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

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

In the matter of Application Serial No. 76/304,063
For the Mark HEXAWAVE
Published in the Official Gazette on May 18, 2003

Bose Corporation,

Opposer,

v.

Hexawave, Inc.,

Applicant.

Opposition No. 91157315

BRIEF FOR OPPOSER

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STATEMENT OF THE FACTS

On July 17, 2003, Opposer Bose Corporation (“Bose”) filed a Notice of Opposition against Application Serial No. 76/304,063 filed August 24, 2001 filed by Applicant, Hexawave, Inc. (“Hexawave”) seeking registration of HEXAWAVE for “compound semi-conductor devices consisting of an integrated circuit; microwave monolithic integrated circuit; modules, namely power modules for wireless communication; transistor; tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; [and] antennas.” Bose alleges prior use and registration of the marks WAVE and ACOUSTIC WAVE on one or more of radios, clock radios, portable radio and cassette recorder combinations, compact stereo systems, loudspeaker systems, sound reproduction systems, namely, a loudspeaker system comprising a power amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player. The Board instituted this proceeding on August 12, 2003.

Discovery in this proceeding opened on September 1, 2003. Bose served interrogatories and documents requests to Applicant on September 8, 2003. Applicant produced non-confidential documents and provided partial responses to Bose on November 18, 2003. Applicant also provided supplemental written interrogatory responses to Bose on May 18, 2003. Applicant served its own discovery to Bose, to which Bose provided written responses, supplemental responses and documents. A stipulated protective order was filed with the Board on or about May 18, 2003. Based on the information obtained from Applicant during discovery, including Applicant’s written responses and documents, Bose filed a Motion for Leave to Amend its Notice of Opposition to add a claim that Applicant’s application is void for fraud. On May 28, 2004, Bose filed a First Amended Notice of Opposition against the above identified

application alleging fraud in the procurement of Applicant's registration on the basis that the verified Declaration of Use signed by the President of Hexawave, submitted with the application for HEXAWAVE, contained knowing false material representations of fact.

Bose is the owner of the following incontestable registrations: Registration No. 1,338,571 of ACOUSTIC WAVE for loudspeaker systems; and Registration No. 1,764,183 of ACOUSTIC WAVE for loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player (JM28-29; BX32A-B),¹ and Registration No. 1,633,789 of WAVE for radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players (JM48; BX63).

On May 21, 2004, Bose took testimony through John F. Mar with Exhibits BX1-65B deemed to have been offered into evidence within the provisions of 37 C.F.R. § 2.123(c)(2).

Mr. Mar, who received a degree in Mechanical Engineering from Worcester Polytechnic Institute and a Master's of Business Administration from Boston University, was employed as a Product Manager in the Consumer Direct division at Bose Corporation. JM8. In that capacity, Mr. Mar was responsible for the product development of the ACOUSTIC WAVE music system. JM8.

Mr. Mar testified that he is familiar with the Bose ACOUSTIC WAVE music system. Mr. Mar identified the ACOUSTIC WAVE music system as a "self contained one-piece music system, [that] includes a radio, a CD player, tuners amplifiers, [and] speakers" that was "originally introduced in 1984." JM9.

Mr. Mar identified a series of press releases for the ACOUSTIC WAVE music system. JM9-10; BX2-3. Mr. Mar testified that that the estimated sales of the ACOUSTIC WAVE music

¹ We refer to John F. Mar testimony on behalf of Bose as JM. We refer to Bose exhibits by BX.

system since inception exceeds 500,000 units, and that the estimated sales revenue from the ACOUSTIC WAVE music system since inception exceeds \$600 million. JM10-11.

Mr. Mar testified that the ACOUSTIC WAVE music system is targeted to “just about anybody.” JM11. Furthermore, Mr. Mar testified that the ACOUSTIC WAVE music system can be purchased directly from Bose through direct marketing, Bose-owned retail stores, and via the Internet. JM11. Mr. Mar identified various representative samples of direct print and mail advertisements for the ACOUSTIC WAVE music system over the years. JM12-15, 19; BX4A-F, 5A-F, 6, 7, 8A-B, 9, 10, 17A-B. Mr. Mar further identified representative advertisements for the ACOUSTIC WAVE music system that appeared over the years in various national magazines such as Newsweek, Time, Forbes (JM16, BX11), USA Weekend Magazine (JM19, BX 19), Parade Magazine (JM20, BX 19)) and newspapers such as the Wall Street Journal, New York Times and The Boston Globe (JM16-17, BX12-16), as well as representative pages from the Bose website featuring the WAVE and ACOUSTIC WAVE products. JM19, BX18.

