

ESTTA Tracking number: **ESTTA1398915**Filing date: **11/29/2024**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ex Parte Appeal - Serial No.	97805954
Appellant	Banner Engineering Corporation
Applied for mark	BANNER ISD
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Date	11/29/2024

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Application Serial No.: 97805954 )  
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Applicant: Banner Engineering Corporation )  
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Filing Date: October 14, 2019 )  
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Mark: BANNER ISD )

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**APPLICANT'S APPEAL BRIEF**

Banner Engineering Corporation ("Applicant") appeals the U.S. Patent and Trademark Office's ("the Office") refusal to register the trademark BANNER ISD on the ground that it is likely to cause confusion under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Applicant respectfully requests that the Trademark Trial and Appeal Board review this matter, hold that there is no likelihood of confusion, and instruct the Office to withdraw the final refusal of registration.

**I. THE BANNER ISD MARK IS NOT LIKELY TO CAUSE CONFUSION**

Applicant respectfully disagrees with the finding that its BANNER ISD Mark so resembles the mark in U.S. Registration Nos. 4252405 and 1739549 as to be likely to cause confusion, mistake or to deceive. Applicant bases this finding upon, among other factors, the dilution of the wording "ISD", the differences between the goods, the differences between the channels of trade through which they travel, and the ability of marks, containing "ISD" to coexist in the marketplace.

**A. There is no likelihood of confusion between Applicant's mark and the Cited Marks**

**1. The marks are not similar in appearance and suggestion.**

Applicant's mark BANNER ISD is different in appearance and suggestion to the cited marks. The Examiner's brief focusses only on one word of Applicant's two word mark. as two words and prominently uses the BANNER house mark.

The use of identical words, or even dominant words in common, does not automatically mean that the two marks are similar. Rather, in analyzing the similarities of sight, sound and meaning between two marks, a court looks to the overall impression created by the marks and does not merely compare individual features.

The Court of Appeals for the Federal Circuit has provided the following guidance for evaluating the marks:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.

In re Nat'l Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

TMEP §1207.01(b).

The appearance of Applicant's BANNER ISD trademark is significantly different than that used by the cited marks, both of which coexist with each other. Applicant's mark

prominently uses the BANNER mark which has numerous federal registrations with use dating back to 1973. May 6, 2024 Request for Reconsideration TSDR pp. 10-19.

Applicant's mark is a two word mark as opposed to the single word mark of the cited marks. Applicant's mark has a different first word, and contains 6 syllables while each of the cited marks contain are one word with three syllables. Applicant's mark contains the wording BANNER which is completely different from the wording in the cited marks. The appearance of Applicant's BANNER ISD trademark is different than that used by the cited marks. Consequently, consumers viewing the marks of the parties are readily able to distinguish them. In fact, this case is much like *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) which held GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design for coating and seasoning for food items were not likely to cause confusion because the addition of "ADOLPH'S" is sufficient to distinguish the marks. Because Applicant's mark has different wording and a very first word from the cited marks, the marks are different enough to avoid consumer confusion.

## **2. The goods are not similar.**

Applicant's factory safety products are significantly different from the cited mark goods. With respect to RN: 4252405, this mark is registered for motors. Applicant's goods are completely different from the cited mark's motors. With respect to RN: 1739549, this mark is registered for highly specialized products, integrated circuits and software for the same. Again, Applicant's factory safety products are completely different goods from these goods. Integrated circuits are very different from Applicant's

factory machine safety goods. Moreover, consumers of Applicant's products and each of the cited marks' products are sophisticated consumers and are unlikely to be confused by Applicant's mark which is different from each of the cited marks.

Additionally, the cited marks already coexist with other marks, including each other. May 6, 2024 Request for Reconsideration TSDR pp. 23-58. Because the goods are different, the parties also target different consumers. Thus, it is highly unlikely that individuals would confuse the mark as used by Applicant with the cited marks. The market and consumers of Applicant's mark and the cited mark are very different. For this additional reason, there is no likelihood of confusion with the cited mark and Applicant's mark.

The Examining Attorney's evidence consists of prior registrations that contain broad listings of goods and are all distinguishable as they cover broad listings of goods in class 9. All of the cited registrations are for long laundry list type listings of goods: Registrations 4916773 (July 10, 2023 Non-Final Action, TSDR p. 30-32), 5800818 (Id. at 45-50), 4978466 (Id. at 52-56), 5657752 (Id. at 58), 6176851 (Id. at 74), 7049612 (Id. at 80-82), 6814194 (Nov. 6, 2023 Final Action, TSDR p. 8), 7196544 (Id. at 18), 6796691 (Id. at 26), 3422565 (Id. at 28), 3581015 (Id. at 29), 6980680 (Id. at 31-32), 6980680 (Id. at 34-43), 7133699 (Id. at 44-45), 5800818 (July 10, 2023 Non-Final Action, TSDR p. 45-50), 6176851 for integrated circuits and semiconductors as well as converters, sensors. (Id. at 74-75), 6802334 (Id. at 76-77), 6869462 (Id. at 78-79), 7013763 (Id. at 83-86), 7029582 (Id. at 87), 6923753 (Id. at 89) 6814194 (Nov. 6, 2023 Final Action, TSDR p. 8), 7154985 (Id. at p. 10-11), 5625772 (Id. at 12-13), 6905769 (Id. at 16-17), 7196544 (Id. at

18), 6410901 (Id. at 20), 6869463 (Id. at 22-23), 5744387 (Id. at 24-25), 6084196 (Id. at 48-49).

Given that the evidence cited for the relatedness of the goods consists of registrations that contain almost all electronic goods in Class 9, this simply does not establish that the goods are related.

**3. The channels of trade and purchasers are different.**

As the goods are completely different, the channels of trade are also completely different. Applicant's goods are directed to factory owners and safety products for the same. May 6, 2024 Request for Reconsideration TSDR pp. 20-22. The cited marks are directed to land vehicle motors and purchasers of integrated circuits as a raw material. In this regard, the purchasers of the two marks are different and the channels of trade are different and therefore, confusion is unlikely.

**4. The cited marks are not strong.**

The term "ISD" is used and registered to a number of unrelated third parties see chart below. This coexistence between the multitude of marks for "ISD" indicates that each mark is entitled to a relatively narrow scope of protection, and that small differences between the marks, the goods and services, or the channels of trade through which they travel are likely to avoid creating a likelihood of confusion.

**5. The Number And Nature Of Similar Marks On Similar Goods**

The Examining Attorney Brief improperly discounts the third party registrations cited in Applicant's brief. In fact, the two cited marks are identical to each other and the same evidence cited by the Examiner regarding relatedness of goods is applicable to

the coexistence of the two cited marks, ISD and ISD, both in class 9. Likewise, the other third party references all coexist in class 9 with the cited marks, including ISDGAMES, ISDESIGN, ISDESIGNCENTER, ISDT, and MISD. May 6, 2024 Request for Reconsideration TSDR pp. 23-58. This evidences shows the diluted status of the term "ISD" in relation to class 9 goods, the ability of consumers to distinguish between similar marks, and the ability of multiple marks utilizing the term "ISD" to co-exist without consumer confusion in the marketplace and on the Federal Register.

### **5. Conclusion**

In light of all of the foregoing, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the 2(d) finding and allow Applicant's application to proceed in the application process.

Respectfully Submitted,

BANNER ENGINEERING CORPORATION

By its Attorney,

Date: November 29, 2024

/Gregory Golla/

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