Paper No. 10
Bottorff

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Winfield Locks, Inc.

Serial No. 75/357,114

Edgar A. Zarins for Winfield Locks, Inc.

Cheryl S. Goodman, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney)

Before Simms, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark MICROCARD, in typed form, for goods identified as "electronic door access systems comprising recodable machine-readable entry key, key encoder and electronic entry lock."[1]

The Trademark Examining Attorney has refused

[1] Serial No. 75/357,114, filed September 15, 1997. The application is based on intent-to-use under Trademark Act Section 1(b).

registration of applicant's mark under both Trademark Act Section 2(e)(1), 15 U.S.C. §§1052(e)(1), and Trademark Act Section 2(d). More specifically, she has refused registration under Trademark Act Section 2(e)(1) on the ground that applicant's mark, as applied to applicant's goods, is merely descriptive. She also has refused registration under Trademark Act Section 2(d) on the ground that applicant's mark, as applied to applicant's goods, so resembles each of two registered marks (which are owned by a single registrant) as to be likely to cause confusion, to cause mistake, or to deceive.

The first registration[2] cited by the Trademark Examining Attorney as a bar to registration of applicant's mark under Section 2(d) is of the mark MICRO CARD for goods identified in the registration as

> electronic systems for processing and storing data in connection with smart card applications; namely, host computers, card readers, customer terminals for interfacing between a smart card and a host computer, card connectors, access control terminals, machine-readable cards including an imbedded microprocessor and software for smart card applications.

[2] Registration No. 1,725,122, issued October 20, 1992. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged. The registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f).

The second cited registration[3] is of the mark MICRO CARD TECHNOLOGIES, INC. and design (TECHNOLOGIES, INC. disclaimed), depicted below, for goods identified in the registration as "electronic terminals used for processing and storing data in conjunction with machine readable cards, namely microcomputers, processors and information processing connectors."

When the three refusals were made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs. Applicant did not file a reply brief, nor did applicant request an oral hearing.

We turn first to the mere descriptiveness refusal under Section 2(e)(1). A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir.

[3] Registration No. 1,504,673, issued September 20, 1988. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged.

1987), and *In re Abcor Development Corp.,* 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.,* 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applying these principles to the present case, we find that applicant's mark MICROCARD is merely descriptive of applicant's goods, inasmuch as it merely consists of the combination of two words which, whether considered separately or in combination, directly and immediately describe a significant component or feature of opposer's electronic door access system.

The Trademark Examining Attorney has presented evidence establishing that “micro” is short for “microprocessor.” See the dictionary evidence attached to the initial office action. Applicant’s own web site marketing materials, made of record by the Trademark Examining Attorney, establish that applicant’s electronic door access systems utilize an access key card into which a microprocessor has been embedded. Thus, the term “micro” immediately and directly describes this feature or characteristic of applicant’s goods, i.e., that the goods employ microprocessor technology. Applicant has not contended otherwise.

Likewise, the word “card” is merely descriptive of the “access key” component of applicant’s system. In its marketing materials, applicant repeatedly and consistently refers to this component as a “card,” e.g.: “…Once this new **card** is inserted, the lock will no longer accept the previously used guest MicroCard”; “The **card** can be reprogrammed indefinitely”; “The front desk clerk simply enters a few keystrokes (quick and easy) and one of the reusable **cards** is programmed for a guest”; “The **card** encoder is used at the front desk, mainly to program guest **cards**”; “No loss of synchronization occurs between front desk and guest room door, even if **cards** are made and not

used. The lock always accepts the last guest **card** made at the front desk for the proper guest room"; and "The maid **card** or the maintenance **card** receives a flashing light if a guest is in the room and the deadbolt is thrown." (Emphasis added.) This evidence of applicant's own use of the term belies its argument that CARD does not immediately describe this component of its goods.

