5 determination that Nartron’s SMART POWER mark is generic).

6 The term “touch” is also descriptive, particularly as used in Nartron’s marketing materials.
7 *See, e.g.*, Washeleski Ex. 19 (“smart Touch . . . the world at your fingertips”; “*Connecting you with*
8 *your vehicle . . . by using intuitive gestures with the **Touch** of a finger to operate controls*”)
9 (emphasis in original). Numerous registrations using “touch” in International Class 009 include a
10 disclaimer of any exclusive right to use that term. *See, e.g.*, Respondent’s Notice of Reliance, Exs.
11 32-41 (registrations), 68-73 (showing use). Although Nartron was not required to disclaim “smart”
12 or “touch,” “[t]he absence of a disclaimer does not . . . mean that a word or phrase in a registration
13 is, or has become, distinctive in the registered mark, so that that part of the mark must be treated the
14 same as an arbitrary feature.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1059, 224 U.S.P.Q. 749, 751
15 (Fed. Cir. 1985) (“it is inappropriate to give the presence or absence of a disclaimer any legal
16 significance”).

17
18 **2. SMART TOUCH Is A Weak Mark Due To The Crowded Field Of Similar**
19 **Marks In International Class 009.**

20 There are a multitude of marks using “smart” and/or “touch” in International Class 009. *See*
21 Respondent’s Notice of Reliance, Exs. 7-31 (registrations for other marks using “smart” in
22 International Class 009), Exs. 53-67 (demonstrating actual use of such marks), Exs. 32-41
23 (registrations for other marks using “touch” in International Class 009), Exs. 68-73 (demonstrating
24 actual use of such marks). This crowded field makes SMART TOUCH a weak mark. “Where a
25 party uses a weak mark, his competitors may come closer to his mark than would be the case with a
26 strong mark without violating his rights.” *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d
27 158, 160, 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958) (no likelihood of confusion between SURE-FIT
28 and RITE-FIT despite identical slip-cover products).

1 See Petitioner’s Notice of Reliance, Ex. 16 (Respondent’s July 8, 2010 letter to Petitioner’s counsel
2 enclosing Respondent’s July 8, 2010 privilege log). Nartron never moved to compel disclosure of
3 these documents and cannot now assert that they were “concealed.”

4 Moreover, the evidence in this case conclusively demonstrates HP’s good faith in selecting the
5 TOUCHSMART mark. Ms. Neumann was personally involved in developing the TOUCHSMART
6 mark and at no time during that process was she aware of Nartron’s SMART TOUCH mark.
7 Neumann 7:7-15. Indeed, prior to this lawsuit, Ms. Neumann had never heard of Nartron
8 Corporation, SMART TOUCH, or electronic proximity sensors and switching devices. *Id.* at 44:21-
9 45:4; *see also* Petitioner’s Notice of Reliance, Ex. 17 (Respondent’s Responses to Petitioner’s First
10 Set of Requests for Admission) at No. 2 (“Respondent is not aware of any non-attorney or non-
11 paralegal knowledge by Respondent of Petitioner’s mark prior to the filing of Application No.
12 77/197/146 [sic] for TOUCHSMART”).

13 In fact, HP’s selection of TOUCHSMART was influenced in large part by its pre-existing
14 family of marks ending in “SMART.” Neumann 9:8-12. HP has used and continues to use a series
15 of other marks with the suffix “SMART.” These marks include PHOTOSMART (U.S. Registration
16 No. 2,362,503), MEDIASMART (U.S. Registration No. 3,665,225), COLORSMART (U.S.
17 Registration No. 2,057,747), and ZOOMSMART (U.S. Registration No. 2,232,611). Respondent’s
18 Notice of Reliance, Exs. 2-5, 51-52; Neumann 9:5-10:25 & Ex. 3. Most recently, HP has applied to
19 register COPYSMART (U.S. Trademark Application No. 77/826,570). Respondent’s Notice of
20 Reliance, Ex. 6. Ms. Neumann expressly considered this series of marks in selecting the
21 TOUCHSMART name; HP wanted to “continue that line of family of products to build on the
22 reputation that [it] had gained from those different product lines.” Neumann 9:3-10:25, 67:24-68:9.

