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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Garmin Ltd.

Serial No. 78238015

Kevin E. West of Garmin Ltd. for Garmin Ltd.

Angela Micheli, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Hairston, Grendel and Drost, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark **ION** (in standard character form) for Class 9
goods identified in the application, as amended, as "GPS
receivers, namely GPS navigation receivers for determining
position and speed."¹

¹ Serial No. 78238015, filed April 15, 2003. The application is based on intent-to-use under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The identification of goods quoted above, i.e., "GPS receivers, namely GPS navigation receivers for determining position and speed," was the subject of an amendment requested by

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the identified goods, so resembles two previously-registered marks (owned by the same owner) as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). The first cited registration is of the mark **IONIC SOFTWARE** (in standard character form; SOFTWARE disclaimed), for "computer software in the nature of interoperable java components for the access and exchange of geospatial and location-based information, in the field of web mapping, location based operations, and geo-enabling distributed applications."² The second cited registration is of the mark depicted below (SOFTWARE disclaimed)



applicant with its September 29, 2005 request for reconsideration. Prior to submission of the proposed amendment, applicant's identification of goods (as previously amended) was "GPS receivers; and computer peripherals featuring a GPS receiver and a GPS antenna used to communicate GPS information to a separate computer." In her December 12, 2005 Office action denying the request for reconsideration, the Trademark Examining Attorney did not mention or act upon applicant's proffered amendment to the identification of goods. We have given effect to the amendment.

² Registration No. 2656671, issued December 3, 2002.

for goods identified as "computer software in the nature of interoperable components for the access and exchange of geospatial and location-based information, in the field of web mapping, location based operations, and geo-enabling distributed applications."³

Applicant and the Trademark Examining Attorney filed main appeal briefs. Applicant filed no reply brief, and did not request an oral hearing. We affirm the refusal to register.

Our likelihood of confusion 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 (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

³ Registration No. 2731941, issued July 1, 2003. The only difference in the respective identifications of goods in the two cited registrations is that this second registration omits the word "java."

The first *du Pont* factor requires us to determine the similarity or dissimilarity of applicant's mark and the cited registered marks when considered in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Initially, we find that the dominant feature in the commercial impression created by each of the cited registered marks is the word IONIC. The word SOFTWARE in each mark is generic and disclaimed. Also, the design element of the '941 mark would not be pronounced, and it contributes less to the mark's source-indicating commercial impression than does the word IONIC. In comparing applicant's mark and the cited registered marks, therefore, we have accorded more weight to the word IONIC in the registered marks. See *In re Chatam International Inc.*, *supra*; *In re National Data Corp.*, *supra*.

"Ion" is defined as "an atom or a group of atoms that has acquired a net electric charge by gaining or losing one or more electrons." The American Heritage Dictionary of the English Language (4th ed. 2000).⁴ The same dictionary defines "ionic," in pertinent part, as "of, containing, or involving ions." Thus, the word "ionic" is simply the adjectival form of the word "ion." We find that ION and IONIC have the same arbitrary or fanciful connotation as applied to the goods at issue in this case.⁵ We also find

⁴ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁵ Applicant acknowledges, at page 6 of its brief, that ION "is a relatively fanciful term in relation to GPS receivers." We find

that the two words look and sound similar, differing only as to the suffix -IC.

Applicant argues that IONIC in the cited registered marks operates as an adjective describing or modifying the word SOFTWARE.⁶ However, there is no evidence that there is a category or class of software called "ionic software." We therefore find that purchasers will not regard the cited registered marks as comprising a unitary term, i.e., "ionic software," but rather will view the marks as comprising the arbitrary word IONIC followed by the generic term SOFTWARE.

that IONIC likewise is fanciful as applied to the GPS-related software identified in the cited registrations. We note that applicant has submitted, with its September 29, 2005 request for reconsideration, a listing from the Office's TESS database of third-party registrations and applications involving marks which include "ION" as a component of the mark. Generally, third-party registrations may not be made of record simply by listing them. *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). However, because the Trademark Examining Attorney did not object to this evidence in her December 12, 2005 Office action denying the request for reconsideration, we deem her objection (made for the first time in her appeal brief) to have been waived. *See in re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). Although we deem applicant's list to be of record, however, we find that it is entitled to little probative value. The listing is of the marks and registration/serial numbers only; it does not indicate the specific goods covered by the third-party registrations and applications, only that they are in Class 9. This evidence therefore does not serve to show that ION or IONIC is anything but arbitrary and fanciful as applied to the GPS-related goods at issue herein.

⁶ Applicant contends: "... the cited marks use the adjective 'IONIC' as a modifier of the term 'SOFTWARE.' The connotation created by such a use is that the cited marks are describing the type of software offered under the mark - i.e., 'what type of software is being offered under the mark? ... 'ionic software'.'" (Applicant's brief at pp. 6-7; emphasis in original.)

That is, it is the word IONIC which serves the source-indicating function in the cited registered marks.

