

7/20/01

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 31
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Integrated Device Technology, Inc.

v.

Management Science Associates, Inc.

Opposition No. 115,082
to application Serial No. 75/510,183
filed on June 29, 1998

Steven F. Lincoln of Skjerven, Morrill, MacPherson,
Franklin & Friel, LLP for Integrated Device Technology,
Inc.

Jon G. Hogue and George F. Pomper of Hogue & Lannis for
Management Science Associates, Inc.

Before Seeherman, Quinn and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Integrated Device Technology, Inc. has opposed the
application of Management Science Associates, Inc. to
register IDT as a trademark for "computer software for
use in the transfer of files via global computer

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information networks."¹ Opposer has brought this opposition on the ground of likelihood of confusion, alleging that opposer designs, manufactures, sells and distributes integrated circuits, microprocessors, logic devices, networking products and communication memories; that it has used its IDT trade name and trademark to identify its company and its products and services since as early as June 1980; that it owns three trademark registrations for IDT and design marks, and a trademark application for IDT and design; that applicant's mark is identical to opposer's trade name and trademark, that opposer uses its IDT mark with software and other goods that are closely related to applicant's, and that the parties' goods are purchased by the same class of purchasers through similar channels of trade; and, as a result, applicant's use of its mark is likely to cause confusion or mistake or to deceive.

Applicant has denied the salient allegations of the notice of opposition in its answer.

The case has been fully briefed;² an oral hearing was not requested.

¹ Application Serial No. 75/510,183, filed June 29, 1998, and asserting a bona fide intention to use the mark in commerce.

² With its appeal brief applicant has submitted a copy of a Board decision marked "This opinion is not citable as precedent of the TTAB." In its reply brief opposer objected to the

With certain exceptions, the parties are in agreement as to what constitutes the record, which is set out at pages 3 and 4 of opposer's brief, and pages 2 and 3 of applicant's brief. We now address the exceptions. On January 8, 2001, after the filing of opposer's main brief on the case, applicant filed a "Second Notice of Reliance under Rule Regarding Judicial Notice." Technically this is not a notice of reliance, which would be manifestly untimely because applicant's testimony period had closed more than three months earlier. We therefore view it as a request that we take judicial notice of the materials submitted with the notice. The materials consist of third-party registrations of trademarks taken from the USPTO electronic files, and excerpts from forms filed with the U.S. Securities and Exchange Commission (SEC). We decline to judicially notice these materials. It is well established that the Board does not take judicial notice of registrations that reside in the Patent and Trademark Office. **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974). Nor are filings with the SEC the kind of evidence of which the Board takes judicial notice.

inclusion of this document. Opposer's objection is well taken, and the non-citable decision has not been considered.

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On January 19, 2001, on the same date opposer filed its reply brief on the case, opposer, too, filed a "Second Notice of Reliance re Rule Regarding Judicial Notice." Again, this is not technically a notice of reliance, which would be manifestly untimely, but a request that the Board take judicial notice of the submitted materials, which consist of printouts of pages from applicant's Web site. The Board does not take judicial notice of such material. Further, to consider such material, after applicant's brief on the case has been filed, and applicant has no opportunity to respond, would be prejudicial.

Accordingly, neither of the so-called second notices of reliance have been considered.

Applicant has also objected to, and has moved to strike, five exhibits and related testimony which were introduced by opposer during the cross-examination of applicant's witness Paul Grubbs. These exhibits consist of pages which opposer asserts were downloaded from applicant's Web site. Applicant contends that these exhibits were not properly authenticated by the witness as being from applicant's Web site, nor is there evidence to show that Mr. Grubbs had personal knowledge of the matters contained in the exhibits. Opposer has opposed

the motion, and applicant has filed a reply brief in support of it.

