

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JAN. 26, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Essilor International

v.

Axel Sattler

---

Opposition No. 101,198  
to application Serial No. 74/617,029  
filed on Dec. 30, 1994

---

Marilyn Neiman and Peter Berger of Levisohn, Lerner, Berger  
& Langsam for Essilor International.

Donald L. Dennison of Dennison, Meserole, Pollack & Scheiner  
for Axel Sattler.

---

Before Sams, Cissel and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Axel Sattler filed an application to register the mark  
VARILUX for electric and electronic apparatus and devices,  
namely, electric lighting circuits and fluorescent lamp

ballasts, especially for energy saving lamps in Class 9 and electric lamps and energy saving lamps in Class 11.<sup>1</sup>

Essilor International filed an opposition to registration of the mark on the ground of likelihood of confusion, under Section 2(d) of the Trademark Act. Opposer alleges use of the mark VARILUX on ophthalmic lenses and other vision related apparatus since at least as early as January 1960; ownership of registrations for the mark VARILUX and related marks for these goods;<sup>2</sup> and the likelihood that the public will believe that applicant's goods emanate from or are otherwise sponsored or endorsed by opposer, if applicant uses the identical mark VARILUX on electric and electronic apparatus.

---

<sup>1</sup> S.N. 74/617,029, filed December 30, 1994 under Section 44(d), claiming the benefit of a German application filed June 30, 1994. A certified copy of German Reg. No. 2,901,810 which issued from the application was later submitted.

<sup>2</sup> The pleaded registrations are:  
Reg. No. 697,797 for the mark VARILUX for optical glasses, and particularly spectacle lenses, issued May 15, 1960, first renewal;  
Reg. No. 1,120,420 for the mark VARILUX 2 THE PROFESSIONAL'S CHOICE and design for optical lenses, issued June 19, 1979, Section 8 & 15;  
Reg. No. 1,504,739 for the mark VARILUX INFINITY for optical lenses, issued Sept. 20, 1988, Section 8 & 15;  
Reg. No. 1,541,358 for the mark VARILUX PLUS for ophthalmic lenses, issued May 30, 1989, Section 8 & 15;  
Reg. No. 1,656,630 for the mark VARILUX SELECT for ophthalmic lenses for eyeglasses, issued Sept. 10, 1991, Section 8 & 15;  
and Reg. No. 1,913,038 for the mark VARILUX COMFORT for ophthalmologic apparatus and instruments, namely ophthalmologic glasses, lenses, frames, and cases for all the aforesaid goods, issued Aug. 22, 1995.

Applicant, in its answer, denied the salient allegations of the notice of opposition<sup>3</sup> and sets forth as a defense to the claim of likelihood of confusion that "[t]he respective goods of the parties are unrelated and travel in entirely different channels of trade... ."

The record consists of the file of the involved application; the testimony depositions taken by opposer of Michael Ness and Robert Colucci, officers of Essilor of America, a wholly-owned subsidiary of opposer; the exhibits accompanying the depositions; and opposer's notice of reliance introducing status and title copies of its six pleaded registrations. Applicant took no testimony and made no evidence of record. Only opposer filed a brief and no oral hearing was requested.

Michael Ness, in his testimony for opposer, described VARILUX lenses as those used to treat the eye condition called presbyopia, a part of the natural aging process of the eye whereby it becomes harder to see at close and in-between distances. VARILUX lenses differ from ordinary bifocals with two visible focal lenses in that they provide a progressive change in focal length with no visible lines. Thus, they are known in the optical field as progressive

---

<sup>3</sup> Applicant also noted that opposer had incorrectly referred in the notice of opposition to applicant's application as an intent-to-use application. The statement in the application that applicant has a bona fide intention to use the mark in commerce is required for an application filed under Section 44(d). See Section 44(d)(2) of the Trademark Act.

lenses. The majority of people wearing these lenses are over forty years of age. Mr. Ness described the three levels of distribution of the lenses in the United States, which consist of the optical wholesale laboratories to whom opposer sells the goods and who then fabricate the lenses to the prescription of the practitioner, the practitioner who represents the retail level of dispensing, and the customer who purchases the lenses from the practitioner.

