

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Oral Hearing:  
March 15, 2007

Mailed:  
November 6, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Bose Corporation  
v.  
Hexawave, Inc.

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Opposition No. 91157315

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Charles Hieken and Amy L. Brosius of Fish & Richardson P.C.  
for Bose Corporation.

Morton J. Rosenberg of Rosenberg, Klein & Lee for Hexawave  
Inc.

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Before Hohein, Drost and Kuhlke, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Hexawave Inc. (applicant) has filed an application to register the mark HEXAWAVE (in standard character form) on the Principal Register 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;

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downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna" in International Class 9.<sup>1</sup>

Bose Corporation (opposer) has opposed registration of the above mark based on the claims of likelihood of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with its previously used and registered marks ACOUSTIC WAVE and WAVE, and fraud based on allegations that applicant has not used the mark in connection with all of the goods listed in the application. In the notice of opposition, opposer alleges that it is the owner of the following registrations:

Registration No. 1338571 for the mark ACOUSTIC WAVE for "loudspeaker systems";<sup>2</sup>

Registration No. 1764183 for the mark 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";<sup>3</sup> and

Registration No. 1633789 for the mark WAVE for "radios, clock radios, audio tape recorders and players, portable radio and cassette recorder

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<sup>1</sup> Serial No. 76304063, filed on August 24, 2001, alleging dates of first use and first use in commerce of May 2, 2000 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

<sup>2</sup> Issued on the Supplemental Register on May 28, 1995 with claimed dates of first use and first use in commerce of February 1, 1984; renewed.

<sup>3</sup> Issued on April 13, 1993, on the Principal Register, with claimed dates of first use and first use in commerce of February 1, 1984; renewed.

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combinations, compact stereo systems and portable compact disc players."<sup>4</sup>

Applicant, in its answer, has denied the salient allegations in the opposition. In addition, applicant asserts a counterclaim which seeks to cancel pleaded Registration No. 1633789 on the ground of fraud. In particular, applicant alleges that opposer committed fraud when it filed its renewal under Sections 8 and 9 of the Trademark Act claiming use on audio tape recorders and players when it knew it no longer manufactured or sold those goods.

Opposer in its answer to the counterclaim has denied the salient allegations thereof.

The record includes the pleadings; the opposed application and registration subject to the counterclaim; applicant's responses to opposer's interrogatories and document requests made of record under opposer's notice of reliance; opposer's responses to applicant's interrogatories and document requests made of record under applicant's notice of reliance; and the testimony of John F. Mar, opposer's product manager, Mark E. Sullivan, opposer's general counsel and assistant secretary (Sullivan I taken by opposer on January 26, 2006 and Sullivan II taken by

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<sup>4</sup> Issued February 5, 1991, on the Principal Register, with claimed dates of first use and first use in commerce on September 25, 1989; renewed.

applicant on March 29, 2006), and Carol Fritz, a legal assistant employed by opposer.<sup>5</sup>

Both parties have filed briefs and an oral hearing was held on March 15, 2007.<sup>6</sup>

**COUNTERCLAIM ON THE GROUND OF FRAUD**

We first address applicant's counterclaim to cancel opposer's pleaded Registration No. 1633789 on the ground of fraud.

**Standing**

Applicant has standing based on opposer's assertion of this registration against applicant in its opposition to the application. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) ("[A]pplicant's standing to assert the counterclaim arises from applicant's position as a defendant in the opposition and cancellation initiated by opposer").

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<sup>5</sup> Though some discovery submissions (e.g., documents obtained from another party under Fed. R. Civ. P. 34, see Trademark Rule 2.120(j)(3)(ii)) are not proper subject matter for introduction by notice of reliance, because neither party made objection to such submissions we have treated the material as having been stipulated into the record, and accorded the submissions whatever probative value they warrant. *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58 (TTAB 1984).

<sup>6</sup> On September 24, 2007, the Board granted opposer's consented motion to suspend proceedings until October 24, 2007 to allow time for settlement. On October 23, 2007, opposer filed a paper informing the Board that no progress towards settlement had been made and no further suspension was sought.