We grant applicant's motion to the extent that Exhibits 5, 6, 7, 9 and 12, and testimony relating solely to the contents of those exhibits, have not been considered. These exhibits were never properly authenticated by the witness. For example, with respect to Exhibit 6, at the deposition it was opposer's attorney who stated that "what's been marked as Exhibit 6 is again another collection of pages from MSA's Web site..." Grubbs dep., p. 48. Mr. Grubbs was never asked if he recognized the document as being from the Web site; he was simply asked to look at the document to determine whether the statements made in it were correct.³ With respect to Exhibit 12, even opposer acknowledges that "Mr. Grubbs did not expressly authenticate Exhibit 12, nor did he seem to have much knowledge about the four trade shows or events listed in that exhibit." Opposer's brief in opposition to the motion to strike, p. 12. There are similar problems with respect to authentication of the remaining exhibits as well.

³ It should be noted that Mr. Grubbs's testimony in this regard was that he was not familiar with the services provided by the division.

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Further, the Board is not persuaded by opposer's arguments to find these exhibits admissible under the provisions of Rules 901(4) and 902(7) of the Federal Rules of Evidence. See **Raccioppi v. Apogee Inc.**, 47 USPQ2d 1368 (TTAB 1998).⁴

However, to the extent that Mr. Grubbs' testified as to his own knowledge regarding the contents of the exhibits in question, that testimony is admissible. (It would appear that applicant's motion to strike does not apply to such testimony in any case, in view of applicant's attorney's agreement with the statement made by opposer's attorney at Mr. Grubbs' deposition, that "even if certain exhibits are struck, any testimony from the witness that's based on his own knowledge and not necessarily on what's contained in those exhibits is not going to be struck."

The record, then, consists of the pleadings; the file of the opposed application; applicant's responses to certain of opposer's interrogatories, and opposer's responses to certain of applicant's interrogatories, submitted by the respective parties under notices of reliance; the affidavit testimony, with exhibits, of opposer's witnesses Phil Bourekas, Isabelle McAndrews and

⁴ Even if the exhibits and all appurtenant testimony were

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applicant's witnesses Paul Grubbs and Joseph Delval, and the rebuttal testimony affidavit of Alisa Johnson;⁵ and the cross-examination depositions, with exhibits, of Phil Bourekas, Isabelle McAndrews, Paul Grubbs⁶ and Joseph Delval.

Isabelle McAndrews testified as to the current status and title of opposer's pleaded registrations, and also made of record its registration which resulted from the application asserted in the notice of opposition. Accordingly, we deem the pleadings to be amended to include the latter registration. The record shows that opposer owns the following registrations:

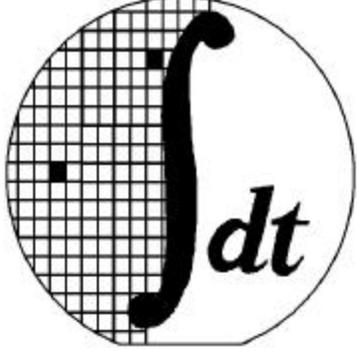
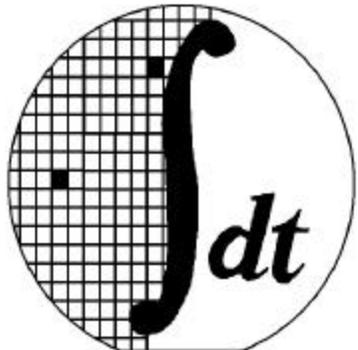
Mark	Goods
	Random access memory apparatus ⁷

considered, it would not change the result in this case.

⁵ The parties stipulated that affidavit testimony could be submitted. In view of the parties' agreement that Ms. Johnson's affidavit forms part of the record, we need not determine whether her testimony would constitute proper rebuttal.

⁶ Consistent with our discussion above, the only exhibits of record submitted with Mr. Grubbs' testimony are Exhibits Nos. 1, 2 and 4.

⁷ Registration No. 1,244,288, issued July 5, 1983. Section 8 affidavit accepted; Section 15 affidavit received. The registration bears the statement, "The mark comprises a circular design within which is the semiconductor grid design and mathematical integral sign and the letters 'dt'." Further, no claim is made to the exclusive right to use the design of a mathematical semiconductor grid or a mathematical integral sign, apart from the mark as shown.

