

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: 12/7/2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prosodie S.A.

Serial No. 76210364

Robert E. Rosenthal of Duane Morris for applicant.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Simms, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Prosodie S.A. to register
the mark PROSODIE for "telecommunications services, namely,
local and long distance transmission of voice and data by
means of telephone transmissions, telephone voice
messaging, data transmission, facsimile transmission and
providing multiple-user access to a global computer
information network."¹

¹ Application Serial No. 76210364, filed February 14, 2001, based
on an allegation of a bona fide intention to use the mark in
commerce.

The trademark examining attorney refused registration on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark PROSODY for the goods and services set forth below² as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Computer telephony equipment, namely, speech processing and recognition platforms, audio recorders and players, dialers, tone and pulse detectors, matrix conferencing platforms, signal processors, telephone interfaces; telecommunications equipment, namely, speech processing and recognition platforms, audio recorders and players, dialers, tone and pulse detectors, matrix conferencing platforms, signal processors, telephone interfaces; computer software in the field of telecommunications for speech processing and recognition, audio recording and audio playing, dialing, tone and pulse detection, matrix conferencing, signal processing, and telephone interfacing; speech processors; circuit boards for computers; integrated circuits; and parts for all aforesaid goods (in International Class 9);

Installation, maintenance and repair of computer telephony equipment, telecommunications equipment and computer hardware (in International Class 37);

Computer telephony, namely, providing computer-controlled telephone communication services; [and] telephone

² Registration No. 2488171, issued September 11, 2001.

communication services (in International Class 38); and

Installation, maintenance and repair of computer software (in International Class 42).

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant asserts that registrant's goods and services are marketed to business customers, and that these purchasers are sophisticated original equipment manufacturers (OEMs) and computer application developers. Applicant contends that registrant's primary product is a card for speech processing computer applications, and that registrant's services are closely associated with the speech processing cards. Applicant also argues that registrant's mark is descriptive of the "prosody" element of the standard used by registrant and, thus, the cited registered mark is entitled to only a limited scope of protection. Further, although indicating that "the term PROSODIE means 'prosody' in French," applicant points to the differences between the French and English spellings of the marks.³ In support of its arguments, applicant

³ We take judicial notice of the dictionary definition of the term "prosody": "song sung to instrumental music, modulation of

submitted excerpts from registrant's website on the Internet, as well as from its own website. Applicant also introduced an excerpt from the website of a third party in the computer field in an attempt to show the descriptiveness of the term "prosody."

The examining attorney maintains that not only are the marks foreign equivalents, but they are phonetically equivalent as well. According to the examining attorney, applicant's and registrant's services are related telecommunications services and that, in one instance, the services are identical (that is, telephonic transmission and communication services). In the examining attorney's view, the services are otherwise complementary. With respect to registrant's services, the examining attorney emphasizes that the identification of goods and services in the cited registration control, and that the identifications do not include any limitations as to classes of purchasers or trade channels.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set

the voice; the study of versification, esp. the systematic study of metrical structure; the rhythmic aspect of language." Webster's Third International Dictionary (unabridged ed. 1993).

Ser No. 76210364

forth in *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, 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 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As to the marks, although applicant contends that the difference in the spelling of the marks PROSODIE (French) and PROSODY (English) is "quite evident," applicant acknowledges that the terms are foreign equivalents. Thus, the marks convey the same meaning. Further, the marks are phonetic equivalents, and therefore are identical in sound. The marks also look alike, differing only in the last two letters. We find that the similarities between the marks in sound, appearance and meaning far outweigh the minor difference in spelling, and that PROSODIE and PROSODY engender virtually identical overall commercial impressions.

Applicant contends that registrant's mark is weak, pointing to alleged descriptive uses of the term by registrant and a third-party. The uses highlighted by applicant are ambiguous at best, and we find that the evidence falls short of supporting applicant's contention. Given the dictionary definition of "prosody," it would appear that the term is only suggestive of registrant's goods and services. An additional point should be made regarding applicant's argument that registrant's mark is descriptive as used in connection with registrant's services. (Brief, pp. 5-6). Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods and services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration, as is the case herein. See *In re Dixie Restaurants*, supra; and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992).

Insofar as the goods and services are concerned, it is not necessary that the goods and/or services of the parties

be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services 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).

Applicant's services and registrant's goods and services are all related to telecommunications. In comparing the services, applicant would have us focus on registrant's website excerpts showing, according to applicant, that registrant's services "must be closely associated with the speech processing cards extensively promoted under the PROSODY name." (Brief, p. 4). Applicant is relying upon registrant's website to improperly restrict the scope of registrant's services as identified in the cited registration. An applicant, however, may not restrict the scope of the goods covered in the registrant's registration by extrinsic evidence. See In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB

1986).⁴ We remind applicant that the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993). If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

In comparing the identifications in the application and the cited registration, we have focused on the fact that both specifically include telephone communication services (referred to as "telephone transmissions" in the application). Thus, at least insofar as these services are concerned, they are identical. See *Tuxedo Monopoly, Inc.*

⁴ So as to be clear, this is not a situation where the terminology in registrant's identification is unclear as to justify applicant's reliance on extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. Compare *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990).

v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion may be found between any one item in an application's identification of goods]. Further, registrant's telephone communications services are otherwise closely related to the rest of applicant's services listed in the application.

In reaching our decision, we have considered applicant's contention that the purchasers of its services and the goods and services of registrant are sophisticated, and that the purchase is made only after careful thought. It should initially be noted that neither applicant's identification nor registrant's identification is limited by class of purchasers. As broadly identified, the telephone communications services of both applicant and registrant are presumed to move in all normal trade channels to all classes of purchasers. These purchasers would include ordinary consumers who would not necessarily be sophisticated or thoughtful in purchasing such services. However, even if prospective purchasers of applicant's and registrant's services, such as OEMs and applications developers, are sophisticated, we find that the virtual identity between the marks and the telephone communications services clearly outweigh any purchaser sophistication.

Ser No. 76210364

See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, supra; and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.