

Hearing:
August 27, 1997

Paper No. 25
RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG 26,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

DNBA Trademarks Holding Inc.

v.

Buehler Ltd.

Opposition No. 99,075
to application Serial No. 74/594,343
filed on November 3, 1994

Joseph B. Bowman of Kokjer, Kircher, Bowman & Johnson, P.C.
for DNBA Trademarks Holding Inc.

Kathy J. McKnight of Banner & Witcoff, Ltd. for Buehler Ltd.

Before Cissel, Hanak and Seeherman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

Based on its statement that it possessed a bona fide
intention to use the mark "VANGUARD" in commerce in
connection with "an apparatus for polishing microstructural
samples," applicant filed the above-referenced application
for registration on the Principal Register in Class 7. At
the suggestion of the Examining Attorney, the
identification-of-goods clause was amended to describe the

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goods with which applicant intended to use the mark as "automatic polishing machines for metallographic, petrographic and ceramographic test samples."

Following publication of the mark in the Official Gazette, a timely notice of opposition was filed by DBNA Trademarks Holding Inc. on September 26, 1995. As grounds for opposition, opposer asserted that it owns a registration¹ of the mark "VANGUARD" for "abrasive tools, particularly grinding wheels," in Class 4; that "opposer, through its authorized licensees, is involved in the field of manufacturing, marketing and selling machines, tools and accessories for material removal operations, specifically including power operated asphalt, concrete, brick, ceramic, glass, masonry, metal, refractory, stone, terrazzo, tile, wall and cut-off saws, grinders, groovers, planers, scarifiers, sanders, polishers, washers, particulate collectors, drills, saw blades, wire brushes, profile wheels, grinding wheels, lapidary blades, core bits and cup wheels"; that opposer, through its predecessors and licensee, has continuously used the mark "VANGUARD" in connection with abrasive tools; and that applicant's mark so resembles opposer's mark that, if it were used in connection

¹ Reg. No. 674,071, issued to opposer's predecessor on the Principal Register on February 17, 1959; combined affidavit under Sections 8 and 15 timely filed in 1964; renewed Feb. 17, 1979. The registration claims use since Feb. 26, 1958.

with the goods set forth in the application, confusion would be likely.

Applicant's answer denied the salient allegations set forth in the notice of opposition.

A trial was conducted in accordance with the Trademark Rules of Practice. The record includes the testimony, with exhibits, of Lyle Stone, President of North American Sales for Diamant Boart, Inc., opposer's licensee; of William Joyce, applicant's Vice President of Sales; and the rebuttal testimony of Richard Norland, Manager of Technical Services at Diamant Boart². A number of documentary exhibits and discovery responses were also made of record by appropriate notices of reliance.

Opposer has objected to our consideration of applicant's exhibit nos. 1, 2 and 3 on the ground that they are irrelevant to the issues before the Board in this proceeding; to exhibit nos. 5, 6, 7, 8, 10, 11 and 12 on the ground that applicant should not be allowed to introduce these exhibits after it failed to produce them in response

² Applicant properly objected to portions of Mr. Norland's testimony that were improper for rebuttal because they exceeded the scope of the testimony of Mr. Joyce. We therefore have not taken Mr. Norland's testimony into consideration as it relates to the products opposer sells, the trade channels through which they move, the entities which buy them, and the uses to which they are put. These issues, however, were discussed in some detail by opposer's other witness, Mr. Stone, during opposer's testimony period, and his testimony is not inconsistent with Mr. Norland's. Even if we were to have considered Mr. Norland's testimony in its entirety, our decision on the merits of this opposition proceeding would not have changed.

to discovery requests from opposer; and to the third-party registrations submitted by applicant on the ground that they are irrelevant.

Opposer's objection to the first three exhibits is denied. The objection to these exhibits was not timely made during the deposition of the witness, but these exhibits would be admissible even if the objection had been raised then. Although they do not show applicant's use of the mark "VANGUARD" in connection with applicant's products, they do explain the process of metallographic sample preparation, and that process is the one in which applicant's automatic polishing machines are used. Exhibits 1, 2 and 3 are therefore not irrelevant to issues in this proceeding.

