

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

9/8/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Beiersdorf Aktiengesellschaft
v.
Southwest Technologies, Inc.

Opposition No. 95,031
to application Serial No. 74/371,744
filed on March 25, 1993

Ronald S. Kadden of Von Maltitz, Derenberg, Kunin, Janssen &
Giordano for Beiersdorf Aktiengesellschaft

Thomas H. Van Hoozer of Hovey, Williams, Timmons & Collins
for Southwest Technologies, Inc.

Before Simms, Hanak and Walters, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Southwest Technologies, Inc. (applicant) seeks to
register ELASTO-GEL and design in the form shown below for
"cast and splint pads, wound dressings" (class 5) and
"medical cushions and pads, namely hospital bed pads,
wheelchair cushions, and therapeutic belts, pads and wraps"
(class 10). The application was filed on March 25, 1993

Opposition No. 95,031

with a claimed first use date of June 1988 for the class 5 goods and February 1989 for the class 10 goods.



On August 4, 1994 Beiersdorf Aktiengesellschaft (opposer) filed a notice of opposition alleging that long prior to June 1988, opposer both used and registered the marks ELASTOPLAST and ELASTOMULL for bandages. Furthermore, opposer alleged that long prior to June 1988, it had used the mark ELASTOPLAST in connection with athletic tape. Continuing, opposer alleged that applicant's mark ELASTO-GEL and design so closely resembles opposer's trademarks ELASTOPLAST and ELASTOMULL such that their use on the respective goods of the parties is likely to result in confusion, mistake and deception.

In addition, opposer alleged that as the result of a judgment dated January 8, 1987 entered against applicant in Opposition No. 72,147 brought by opposer, "applicant is precluded under the doctrine of res judicata from obtaining the registration sought in the application opposed herein." (Notice of opposition paragraph 10). More specifically, opposer noted that on April 30, 1984 applicant filed application serial number 73/478,106 seeking to register ELASTO-GEL and design in the form shown below for "medical

Opposition No. 95,031

cushions and pads, hot/cold therapeutic limb wraps, and hand exercisers for muscle rehabilitation.”

Opposer stated that on July 22, 1985 it filed a notice of opposition (Opposition No. 72,147) against registration of the above mark based upon its prior rights in the identical marks (ELASTOPLAST and ELASTOMULL) which form the basis for opposer's section 2(d) claim in this present opposition. Opposer noted that on November 14, 1986, applicant, without the written consent of opposer, withdrew its application serial number 73/478,106, the subject of Opposition No. 72,147. Thereafter, on January 8, 1987 this Board entered the above judgment against applicant.

Applicant filed an answer which denied that the contemporaneous use of ELASTO-GEL and design by applicant and ELASTOPLAST and ELASTOMULL by opposer is likely to result in confusion, mistake or **deception**. As for opposer's claim of **res judicata**, applicant admitted the foregoing **sequence of events regarding the filing of its prior application; the filing of the prior notice of opposition; and the entry of judgment against it in the prior**

Opposition No. 95,031

opposition. However, applicant denied that the doctrine of res judicata was applicable to this proceeding. As applicant explained in subsequent papers, "it is applicant's position that its prior mark and its current mark create totally different commercial impressions" such that the doctrine of res judicata is not applicable.

Finally, in its answer applicant also asserted the affirmative defense of laches.

On December 14, 1994 opposer filed a motion for summary judgment on its claim of res judicata and on applicant's affirmative defense of laches. Said motion was contested by applicant.

In an opinion dated March 28, 1996 this Board entered partial summary judgment in favor of opposer by finding applicant's laches defense to be legally insufficient. However, with regard to opposer's claim of res judicata, this Board denied the grant of summary judgment, stating that "there exists a genuine issue of material fact as to whether the mark now sought to be registered by applicant creates substantially the same commercial impression as the mark which was the subject of a prior opposition."

The large record in this case is fully described in the opening pages of opposer's brief. At page four of its brief, applicant states that it "does not dispute the

Opposition No. 95,031

identification of the evidence now before the Board as set forth [in] opposer's brief."

