

2000 TTAB LEXIS 767, *

Red Hat, Inc. (by name change from Red Hat Software, Inc.) n1 v. CMC Magnetix Corp. Ltd.

n1 Inasmuch as the name change document in connection with opposer's pleaded registrations is recorded with the Assignment Branch of the PTO at reel 1934, frame 0491, the Board has amended the caption of this proceeding. TBMP Section 512.02.

Opposition No. 113,557

Trademark Trial and Appeal Board

2000 TTAB LEXIS 767

October 31, 2000, Decided

[*1]

Before Hohein, Chapman and Rogers, Administrative Trademark Judges.

**OPINION:
THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.**

By the Board:

CMC Magnetix Corp. Ltd. ("applicant") seeks to register the mark MR. DATA and design, as reproduced below in reduced form, [SEE ILLUSTRATION IN ORIGINAL] for "electronic equipment and its components and magnetic storage media, namely, fax machines; televisions, television receivers; audio cassette recorders and players; video cassette recorders; cameras, digital cameras; camcorders; stereo equipment, namely, stereo speakers; radios; video tapes; blank magnetic tapes; blank magnetic discs; blank floppy discs; blank compact discs, blank CD-ROMs and blank CD-Rs (recordable compact discs); blank digital video discs (DVDs); blank DVD-ROMs, blank DVD-Rs and blank DVD-RAMs." n2

n2 Application Serial No. 75/287,519, filed on May 6, 1997, based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

Registration has been opposed by Red Hat, Inc. ("opposer") on the grounds that (1) the involved mark, if applied to applicant's goods, would so resemble **[*2]** the following marks, which have been previously used and registered by opposer, as to be likely to cause confusion, mistake or deception: RED HAT for "computer software, namely, computer programs for operating systems, system administration, computer communications administration, and instructional materials provided therewith as a unit" in International Class 9 n3 and "providing consultation in the field of computer software" in International Class 42; and the design mark shown below, [SEE ILLUSTRATION IN ORIGINAL] for "computer software, namely, computer programs for operating systems, system administration, and computer communications administration, and instructional materials provided therewith as a unit" in International Class 9 and "technical support services in the field of computer software" in International Class 42; n4 and (2) the involved mark, if applied to applicant's goods, would dilute opposer's pleaded marks.

n3 Registration No. 2,142,662, issued March 10, 1998 and reciting July 29, 1994 as the date of first use and first use in commerce in International Class 9 and November 2, 1994 as the date of first use and first use in commerce in Class 42.

n4 Registration No. 2,161,889, issued June 2, 1998 and reciting October 4, 1996 as the date of first use and first use of the mark in commerce in both International Classes 9 and 42. The mark is lined for the color red, and color is claimed as a feature of the mark. **[*3]**

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

This case now comes up for consideration of applicant's motion (filed October 14, 1999) for summary judgment on the grounds that there is neither likelihood of confusion nor dilution, and opposer's cross-motion (filed November 18, 1999) for summary judgment on the same grounds. Both motions are fully briefed. n5

n5 We have considered opposer's reply brief because it clarifies the issues before us. See Trademark Rule 2.127(a).

In support of its motion, applicant argues that because of the dissimilarities of the parties' marks, there is no genuine issue of material fact regarding both likelihood of confusion between applicant's involved mark and opposer's pleaded marks and dilution of opposer's pleaded marks by applicant's involved mark. n6

n6 Although applicant did not submit its motion for summary judgment as a separate paper, the Board deems applicant's memorandum of law (filed October 14, 1999) as incorporating a proper motion for summary judgment. See Trademark Rule 2.127(a). In view thereof, opposer's challenge to the Board's jurisdiction over applicant's motion is not well taken and will receive no further consideration. [*4]

As evidentiary support for its motion, applicant has submitted: (i) an enlarged copy of the mark in the involved application as published in the Official Gazette on November 3, 1998; (ii) photocopies of opposer's pleaded registrations; (iii) photocopies of packaging depicting opposer's marks; (iv) copies of opposer's responses to applicant's interrogatories; (v) copies of documents produced by opposer in response to applicant's requests for document production; and (vi) a declaration from its counsel, Roy S. Gordet, introducing applicant's exhibits.

