

Hearing:

May 20, 1998

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

Paper No. 26

RLS/cj

MARCH 31, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Bose Corporation

v.

Navitar, Inc.

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Opposition No. 100,151  
to application Serial No. 74/406,004  
filed on June 28, 1993

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Charles Hieken of Fish & Richardson for Bose Corporation

Herbert Cohen of Wigman, Cohen, Leitner & Myers, P.C. for  
Navitar, Inc.

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Before Simms, Seeherman, and Walters, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Bose Corporation (opposer), a Delaware corporation, has  
opposed the application of Navitar, Inc. (applicant), a New  
York corporation, to register the mark ROMMATE for "video  
display apparatus for displaying information contained on

**Opposition No. 100,151**

photo CD and CD ROM."<sup>1</sup> In the notice of opposition, opposer alleges that applicant's mark used in connection with its goods so resembles opposer's mark ROOMMATE, previously used and registered by opposer for "loudspeaker systems,"<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive. Opposer also alleges that applicant's mark falsely suggests a connection with opposer.<sup>3</sup> In its answer, applicant has denied the essential allegations of the notice of opposition.

The record of this case consists of testimony (and exhibits) taken by each party, a status and title copy of opposer's pleaded registration, relied upon by notice of reliance, as well as the application herein opposed. Briefs were filed and an oral hearing was held.

Opposer's Record

According to the testimony of Mr. Robert Gierschick, opposer's senior marketing planning manager, opposer's ROOMMATE speaker system, which may be used with portable CD players or a personal stereo system, could be used with a "video display apparatus," which the witness stated could be a television monitor. Sales of opposer's ROOMMATE I

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<sup>1</sup> Application Serial No. 74/406,004, filed June 28, 1993, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,321,919, issued February 26, 1985, Section 8 filed, Section 15 acknowledged.

<sup>3</sup> Although opposer alleged this ground for opposition under Section 2(a) of the Act, 15 USC §1052(a), opposer has not argued

**Opposition No. 100,151**

speakers since 1984 have exceeded \$10 million dollars, with over 100,000 units being sold. Since 1989, opposer has sold at least 75,000 VIDEO ROOMMATE speakers, totaling at least \$7 million dollars. Since 1991, opposer has sold at least 10,000 Bose ROOMMATE computer monitor speakers, with sales exceeding \$1 million. According to the witness, opposer's speakers are sold through the same channels as "video display apparatus" used for displaying information on photo CDs and CD-ROMs. According to Mr. Gierschick, there is an overlap of purchasers of speakers and video display apparatus.

Applicant's Record

Applicant took the testimony of its president, Mr. Julian Goldstein, and Mr. Denny Bell, the vice president of sales of Professional Products Incorporated, a dealer for applicant's video products. Applicant, which began business as a lens company, modifies Kodak photo CD players into video or electronic slide projectors with random access picture selection by adding various video features. Having previously used the marks VIDEOMATE and MICROMATE for other products, applicant first used the mark ROMMATE in January 1993 in connection with its video display apparatus at a trade show. Applicant's first order was received in February 1994. According to Mr. Goldstein, applicant's

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this ground in its briefs. Accordingly, we will not further consider it.

goods are not available on the consumer market in retail electronic stores, but rather applicant sells its goods to audiovisual dealers who are not in the retail business. The typical user of applicant's equipment in the professional market is the corporation for its corporate boardroom.

Q. How would you describe the purchaser of the RomMate product?

A. They are very sophisticated, knowledgeable customer [sic] who does a lot of research. The typical purchaser of a Navitar RomMate is a large corporation that's designing a new fancy boardroom just like this that has a video presentation system in it and they want multiple inputs into that video projector just in case someone brings that media into the room.

Some presenters like to present with slides. Some presenters like to present with the computer. Some presenters like to present with flip charts. Some presenters like to present with documents. So in the boardroom they will have a document to video, a slide to video, a photo CD to video, a microscope to video, so just in case any presenter ever came into that boardroom they would have the capability displaying his media on the video projector for the group.

Goldstein dep., 10-11.

Mr. Goldstein also testified to the nature of the purchasing process of applicant's equipment.

A. Well again, typically from the time we start talking to a customer until the time we get the order, it's upwards of six months to a year. We have to demonstrate the product and they have to decide

they want to buy the product. It has to be approved by the budget committee, then it has to go out for bid, and then it has to get installed. And from the time that someone looks at it to the time they actually install it could be upwards of a year.

Goldstein's dep., 15-16.

Mr. Bell, among other things, testified that the respective marks have different meanings.

- Q. What does the term RomMate mean to you?
- A. Well, Rom, anytime you hear the word Rom it's specifically talking about a computer-based disk. CD Rom, Rom. It's always about computer type of products. A photo CD Rom would be, could also be a software product. Any lot of software products are put out on CD Roms. So anytime I hear Rom, it references computer. You know, I mean, it's just an automatic response.