We will consider first opposer's section 2(d) claim. Of course, priority is not an issue in this proceeding. Opposer has properly made of record certified status and title copies of its registrations for ELASTOPLAST (typed drawing form) and ELASTOMULL (typed drawing form). Registration No. 250,633 for ELASTOPLAST issued on December 11, 1928 with a claimed first use date of January 5, 1925. The goods of said registration are "plaster bandages." Registration No. 1,130,757 for ELASTOMULL issued on February 12, 1980 with a claimed first use date of December 13, 1976. The goods of said registration are "non-adhesive elastic gauze bandages." In addition, opposer, a company organized under the laws of the Federal Republic of Germany, has established that, through its United States subsidiaries, it has made continuous use of both of these marks in the United States since at least 1978. It was in 1978 that the now chief operating officer of opposer's primary United States subsidiary commenced work for another United States subsidiary of opposer.

In any likelihood of confusion of analysis, two key considerations (although not exclusive considerations) are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544

Opposition No. 95,031

F.2d 1098, 192 USPQ 24, 29 (CCPA 1978) ("The fundamental inquiry mandated by section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the goods, we note that applicant's class 5 goods include "wound dressings" without any limitations whatsoever as to types of wound dressings. The term "dressing" is defined as "any of various materials utilized for covering and protecting a wound. See also bandage." Dorland's Illustrated Medical Dictionary (25th ed. 1974). This same reference work, in defining the term "bandage," makes cross-reference to both "dressing" and "strapping." Thus, the term "wound dressings" in the application is a very broad term which encompasses "any of various materials utilized for covering and protecting a wound," including bandages. Hence, certain of applicant's class 5 goods (wound dressings) encompass the goods set forth in opposer's registrations for ELASTOPLAST (plaster bandages) and ELASTOMULL (non-adhesive elastic gauze bandages). Moreover, the record reflects that in practice, opposer's ELASTOPLAST and ELASTOMULL bandages have been utilized since at least 1978 to cover (dress) a wound, either by themselves or conjunction with other materials.

Turning to a consideration of applicant's class 10 goods, we note that said goods include "therapeutic belts,

Opposition No. 95,031

pads and wraps." When asked "what types of injuries or conditions or ailments are treated by your therapy products sold under the ELASTO-GEL mark," applicant's chairman of the board (Edward Stout) responded as follows: "Well, of course, I don't know all of them and exactly how people use them. We recommend sprains, strains, muscle aches, those kind of things..." (Stout discovery deposition page 58). Of course, these are precisely the same conditions for which non-adhesive elastic gauze bandages, such as opposer's ELASTOMULL bandages, are used. Moreover, the record reflects that since at least as early as 1978, opposer has made continuous use of its other mark (ELASTOPLAST) in connection with both (1) elastic bandages used to treat these same conditions, as well as with (2) the goods set forth in the registration for ELASTOPLAST, namely "plaster bandages."

In sum, we find that certain of applicant's class 5 goods (wound dressings) are legally identical to opposer's goods. Moreover, certain of applicant's class 10 goods (therapeutic belts, pads and wraps) are extremely similar to opposer's elastic bandages in that they serve to treat at least some of the very same injuries and ailments.

In arguing that its goods "can be readily contrasted with the elastic bandages of opposer," applicant improperly attempts to compare its actual goods with opposer's actual

Opposition No. 95,031

goods. (Applicant's brief page 23). For example, with regard to its wound dressings, applicant argues that all of its wound dressings "include a bacteria static hydrogel." (Id.) In arguing that its therapy products are "radically different [from] the elastic gauze bandages of opposer's ELASTOPLAST and ELASTOMULL marks," applicant relies upon the fact that its therapeutic belts, pads and wraps are "characterized by the ability to heat in a microwave or cool by freezing." (Id.) In contrast, the performance capabilities of opposer's elastic bandages and other bandages are not likewise enhanced by heating or freezing.

However, the flaw in applicant's reasoning is that "in [an opposition] proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration [and the goods for which the opposer has established prior rights], rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). The pertinent part of applicant's class 5 goods reads simply "wound dressings," not "bacteria static hydrogel wound dressings."