Turning to opposer's motion for summary judgment, and in regard to the likelihood of confusion claim, opposer argues that a side-by-side comparison of the marks is inappropriate and that, instead, the Board should evaluate how a consumer, who has previously seen or heard about opposer's goods, would remember opposer's mark and be affected by that memory when later confronted with applicant's mark alone. Opposer further argues that applicant's addition of the wording MR. DATA is insufficient to distinguish the marks in issue because purchasers could mistakenly believe that the wording constitutes a separate mark and that the design component [*5] of the applicant's involved mark designates opposer's goods. Opposer finally argues that all of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), favor opposer.

Regarding the dilution claim, opposer contends that its pleaded registered marks are famous and have been in use since before the filing date of the involved application; and that, inasmuch as there is no evidence that any other hat designs are used to identify the products of third parties in the field of computer hardware, software and accessories, applicant's mark "will dilute" opposer's pleaded marks.

As support for its position, opposer submitted: (i) the declaration of its chief counsel, David Shumannfang, in which he primarily avers that opposer's pleaded marks are famous and introduces news clippings as evidence of their fame; (ii) the declaration of its chief marketing officer, Thomas Butta, avering that the design portion is dominant in creating the commercial impression of applicant's mark; (iii) samples of news clippings featuring opposer's pleaded marks; (iv) photocopies of computer catalogs; (v) a specimen [*6] of applicant's mark in use in foreign commerce; n7 and (vi) samples of packaging in which opposer's goods are used.

n7 In its brief in opposition to opposer's cross-motion for summary judgment, applicant has objected to opposer's introduction into evidence of the specimen on the grounds that it is irrelevant because the Board must consider marks as they are applied for, not as they are used, and because a party's foreign use of an involved mark is irrelevant to the issues in a Board proceeding. See Wells Fargo Bank v. Stagecoach Properties, Inc., 685 F.2d 302, 216 USPQ 480, 484 (9th Cir. 1982); Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991); and Johnson & Johnson v. Salve S.A., 183

USPQ 375 (TTAB 1974). However, since applicant's mark is not limited to a particular color, the Board finds that, to the extent that the specimen shows an intended use of the involved mark in the color red, the specimen is relevant and, therefore, will be considered. **[*7]**

In response to opposer's cross-motion, applicant maintains that the marks are dissimilar and that opposer has ignored relevant case law in its arguments. Applicant further contends that its involved mark is not a design of a hat, but rather is composed of an abstract design that defies verbal description, and does not include a claim to the color red.

The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. See Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 730 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). See also TBMP section 528.01 and cases cited therein.

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 106 S. Ct. 2505 (1986); and Octocom Systems Inc. v. Houston Computers Services, Inc., 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). **[*8]** A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. See, e.g., Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Based on the record now before us and for the reasons discussed below, we conclude that summary judgment is appropriate in this case because applicant has established that there are no genuine issues of material fact remaining for trial and that it is entitled to a judgment dismissing opposer's likelihood of confusion and dilution claims as a matter of law.

Initially, we note that for purposes of applicant's motion for summary judgment, applicant appears to concede that opposer's pleaded registrations are valid and subsisting and that priority, therefore, is not in issue. See King Candy Co. v. Eunice King's Kitchen, Inc., 182 USPQ 108, 110 (TTAB 1974). We note, however, that, inasmuch as the parties' marks are so dissimilar, **[*9]** there is no likelihood of confusion. Specifically, after a careful review of the record in this case, we find the circumstances here are similar to those in Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single *du Pont* factor of the similarity or dissimilarity of the marks in their entireties outweighs all other relevant factors and is dispositive of the issue of likelihood of confusion.