Mr. Mar testified that Bose held several press conferences when it introduced the ACOUSTIC WAVE music system in 1984, and held subsequent press conferences to introduce successive generations of the ACOUSTIC WAVE music system in the late 1980s/early 1990s. JM20-21. Mr. Mar further testified that the ACOUSTIC WAVE music system has received a significant amount of press coverage over the years, including in such publications as the Metrowest Business Review, Chicago Tribune, Bay State Business World, Boston Herald, The Consumer Electronics Show Daily, Sound & Vision, Stereo Guide, High Fidelity, Popular Science, The Atlantic Magazine, and Chicago Magazine, during the 1980s. JM21-26; BX20-29. Mr. Mar further identified a series of representative press articles featuring the ACOUSTIC WAVE music system in such publications as the Philadelphia Inquirer, Honolulu Advertiser,

Jazz Times, Oregonian, Chicago Tribune, Atlanta Journal, Boston Globe, Dallas Morning News, and Newsday, during the 1990s. JM26; BX30A-E. In addition, Mr. Mar testified that Bose has advertised its ACOUSTIC WAVE music system on radio and television. JM27-28.

Mr. Mar also identified a program for the Inventor of the Year Award in 1987, naming Drs. Bose and Short as recipients for the acoustic waveguide loudspeaker invention embodied in the Bose ACOUSTIC WAVE music system and WAVE radio. JM28; BX31.

Mr. Mar identified Certificates of Registration Nos. 1,338,571 and 1,764,183 of the ACOUSTIC WAVE mark and identified the goods identified in these registrations as "loudspeaker systems" and "loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player", respectively. JM28-29; BX32A-B.

Mr. Mar testified that he is familiar with the Bose WAVE radio which was introduced in 1993, and the Bose WAVE radio/CD which, according to Mr. Mar, first went on sale in late 1998 or early 1999. Mr. Mar testified that, since inception, the estimated units sold of the Bose WAVE radio/CD exceeds three (3) million units, and the estimated sales revenues associated with the Bose WAVE radio/CD exceeds \$1 billion dollars. JM30. Mr. Mar testified that the WAVE radio is marketed to a very broad market, specifically, "anybody who likes music." JM30.

Mr. Mar identified press releases from Bose announcing the WAVE radio (JM31; BX33-34), and testified that the Bose WAVE radio and radio/CD products are sold, marketed and advertised in the same channels as Bose's ACOUSTIC WAVE music systems, namely, they can be purchased directly from Bose and Bose owned retail stores, and they are advertised through print advertising, on the Internet, and on television. JM31-32. Mr. Mar identified several

representative print advertisements for the WAVE radio and WAVE radio/CD that have appeared in such national publications as Newsweek, Time, Wall Street Journal, New York Times and the Boston Globe. JM32-38; BX36A-F, 38A-G, 40, 44, 45A-C. Mr. Mar also identified several pages from representative direct mail packages for the WAVE radio and WAVE radio/CD (JM33 -38; BX35, 37, 39, 43, 46A-B), as well as brochures for the WAVE radio, one of which contained customer testimonials, about the WAVE radio. JM36; BX 41, 42. Mr. Mar also identified WAVE radio and WAVE radio/CD advertisements from the Bose website. JM 38-39; BX 47A-B.

Mr. Mar identified print advertisements for the Bose ACOUSTIC WAVE music system and WAVE radio in Skymall Magazine (JM39; BX48) and in Delta Airlines' magazine in 1994 (JM39; BX49). Mr. Mar also further identified the USAir 'Giftfolio' which featured the Bose WAVE radio on the cover, and an advertisement for the Bose WAVE radio inside the magazine (JM40; BX50), representative advertisements for the Bose WAVE radio and the ACOUSTIC WAVE music system in Frontgate, the Brookstone Collection, and the Mercedes-Benz Collection catalog from 1998 (JM40-41; BX51A-C), and representative advertisements for the Bose WAVE radio/CD in Parade Magazine from 2003 (JM41-42; BX52A-C).

