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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **PageMart, Inc.**

Serial No. 75/366,221

William A. Munck of Novakov Davis for PageMart, Inc.

Melvin T. Axilbund, Trademark Examining Attorney, Law
Office 113 (Meryl Hershkowitz, Managing Attorney)

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

PageMart, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register SCOUT as a trademark for "message pagers and personal communication systems, namely, two-way pagers; and two-way pager cards."¹ This is the identification submitted by applicant with its request for reconsideration, and the identification which

¹ Application Serial No. 75/366,221, filed October 1, 1997, based on an asserted bona fide intention to use the mark in commerce.

the Examining Attorney accepted. It is noted that applicant, in both its appeal brief and reply brief, has referred to the goods as "message pagers and personal communications systems, namely, two-way pagers and two-way pager cards," despite the fact that the Examining Attorney pointed out in his brief the discrepancy in punctuation with the identification which is of record. Our decision herein is based on the identification which the Examining Attorney accepted, although we agree with the Examining Attorney that the punctuation differences found in the identifications recited by applicant in its briefs have no effect on the outcome of our decision.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the following marks, registered to two separate entities, that, if used on applicant's identified goods, it would be likely to cause confusion or mistake or to deceive.

SCOUT for digital computers²; and

SCOUT for wireless microphones and wireless receivers.³

² Registration No. 1,238,102, issued to Computer Automaton, Inc. on May 17, 1983; Section 8 affidavit accepted; Section 15 affidavit received.

³ Registration No. 1,813,481, issued to TOA Corporation on December 28, 1993; Section 8 affidavit accepted; Section 15 affidavit received.

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The appeal has been fully briefed; an oral hearing was not requested.

Our determination 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Food, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the refusal based on Registration No. 1,813,481 for SCOUT for wireless microphones and wireless receivers, there is no question that the marks are identical. As for the goods, the Examining Attorney has submitted a dictionary definition showing that a "pager" is "a small one-way (typically) wireless receiver you carry with you." This definition goes on to state that "[m]any pagers and pager networks now include an 'acknowledgment' feature, which allows you to press a button to acknowledge the receipt of the page through two-way communications capability." Newton's Telecom Dictionary, 15th ed., 1999. This same dictionary defines "receiver" as, inter alia, "any device which receives a transmission signal" and "any portion of a telecommunications device which decodes an

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encoded signal into its desired form." In addition, the Examining Attorney has made of record several third-party registrations which show that other entities have registered their marks both for wireless receivers and pagers, for example, radio pagers and wireless receivers⁴; wireless receivers and transmitters, paging radio receiving units, and radio paging transmitting units⁵; radio pager cards, namely personal computer memory cards for use with wireless receivers or radio pagers⁶; and computer hardware and software, namely pagers and wireless receiver devices for use in the field of radio transmission of textual data such as messages.⁷ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Applicant appears to take the position that because its goods do not include wireless microphones, there can be no likelihood of confusion. However, it is not necessary, in order to support a finding of likelihood of confusion,

⁴ Registration No. 2,270,986.

⁵ Registration No. 1,449,412.

⁶ Registration No. 1,912,366.

⁷ Registration No. 2,044,128.

that likelihood of confusion must be proved with respect to each of the goods listed in the cited registration; if applicant's mark is likely to cause confusion with any of the goods or services identified in the cited registration, refusal of registration pursuant to Section 2(d) is appropriate.

In this case, we find that applicant's mark SCOUT is likely to cause confusion with the registered mark SCOUT as used for wireless receivers. As shown by the dictionary definition, a pager is a type of wireless receiver. Moreover, applicant has acknowledged that its one-way pagers include an integrated receiver. Appeal brief, p. 6. We recognize that, as identified in the application, applicant's goods do not include all pagers, but are specifically two-way pagers, and therefore they are not simply wireless receivers⁸; indeed, applicant describes them as containing a transceiver (combination transmitter and receiver). However, one-way pagers (wireless receivers) and two-way pagers are so closely related that, if sold under the identical mark SCOUT, they will be assumed to emanate from the same source.