**Fraud**

In order for applicant to prevail on a claim of fraud, applicant must prove that opposer knowingly made "false, material representations of fact in connection with" opposer's Section 8/9 renewal, filed January 8, 2001. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986) ("Fraud in obtaining renewal of a registration amounts to fraud in obtaining a registration within the meaning of Section 14(c) of the Lanham Act"). See also *Hachette Filipacchi Presse v. Elle Belle, LLC*, \_\_\_ USPQ2d \_\_\_ (Canc. No. 92042991 TTAB April 9, 2007) (statements regarding the use of the mark on goods and services are material to issuance and maintenance of a registration covering such goods and services). That is, to constitute fraud on the United States Patent and Trademark Office (USPTO), a statement must be (1) false, (2) made knowingly, and (3) a material representation. Moreover, the charge of fraud upon the USPTO must be established by clear and convincing evidence. See *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). See also *Smith International Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981) ("It thus appears that the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be

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resolved against the charging party"). Fraud will not lie if it is proven that the statement, though false, was made with a reasonable and honest belief that it was true. See *Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon)*, 43 USPQ2d 1440, 1444 (TTAB 1997) (defendant "held, at the time she signed the application oath, an honest, good faith belief that her corporation ... as the senior user of the registered mark, was the owner of the mark"). "[P]roof of specific intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." *General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car Inc.*, 17 USPQ2d 1398, 1400 (S.D. Fla. 1990). See also *Torres, supra*, and *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003).

The material facts are largely undisputed. Rather, the controversy in this case centers on the legal implications that arise from those facts. Applicant contends and opposer acknowledges that it stopped manufacturing and selling audio tape recorders and players sometime in 1996 and that it had completely phased out sales of this product by early 1997.

Based on these facts, applicant concludes that when opposer filed its Section 8/9 renewal on January 6, 2001, which included those goods in the statement of continuing

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use, it knowingly made a material, false statement to the USPTO that consequently constitutes fraud.

Opposer disputes the contention that the statement was false, arguing that it has continued to use its mark on the goods because owners of audio tape recorders and players continue to send their previously purchased goods to opposer for repair services and upon completion of the repair services opposer "transports" them back to the owner.

Mr. Sullivan, opposer's general counsel and associate secretary, signed the Section 8/9 renewal. He is responsible for "all legal issues in the company, intellectual property issues, contract issues, litigation issues in Europe, Asia, the United States." Sullivan I Dep. p. 16. He stays current on the company's primary business. Id. at 20. It is clear from the record that Mr. Sullivan knew that opposer had not manufactured or sold audio tape recorders and players under the WAVE mark since 1997. Id. at 9. See also Mar Dep. p. 54. In the following testimony, Mr. Sullivan describes his asserted basis for including these goods in the renewal:

Q. Okay. Was that statement true at the time you signed this document?

A. Yes.

Q. Why was that true?

A. It's my understanding that at that time this product was being repaired. And in the process of

repairs, the product was being transported back to customers.

Id at 12.

The following testimony describes the logistics of the "transportation":

A. As I mentioned, the product comes back to the company, and I already described how it comes back here. It's repaired by our parts group, and then it's shipped back to the consumer.

Q. Who pays for the shipping?

A. It depends. If it's under warranty, we pay for shipping. If it's not under warranty, the customer pays for the shipping.

Id. at 27-28.

Mr. Sullivan further testified that opposer does not re-label or make any alteration to the product, apart from the technical repair. Id. at 30.

It is not clear whether he consulted with his outside trademark counsel as to whether the repair services and subsequent shipments would constitute use in connection with the goods. Sullivan II Dep. pp. 8-10. He does not recall the basis for his understanding that "transporting" goods in connection with repair services constitutes use in connection with goods. See Id. at pp. 6-8. However, he testified that he is aware of his duty to update the description of goods to accurately reflect use of the mark.

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Sullivan I Dep. p. 33.<sup>7</sup> As to whether Mr. Sullivan made inquiries into opposer's use of the mark prior to signing the Section 8/9 renewal, there are inconsistencies between Mr. Sullivan's testimony and the testimony of his paralegal, Ms. Fritz. Mr. Sullivan testified that he inquired of the paralegal how the mark was being used, however, the paralegal testified that no such inquiry was made. Compare Sullivan I Dep. p. 23 with Fritz Dep. pp. 10-12, 17-18.

Opposer offers no case law to support its theory that "transporting" a product back to an owner of that product in connection with repair services constitutes use of a trademark on a good so as to imbue the transporter with trademark rights as to those goods as contemplated by Section 45 of the Trademark Act, nor are we aware of any. Trademark Act Section 45, 15 U.S.C. Section 1127, provides in relevant part as follows:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce- (1) on goods when- (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement

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<sup>7</sup> We note that in 1996 when opposer filed its Section 8 declaration of continuing use to maintain the registration, the declaration signed by Mr. Sullivan did not include the following goods that were in the original registration: television receivers, video cassette recorders, video cassette players, and camcorders. See Sullivan I Dep. Exh. No. 67. Mr. Sullivan testified that opposer never manufactured these goods. Sullivan I Dep. p. 34.

impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

The term "trademark" includes any word, name, symbol, or device, or any combination thereof- (1) used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Applicant argues that the assertion that "goods belonging necessarily to others (the customers who purchased them earlier and are now submitting them for repair)" is "fallacious" inasmuch as "[o]ne could hardly be said to be making use of one's mark on or in connection with certain goods when they are not one's own goods." Br. p. 38. Further, applicant contends that "[a]s a rather fundamental matter, then, before one can make 'use in commerce' of a mark for certain goods, the goods must actually be 'his or her goods.'" Br. p. 39 citing Section 45. Applicant relies on *Standard Pressed Steel Co. v. Midwest Chrome Process Co.*, 183 USPQ 758 (TTAB 1974), in support of its argument that this activity cannot be considered use in connection with goods. In *Standard Pressed Steel*, the Board stated:

But, the question here is what business was fostered by the shipments of these fasteners. It is readily apparent that applicant was not at that

time and is not now commercially engaged either in the manufacture and/or sale of fasteners as such; that applicant's primary business is the job plating of fasteners and other metal parts produced and/or owned by others; that applicant has used and advertised the mark "UNBAR" solely to identify a proprietary plating process; and that the fasteners involved in these shipments were plated with the "UNBAR" process and used to demonstrate and solicit sales for the "UNBAR" process rather than to promote the sale of fasteners. Thus, under this set of circumstances, it must be concluded that the initial shipment in commerce on which the subject application is predicated constitutes an insufficient basis or foundation for the registration of "UNBAR" as a trademark for fasteners.

There is no question but that a party need not be a manufacturer of goods to own a trademark. In fact, any person in the normal channels of distribution including a manufacturer, a contract purchaser who has goods manufactured for him, and a retailer or merchant as well as any non-profit organization or institution can be the owner of a trademark "in commerce" if he applies or has someone in his behalf apply his own trademark to goods to which he has acquired ownership and title and sells or merely transports such goods in commerce as his own product with the mark, as applied thereto, serving to identify the particular product as emanating from the shipper or seller in his own capacity. The essence is title and ownership which bestows upon the person possessing such attributes the unhampered right or freedom to dispose of his products in any manner appropriate and consonant with law. In the present instance, applicant is primarily engaged in performing plating services on screws or fasteners and other metal objects owned by screw manufacturers or by automobile producers who have purchased the screws. While applicant adds value to the screws by performing its "UNBAR" services on them, the screws always remain the property of the screw manufacturers or their customers with applicant's dominion over the goods being that of a bailee confined to the specific task requested by its customers with title never passing to applicant ... The mark "UNBAR," as used by applicant on the containers in which the plated

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screws are shipped and on the shipping documents accompanying the containers, serves merely to advise the recipients of the goods, whether they be screw manufacturers or their customers, members of the automotive industry, that these screws have been treated with the "UNBAR" plating service. This use is not trademark use and hence does not create trademark rights in "UNBAR" for fasteners.