Mr. Mar identified several radio advertisements for the WAVE radio, including a transcript from a show that aired on a New York radio station, WBEN in 1999 (JM42; BX53), a transcript from the 'Car Talk' radio show that aired on National Public Radio in 2000 in which the Bose WAVE radio was discussed (JM43; BX54), and a transcript from Joan Hamburg's New York radio show in 2001 in which she mentioned the Bose WAVE radio (JM44; BX55).

Mr. Mar testified that there was a "flurry" of press and media activity following Bose press events for the Bose WAVE radio and Bose WAVE radio/CD. In this regard, Mr. Mar

identified a press article in Popular Science Magazine in 1993 that introduced the Bose WAVE radio to the world. JM44; BX56. He further identified several press articles featuring the WAVE radio and Bose WAVE radio/CD in the San Francisco Chronicle (JM45; BX57, 58B), Chicago Tribune (JM45; BX58A), Better Homes & Gardens Home Products Guide from 1999 (JM46; BX59), Audio Video Interiors Magazine from 1999 (JM46; BX60), Where Boston Magazine from 2000 (JM47; BX61), and Los Angeles Times Magazine from 2002 (JM47; BX62).

Mr. Mar testified that a conservative estimate of Bose's total expenses in connection with the marketing, advertising and promotion of the ACOUSTIC WAVE music system, the WAVE radio and WAVE radio/CD products is in excess of \$350 million. JM47-48.

Mr. Mar identified the Certificate of Registration No. 1,633,789 of the WAVE mark and identified the goods covered by the registration as "television receivers, videocassette players, camcorders, radios, clock radios, audio tape recorders and players, portable radios and cassette recorder combinations, compact stereo systems, and portable compact disc players." JM48-49; BX63.

On May 28, 2004, Bose submitted Opposer's Notice of Reliance Pursuant to Rule 2.122 (d)(2).

On or about June 17, 2004, Applicant filed a Response to the Bose Motion to Amend its Notice of Opposition.

On June 23, 2004, Applicant filed a Motion for Leave to File Amended Answer to add Counterclaim, and an Amended Answer and Counterclaim.

On July 15, 2004, Bose filed its Opposition to Motion for Leave to Amend Answer to Add Counterclaim.

On July 27, 2004, Applicant filed Applicant's Notice of Reliance Pursuant to Rule 2.122(d)(2).

On January 8, 2005, the Board issued an order granting both the Bose Motion to Amend Notice of Opposition and Applicant's Motion to File Amended Answer to Add Counterclaim.

On January 28, 2005, Applicant filed its Answer to Amended Notice of Opposition and Counterclaim.

On February 28, 2005, Bose filed a Motion to Dismiss Applicant's Counterclaim for Failure to State a Claim Upon Which Relieve Could be Granted, and Applicant filed its response to this motion on March 18, 2005.

On October 13, 2005, the Board issued an order denying the Bose Motion to Dismiss the Counterclaim, and resetting the trial dates.

On November 14, 2005, Bose filed its Answer to the Counterclaim.

On January 26, 2006 Bose took the testimonial deposition of Bose employee Mark Sullivan.

On March 29, 2006, Applicant took the testimonial depositions of Bose employees Mark Sullivan and Carol Fritz.

ARGUMENT

- I. **“HEXAWAVE” WITHOUT CHANNEL OR PURCHASER RESTRICTIONS FOR COMPOUND SEMI-CONDUCTOR DEVICES CONSISTING OF AN INTEGRATED CIRCUIT; MICROWAVE MONOLITHIC INTEGRATED CIRCUIT; MODULES, NAMELY POWER MODULES FOR WIRELESS COMMUNICATION; TRANSISTOR; TUNER; MIXER; AMPLIFIER; DOWNCONVERTER; TRANSCEIVER; TRANSMITTER; RECEIVER; DETECTORS, NAMELY RADIO FREQUENCY DETECTORS; RADIO FREQUENCY SWITCH; ANTENNA IS SUFFICIENTLY SIMILAR IN APPEARANCE, CONNOTATION, AND SOUND TO THE FAMOUS “WAVE” AND “ACOUSTIC WAVE” MARKS PREVIOUSLY USED AND REGISTERED BY BOSE WITHOUT CHANNEL OR PURCHASER RESTRICTIONS FOR RADIOS, CLOCK RADIOS, AUDIO TAPE RECORDERS AND PLAYERS, PORTABLE RADIO AND CASSETTE RECORDER COMBINATIONS, COMPACT STEREO SYSTEMS AND PORTABLE COMPACT DISC PLAYERS; LOUDSPEAKER SYSTEMS; MUSIC SYSTEMS CONSISTING OF A LOUDSPEAKER SYSTEM AND AMPLIFIER AND AT LEAST ONE OF A RADIO TUNER, COMPACT DISC PLAYER AND AUDIO TAPE CASSETTE PLAYER; AND LOUDSPEAKER SYSTEMS, THAT CONFUSION, DECEPTION, OR MISTAKE IS LIKELY**

