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Paper No. 13  
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10/11/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Digi International Inc.

v.

Universal Design, Inc.

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Cancellation No. 27,183  
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Marsha Stolt of Fish & Richardson P.C. for Digi International Inc.

John S. Hale of Gipple & Hale for Universal Design, Inc.

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Before Hairston, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Digi International, Inc. has filed a petition to cancel a registration owned by Universal Design, Inc. for the mark DIGI-FAX for "digital facsimile transmission machines."<sup>1</sup>

As its ground for cancellation, petitioner asserts priority and likelihood of confusion under Section 2(d) of the Trademark Act, contending that respondent's mark when applied to respondent's goods so resembles petitioner's previously

used mark DIGIFAX for its "computer network connectivity hardware and software" as to be likely to cause confusion. Petitioner alleges that respondent did not begin use of its DIGI-FAX mark until February 19, 1992, long after petitioner's February 26, 1991 claimed date of first use.

Respondent, in its answer, denied the salient allegations in the petition to cancel.<sup>2</sup>

The record includes the pleadings; the file of the involved registration; evidence made of record by notice of reliance; and the testimony with exhibits of John Gaylord, petitioner's Director of Corporate Strategy and Susan Marie Chapman, petitioner's Financial Analyst. Respondent did not take testimony or offer any other evidence. Only petitioner filed a brief. An oral hearing was not requested.

Petitioner claims, and the evidence shows, that its mark DIGIFAX is used on facsimile systems comprised of menu-driven software and single or double modem facsimile boards used to transmit facsimile messages from a desktop PC. The invoices and packing slips identified by Ms. Chapman demonstrate that petitioner has continuously used DIGIFAX to identify these

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<sup>1</sup> Registration No. 1,894,861, issued May 23, 1995, claiming dates of first use and first use in commerce on February 19, 1992 and May 13, 1992, respectively.

<sup>2</sup> Respondent also affirmatively asserted defenses of laches, estoppel and abandonment of petitioner's mark but did not pursue these defenses. Accordingly, we deem those defenses to have been waived.

products since at least as early as February 26, 1991. In responses to admission requests, respondent admitted that it did not use its DIGI-FAX mark on the identified goods prior to that date. In any event, petitioner has demonstrated use of its mark prior to the September 2, 1993 filing date of respondent's underlying application, which, in view of the absence of other evidence, is the earliest date on which respondent is entitled to rely.

We turn then to a consideration of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

With respect to the marks, respondent has admitted in its responses to admission requests that the respective marks are identical in sound, and virtually identical in appearance. We agree, and it is also clear that the marks have the same meaning. Petitioner's mark is the two-syllable word DIGIFAX. Respondent's mark DIGI-FAX is the same two-syllable word either joined or separated by a hyphen. Whatever its function, the hyphen is an insignificant feature of respondent's mark which does nothing to distinguish its mark

from petitioner's mark or to alter the meaning conveyed by both marks.

Turning our attention to the goods, we note that it is not necessary that the goods of the parties be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Based on the record, it is clear that respondent's fax machines and petitioner's hardware (fax modem boards) and menu-driven software which enables users to send and receive faxes from a desktop PC (without printing out a hard copy), are closely related, if not competitive, products. The essential purpose of these products is identical; both are used to allow fax receipt and transmission of printed or graphic matter. In view of the unrestricted nature of respondent's identification of goods, we must presume that the respective products travel in the same channels of trade to the same classes of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813

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(Fed. Cir. 1987) and *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Moreover, the fact that the purchasers of the parties' goods would include those who are, for the most part, discriminating and knowledgeable in the field, such as value-added resellers and systems integrators, would not preclude the likelihood of confusion. The respective marks and products in this case are so similar that even knowledgeable purchasers are likely to believe the goods come from the same source.

Finally, we note that respondent, in at least two written communications, has charged petitioner with infringement of respondent's DIGI-FAX mark. If we had any doubt as to the likelihood of confusion in this case, which we do not, those doubts would be resolved by the admissions of likelihood of confusion contained in those communications. See, for example, *Ultra Electronics, Inc. v. Workman Electronic Products, Inc.*, 192 USPQ 497 (TTAB 1976).

**Decision:** The petition to cancel is granted, and Registration No. 1,894,861 will be cancelled in due course.

P. T. Hairston

H. R. Wendel

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