The mere descriptiveness of the words MICRO and CARD, as applied to applicant's goods, is not eliminated by their combination into the single word MICROCARD. The composite term directly and immediately informs purchasers and users that applicant's electronic door access systems utilize a key "card" which employs a "micro" or microprocessor. The combination of these two merely descriptive words does not result in a composite term which creates a new, unusual or incongruous commercial impression. The composite term is as lacking in inherent distinctiveness as the two words are when considered separately.

Applicant argues that it is seeking to register the mark for an entire electronic door access system, not just for the key card component. However, as noted above, the Section 2(e)(1) refusal is appropriate if the mark merely describes one significant feature or component of the goods; it need not describe all features or components of

the goods. The key card with embedded microprocessor certainly is a significant, indeed crucial, component of applicant's system, and because MICROCARD is merely descriptive of that component, it also is merely descriptive of the goods identified in the application, for purposes of Section 2(e)(1).

For the reasons set forth above, we affirm the Trademark Examining Attorney's mere descriptiveness refusal under Trademark Act Section 2(e)(1).

We turn next to the Section 2(d) refusals issued by the Trademark Examining Attorney. Our likelihood of confusion 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 E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities 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, 29 (CCPA 1976).

Applicant's mark MICROCARD is essentially identical to MICRO CARD, the mark registered in Registration No. 1,725,122, and it is highly similar to MICRO CARD

TECHNOLOGIES, INC. and design, the mark registered in Registration No. 1,504,673. Applicant has never contended otherwise. Neither the presence in the latter registered mark of the design element and the disclaimed and descriptive words TECHNOLOGIES, INC. nor the space between the words MICRO and CARD in each of the registered marks suffice to distinguish applicant's mark from the respective registered marks, for purposes of our likelihood of confusion analysis. Thus, the first *du Pont* evidentiary factor weighs significantly in favor of a finding of likelihood of confusion in this case.

We next must consider the similarity and commercial relationship between applicant's goods, as identified in the application, and the goods identified in the cited registrations. It is not necessary that these respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are 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 producer or that there is an association or connection

between the producers of the respective goods. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991*); In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, the greater the degree of similarity between the parties' marks, the lesser the degree of similarity between the parties' respective goods that is required to support a finding of likelihood of confusion, and where the parties' marks are essentially identical, there need be only a viable relationship between their respective goods in order to find that a likelihood of confusion exists. *See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). Finally, our determination must be based on a comparison of the goods as they are identified in the application and in the cited registrations, rather than on the basis of any actual limitations or restrictions to the goods as actually used in commerce by applicant or registrant. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applying these principles to the present case, we find that applicant's goods are sufficiently similar to the goods identified in the cited registrations that confusion is likely to result from the contemporaneous use thereon of

the identical and/or highly similar marks involved in this case.

Regarding Registration No. 1,725,122, we agree with the Trademark Examining Attorney's contention that applicant's goods, i.e., "electronic door access systems comprising recodable machine-readable entry key, key encoder and electronic entry lock," are encompassed within, and a species of, the goods identified in the registration, i.e.:

> electronic systems for processing and storing data in connection with smart card applications; namely, host computers, card readers, customer terminals for interfacing between a smart card and a host computer, card connectors, access control terminals, machine-readable cards including an imbedded microprocessor and software for smart card applications.

The particular components of applicant's system are included in this registration's identification of goods. Applicant's "recodable machine-readable entry key" is essentially a "machine-readable card[] including an imbedded microprocessor." Applicant argues that its "key" is not a "card," but we reject that argument for the reasons discussed above in connection with the Section 2(e)(1) refusal. Similarly, applicant's "key encoder," which, according to applicant's advertising materials, is

used to reprogram the key cards so as to deny hotel room access to unauthorized persons, can be deemed to be, essentially, an “access control terminal.” Applicant’s “electronic entry lock” is essentially a “card reader” which scans the encoded key card and either admits or denies access to the room, as appropriate.