	
	<p>Electronic semiconductor components, namely random access memories, programmable read only memories; bit-slice apparatuses; microprocessors; sequencers; error detection and correction apparatuses; register files; support chips; multipliers; analog-to-digital converters; and binary counters.⁸</p>
<p>Mark</p>	<p>Goods</p>
	<p>Electronic semiconductor components, namely random access memories; programmable read only memories; bit-slice apparatuses; microprocessors; sequencers; error detection and correction apparatuses; register files; support chips; multipliers; analog-to-digital converters; and</p>

⁸ Registration No. 1,542,345, issued June 6, 1989. Section 8 affidavit accepted; Section 15 affidavit received. The registration bears the statement "The mark comprises the stylized letters 'IDT' and design."

	to-digital converters; and binary counters. ⁹
	Semiconductor devices, semiconductor memory modules, computer programs for use in the design and application of semiconductor devices, microprocessors, and microcontrollers. ¹⁰

The evidence opposer has provided regarding its use of its mark and trade name is relatively sketchy. For example, opposer never provided specific testimony as to the date on which it began using its trade name or any of its four trademarks, relying only on the date of first use indicated in each of the trademark registrations. However, the date of use listed on a certificate of registration, which merely reflects the date of first use provided by the registrant in its application, is not evidence that the mark was actually used on that date. See Section 7(b) of the Trademark Act, for the presumptions provided by a certificate of registration. Opposer's evidence is also vague with respect to the specific marks used on any of its goods. Throughout Mr.

⁹ Registration No. 1,542,346, issued June 6, 1989; Section 8 affidavit accepted; Section 15 affidavit received. The registration bears the statements, "The lining in the mark are inherent elements of the mark and are not intended to indicate color" and "the mark comprises the stylized letters 'DT' within a circular design which contains two dots."

¹⁰ Registration No. 2,300,863, issued December 14, 1999.

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Bourekas' testimony he refers to the IDT marks without indicating the particular mark involved. Further, no exhibits showing actual trademark have been submitted. The only exhibit opposer has submitted, aside from its registrations (and the exhibits as to applicant's activities) consists of several press releases. However, the testimony pertaining to these releases merely states that the releases describe certain of opposer's recently developed products; there is no information as to the distribution of the releases.

Similarly, although opposer has submitted testimony that it engages in print advertising, it has not provided any information as to the publications in which it advertises.

Priority is not in issue in view of opposer's registrations. See **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Accordingly, we turn our attention to the issue of likelihood of confusion. In determining this question, we have looked to the evidence submitted in connection with the factors enunciated in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Considering first the factor of fame, we cannot agree with opposer that the mark IDT is famous. The

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basis for its claim is that "by virtue of that longstanding and continuous use—domestically and internationally—Opposer has established the 'IDT' mark as a prominent and recognizable trademark..." Brief, p. 19. To establish this claim opposer relies on its three registrations (Nos. 1,244,288; 1,542,345 and 1,542,346) which claim first use dates of 1982. As noted above, the dates of use recited in a trademark registration are not evidence of use of the mark. In any event, even testimony that a mark has been used for twenty years is not, by itself, sufficient to demonstrate fame of a mark since minimal sales over a twenty-year period would not, in general, support a finding of fame. In this case, opposer has not provided any information at all as to the amount of sales of goods under any of the IDT marks from which we could conclude that the consuming public regards IDT as a famous mark. Similarly, opposer has not shown that it has engaged in substantial advertising efforts which would demonstrate the fame of its marks. The affidavit of Alisa Johnson states that the company "ran a RISC family of products advertisement twenty-four times in Calendar Year (CY) 1993 and eight times in CY 1994" and that it "also ran an Orion (evaluation board/kit) advertisement fourteen times in CY 1994 (and likely in CY

