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Subject: U.S. Trademark Application Serial No. 97805954 - BANNER ISD - -
1684.276US01 - Examiner Brief
Sent: November 08, 2024 12:01:30 PM EST
Sent As: tmng.notices@uspto.gov

Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 97805954

Mark: BANNER ISD

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Reference/Docket No. 1684.276US01

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Banner Engineering Corporation ("applicant") has appealed the refusal to register its standard character mark, BANNER ISD, used in connection with "self-contained and remote electronic sensors for industrial automation in manufacturing; machine safety products, namely, safety light curtains, safety laser scanners, safety electric interlock switches, emergency stop switches, and electric stop control devices for factory machinery; machine vision products, namely, remote LED displays, c-mount camera lenses, video monitors, mounts and mounting brackets adapted for cameras and sensors, laser line generators, electrical vision cables, vision sensor filters; wireless communication modules for

voice, data or image transmission; antennas, voltage surge suppressors, electric cord sets, enclosures for sensors, and electric relay boxes; photoelectric based proximity and measuring sensors; ultrasonic based proximity and measuring sensors; radar based proximity and measuring sensors; sensors for detecting and measuring applications; pick-to-light sensors; pick-to-light indicators; sensors and detector units for use in controlling the actuation and operation of safety apparatus and equipment; vibration sensors; temperature sensors; fiber optics; capacitive sensors; geo-magnetic proximity and measuring sensors; vibration monitoring and measuring sensors; LED based indicator lights, namely, base mount indicators, t-style mount indicators, flush mount indicators and barrel mount indicators; Digital to analog converters; analog to digital converters; plug-in connectors; fiber optic converters, namely, convertors for digital and analog signals; electric converters; Electronic currency converters; electrical cables and cordsets; fiber optic adapters for converting digital and analog signals; electrical adapters; digital communication hubs for consolidating, processing, transmitting, adapting, and converting digital and analog data from multiple sources; digital communication masters for consolidating, processing, adapting, and converting digital and analog electrical data from multiple sources; electrical suppressors, namely, voltage surge suppressors; electronic filters, namely, filters that improve digital or analog signal integrity; fuses; programmable logic controller" in International Class 009, based on a likelihood of confusion under Trademark Act Section 2(d) with the following two registered marks:

- (1) ISD in standard characters for, in relevant part, "Motor control system comprised of one or more of electric power supply units, electric power controllers, electrical and electronic power controllers, software for controlling motors, electronic speed controllers, inverters, converters, and frequency converters; electric power supply units; electric power controllers; electrical and electronic power controllers; software for controlling motors; electronic speed controllers; electronic control systems for machines; inverters and converters, including frequency converters" in International Class 009 (Reg. No. 4252405); and
- (2) ISD in stylized text for "integrated circuits, semiconductors, and computer hardware for use in evaluating and demonstrating semiconductors and integrated circuits" in International Class 009 (Reg. No. 1739549).

I. STATEMENT OF FACTS

On February 22, 2023, applicant filed a Section 1(b) intent-to-use application to register the standard character mark BANNER ISD on the Principal Register in association with various electrical and electronic components and devices in International Class 009. On July 10, 2023, the examining attorney issued an Office action refusing registration pursuant to Trademark Act Section 2(d) based on a likelihood of confusion with two registered marks, requiring amendments to the identification of goods, and requiring additional information regarding the significance of the letters in the mark. Applicant filed a response to the Office action on October 10, 2023 that satisfied the two requirements; however, the examining attorney was not persuaded by applicant's arguments against the Section 2(d) refusals, and the refusal was made final on November 6, 2023. Applicant filed a request for reconsideration on May 6, 2024, in which it amended its identification of goods to remove certain goods that were identical to goods in the cited registrations (including microcontrollers, electrical controllers, and frequency converters). The examining attorney denied the reconsideration request on July 15, 2024. Applicant subsequently filed its appeal brief on September 13, 2024.

II. STATEMENT OF THE ISSUE

The only issue on appeal is whether there is a likelihood of confusion under Trademark Act Section 2(d) between applicant's mark, BANNER ISD, and the two registered marks, ISD (U.S. Registration No. 1739549) and ISD (U.S. Registration No. 4252405), when used on or in connection with the identified goods.

III. ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533

(Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Here, applicant has applied to register the mark BANNER ISD in standard characters for, as amended, "self-contained and remote electronic sensors for industrial automation in manufacturing; machine safety products, namely, safety light curtains, safety laser scanners, safety electric interlock switches, emergency stop switches, and electric stop control devices for factory machinery; machine vision products, namely, remote LED displays, c-mount camera lenses, video monitors, mounts and mounting brackets adapted for cameras and sensors, laser line generators, electrical vision cables, vision sensor filters; wireless communication modules for voice, data or image transmission; antennas, voltage surge suppressors, electric cord sets, enclosures for sensors, and electric relay boxes; photoelectric based proximity and measuring sensors; ultrasonic based proximity and measuring sensors; radar based proximity and measuring sensors; sensors for detecting and measuring applications; pick-to-light sensors; pick-to-light indicators; sensors and detector units for use in controlling the actuation and operation of safety apparatus and equipment; vibration sensors; temperature sensors; fiber optics; capacitive sensors; geo-magnetic proximity and measuring sensors; vibration monitoring and measuring sensors; LED based indicator lights, namely, base mount indicators, t-style mount indicators, flush mount indicators and barrel mount indicators; Digital to analog converters; analog to digital converters; plug-in connectors; fiber optic converters, namely, convertors for digital and analog signals; electric converters; Electronic currency converters; electrical cables and cordsets; fiber optic adapters for converting digital and analog signals; electrical adapters; digital communication hubs for consolidating, processing, transmitting, adapting, and converting digital and analog data from multiple sources; digital communication masters for consolidating, processing,

adapting, and converting digital and analog electrical data from multiple sources; electrical suppressors, namely, voltage surge suppressors; electronic filters, namely, filters that improve digital or analog signal integrity; fuses; programmable logic controller" in International Class 009.

Registrant's mark (Reg. No. 4252405) is ISD in standard characters for, in relevant part, "Motor control system comprised of one or more of electric power supply units, electric power controllers, electrical and electronic power controllers, software for controlling motors, electronic speed controllers, inverters, converters, and frequency converters; electric power supply units; electric power controllers; electrical and electronic power controllers; software for controlling motors; electronic speed controllers; electronic control systems for machines; inverters and converters, including frequency converters" in International Class 009.

Registrant's mark (Reg. No. 1739549) is ISD in stylized text for "integrated circuits, semiconductors, and computer hardware for use in evaluating and demonstrating semiconductors and integrated circuits" in International Class 009.

A. The Marks are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Charger Ventures LLC*, 64 F.4th 1375, 1380, 2023 USPQ2d 451, at *3 (Fed. Cir. 2023) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371-72, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Here, applicant's mark, BANNER ISD, is confusingly similar to the registered marks, ISD in standard characters and ISD in stylized text, because the marks contain the identical term ISD, which means the marks are similar in appearance, sound, and meaning. Specifically, applicant's mark creates the same overall commercial impression as registrants' marks, as the entirety of the literal elements of registrants' marks are encompassed within applicant's mark. The incorporation of an entire mark within another has often been found to increase the similarity between the compared marks where, as in the

present case, the dominant portion of the marks is the same. *See In re Charger Ventures LLC*, 64 F.4th 1375, 1381-82, 2023 USPQ2d 451, at *4-5 (Fed. Cir. 2023) (holding SPARK LIVING and SPARK confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660-61 (TTAB 2014) (holding PRECISION DISTRIBUTION CONTROL and PRECISION confusingly similar); TMEP §1207.01(b)(iii).

The inclusion of the word BANNER in applicant's mark does not overcome the confusing similarity between the marks, as the addition of a house mark to a registered mark does not generally obviate a likelihood of confusion under Section 2(d). *See In re Bay St. Brewing Co.*, 117 USPQ2d 1958, 1965 (TTAB 2016) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1602 (TTAB 2011); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007)); *In re Apparel Ventures, Inc.* 229 USPQ 225, 226 (TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985); TMEP §1207.01(b)(iii). It is likely that goods sold under these marks would be attributed to the same source. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007). In fact, applicant even describes the wording BANNER as being used as a house mark by stating, "[a]pplicant's mark . . . prominently uses the BANNER house mark." *See Applicant's Appeal Brief*, p. 4. Because the only difference between the literal elements of applicant's and registrants' marks is applicant's inclusion of its house mark, consumers are likely to mistakenly presume that the two registered ISD marks are a shortened version of applicant's BANNER ISD and/or are associated with the BANNER line of products. The Trademark Act not only guards against the misimpression that the senior user is the source of a junior user's goods and/or services, but it also protects against "reverse confusion," where a significantly larger or prominent junior user is perceived as the source of a smaller, senior user's goods and/or services such that the "senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user" for related goods

and/or services. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1329, 123 USPQ2d 1744, 1752 (Fed. Cir. 2017) (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)); *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994). In this case, consumer confusion as to the source of the goods would be likely.

B. Applicant's and Registrants' Goods are Closely Related

The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i); *see Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)).

Here, applicant's goods are closely related to registrants' goods in that the compared goods are electronics commonly manufactured by the same entities, used for similar and/or related purposes, and available to the same consumers in the same channels of trade. Specifically, applicant's **sensors** ("Self-contained and remote electronic sensors for industrial automation in manufacturing; photoelectric based proximity and measuring sensors; ultrasonic based proximity and measuring sensors; radar based proximity and measuring sensors; sensors for detecting and measuring applications; pick-to-light sensors; sensors and detector units for use in controlling the actuation and operation of safety apparatus and equipment; vibration sensors; temperature sensors; capacitive sensors; geo-magnetic proximity and measuring sensors; vibration monitoring and measuring sensors"); various **indicators** ("pick-to-light indicators; LED based indicator lights, namely, base mount indicators, t-style mount indicators, flush

mount indicators and barrel mount indicators"); **machine safety and vision products** ("machine safety products, namely, safety light curtains, safety laser scanners, safety electric interlock switches, emergency stop switches, and electric stop control devices for factory machinery; machine vision products, namely, remote LED displays, c-mount camera lenses, video monitors, mounts and mounting brackets adapted for cameras and sensors, laser line generators, electrical vision cables, vision sensor filters"); **communication-related goods** ("wireless communication modules for voice, data or image transmission; digital communication hubs for consolidating, processing, transmitting, adapting, and converting digital and analog data from multiple sources; digital communication masters for consolidating, processing, adapting, and converting digital and analog electrical data from multiple sources"); **converters** ("Digital to analog converters; analog to digital converters; plug-in connectors; fiber optic converters, namely, convertors for digital and analog signals; electric converters; Electronic currency converters"); **adapters** ("fiber optic adapters for converting digital and analog signals; electrical adapters"); **electrical suppressors, filters, cables, cords** ("voltage surge suppressors, electric cord sets, enclosures for sensors, and electric relay boxes; electrical cables and cordsets; electrical suppressors, namely, voltage surge suppressors; electronic filters, namely, filters that improve digital or analog signal integrity"); fuses; fiber optics; antennas; and programmable logic controllers are closely related to registrants' electronic goods, namely, electric power supply units, power controllers, inverters, and converters (Reg. No. 4252405) and integrated circuits and semiconductors (Reg No. 1739549), respectively.

The third-party registrations attached to the previous Office actions establish that the relevant goods are of a kind that may emanate from a single source under a single mark. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii). Additionally, the Internet evidence of record demonstrates that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use.

For the third-party registrations cited, the full scope of the goods must be considered. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *9 (TTAB 2019). Specifically, "a registration that describes goods [or services] broadly is presumed to encompass all goods or services of the type described." *In re*

Country Oven, Inc., 2019 USPQ2d 443903, at *9 (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)). For example, the third-party registrations that include the term sensors are broad enough to encompass "Self-contained and remote electronic sensors for industrial automation in manufacturing; photoelectric based proximity and measuring sensors; ultrasonic based proximity and measuring sensors; radar based proximity and measuring sensors; sensors for detecting and measuring applications; pick-to-light sensors; sensors and detector units for use in controlling the actuation and operation of safety apparatus and equipment; vibration sensors; temperature sensors; capacitive sensors; geo-magnetic proximity and measuring sensors; vibration monitoring and measuring sensors; self-contained and remote electronic sensors for industrial automation in manufacturing; Self-contained and remote electronic sensors for industrial automation in manufacturing" in the application. Similarly, the term converters in the third-party registrations is broad enough to encompass "Digital to analog converters; analog to digital converters; fiber optic converters, namely, converters for digital and analog signals; electric converters; electronic cable converters" in the application.

Moreover, an examining attorney need not establish that every good or service listed in the application is related to the goods and/or services in the cited registration(s). In a likelihood of confusion analysis, it is sufficient to establish relatedness for one good or service in the refused class(es). *MLB Players Ass'n v. Chisena*, 2023 USPQ2d 444, at *18 (TTAB 2023) (quoting *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *11 (TTAB 2020)); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *2 (TTAB 2020) (citing *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 938-39 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981)).