Standard Pressed Steel, at 765.

Applicant argues that opposer's "legal theory (of trademark use) could only be postulated upon carefully parsing language from a relatively obscure part of the Lanham Act - the definitions. As highly suspect as it is, the proffered theory is hardly self-evident enough in nature to jump out at even a seasoned trademark attorney, much less a general counsel like Mr. Sullivan .... When questioned more closely about the genesis of this novel theory, however, Mr. Sullivan could shed very little light .... " Br. p. 41.

Opposer attempts to distinguish the Standard Pressed Steel case, noting that in this case "Bose is the original manufacturer and source of the audio tape recorder and player goods. Bose itself placed the WAVE mark on the products, and the WAVE mark remains on the products throughout the repair process and during the time the goods are transported back to customers, thus constituting use in commerce of the WAVE mark in connection with 'audio tape recorders and players' in 2001 when Mr. Sullivan signed the Sec. 8/9." Reply Br. p. 10. We find this to be a

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distinction without a difference. As stated in *Standard Pressed Steel*, the "essence is title and ownership which bestows upon the person possessing such attributes the unhampered right or freedom to dispose of his products." *Standard Pressed Steel*, supra at 765. Further, as noted by the Ninth Circuit in the context of an infringement case, "a mere repair of a trademarked good, followed by return of the good to the same owner who requested the repair or rebuild, does not constitute a 'use in commerce' of the trademark under the Lanham Act unless the repair constituted a complete rebuild of the product." *Karl Storz Endoscopy-America v. Surgical Technologies Inc.*, 285 F.3d 848, 62 USPQ2d 1273, 1277 (9<sup>th</sup> Cir. 2002).

We acknowledge that sales of goods are not necessary to establish trademark ownership and that transportation of goods can be enough to establish use. Examples of sufficient use based only on a transportation of goods without a sale have included shipments of samples and prototypes, *International Mobile Machines Corp. v. International Tel. & Tel. Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986), shipments for a sales presentation that resulted in an order, *Sunbeam Corp. v. Merit Enterprises, Inc.*, 451 F. Supp. 571, 203 USPQ 494 (S.D.N.Y. 1978), distribution of free samples, *La Maur, Inc. v. International Pharmaceutical Corp.*, 199 USPQ 612 (TTAB 1978), and

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shipments of drugs for use in clinical testing, Schering Corp. v. Alza Corp., 207 USPQ 504, 506 n. 4 (TTAB 1980).<sup>8</sup> However, in all of these examples, the entity transporting the goods owned the goods at the time of transportation. Similarly, in the case cited by opposer, the party asserting trademark rights owned the goods that were transported. See General Healthcare Ltd. v. Qashat, 364 F.3d 332, 70 USPQ2d 1566, 1568 (1<sup>st</sup> Cir. 2004).

Put simply, the scenario presented by opposer does not constitute use sufficient to maintain a registration for goods. Thus, the only question is whether it was reasonable for opposer to believe that it did.

The Board has considered the question of "reasonable belief" in other cases. In Maids to Order of Ohio Inc. v. Maid-to-Order Inc., 78 USPQ2d 1899 (TTAB 2006), the Board determined that limited use of a mark across state lines in connection with services provided a reasonable basis for a belief that the mark was used in interstate commerce to support a declaration under Trademark Act Section 8, and an application for renewal. However, in Hachette Filipacchi Presse v. Elle Belle, LLC, supra, the fact that applicant did not understand that "use" meant use as to *all* goods and

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<sup>8</sup> While we realize that these cases are all prior to the revised definition of use in commerce which took effect in November 1988 as part of the Trademark Law Revision Act to require bona fide rather than token use, for the present purposes such makes no difference.

