

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

SEPT. 27, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Hewlett-Packard Company  
v.  
Packquisition Corporation

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Opposition No. 106,540  
to application Serial No. 75/000,036  
filed on October 2, 1995

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Francine R. Gorowitz of Ladas & Parry for Hewlett-Packard  
Company.

Timothy D. Pecsénye and Eric H. Vance of Blank Rome Comisky  
& McCauley LLP for Packquisition Corporation.

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Before Quinn, Hairston and Wendel, Administrative Trademark  
Judges.

Opinion by Hairston, Administrative Trademark Judge:

On October 2, 1995 Packquisition Corporation filed an  
intent-to-use application to register the mark PACKARD  
TECHNOLOGIES (TECHNOLOGIES is disclaimed) for the following  
services:

Data and information processing in class 35;  
electronic transmission of data and documents  
via computer terminals; electronic transmission  
of messages and data in class 38; and

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data and digital information (media duplication of); conversion from one media form to another media (document data transfer and physical) in class 40.

Registration has been opposed by Hewlett-Packard Company under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used in connection with the above-identified services, would so resemble opposer's previously used and registered mark HEWLETT-PACKARD for a variety of computer products and/or related services, as to be likely to cause confusion. Opposer pleaded ownership of, inter alia, the following registrations:<sup>1</sup>

Registration No. 1,861,560 issued November 8, 1994 for, in pertinent part, "house mark for computers, computer software, data processing and data storage systems and accessories ... facsimile machines;"

Registration No. 1,850,493 issued August 23, 1994 for, in pertinent part, "house mark for computers, computer software, data processing and data storage systems and parts therefor ... facsimile machines; and consulting services in the field of data processing; retail mail and telephone order services for data processing products;"

Registration No. 1,710,346 issued August 26, 1992 (Sections 8 & 15 affidavit filed) for, in pertinent part, "rental and leasing services for data processing equipment, consultation services in the field of data processing;" and

Registration No. 1,014,357 issued June 24,

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<sup>1</sup> Because opposer pleaded ownership of thirteen registrations which cover a wide range of goods and services, we have listed only those registrations and the goods and/or services therein which opposer maintains in its brief are closely related to the services in applicant's application.

1975 (Renewed) for, in pertinent part,

"apparatus used for data acquisition and processing; data acquisition and handling; and computers and data processing systems."

Further, opposer alleges that as a result of its extensive use of the trademark HEWLETT PACKARD in connection with a wide range of computer goods and services, the mark has become famous.

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

The parties have fully briefed the case, but an oral hearing was not requested.

The record consists of the file of the involved application; opposer's notice of reliance on certified copies of its registrations; applicant's notice of reliance on certified copies of its registrations; and the testimony deposition (with exhibits) of applicant's vice-president of operations, Donald C. Disque.<sup>2</sup>

According to the testimony of Mr. Disque, applicant is in the printing business. While applicant's core business is financial printing, e.g., printing prospectuses, reports,

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<sup>2</sup> We note that opposer, in its brief and reply brief, has objected to certain information applicant has attempted to enter into evidence and has renewed certain objections it made during the testimony deposition of Mr. Disque. Suffice it to say that because none of the testimony or information at issue was crucial to our decision herein, we do not find it necessary to rule on each of opposer's objections.

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and offering circulars, applicant also does commercial, municipal, and legal printing. Currently, applicant has

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sales offices in New York and Philadelphia, and a manufacturing facility in Marlton, New Jersey. Applicant promotes its printing services by advertising in publications and mailing brochures to prospective clients. Applicant markets these services through sales representatives who call on current and prospective clients.

According to Mr. Disque, applicant has used the marks PACKARD and PACKARD PRESS in connection with its traditional printing services. However, applicant wishes to "expand [its] products and services to provide [its] customers with other means of processing information - through CD-ROMS and publishing on the Internet - and not [limit itself] just to the paper industry." (Disque deposition, p. 22). Applicant selected the mark PACKARD TECHNOLOGIES to differentiate these new services from its traditional printing services.

