

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re TBN Holdings Inc.

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Serial No. 74/710,101

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D. Peter Hochberg of D. Peter Hochberg Co., L.P.A. for TBN Holdings Inc.

E. Santiago Clarke, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney)

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Before Cissel, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

TBN Holdings Inc. has filed an application to register the mark OMNI for "solvents, namely, acetone, aromatics, hexane, methanol, methylene, mineral spirits, toluene, naphthas, xylene, isopropyl alcohol (IPA), methyl ethyl ketone (MEK), methyl isobutyl ketone (MIBK), lacquer diluent, perchloroethylene (PERC), trichlorethane (111TRI),

Ser. No. 74/710101

trichlorethylene (TRI), chlorinated solvents, and solvent blends thereof."<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of two prior registrations issued to two different entities-- (1) the mark OMNISOLV for "organic glass distilled solvents used by laboratories in educational institutions, government facilities and industry for general in vitro use"<sup>2</sup>; and (2) the mark shown below

for "chlorine for use in pools and spas, and pool and spa water test kits consisting primarily of diagnostic chemicals" in Class 1, "general purpose surface cleaners for pools and spas" in Class 3, and "algicides for use in pools and spas" in Class 5.<sup>3</sup> The Examining Attorney contends that applicant's mark, when applied to its

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<sup>1</sup> Serial No. 74/710,101, filed August 2, 1995. Applicant claims dates of first use and first use in commerce of January 2, 1988.

<sup>2</sup> Reg. No. 1,182,588, issued December 22, 1981, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>3</sup> Reg. No. 1,504,458, issued September 20, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

**Ser. No.** 74/710101

identified goods, so resembles both previously registered marks as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm the refusal to register as to the mark OMNISOLV (Reg. No. 1,182,588) only. In reaching this conclusion, we have considered all of the relevant du Pont<sup>4</sup> factors in relation to both cited registrations.

Turning first to the refusal to register based on the mark OMNI and O design (Reg. No. 1,504,458), while there are clearly differences in these respective marks (applicant's mark is OMNI, whereas the registered mark includes a fanciful "O" within a dark square design, and the word OMNI in large block type), it is not improper to give more weight to a dominant feature of a mark. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). OMNI is the dominant portion of the cited mark, and it is applicant's entire mark. Thus, the common, dominant

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<sup>4</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

element in these two marks is the same word. When this registered mark and applicant's mark are considered in their entireties, the marks are similar in sound, appearance and meaning.

However, as identified in the application and registration respectively, the goods of applicant (a variety of solvents and solvent blends) and this registrant (chlorine, water test kits, surface cleaners and algicides, all for pools and spas) are different. The Concise Chemical And Technical Dictionary (1986) defines "chlorine" as "yellowish-green poisonous gas"; "algicide" as "agent which destroys algae"; and "solvent" as "component of a solution which is present in excess; liquid used to dissolve a substance."<sup>5</sup> Although the Examining Attorney argues that the goods in both cited registrations are "solvents," the identification of goods in Registration No. 1,504,458 does not include solvents, but rather is for chlorine, water test kits, surface cleaners and algicides, all for pools and spas. There is no evidence of record to show that such goods are solvents. To the contrary, applicant explains that some of its goods are "chlorinated organic solvents (i.e. are organic molecules combined with

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<sup>5</sup> The Board may take judicial notice of dictionary definitions. See TBMP §712.01, and cases cited therein.

**Ser. No.** 74/710101

chlorine atoms), but that this is much different than the use of straight chlorine for pool and spa cleaning"; and that applicant "does not produce or sell chlorine or its products, i.e., neither organic solvents nor chlorinated organic solvents used for pool cleaning, pool testing or as algicides." (Applicant's brief, p. 3). Thus, we agree with applicant that the applicant's goods and channels of trade are dissimilar, and in fact, are unrelated to the goods listed in Registration No. 1,504,458.

Based on the record before us, we conclude that the goods of applicant and those in the cited Registration No. 1,504,458 are not sufficiently related that consumers are likely to assume a common source when the goods are sold under similar marks.

Turning next to the refusal to register based on the mark OMNISOLV (Reg. No. 1,182,588), the marks OMNI and OMNISOLV are similar in sound and connotation. We disagree with applicant that the cited mark, OMNISOLV, creates a different commercial impression from that of applicant's mark, OMNI. The addition of the abbreviation of the word "solvent" in the cited mark does not distinguish the cited mark from applicant's mark. The purchasing public would understand that "solv" is an abbreviation of "solvent," the involved goods.

With regard to the respective goods and trade channels as to the goods listed in this registration, applicant argues that the cited registrant's goods are used by educational, government and industry laboratories "which are most likely conducting biological research" (Applicant's brief, p. 11); that the cited registrant's goods are purchased by sophisticated purchasers who work in laboratories in the biological field; that the purity of such solvents is much higher than that offered by applicant; and that applicant sells to repackagers, distributors, and industrial end-users in large quantities ranging from five-gallon containers to rail cars (Applicant's brief, p. 7). Applicant further contends that there has been no actual confusion in the nine and one-half years of contemporaneous use.

It is well settled that to support a holding of likelihood of confusion, it is sufficient if the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992).

**Ser. No.** 74/710101

Also, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Here, the applicant's goods and the cited registrant's goods are solvents. The likelihood of confusion would not be precluded simply because the cited registrant's solvents are used by laboratories for general in vitro use. That is, although the cited registrant's goods are identified as solvents used by laboratories for in vitro use, applicant's goods are broadly identified as "solvents, namely...". There is no restriction in applicant's identification of goods which limits applicant's goods or excludes the solvents listed in the cited registration, nor is there any restriction on applicant's channels of trade. Applicant's broad identification of goods, listing numerous specific solvents, encompasses solvents used in educational, government and industry laboratories for general in vitro use.

Assuming that the purchasers are sophisticated and the channels of trade are separate, even relatively sophisticated purchasers and users of solvents in educational, governmental and industrial laboratories

**Ser. No.** 74/710101

would, because of the similarity of the marks and the similarity of the goods, believe that they come from the same source. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). Cf. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

Regarding the absence of actual confusion, there is no evidence as to the amount and extent of either applicant's or registrant's sales, and we have no input from the registrant as to any actual confusion. Therefore, we cannot find that this factor weighs in applicant's favor. In any event, the test is likelihood of confusion, not actual confusion.

Decision: The refusal under Section 2(d) is reversed as to Registration No. 1,504,458, and the refusal to register is affirmed as to Registration No. 1,182,588.

R. F. Cissel

B. A. Chapman

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