

Hearing:  
May 18, 2006

**This Opinion is Not  
Citable as Precedent  
of the TTAB**

Mailed:  
September 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Bose Corporation  
v.  
ONG Corp.

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Opposition No. 91162058  
to application Serial No. 76511496  
filed on May 5, 2003

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Amy L. Brosius of Fish & Richardson P.C. for Bose  
Corporation

Leighton K. Chong of Godbey Griffiths Reiss & Chong for ONG  
Corp.

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Before Holtzman, Rogers and Zervas,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

ONG Corp. [applicant] has applied to register the mark WAVETRACE, in typed or standard character form, for goods identified as "sound recording, transmission, and reproducing apparatus, namely, audio encoding and decoding circuit boards and software for converting audio content to and from digital audio files," in Class 9. The application is based on applicant's stated intention to use the mark in commerce.

**Opposition No. 91162058**

When the mark in the application was published for opposition, Bose Corporation [opposer] filed a notice of opposition. Opposer's pleading asserts that opposer has used, since prior to applicant's filing date of May 5, 2003, the marks WAVE, ACOUSTIC WAVE, PROFESSIONAL WAVE, WAVESYNC and WAVE/PC for various items of audio equipment. Opposer's pleading also asserts that these marks are all registered, and copies of six registration certificates were attached to the notice of opposition.<sup>1</sup> Opposer asserted that it "owns valuable goodwill in its marks" and that use of applicant's mark for the goods identified in applicant's application would result in a likelihood that consumers would be confused, mistaken or deceived as to the source of opposer's and applicant's respective goods.

Applicant denied, expressly or effectively, all of the allegations of the complaint, except for the allegations relative to the filing of applicant's application and the publication of applicant's mark for opposition. Applicant did not plead any affirmative defenses or assert any counterclaims.

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<sup>1</sup> ACOUSTIC WAVE is the mark in two of the registrations. Opposer's claim of priority of use of the various marks states that the marks have been used for "one or more of" a long list of items and does not specifically identify items for which each mark has been used. The registration certificates show that the marks were each registered for only certain items, and in some cases for only one item.

**Opposition No. 91162058**

Neither party amended its pleading prior to trial. At trial, opposer took only one testimony deposition, specifically, the testimony deposition of Santiago Carvajal, "category business manager for Wave systems." Through Mr. Carvajal's testimony, opposer introduced 83 exhibits. Applicant did not take any testimony but filed a notice of reliance to introduce into the record copies of two patents and opposer's responses and objections to applicant's interrogatories.

The parties have filed briefs, and opposer requested and appeared at an oral hearing. Applicant did not attend the testimony deposition of Mr. Carvajal or the oral hearing. Neither party has asserted any objections to the evidence of the other.

Had opposer properly established, in any one of various ways, its ownership of, and the current status of, its pleaded registrations, that would have been sufficient to establish opposer's standing and to remove priority as an issue to be proved. See TBMP Section 704.03(b)(1)(A) (2d ed. rev. 2004) for an explanation of the various ways in which an opposer can ensure that its pleaded registrations are entered into or considered to be part of the record; see King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974), and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995),

**Opposition No. 91162058**

for the proposition that priority of use of a mark need not be proved when a pleaded registration for that mark is properly made of record.

Opposer's pleading did not make its registrations of record because the copies attached thereto are, with one exception, plain photocopies, not certified copies prepared by the USPTO showing status and title.<sup>2</sup> The one exception is the copy of Registration No. 1633789 for the mark WAVE for "radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players," in Class 9. The copy of this registration is a photocopy of a certified copy prepared by the USPTO showing status and title. However, the certified copy used to make the photocopy was prepared in March 1993, more than 11 years prior to the filing of the notice of opposition. This is not reasonably contemporaneous with the date of filing of the complaint. See Hard Rock Café International (USA) Inc. v. Elsea, 56 USPQ2d 1504, 1511 (TTAB 2000)(status and title copies prepared three years prior to notice of opposition not reasonably contemporaneous with filing of complaint). Thus, status and title of even this registration were not

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<sup>2</sup> Copies showing status and title do not need to be certified, see TBMP Section 704.03(b)(1)(A), but all copies presently prepared and issued by the office with a designation of status and title are certified copies.

properly proved by the copy submitted with the notice of opposition.<sup>3</sup> Nor did the answer to the notice of opposition admit opposer's ownership of the registrations and their continuing validity.<sup>4</sup> Thus, proper introduction of the registrations was a matter to be completed at trial.

As noted above, the TBMP outlines various ways for a plaintiff to make its pleaded registrations part of the record, including by appropriate testimony from a competent witness, and even notes ways in which a defendant may effectively have stipulated that the pleaded registrations are of record notwithstanding that a plaintiff has not properly introduced them. In this case, opposer's witness was asked, in regard to each of the pleaded registrations, to read from the copies the registration number, mark, and listed goods. The witness was not, however, asked to testify as to the ownership of or current status of any of the registrations. Accordingly, the registrations were not properly made of record during the testimony of Mr.