Inasmuch as certified copies of opposer's registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to the issue of likelihood of confusion. In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.

With respect to the involved marks, opposer's mark HEWLETT PACKARD and applicant's mark PACKARD TECHNOLOGIES

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create similar commercial impressions. While applicant argues that the inclusion of the word TECHNOLOGIES in its mark helps to distinguish the marks, we disagree. First, while we have considered the marks in their entireties, there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. In this case, we have given more weight to the PACKARD portion of applicant's mark which is identical to PACKARD in opposer's mark. This is so because of the highly suggestive/merely descriptive nature of the disclaimed word "Technologies." See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Also, it is obvious from the goods and services listed in opposer's registrations that opposer's business is in the technology field. Thus, the inclusion in applicant's mark of the word "Technologies," which also suggests/merely describes the field in which opposer does business, does not help distinguish the involved marks.

With respect to the goods and services, we readily acknowledge that opposer's pertinent goods and services and the services in connection with which applicant intends to use its mark are specifically different. However, the test here, is not whether opposer's goods and services and applicant's services are likely to be confused. Rather, the test is whether purchasers are likely to be confused as to

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source, connection or sponsorship of the goods and services. As often stated, it is not necessary that the goods and services be similar or competitive, or even that they move in the same channels of trade to support a likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) and *Hercules Inc. v National Starch and Chemical Corp.*, 223 USPQ 1244, 1247 (TTAB 1984).

In this regard, it has frequently been held that likelihood of confusion may result from the use by different parties of the same or similar marks for goods, on the one hand, and in connection with services which deal with those goods, on the other. See, for example: *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988); *MSI Data Corp. v.*

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Microprocessor Systems, Inc., 220 USPQ 655 (TTAB 1983); and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983).

Further, it is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the goods or services specified in the subject application vis-à-vis those set forth in opposer's registration. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In the present case, opposer's computers, computer software, facsimile machines, computer and data processing systems, and data acquisition systems, in particular, are all goods which would be used with the services in applicant's application, i.e., data and information processing; electronic transmission of data and documents via computer terminals; electronic transmission of messages and data; data and digital information (media duplication); and conversion from one media form to another media (document data transfer and physical). Moreover, because there are no restrictions in applicant's application or opposer's registrations as to channels of trade or classes of purchasers, the distinctions urged by applicant, i.e., that opposer's goods are sold in mass merchandisers and specialty stores, whereas applicant's services will be marketed by sales professionals to well-educated clients, are not well taken. For purposes of our analysis of

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likelihood of confusion, we must assume that both opposer's goods and applicant's services may be marketed in some of the same manners, e.g., by sales professionals, to the same classes of purchasers.

Two other duPont factors, to which the parties have referred, require comment.

Although opposer pleaded that its mark is famous, it offered no evidence in support of this allegation. Mere ownership of a number of registrations is insufficient to establish the fame of a mark. Thus, we cannot conclude, based on the present record, that opposer's mark has achieved the status of a famous mark. Compare: *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Finally, applicant points to the absence of any instances of actual confusion. However, inasmuch as Mr. Disque testified that applicant has not begun to use the mark PACKARD TECHNOLOGIES, there has been no opportunity for confusion to occur. Also, the fact that applicant is aware of no instances of actual confusion between opposer's HEWLETT PACKARD mark and applicant's marks PACKARD and PACKARD PRESS has no bearing on the issue of likelihood of confusion in this proceeding which involves a different mark, i.e., PACKARD TECHNOLOGIES.

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We conclude that purchasers familiar with the above goods and services of opposer sold under the mark HEWLETT PACKARD would be likely to believe, upon encountering applicant's mark PACKARD TECHNOLOGIES for its identified services, that the goods and services originated with or were somehow associated with or sponsored by the same entity.

**Decision:** The opposition is sustained.

T. J. Quinn

P. T. Hairston

H. R. Wendel  
Administrative Trademark Judges  
Trademark Trial and Appeal Board