In addition to the similarity of the various components of applicant’s system to the components of the system identified in the registration, applicant’s “electronic door access systems,” as a whole, can reasonably be deemed to be a species of registrant’s “electronic systems for processing and storing data in connection with smart card applications…” Applicant’s advertisements reveal that applicant’s system processes and stores data, such as the currently encoded access number for a particular hotel room and a record of the last forty entries into a particular hotel room. We also find that applicant’s electronic door access system is or may be a “smart card application” within the meaning of registrant’s identification of goods.

In this regard, the Trademark Examining Attorney has submitted a dictionary definition of “smart card” which defines the term as “a plastic card the size of a credit card that has an embedded microprocessor for storing

information, used for banking, medical alerts, etc. It is used by inserting it into a reading device which is connected with a main computer." Similarly, it appears from the record that a "smart card" is a card that, instead of utilizing a magnetic stripe, contains a microchip in which information can be stored and processed, and that these cards are used in many different applications, both financial and nonfinancial. And, of particular relevance to the present case, it appears from the record that such "smart card" applications can include building security and access systems, in which relevant authorization data is stored on a card which is scanned by a card reader to determine whether building access is allowed or denied.[4]

Thus, applicant's goods are encompassed within, and accordingly are legally identical to, the goods identified

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[4] We acknowledge that, to the extent that a "smart card" has been referred to as being in the size and shape of a credit card, it appears from applicant's advertising materials that applicant's access key cards may not be "smart cards," because they are not in the shape and size of a credit card. Conversely, however, applicant's key cards, like smart cards, operate by means of an embedded microprocessor chip rather than a magnetic stripe. However, even assuming that applicant's system does not presently use smart card technology, applicant's identification of goods is sufficiently broad to encompass a system which uses such technology. Applicant would be entitled, under its current identification of goods, to market an electronic door access system which comprises a "smart card application." It is that identification of goods which is determinative in our likelihood of confusion analysis, not applicant's actual goods as they presently are configured. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, *supra*.

in Registration No. 1,725,122. That is, "electronic systems for processing and storing data in connection with smart card applications…" would include "electronic door access systems," for purposes of our likelihood of confusion analysis. Moreover, neither registrant's nor applicant's identification of goods is limited in any way as to trade channels or classes of customers, and we accordingly presume that each parties' goods move in all normal trade channels and are marketed to all normal classes of customers for such goods. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981). To the extent that applicant's goods are legally identical to registrant's goods, applicant's and registrant's respective trade channels and classes of customers also must be deemed to be the same.

We likewise find that applicant's goods are closely related, if not legally identical, to the goods identified in the second cited registration, Registration No. 1,504,673, i.e., "electronic terminals used for processing and storing data in conjunction with machine readable cards, namely microcomputers, processors and information processing connectors." It is apparent from applicant's literature that applicant's "electronic door access system" includes components, i.e., the "key encoder" and the "electronic entry lock," which, like the "electronic

terminals" identified in the registration, are "used for processing and storing data in conjunction with machine readable cards."

In summary, we find that applicant's goods are closely related to, indeed legally identical to, the goods identified in each of the cited registrations, and that applicant's and registrant's respective goods must be presumed to be marketed in the same trade channels and to the same classes of customers. These *du Pont* factors weigh in favor of a finding of likelihood of confusion in this case.

Having carefully considered all of the evidence of record with respect to the relevant du Pont factors, we conclude that a likelihood of confusion exists as between applicant's mark, as applied to applicant's goods, and the marks and goods set forth in the registrations cited by the Trademark Examining Attorney, i.e., Registration Nos. 1,725,122 and 1,504,673. Accordingly, we affirm each of

the Trademark Examining Attorney's Section 2(d) refusals.

Decision: The refusal to register under Section 2(e)(1) and the two refusals to register under Section 2(d) are all affirmed.

R. L. Simms

T. J. Quinn

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board