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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Foseco International Limited
v.
Ashland Oil, Inc.

Opposition No. 90,496
to application Serial No. 74/143,477
filed on March 1, 1991

Herbert D. Hart III and David D. Headrick of McAndrews, Held & Malloy for Foseco International Limited.

David L. Hedden and Vernon F. Venne for Ashland Oil, Inc.

Before Cissel, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Ashland Oil, Inc. to register the mark ECOSET for "binders for making cores and molds for use in the manufacturing of metal castings."[1]

[1]Application Serial No. 74/143,477, filed March 1, 1991, based on a bona fide intention to use the mark in commerce. The record reveals that applicant's first sale in interstate commerce took place on April 30, 1993. (response, opposer's interrogatory no. 4) The caption of applicant's brief at final hearing on the case indicates that applicant apparently changed its name to Ashland Inc. Applicant's attention is directed to Trademark Rule 3.85 for the proper procedure to ensure that the

Registration has been opposed by Foseco International Limited under Section 2(d) of the Act on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark ECOLOTEC for "chemical products, namely, binders for use in the preparation of cores and molds for the foundry industry"[2] as to be likely to cause confusion.[3]

Applicant, in its answer, denied the salient allegations of likelihood of confusion. Applicant also made allegations, set forth as "affirmative defenses", which amplify the denials.[4]

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; applicant's responses to certain interrogatories and requests for admissions, official records and excerpts from printed publications, all introduced by way of opposer's notice of reliance; and opposer's responses to certain interrogatories and requests

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certificate of registration issues in applicant's new name (assuming, of course, that applicant ultimately prevails in the event of an appeal). See also: Trademark Trial and Appeal Board Manual of Procedure, § 512.03.

[2]Registration No. 1,681,703, issued April 7, 1992.

[3]The notice of opposition included an additional claim of likelihood of confusion between applicant's mark and opposer's mark VELOSET, the subject of Registration No. 1,371,989. The Board, in an order dated September 21, 1995, granted as uncontested applicant's motion for summary judgment in its favor on the issue of likelihood of confusion with respect to opposer's mark VELOSET.

[4]The exhibits attached to the answer do not form part of the record in this case, except, of course, to the extent that any were properly introduced during applicant's testimony period. Trademark Rule 2.122(c).

for admissions, official records and excerpts from printed publications, all made of record by applicant's notice of reliance. Both parties filed briefs on the case and both were represented by counsel at an oral hearing held before the Board.

The parties are direct competitors in the foundry binder market. Metal castings are made in foundries by producing a mold into which molten metal is poured. The metal is allowed to cool, and then the metal casting is removed from the mold for finishing. The molds or cores (having the dimensions which match the metal article to be cast) for this process are formed with binders mixed with sand. The binders act to bond the sand grains together. After the metal castings cool and are removed from the molds, some of the sand used to create the molds is reclaimed and used for other molds. Other sand ends up being dumped or removed from the foundry to a place where it is disposed of. According to the testimony of John Wallace, a college professor of metallurgy (offered as an expert by opposer), a foundry is a rough, dirty and dusty environment. Through the years, as indicated by Thomas Penko, opposer's marketing manager for sand products, the selection of binders by foundries was driven primarily by performance, followed by cost. In recent years, however, federal and state laws have been enacted to address heightened concerns about the environmental impact of the use of binders. These concerns have resulted in changes in the foundry industry,

including changes in the selection of binders. Now, environmental concerns have become important in the buying decision, with foundries' wanting environmentally acceptable (or "friendly") binders. The parties' binders sold under the marks ECOLOTEC and ECOSET are purported to be environmentally friendly; that is, the binders contain lower levels of potentially hazardous materials, are easier and less expensive to dispose of, and do not emit noxious odors during the casting process.

In view of opposer's ownership of a valid and subsisting registration for its pleaded mark, there is no issue with respect to opposer's priority. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, the record establishes, and applicant concedes that opposer is the prior user.

Our determination under Section 2(d) of the Act 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. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in the proceeding now before us are discussed below.