⁸ In point of fact, applicant throughout its briefs has stated that its message pagers include "portable, conventional one-way communication devices." Reply brief, p. 2. However, applicant's identification lists its pagers as "two-way pagers," and our determination herein is based on the identification.

Applicant has asserted that the channels of trade for the goods are different, and the purchasers of its products are careful. Applicant bases this assertion on the fact that it intends its goods to be used by subscribers to applicant's wireless messaging services, that is, that its pagers and pager cards may only be purchased by parties subscribing to its messaging services. Accordingly, applicant asserts that its services and related goods will be purchased only after careful inspection and not on impulse because "the decision to select a message paging service provider is similar to the decision to select a long distance company." Brief, p. 9.

The difficulty with applicant's argument is that its identification of goods does not limit their sales to customers who purchase applicant's messaging services. It is well settled that the determination of likelihood of confusion must be based on a consideration of the goods as they are identified in applicant's application and the cited registration. **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976); see also, **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we must assume that the goods are sold in all channels of trade appropriate for goods of this type. Accordingly, we must deem applicant's pagers to

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be sold in the same channels of trade as the registrant's wireless receivers. Such channels could include consumer electronics stores, in which case the asserted care with which a consumer would choose a messaging service would be irrelevant. Further, even if we assume that the two-way pagers are not impulse purchases, even a careful purchaser would not be able to distinguish between identical marks. As noted above, given the close relationship between one-way and two-way pagers, consumers are likely to assume that both types of pagers sold under the identical mark SCOUT emanate from a single source.

Applicant has argued that SCOUT is not a strong mark, and the cited registration should be given only a limited scope of protection. It bases this argument on references to certain third-party registration which it lists in its appeal brief. The Examining Attorney has objected to these registrations, which he points out were never made of record during the examination phase of this application. The Examining Attorney's objection is well taken, and we have not considered the registrations. See Trademark Rule 2.142(d).

For the foregoing reasons, we find that applicant's mark SCOUT, if used for the identified "message pagers and personal communication systems, namely, two-way pagers," is

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likely to cause confusion with the mark SCOUT, registered for wireless receivers.

This brings us to a consideration of the question of likelihood of confusion with respect to Registration No. 1,238,102 for SCOUT for digital computers. Again, the marks are identical, so we focus our attention on a comparison of the goods.

In support of his position that the goods are related, the Examining Attorney has submitted excerpts from U.S. Patent No. 5,905,777 that indicates a pager card may be used with a computer, to wit:

In response to the selection signal, the server sends a wakeup signal to the pager card attached to the recipient's computer. The wakeup signal sufficiently identifies the E-Mail message waiting on the server, to enable the computer to logon and request the message.

In another embodiment, the server transmits an alert signal over the wireless paging network to a pager card attached to the recipient's computer.

The Examining Attorney also points to another application filed by applicant which includes, in the identification, "two-way pager cards for use with desktop computers."⁹

⁹ Application Serial No. 75/366,142.

Although this evidence shows that pager cards may be used with computers, we must recognize that, given the ubiquitous role that computers play in daily life, many items are designed to be used with computers. That fact alone is not a sufficient basis for us to find that two-way pager cards and digital computers are related products. Nor do we find that the third-party registrations referenced by the Examining Attorney¹⁰ support a conclusion that computers and pager cards are related goods which may be sold by the same entity under the same mark.

Accordingly, based on the record before us, we cannot find that applicant's mark, if used for its identified goods, is likely to cause confusion with Registration No. 1,238,102 for SCOUT for digital computers.

¹⁰ The specific registrations include in their identifications "paging information computers" and "radio paging transmitting units" (Registration No. 1,449,412); "radio pager cards, namely personal computer memory cards for use with wireless receivers or radio pagers" (Registration No. 1,912,366); and "computer hardware and software, namely radio transmission software, pagers, and wireless receiver devices, all for use in the field of radio transmission of textual data such as messages, news, and other information" (Registration No. 2,044,128).

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Decision: The refusal of registration based on Registration No. 1,813,481 is affirmed; the refusal of registration based on Registration No. 1,238,102 is reversed.

R. L. Simms

R. F. Cissel

E. J. Seeherman
Administrative Trademark Judges
Trademark Trial and Appeal Board