Opposer's objection to exhibits 5 through 8 and 10 through 12 is not well taken either. As applicant points out, these exhibits are advertising and promotional materials which, although not produced responsive to opposer's discovery requests, are nonetheless similar to the representative samples which applicant did provide for opposer during discovery. Opposer has not asserted that the objected-to exhibits are materially different from those supplied responsive to Interrogatory 19, nor has opposer claimed that applicant put opposer at any disadvantage by introducing these exhibits instead of the similar materials

supplied during discovery. We have therefore considered these exhibits.

Opposer's objection to the third-party registrations introduced by applicant is also denied. Third-party registrations, while not probative of the use of the marks therein, may nonetheless be used to show that particular terms have been adopted as marks or components of marks in a particular field, and that such terms have recognized meanings in that particular field of business. *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, (TTAB 1988).

On October 4, 1996, applicant moved to amend the identification of goods in its opposed application. The proposed amendment constitutes a limiting or narrowing of the identification-of-goods clause which had been of record since applicant had amended the application after the first Office Action. Opposer filed arguments objecting to the amendment and applicant filed a brief in reply. The Board then deferred ruling on the proposed amendment until the case was ready for decision on its merits.

Applicant's motion to amend the identification of goods at this juncture is denied. As the Board pointed out in its January 17, 1997 decision deferring ruling on the motion until final hearing, in view of the lateness of the motion and the facts that opposer has not consented to the proposed

amendment and, in fact, strenuously opposes it, the question for the Board to resolve is whether the issue of likelihood of confusion has been tried as if the proposed amendment to the application had been accepted with the implied consent of opposer. See TMBP 514.3. Applicant argued that once it had actually begun use of the mark on its polishing machines, it could more accurately describe them, and that when this was made clear during the course of the testimony, it became even clearer that confusion with opposer's mark is unlikely. The record, however, when considered in its entirety, does not support the conclusion that both parties to this action proceeded under the assumption that the Board would resolve this dispute by considering applicant's goods in the limited terms reflected by the proposed amendment.

In any event, even if we were to consider applicant's goods as they are identified in the proposed amendment, our decision would be the same. As is typical in opposition proceedings involving the issue of likelihood of confusion, for an applicant to limit or restrict the description of goods in its application does not solve the problem when the goods as opposer has identified them in its registration are just as closely related to applicant's goods as presently specified in the application as they are to the goods as they are more narrowly identified in the proposed amendment. In such circumstances, unless the applicant also asks the

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Board to restrict or limit opposer's registration under Section 18 of the Act, the proposed restriction limiting applicant's goods is to no avail.

The applicant in the instant case made no such claim under Section 18. The Board has considered opposer's goods as they are identified in the pleaded registration and applicant's goods as they are identified in the application as it was amended responsive to the first Office Action, and not as they were identified in the amendment proffered by applicant on October 4, 1996.

Both parties filed briefs on the merits of the opposition, and an oral hearing before the Board was held on August 27, 1997. Based on careful consideration of the arguments of the parties and the relevant legal authorities, we sustain the opposition. Opposer has clearly established its prior use of the mark "VANGUARD," and has shown that confusion is likely in view of the identity of the trademarks of the parties and the relationship between opposer's goods, as broadly described in the registration, and applicant's goods, as they are specified in the application.

There is no dispute concerning the fact that both parties use the same mark. Applicant contends that "VANGUARD" is a weak mark, entitled to only a narrow scope of protection because it is a laudatory term which has been

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adopted and registered by a number of businesses. While we agree that the dictionary definition and the third-party registrations of record make it clear that the term has a certain laudatory suggestiveness to it, in that the term designates the leading position in a given field, this fact does not permit applicant to register the identical mark for closely related goods. In that regard, we note that the third-party registrations applicant made of record are not for the same goods that are under consideration in this case, but instead include products as disparate as dental and medical appliances, hinges, enclosures for lighting fixtures, plastic pipe, hydraulic pumps, electric fans and blowers, knives and so forth. The term "VANGUARD" is suggestive, but both parties use the same mark, and it has the same suggestiveness as applied to applicant's goods that it has in connection with opposer's products.