U.S. Registration No. 4252405

The evidence supporting the relatedness of applicant's and registrant's goods includes:

- Reg. No. 4916773 for power controllers as well as sensors, programmable logic controllers, and indicator lights. July 10, 2023 Non-Final Action, TSDR p. 30-32.
- Reg. No. 5800818 for electrical power supplies and power controllers as well as electric converters, electrical cables, antennas for wireless communications apparatus, current converters, electrical adapters, indicator lights. *Id.* at 45-50.

- Reg. No. 4978466 for electrical controllers as well as fuses, fiber optic and electronic cables, optical signal filters, sensors, converters. *Id.* at 52-56.
- Reg. No. 5657752 for electrical controlling devices as well as voltage surge protectors. *Id.* at 58.
- Reg. No. 6176851 for electrical controllers as well as converters, sensors. *Id.* at 74.
- Reg. No. 7049612 power controllers as well as electric power converters, electrical connection boxes, communications modules. *Id.* at 80-82.
- Reg. No. 6814194 for mechanical remote controls for motors as well as electronic filters, relays, fuses, voltage stabilizers. Nov. 6, 2023 Final Action, TSDR p. 8.
- Reg. No. 7196544 for electric power controllers as well as electric power conversion devices. *Id.* at 18.
- Reg. No. 6796691 for power controllers as well as converters, adapters, connectors, voltage regulators and stabilizers. *Id.* at 26.
- Reg. No. 3422565 for power controllers as well as converters. *Id.* at 28.
- Reg. No. 3581015 for controllers for electric motors as well as machine safety goods such as light curtains, emergency stop switches, relays, programmable controllers, and sensors. *Id.* at 29.
- Reg. No. 6980680 for power controllers as well as converters. *Id.* at 31-32.
- Reg. No. 4538110 for electric, electronic and electrical controllers as well as connectors, relays, sensors, antenna systems, fiber optics, fuses, telecommunications and communications equipment. *Id.* at 34-43.
- Reg. No. 7133699 for electrical controllers as well as electrical cable and sensors. *Id.* at 44-45.
- *Eaton* providing controllers and fuses. July 15, 2024 Request for Reconsideration Denial, TSDR p. 4-28.
- *Grainger* providing safety products (such as emergency power off buttons), sensors, electric controllers, and electric power supply units. *Id.* at 32-37, 40, 43.
- *McMaster-Carr* providing power supplies, connectors, fuses. *Id.* at 45-46.
- *Mouser* providing converters, emergency stop switches, power controllers, capacitive sensors. *Id.* at 47-53, 58.

U.S. Registration No. 1739549

The evidence supporting the relatedness of applicant's and registrant's goods includes:

- Reg. No. 5800818 for electronic integrated circuits and semi-conductors as well as electric converters, electrical cables, antennas for wireless communications apparatus, current converters, electrical adapters, indicator lights. July 10, 2023 Non-Final Action, TSDR p. 45-50.
- Reg. No. 6176851 for integrated circuits and semiconductors as well as converters, sensors. *Id.* at 74-75.
- Reg. No. 6802334 for electronic integrated circuits and electronic semi-conductors as well as sensors. *Id.* at 76-77.
- Reg. No. 6869462 for semiconductors and integrated circuits as well as sensors. *Id.* at 78-79.
- Reg. No. 7013763 for integrated circuits and semiconductors as well as voltage surge suppressors, converters. *Id.* at 83-86.
- Reg. No. 7029582 for integrated circuits as well as sensors, wires, electric relays, light emitting diodes (LEDs), video screens. *Id.* at 87
- Reg. No. 6923753 for integrated circuits and semiconductors, as well as electric relays, fuses, sensors. *Id.* at 89.
- Reg. No. 6814194 for semiconductors and integrated circuits as well as electronic filters, relays, fuses, voltage stabilizers. Nov. 6, 2023 Final Action, TSDR p. 8.
- Reg. No. 7154985 for integrated circuits as well as converters. *Id.* at p. 10-11.
- Reg. No. 5625772 for semiconductors and integrated circuits as well as electric relays, electric wires, fiber optics, video screens. *Id.* at 12-13.
- Reg. No. 6905769 for semiconductors as well as indicator lights, electrical cables. *Id.* at 16-17.
- Reg. No. 7196544 for integrated circuits and semiconductors as well as electric power conversion devices. *Id.* at 18.
- Reg. No. 6410901 for semiconductors as well as sensors, light emitting diode (LED) displays, electronic indicator boards. *Id.* at 20.
- Reg. No. 6869463 for semiconductors, integrated circuits as well as sensors. *Id.* at 22-23.
- Reg. No. 5744387 for integrated circuits as well as sensors. *Id.* at 24-25.
- Reg. No. 6084196 for integrated circuits as well as sensors, communications systems. *Id.* at 48-49.
- *Grainger* providing safety products (such as emergency power off buttons), sensors, and

semiconductor fuses. July 15, 2024 Request for Reconsideration Denial, TSDR p. 32-33, 38, 40.