Likelihood of confusion is evaluated by examining various factors set forth in *In re E.I.*

DuPont de Nemours & Co., 177 USPQ 563 (CCPA 1973). Examination of each of the DuPont factors is not necessary to a determination of likelihood of confusion; different factors may play a dominant role in determining likelihood of confusion depending on the evidence of each case.

Bose Corporation v. QSC Audio Products, Inc., 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (citing *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)).

In this proceeding, the factors that are most significant are the similarity of the marks, the fame of the Bose WAVE and ACOUSTIC WAVE marks, the relatedness of the products, and similarity of channels of trade and potential purchasers.

A. **THE BOSE “WAVE” AND “ACOUSTIC WAVE” MARKS ARE FAMOUS AND THEREFORE ENTITLED TO A WIDE SCOPE OF PROTECTION**

The fame of the Bose WAVE and ACOUSTIC WAVE marks weighs heavily towards a finding of likelihood of confusion. It is well settled that fame of an opposer’s mark, if it exists,

plays a “dominant role in the process of balancing the DuPont factors,” *Recot, Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (citations omitted), and “famous marks thus enjoy a wide latitude of legal protection.” *Id.* This is understandable, where famous marks are more likely to be remembered and associated in the public mind than weaker marks, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 22 USPQ at 1456. A famous mark is one “with extensive public recognition and renown.” *Bose v. QSC* 63 USPQ2d at 1305 (citations omitted).

There is overwhelming evidence of the fame of the ACOUSTIC WAVE and WAVE marks. First of all, the Federal Circuit has determined Bose’s WAVE and ACOUSTIC WAVE marks to be famous. *Id.* at 1309. The Federal Circuit considered evidence of considerable sales, advertising presence, and promotional expenditures of the Bose WAVE and ACOUSTIC WAVE products, and concluded:

When the full record is considered, only one conclusion can be reached regarding the fame of the Bose product marks; they are famous and thus entitled to broad protection.

Id.

The same and more substantial and compelling evidence of the fame of the WAVE and ACOUSTIC WAVE marks which the Federal Circuit considered in determining the fame of the WAVE and ACOUSTIC WAVE marks in the *Bose v. QSC* case has been put in the record in this case. *Id.*

The ACOUSTIC WAVE mark has been used by Bose for 22 years and in excess of 550,000 ACOUSTIC WAVE units have been sold generating in excess of \$600 million in revenue. JM10-11. The ACOUSTIC WAVE products have been advertised in many national

publications, such as Newsweek, Time, Forbes, Parade Magazine, the Wall Street Journal, New York Times and The Boston Globe, as well as through direct mail, on Bose's website, and on radio and television. JM11-19. There has been significant press coverage of the ACOUSTIC WAVE products, including in the Chicago Tribune, Boston Herald, Sound & Vision, Stereo Guide, Popular Science, The Atlantic, Boston Globe, and Newsday. JM21-28; BX20-30E. Drs. Bose and Short received the Inventor of the Year Award for the waveguide speaker technology embodied in the ACOUSTIC WAVE music system and the WAVE radio. JM28; BX31.

The WAVE mark has been used by Bose for 12 years and in excess of three (3) million WAVE units have been sold generating in excess of \$1 billion in revenue. JM30. The WAVE products have been advertised on television, by direct mail, through catalogs, via the Internet, and in such publications as Newsweek, Time, Wall Street Journal, New York Times, Boston Globe, Skymall, Delta Airlines and US Air magazines, in the Brookstone Collection and Mercedes-Benz Collection catalogs. JM32-42; BX35, 36A-F, 37, 38A-G, 39, 40, 43, 44, 45A-C, 46A-B, 47A-B, 48, 49, 50, 51A-C, 52A-C. The WAVE mark has also been advertised and mentioned on various radio shows. JM42-44, BX53-55. There has been significant press coverage of the WAVE products, including in the San Francisco Chronicle, The Chicago Tribune, Better Homes & Gardens, Boston Magazine, and the Los Angeles Times Magazine. JM45-47; BX57-62.

