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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Digi International Inc.

v.

ControlNet, Incorporated

Opposition No. **111,240**
to application Serial Nos. 75/185,410 and 75/185,625
filed on **October 22, 1996**

**Marsha Stolt, Jana L. France, Stephen R. Baird and
Stephen C. Lee** of Fish & Richardson P.C. for Digi
International Inc.

**Jonathan O. Scott of Hickman Beyer & Weaver LLP for
ControlNet, Incorporated**

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by **Seeherman**, Administrative Trademark Judge:

Digi International Inc. has opposed Controlnet,
Incorporated's applications to register DIGIHOME¹ and
DIGIWIRE,² both filed on October 22, 1996 on the basis of

¹ Application Serial No. 75/185,410.

² Application Serial No. 75/185,625.

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a bona fide intention to use the mark in commerce, for "computer software for the development, design and manufacture of semiconductor cores and integrated circuits; semiconductor cores, integrated circuits and integrated circuit subassemblies for use with computer network protocols" in Class 9, and "design of semiconductor cores, integrated circuits and computer software for use by the computer communications and computer networking industries."

As grounds for opposition opposer has alleged that it manufactures and sells, under the housemark DIGI, computer connectivity hardware and software, and provides, under the DIGI mark, various services connected with such goods, including installation, maintenance, repair, training, technical support and design. Opposer has further alleged that it owns registrations for the marks DIGIBOARD, DIGI and design and DIGI INTERNATIONAL, all for use in connection with various types of computer connectivity hardware and software; that it has been using the formative DIGI in connection with computer connectivity hardware and software and associated services since 1985, and has applied to register the mark DIGIFAX, DIGI BOARD CLASSIC, DIGI and DIGI (stylized)

prior to the filing date of applicant's applications; that opposer owns a family of DIGI marks; and that applicant's use of DIGIHOME and DIGIWIRE for its identified goods and services, particularly because they are used with computer network protocols, is likely to cause confusion or mistake or to deceive.

In its answer applicant denied all the salient allegations of the notice of opposition, admitting only that the pleaded registrations issued, and that the applications were filed.

The record includes the pleadings and evidence submitted by opposer under a notice of reliance. The evidence consists of certified status and title copies of opposer's pleaded registrations and of the registrations issuing from its pleaded application for DIGI CLASSICBOARD and an unpleaded application for DIGI CONNECTS and design,³ as follows:

DIGIBOARD	microcomputer hardware and computer programs for use in communications ⁴ ;
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³ Although opposer made no mention of a pending application for this mark in its notice of opposition, in its requests for admission it made specific requests relating to likelihood of confusion with this mark and pending application. Accordingly, we deem that the issue of likelihood of confusion with respect to this mark was tried, and therefore deem the pleadings to be amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure.

⁴ Registration No. 1,666,495, issued December 3, 1991; Sections 8 and 15 affidavit filed.

microcomputer circuit boards and peripherals for use in connection with multi-user systems and local area networks; and microcomputer software, namely, software for operating such microcomputer hardware, software for terminal emulation, software for data communications in multi-user systems, software for data communications in local area networks and software for remote local area network access⁵;

DIGI INTERNATIONAL
(INTERNATIONAL
peripherals,
disclaimed)
for

microcomputer hardware, circuit boards, microcomputer

and software, namely, software

operating such microcomputer hardware, software for terminal emulation, software for data communications in multi-user systems, software for data communications in local area networks, and software for remote local area network access, all for use in data communications⁶;

DIGI CLASSICBOARD

computer network connectivity hardware and software⁷; and

computer hardware and software for data communications and hardware and software designed to operate with data communications products.⁸

⁵ Registration No. 2,019,613, issued November 26, 1996.

⁶ Registration No. 2,132,925, issued January 27, 1998.

⁷ Registration No. 2,176,760, issued July 28, 1998.

⁸ Registration No. 2,193,984, issued October 6, 1998.

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Opposer has also submitted, under a notice of reliance, copies of the interrogatories, document production requests and requests for admission that it served on applicant, along with a declaration by its attorney attesting to applicant's failure to respond thereto. The interrogatories and requests for production of documents have no evidentiary value. (Opposer never made a motion to compel; further, even if applicant had provided responses to the document production requests, such responses cannot be made of record by notice of reliance. See Trademark Rule 2.120(j)(3)(ii).) However, Rule 36(a) of the Federal Rules of Civil Procedure (made applicable to Board proceedings by Trademark Rule 2.116(a)) provides that the matter of which an admission is requested is deemed admitted unless, within 30 days after service of the request, the party to whom the request is directed serves upon the requesting party a written answer or objection. Because applicant made no response whatsoever to the requests for admission, we deem all the matters contained therein to be admitted.

Applicant did not submit any evidence. Only opposer filed a brief. An oral hearing was not requested.

Priority is not in issue in view of opposer's submission of its pleaded registrations and the

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registrations which issued from its applications, as set forth above. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Because opposer did not submit any evidence with respect to its alleged family of DIGI marks, we must consider the question of likelihood of confusion with respect to the individual marks. Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant has admitted that its goods and services are closely related to the goods identified in each of opposer's registrations; that applicant's goods and services are in the same field, and that its DIGIWIRE and DIGIHOME products will be sold in the same or similar channels of trade as are opposer's computer network connectivity hardware and software products provided under its various DIGI marks; and that there is overlap of the potential purchasers of opposer's identified products provided under its DIGI marks and the potential purchasers of applicant's products and services offered under the marks DIGIWIRE and DIGIHOME. Essentially, then, we are dealing with closely related goods and/or

services, sold through the same or similar channels of trade, and to the same purchasers.

We further find that applicant's marks are very similar to opposer's various DIGI marks. DIGI is clearly the dominant part of each of opposer's marks. It is the sole verbal element of DIGI and design, and therefore the portion that consumers are more likely to note and remember. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). In the other marks, the additional words have a suggestive or descriptive connotation, such that DIGI would have the stronger source-identifying role.

DIGI is also the dominant portion of applicant's marks; it is the beginning element, and it is followed by words with a descriptive or suggestive connotation in connection with applicant's identified goods and services. Moreover, applicant has admitted that it is not aware of any third-party uses of a DIGI-containing mark in connection with computer network connectivity hardware and software, nor is there any evidence of such use or registrations in the record.

For the foregoing reasons, we find that applicant's use of the marks DIGIWIRE and DIGIHOME in connection with its identified goods and services would be likely to

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cause confusion with opposer's registered marks DIGI and design, DIGI INTERNATONAL, DIGIBOARD, DIGICLASSICBOARD and DIGI CONNECTS and design.⁹

We would also point out that applicant has admitted that "[o]pposer's DIGI mark is well known in connection with computer network connectivity hardware and software" (Admission No. 30) and that it is a strong mark when used in connection with such goods.¹⁰ Admission No. 32. Giving the appropriate weight to this factor in the likelihood of confusion analysis, the case for finding likelihood of confusion is even stronger with respect to opposer's DIGI and design mark.

Decision: The opposition is sustained.

E. J. Seeherman

T. J. Quinn

⁹ In reaching this decision we have noted applicant's admission that applicant's use of the marks DIGIWIRE and DIGIHOME would be likely to cause confusion with "Opposer's above identified Digi marks." Requests for Admission Nos. 25 and 26. We point out that the issue of likelihood of confusion is a matter of law, and must be determined by the Court; thus, although admissions by a party may be considered in reaching this determination, the ultimate decision must rest with the trier of fact.

¹⁰ We have assumed that the reference in the requests for admission is to opposer's mark DIGI and design, since the other pleaded marks include other wording.

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