Opposition No. 95,031

Likewise, the most pertinent part of applicant's class 10 goods reads simply "therapeutic belts, pads and wraps," and not "therapeutic belts, pads and wraps that can be heated in a microwave or frozen." As set forth in its application, certain of applicant's class 5 goods (wound dressings) encompass products which are legally identical to the goods set forth in opposer's two registrations and the goods for which opposer has established prior common law rights for its ELASTOPLAST mark, namely, elastic bandages. Likewise, certain of applicant's class 10 goods (therapeutic belts, pads and wraps) are legally extremely similar to opposer's elastic bandages in that they are functional equivalents. The fact that applicant's actual therapeutic belts, pads and wraps are not the functional equivalents of elastic bandages in that the former can be heated or frozen and the latter cannot is irrelevant.

Having determined that certain of applicant's class 5 goods (wound dressing) are legally identical to opposer's goods and that certain of applicant's class 10 goods (therapeutic belts, pads and wraps) are the functional equivalents of certain of opposer's goods (elastic bandages), we turn to a consideration of the marks. In so doing, we note at the outset that it is important to remember that "when marks would appear on virtually identical goods or services, the degree of similarity [of

Opposition No. 95,031

the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)

In comparing opposer's two marks to the word portion of applicant's mark, we note that all three consist of four syllables, and that the first three syllables are identical. Applicant has appropriated the first three syllables of opposer's long standing marks (i.e. ELASTO) and merely added thereto the descriptive word GEL and a simple geometric shape (i.e. a triangle). Indeed, applicant itself acknowledges that "the 'gel' component [of applicant's mark ELASTO-GEL] derives from the hydrogel properties of the gel component." (Applicant's brief page 20). All of applicant's wound dressings contain hydrogel. Moreover, applicant's therapeutic belts, pads and wraps also contain hydrogel. In this regard, reference is made to applicant's exhibit number one where, in describing a neck wrap, the following statement appears: "ELASTO-GEL is a specially formulated gel with exceptional properties for transferring heat. The gel provides moist heat therapy... The unique combination of specifically selected fabric and a touch flexible gel provides a nearly indestructible product, which is suitable for use in environments from hospitals to athletic fields."

Opposition No. 95,031

A predecessor Court to our primary reviewing Court long ago stated that "if all that a newcomer in a field need do in order to avoid the charge of confusing similarity is to select a word descriptive of his goods [in this case GEL] and combine it with a word which is the dominant feature of a registered mark [in this case ELASTO] so that the borrowed word [in this case ELASTO] becomes the dominant feature of [the newcomer's] mark, the registered trademark, made valuable and outstanding by extensive advertising and use, soon becomes of little value.") Bon Ami Co. v. McKesson & Robbins, Inc., 93 F.2d 915 (CCPA 1938)(BON AMI soap and SHAV-AMI shaving cream held confusingly similar).

In an effort to minimize the fact that it appropriated the first three syllables of each of opposer's marks, applicant makes the totally unsubstantiated claim that "the 'elasto' term is descriptive in connection with applicant's goods, which are elastic bandages which stretch." (Applicant's brief page 21). While the ELASTO portion of applicant's mark and opposer's marks may be slightly suggestive of some applicant's goods and opposer's goods, there is absolutely no evidence of record showing that it is descriptive of any of the goods. The term "elasto" does not appear in any dictionary. In this regard we note that applicant has made of record by means of a notice of reliance excerpts from three dictionaries: Webster's New

Opposition No. 95,031

Collegiate Dictionary (1973); McGraw-Hill Dictionary of Scientific and Technical Terms (1974); The American Heritage Dictionary of the English Language (1981). It is quite telling that none of these three dictionaries nor any other dictionary consulted by this Board contain the term "elasto." Moreover, while this will be discussed in greater length later, applicant was unable to find any third-party mark containing any ELASTO component. In short, we find that while the ELASTO component common to all three marks is slightly suggestive of some of opposer's and applicant's goods, it is certainly not descriptive, and it is clearly deserving of protection.