Bose has spent in excess of \$350 million in connection with the advertising of the Bose ACOUSTIC WAVE and WAVE products. JM48.

Such compelling evidence as set forth above, leads inexorably to the same conclusion made by the Federal Circuit in *Bose v. QSC*, namely, that the ACOUSTIC WAVE and WAVE

marks are famous, and as such are entitled to a wide scope of protection. *See Bose v. QSC*, 64 USPQ2d at 1305.

B. “HEXAWAVE” IS CONFUSINGLY SIMILAR TO THE FAMOUS BOSE “WAVE” AND “ACOUSTIC WAVE” MARKS

Since Bose has priority in its use of its registered trademarks WAVE and ACOUSTIC WAVE, *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974); *Flow Technology, Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991), the determinative issue in this case is whether the HEXAWAVE mark and the WAVE and ACOUSTIC WAVE marks are sufficiently similar in appearance, sound, or connotation that confusion, deception, or mistake is likely. *General Foods Corp. v. General Mills, Inc.*, 167 USPQ 638 (TTAB 1970) (ARISE confusingly similar to AWAKE.) In *General Foods*, only the first letter was identical. *See id.* Here, Hexawave’s HEXAWAVE mark incorporates the entirety of the incontestably registered, famous Bose WAVE mark, and the salient portion of the incontestably registered, famous Bose ACOUSTIC WAVE mark, and simply adds to it the prefix “HEXA.”

It is well-established that:

[a] subsequent user may not appropriate another’s entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it.

In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984). The dominant and distinctive component of Hexawave’s HEXAWAVE mark is the “WAVE”. At the very least, the fact that the Hexawave mark embodies the entire famous Bose WAVE mark and simply adds the prefix “HEXA-”, means that consumers are likely to be mistaken or deceived into believing Hexawave’s HEXAWAVE products are affiliated in some way with Bose. *See Earth Technology Corp. v. Environmental Research and Technology, Inc.*, 222 USPQ 585 (C.D. Cal. 1983)(ERTEC

confusingly similar to ERT); *see also*, *Glamorene Prod. Corp. v. Proctor & Gamble Co.*, 190 USPQ 543 (CCPA 1976)(BOUNCE BACK confusingly similar to BOUNCE.)

In fact,

[t]he Board itself, other courts and this court have been confronted frequently with situations similar to this one, in which a competing mark shares a core portion of a senior marks, and in which the competing mark was found too similar to the other mark to earn mark status for itself. *See McCarthy*, § 23.29. Typical of the marks found similar in sound and connotation are AQUA-CARE and WATER-CARE, BEER NUTS and BREW NUTS, BLUE SHIELD and RED SHIELD, GENTLE TOUCH and KIND TOUCH, MANPOWER and WOMANPOWER, DOWNTOWNER and UPTOWNER, WEED EATER and LEAF EATER, THERMO KING and ZERO KING.

Id. Recently, in *Bose v. QSC*, 63 USPQ2d 1305, the Federal Circuit held that applicant's POWERWAVE mark and Bose's WAVE and ACOUSTIC WAVE marks were confusingly similar.

In addition,

[i]t is not necessary for similarity to go only to the eye or ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or ear.

Standard Oil Co. v. Standard Oil Co., 116 USPQ 176, 182 (10th Cir. 1958) (footnotes omitted).

In this case, HEXAWAVE, WAVE, and ACOUSTIC WAVE all stimulate the same mental reaction and have the same commercial impression – that of WAVE products from the same source, namely, Bose. *A fortiori*, where there is identity of appearance, sound, and connotation of the primary WAVE portions of Applicant's mark and the Bose incontestably registered, famous trademarks WAVE and ACOUSTIC WAVE, there is likelihood of confusion.

C. THE PRODUCTS IDENTIFIED IN THE “HEXAWAVE” APPLICATION ARE CLOSELY RELATED TO THE BOSE “WAVE” AND “ACOUSTIC WAVE” PRODUCTS SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, DECEIVED, OR MISTAKEN IN BELIEVING THAT THE “HEXAWAVE” PRODUCTS ARE AFFILIATED WITH BOSE

Consumer confusion is likely because the goods identified in the HEXAWAVE application are highly similar to the goods identified in the incontestable WAVE and ACOUSTIC WAVE registrations.