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<sup>3</sup> We note that it is not improper to submit a photocopy of a proper status and title copy, but the underlying status and title copy must have been prepared reasonably contemporaneously with the filing of the plaintiff's complaint.

<sup>4</sup> Items attached to a pleading (with the exception of certified copies of registrations showing status and title) do not form part of the trial record in a Board inter partes proceeding, in the absence of an admission of their authenticity by the non-offering party in a responsive pleading, or by a stipulation of the parties, or by proper introduction during trial. See Trademark Rule 2.122(c) and (d), 37 C.F.R. §2.122(c) and (d); see also TBMP Sections 317, 704.05, 704.06 and 706 (2d ed. rev. 2004).

Carvajal.<sup>5</sup> Nonetheless, applicant stated in its brief that "Opposer Bose Corporation is the owner of the registered trademarks WAVE, ACOUSIC [sic-should be ACOUSTIC] WAVE, and WAVE/PC which it has used for radios, audio tape players, compact disc players, loudspeaker systems, and sound systems coupling a radio to a computer." We take this as an admission that four of the six pleaded registrations exist and are owned by opposer. See West Point-Pepperell, Inc. v. Borlan Industries, Inc., 191 USPQ 53, 54 (TTAB 1976). Accordingly, applicant's admission effectively establishes opposer's standing and removes priority as an issue, as to the following registered marks:

WAVE, Registration No. 1,633,789, registered February 5, 1991 and renewed in 2001, covering "radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players";

ACOUSTIC WAVE, Registration No. 1,764,183, registered April 13, 1993 and renewed in 2002, covering "loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player";

ACOUSTIC WAVE, Registration No. 1,338,571, registered May 28, 1985 and renewed in 2004, covering "loudspeaker systems"; and

WAVE/PC, Registration No. 2,552,385, registered March 26, 2002, covering "sound reproducing system

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<sup>5</sup> Nor was the witness asked about his knowledge of the registrations, opposer's records related thereto, or any other questions that would have established that he was competent to testify to such matters.

comprised of a radio, electronic interface for coupling the radio to a computer, and computer software for controlling the signal transmission between the radio and the computer."

The Board has stated its predisposition "to be liberal in finding admissions as to title to and subsistency of registrations" in cases where the plaintiff has not properly entered its pleaded registrations into the record, Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945, 949 (TTAB 1983). We have not, however, had to be particularly liberal in construing applicant's brief to find applicant's admission. The brief can hardly be said to be equivocal on the issue of opposer's ownership of valid registrations for particular marks, and applicant did not argue at all in its brief that opposer does not have standing or is not the prior user of its marks. Instead, applicant argued only that there is no likelihood of confusion between applicant's mark and the WAVE, ACOUSTIC WAVE and WAVE/PC marks of opposer.

Because applicant has admitted that four of opposer's pleaded registrations are registered and owned by opposer, opposer's standing has been established and its priority with respect to the registered marks for the goods identified therein is not in issue. However, even if opposer's ownership of the registered marks registrations had not been admitted, there is ample evidence in the record

establishing both opposer's standing and its prior and continuous use of these marks.

As for standing, an opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); see also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). To establish a reasonable basis for a belief that one would be damaged by the registration sought, a pleading may assert a likelihood of confusion that is not wholly without merit. Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Here, the notice of opposition alleges that opposer is the owner of various registered trademarks, asserted to have been in use since long prior to the filing date of applicant's involved intent to use application. The element common to each of opposer's marks is also the first word in applicant's mark, and opposer asserts that when applicant's mark is used for its goods, there will be a likelihood of confusion among consumers. Because the record bears out opposer's claim of prior use and that the goods of opposer and applicant are related, opposer has established its standing.

As for priority of use, we must consider items in evidence as a whole, not merely whether any individual item of evidence is sufficient to establish priority. West

Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) ("one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use"). Opposer's witness was not asked directly when each of the pleaded marks was first used. None of the exhibits introduced by the testimony of the witness establishes a particular sale of goods bearing a particular mark. Nonetheless, applicant introduced into the record opposer's responses to applicant's interrogatories, and opposer's response to interrogatory no. 2 states that opposer first used the WAVE mark on September 25, 1989 and first used the ACOUSTIC WAVE mark on February 1, 1984. Testimony from opposer's witness, and exhibits attached thereto, while not corroborative of these particular dates, clearly establishes the history of opposer's business, its development of various products sold under the mark WAVE or marks including that term, and that these products were introduced to the marketplace long before applicant's filing date. See, for example, the Carvajal dep. at various places:

"...So I joined Bose in 1995. Q. What was your title, your first job here? A. My first title was associate product manager. Q. What was the product? A. Wave radio actually. It was right after the Wave radio was introduced to the market." (p. 9);

**Opposition No. 91162058**

"I believe it's 1984 when we introduced the Acoustic Wave Music System." (p. 12);

Testifying to sales "in excess of 550,000 units" of the Acoustic Wave Music System since its introduction and valued "in excess of \$600 million" (pp. 14-15);