There is no issue regarding the similarity between the parties' goods. The analysis of likelihood of confusion in these types of cases is based on a comparison of the goods as identified in opposer's registration and applicant's involved application. Although the goods here may have

specific differences (for example, inorganic versus organic composition, or "no bake" binders versus "cold box" binders), the differences are not reflected in the identifications of goods in the registration and the application. For purposes of our analysis, the parties' goods, as described in the involved registration and application, are legally identical. Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Applicant essentially admits this point, and further concedes that the goods travel in the same channels of trade to the same classes of purchasers.

With respect to the conditions under which and purchasers to whom sales are made, opposer essentially contends that buyers of foundry binders vary greatly in experience and education. For example, according to Professor Wallace, individuals purchasing binders in small foundries frequently have only a high school education. Thus, according to opposer, purchasers are not necessarily sophisticated.

Notwithstanding opposer's contentions on this point, we agree with applicant's claim that, given the technical nature of binders, the purchase of binders by foundries generally involves an informed and discriminating decision.[5]

[5]Although opposer has taken issue with applicant's contention that the purchasers are sophisticated, opposer has not disputed applicant's claim that binders are technical in nature and, therefore, involve a thoughtful purchasing decision. Indeed,

Gregory Sturtz, applicant's manager of consulting and technical services, foundry products division, has eighteen years of experience in the foundry industry, and has visited hundreds of foundries throughout the world. He testified about foundries' decisions to purchase binders for making cores and molds for use in the manufacturing of metal castings.

Mr. Sturtz stated that product information is given to prospective customers because foundry binders are very technical in nature, and detailed information is needed by customers to allow them to make an informed decision on whether or not a proposed binder system is proper for a specific use in the foundry. Mr. Sturtz testified that the sale of binders to a foundry, especially sales of a new binder system, is "a great deal of work." The binders are sold by direct sales after face-to-face meetings. According to Mr. Sturtz, the foundry has to be educated about "the productivity of the system, the quality of the system, the casting properties of the system, the handling characteristics of the cores and molds produced by the system, worker exposure issues and so forth." If it appears to the foundry that the binders are appropriate, a technical presentation is made to the prospective foundry customer, followed by an initial trial of the binder so that the customer sees the advantages of the new binder system under

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Professor Wallace recognized that binders are "so important" in the foundry industry.

actual working conditions. Mr. Sturtz further testified that many people in the foundry are involved in the purchasing decision, including the workers on the floor, the production manager, the foundry superintendent, the foundry manager and the environmental manager. Mr. Sturtz also enumerated the factors that influence the customer's selection of a binder, and discussed the purchasing decision:

> A. Certainly the bottom line is produce saleable castings at the lowest possible cost. Things that are related to that objective are productivity of the binder, the cost of the binder per pound, the ability of the binder to produce a defect free casting, the safety, the ability of the binder to be used in a particular application in a safe manner, and the environmental characteristics of the binder related to emissions to the atmosphere, leachates to the water, residual sand, disposal issues and so forth. There are many, many different issues which relate to the bottom line of producing a saleable casting at the lowest possible cost.
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> Q. Based on your experience how long does it typically take to get a new foundry binder introduced into the foundry?
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> A. From my experience with a number of new systems it can take several years for a new binder being commercially successful.
>
> Q. Why do you think it takes so long?
>
> A. It takes a long time to introduce a new binder system based on new technology because of unfamiliarity of the foundry industry with that

> technology and the various complicated use of that particular binder system in the foundries.
>
> I will elaborate just briefly. Foundries vary widely in their requirements for [a] particular binder system. Castings can weigh from a few ounces up to tons. And a binder system needs to fit many different requirements within the foundry.
>
> In order to become commercially successful many customers have to be converted to a given binder system, and it's almost a case-by-case basis on converting those customers.

A review of the printed publications also makes it apparent that binders are very technical in nature, and that many considerations go into the selection of a binder which is appropriate to a specific application in the foundry.

The binders are bought in bulk and Mr. Penko stated that binders are typically shipped by truck. Further, Professor Wallace testified that a large amount of sand is required to make a casting and "that's why the sand and the sand binders are so important, because of the large quantities involved."[6] This testimony tends to indicate that the cost of binders, in the large quantities required, is significant.