The 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, regardless of what the record may reveal as to the particular nature of applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of the goods are directed.

Octocom Systems, Inc. v. Houston Computer Services, Inc., 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also*, *Squirtco v. Tomy Corp.*, 216 USPQ 937, 940 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 209 USPQ 986, 988 (CCPA 1981).

The goods identified in the Bose WAVE and ACOUSTIC WAVE registrations are types of sound reproducing apparatus: Registration No. 1,338,571 of ACOUSTIC WAVE for loudspeaker systems; Registration No. 1,764,183 of ACOUSTIC WAVE for loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player; and Registration No. 1,633,789 of WAVE for radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players. BX32A-B, 63.

The goods identified in the HEXAWAVE application are:

“compound semi-conductor devices consisting of an integrated circuit; microwave monolithic integrated circuit; modules, namely power modules for wireless communication; transistor; tuner; mixer; amplifier; downconverter; transceiver;

transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna.”

The HEXAWAVE goods identified in the application are highly similar to, and in some cases directly overlap, with the goods identified in the Bose WAVE and ACOUSTIC WAVE registrations. First of all, Applicant identifies “tuner” and “amplifier” goods in its application. Bose’s Registration No. 1,764,183 for the mark ACOUSTIC WAVE also includes a “radio tuner” and “amplifier.” In addition, Applicant’s application identified other sound reproducing goods that are highly similar to the goods used and registered by Bose under its WAVE and ACOUSTIC WAVE marks, such as a “transistor”; a “mixer”; a “downconverter”; a “transceiver”; a “transmitter”; a “receiver”; “detectors, namely radio frequency detectors”; a “radio frequency switch”; and an “antenna.” The Board has in the past found a component part of a product to be a related good of the product for purposes of likelihood of confusion, because the public is likely to believe that the component originates with, or is associated with or sponsored by the source of the product. *See In re Belanger, Inc.*, 218 USPQ 742, 743 (TTAB 1983) (finding applicant’s components of machine tools and registrant’s machine tools to be “closely related”); *In re Autometric, Inc.*, 1997 TTAB LEXIS 68 (finding “a close relationship” between applicant’s stereoscope components and registrant’s stereoscopes); *In re Jeep Corp.*, 222 USPQ 333, 337 (TTAB 1984) (finding a “close relationship” between applicant’s land vehicles and structural parts and registrant’s pneumatic tires for land vehicles).

In view of the foregoing, the similarity of the goods weighs in favor of a finding of likelihood of confusion.

D. THE CHANNELS OF TRADE AND CLASSES OF PURCHASERS FOR THE “HEXAWAVE” PRODUCTS AND THE “WAVE” AND “ACOUSTIC WAVE” PRODUCTS ARE UNRESTRICTED

The channels of trade and classes of purchasers for the HEXAWAVE and Bose WAVE, and ACOUSTIC WAVE products are the same, and it is well settled that

[r]egistrability must be determined on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales are directed.

Bose v QSC, 64 USPQ2d at 1310-1311 (citing *Octocom Sys., Inc. v. Houston Computer Serv., Inc.*, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also, *Squirtco v. Tomy Corp.*, 216 USPQ 937, 940 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 209 USPQ 986, 988 (CCPA 1981); *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 196 USPQ 1, 2 (CCPA 1977); *Broderick & Bascom Rope Co. v. Goodyear Tire & Rubber Co.*, 189 USPQ 412, 413 (CCPA 1976); *Penwalt Corp. v. Center Laboratories, Inc.*, 187 USPQ 599, 601 (CCPA 1975). “Where likelihood of confusion is asserted by an opposer with respect to a trademark for which an application for registration has been filed, the issue must be resolved on the basis of not only a comparison of the involved marks, but also on consideration of the goods named in the application and in opposer’s registration and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution.” *CBS, Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983); citing *Squirtco v. Tomy Corp.*, 216 USPQ 937, 940 (Fed. Cir. 1983)..

There are no limitations on the channels of trade or purchasers in the HEXAWAVE application or in the WAVE and ACOUSTIC WAVE registrations, therefore, likelihood of confusion is evaluated relative to all channels of trade and all classes of purchasers for the identified goods. See *In re Melville Corp.*, 18 USPQ2d 1387, 1388 (TTAB 1991); *Kangol Ltd. v.*

KangaROOS U.S.A. Inc., 23 USPQ2d 1945 (Fed. Cir. 1992); *Canadian Imperial Bank v. Wells Fargo Bank*, 1 USPQ2d at 1815; *CBS, Inc. v. Morrow*, 218 USPQ 198; *Glamorene Products Corp. v. Procter & Gamble Co.*, 190 USPQ 543.

