

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN 16, 98

Hearing:
April 1, 1997

Paper No.
RLS/CJ

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Ishihara Sangyo Kaisha, Ltd.*

Serial No. 74/567,999 & 74/568,000

Gerald H. Kiel of McAulay Fisher Nissen Goldberg & Kiel for
Ishihara Sangyo Kaisha, Ltd.

Karen Kuhlke, Trademark Examining Attorney, Law Office 105
(*Tom Howell*, Managing Attorney)

Before *Simms*, *Cissel* and *Seeherman*, Administrative Trademark
Judges.

Opinion by *Simms*, Administrative Trademark Judge:

Ishihara Sangyo Kaisha, Ltd. (applicant), a Japanese corporation, has appealed from the final refusals of the Trademark Examining Attorney in the above-identified applications to register the marks TITANPLATE and TITANMASTER for electrophotographic printing plates for offset press printing.¹ The Examining Attorney has refused

¹ Application Serial Nos. 74/567,999 and 74/568,000, both filed August 31, 1994. In each application, applicant has asserted a bona fide intention to use the mark in commerce.

Seer No. 74/567,999 & 74/568,000

registration under Section 2(d) of the Act, 15 USC 1052(d), on the basis of Registration No. 1,160,772, issued July 14, 1981, Sections 8 and 15 affidavit filed, for the mark TITAN for processing machines used to expose and develop photosensitive printing plates. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

We affirm.

Essentially, it is applicant's position that the respective marks differ visually and in connotation, applicant's mark having the meaning of "master of the titan," in one of applicant's applications. Applicant's counsel also states that applicant's goods, electrophotographic printing plates, cannot be processed by registrant's processing machines. Counsel also indicates that there has been no evidence of actual confusion. Finally, in order to show the "commonness" or the "widespread use" of the term TITAN, applicant in its brief has listed various third-party registrations. However, the Examining Attorney has objected to this listing as untimely, an objection which we find well taken.²

² Not only has applicant presented this mere listing of third-party registrations in its brief for the first time, but also copies of these registrations have not been submitted. See Trademark Rule 2.142(d), *In re Norfolk Wallpaper, Inc.*, 216 USPQ 903, 904 (TTAB 1983) and *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). Moreover, applicant's inappropriate request for remand, presented in footnote 1 of its appeal brief, is denied. In any event, these registrations cover different goods in different fields (electric motors, pumps for spraying paint, cranes, food mixers, etc.).

The Examining Attorney, on the other hand, argues that all marks are dominated by the word TITAN and that, with respect to both of applicant's marks, the second word is descriptive of applicant's goods ("PLATE" on the one hand and "MASTER" on the other, the original identification being "printware, particularly electrostatic masters.") With respect to the goods, it is the Examining Attorney's position that we must assume that registrant's processing machines can be used for processing printing plates of the type identified by applicant's mark. In this regard, the Examining Attorney notes that registrant's processing machines are used to expose and develop photosensitive printing plates and that such printing plates could include applicant's electrophotographic printing plates. However, even if applicant's printing plates could not be processed by registrant's machines, the Examining Attorney argues that applicant's printing plates are related to registrant's processing machines for exposing and developing printing plates, and that purchasers may believe that these goods all come from the same source. In support of his position, the Examining Attorney has made of record computerized versions of third-party registrations and applications purporting to show that third parties have adopted the same mark for printing plates and for printing presses or machines which process printing plates. Finally, the Examining Attorney

Seer No. 74/567,999 & 74/568,000

argues that it is not clear from this record that the printing plates identified in applicant's application could not be processed by the processing machines identified in the registration.

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that confusion is likely if applicant's marks TITANPLATE and TITANMASTER are used in connection with applicant's electrophotographic printing plates. While there are obvious differences in the respective marks of applicant and registrant, they differ only to the extent that applicant's marks include either highly suggestive or descriptive matter. While marks, of course, must be considered in their entirety, it is not improper, in considering the overall similarities of competing marks, to afford less weight or significance to those portions which may be descriptive. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The Examining Attorney's argument that a purchaser or a potential purchaser may view applicant's mark as suggesting a plate or a master (plate) that may be processed by the TITAN processing machine is not unreasonable.

While applicant's attorney argues that applicant's goods cannot be processed by registrant's processing machines, there is nothing in the record to support this

Seer No. 74/567,999 & 74/568,000

contention. Indeed, applicant's attorney has explained that applicant's goods include a photosensitive layer coated on the plate. See applicant's Amendment, filed August 10, 1995, p.2. Accordingly, applicant's electrophotographic printing plates appear to be photosensitive printing plates, plates which are specifically identified as being capable of being processed by registrant's processing machines.

Finally, it should be kept in mind that the goods of the parties need not be identical or directly competitive in order to support a finding of likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers or potential purchasers under circumstances that could give rise to the mistaken belief that the goods emanate from the same source. See *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985). The third-party registration made of record by the Examining Attorney tends to support the proposition that a manufacturer may sell both printing presses and printing plates as well as other types of printing equipment under the same mark.³ In *re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

³ We have disregarded the intent-to-use applications and the third-party registrations issued pursuant to Section 44 of the Act. There is no indication that the goods listed in those applications and registrations have ever been sold or offered for sale in this country.

Seer No. 74/567,999 & 74/568,000

Finally, while applicant's attorney argues that there is no evidence in the record of actual confusion, this application is an intent-to-use application and there is nothing in the record to support the statement that applicant's marks have been used in this country.

Decision: The refusals of registration are affirmed in both cases.

R. L. Simms

R. F. Cissel

E. J. Seeherman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board