Moreover, we find that ELASTO is the dominant portion of all three marks. In finding THERM-O-LITE for storm windows to be confusing similar to THERMOPANE for insulated glass, the Court noted that "THERMO although suggestive, but not descriptive, is the dominant feature of both trademarks." Libbey-Owens-Ford Co. v. General Window Co., 125 USPQ 229, 231 (CCPA 1960). Interestingly, the Court found that THERMO was only suggestive despite the fact that, unlike ELASTO, THERMO is listed in every dictionary consulted by this Board as a prefix meaning "heat." See also Schering Corp. v. Alza Corp., 207 USPQ 504, 509 (TTAB 1980) ("It is our opinion, that although CHRONO is a highly suggestive term, meaning 'time', that, nevertheless, it is

Opposition No. 95,031

this term in each mark which gives the mark its primary significance, and would be the word most likely to be impressed upon the minds of purchasers and to be remembered and used in calling for the goods.") Again, CHRONO, unlike ELASTO, is listed in every dictionary consulted by the Board as a prefix meaning "time." If THERMO and CHRONO are merely suggestive despite being listed in every dictionary, then the designation ELASTO -- which is not listed in any dictionary -- is at most suggestive, and certainly not descriptive, of some of applicant's and opposer's goods.

Finally, as for the fact that applicant's mark contains a simple geometric shape (i.e. a triangle), a few comments are in order. First, the presence of a triangle in no way alters the pronunciation or connotation of applicant's mark. This is of particular significance given the fact that applicant acknowledges that it actively solicits orders for its ELASTO-GEL products by telephone. (Stout discovery deposition page 65). Moreover, applicant's customers frequently convey their orders to applicant by telephone. (Id. page 66). Obviously, when the ELASTO-GEL mark is spoken, the simple triangle design feature will not be verbalized. In deciding whether marks are confusingly similar, it has been noted that "similarly of sound may be particularity important when the goods are of the type frequently purchased by verbal order." 3 J. McCarthy,

Opposition No. 95,031

McCarthy on Trademarks Unfair Competition section 23:22 at page 23-48 (4th ed. 1998).

Second, it must be remembered that in order to be held confusingly similar, marks need not be similar in all respects, that is to say, in terms of visual appearance, pronunciation and connotation. Similarity as to any one factor can be sufficient to sustain a finding a likelihood of confusion. Krin-Ko Corp. v. Coca-Cola Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968). Here applicant's mark and opposer's two marks are clearly similar in terms of pronunciation and connotation. Moreover, even when prospective purchasers have the opportunity to view applicant's mark in its entirety, it is our view that the word portion of the mark predominates, and, as such, said mark shares some similarity in terms of visual appearance to both of opposer's marks.

Before leaving our discussion of the similarities of the marks, two arguments of applicant need to be dismissed. First, at page 20 of its brief applicant argues that opposer "uses the 'ship bow and trumpet' [design] throughout its packaging as a distinguishing component." Second, at page 30 of its brief, applicant argues that FDA regulations require that the company names of both applicant and opposer appear on their respective goods, and that this is "another factor ... demonstrating why there is no likelihood of

Opposition No. 95,031

confusion." Applicant's arguments are legally insufficient. The issue of likelihood confusion must be decided based upon a comparison of applicant's mark ELASTO-GEL and design per se and opposer's marks ELASTOPLAST and ELASTOMULL per se. In our likelihood of confusion analysis, the Board is not permitted to consider the trade dress of the products or any additional wording that may appear on the products, other than to the extent that these elements may show possible bad faith adoption on the part of the applicant. Ultracashmere v. Spring Mills, 828 F.2d 1580, 4 USPQ2d 1252, 1254 (Fed. Cir. 1987).

In addition, while applicant's arguments are legally insufficient, we feel compelled to note that in practice the "ship bow and trumpet" design simply does not appear on all of opposer's packaging. However, what is striking is the fact that both opposer and applicant frequently employ a blue and white trade dress for their respective products. Moreover, a review of the relevant FDA regulation does not support applicant's position that the name of the manufacturer must appear on applicant's products and opposer's products. Rather, the FDA regulation in question (21 CFR 801.1) simply requires that the name of the manufacturer, packager or distributor appear on the packaging. As will be discussed at greater length, both applicant's ELASTO-GEL products and opposer's ELASTOPLAST

Opposition No. 95,031

and ELASTOMULL products are carried by the same distributors. Thus, if we were to consider the FDA regulation (which we are not), said regulation may only serve to increase the likelihood of confusion in that the name of the same distributor could appear on both ELASTO-GEL products and on ELASTOPLAST and ELASTOMULL products without the name of either applicant or opposer.

