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AUG. 6, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Spicers Paper, Inc.*

Serial No. 75/088,444

Steven J. Nataupsky of Knobbe, Martens, Olson & Bear, LLP
for *Spicers Paper, Inc.*

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107 (Thomas Lamone, Managing Attorney)

Before *Simms, Chapman and Bottorff*, Administrative
Trademark Judges.

Opinion by *Bottorff*, Administrative Trademark Judge:

Spicers Paper, Inc. has applied to register the mark
SPICERS NORTHWEST PAPER for "commercial printing paper and
envelopes."¹

The Trademark Examining Attorney has refused
registration under Trademark Act Section 2(d), 15 U.S.C.

¹ Application Serial No. 75/088,444, filed April 15, 1998.
Applicant alleges August 11, 1993 as the date of first use of the
mark anywhere and first use in commerce. Applicant has

§1052(d), on the ground that applicant's mark, when used on applicant's goods, so resembles the registered mark NORTHWEST for "coated and uncoated printing, writing, and converting paper"² as to be likely to cause confusion, mistake, or to deceive.

When the refusal was made final, applicant appealed. Applicant and the Trademark Examining Attorney have filed main briefs, and the applicant has filed a reply brief. Applicant requested an oral hearing, but subsequently waived that hearing.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We also consider the other *du Pont* factors, to the extent that the record contains relevant evidence

disclaimed the exclusive right to use PAPER apart from the mark as shown.

² Registration No. 1,819,925, issued February 8, 1994.

pertaining thereto. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Turning first to the question of the similarity or dissimilarity of the respective goods, we find that registrant's "printing" paper encompasses applicant's "commercial printing paper" and, to that extent, applicant's goods are legally identical to registrant's goods. See *In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987); see also *Shunk Manufacturing Company v. Tarrant Manufacturing Company*, 137 USPQ 881 (CCPA 1963). