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EWH
Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Union Semiconductor Technology Corporation

Serial Number 75/801,563

Erik O. Berger for Union Semiconductor Technology Corporation.

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

Before Simms, Hanak and Drost, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Union Semiconductor Technology Corporation (applicant) seeks to register USTC in typed drawing form for "semiconductor devices, namely, semiconductor integrated circuits and devices incorporating semiconductor integrated circuits." The intent-to-use application was filed on September 18, 1999.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's goods,

is

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likely to cause confusion with the mark USTC and design in the form shown below, previously registered as a certification mark for a "variety of goods subject to standards or specifications, primarily in the areas of goods distributed for use by businesses, business equipment, communication devices and instruments, raw materials and product components, medical equipment, wearing apparel and personal protective equipment, construction and building materials, electrical devices, and pharmaceuticals." Registration No. 1,947,395 issued January 9, 1996.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining

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Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). Considering first the marks, we note that marks are compared in terms of visual appearance, pronunciation and connotation, if any. In terms of visual appearance, the two marks are almost identical. Both consist of the letters USTC. We recognize that the registered mark has the letters USTC enclosed in a thin, rounded rectangle. However, it is our judgment that this very ordinary background design in the registered mark would do very little to differentiate the registered mark from applicant's mark USTC per se.

In terms of pronunciation, the two marks are

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absolutely identical. Obviously, no one would pronounce the registered mark as "USTC and rounded rectangle design." Rather, both marks would be pronounced simply as USTC.

Finally, in terms of connotation, we note that in its brief applicant has not discussed the issue of the connotations of the two marks. See applicant's brief page 3. We are not oblivious to the fact that the letters USTC are an initialism for applicant's corporate name (Union Semiconductor Technology Corporation) and registrant's corporate name (United States Testing Company). However, the fact remains that neither mark contains the corporate name of applicant or registrant. Thus, in terms of connotation, consumers would have no way of differentiating applicant's mark USTC per se from registrant's mark USTC and rounded rectangle design.

In sum, given the fact that the marks are absolutely identical in terms of pronunciation and are almost identical in terms of visual appearance, we find that overall the two marks are almost identical. In sum, the

first Dupont "factor weighs heavily against applicant"

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because applicant's mark and the registered mark are almost identical. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's goods and registrant's certification services, we note that because the marks are almost identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in this case we find that applicant's semiconductor integrated circuits and devices incorporating semiconductor integrated circuits are clearly related to at least certain of the goods which registrant certifies under its mark, namely, electrical devices. Because applicant's identification of goods is somewhat lengthy, we will, for ease of reference, refer to applicant's goods as "semiconductor devices," just as applicant

itself does at page 4 of its brief.

The Examining Attorney has made of record numerous stories from the NEXIS database demonstrating that

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semiconductors or semiconductor devices are a type of electrical device. For example, a story appearing in the February 12, 1985 edition of The San Diego Union-Tribune refers to semiconductors as "the tiny electrical devices that have made possible the modern computer world." An article appearing in the July 31, 1989 edition of Fortune refers to a company that makes instruments "that test semiconductors, among other electrical devices." In a story appearing in the July 22, 1997 edition of the Los Angeles Times, there is a discussion of a company which "distributes transistors, semiconductors and other electrical devices."

In short, "semiconductor devices" -- as applicant refers to its goods -- are a type of electrical device, one of the types of products which registrant certifies under its mark USTC and rounded rectangle design. If a consumer, even a sophisticated consumer, were to see the letters USTC on one of applicant's semiconductor devices,

the sophisticated consumer could well assume that this device has been certified by registrant. It is our belief that even a sophisticated consumer would not notice that the

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letters USTC lack the thin, common background design, namely, a rounded rectangle. Conversely, if a sophisticated consumer were to see registrant's certification mark USTC and rounded rectangle design on a semiconductor device, that sophisticated consumer would assume that the mark indicated that this was a semiconductor device manufactured by applicant.

Decision: The refusal to register is affirmed.