We will now turn to a consideration of the other relevant du Pont factors which have been tried by the parties. As to trade channels, when the goods of the parties are legally identical or extremely similar, then the trade channels will be the same. Indeed, in actuality both opposer's products and applicant's products have been carried by the very same wholesale distributors and dealers. Moreover, opposer product's and applicant's products have appeared in the very same distributor catalogs. Indeed, applicant "acknowledges that there is overlap between the channels of trade." (Applicant's brief page 25). Obviously, this factor favors opposer.

We will next consider the level of purchaser sophistication, the cost of the goods and the conditions under which the goods are purchased. As described in the application and the two registrations, the goods (wound dressings; therapeutic belts, pads and wraps; bandages) encompass goods which, according to the evidence of record,

Opposition No. 95,031

are inexpensive, are sold to ordinary purchasers and are often purchased in a hurried fashion because there is an immediate need to treat a wound or other ailment. Indeed, in practice applicant's ELASTO-GEL and design products and opposer's ELASTOPLAST and ELASTOMULL products are sold in pharmacies to ordinary purchasers with suggested retail prices as low as \$4.35. (Opposer's exhibit 35). Applicant argues that in reality, most buyers for its products and opposer's products are hospitals, distributors and physicians who are "typically" sophisticated (Applicant's brief page 23) and who "normally" acquire said products "as a result of careful thought." (Applicant's brief page 26). Whether or not the vast majority of applicant's and opposer's products are sold to sophisticated purchasers exercising a high level of care is irrelevant when the identification of goods in the application and the identification of goods in the registrations are broad enough to include products sold at nominal sums to ordinary purchasers who are often making their purchasing decisions in a hurry because of an immediate need to treat a wound or ailment. Thus, the factors of (1) purchaser sophistication, (2) conditions of sale and (3) cost of goods favor a finding of likelihood of confusion.

We next consider the fact that, as acknowledged by opposer at page 15 of its brief, there have been "no

Opposition No. 95,031

instances of actual confusion" reported to either party. Of course, proof of actual confusion is not a prerequisite to a finding of likelihood of confusion. However, the absence of actual confusion in this case is not surprising given the fact that, as applicant repeatedly emphasizes, the vast majority of its ELASTO-GEL products and opposer's ELASTOPLAST and ELASTOMULL products have been sold in large quantities to professional buyers (hospitals, distributors and physicians) exercising a very high level of care. To date, there has been minimal opportunity for actual confusion to have occurred amongst the ordinary consumers described above. Moreover, given the similarity of the marks, ordinary consumers are not likely to later recognize their initial confusion, and if they should, they are not likely to take the time and effort to report it given the nominal cost of the goods. Thus, we find, under the facts of this particular case, that the absence of actual confusion is a neutral factor.

Turning to a consideration of the number and nature of similar marks in use on similar goods, we note that applicant has introduced evidence showing use by third parties of the mark ELASTIKON on elastic bandages and the mark ELASTINET on support bandages. However, we have accorded limited weight to this third-party use for three reasons. First, we note that applicant's own evidence

Opposition No. 95,031

(product catalogs and the like) shows that there are literally hundreds of different brands of products similar to those at issue here. From this list of hundreds, applicant was able to find only two marks which are remotely similar to either applicant's mark or opposer's marks. Second, applicant has offered absolutely no evidence showing the extent of use of either the ELASTIKON or the ELASTINET marks. Third, and of greatest importance, is the fact that neither of these two third-party marks contains the ELASTO element common to both applicant's mark and opposer's marks. As previously noted, it is this ELASTO element which is the most prominent feature of both applicant's mark and opposer's marks. Accordingly, we find that the factor involving the number and nature of similar mark favors, if any one, opposer in that after an exhaustive search, applicant was not able to locate even one third-party use of a mark containing the ELASTO element.