The record indicates that the relevant classes of purchasers are not uniformally highly educated. Nonetheless, the above testimony and evidence convince us that the purchase of binders involves a thoughtful and

[6]Professor Wallace roughly estimated that five units of sand, by weight, are used to one unit of metal.

careful decision. Therefore, all purchasers, no matter the level of formal education thereof, would be informed about the specifics of binders appropriate for use in the purchasers' foundries.

We next turn to consider the marks ECOLOTEC and ECOSET. The witnesses of both parties acknowledged that the presence of "ECO--" in the marks suggests "ecology" or "environment", that is, that the binders are ecologically or environmentally friendly. Mr. Penko testified that the "--TEC" portion of opposer's mark signifies "technical" (or "technology"). James Elwood, applicant's supervisor of training in environmental and regulatory affairs, won a contest to name applicant's new binder. He created the name ECOSET, drawing from the meanings of "eco" and "set." According to Mr. Elwood, the term "set" is commonly used in the foundry trade, connoting curing of the binder.[7] Mr. Elwood was aware of the prior "--SET" marks already used by applicant,[8] thus choosing the "SET" suffix over others for the mark ECOSET.

The record includes several third-party registrations of marks with an "ECO--" prefix for various chemical products.[9] In addition, a dictionary listing of "eco" is of

[7]In this connection, applicant also introduced four third-party registrations of marks comprising "--SET" for binders, as well as a dictionary definition.
[8]Applicant introduced copies of its registrations for the marks PEP SET, ISOSET, NOVASET, INOSET, LINOSET and ACCOSET, all for chemicals used in the foundry industry.
[9]The record also includes two third-party registrations of a "--TEC" mark and a "--TECH" mark, both for foundry products.

record showing that the prefix means "a habitat or environment esp. as a factor significantly influencing the mode of life or the course of development." Although the third-party registrations are not evidence of use of the involved marks to the extent that the public is necessarily aware of them, this evidence has probative value to the extent that it adds to the dictionary listing. That is, the third-party registrations are "competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each mark may be an insufficient basis upon which to predicate a holding of confusion similarity." Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404, 1406 (TTAB 1988).

We find that the record establishes the suggestiveness of both marks. Opposer's mark ECOLOTEC conveys the idea that its binder employs ecologically friendly technology, whereas applicant's mark ECOSET connotes a binder that cures (i.e., sets) castings in an ecologically friendly process. The mere presence of the highly suggestive term "eco" in the marks is insufficient upon which to base a finding of a likelihood of confusion. Tektronix, Inc. v. Daktronics,

Inc., 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976). The suggestive "eco" portion of each of the marks is followed by a different suggestive term. When the marks are considered in their entireties, the dissimilarities between the marks, on balance, outweigh the similarities. The marks as a whole look different, sound different and have different, suggestive connotations.

Applicant directs our attention to the absence of evidence of any instances of actual confusion. The absence of actual confusion is a factor to be considered inasmuch as the parties are direct competitors and the goods are substantially identical. Nonetheless, this factor is not significant here. This insignificance is due to the facts that applicant only has, at best, a few years of use of its mark ECOSET and, according to Mr. Sturtz, it can take several years to establish the sale of a new binder. Moreover, as often stated, evidence of actual confusion is very difficult to obtain. And, in any event, the applicable test is likelihood of confusion.

Finally, opposer places significance on the fact that applicant knew about opposer's use prior to the filing of applicant's application. While this may be true, given our view that the marks are different, we see no bad faith adoption by applicant.

Based on the record before us, we see the likelihood of confusion claim asserted by opposer as amounting to only a speculative, theoretical possibility in a purchase conducted

with care. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

> We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g 153 USPQ 412 (TTAB 1967).

In sum, we find that, in light of the differences between the suggestive marks and the conditions under which the goods are purchased, confusion is not likely to occur when foundries are making a thoughtful and careful purchase of binders.

Decision: The opposition is dismissed.

R. F. Cissel

T. J. Quinn

G. D. Hohein

Administrative Trademark Judges
Trademark Trial and Appeal Board