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Paper No. 12
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HID Corporation

Serial No. 75/613,067

Rodney F. Brown for HID Corporation.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Acting Managing Attorney).

Before Simms, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

HID Corporation has filed an application to register
the mark EPROX for "radio frequency identification
components, namely proximity modules and electronic door
locks, for security access control systems."¹

Registration has been finally refused under Section
2(d) of the Trademark Act on the ground of likelihood of
confusion with the mark PROXX which is registered, inter

¹ Serial No. 75/613,067, filed December 29, 1998, based on an
allegation of a bona fide intention to use the mark in commerce.

alia, for "electrical, electromagnetic and electronic locks, metal detectors, infrared motion detectors, remote controls for security purposes and burglar alarms."²

The refusal has been appealed and applicant and the Examining Attorney have filed briefs.³ An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*⁴ factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

² Registration No. 2,275,211, issued September 7, 1999.

³ The Examining Attorney has objected to an advertising brochure which applicant has attached to its brief as untimely. Under Trademark Rule 2.142(d) the record should be complete prior to the filing of an appeal. Accordingly, no consideration has been given to this brochure.

The Examining Attorney has also objected to the list of applicant's prior registrations which applicant appended to its response filed September 26, 2000 as being improperly submitted. The Examining Attorney did not, however, raise this objection in the action following the submission of the list, but rather waited until the filing of the brief. As such, we find the Examining Attorney to have waived the objection and accordingly, the prior registrations have been taken into consideration.

⁴ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Looking first to the respective goods, the Examining Attorney argues that the goods are essentially the same in that the goods of both applicant and registrant include electronic locks for security purposes. Applicant has made no argument to the contrary. In fact, applicant states in its brief that "applicant has assumed ... for the sake of argument that the goods of the instant application and registration are essentially the same." (Brief, p.7). Applicant instead attempts to distinguish the goods of applicant and registrant on the basis of the means by which the goods are marketed. Applicant contends that its goods are sold through a limited distribution network of distributors and representatives to OEM'S who produce and market security access control systems, whereas, from the services listed in the registration, it would appear that registrant sells its goods as off-the-shelf products through retail outlets.

There are no restrictions or limitations in the identification of goods in the application with respect to the markets for applicant's goods. Neither are the goods as identified in the registration limited in the markets or means of distribution therefor. Thus, in the absence of any limitations in the identifications of these goods, we must assume that the goods of both registrant and applicant

Ser No. 75/613,067

would travel in the same channels of trade and be available to the same class of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). No distinction can be drawn on this basis.

Thus, the major factor in the present case is the similarity or dissimilarity of the respective marks. In making our analysis, we are guided by the general principle that the greater the similarity of the goods, the lesser the degree of similarity of the marks which is necessary to support a conclusion that there will be a likelihood of confusion. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The Examining Attorney notes that both applicant's and registrant's marks contain the identical term "PROX," the only difference being the addition of an "E" to the beginning of the term by applicant and the addition of an "X" to the end of the term by registrant. The Examining Attorney maintains that the addition of the "E" by applicant does not obviate the similarity in appearance and overall commercial impression between the two marks because the "E" is descriptive of applicant's goods. Relying upon a dictionary definition of "E" as being used at the

beginning of a term to mean "electronic,"⁵ the Examining Attorney argues that "E" is simply descriptive of applicant's electronic door locks and would not obviate a finding that the marks are confusingly similar. The Examining Attorney further argues that the repetition of the "X" at the end of registrant's mark does not differentiate the registrant's mark from applicant's mark in sound, appearance or overall commercial impression.

Applicant contends that both marks, EPROX and PROXX, create inseparable unitary impressions and must only be compared to one another in their entireties. Applicant argues that its mark does not create the impression of a dominant portion "PROX" preceded by a weak portion "E"; that while the prefix "E" has come to be used in a descriptive manner of Internet-based goods or services, the present goods are not Internet related. The letter "E" in its mark, according to applicant, is derived from "embedded" and the second portion "PROX" is derived from the term "proximity," with the entire mark intended to

⁵ The dictionary definition introduced by the Examining Attorney in her brief, and of which we take judicial notice, comes from *Newton's Telecom Dictionary* (16th ed. 2000). The definition reads in full:

E stands for electronic. But it's become the all-purpose Internet and Web prefix. Stuck on the front of any term you want, it means to make that thing happen over the Internet/Web, e.g. e-commerce, e-mail, e-check.

suggest "embedded proximity technology." Thus, applicant argues, neither portion of its mark should be considered dominant. Applicant insists that the appearance, syntax and cadence of applicant's and registrant's marks create the commercial impression of unitary marks, and of unitary marks which are distinct from one another.

In addition, applicant points to the several prior registrations which it has obtained for marks containing the term "PROX," many of which were filed prior to the filing date of the cited registration. Applicant contends that it is inconsistent to have allowed registration of the cited mark over these registrations, yet refuse registration of applicant's later mark on the grounds of likelihood of confusion.