Finally, we turn to consideration of the fame of opposer's marks, including sales, advertising and length of use. Opposer has made of record evidence demonstrating that from 1978-1996, it sold over \$50 million worth of ELASTOPLAST products, and over \$9 million worth of ELASTOMULL products. Moreover, both of opposer's marks have been in use for long periods of time. Opposer's registration for ELASTOPLAST issued in 1928, and its

Opposition No. 95,031

registration for ELASTOMULL issued in 1980. In addition, applicant was well aware of both of opposer's marks when it adopted its ELASTO-GEL and design mark. Nevertheless, we find that despite opposer's substantial and long use, it has simply failed to prove that either of its marks is a famous mark. In particular, opposer has presented no evidence that either of its marks enjoys a high level of recognition amongst purchasers. Hence, in our likelihood of confusion analysis, we will accord opposer's marks only the normal scope of protection and not the expanded scope of protection accorded famous marks.

In conclusion, we find that applicant's mark in its entirety is sufficiently similar to each of opposer's marks such that their use on identical and closely related goods is likely to result in confusion. In reaching this determination, we have taken into account the facts that the channels of trade are identical; that the goods can be very inexpensive; that the purchasers can be ordinary individuals exercising minimal care and often buying under hurried conditions; and that although opposer first registered its ELASTOPLAST mark in 1928, there has not been one other company, besides applicant, that has used an ELASTO mark on goods even remotely similar to opposer's goods or applicant's goods. Moreover, while we have no doubt on the issue of likelihood of confusion, were such doubt to exist,

Opposition No. 95,031

said doubt must, of course, be resolved in favor of opposer as the registrant and long prior user. See Century 21 Real Estate, 23 USPQ2d at 1701.

Having sustained the opposition pursuant to opposer's section 2(d) claim, we elect not to consider whether the doctrine of *res judicata* applies. See American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2039 (TTAB 1989), aff'd 17 USPQ2d 1726 (Fed. Cir. 1990) and cases cited therein.

Decision: The opposition is sustained solely on opposer's section 2(d) claim.

E. W. Hanak

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

Because of the differences between applicant's mark ELASTO-GEL and design and opposer's marks ELASTOPLAST and ELASTOMULL, I would find no likelihood of confusion and, therefore, respectfully dissent.

First, I agree with the majority's conclusion that, based upon the goods recited in applicant's application and in opposer's registrations as well as opposer's goods for which it has shown prior common law rights, the goods of the parties must be considered identical in part and otherwise commercially similar. Further, as described, they are presumed to travel in similar channels of trade to the same class of potential purchasers, including ordinary consumers. However, because the marks of the parties are similar only to the extent that each contains the suggestive formative "ELASTO", I do not believe that purchasers of wound dressings and bandages will be confused as to source of the respective products.

I disagree with the majority's statement that the term "ELASTO" is the dominant part of opposer's marks. It is certainly suggestive, as is the term "PLAST" (suggestive of "plaster") in the mark ELASTOPLAST. The formative "ELASTO" suggests the "elastomeric" or elastic properties of opposer's elastic bandages. With respect to the mark ELASTOMULL, the element "MULL" appears to be arbitrary. And

Opposition No. 95,031

in applicant's mark, both elements ("ELASTO" and "GEL") are suggestive of the elastic properties of applicant's wound dressings and other products as well as the gel composition thereof. In any event, because of the suggestive nature of the only common element of the marks, purchasers are likely to look to the other components to distinguish the marks. Applicant's mark also differs in sound and connotation from each of opposer's pleaded marks. All of these elements of the respective marks should be considered in determining whether or not confusion is likely. See *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("Moreover, such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.").

There are numerous cases in which this Board and the courts have found confusion to be unlikely where the only element in common was a descriptive or suggestive word. See, for example, *Keebler Co. v. Murray Bakery Products, Inc.*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (PECAN SANDIES vs. PECAN SHORTEES); *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 809 F.2d 601, 1 USPQ2d 1809 (9th Cir. 1987) (NUTRI/SYSTEM vs. NUTRI-TRIM); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED AND BREAKFAST REGISTRY vs. BED AND BREAKFAST INTERNATIONAL);