In considering the similarities and dissimilarities of the parties' marks, we evaluate, among other things, the visual appearance and sound of the parties' marks. None of opposer's marks contain the terms "Mr." (or its full-length form, "mister"), or "data", or their phonetic equivalents. Moreover, in comparing the design elements of the parties' marks, we find that the differences outweigh the similarities. The graphic elements in the designs of the parties' marks present different types of hats in very different stylizations. A common reference to hats in the relevant marks is not enough to render those marks similar in their entireties. **[*10]**

Opposer's marks not only differ greatly in appearance and sound from applicant's composite mark, but also convey a much different overall commercial impression, even when applicant's mark is presented in the color red. It is our view that the wording MR. DATA in conjunction with a depiction of a stovepipe hat with an orbiting planet and moon brim suggests an intergalactic connotation. n8 This is to be distinguished from the connotation of opposer's word mark, which literally connotes a red hat, and its design mark, which denotes a shadowy and decidedly earthbound figure wearing a red fedora hat.

n8 Inasmuch as the letter M in applicant's involved mark nearly touches the orbit in the design portion thereof, opposer's contention that purchasers will view that mark as two separate marks is unpersuasive.

We are not persuaded by opposer's contention that the design portion of applicant's mark is dominant in creating the commercial impression thereof. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987); [*11] Amoco Oil Co. v. Amerco, Inc., 192 USPQ 729 (TTAB 1976).

Furthermore, we are not persuaded by opposer's contention that applicant's mark and opposer's pleaded marks are legal equivalents under In re Duofold, Inc., 184 USPQ 638 (TTAB 1974). Rather, we find that, even if presented in the color red, applicant's involved mark, when viewed in its entirety, is so highly stylized that it would not readily evoke a connection with RED HAT and thus would not result in a likelihood of confusion. See In re Serac, Inc., 218 USPQ 340 (TTAB 1983).

In addition, while opposer correctly contends that the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, for the foregoing reasons, we conclude that the parties' marks do not convey the same overall commercial impression, inasmuch as they do not look alike, do not sound alike, and do not convey similar meanings. In short, the marks are so dissimilar that there is no likelihood of confusion between them. See, e.g., G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990). [*12]

As such, there is no genuine issue as to any fact that would be material to the question of likelihood of confusion, and applicant is entitled to judgment on this issue as a matter of law.

Considering next the issue of dilution under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c), to cause dilution of the distinctive quality of a senior mark, the marks in issue must be of such similarity that, in the minds of consumers, the junior mark will conjure an association with the senior. Nabisco, Inc. v. PF Brands, Inc., 51 USPQ2d 1882, 1889 (2d Cir. 1999); Luigino's, Inc. v. Stouffer Corp., 170 F.3d 827, 50 USPQ2d 1047 (8th Cir. 1999); Mead Data Central v. Toyota Motor Sales, Inc., 10 USPQ2d 1961, 1964 (2d Cir. 1989). The United States Court of Appeals for the Sixth Circuit has stated that the extent of similarity necessary to show dilution is greater than that which is required to show likelihood of confusion. Jet, Inc. v. Sewage Aeration Sys., 165 F.3d 419, 49 USPQ2d 1355 (6th Cir. 1999).

We [*13] find that the commercial impressions of the marks in issue are so dissimilar that, in the minds of consumers, applicant's mark will not conjure an association with opposer's marks. Furthermore, inasmuch as the marks in issue are not similar enough to satisfy even the likelihood of confusion test, opposer's claim of dilution must fail as well. As such, we find that there is no genuine issue of material fact with regard to opposer's claim of dilution, and applicant is entitled to judgment on this issue as a matter of law.

In view thereof, applicant's motion for summary judgment is granted, and opposer's cross-motion for summary judgment is denied. n9 See Fed. R. Civ. P. 56(c). Accordingly, the opposition is hereby dismissed with prejudice.

n9 Applicant's motion (filed October 14, 1999) to extend discovery is moot.

G. D. Hohein

B. A. Chapman

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board