Mr. Ness further testified as to the extensive promotion and advertising by opposer of its VARILUX products, including both direct consumer campaigns such as advertising in magazines, endorsement by Paul Harvey on his radio program, and provision of a web site and indirect campaigns such as co-op advertising with practitioners, point-of-sale literature for practitioners to provide to customers, and promotional material providing practitioners with technical information about the lenses. Mr. Ness introduced a wide array of materials demonstrating the scope of this promotional activity. He also introduced an article from the March 15, 1995 issue of the trade publication 20/20 naming VARILUX products as the number one selling progressive lenses in most sections of the country. Mr. Ness described the promotion of VARILUX products by sponsorship of Senior PGA tour events and by distribution of

items such as eyeglass screw drivers, pens, mugs, note pads, baseball caps, shirts and the like.

Robert Colucci testified as to sales and advertising figures, setting sales figures for 1996 at approximately 140 million dollars, with approximately 170-180 million dollars expected in 1997, and advertising and promotion figures at approximately 10.5 million dollars for 1997. He estimated the number of consumers wearing VARILUX products in 1997 to be over 10 million. Mr. Colucci also described the use of the mark in connection with promotional items, but made it clear that no products other than lenses were sold bearing the mark VARILUX.

Priority is not an issue here in view of opposer's submission of status and title copies of its pleaded registrations proving ownership of valid and subsisting registrations for the marks VARILUX, VARILUX 2 THE PROFESSIONAL'S CHOICE, VARILUX INFINITY, VARILUX PLUS, VARILUX SELECT<sup>4</sup> and VARILUX COMFORT. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

---

<sup>4</sup> Mr. Ness did state during his deposition that the mark VARILUX SELECT was not in use at that time.

**Opposition No. 101,198**

Thus, we turn to the issue of likelihood of confusion and those of the du Pont factors<sup>5</sup> which we find relevant to our determination here.

In the first place, there is no question but that the marks are identical. Moreover, it is well established that the greater the degree of similarity of the marks, the lesser the degree of similarity of the goods required to support a holding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983). The goods need not be identical or even competitive. It is only necessary that there be a viable relationship between the goods, such that persons encountering the goods of the respective parties under the identical mark would be likely to assume that there is some association or affiliation between the sources thereof. See McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989) and the cases cited therein.

Opposer contends that there is such a relationship between the goods of the parties here. Opposer argues that it is those persons who have difficulty in seeing and accordingly wear eyeglasses such as opposer's VARILUX lenses who also use lamps such as applicant's to enable them to see while reading. Opposer points to certain of its advertising materials which feature pictures of a person

---

<sup>5</sup> In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

**Opposition No. 101,198**

both wearing opposer's lenses and using a lamp to read. Opposer also notes the testimony of Mr. Ness as to the correlation of light and lamps with opposer's goods, namely, that it is often dim lighting situations which make a person aware of the onset of presbyopia and the need for opposer's lenses.

Opposer cites Philip Morris v. K2 Corp., 555 F.2d 815, 194 USPQ 81 (CCPA 1977) as a situation in which the goods (cigarettes and skis) were not competitive or intrinsically related, yet there was sufficient association between the two, as a result of promotions and advertising, to result in the likelihood of confusion with the use of the identical mark "K2" thereon. Opposer maintains that in the present case an association has similarly been developed in the public's mind between VARILUX lenses and VARILUX lamps (or lighting), such that use of the same mark in connection with the lamps would lead consumers to assume a common source therefor. Opposer also argues that its use of the VARILUX mark with a variety of promotional products is another basis on which consumers might be led to believe that applicant's lamps originate from opposer.