We find that the basic similarity between the marks which results from their use of the highly similar and related words ION and IONIC greatly outweighs the points of dissimilarity between the marks. The marks do not look and sound absolutely identical, due to the presence of the suffix -IC and the generic word SOFTWARE in the cited registered marks and the ornamental arrow design element in the '941 mark, but that is not the test. We find that applicant's mark and the cited registered marks look and sound similar, and that they carry the same or highly similar connotations. Purchasers are likely to confuse ION and IONIC. Moreover, they are more likely to assume, based on the presence of ION and IONIC in the respective marks, that a source connection exists, than they are likely to assume, based on the minor differences between the marks, that no source connection exists. On balance, we find that the marks are similar, and that the first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

We turn next to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the goods as identified in the application and in the cited

registrations, respectively. It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The Trademark Examining Attorney has submitted printouts of fourteen third-party registrations which include in their identifications of goods both GPS-related hardware items including receivers, and GPS-related software used in conjunction therewith. Although such registrations are not evidence that the marks shown therein

Ser. No. 78238015

are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

Also of record is a printout of Registration No. 2288989, owned by applicant, which is of the mark GARMIN for goods which include both "global positioning satellite (GPS) based navigation receivers" and "pre-recorded CD-ROMs and cartridges featuring digital map data and software for facilitating use of GPS based navigation receivers." Likewise of record are printouts from the website of a third-party retailer (GPS World Supply) depicting and describing various of applicant's GPS receivers. Listed among the features of these receivers is the GPS-related software used to operate them, e.g.: "Unit Includes: GPSPMAP® 296 receiver ... Trip & Waypoint Manager software"; "Unit Includes: StreetPilot 2610 receiver w/ built-in antenna ... MapSource City Navigator v5 CD-ROM w/ full coverage, full unlock"; "The Rino 120 has eight megabytes of internal memory for downloadable cartography from GARMIN's exclusive line of MapSource CD-ROMs - providing

topographic, bathymetric, and street-level map information." We find that this evidence regarding applicant's own products establishes the relatedness of GPS hardware devices, i.e., receivers, and GPS-related software. The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to consider the similarity or dissimilarity in the trade channels and classes of purchasers for the respective goods. We make this determination based on the goods as identified in the application and registrations, respectively. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). In its brief (at pp. 9-10), applicant asserts as follows (emphasis in original):

Appellant's GPS receivers are stand-alone hardware devices that receive signals from orbiting satellites, calculate their position based on those signals, and display or transmit that calculated GPS coordinate data. These GPS receivers are commonly marketed directly to the consumer/end-user, and are sold through sporting goods stores, the sporting goods sections of department stores, electronics stores, and the like.

In contrast, the computer software of the cited IONIC SOFTWARE marks is described as "interoperable components for the access and exchange" of information in the field of "web mapping, location based operations, and geoenabling distributed applications." As is known in the art, software "components" are small utility programs that perform a very specific function. These "components" are used by programmers in building a software application, just as hardware "components" are used by

technicians in building a hardware device. A resistor or capacitor is a hardware component that is used to build, for example, a television set. However, by itself, a resistor or capacitor has no utility to a consumer in need of an assembled television set. Similarly, the software "components" of the cited IONIC SOFTWARE marks may be used by programmers or software developers to build, for example, a Web mapping application that can run on a home computer. However, by itself, that software component will be of no use to a consumer seeking a Web mapping application. Thus, the intended consumer of IONIC SOFTWARE is not the consumer/end-user of a Web mapping application, but is a software developer or programmer who is developing a Web mapping application and wants to incorporate the utility provided by the interoperable components of the IONIC SOFTWARE into the software being developed.

Furthermore, while consumer/end-user software may be sold directly to consumers through channels such as department stores or electronic and computer stores, development software is not typically sold through those channels. Development software is typically marketed directly to software development professionals and programmers through software-specific Web sites and stores, and through publications geared towards those developers.

These asserted limitations in the nature of registrant's software and the likely classes of purchasers thereof (i.e., "software development professionals") are not apparent from the registrations themselves, nor are they established by other evidence in the record (including the printouts from registrant's website, made of record by applicant). Likewise, applicant's assertions as to the assertedly limited trade channels and classes of purchasers

for its GPS receivers are not reflected in applicant's identification of goods. There is nothing in the record which shows that registrant's mark, as used on its software products, would not be encountered by the same purchasers (whether individual consumers, business entities or government agencies) as those in the market for applicant's GPS receivers. Nor have we any basis for concluding that registrant's GPS software and applicant's GPS receivers are not in fact complementary products which could be used together. We note that the product descriptions for applicant's products (appearing on the GPS World Supply website noted above) include, among the products' features, a "PC interface cable"; this shows that applicant's GPS receivers are meant to be compatible for use in conjunction with the user's personal computer, upon which software such as registrant's might also be used.

In short, we find that applicant's and registrant's goods, as identified in the application and registration, respectively, could be marketed in the same trade channels and to the same classes of purchasers. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The record does not support applicant's argument, under the fourth *du Pont* factor, that the purchasers of the

goods at issue necessarily are sophisticated and knowledgeable purchasers. We find that even sophisticated purchasers would not be immune to source confusion in this case; they are likely to be confused by the use of these highly similar marks on these similar GPS-related products. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). The fourth *du Pont* factor is neutral, at best.

Finally, there is no evidence under the sixth *du Pont* factor (number and nature of similar marks in use on similar goods) which establishes that the cited registered marks are at all weak or diluted, or entitled to a narrowed scope of protection. We have considered applicant's TESS listing of third-party registrations as being of record, but for the reasons discussed above, we find it to be of little probative value because the goods covered by the registrations are not apparent from the listing. Moreover, even if applicant had made the actual third-party registrations of record, they would not constitute probative evidence of use under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Weighing all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists. Use of these similar marks on these

Ser. No. 78238015

similar GPS-related goods is likely to cause source or other confusion. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc. supra.*

Decision: The refusal to register is affirmed.