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1995)." Paragraph 3. It is not clear from this affidavit whether the products advertised even showed or were sold under any of the IDT trademarks pleaded herein, as opposer did not submit these advertisements as exhibits. Nor did opposer provide information as to which publications these print advertisements appeared in, or indicate whether it produced any print advertisements after 1995 (Ms. Johnson's affidavit is dated June 23, 2000). The other information regarding opposer's advertising efforts is that it "distributes 'price books' to its customers and potential customers four times a year" (with no indication as to how many of such books were distributed, or for how many years, or even whether any or all of the pleaded IDT marks were featured in the price books); that it has maintained a web page "for several years" (again, there are no specifics as to the years the web page has been in existence, or the number of "hits" it has received); that it has used point of purchase materials such as manuals or documentation for some of its products (with no indication as to how many pieces have been distributed); and that it conducts displays at trade shows, roadshows, and seminars, including, in 1994 and 1997 "datacom seminars, featuring RISC products, in many cities" at a

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total cost of \$732,000; and that it "also presented its RISC products at roadshows in many cities, likely in 1992 and 1993." This evidence falls far short of demonstrating that any of opposer's IDT marks is famous.¹¹ Thus, in determining the issue of likelihood of confusion, opposer's marks are not entitled to the wide latitude of legal protection that a famous mark would have.

We turn next to a consideration of the parties' goods. Mr. Bourekas, opposer's vice president, described its goods in his testimony affidavit in the following paragraph:

IDT designs and manufactures and sells microprocessors and other related electronic products. IDT also designs software that is embedded in the systems utilizing the microprocessors that it manufactures and sells, including RISC microprocessors, and in various networking products that it manufactures and sells. IDT also designs and sells software drivers that function as part of an operating system in controlling a particular device. IDT also designs and licenses such software products as its 'IDT/c' and 'IDT/sim' software, usually, but not always, in connection with diagnostic products such as evaluation boards. IDT manufactures the microprocessors and other products

¹¹ We would point out that opposer's statements that it has placed advertisements in Asia and Japan, and maintains a Japanese website, are not evidence of fame of its mark in the United States.

that contain and/or execute its software. IDT sells its products both directly to its customers and through its distributors. Para. 2¹²

Opposer's goods are identified in its registrations as, essentially, hardware devices (including semiconductor components such as random access memories; microprocessors; and support chips), while its most recent registration also includes software in the nature of "computer programs for use in the design and application of semiconductor devices, microprocessors, and microcontrollers."

Applicant's evidence shows that it provides data processing services to companies whose businesses involve the sales, distribution and marketing of "consumer packaged goods" to distributors. Consumer packaged goods are items that consumers ordinarily purchase at a supermarket, such as canned ham, cookies and bottled water. Data regarding such consumer packaged goods is often supplied to applicant by consumer product distributors, who supply the products to retail outlets for sale to consumers. Applicant uses the mark IDT on software which is designed to permit consumer product distributors to send to applicant, in a secure fashion,

¹² It should be noted that opposer provided no testimony as to the dates on which it began using any of its IDT marks on its

product data over the Internet. The software is purchased only by consumer product distributors, and who purchase it by downloading it from applicant's Web site.

Although applicant has discussed in its brief the specific goods on which applicant uses its mark, we must, in determining the issue of likelihood of confusion, look to the goods as they are identified in applicant's application, namely, "computer software for use in the transfer of files via global computer information networks."¹³ **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be). Thus, the representation made by applicant's counsel in the trial brief that applicant will not expand

various goods.

¹³ The phrase "global computer information networks" is a reference to the Internet. See **In re Styleclick.com Inc.**, 57 USPQ2d 1445 (TTAB 2000). Opposer has acknowledged this meaning at pages 13-14 of its brief. We confirm, however, that opposer's assertion, at page 17 of that same brief, that applicant's identification encompasses software to transfer electronic files over cable systems and over radio, television, satellite, and other broadcasting systems, is incorrect.

its use of its mark beyond the aforesaid wholesale distributors, has no effect on our decision herein.