Bell dep., 21-22.

Comparing the products of the parties, Mr. Bell, at 23, testified:

- A. Well, essentially one [opposer's] is an audio product, a speaker, consumer powered speaker system more or less. And the RomMate is an industrial video product. I mean in a nutshell that's the difference. One's used for one thing and one's used for another thing.

Mr. Bell did testify, however, that he sometimes installed a professional line of speakers made by opposer in corporate boardrooms. Bell dep., 24, 29. However, these

**Opposition No. 100,151**

installations involved ceiling speakers driven by high-end audio amplifiers. Applicant's witnesses testified that there have been no instances of actual confusion involving the marks of the parties.

Arguments of the Parties

Essentially, opposer argues that applicant's mark ROMMATE is sufficiently similar to opposer's mark ROOMMATE in sound and appearance that confusion is likely. With respect to the goods, opposer argues that there is no restriction in either its registration or in applicant's application as to trade channels or class of potential purchasers and that opposer's loudspeakers may be and are sold through the same channels of trade to the same class of purchasers as applicant's photo CD players. Opposer also argues that, to the extent there may be any doubts as to the question of likelihood of confusion, those doubts should be resolved against the newcomer.

Applicant, on the other hand, argues that the respective marks are different in sound, appearance and meaning. With respect to meaning or connotation, applicant argues that the term "ROM" is an acronym for "read-only memory," so that applicant's mark connotes CD-ROMs, which can be used to store visual images. With respect to the goods, it is applicant's position that opposer's loudspeakers are compact powered speakers used to connect to televisions, home

**Opposition No. 100,151**

computers, CD players and personal stereo. Applicant's product, on the other hand, is not a consumer audio product but rather a high-end audiovisual product, which is custom-ordered by sophisticated purchasers, and is not an impulse-purchase item. While applicant's goods include an audio capability, photo CDs have no sound and a customer, therefore, has no use for the audio function, applicant contends. Also, applicant argues that the fact that its dealers may also sell some models of opposer's speakers does not lead to the conclusion that confusion is likely. Further, applicant notes that, in view of the differences in the goods, these goods travel in different channels of trade, one to retail electronic stores to the general public and the other to audiovisual dealers involved in high-end custom audiovisual equipment selling to large corporations. Applicant states that, despite almost five years of contemporaneous use, there have been no instances of actual confusion, and that the potential for confusion is negligible.

Discussion and Opinion

First, it is clear that there is no issue with respect to priority in this case. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974) and *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991). Not only has opposer made of record its pleaded

**Opposition No. 100,151**

registration, but the testimony indicates that opposer has used its mark since 1984.

Concerning the marks, while it is true that the two marks are not identical, there are obvious similarities, the marks only differing by one letter. The appearance of the marks is very similar, and it is possible that many purchasers, familiar with the ordinary word "roommate" will see applicant's mark as this word, rather than the fanciful and unfamiliar "ROMMATE."

With respect to the goods, we must consider the issue of likelihood of confusion in the context of the identifications in the respective application and registration, and, in the absence of specific limitations, on consideration of all of the normal and usual channels of trade for the respective goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) and *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). We believe that, as described, applicant's "video display apparatus for displaying information contained on photo CD and CD ROM" is not clearly a product that could only be sold in the channels of trade urged by applicant. In cases where there may be some ambiguity concerning the precise nature of the goods identified, we may construe an applicant's description in a manner favorable to the opposer. *Tuxedo Monopoly, Inc.*

**Opposition No. 100,151**

v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) and CTS Corp. v. Cronstoms Manufacturing, Inc., 515 F.2d 780, 185 USPQ 773 (CCPA 1975). Therefore, we see no reason why applicant's goods, which are after all modified photo CD players, could not be sold in retail electronic stores. Of course, these outlets would be the same kind of stores in which opposer's loudspeakers are sold. Furthermore, even if we were to construe applicant's description as militating against the sale of such goods in retail stores, there is no restriction in opposer's registration as to the type of speakers that they are or the channels of trade or class of purchasers of those goods, and they could be sold in the same channels of trade as applicant's equipment for the corporate boardroom. In this regard, there is no dispute that boardrooms and other sites which may use applicant's equipment also use speaker systems, albeit high-end audio systems. Accordingly, opposer's loudspeakers and applicant's video display apparatus could form parts of the same system. Finally, if we had any doubt with respect to the question of likelihood of confusion, that doubt, in accordance with precedent, must be resolved in favor of the prior user and registrant.

**Opposition No. 100,151**

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

E. J. Seeherman

C. E. Walters  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board