

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN 11,99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rexair, Inc.

v.

Beamco, Inc.

Opposition No. 104,527
to application Serial No. 74/678,319
filed on May 27, 1995

Jeffery A. Sadowski of Howard & Howard Attorneys, PC
for Rexair, Inc.

R. Michael Ananian of Flehr Hohbach Test Albritton &
Herbert, LLP for Beamco, Inc.

Before Hohein, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Beamco, Inc. has filed an application to register the
mark depicted below for "stationary and portable vacuum
cleaners incorporating small particle filtration components,
and parts of stationary and portable vacuum cleaners."¹

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Rexair, Inc. has 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 ownership of a registration for the mark REXAIR in the stylized form shown below for "vacuum cleaners, parts thereof, and attachments therefor";² continuous use of such mark from the date of first use claimed in the registration until the present time; and a likelihood of confusion with applicant's proposed mark when used in connection with goods which would compete in the same market with opposer's vacuum cleaners.³

Applicant, in its answer, denied the salient allegations of the notice of opposition and further alleged that applicant's proposed mark "includes the pharmaceutical 'prescription' symbol \mathcal{R} followed by the stylized word AIR" and is pronounced "Prescription Air."⁴

¹ Ser. No. 74/678,319, filed May 24, 1995, on the basis of a bona fide intent to use.

² Reg. No. 610,593, issued Aug. 16, 1955, claiming first use dates of Dec. 6, 1933; second renewal.

³ For purposes of this opinion, the term "REXAIR mark" will be used to refer to opposer's mark in the stylized form in which it is registered.

⁴ Applicant also set forth as an affirmative defense (although strictly speaking, this is not an affirmative defense but simply a defense to the likelihood of confusion claim) the contention that opposer limits its activities to manufacturing vacuum

The record consists of the file of the involved application; the trial testimony taken by opposer of Kenneth A. Hook, general counsel and an officer of opposer, and of John J. Breslin, chairman of applicant; opposer's Exhibits 1-33, which accompany the testimony; and opposer's notice of reliance introducing a copy of its pleaded registration. Applicant took no depositions of its own, but cross-examined both witnesses during the depositions taken by opposer and introduced Exhibits 1-11 during the deposition of John Breslin. Only opposer filed a brief on the case and its request for an oral hearing was later waived.

Opposer introduced by means of the testimony of Kenneth Hook a copy of the pleaded registration issued to a predecessor of opposer, as well as copies of the Section 8 and 15 affidavit filed by opposer in 1960, the application for second renewal filed in August 1995 executed by Mr. Hook, and the certificate of renewal issued by the Patent and Trademark Office for the second renewal term.⁵ Mr.

cleaners for independent businessmen who in turn sell the cleaners under the mark RAINBOW to individual customers.

⁵ Although opposer filed a notice of reliance, and a supplement thereto, to make of record a "status" copy of the pleaded registration, the copy submitted is identical to that issued with the second certificate of renewal in May 1996. Inasmuch as the present opposition was filed in December 1996 and the testimony period for opposer was not until August 1997, the copy is not reasonably contemporaneous so as to be considered timely documentation of the current status and title of the registration. See TBMP § 703.02(a). As a result, only the testimony of Mr. Hook has been relied upon to establish that the registration is subsisting and owned by opposer.

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Hook's testimony also introduced photographs of the specimens which were filed with the Section 8 and 15 affidavit and the first and second renewals, the specimens evidencing continued use of the REXAIR mark on vacuum cleaners, though, in later years, not in the stylized form shown in the registration. For example, in the specimen submitted with the second renewal application, the plate used on the goods bears the notation "MFG BY REXAIR, INC." in typed letters, in conjunction with the mark RAINBOW. Mr. Hook's testimony also introduced copies of recent owners' manuals and demonstration notebooks for opposer's vacuum cleaners, as sold under the RAINBOW mark, in which it is stated that the products are manufactured by Rexair, Inc., are sold to its authorized RAINBOW distributors for resale to the ultimate users, and that REXAIR is a registered mark of opposer. Third-party advertisements were also introduced showing use of both trademarks, RAINBOW and REXAIR, in promotion of the vacuum cleaners by opposer's independent authorized distributors to purchasers of the products.

By means of the testimony of Mr. Breslin, opposer established that applicant had not, as of the August 21, 1997 date of the deposition, used its proposed mark, which applicant consistently refers to as "Prescription Air", but was selling the portable industrial vacuum cleaner upon

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which it intended to use the mark under its model number. Mr. Breslin further testified that applicant advertises in the Thomas Register models similar to that with which it intends to use its mark; that it does no business with respect to portable vacuum cleaners on the retail level; and, that it advertises under the trade name and trademark Grand Central in its chief sales area, the San Francisco Bay area, for "built-in vacuum systems" manufactured by applicant for residential, commercial and industrial use. By cross-examination applicant introduced into the record copies of the agreement into which opposer enters with its independent authorized distributors for sale of the RAINBOW vacuum cleaners and of the limited warranty which opposer provides to these distributors for its products. Mr. Breslin also testified to the fact that opposer's vacuum cleaners use a water filter but that applicant's vacuum systems use an entirely different filtration system involving non-aqueous solid materials.

Despite the deficiencies in the status and title copy of the pleaded registration which opposer submitted with its notice of reliance, we find that opposer has adequately established ownership and the subsistence of Registration No. 610,593 for the mark REXAIR (in stylized form) by the testimony of Mr. Hook. Accordingly, priority is not an

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issue in this case. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Thus, we turn to the issue of likelihood of confusion and those of the du Pont factors⁶ which we find most relevant to our determination, namely, the similarity or dissimilarity of the marks and the similarity or dissimilarity of the goods and the channels of trade for the respective products.

Opposer contends that the marks of the two parties are substantially identical in sound, appearance and connotation. While applicant has taken the position that the **R** symbol in its mark represents the word "Prescription" and would be pronounced as such, opposer argues that applicant's mark is more likely to be pronounced in a shorthand manner, as "Rexair," similarly to opposer's mark.

It has frequently been stated that there is no one correct pronunciation of a trademark. See *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); *Frances Denney, Inc. v. ViVe Parfums Ltd.*, 190 USPQ 302 (TTAB 1976). Even though applicant may have intended to use the **R** symbol as shorthand for the word "Prescription", there is no assurance that purchasers, upon viewing the mark, would say the word "Prescription" rather than merely adopting the

⁶ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

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shorthand version for pronunciation purposes also. Thus, we find that the two marks are clearly susceptible to, at the very least, the highly similar pronunciations, "Rexair" and "R-x-Air", if not to the same pronunciation, "Rexair",

Furthermore, both applicant's mark and opposer's mark present the same general appearance. In addition, whether or not applicant's mark, on further contemplation, is given applicant's intended interpretation as "Prescription Air", or opposer's mark is equated with " King of the Air" (as opposer itself defined its mark in Opposer's Exhibit 1), we find the overall commercial impression created by the two marks to be highly similar, namely, Rx or REX + AIR.

Insofar as the goods are concerned, we agree with opposer that the stationary and portable vacuum cleaners of applicant must be viewed as substantially identical to the vacuum cleaners of opposer. There are no restrictions in the identification of goods in either the application or registration which might serve to distinguish the goods of the two parties. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813 (Fed. Cir. 1987). Opposer's vacuum cleaners are not limited to any particular type of filtration system. Applicant's vacuum cleaners may be portable or stationary; it is immaterial.

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Finally, since there is no restriction in either opposer's registration or applicant's application as to the channels of trade or class of purchasers, it must be assumed that the goods of each move through all the normal channels of trade for goods of this type and are available to all purchasers of these goods, whether they be in the retail, commercial, or industrial field. See *Fort Howard Paper Co. v. Marcal Paper Mills, Inc.*, 189 USPQ 305 (TTAB 1975). The goods, as recited, being virtually identical, the channels of trade and class of purchasers must also be presumed to be virtually identical. Although applicant may have introduced evidence with respect to the independent distributors authorized by opposer to sell its vacuum cleaners to the ultimate customers, all of this is irrelevant to the present determination of likelihood of confusion. No such limitations exist in the pleaded registration. Nor has applicant filed a counterclaim seeking partial cancellation of the registration under Section 18 of the Trademark Act on the basis of this evidence, as a possible means of avoiding the likelihood of confusion. See *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ 2d 1266 (TTAB 1994).

Accordingly, on the basis of the similarity between the marks of the parties and the virtual identity of the goods and channels of trade, we find that contemporaneous use of

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the respective marks in connection with the respective goods would be likely to cause confusion.

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Decision: The opposition is sustained and registration is refused to applicant.

G. D. Hohein

H. R. Wendel

D. E. Bucher
Trademark Administrative Judges,
Trademark Trial and Appeal Board