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English was not applicant's first language did not constitute a reasonable belief sufficient to support a use statement. In *Sinclair Oil Corp. v. Sumatra Kendrick*, \_\_\_ USPQ2d \_\_\_ (Opp. No. 91152940 TTAB June 6, 2007), the Board found that it was not reasonable to believe a one time giveaway and a registration of a fictitious name in 1996 was sufficient use to support an application filed on February 20, 2001. In *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007), the Board found that it was not reasonable to believe that use in Australia was sufficient to satisfy the use requirement of Section 1(a) of the Trademark Act and noted that applicants are under an obligation to investigate thoroughly the validity of such a belief before signing their application.

Under the circumstances of the case before us, we find that it was not reasonable for opposer's general counsel to believe that repair services constituted use of the trademark in connection with the "sale or transportation" of "his or her" goods. Opposer knew it no longer manufactured or sold those goods. Opposer asserts that it relies on the definition of "use in commerce," which includes transportation of goods, to support its proffered basis of use, but could not point to case law that supports an interpretation that transportation, without ownership of the goods and application of the mark to the goods at some point

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in the distant past, in connection with repair services constitutes use in connection with a good. Nor is it clear from the record that opposer inquired as to its use on the goods prior to signing the Section 8/9 renewal or investigated whether such a belief regarding the repair services was warranted. See *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) and *Hachette Filipacchi*, supra. Based on the plain meaning of the words in the statute that define "use in commerce" ("a mark ... is placed in any manner on the goods ... and ... the goods are sold or transported") and "trademark" ("used by a person ... to identify and distinguish his or her goods"), we do not find it reasonable to believe that an application of a mark at some point in the past to goods which have been sold, still serves to constitute use when those goods, now owned by another, are subsequently shipped again in connection with a repair service.

Thus, inasmuch as opposer was not using the mark in connection with audio tape recorders and players, the statement in the Section 8/9 renewal was false. Further, opposer knew it had not manufactured or sold audio tape recorders and players for at least three years prior to filing the Section 8/9 renewal and opposer's asserted belief that the return of a repaired audio tape recorder and player to its owner after rendering repair services was sufficient

to support use in connection with goods to maintain a registration for such goods was not reasonable. Finally, a use statement in a Section 8/9 renewal is a material representation; without use on all of the goods, the affidavit of continued use would not have been accepted. Therefore, we find that opposer committed fraud on the USPTO in maintaining Registration No. 1633789.<sup>9</sup> Accordingly, the registration will be cancelled in its entirety inasmuch as fraud cannot be cured by the deletion of goods from the registration. *Medinol, supra*.

If opposer should ultimately prevail in any appeal of this decision, we find in the alternative that the registration would in any event require restriction. Based on the record, it is clear that audio tape recorders and players, at a minimum, must be deleted from the registration.

**OPPOSITION ON GROUNDS OF LIKELIHOOD OF CONFUSION AND FRAUD**

Inasmuch as the counterclaim based on fraud only relates to the maintenance of Registration No. 1633789,

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<sup>9</sup> "It is important to note that the United States Patent and Trademark Office relies on the thoroughness, accuracy and honesty of each applicant. In general, the Office does not inquire as to the use of the mark on each good listed in a single class and only requires specimens of use as to one of the listed goods, relying on applicant's declaration with regard to use on the other listed goods. TMEP Sections 806.01(a) and 904.01(a) (4<sup>th</sup> ed. 2005). Allowing registrants to be careless in their statements of use would result in registrations improperly accorded legal presumptions in connection with goods on which the mark is not used." *Standard Knitting, supra* at 1928 n. 14 (TTAB 2006).

opposer is still entitled to rely on Registration Nos. 1338571 and 1764183 and its common law rights in the WAVE mark in asserting its claims of likelihood of confusion and fraud in the opposition. See *Standard Knitting*, supra.

**Standing/Priority**

Because opposer has made of record its pleaded Registration Nos. 1338571 and 1764183, opposer has established its standing to oppose registration of applicant's mark, and its priority is not in issue. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer has submitted testimony with accompanying evidence that establishes opposer's prior use of the mark WAVE in connection with radios and music systems.

