

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/15/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Lucent Technologies Inc.**

Serial No. 75/217,220

W. Drew Kastner for Lucent Technologies Inc.

Angela Lykos, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Managing Attorney).

Before Hairston, Chapman and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Lucent Technologies Inc. to
register the mark ATLANTA for "integrated circuits and
chipsets."¹

The Examining Attorney has refused registration under
Section 2(d) of the Trademark Act on the basis of the previously

¹ Application Serial No. 75/217,220 filed December 17, 1996 based on
Section 1(b) of the Trademark Act.

registered mark SCIENTIFIC ATLANTA for the following goods:²

"Satellite communications ground station equipment-namely, receivers, transmitters, antennas, frequency converters and digital earth terminals; cable television (CATV) equipment-namely, antennas and headend apparatus, coaxial cable, set-top terminals, taps and passives, video receivers and low noise amplifiers; test and measurement instruments-namely, noise and vibration analyzers, wave and spectrum analyzers and antenna testers; electronic instrumentation and automatic test equipment-namely, microwave antenna testers, bit error rate testers and intermediate frequency (IF) noise testers; energy management products-namely, residential and commercial power usage control apparatus; and wireless home security apparatus, alarms, and parts therefor."

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

We reverse for the reasons set forth below.

In any likelihood of confusion analysis, two key considerations are the similarity of the marks and the similarity of the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976), and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Turning first to a consideration of the goods, the Examining Attorney argues that the respective goods are related products despite any asserted sophistication or technical background of

² Registration No. 1,218,938 issued October 28, 1997 on the Principal Register to Scientific-Atlanta, Inc. located in Atlanta, Georgia. The word "ATLANTA" has been disclaimed apart from the mark as shown.

the purchasers. The Examining Attorney has made of record copies of ten third-party registrations to show the adoption of the same mark for both the goods of the type listed in the application and the registration. These registrations indicate that six different entities³ have registered their marks for integrated circuits on the one hand, and at least one of the items listed in the cited registration, on the other. Although these registrations are not evidence that the marks shown therein are in commercial use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein may emanate from a single source. See *In re Albert Trostel & Sons Co.*, *supra*, and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). While the applicant's and registrant's goods are not identical, the registrations provide at least some evidence to show that applicant's integrated circuits and certain communications and electronics equipment provided by registrant are related products, which if sold under the same or similar marks, would result in a likelihood of confusion.

³ We note that the registrations are not all registered to different entities and that they are not all based on use in commerce. One of the registrations issued under the provisions of Section 44(e) of the Trademark Act. Without any use in commerce basis, the probative value of this type of registration is very limited. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Thus, our decision on likelihood of confusion turns on a comparison of the respective marks.

The Examining Attorney argues, in this regard, that ATLANTA and SCIENTIFIC ATLANTA are similar in appearance and commercial impression because of the shared term "ATLANTA." While the Examining Attorney notes the disclaimer in the cited registration and the fact that the "ATLANTA" portion of the registered mark is geographically descriptive, she nonetheless contends that ATLANTA is "arbitrary" with respect to the applicant's goods.⁴ Further, the Examining Attorney argues that the word "SCIENTIFIC" is highly suggestive of the technical goods provided by registrant and has submitted a dictionary definition of that word to support her position.⁵ Thus, the Examining Attorney is arguing, in effect, that the SCIENTIFIC portion of registrant's mark is weak

⁴ In her appeal brief, the Examining Attorney indicated that she did not refuse registration of applicant's mark on the basis that ATLANTA is primarily geographically descriptive because "a goods/place association does not exist in the mind of the public with respect to the city Atlanta and the applicant's [products]." The record, however, does not reflect how the Examining Attorney reached this conclusion since she apparently never inquired as to whether the applicant's goods do or will originate in Atlanta, or whether the goods have or will have any other connection with that geographic place. As the Examining Attorney herself, recognizes, a goods/place association is presumed if the primary significance of a mark is geographic and the applicant's goods come from the place named in the mark. Nevertheless, this refusal was not made by the Examining Attorney, and the issue of geographical descriptiveness of applicant's mark is not before the Board.

⁵ The word "scientific" is defined in *The American Heritage Dictionary of the English Language*, (3rd ed. 1992) as "of or relating to, or employing the methodology of science."

and that the disclaimed geographically descriptive word "ATLANTA" dominates.

Applicant, on the other hand, argues essentially that ATLANTA and SCIENTIFIC ATLANTA create different commercial impressions in view of the geographic meaning of ATLANTA in registrant's mark. We agree.

While marks must be compared in their entireties, one feature of a mark may have more significance than another, and in such a case there is nothing improper in giving greater weight to the dominant feature. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the only common element in the respective marks is the word, "ATLANTA." This word has been disclaimed in the registration and there is no dispute as to its geographic significance in the registered mark.⁶ Contrary to the Examining Attorney's apparent position, such disclaimed or otherwise descriptive matter is generally

⁶ We note the Examining Attorney's argument that the mere addition of a term to a registered mark will not overcome a likelihood of confusion. This, however, is not the situation here, where the applicant's mark has fewer words than the registrant's mark. Further, this may be true if one were to incorporate an arbitrary element of a registered mark into a composite mark. See, for example, *The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977). That is not the case here either. As noted above, the only shared feature of the marks before us is a term which has been disclaimed in the cited registration as geographically descriptive.

viewed as a less dominant or less significant feature of a mark.⁷ See *In re National Data Corp.*, supra and *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986). Thus, we find that the presence of the word ATLANTA in both marks is an insufficient basis on which to find that the marks are similar.

We find instead that the more prominent or distinguishing feature of registrant's mark is the word "SCIENTIFIC" and we believe that purchasers would look to that portion of the registered mark to distinguish source. Although it appears that SCIENTIFIC is suggestive of the registrant's goods, as the Examining Attorney claims, we believe the inclusion of this term in registrant's mark is sufficient to avoid confusion.

⁷ This is particularly true when the descriptive matter is not the first word in the mark. The average purchaser of goods retains only a vague recollection of marks encountered in marketplace, and this recollection may logically be triggered by the first word of a mark, especially if it is word or term not frequently encountered in similar marketing experiences. See *Tony Lama Company, Inc. v. Anthony Di Stefano*, 206 USPQ 176 (TTAB 1980).

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Thus, notwithstanding any relatedness in the goods herein, we find that ATLANTA is not sufficiently similar to registrant's mark SCIENTIFIC ATLANTA as to be likely to cause confusion.

Decision: The refusal to register is reversed.

P. T. Hairston

B. A. Chapman

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board