Applicant argues that the evidence shows that its goods are actually sold through different channels of trade to people who would not ordinarily constitute the market for opposer's products, and that the purposes for which the respective goods are used are also different. It is well settled, however, that in resolving the question of whether confusion is likely, the Board must consider the goods as they are set forth in the opposed application and the registration pleaded by opposer, without restrictions or

limitations which are not reflected therein. Toys R Us, Inc. v. Lamps R Us, 219 USPQ 340 (TTAB 1983), and cases cited therein.

In the instant case, the unchallenged registration opposer owns lists opposer's goods as "abrasive tools, particularly grinding wheels." This identification does not exclude as purchasers of opposer's products laboratory technicians, and it is broad enough to include not just the grinding wheels opposer sells for grinding down paved surfaces or the decks of concrete structures, but also the kinds of grinding wheels used by dentists, jewelers and even laboratory technicians who prepare samples of materials for microstructural analysis. These abrasive tools could be used in an interim step, prior to the polishing operation, in the process of preparing specimens of materials for such testing.

Moreover, grinding can be accomplished by mounting a group of saw blades mounted on a single shaft. Even applicant admits that a saw with a blade bearing opposer's registered trademark, "VANGUARD," could be the very tool used to cut out a section of material, such as concrete or the reinforcing bars used within concrete, from which smaller samples would be taken for polishing in applicant's automatic polishing machines prior to testing for structural defects. At the oral hearing before the Board, counsel for

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applicant argued that this scenario was unlikely, but he nonetheless acknowledged that it could happen this way.

In our view, the complementary nature of these products as they are identified in the application and registration, respectively, makes confusion not just possible, it makes it likely. Both applicant and opposer sell abrasive cutting equipment, grinding equipment and polishing equipment. Opposer sells abrasive cutting and grinding tools under the "VANGUARD" mark. Applicant sells polishing equipment under the "VANGUARD" mark. If the quality control technician charged with obtaining and preparing the samples of rebar and concrete discussed above were to use a "VANGUARD" saw or grinding wheel to cut off or grind down a specimen for testing, and then were to use a "VANGUARD" automatic polishing machine to further prepare the sample for testing, he or she would be likely to make the reasonable, albeit erroneous, conclusion that a single source is responsible for both tools bearing the mark.

We of course recognize that both parties' goods would be sold to specialized personnel, rather than to the general public, but even if a reasonable amount of care is exercised in purchasing these products, confusion is still likely to occur when the users of these complementary devices are confronted with identical marks on them.

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That applicant is not aware of any incidents of actual confusion caused by its use of the same mark that opposer has used and registered is not determinative of the issue in favor of applicant. Proof of actual confusion is not a prerequisite to a finding of likelihood of confusion. *Towers v. Advent Software Inc.*, 17 USPQ2d 1471 (TTAB 1989). That the parties have not yet competed directly in the relatively narrow field of automatic polishing machines for metallographic, petrographic and ceramographic test samples may have reduced the opportunity for actual confusion to have occurred. In any event, evidence of such confusion is not necessary to support our conclusion that confusion is likely.

If we were left with any doubt as to the result in this case, such doubt would necessarily be resolved in favor of the prior user and registrant, and against applicant as the newcomer, who had the opportunity and the duty to select a mark that would avoid confusion with the mark of opposer. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 22 USPQ2d 1453 (Fed. Cir. 1992); and *J & J Snack Food Corp. vv. McDonald's Corp.*, 18 USPQ2d 1889 (Fed. Cir. 1991).

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The opposition is accordingly sustained, and registration to applicant is refused.

R. F. Cissel

E. W. Hanak

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