**Fraud**

Opposer asserts the claim of fraud based on the allegation that applicant was not using its mark in connection with certain goods ("tuner; mixer; amplifier; downconverter; transceiver; transmitter; receiver; detectors, namely radio frequency detectors; radio frequency switch; antenna") listed in the application when it signed the declaration attesting to such use. In support of this allegation opposer relies on applicant's supplemental response to Interrogatory No. 5 and response to Document

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Request No. 17. These responses, formulaic objections omitted, are set forth below:

Interrogatory No. 5 - Identify 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 that Applicant, or a person on behalf of Applicant, intends to manufacture, license for manufacture, or sell that bears Applicant's mark.

Objection - (omitted).

Supplemental Answer - Subject to and without waiving the foregoing objections, and in accordance with the provisions of the Stipulated Protective Order in this Opposition, at least the following products are or are intended to be marketed by or on behalf of Applicant: (filed under seal)<sup>10</sup>

Document Request No. 17 - All 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.

Objections: (omitted).

Response: Subject to and without waiving its previously stated objections, Applicant will produce documents and things located upon conducting a reasonable search, to the extent that they exist.

In view of these responses, opposer argues that "it is clear that by Applicant's own admission it was not using the Mark on all of the goods identified in the application."

Br. p. 19. Further, opposer argues that the responses to

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<sup>10</sup> Inasmuch as this exhibit was filed under seal we do not reproduce the remainder of applicant's response.

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document request No. 17 "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." Br. p. 20.

Applicant argues that its responses to other interrogatories "clearly and explicitly affirm the identification of goods included in the original statement." App. Resp. Br. p. 29.

As noted above, a claim of fraud must be proven to the hilt and cannot be sustained on speculation. Smith International Inc., supra. Opposer mistakenly characterizes applicant's response to an interrogatory as an admission. In addition, any omission of these particular goods from applicant's response to Interrogatory No. 5 is hardly conclusive evidence of nonuse, particularly given the objection made concurrently with the response, and the qualifying language "at least." If opposer were dissatisfied with the response and believed the interrogatory to be appropriate and not unduly burdensome, opposer could have moved to compel a complete response absent objection.<sup>11</sup> See *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, Brunswick

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<sup>11</sup> We note, however, that applicant's responses and boilerplate objections cannot be characterized as a paragon for discovery responses within the spirit of the duty to cooperate. See generally TBMP § 408 (2d ed. rev. 2004).

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Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Time Warner Entertainment, Co. v. Jones, 65 USPQ2d 1650, 1656 (TTAB 2002). Rather than availing itself of this procedural tool, opposer opted to present a case of fraud based on this response. In addition, the fraud claim was added to the complaint after discovery closed and opposer never sought further discovery related to this claim.

Based on this record, opposer has not proven a prima facie case of fraud. Although the record may not be crystal clear as to applicant's use on each of the goods listed in the application, it is opposer's burden to prove by clear and convincing evidence its allegation of fraud. As noted above, there is no room for speculation and any doubt must be resolved against the charging party. Smith International Inc., supra. In view thereof, opposer's claim of fraud is dismissed.

**Likelihood of Confusion**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

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In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Opposer focuses its arguments on the fame of its marks, the similarity of the marks at issue, and, in the absence of restrictions in the identification of the respective goods, the relatedness of such goods and the overlap in their channels of trade and class of purchasers.

Fame

A key factor is the fame of the prior mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). We begin our analysis with this factor, because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

In support of its assertion of fame for its ACOUSTIC WAVE and WAVE marks, opposer states:

[T]he Federal Circuit has determined Bose's WAVE and ACOUSTIC WAVE marks to be famous. 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.' [Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)] 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.

Br. p. 9.

Based on this record and in view of the Federal Circuit's decision based on similar facts, we find that the evidence demonstrates that the ACOUSTIC WAVE and WAVE marks are famous for radios, loudspeakers and music systems that include amplifiers and tuners.

