

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      APRIL 2, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Thyssen Telecom AG<sup>1</sup>

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Serial No. 75/017,336

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LLP for Thyssen Telecom AG

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Before Cissel, Walters and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Thyssen Telecom AG, as owner by assignment, has filed  
an application to register the mark XTEND for "maintenance  
and repairing of apparatus for telecommunications" in Class  
37, and "rental of telecommunications apparatus, namely

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<sup>1</sup> The records of the Assignment Branch of this Office indicate  
that the original applicant, XTEND Gesellschaft fur  
Mehrwertdienste mbH, changed its name to Mediagate Gesellschaft  
fur Multimedia Losungen mbH (recorded at reel 1653, frame 0615),

communications equipment, systems for video conferencing, firewall systems, routers, multiplexers, and telephone PABX's (private automatic branch exchanges) [sic-PABXs]" in Class 38.<sup>2</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if applied to its identified services, would so resemble the registered mark XTEND for "circuits for use in transferring data or electrical signals between two units of computer hardware,"<sup>3</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

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and thereafter assigned the application to Thyssen Telecom AG (recorded at reel 1662, frame 0030).

<sup>2</sup> Application Serial No. 75/017,336, filed November 9, 1995. The application was filed claiming priority under Section 44(d) based on applicant's application No. 395 21 644.3 filed May 23, 1995 in the Federal Republic of Germany. Applicant later submitted a certified copy of German Registration No. 395 21 664, which issued on November 6, 1995, and expires on May 31, 2005. See Section 44(e) of the Trademark Act.

The application originally included goods and services in Classes 9, 37, 38 and 42. Applicant deleted the goods in Class 9; and the Examining Attorney withdrew the refusal to register as to the services in Class 42, which applicant then divided out and the divisional application issued as Reg. No. 2,180,857. This refusal to register relates only to the Class 37 and 38 services.

<sup>3</sup> Reg. No. 1,454,932, issued September 1, 1987, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are October 23, 1983.

We affirm the refusal to register. In reaching our decision we have considered all of the relevant du Pont<sup>4</sup> factors.

The involved marks are identical, and applicant did not argue otherwise.

We turn to a consideration of the cited registrant's goods and applicant's services. Applicant's position is set forth in unnumbered pages 2 - 3 of applicant's November 25, 1996 response to the first Office action, wherein applicant stated as follows:

It is well known that Registrant PYRAMID TECHNOLOGY, a subsidiary of the German company SIEMENS NIXDORF, is primarily in the business of fault-tolerant computing, i.e. two adjacent mainframe computers which operate in parallel, so that if a hardware "crash" or software fault causes one mainframe to cease processing, the parallel "partner" mainframe computer can take over the processing chores, so that an airline reservation system, bank ATM network, or the like, will operate continuously. Such systems typically cost hundreds of thousands of dollars, and the connection between the mainframes is typically local, so Applicant's ID of goods has been amended to emphasize that Applicant's goods are used for remote telecommunications, and would not likely be confused with the fault-tolerant "fail-over" circuits sold by Registrant.

In considering the likelihood of confusion, the **sophistication** of the

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<sup>4</sup> See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

purchasers, the **cost of the goods**<sup>5</sup>, and the **time spent in evaluating** the product before purchase are highly relevant factors. Both Pyramid Technology's goods and Applicant's goods are purchased by highly educated engineers or computer scientists employed by large corporations. One can safely estimate that few of the goods cost under \$5,000 per item, and often much more. These products are bought only after careful specification of performance characteristics of the specific models being purchased, and their compatibility with the other components of the computing/communications systems in which they are intended to be used. Frequently, testing for compatibility is done before the purchase is completed. (emphasis in original)

Further, applicant asserted the following in its brief on appeal (p. 2):

Registrant's goods are used primarily in fault-tolerant computing, and thus are sold to owners of large mainframe computers, who must carefully evaluate them for compatibility and inter-operability with their existing equipment. Similarly, Applicant's services are rendered primarily to corporations, pursuant to contracts which cover an extended period of time. These corporations typically have employees who, before recommending such contracts, carefully evaluate the features and performance records of competing vendors. . . . . In the present case, Registrant sells goods, while Applicant sells services which involve study and contract evaluation by the purchasers. (emphasis in original)

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<sup>5</sup> In this response applicant argued regarding the cited registrant's goods and applicant's Class 9 goods; and then later in the same paper applicant argued that "with regard to [applicant's] services in **classes 37, 38 and 42**, the possibility of confusion is even more remote." (emphasis in original)

The Examining Attorney argues that registrant's goods as identified are broad, and must be presumed to encompass all goods of the type described; and that therefore, the cited registrant's circuits for use in transferring data between two units of computer hardware could include the same type of goods used in or with the telecommunications equipment which applicant intends to offer for rent, and to maintain and repair.