"The Wave radio is a smaller version of the Acoustic Wave Music System... It's a much smaller product that was introduced in 1993 and at a much lower price than the Acoustic Wave Music System. ...  
Q. The Wave radio was introduced, you said, in 1993? A. 1993. Q. What about the Wave radio/CD? A. The Wave radio/CD was introduced in 1998, and basically what that is, is very similar to the Wave radio but it just added a CD player to it." (pp. 45-46);

Testifying to sales of "well over three million units" of the Wave radio and Wave CD valued at "well over \$1.4 billion." (pp. 46-47); and

"A. Wave/PC is a product we introduced back in 2001 based on the Wave radio platform, so it uses the same -- a very similar platform to the Wave radio, but it had some electronic changes inside, some modifications inside, and the product also included software that customers would install on their personal computers." (pp. 70-71).

Other pieces in the puzzle establishing opposer's priority include the numerous dated reviews of opposer's various products that have appeared in various publications over the years, all of which were introduced as exhibits to the Carvajal testimony; and Carvajal exhibit 53, which catalogs numerous cards and letters received from purchasers of opposer's products stating their opinions of the products.

We turn, then, to the question of likelihood of confusion. Our determination under Section 2(d) is based on

an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); see also, In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the fact that the goods are related. 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 differences in the marks"). The fame of opposer's WAVE and ACOUSTIC WAVE marks also is critical in this case. See Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (The "fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *du Pont* factors" and famous marks therefore "enjoy a wide latitude of legal protection"). See also, Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002) (WAVE and ACOUSTIC WAVE marks found to be famous and entitled to a broad scope of protection). We hasten to add that we do not find opposer's marks to be famous merely because they have previously been found to be famous, and note that the record created in this

case establishes significant sales and expenditures on advertising<sup>6</sup>, widespread national advertising, and numerous pieces of favorable publicity in media throughout the country.

To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these means of comparison may be critical in finding marks to be similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 (TTAB 1988); see also, In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988). In fact, "the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark." In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983). In addition, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties,

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<sup>6</sup> Sales figures have been recited in our discussion of excerpts from the Carvajal testimony that establish opposer's priority. We add to those excerpts the following: "Q. With your understanding of the Bose market, can you give me a conservative estimate of how much has been spent to market the Acoustic Wave and Wave products? A. It's well over \$360 million." (p. 61).

including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, opposer uses the element WAVE in each of its pleaded marks. In fact, it is the entirety of one of opposer's marks and is the dominant term in the ACOUSTIC WAVE and WAVE/PC marks, as the other terms in those two marks are somewhat suggestive of the products for which those marks have been registered. WAVE is also most likely to be seen by consumers as the dominant element in applicant's mark, simply because it is the first word in the compound WAVETRACE. See Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895 (TTAB 1988). Overall, we find the marks similar and in particular note that whatever connotation consumers would attach to WAVE for the involved audio products would be the same for both opposer's marks and applicant's marks.

Turning to the goods, applicant stresses that its goods "are encoding software and circuit boards which are clearly understood by the Trademark Examiner and those in the

industry to be different and distinct from Opposer's products." Brief, unnumbered p. 2 of 3. Opposer's witness, however, has testified, "There is a decoding circuit board inside the Wave Music System. We have a microprocessor that decodes those files and then plays [digital audio files] back through the system." (Carvajal dep., p. 63.) In addition, in an extensive discussion of opposer's WAVE/PC product, opposer's witness explained that this product allows consumers to store music on their personal computers and to listen to that music and Internet radio stations via a link between their computers and their WAVE music systems. In particular, Mr. Carvajal testified "The Wave/PC software has basically a MP3 encoder, so if you were to take a CD and put it on the WAVE/PC software it would read that CD, encode it into MP3 files, digital music files, store them in your hard drive, and then you could access those files and decode them and play them through the Wave radio." (pp. 71-72.)

There is also information in the record, via exhibits to the Carvajal testimony, that components of opposer's products, including software elements with functions similar to applicant's product, are proprietary in nature and are promoted as elements contributing to the superiority of opposer's products. There is nothing in the record to indicate that opposer markets these components to makers of finished audio products. Thus, in that sense, it does not

appear from the record that opposer and applicant are competitors. Nonetheless, we find the goods clearly related.

It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). That is, likelihood of confusion may exist even if the parties are not direct competitors, and the rights of the owner of a mark extend to any goods and services that potential purchasers might think are related or put out by the same producer. In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001). Finally, we note that the protection accorded registered marks, even those that are not famous, includes a zone of natural expansion. See Mason Engineering & Designing Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985). Because opposer utilizes in its finished products elements that are similar in function to the product of applicant, it would be within opposer's zone of natural expansion to consider marketing such elements to other producers of finished products.

**Opposition No. 91162058**

In sum, because the record establishes opposer's ownership of its pleaded registered marks, as well as opposer's priority of use of those marks, and in view of the similarity of the marks and the involved goods and the fame of opposer's marks, there is a clear likelihood of confusion.

Decision: The opposition is sustained.