Where the Applicant's goods either directly overlap or at the very least are highly related to the Bose WAVE and ACOUSTIC WAVE goods, and where there are no limitations on the channels of trade or classes of purchasers in either the HEXAWAVE application or the WAVE and ACOUSTIC WAVE registrations, the channels of trade and classes of potential purchasers are considered to be the same, and there is likelihood of confusion, deception, or mistake.

II. DOUBTS AS TO LIKELIHOOD OF CONFUSION ARE RESOLVED AGAINST THE NEWCOMER

While there is no doubt as to likelihood of confusion between HEXAWAVE and WAVE, or ACOUSTIC WAVE, doubts as to likelihood of confusion are resolved against the newcomer. "It is well settled that one who adopts a mark similar to another for closely related goods acts at his peril and any doubt there might be must be resolved against him." *Carlisle Chem. Works, Inc. v. Hardmann & Holden, Inc.*, 168 USPQ 110, 112 (CCPA 1970); *J&J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Kimberley-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 543 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 USPQ 1281, 1284 (Fed. Cir. 1984). The fame of the Bose WAVE and ACOUSTIC WAVE marks also necessitates that any doubt should be resolved in favor of Bose and against Hexawave.

There is no excuse for even approaching the well-known trademark of a competitor...and that all doubt as to whether confusion, mistake, or deception is likely to be resolved against the newcomer, especially where the established mark is one which is famous.

Kenner Parker, 22 USPQ2d 1453, 1456 (citing *Nina Ricci, S.A.R.L. v. ETF Enterprises, Inc.*, 12 USPQ 1901, 1903 (Fed. Cir. 1989), quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 134 USPQ 504, 508 (CCPA 1962)). Here, if there be any doubt regarding the newcomer Hexawave, it must be resolved against Hexawave when measured against the rights of senior user Bose, the owner of the famous incontestably registered marks WAVE and ACOUSTIC WAVE.

III. APPLICATION SERIAL NO. 76/304,063 OF “HEXAWAVE” SHOULD BE REFUSED REGISTRATION BECAUSE APPLICANT HEXAWAVE SUBMITTED A FRAUDULENT DECLARATION OF USE WITH THE APPLICATION THAT FALSELY AVERRED THAT THE MARK HAD BEEN USED ON ALL OF THE GOODS LISTED IN THE APPLICATION, WHEN IT WAS NOT IN USE ON ALL OF THE GOODS

Applicant committed fraud on the Patent and Trademark Office by submitting a Declaration of Use in the application averring that the HEXAWAVE mark was being used and had been used in the United States at the time it filed its application on August 24, 2001 on or in connection with all of the goods recited in the application, namely, “compound semi-conductor devices consisting of an integrated circuit; microwave monolithic integrated circuit; modules, namely power modules for wireless communication; transistor; tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna” when in fact the mark had not been used (and is not being used) for any of a “tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna.”

Fraud is committed when a trademark applicant procures or attempts to maintain a registration based on a statement that is (1) false; (2) a material representation; and (3) made knowingly. *See Torres v. Cantine Torresella S.r.l.*, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986);

Medinol Ltd. v. Neuro Vaxx, Inc., 67 USPQ2d 1205, 1209 (TTAB 2003); *Mister Leonard, Inc. v. Jacques Leonard Couture, Inc.*, 23 USPQ2d 1064, 1065 (TTAB 1992).

The obligation which the Lanham Act imposes on an applicant is that he will not make *knowingly* inaccurate or *knowing* misleading statements in the verified declaration forming a part of the application for registration.