In support of this position, the Examining Attorney submitted the following definitions from Newton's Telecom Dictionary ("The Official Dictionary of Computer Telephony, Telecommunications, Networking, Data Communications, Voice Processing and the Internet") (8th Ed. 1994): (1) "router" as "2. an interface between two networks"; (2) "private automatic branch exchange" as "PABX. A private telephone switch for a business or an organization in which people have to dial '9' to access a local line....."; (3) private branch exchange" as "PBX. Term now used interchangeably with PABX. PBX is a private telephone switching system, usually located on a customer's premises with an attendant console....."; (4) "multiplexer" as "Electronic equipment which allows two or more signals to pass over one communication circuit...."; and (5) "firewall" as "A LAN term. A barrier set up to contain

designated LAN traffic within a specified area....". The Examining Attorney also submitted The Internet Dictionary (1995) definition of "firewall" as "(n) A security measure on the Internet, protecting information, preventing access, or ensuring that users cannot do any harm to underlying systems....".<sup>6</sup> That is, registrant's goods could encompass telecommunications equipment such as firewalls, PABXs, and routers, and applicant offers the services of renting, and maintaining and repairing such items.

In further support of his position as to the relatedness of the respective goods and services, the Examining Attorney submitted seven third-party registrations, which issued on the basis of use in commerce, to show that it is common in the computer and telecommunications industries for companies to offer the goods of registrant and the services of applicant. That is, the third-party registrations identify both telecommunications equipment (which could be included within the broad scope of the cited registrant's goods), and the maintenance, repair and leasing of telecommunications equipment (like applicant's services),

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<sup>6</sup> The Examining Attorney's request that the Board take judicial notice of the dictionary definitions of the term "firewall" is granted. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), and TBMP §712.01.

thereby showing that a single entity has adopted a single mark for both.<sup>7</sup>

It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and *In re International Telephone & Telegraph Corp.*, 197 USPQ

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<sup>7</sup> Some examples of the third-party registrations submitted by the Examining Attorney include the following: (1) Reg. No. 2,014,813 for, inter alia, "low energy electrical circuits for data communication, telecommunications applications, and control engineering, ...electronic computers, computer programs for use in telecommunication and data transfer...", and "installation, assembly and maintenance and repair of data communication circuits, overvoltage and electrical signal detection, modules, printed circuit boards,..."; (2) Reg. No. 1,977,610 for, inter alia, "information processing apparatus, namely, computers, computer peripherals, computer printers, microcomputers...", and "installation and maintenance of computers and telecommunications hardware"; and (3) Reg. No. 1,844,967 for, inter alia, "computer software in the field of telecommunications, computer hardware," "telecommunication services, telecommunications equipment leasing," and "maintenance services for telecommunication equipment for voice, data and video transmission."

910 (TTAB 1978). Also, confusion in trade can occur from the use of similar (or the same) marks for products on the one hand and for services involving those products on the other hand. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Safety-Klean Corporation v. Dresser Industries, Inc.*, 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983), and cases cited therein.

Moreover, in determining the question of likelihood of confusion, the Board is constrained to compare the goods and/or services identified in applicant's application with the goods and/or services as identified in the cited registration. If the parties' respective goods and/or services are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual goods of the applicant and the cited registrant are not similar. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985).

In this case, the cited registration covers "circuits for use in transferring data or electrical signals between

two units of computer hardware," while applicant's services are, essentially, maintaining and repairing telecommunications apparatus, and renting various telecommunications apparatus, such as systems for videoconferencing, firewall systems, routers, mutiplexers, and telephone PABXs.

The function carried out by the goods enumerated in applicant's repair and maintenance services (e.g., PABXs as switching systems, routers as interfacing between networks, multiplexers as allowing two or more signals to pass over one circuit) are precisely the function enumerated in registrant's identification of goods. Thus, the registrant's goods are closely related or are identical to the goods for which applicant intends to offer the services of maintaining, repairing and renting.

The third-party registrations submitted by the Examining Attorney are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. However, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods and/or services emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and

In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Although applicant argued that the registrant's goods and applicant's services are quite different, and that the exact nature of these goods sold by registrant under the mark XTEND is "well known," applicant offered no evidence on these matters as to either its own services, or the cited registrant's goods.<sup>8</sup> Further, applicant argued, without providing evidence, that the trade channels and purchasers are different, and that the purchasers are sophisticated.

Even if we assume that the purchasers are sophisticated, this does not mean that they are immune from confusion as to the origin of these goods and services, especially when sold under the identical mark. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. world Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992).

In addition, applicant has included no restriction to trade channels or purchasers in its identification of goods. Thus, the Board must consider that the parties'

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<sup>8</sup> Inasmuch as this is an ex parte appeal case, the cited registrant has no input into this record. This situation is to be distinguished from that set forth in the inter partes case of *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

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respective goods and services could be offered and sold to the same class of purchasers through all normal channels of trade. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Based on the identity of the marks, the relatedness of registrant's goods and applicant's services, and the similarity of the trade channels and purchasers, we find that there is a likelihood that the purchasing public would be confused when applicant uses XTEND as a mark for the services of renting, maintaining and repairing telecommunications apparatus.

Decision: The refusal to register under Section 2(d) is affirmed.

R. F. Cissel

C. E. Walters

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board