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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re General Semiconductor, Inc.

Serial No. 76231575

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Before Quinn, Chapman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 27, 2001, General Semiconductor, Inc. (a Delaware corporation) filed an application to register on the Principal Register the mark SMF for "semiconductors" in International Class 9. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the

ground that applicant's mark so resembles the SMF-28¹ and SMF-28e² marks, both registered by Corning Incorporated, and both for "optical fiber" in International Class 9, that when applicant's mark is used on or in connection with its identified goods, there is a likelihood of confusion, mistake or deception.

Applicant has appealed, and briefs have been filed. An oral argument has not been held.³

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities

¹ Registration No. 2581203, issued June 18, 2002.

² Registration No. 2675475, issued January 14, 2003. The mark in this registration is presented in special form to the extent that the letter "e" is in lower case.

³ Applicant requested an oral argument, but its request did not comply with Trademark Rule 2.142(e)(1), which expressly states that the "request therefor should be made by a separate notice...." See also, TBMP §802.02 (2d ed. rev. 2004). Instead, applicant's request for an oral argument is embedded on page 6 of its 7-page brief on the case. When a request for oral argument is not made by separate notice, it is administratively extremely difficult, if not impossible, for the Board to note the request, and take appropriate action thereon. The administrative difficulties arise whether an applicant files paper documents or electronic submissions to the Board.

between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The salient question to be determined is not whether the goods of the parties are likely to be confused, but rather whether there is a likelihood that the public will be misled to believe that the goods offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965); and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 30 (TTAB 1976).

We consider first the marks. Applicant's mark SMF is highly similar to each of the cited marks, SMF-28 and SMF-28e. The only difference is that applicant did not include in its mark the hyphen or the numeric or alphanumeric designations appearing after the letters "SMF" in the registered marks. These minor differences would not obviate any likelihood of confusion. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992). Moreover, the numeric and alphanumeric designations following the

letters "SMF" in registrant's marks would likely be perceived by consumers as model or style numbers. We find that applicant's mark is similar in appearance and sound to each of the cited registrations.

As to connotation, all we have in the record is applicant's response to the Examining Attorney's request for information as to any meaning or significance the letters have in the relevant trade, including whether SMF is an abbreviation or acronym. Applicant stated that it is "not aware that [SMF] has any particular meaning in the relevant trade." (Response, February 4, 2004.) Thus, whatever the connotation of the letters SMF, it is presumptively the same for both applicant's and registrant's marks.

We find that applicant's mark is highly similar in sound, appearance, connotation and overall commercial impression to each of the two cited registered marks. See *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Applicant contends that the cited marks are weak and as evidence thereof it submitted copies from the USPTO's Trademark Electronic Search System (TESS) of two third-party registrations and two third-party applications. The records indicate that the third-party applications had been

approved for publication, but were later abandoned by those respective applicants. The two third-party applications are not probative except as evidence that the respective applications were filed on particular dates. We do not agree with applicant's argument that the reason the applications were allowed for publication must be the differences in the marks and the goods and this "can be inferred." (Brief, p. 6.) To the contrary, this is mere speculation on applicant's part. It is likewise pure speculation by applicant as to why the respective third-party application owners abandoned those applications. (Reply brief, p. 4.)

The two third-party registrations submitted by applicant are (1) Registration No. 2693365 for the mark SMF 2000, and (2) Registration No. 2693366 for the mark SMF 166, both for "non-magnetic steel in sheet, rod, bar and/or billet form" in International Class 6 and "drilling machines and parts thereof" in International Class 7, and both issued to S.M.F. International Societe Anonyme. These are not persuasive because they are for goods unrelated to applicant's "semiconductors" and the cited registrant's "optical fiber." Most importantly, third-party registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with

them that they are able to distinguish among such marks. There is no evidence of record of any use by any party (including applicant, the cited registrant or any third-party) of any mark including the letters SMF for semiconductors or optical fiber or any other goods or services.

To the extent applicant is arguing that inconsistent actions were taken by Examining Attorneys, the record history of each of the two cited registrations as well as the records of the third-party registrations are not before us. Moreover, neither the Board nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

Furthermore, even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Turning next to a consideration of the goods involved in this case, we start with the well-settled principle that goods or services need not be identical or even competitive

to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they emanate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). Further, the question of likelihood of confusion in Board proceedings regarding the registrability of marks, must be determined based on an analysis of the goods or services identified in applicant's application vis-a-vis the goods or services recited in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, both registered marks are for "optical fiber," while applicant intends to offer "semiconductors." In support of the refusal to register, and particularly the relatedness of the respective goods, the Examining Attorney has submitted printouts of excerpted stories retrieved from

the Nexis database and printouts from Internet websites to show that semiconductors and optical fiber are used in conjunction with one another and they are related industries. Examples of this evidence are set forth below:

Headline: Sumitomo Elec Ties Up With Alcatel in Fiber-Optic Technology
...Under the deal, the two companies will mutually license patents and production expertise related to optical fiber and cable, it said. The Japanese firm already sells high-performance optical fiber and compound semiconductors to Alcatel. ... "AFX News Limited," May 29, 2001;

Headline: Photonic Chips
Photonic Chips are wafer-based, integrated, optical sub-assemblies for high-volume telecommunication and data communications applications. They combine miniature optic and electronic components onto semiconductor wafer assemblies for use with optical fibers that have large voice, data, and video data-transfer capabilities. "Design News," May 7, 2001;