- *Mouser* providing converters, emergency stop switches, semiconductor modules, capacitive sensors. *Id.* at 47-50, 55, 58.

Thus, the evidence of record establishes that applicant's and registrants' identified goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

C. Applicant's Arguments are Unpersuasive and Unsupported

1. Applicant's mark is not sufficiently different in appearance and suggestion to the cited marks.

Applicant contends that its mark is different from the cited marks because it prominently uses its BANNER house mark. However, instead of operating to distinguish applicant's mark from the registrants', the use of a house mark does not generally obviate a likelihood of confusion under Section 2(d), as explained above. Furthermore, even to the extent that potential purchasers may realize the apparent differences between the marks, they are likely to assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that applicant's goods sold under the "BANNER ISD" mark constitute a new or additional product line from the same source as the goods and services sold under the "ISD" marks with which they are acquainted or familiar, or vice versa, and that applicant's mark is merely a variation of the registrant's mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.*, 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were "likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing.").

2. Applicant's and registrants' goods are not significantly different from the goods in the cited marks.

Applicant argues that its goods are "significantly different" from the goods in the cited registrations, but merely states as argument that the goods are different without providing any evidence to support its assertions. However, "[a]ssertions in briefs are not evidence." *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1420 (TTAB 2012) (citing *In re Simulations Publ'ns, Inc.*, 521 F.2d 797, 798, 187 USPQ 147, 148 (C.C.P.A. 1975); *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983)); *see also In re Sauer*, 27 USPQ2d 1073, 1074 n.1 (TTAB 1993) ("Applicant's

assertion that [applicant] took an informal survey as to how the mark [was] perceived [was] without evidentiary support.”); *Spin Physics, Inc. v. Matsushita Elec. Indus. Co.*, 168 USPQ 605, 607 (TTAB 1970) (“The arguments and opinions of counsel for applicant [were] wholly insufficient to overcome the facts”). Therefore, applicant's conclusory statements such as, “[i]ntegrated circuits are very different from Applicant's factory machine safety goods” are unpersuasive. *See* Applicant's Appeal Brief, p. 8.

Further, applicant's argument that consumer confusion is highly unlikely because its goods are factory safety products while Reg. No. 4252405's goods are for motors and Reg. No. 1739549's goods are highly specialized products is unpersuasive. Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Here, there is nothing in the application to limit the goods to factory safety products, and as such, the likelihood of confusion determination is made on the applied-for goods. Moreover, although applicant asserts that Reg. No. 4252405 is “registered for motors”, the registration states such goods as electric power supply units and electric power controllers generally, which as demonstrated by the evidence discussed above, are closely related to applicant's goods. Similarly, applicant states that Reg. No. 1739549's integrated circuits are completely different from applicants goods, apparently basing this conclusion on the assertion that registrant's goods are highly specialized products. However, the evidence discussed above shows that many manufacturers of integrated circuits also provide products identical to those offered by applicant.

3. Applicant's and registrants' goods do not travel in different trade channels

Applicant also claims that the market, consumers, and trades of channels of the respective goods are very different. However, here, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are thus “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *49. The presumption under Trademark Act Section 7(b) is that the registrant is the owner of the mark and that

their use of the mark extends to all goods and/or services identified in the registration. 15 U.S.C. §1057(b). In the absence of limitations as to channels of trade or classes of purchasers in the goods and/or services in the registration, the presumption is that the goods and/or services move in all trade channels normal for such goods and/or services and are available to all potential classes of ordinary consumers of such goods and/or services. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii). Because neither applicant's nor registrants' identifications contain limitations or restrictions on channels of trade or class of consumer, it must be presumed that the relevant goods are provided to all consumers and in all normal channels.

Moreover, applicant's argument that the consumers of its products and the cited marks' products are sophisticated and therefore unlikely to be confused is unpersuasive. Applicant has not provided any evidence to support its conclusory statement that the relevant consumers are sophisticated. However, even if applicant had provided evidence that supported the claimed sophistication, it would be insufficient to overcome the Section 2(d) refusals. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1383, 2023 USPQ2d 451, at *6 (Fed. Cir. 2023); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019).