We find that opposer has failed to establish any viable relationship between the goods of the parties. The mere depiction in promotional material of a person wearing VARILUX lenses for reading while seated at a desk near a

**Opposition No. 101,198**

lamp is clearly insufficient to create an association between the two products. Although the lack of light may lead a person to realize a need for eyeglasses, as well as perhaps for a lamp, there is no inherent reason to associate the source of corrective lenses with the source for a means of lighting. Opposer has introduced no evidence to demonstrate any such reason for persons to assume that these products might originate from a single source, i.e., that lamps or other lighting might originate from, or be sponsored or affiliated with the same source as lenses to correct eyesight deficiencies.

In the K2 Corp. case cited by opposer, the circumstances were entirely different. Evidence had been made of record that the applicant Philip Morris Inc. had been a promoter of ski races for years and had advertised its cigarettes under other marks in connection with these events. As a result, there was a basis for consumers to assume an association or affiliation between the source of "K2" skis and "K2" cigarettes, despite the disparity in the goods themselves. (See the description of the record in the Board's decision, K2Corp. v. Philip Morris Inc., 192 USPQ 174 (TTAB 1976)). By contrast, opposer has introduced no evidence which might lead consumers to make such an association here. There is no evidence that opposer, or any other source of optical lenses, sponsors or has any other

**Opposition No. 101,198**

affiliation with the manufacturers of lamps or similar lighting devices. Furthermore, although opposer may distribute various promotional items bearing its VARILUX marks, opposer has failed to introduce any evidence to show that lamps are typical promotional items.

Looking to the channels of trade for the respective goods, opposer takes the position that since the class of customers is likely to be similar, there is overlap in the channels of trade. We do not agree. Although it is true that the same consumers may go to eye care professionals for opposer's VARILUX lenses and to the appropriate retail outlets for applicant's VARILUX lamps, this does not indicate that the goods themselves travel in the same channels of trade. Instead, Mr. Ness clearly outlined the specific levels of distribution of VARILUX lenses, from opposer to wholesale laboratory to practitioner to customer. The ultimate consumer only encounters the lenses through this particular chain of travel for the eye care products. While these consumers, as well as the practitioners serving them, may also purchase lamps, they would do so at retail outlets for such goods, not at professional eye care locations.

Opposer also strongly argues that the fame of its mark is a factor to be weighed in its favor. Opposer relies not only upon its sales and advertising figures, but also its

evidence of the popularity and wide-spread use of VARILUX lenses.

We acknowledge that opposer has demonstrated that its VARILUX lenses are well known in the optical field, especially in the area of progressive lenses. We cannot agree, however, with any contentions that opposer's mark is famous. Opposer has introduced no evidence by which we may compare its sales and advertising figures with those of others or determine the percentage of VARILUX lenses wearers with eyeglass wearers in general. We have only the statement made by Mr. Ness that the mark is a "strong trademark in this category", i.e., the progressive lenses category (Deposition p. 24). Accordingly, while opposer's VARILUX mark may be a strong, well-known mark in the field of optical lenses, we cannot extend this renown, and the scope of protection afforded thereto, to totally unrelated goods, in the absence of a reasonable basis for the public to believe that these goods might originate from, or are in some way associated with the source of VARILUX lenses. See *Anheuser-Busch, Inc. v. Major Mud & Chemical Co., Inc.*, 221 USPQ 1191 (TTAB 1984). Cf. *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995)[In view of opposer's famous family of marks and its use and licensing of its mark for goods and services, some of which are unrelated to food products or services, consumers likely to believe opposer is connected

**Opposition No. 101,198**

in some manner with applicant's legal services being offered under the mark MC CLAIM].

Thus, in view of the great disparity between the goods upon which the marks are used, and since we find no other duPont factor which might be weighed in opposer's favor, we find that there is no likelihood of confusion with the contemporaneous use of the mark VARILUX on opposer's optical lenses and applicant's lamps and other lighting goods.

Decision: The opposition is dismissed.

J. D. Sams

R. F. Cissel

H. R. Wendel  
Trademark Administrative Judges,  
Trademark Trial and Appeal Board

Opposition No. 101,198