#### Goods/Trade Channels

We turn now to consider whether the goods at issue are related and their channels of trade overlap in such a manner as to cause a likelihood of confusion. The respective goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, they need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). Further, it is well settled that likelihood of confusion is determined on the

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basis of the goods as they are identified in the application and in the pleaded registrations. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). However, in regard to opposer's WAVE mark, because we have determined that the registration must be cancelled, we base our determination here on the evidence showing actual use of that mark.

Applicant's goods are identified as follows: compound semiconductor devices consisting of integrated circuits; microwave monolithic integrated circuits; modules, namely, power modules for wireless communication; transistors; tuners; mixers; amplifiers; down converters; transceivers; transmitters; receivers; detectors, namely, radio frequency detectors; radio frequency switches and antennas. Opposer's registration for the mark ACOUSTIC WAVE identifies its goods as follows: loudspeaker systems; 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. In addition, opposer has at a minimum established use of the mark WAVE on radios, clock radios and portable compact disc players.

Although applicant states in its brief that its "products are internal electronic compounds usable only by highly trained technical personnel with the needs and resources to manufacture goods incorporating them" (br. p.

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12), applicant's tuners and amplifiers are not limited in any manner in the identification of its goods. Inasmuch as applicant's identification of goods is not limited or restricted, it is presumed that the application encompasses all goods of the type described, including those enumerated in opposer's registrations and marketed by opposer. Thus, applicant's identification "amplifier" must be read to include all types of amplifiers, including, as applicant describes opposer's amplifiers, "audio equipment typified by the sizable speaker-like devices." In addition, applicant's broad identification of "tuner" includes radio tuners. Both amplifiers and tuners are integral parts of opposer's loudspeaker and music systems. Thus, as identified, applicant's goods are related to opposer's goods.

Applicant's arguments regarding the highly specialized nature of its goods cannot rewrite the broad manner in which such goods are set forth in the identification. Although applicant's identification includes goods that may more accurately reflect the asserted true nature of applicant's goods (e.g., compound semiconductor devices consisting of integrated circuits), at a minimum, "tuner" and "amplifier" stand separately and encompass a broad spectrum of goods. Further, in view of our findings with respect to applicant's tuners and amplifiers and opposer's loudspeaker and music systems that include amplifiers and tuners, we need not

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discuss applicant's remaining goods in International Class 9. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Inasmuch as there is no limitation in the identifications of goods in the application and opposer's ACOUSTIC WAVE registrations, we presume an overlap in trade channels and that the goods would be offered to all normal and usual classes of purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, supra; and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Again, applicant's arguments as to the actual channels of trade of its goods cannot limit the broad identification of its goods in the application.<sup>12</sup> The ordinary channels of trade and class of purchasers would include retail stores, including those specializing in audio and electronic equipment, and both professional and general consumers. Further, with regard to opposer's WAVE mark, opposer has established that it sells goods under that mark to the general public in retail stores and over the internet, and widely advertises in print media, the

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<sup>12</sup> We further note that applicant's arguments characterizing opposer's marks as "non-distinctive" such that the "latitude of protection" should be tempered so as not to overreach "across the unrelated goods and across the unrelated channels of trade," are not persuasive given the relatedness of applicant's goods and overlap in channels of trade as defined by its own broad identification of goods in the application.

internet, and has advertised through television and radio. See, e.g., Mar Dep. pp. 31-32.

In view of the above, the du Pont factors of the relatedness of the goods, channels of trade and class of purchasers weigh in favor of a finding of likelihood of confusion.

Similarity of the Marks

We turn next to the du Pont factor of whether applicant's mark and opposer's marks are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result.