Torres, 1 USPQ2d at 1484, *quoting Bart Schwartz International Textiles, Ltd. v. Federal Trade Commission*, 129 USPQ 258, 260 (CCPA 1961) (emphasis in original). This obligation of veracity is further supported by Section 14(3) of the Lanham Act which permits cancellation of a registration at any time if the registration of the mark was obtained fraudulently. 15 USC §1064(c). It is widely accepted that fraud in obtaining a trademark registration occurs ‘when an applicant knowingly makes false, material representations of fact in connection with his application.’” *Torres v. Cantine*, 1 USPQ2d at 1484. When a registration is based upon a fraudulent statement, the registration is void in its entirety. *See, e.g., Medinol*, 67 USPQ2d at 1208 (registration cancelled because respondent submitted a verified statement falsely asserting that the mark was in use on all of the goods identified in the notice of allowance, when respondent knew or should have known that the mark was not in use on all of the identified goods); *Torres*, 1 USPQ2d at 1485 (registration cancelled because respondent filed a declaration falsely verifying the mark was in use as part of the renewal application).

In this case, Applicant submitted a verified Declaration of Use in the application asserting that the HEXAWAVE mark was being used in commerce in connection with “compound semiconductor devices consisting of an integrated circuit; microwave monolithic integrated circuit; modules, namely power modules for wireless communication; transistor; tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna,” as of the filing date of the application. In fact, Applicant was

not using the mark in connection with these goods, as conceded in its verified answers to Bose's Interrogatories and Requests for Documents, where not one of a "tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna" were identified in response to an interrogatory asking Applicant to identify all goods and services upon which the mark was used or was intended for use.

Bose Interrogatory No. 5 asked Applicant to "[i]dentify and provide a detailed description of every product manufactured, licensed for manufacture, or sold by or on behalf of Applicant since the inception of Applicant's business that bears Applicant's Mark, and/or the Applicant, or a person on behalf of Applicant, intends to manufacture, license for manufacture or sell that bears Applicant's Mark." OPPOSER'S NOTICE OF RELIANCE, Opposer's First Set of Interrogatories to Applicant, Interrog. No. 5. Applicant's verified response to this interrogatory (apart from boilerplate objections which would not have excused the failure to identify the short list of goods covered by the application), identified only the following goods: "GaAs Power Field Effect Transistors and MMIC Switch Devices", accompanied by a list of alphanumeric product numbers for these products. OPPOSER'S NOTICE OF RELIANCE, Applicant's Supplemental Answers to Opposer's First Set of Interrogatories, Response to Interrog. No. 5. As only "GaAs Power Field Effect Transistors and MMIC Switch Devices" were verified by Applicant as being "every product manufactured, licensed for manufacture, or sold by or on behalf of Applicant since the inception of Applicant's business that bears Applicant's Mark, and/or the Applicant, or a person on behalf of Applicant, intends to manufacture, license for manufacture or sell that bears Applicant's Mark," it is clear that by Applicant's own admission it was not using the Mark on all of the goods identified in the application.

In addition, Bose's Request for Documents No. 17 requested the production of "[a]ll documents or things that establish Applicant's continuous use of Applicant's Mark on or in connection with Applicant's goods since the dates of first use and the first use in interstate or other commerce regulable by Congress, of Applicant's mark." OPPOSER'S NOTICE OF RELIANCE, Opposer's First Request to Applicant for the Production of Documents and Things, Request No. 17. The responsive documents produced by Applicant are consistent with Applicant's interrogatory responses, and they do not evidence any use of the mark on the majority of the goods covered by the application, namely: "tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna." OPPOSER'S NOTICE OF RELIANCE, Applicant's Supplemental Responses to Opposer's First Request for the Production of Documents and Things, Response to Document Request No. 17.

In view of both Applicant's verified interrogatory responses and document production, wherein no use of the mark on "tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna" is claimed or documented, the verified Declaration of Use in its application signed by Hexawave's President stating that the mark was actually being used on these goods was knowingly false. There is no question that the registration would have issued but for Applicant's misrepresentation, since the USPTO will not issue a registration covering goods upon which the mark has not been used. See, *Medinol*, 67 USPQ2d at 1208.

Thus, Applicant knowingly submitted false, material representations in connection with its attempted registration of Application Serial No. 76/304,063 for HEXAWAVE. Accordingly,

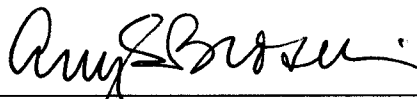
Application Serial No. 76/304,063 is void ab initio and should be refused registration on the basis of fraud. See, *Medinol*, 67 USPQ2d at 1208.

CONCLUSION

For the reasons set forth above, the opposition should be sustained.

Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that on this 30th day of May 2006, a true copy of the BRIEF OF
OPPOSER has been sent by First Class mail, postage prepaid to the below-identified counsel for
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