Headline: American Microsystems Inc...
...Sensors Unlimited Inc. named Clifton Draper to its executive team. Draper will be retiring from Lucent Technologies, bringing to Sensors over 23 years experience in optical fiber and semiconductor device manufacturing research, as well as fundamental research in the field of laser interactions with materials. ... "Microwave Journal," February 1, 2001;

Headline: Phyworks Claims Chip First...
Phyworks Ltd. a fabless semiconductor company developing innovative electronic solutions to overcome signal

degradation on optical fibers,
announced that it has begun to ship
samples of its PHY 1060 Electronic
dispersion Compensation (EDC)
integrated circuit (IC) to customers
for evaluation. ... "Fiber Optics Weekly
Update," February 20, 2004;

Headline: Corning Inc.
...Principal businesses: Optical fiber
and cable, specialty glass, ceramic
pollution control products,
semiconductor materials. "Star-Gazette
(Elmira, NY)," July 23, 2003;

Headline: A Second Chance for X-ray
Lithography?...

J-Mar uses a solid-state laser to blast
short, powerful light pulses at a thin,
moving copper strip, creating a high-
energy plasma that emits X rays with a
wavelength of about 1 nanometer. The X
rays are collected and carried through
a bundle of tiny optical fibers called
a collimator to a semiconductor
stepper, which uses X rays to expose
circuit patterns on wafers coated with
photosensitive materials. ... "Electronic
Business," July 10, 2003;

Headline: Wild, Wireless West
...Already successful in traditional
areas like steel, copper wiring and
optical fiber for power and
telecommunications applications, Walsin
also has semiconductor experience
through its stake in Winbond
Electronics Corp. ... "Electronic
Engineering Times," August 12, 2002;

Corning Products + Services

...

Optical Fiber

Corning Optical Fiber produces a wide
range of optical fiber products
designed to perform in a variety of
applications...

...

Semiconductor Optics

Corning Semiconductor Optics expands the capabilities of wavelength technology through the application... .
www.corning.com (the cited registrant);
and

Fujitsu

Compound Semiconductors

Fujitsu designs and manufactures key lightwave/optoelectronic components for many high-speed optical networks and microwave components for wireless communication systems.
www.fcsi.fujitsu.com/products.htm.

In addition to the Nexis and Internet evidence, the Examining Attorney also submitted copies of several third-party registrations, based on use in commerce, indicating the same entities offer semiconductors and optical fiber under the same mark. See, for example, Registration No. 2622346 for, inter alia, "semiconductor, ..." and "optical fiber, ..."; Registration No. 2636018 for, inter alia, "... optical fibers, ..." and "... semiconductor panels, ..."; and Registration No. 2249955 for, inter alia, "optical fiber cable, ..." and "semiconductors."

When considering the third-party registrations submitted by the Examining Attorney, we remain mindful that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to

suggest that such goods are of a type which emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988). Thus, the third-party registrations submitted by the Examining Attorney are further evidence of the relatedness of the respective goods.

The Nexis and Internet evidence, as well as the third-party registrations which include both items of goods in the identifications of goods, all show a commercially significant relationship between these two specifically different products, such that consumers may well expect the two items to emanate from a single source. That is, applicant's identified goods and the goods listed in the cited registrations are related in the mind of the consuming public as to origin. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

We find that applicant's semiconductors and registrant's optical fiber are related goods. See

Transitron Electronic Corp. v. Weston Instruments, Inc.,
147 USPQ 503 (TTAB 1965).

Applicant's argument that "[its] semiconductors are completely unrelated to the [registrant's] optical fibers" (reply brief, p. 3, emphasis in original) is not persuasive. It is clear that the products involved herein are different products. However, we have found that the Examining Attorney established a prima facie showing that these different products, "semiconductors" and "optical fiber," are related goods. Applicant's argument to the contrary, that the goods are "completely unrelated," is not supported by rebuttal evidence. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir.) (The issue in the case was mere descriptiveness, but the Court discussed an applicant's burden of coming forward with evidence in support of its arguments.)

We find that the goods, as identified, could be offered through the same or at least overlapping channels of trade, to the same or at least overlapping classes of purchasers.

Although not raised by applicant,⁴ we recognize that the involved goods would not be purchased on impulse, but

⁴ In applicant's reply brief (p. 2), it argued that in any ex parte case there are several du Pont factors which are "usually

rather would be purchased with care, and may be purchased only by sophisticated purchasers. However, even if purchased with care, and by sophisticated purchasers, these purchasers are not immune from confusion as to the source of services, particularly when they are sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

In view of the highly similar marks, the relatedness of these goods, and the same or overlapping channels of trade and purchasers, we find that applicant's mark SMF for its identified goods is likely to cause confusion with the marks SMF-28 and SMF-28e in the cited registrations.

While we do not have doubt on the question of likelihood of confusion in this case, if there were such doubt, it must be resolved against applicant as the newcomer, as applicant has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997);

the most relevant," listing six factors, including the conditions of sale, i.e., impulse versus sophisticated purchasing. However, applicant made no argument with regard to this factor. (Indeed, applicant had also listed "valid consent agreement" in its list of du Pont factors arguably generally relevant in ex parte cases, but there is no consent agreement of record herein.)

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and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to both cited registrations.