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Paper No. 23
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hewlett-Packard Company
v.
Packard Press, Inc.
by change of name from Packquisition Corporation¹

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

On Remand From
The U.S. Court of Appeals For The Federal Circuit

Elizabeth A. Sheets of Hewlett-Packard Company for
Hewlett-Packard Company.

Timothy D. Pecsénye of Blank, Rome, Cominsky & McCauley for
Packard Press, Inc.

Before Quinn, Hairston and Wendel, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

The U.S. Court of Appeals for the Federal Circuit, in a
decision dated September 25, 2000, at ___ F.3d ___, 56
USPQ2d 1351 (Fed. Cir. 2000), vacated the Board's September

¹ We note that during the pendency of the appeal Packquisition
Corporation changed its name to Packard Press, Inc.

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27, 1999 decision sustaining the opposition of Hewlett-Packard Company to registration of the mark PACKARD TECHNOLOGIES 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 data and digital information (media duplication of); conversion from one media form to another media (document data transfer and physical) in class 40.

The Court remanded the case to the Board to: (1) make findings as to the similarity/dissimilarity in the appearance, sound and connotation of the marks HEWLETT-PACKARD and PACKARD TECHNOLOGIES as a whole, and explain any rational reasons for emphasizing a particular portion of these marks; (2) state findings on the relatedness of opposer's goods/services and applicant's services, and (3) apply the proper legal test in determining whether opposer's goods/services and applicant's services are related.

We turn first to a consideration of the marks HEWLETT-PACKARD and PACKARD TECHNOLOGIES. Despite the obvious differences in appearance and sound of these marks as a whole, we remain of the view that the marks create similar commercial impressions. We readily acknowledge that the marks must be compared in their entirety. However, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in

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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." In re National Data Corp., 753 F.3d 1056, 24 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a particular portion of a mark . . ." 224 USPQ at 651.

Here, the disclaimed term TECHNOLOGIES in applicant's mark PACKARD TECHNOLOGIES is highly suggestive/descriptive of applicant's services. Thus, when applicant's mark is considered as a whole, it is the term PACKARD which is the dominant and distinguishing element thereof. See e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) [DELTA is the dominant portion of the mark THE DELTA CAFÉ and design because the disclaimed word CAFÉ is generic of applicant's restaurant services.] Thus, the dominant element of applicant's mark is identical to the term PACKARD which is a prominent element of opposer's mark.

Also, in this case, the inclusion of the term TECHNOLOGIES in applicant's mark results in greater similarity in overall commercial impression between the marks because, as evidenced by the services listed in the pleaded registrations, opposer's business is in the

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technology field. Further, in reaching our finding that the marks are very similar in overall commercial impression, we have considered the fact that there is no evidence of record of third-party use of the term PACKARD for any of the involved goods and services. See *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973) [One of the factors to be considered in determining likelihood of confusion is "the number and nature of similar marks in use on similar goods."].

We turn next to a consideration of the parties' respective goods and services. We note at the outset that opposer took no testimony and offered no evidence other than copies of its pleaded registrations. We have no testimony or other evidence in this case as to the relationship between opposer's goods and services and applicant's services. In other words, there is no evidence that goods and services of the type involved herein would be expected by the consuming public to emanate from the same source. Rather, we simply have the blanket assertions of opposer, in its brief on the case, that its goods and services and applicant's services are "closely related or identical" and

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"could be used in conjunction [with each other]." (Brief, p. 16).² Although, at first blush, the goods/services of the parties would appear to be at least tangentially related, opposer failed to present any evidence with respect to the identity/relatedness of the parties' goods/services. In particular, there is no evidence that goods/services of the type involved herein are offered by the same companies. Nor is there evidence regarding precisely how opposer's goods and services and applicant's services would be used together and/or would be encountered by the same classes of purchasers. Upon further review, we are unable to conclude simply from the identification of goods/services in opposer's registrations and the recitation of services in applicant's application that such goods/services are sufficiently related to support a finding of likelihood of confusion.

In sum, notwithstanding the similarities in the overall commercial impressions of the marks HEWLETT-PACKARD and

² For example, opposer asserts: "The Class 36 services listed in the opposed application are: data and information processing. These services are closely related or identical to the following goods and services of Opposer, which all relate to the processing of data and/or information: programs for use in information manipulation; apparatus used for data acquisition and processing; data acquisition and handling systems; computers and data processing systems; rental and leasing services for data processing equipment; consultation services in the field of data processing; and retail mail and telephone order services for data processing products."

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PACKARD TECHNOLOGIES as a whole, we find that there is no likelihood of confusion in this case because opposer has failed to establish that the goods and services involved herein are related in the mind of the consuming public as to their source or origin.

Decision: The opposition is dismissed.

T. J. Quinn

P. T. Hairston

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