Having said this, we find that there are significant differences between opposer's goods as identified in its registrations and applicant's goods as identified in its application.¹⁴ While it is true that both parties' goods are or contain software, more must be shown than that one term may generically describe the goods. **General**

Electric Company v. Graham Magnetics Incorporated, 197 USPQ 690 (TTAB 1977); **Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.**, 188 USPQ 517 (TTAB 1975).

The record shows that, in terms of opposer's hardware, the software it sells is embedded in the hardware components, and essentially gives instructions to the components. The software identified in its 1999 registration--computer programs for use in the design and application of semiconductor devices, microprocessors, and microcontrollers--are also closely related to this hardware. Applicant's software, on the other hand, has a

¹⁴ Opposer points out that even though applicant currently uses its IDT mark with only one software product, applicant could expand its goods to any software that fits within the identification of goods in its application. We confirm that in determining the issue of likelihood of confusion, we have considered applicant's goods to encompass all software within the scope of its identification.

very different purpose: it is used to transfer files via the Internet.

Opposer has made the conclusory assertions in its brief that the parties' goods are virtually identical, and that applicant's use of its mark for its identified goods "will directly overlap with the goods currently being sold under Opposer's registered 'IDT' trademark." Brief, p. 14. However, although opposer argues that its goods include software used in transferring files over the Internet, it appears that the evidence in support of this statement is that certain of opposer's products "are sold to Internet companies such as Cisco Systems, for incorporation as integral components in products like routers" which are in turn used to transfer files via the Internet. Brief, p. 13.

We find that there is a very real difference between a part sold to an original equipment manufacturer which can then be used by that manufacturer to make hardware which can be used in connection with transferring files over the Internet, and the software which is identified in applicant's application.

This Board and our primary reviewing court have recognized the ubiquitous use of computers in all aspects of business in the United States today, and as a result

have rejected the view that a relationship exists between goods (or services) simply because each involves the use of computers. See **Electronic Data Systems Corp. v. EDA Micro Corp.**, 23 USPQ2d 1460, 1463 (TTAB 1992), and cases cited therein. "It is important to note that, in order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue herein beyond the fact that each involves the use of computers." **Reynolds & Reynolds Co. v. I.E. Systems, Inc.**, 5 USPQ2d 1749, 1751 (TTAB 1987).

We thus must consider whether opposer has submitted any other evidence to demonstrate a relationship between its goods and those of applicant. The record shows that applicant also sells hardware such as monitors and computers, and that it sells other software products. Opposer argues that there is "a potential to overlap even more products for which Opposer is authorized to use its mark" if applicant were to expand the use of its mark to "any other software product that might be viewed as within its natural area of expansion." Brief, pp. 14, 15. However, opposer has not shown that hardware or software similar to opposer's is within the natural area of expansion for a party making applicant's identified software.

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Opposer also argues that the parties' goods must be deemed to be sold through the same channels of trade. However, opposer has not provided any information as to its channels of trade, or shown how they are the same channels as applicant's. Certainly opposer's hardware cannot be downloaded over the Internet, as applicant's software can; nor has opposer shown that computer programs for use in the design and application of semiconductor devices, microprocessors, and microcontrollers would be sold in such a manner. Further, opposer has not shown that its hardware and software are or would be offered in the same stores or other distribution areas as software for use in the transfer of files via the Internet.

Opposer also argues that it markets its goods¹⁵ through print advertisements, printed materials and trade shows, and that these are the same channels of trade as applicant. However, there is no evidence as to the specific publications or trade shows in which opposer promotes its goods, there is no evidence as to the specific trade shows which applicant attends, or that applicant promotes its ITD software in publications at

¹⁵ In its brief opposer asserts that it markets and sells its goods through these channels of trade, but it is clear that these are just advertising media.

all. We certainly cannot conclude from the evidence of record that the parties promote their respective ITD trademarked goods at the same trade shows or publications, or that they target the same class of consumers.