In the first place, we find that, although there may be differences in the pronunciation, and to a certain extent in the appearance, of the marks EPROX and PROXX, when considered in their entirety the marks create highly similar overall commercial impressions. It is well established that the test in determining likelihood of confusion is not whether the marks are distinguishable on a side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, taking into consideration the fallibility of memory over a period of

time. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Here the term "PROX" clearly forms a major portion of each mark and would be seen and heard as such. The additional "X" in registrant's mark makes little difference in the impression created. We do not consider the additional "E" in applicant's mark sufficient to obviate the likelihood of confusion, particularly considering the imperfections of memory and the tendency to retain general, rather than specific, impressions of trademarks.

Even if the prefix "E" is given greater consideration in applicant's mark, we are convinced that purchasers would reasonably construe this prefix as being no more than descriptive of the electronic feature of applicant's goods. Although applicant claims that the prefix "E" refers to the "embedded" nature of its goods, there is no evidence of record to substantiate this claim or that purchasers would grasp such a reference.

Instead, we believe that the prefix "E" would be viewed as being the equivalent of the term "electronic," even though the goods with which it is being used are not Internet-related. Taking the full dictionary definition of "E" into consideration, as applicant argues we must, we do not find that "E" is limited solely to use with Internet-

related goods. Its standard use as the equivalent of the term "electronic" has not been eliminated by its later adoption as the "all purpose Internet and Web prefix." Just as the prefix "e" in the term "e-mail" still indicates that this is "electronic mail," the prefix "E" in the mark EPROX stands as an indication that these were "electronic" goods. Clearly, it would be obvious from the goods with which the mark is being used that the goods are not Internet-related, but merely electronic in nature.

Although descriptive matter cannot be ignored in comparing the marks as a whole, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as a indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). If in the mark EPROX the prefix "E" would be likely to be viewed by purchasers as an indication of the electronic nature of applicant's goods, the prefix, although a part of the mark which cannot be ignored, at the same time cannot be considered as carrying equal weight as an indication of source. The "PROX" portion of the mark would dominate as the source indicator, making confusion with registrant's mark highly likely.

Furthermore, it is well settled that a subsequent user may not appropriate the mark of another and by adding

subordinate or descriptive matter thereto avoid a likelihood of confusion. See *Henry I. Siegel Co., Inc. v. A & F Originals, Inc.*, 225 USPQ 626 (TTAB 1985); *Alberto-Culver Co. v. Helene Curtis Industries, Inc.*, 167 USPQ 365 (TTAB 1970). Here the addition of the prefix "E" to the registered mark PROXX, together with the insignificant elimination of the extra "X," would fail to avoid a likelihood of confusion. There are two exceptions to this general rule: (1) when the common portion is weak or descriptive or (2) when the marks in their entireties convey significantly different commercial impressions. See *In re Denise*, 225 USPQ 624 (TTAB 1985); 3 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:50 (4th ed. 2001). We find neither one applicable here. The "PROX" portion of the marks has not been shown to be weak or descriptive and the addition of the descriptive "E" prefix thereto does not result in a significant change from the commercial impression created by registrant's mark.

Accordingly, we find the respective marks in their entireties to be highly similar in overall commercial impressions.

While applicant has pointed to its prior registrations for "PROX" marks and argues that if registrant's mark PROXX were allowed to issue over these registrations, applicant's

mark should be allowed to issue over registrant's mark, we do not agree. The marks involved in those prior registrations were composite terms, with "PROX" being used in combination with another readily discernable term, such as "CARD," "KEY" or "PHOTO." There is a much greater degree of dissimilarity between these marks and registrant's mark PROXX than between PROXX and EPROX. We find no inconsistency in the issuance of registrant's registration. In any event, we are without the file history of registrant's mark and thus cannot make a full assessment of the reasons for the coexistence of registrant's and applicant's prior registrations. Moreover, the prior decision of an Examining Attorney on the registrability of registrant's mark is in no way controlling over our present decision. See *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882 (TTAB 1988).

We also find applicant's argument as to the sophistication of its customers to be to no avail. As discussed earlier, there can be no viable distinctions drawn on the basis of channels of trade or class of customers. Moreover, even if the present customers of applicant's goods are, as applicant argues, a relatively sophisticated group of systems designers and purchasing agents, they are not immune to source confusion. This is

Ser No. 75/613,067

especially true when the marks are highly similar in commercial impression, as is the case here, and the goods have been acknowledged to be essentially the same.

See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

Accordingly, upon weighing all of the relevant *duPont* factors, we find confusion likely. To the extent that there may be any remaining doubt, we follow the well-established principle that any doubt regarding likelihood of confusion must be resolved in favor of the registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

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