We find this case to present very similar circumstances to those found in Bose Corporation v. QSC, where the Federal Circuit stated:

"[the presence of the] root element WAVE ... introduces a strong similarity in all three marks. Whatever additional distinction may be introduced by the element of POWER in the QSC POWERWAVE mark is severely limited by the fact that the mark is applied to acoustic equipment, namely amplifiers. For this reason, the overall commercial impression engendered by the use of the POWERWAVE mark also

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carries a strong connotation of sound waves, corresponding to the Board's findings with respect to ACOUSTIC WAVE and WAVE. Any examination of the record before the Board reveals that the 'wave' portion of the Bose marks refers to sound and the unique way in which it is manipulated in the Bose products to produce the end product, sound. 'Wave' thus has meaning, and in this instance the newcomer, QSC, seeks to nestle close to the fame-benefited Bose marks.

Bose Corporation v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1311 (Fed. Cir. 2002).

Here, applicant's mark HEXAWAVE incorporates the entirety of opposer's WAVE mark and a substantial portion of the ACOUSTIC WAVE mark. In both comparisons, the presence of the term WAVE creates a similar commercial impression and evokes a similar connotation, at a minimum, when used in connection with the amplifiers. As noted above, applicant's identification of goods is not limited by any specific use or trade channels and includes opposer's type of amplifiers. Thus, the addition of the prefix HEXA, rather than serving to distinguish the marks, could be viewed as denoting a variant of opposer's famous WAVE and ACOUSTIC WAVE marks. In view thereof, we find that the similarity of the marks weighs in favor of a finding of likelihood of confusion.

In making our determination, we have considered applicant's argument that the term WAVE is "weak" and that "different variations of 'WAVE' thereby used have surely accustomed the consuming public to notice and differentiate between such variations." App. Br. p. 16. Applicant

references third-party registrations that form part of the prosecution history of its applications; however, third-party registrations are not evidence of use.<sup>13</sup> *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). They may, however, serve as an indication that the term may have a particular meaning in the field. *Id.* Applicant also points to a dictionary definition that defines WAVE as "a disturbance or oscillation propagated from point to point in a medium or in space and described, in general, by mathematical specification of its amplitude, velocity, frequency and phase." Webster's II New College Dictionary (2001). To the extent opposer's marks may be suggestive of its goods, it has already been established that its marks are famous and, thus, any perceived weakness due to suggestiveness is outweighed by the fame of the marks. Moreover, as noted above, to the extent WAVE has a meaning in relation to the overlapping goods, use of the identical term in the respective marks creates a similar overall commercial impression.

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<sup>13</sup> Applicant also references third-party registrations attached to applicant's answer. With the exception of a status and title copy of a plaintiff's pleaded registration, exhibits attached to pleadings and not properly introduced during trial are not evidence on behalf of that party. Trademark Rules 2.122(c) and 2.122(d). See also *W.R. Grace & Co. v. Herbert J. Meyer Industries Inc.*, 190 USPQ 308, 309 n.5 (TTAB 1976); and TBMP Sections 704.03 and 704.05(a) (2d ed. rev. 2004).

Actual Confusion

Applicant argues that opposer indicated in response to an interrogatory that it is not aware of any instances of actual confusion, and submits this supports a finding of no likelihood of confusion. However, there is no evidence in the record to establish that the parties' products have been offered in overlapping channels of trade such that any meaningful inference could be drawn from a lack of actual confusion.<sup>14</sup> Under such circumstances, this factor carries little weight in our determination of likelihood of confusion. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); and *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 541 (TTAB 1979). Specifically, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Moreover, it is well established that actual confusion is not necessary for a finding of likelihood of confusion. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

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<sup>14</sup> This analysis of actual confusion that necessarily looks to what occurs in the marketplace is distinguished from our determinations on the relatedness of the goods and channels of trade which are limited to the identifications of the goods as listed in the application and registrations.

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Based on the evidence of record pertaining to the relevant du Pont likelihood of confusion factors, we conclude that a likelihood of confusion exists.

**Decision:** The counterclaim to cancel Registration No. 1633789 is granted and such registration will be canceled in due course; the opposition to registration of application Serial No. 76304063 is sustained based only on the claim of priority and likelihood of confusion under Section 2(d) and registration to applicant is refused.