Opposer also makes the point that both parties have Web sites on the Internet. However, since businesses of virtually every type are represented on the Internet, we cannot conclude that the parties' goods are related from this fact alone.

Opposer does assert that it has a wide variety of customers to whom it sells its products, including Philips Electronics, Lucent Technologies and Cisco Systems. Even if we assume that applicant's software could be purchased by these entities, it is not clear that the same persons responsible for buying opposer's specialized hardware and related software would be involved in a decision to purchase or use applicant's identified software. See **Electronic Design & Sales Inc. v. Electronic Data Systems Corp.**, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). More importantly, because of the very nature of opposer's products, many if not most of which are integrated into systems manufactured by the purchasers, they will be purchased by sophisticated

purchasers. See, for example, the descriptions of opposer's products as shown in the press releases attached as exhibits to the Bourekas affidavit.¹⁶ Such purchasers, even more than the public at large, are not likely to assume that the goods identified in opposer's registrations and applicant's application emanate from the same source simply because all are computer products.

We should also point out that, with respect to the earlier three of opposer's registrations (Nos. 1,244,288; 1,542,345 and 1,542,346), we also find significant differences in the parties' marks. Although opposer refers to its marks as IDT, in these three registrations the "I" is actually the mathematical integral sign (\int).¹⁷ Purchasers who are familiar with higher mathematics (and we assume many of those who work in the computer industry would be) will view the marks as the mathematical symbol followed by the letters "dt." And those who are not

¹⁶ Opposer asserts that no evidence was submitted on the factor of careful, sophisticated purchasing versus impulse buying. However, certain products, by their very nature, will be purchased by sophisticated purchasers. Moreover, the press releases showing the technical nature of opposer's products and the testimony about the customers for the products and the uses to which the products are put all show that opposer's goods are not items purchased on impulse by the general public.

¹⁷ We note that in two of these registrations the description of the mark refers to the letters IDT. However, it is not the description offered by applicant or accepted by the Examining Attorney that controls, but how the public is likely to perceive the mark.

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familiar with the integral symbol are just as likely to view the design, as used in the mark, as the stylized letters "f" or "S" as they are to see the letter "I." Thus, because of these differences in the marks, coupled with the differences in the goods, the likelihood of confusion is remote.

Opposer's fourth registration, No. 2,300,863, for IDT with the integral symbol and computer chip design, does clearly depict the letters IDT in block form, and they will be perceived as these letters. Applicant's mark is also for the letters IDT. With respect to this point, we note applicant's discussion of the particular manner in which its mark is currently used, "with a lower case 'i', next to the capital letters 'DT'" or "with a globe as the dot on the 'i' in close proximity to the name and Management Science Associates, Inc." Brief, p. 13. However, this discussion is irrelevant in view of the fact that the application is for a typed drawing version of the mark. If a registration for this mark were to issue to applicant, applicant's protection would not be limited to the manner in which the mark is currently being used, and would certainly extend to the depiction of the mark with a capital "I" or all capital letters IDT, as in opposer's registration No. 2,300,863.

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However, even though applicant's mark is similar to this mark of opposer's, because of the differences in the goods, and the sophistication of the purchasers of opposer's products, we find that confusion is unlikely. Opposer has failed to meet its burden of establishing that applicant's goods are related to opposer's such that purchasers are likely to assume that they emanate from the same source.

In reaching our determination, we have given no weight to applicant's evidence pertaining to no actual confusion. Applicant submitted the testimony of Joseph Delval, an employee of DEBS InfoNet, Inc., which acts as a help desk for applicant's customers, both calling these customers about data problems and fielding calls from them. The fact that Mr. Delval was aware of no instances of confusion can easily be explained by the fact that the calls were made only by existing customers of applicant, and the telephone number they called was supplied by applicant. Thus, there could be no opportunity for misdirected calls, since calls were not being made to an entity identified as IDT.

Decision: The opposition is dismissed.