

2/27/01

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

Paper No. 20  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Toshiba America, Inc.

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Serial No. 75/015,839

**Brian E. Banner** of Banner & Witcoff, Ltd. for Toshiba America, Inc.

Jessie W. Billings, Trademark Examining Attorney, Law Office 134 (Michael Szoke, Managing Attorney).

Before **Cissel**, Hohein and Chapman, Administrative Trademark Judges.

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

On November 7, 1995, applicant filed the above-referenced application to register the mark "ASPIRE CI" on the Principal Register for "a bundle of software and hardware options for CT scanners," in Class 9. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in connection with these goods in commerce.

In her initial Office Action, the Examining Attorney noted a prior-filed application that she warned might

present a bar to registration of applicant's mark, and also required a more definite identification-of-goods clause in the application.

Applicant responded by amending the application to identify the goods with which it intended to use the mark as "computer hardware and software for use with medical CT scanners." Applicant also presented arguments on the issue of likelihood confusion with the mark in the prior-filed application the Examining Attorney had referenced in the first Office Action.

The Examining Attorney then suspended action on the instant application in view of the prior-filed application, but on May 20, 1998, she resumed action on it and refused registration under Section 2(d) of the Lanham Act in view of the fact that the referenced application had matured into Registration No. 2,124,703 on December 30, 1997.<sup>1</sup> The cited registration is for the mark "ASPIRE" for goods identified as "computer, monitor, keyboard, printer, scanner, and remote controller," in Class 9.

Applicant responded to the refusal to register with arguments that confusion with the registered mark would not

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<sup>1</sup> The registration issued to Acer America Corp. on the Principal Register based on claims of first use and first use in commerce on August 31, 1995.

be likely if applicant were to use the mark it seeks to register in connection with the goods identified in the application. Applicant conceded that the marks are similar, but argued that confusion would not be likely because registrant's products are personal computers designed for home use, whereas applicant's computer hardware and software is used by physicians and radiologists on live patients in medical facilities such as hospitals, clinics and medical offices with the applicant's medical CT scanners. Applicant argued that registrant's goods travel in a different trade channel than the goods set forth in the application, that applicant's goods are expensive, complicated devices marketed to medical specialists in radiology, and that the purchasing decisions for its goods are made by sophisticated, knowledgeable individuals only after careful consideration. Applicant contrasted this situation to the personal computers it argued registrant sells, which applicant asserted move only in the trade channels for home computer products.

Applicant listed three registered trademarks in Class 9 which consist of or include the word "aspire." Copies of these registrations were included. Along with these registrations, applicant submitted a corporate profile of registrant obtained by applicant from the Internet and a

copy of a press release from applicant which discusses applicant's "Aspire CI" scanners and imaging equipment and mentions that these products are used by physicians who are radiologists.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register under Section 2(d) the Act was continued and made final in the next Office Action.

Applicant timely filed a Notice of Appeal, along with an amendment and a request for reconsideration. The amendment sought to change the identification-of-goods clause in the application to "a multi-slice computer tomography fluoroscope for continuous imaging of patients as a diagnostic tool to an interventional procedure for sale to hospitals and clinics and for use by physicians and radiologist" (sic). Attached as exhibits to the request for reconsideration were a copy of a medical press release regarding applicant's goods and an advertising brochure describing the products to be sold by applicant under the mark sought to be registered.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the request for reconsideration and the proposed amendment to the

identification-of-goods clause. The Examining Attorney refused to accept the amendment on the ground that it designates goods which are not within the scope of the identification then set forth in the application, as previously amended. The Examining Attorney pointed out that fluoroscopes are not computer hardware or software, and that an application may only be amended to clarify or limit the goods, so that additional goods, not within the scope of the existing identification-of-goods clause, are not allowed. Applicant responded to the refusal to accept its proposed amendment by proposing yet another identification-of-goods clause: "computed tomography software and hardware." The Examining Attorney accepted this amendment, but adhered to the final refusal to register under Section 2(d) of the Lanham Act.

The Board resumed action on the appeal, and applicant submitted its appeal brief, attached to which were additional exhibits and a declaration from one of applicant's attorneys.

The Examining Attorney filed her appeal brief, including an objection to the additional evidence submitted with applicant's brief on appeal. The Examining Attorney's objection is sustained. As she points out, the record in an application should be complete prior to the filing of a

Notice of Appeal. The Board may grant a request under Trademark Rule 2.142(d) to allow additional evidence to be submitted after that time, but applicant in the instant case made no such request, nor does it appear that if a request had been made, it would have been granted.

Applicant did not request an oral hearing before the Board.

The sole issue presented by this appeal is whether applicant's mark, "ASPIRE CI," if it were to be used in connection with computed tomography software and hardware, so resembles the registered mark "ASPIRE" for "computer, monitor, keyboard, printer, scanner, and remote controller," that confusion would be likely. Based on careful consideration of the record and arguments before us, we find that the refusal to register is well taken. Confusion is likely in this case because the broad identification-of-goods clause in the cited registration encompasses the goods identified in the application, and as even applicant acknowledges the mark of applicant and the mark in the cited registration are similar.

In the case of *E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set forth thirteen factors to be considered in determining whether confusion is likely

between two marks. In each case where this is the issue, we must consider any factor which relates to the facts before us. Chief among these factors are the similarity of the marks, as to appearance, sound, meaning and commercial impression, and the similarity of the goods. Any doubt as to whether confusion is likely must be resolved in favor of the registrant. Lone Star Manufacturing Co. v. Bill Beasley, Inc., 498 F.2d 906,182 USPQ 368 (CCPA 1974).

In view of the close similarity of the marks at issue in the case before us, the outcome of this appeal hinges on the relationship between the goods. It is well settled that in determining whether confusion is likely, we must compare the goods as they are identified in the application and registration, respectively, without restrictions or limitations not reflected therein. Toys "R" Us, Inc., v. Lamps R Us, 219 USPQ 340 (TTAB 1983). We must consider the listed goods as encompassing all products of the type described, and that they move in all of the normal channels of trade for such products and are available to all potential customers for such goods. In re Elbaum, 211 USPQ 639 (TTAB 1981).

As noted above, applicant's goods are identified as "computed tomography software and hardware." The registration identifies the goods with which the registered

mark is used even more broadly as "computer, monitor, keyboard, printer, scanner, and remote controller." Contrary to applicant's assertion, we cannot consider registrant's products as limited to use in connection with personal computers for home use by ordinary consumers. Registrant's computer products, as identified without restriction or limitation, could be used by almost anyone for almost anything, including use by radiologists in connection with computed tomography. Applicant's goods are thus encompassed within the identification-of-goods clause in the cited registration.

Applicant's argument that confusion is not likely in view of the three third-party registrations applicant submitted is not persuasive. Such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Moreover, even if it were clear that the marks and goods in these registrations are similar to those set forth in both the application and the cited registration, the existence on the register of confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999). In this regard, third-party registrations are of little value in

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determining whether confusion is likely. *United Foods Inc. v. J. R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987).

We accordingly conclude that confusion is likely because these marks are quite similar and the goods set forth in the registration encompass the goods identified in the application.

Decision: The refusal to register under Section 2(d) of the Act is affirmed.

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