4. The cited marks are not weak and/or diluted.

Applicant claims that because the term "ISD" is registered to a number of third parties, it is weak, dilute, and only entitled to a narrow scope of protection. To support this, applicant lists (in addition to the two cited marks) four registered marks and one application with goods in Class 009 and the letters ISD in the mark. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1363, 2023 USPQ2d 737, at *4-5 (Fed. Cir. 2023) (quoting *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, SLU*,

797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015)); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); TMEP §1207.01(d)(iii). A large number of active use-based third-party registrations including the same or similar term or mark segment for the same or similar goods and/or services may be relevant to prove, in the same way dictionaries are used, that a term or mark segment has “a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak” and entitled to only a narrow scope of protection. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1364, 2023 USPQ2d 737, at *5-6 (Fed. Cir. 2023) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §11:90 (5th ed. 2023)); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, SLU*, 797 F.3d at 1374, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1675).

Here, however, the third-party registrations submitted by applicant are not probative. Of the four third-party registrations applicant submitted, only two appear to be active and based on use in commerce. Reg. No. 4341242 cancelled on December 7, 2023. Cancelled or expired registrations are not probative. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *13 (TTAB 2020) (quoting *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019)). Additionally, Reg. No. 6466006 has a basis of Section 44(e). Registrations that are not based on use in commerce, such as those registered under Trademark Act Section 66(a) or solely under Section 44, and for which no Section 8 or 71 affidavits or declarations of continuing use have been filed, have “very little, if any, persuasive value.” TMEP §1207.01(d)(iii) (citing *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020)). Moreover, the third-party application submitted by applicant is similarly unpersuasive. Third-party applications are evidence only that the applications were filed; they are not evidence of use of the mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *see In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); TBMP §1208.02; TMEP §710.03. This leaves two active, use-based registrations.

Evidence comprising only a small number of active use-based third-party registrations including the same or similar component is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017);

AMF Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). That is especially so where, as here, the marks in those registrations are not as similar in format or commercial impression as registrants' and applicant's marks are to each other. See *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1284-85 (Fed. Cir. 1984) (noting none of the five registrations of marks shown to be in use had the same format or conveyed a commercial impression similar to the applicant's and cited registered mark). These few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269).

Further, assessing conceptual strength is "based on the nature of the [component] itself," that is, its level of distinctiveness in relation to the specified goods and/or services. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)). Evidence comprising third-party registrations of similar marks for different or unrelated goods and/or services has "no bearing on the strength of the term in the context relevant to this case." See *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1058 (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). These registrations appear to be for goods that are predominantly different from or unrelated to those identified in the cited registrations and applicant's application.

Here, the marks in the small number of registrations provided by applicant convey different meanings and are for dissimilar goods. ISDESIGN (Reg. No. 4453590) conveys a different commercial impression than applicant's mark and the cited marks as it appears to read as IS DESIGN, and does not involve the term "ISD". Additionally, the goods are software for computer aided building and engineering, which are not similar to the goods at issue here. The registered mark ISDT (Reg. No. 5265557) does include a few goods arguably related to those currently at issue, but the mark itself is a completely different acronym, which conveys a different meaning.

Thus, the few use-based third-party registrations submitted by applicant are insufficient to establish that the mark or portion of the mark is inherently or conceptually weak and have little, if any, probative value with respect to the registrability of applicant's mark.

5. Applicant's claim that it is unaware of actual confusion is of little evidentiary value.

Applicant includes one sentence in its brief claiming that it is unaware of any case of actual confusion by a consumer. However, “[A] showing of actual confusion is not necessary to establish a likelihood of confusion.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). “[T]he relevant test is *likelihood* of confusion, not *actual* confusion.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original). “Uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value,” especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). As such, applicant's claim is insufficient to overcome the Section 2(d) refusals.

IV. CONCLUSION

The evidence of record demonstrates that the parties' marks are confusingly similar and the goods are closely related, establishing that a likelihood of confusion exists between applicant's mark and the registered marks. Further, in a likelihood of confusion determination, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

For the foregoing reasons, the refusal to register the applied-for mark on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) should be affirmed.

Respectfully submitted,

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USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on November 8, 2024 for
U.S. Trademark Application Serial No. 97805954

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of November 8, 2024**, if you wish to do so. If submitted, a reply brief must be submitted using the [Electronic System for Trademark Trials and Appeals \(ESTTA\)](#) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.