Opposition No. 95,031

Henri's Food Products Co. v. Kraft, Inc., 717 F.2d 352, 220 USPQ 386 (7thCir. 1983)(MIRACLE WHIP vs. YUGOWHIP); Bulova Watch Co. v. Miller, 463 F.2d 1376, 175 USPQ 38 (CCPA 1972)(ACCUTRON vs. UNITRON); Clark Equipment Co. v. Baker-Lull Corp., 288 F.2d 926, 129 USPQ 220 (CCPA 1961) (YARDLOADER vs. YARDLIFT); Sears Mortgage Corp. v. Northeast Savings F.A., 24 USPQ2d 1227 (TTAB 1992)(APPROVAL PLUS vs. APPROVAL FIRST); Burns Philp Food, Inc. v. Modern Products, Inc., 24 USPQ2d 1157 (TTAB 1992)(SPICE ISLAND vs. SPICE GARDEN and design); and Stouffer Corp. v. Health Valley Natural Foods Inc., 1 USPQ2d 1900 (TTAB 1986) (LEAN CUISINE vs. LEAN LIVING). Compare Champagne Louis Roederer S.A. v. Delicato Vineyards, ___ F.3d ___, 47 USPQ2d 1459 (Fed Cir. 1998)(CRISTAL vs. CRYSTAL CREEK). See also J.T. McCarthy, Trademarks and Unfair Competition, §23.15[6]

(1992)(footnotes omitted):

Whether a mark is classified as "strong" or "weak" is a very important element in deciding likelihood of confusion. If the common element of conflicting marks is a word that is "weak" then this reduces the likelihood of confusion. A portion of a mark may be "weak" in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market...

For example, the suffix "-tronics" (or its equivalent misspelling "tronix") can be used to convey its ordinary suggestion that products are electronic in character. The inclusion in two marks of such a suffix may alone be an insufficient basis to find a likelihood of confusion where the initial portions of the mark are sufficiently distinguish-

Opposition No. 95,031

able... Similarly, the use of KICKER was found not to cause likely confusion with KIK-IT when both were used on tabletop soccer games, the court noting that the common element "kick" is suggestive of such games.

Unlike the majority, I do not place much significance on the fact that both opposer's marks and applicant's mark contain the prefix "ELASTO_o." Purchasers are not likely to remember this minor element--the "o" ending of "ELASTO". In this connection, applicant has pointed to the demonstrated third-party use of the marks ELASTIKON for elastic bandages and ELASTINET for elastic support bandages. See exhibits 54-59. However, even without this evidence, it is clear that the prefix has an obvious suggestive meaning. Applicant has also noted (brief, 25) that competitors use a number of suggestive marks for their different types of bandages or dressings.

For example, attention is invited to Exhibit 58 showing contemporaneous use of "Algenate", "Algederm", "Algesorb", "Kalginate" and "Algesite", all for algenate dressings, "Covaderm", "Duoderm", "Exuderm", and "Royle-Derm", all for different wound dressings, "Span-gel", "Hypogel", "Normlgel", "New-Gel" and "Curagel", all for hydrogel dressings...

The majority has concluded that opposer's marks are not "famous" and entitled to an enlarged scope of protection. I also note that there is no indication that opposer has a "family" of "ELASTO-" marks--that is, there is no evidence that opposer has jointly promoted and sold its products

Opposition No. 95,031

under these marks such that purchasers would associate the common element "ELASTO" with opposer, and, potentially, any further ELASTO mark that was introduced into the marketplace. Also, it is significant that the marks do not have the same structure or characteristics such that potential purchasers may associate applicant's ELASTO-GEL products with opposer. For example, contrary to applicant's mark, which the majority characterizes as the suggestive term "ELASTO-" plus the generic term "GEL", opposer's marks do not have components of this nature. Compare, for example, McDonald's Corp. v. McBagel's Inc., 649 F.Supp. 1268, 1 USPQ2d 1761 (SDNY 1986)(various "Mc" marks vs. McBagels) and McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989)(various "Mc" marks vs. McTeddy).

While I agree that it is not entitled to much weight herein, the fact that there have been no instances of actual confusion despite 10 years' coexistence should be taken into consideration. In this regard, it is interesting to note what opposer says, brief, 8-9:

The same wholesale distributors and dealers carry both ELASTO-GEL and ELASTOPLAST or ELASTOMULL products. Listings for ELASTO-GEL and ELASTOPLAST products have appeared side by side in the same distributor catalogs. Thus, every opportunity exists for confusion to occur from the concurrent use of the marks on goods which are in part identical and are sold through the same channels of trade to the same class of customers.

R. L. Simms
Administrative Trademark
Judge, Trademark Trial
and Appeal Board