23 Nartron has not introduced any evidence casting doubt on HP’s proffered reasons for selecting
24 the TOUCHSMART mark and there are certainly no documents or testimony evincing bad faith or
25 malicious intent. Tellingly, the examining attorney did not cite Nartron’s SMART TOUCH mark in
26 his examination of HP’s application for TOUCHSMART (Application Serial No. 77/197,146).
27 HP’s good faith and intent in selecting the TOUCHSMART mark, if relevant at all, weigh against
28 finding a likelihood of confusion.

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VII.

RESPONDENT’S OBJECTIONS TO PETITIONER’S EVIDENCE.

HP objects to the following items of evidence, all of which are inadmissible and should not be considered by the Board:

1. Exhibit 5 to Petitioner’s Notice of Reliance and Exhibit 15 to Mr. Washeleski’s deposition are inadmissible to the extent they are offered for the truth of the matter asserted—that HP uses embedded capacitive sensors in its computers—because they are hearsay and do not fall within any exception to the hearsay rule. Fed. R. Evid. 801, 802.
2. Exhibit 7 to Petitioner’s Notice of Reliance and Exhibit 23 to Mr. Washeleski’s deposition are inadmissible to the extent they are offered for the truth of the matter asserted—that HP entered into a \$2 billion contract with GM—because they are hearsay and do not fall within any exception to the hearsay rule. Fed. R. Evid. 801, 802.
3. Exhibit 8 to Petitioner’s Notice of Reliance and Exhibit 24 to Mr. Washeleski’s deposition are inadmissible because they were not properly authenticated and therefore lack foundation. Fed. R. Evid. 901.
4. Exhibit 9 to Petitioner’s Notice of Reliance and Exhibit 25 to Mr. Washeleski’s deposition are inadmissible because they were not properly authenticated and therefore lack foundation. Fed. R. Evid. 901.
5. Exhibit 10 to Petitioner’s Notice of Reliance and Exhibit 28 to Mr. Washeleski’s deposition are inadmissible because they were not properly authenticated and therefore lack foundation. Fed. R. Evid. 901.
6. Exhibit 11 to Petitioner’s Notice of Reliance and Exhibit 20 to Mr. Washeleski’s deposition are inadmissible because they were not properly authenticated and therefore lack foundation. Fed. R. Evid. 901.
7. Exhibit 12 to Petitioner’s Notice of Reliance and Exhibit 21 to Mr. Washeleski’s deposition are inadmissible because they were not properly authenticated and therefore lack foundation. Fed. R. Evid. 901.
8. Exhibit 26 to Mr. Washeleski’s deposition is inadmissible because it was not properly

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authenticated and therefore lacks foundation. Fed. R. Evid. 901.

9. Exhibit 27 to Mr. Washeleski’s deposition is inadmissible because it was not properly authenticated and therefore lacks foundation. Fed. R. Evid. 901.

10. Exhibits 2-5 to Petitioner’s Rebuttal Notice of Reliance are inadmissible because they are offered in support of Petitioner’s “objections” to certain Internet evidence Respondent submitted (Exhibits 42, 53, 54, 60, 72 to Respondent’s Notice of Reliance). See Petitioner’s Rebuttal Notice of Reliance ¶¶2-5. Each of these “objections” pertains to alleged defects that could have been cured. If a defect can be cured, the objection must be made promptly. See, e.g., *Manpower, Inc. v. Manpower Info. Inc.*, 190 U.S.P.Q. 18, 21 (T.T.A.B. 1976) (objection that notice of reliance failed to indicate relevance of materials was curable and should have been raised when notice was filed). Petitioner’s Rebuttal Notice of Reliance, which was filed on January 20, 2011, nearly two months after Respondent filed its Notice of Reliance on November 22, 2010, cannot be said to have been promptly filed. Accordingly, the Board should disregard these untimely and improper objections.

However, even if the Board were to consider the entirety of the evidence upon which Petitioner relies and disregard Exhibits 6, 42, 53, 54, 60 and 72 to Respondent’s Notice of Reliance (as improperly requested in Petitioner’s Rebuttal Notice of Reliance), HP would still prevail. The remaining evidence is more than sufficient to demonstrate that confusion is unlikely.

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CONCLUSION

Because all of the relevant factors weigh strongly against confusion, the Board should find that there is no likelihood of confusion between SMART TOUCH and TOUCHSMART as applied to the goods in the parties' respective registrations.

DATED: April 20, 2011.

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