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AS PRECEDENT OF THE TTAB JULY 22, 97

Hearing:
December 12, 1996

Paper No. 20
RLS/LCB

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Brown & Williamson Tobacco Corporation**

Serial No. 74/451,409

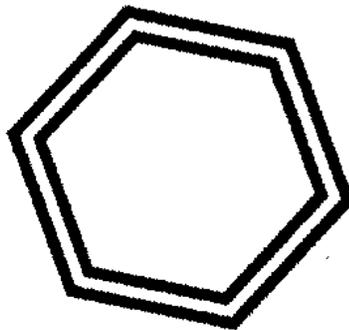
Amy B. Berge of Middleton & Reutlinger for applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (**David Shallant**, Managing Attorney)

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

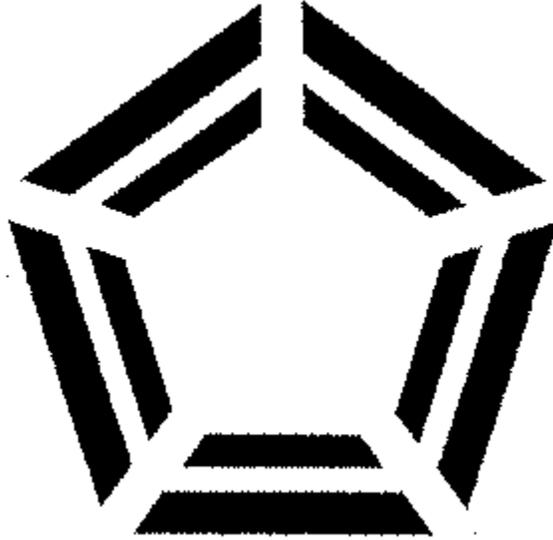
Opinion by Simms, Administrative Trademark Judge:

Brown & Williamson Tobacco Corporation (applicant) has
appealed from the final refusal to register the mark shown
below



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for cigarettes.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of the registered mark shown below, for cigarettes.²



Applicant and the Examining Attorney have submitted briefs and an oral hearing has been held.

The Examining Attorney argues that the respective marks are substantially similar in appearance and project the same commercial impression. Although the Examining Attorney concedes that applicant's mark is a closed design of six sides while registrant's is an "open" design of five sides, the Examining Attorney contends that the only real difference is that applicant's mark has "closed" corners.

¹ Application Serial No. 74/451,409, filed October 20, 1993, based upon applicant's allegations of use and use in commerce since at least as early as December 31, 1980. In the application, applicant claims ownership of Registration No. 1,388,505.

² Registration No. 1,752,003, issued February 9, 1993.

Final refusal, April 4, 1995, p. 2. Noting that the goods of applicant and registrant are identically described, the Examining Attorney argues that, in view of the fallibility of memory and considering the fact that the respective marks may be viewed without an opportunity for side-by-side comparison, confusion is likely.

Applicant, on the other hand, contends that registrant's mark is a stylized five-pointed star or starburst design within an open-cornered pentagon while applicant's mark is a hexagon with two sets of completely solid lines. According to applicant, in addition to the distinction between registrant's pentagonal and applicant's hexagonal design, the marks convey noticeably different images. Applicant also notes that geometric and other common shapes have not generally been accorded a wide scope of protection and have been characterized as relatively weak marks in terms of their inherent distinctiveness. In this regard, applicant has referred us to language from the Board's decision in *Guess ? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804, 1806 (TTAB 1990):

[C]ommon basic shapes such as circles, diamonds, triangles, squares, ovals, arrows and the like have been so commonly adopted as marks or as a part of marks for a variety of products in a variety of fields that whatever rights one possesses in such a design are confined to the particular design and cannot serve to preclude the subsequent registration of a similar yet readily distinguishable design for the same or similar goods.

Applicant also argues that the registered mark is not famous; rather, according to applicant's attorney and a declaration submitted during the prosecution of this case, applicant's GPC brand used with applicant's design is now the second leading cigarette brand in the United States with many millions of dollars in sales per year and over \$50 million in promotional and advertising expenses over the last five years. Applicant has also attested to the fact that there have been no instances of actual confusion despite over four years of co-existence of the respective marks. Finally, applicant points to the manner of application of registrant's mark (only on cigarette tipping paper or the tip of the cigarette) so that consumers do not see registrant's mark until after purchase, and applicant's ownership of other registrations which include the mark herein sought to be registered. In this regard, applicant argues that the Office's treatment of those applications (now registrations) vis-a-vis the cited mark has been inconsistent with the treatment of this application.³

Finally, applicant's attorney and the Examining Attorney have discussed a number of cases involving design

³ Those registered marks are reproduced below:

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marks. Among those are Daimler-Benz A.G. v. Ford Motor Company, 143 USPQ 453 (TTAB 1964), finding no likelihood of confusion between the following marks:

Applicant's Mark



Registered Marks



Daimler-Benz Aktiengesellschaft v. Chrysler Corporation, 169 USPQ 686 (TTAB 1971), finding no likelihood of confusion among the following marks:

Applicant's Mark



Registered Marks



and Daimler-Benz Aktiengesellschaft v. Nissan Jidosha Kabushiki Kaisha, 179 USPQ 182 (TTAB 1973), finding no likelihood of confusion among the following marks:

Applicant's Mark



Registered Marks



In cases involving the issue of likelihood of confusion between different design marks, the Board has noted that the

"eyeball" test involved in such determinations is relatively subjective. This case is a case in point. Upon careful consideration of the arguments of the attorneys, we conclude that applicant's mark is sufficiently different from the registered mark that, even on identical products such as cigarettes, confusion is not likely. We believe that registrant's mark would clearly be remembered as a pentagon (or perhaps a starburst design surrounded by broken lines), while applicant's mark is clearly a different figure projecting a different image and commercial impression.⁴

Decision: The refusal of registration is reversed.

R. L. Simms

E. W. Hanak

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board

⁴ Other arguments of applicant are unpersuasive, however. For example, the fact that registrant has indicated in its application that it applies its mark by affixing it to cigarette tipping paper is not persuasive. We must consider registrant's mark as applied to cigarettes or the packaging therefor, irrespective of the particular means of affixation set forth in registrant's application. Also, because applicant's other registrations are for different marks with different elements, albeit including a hexagonal design, we do not agree with applicant's assessment that the Office treatment of this application is necessarily inconsistent with its treatment of the other applications. However, that point is largely irrelevant.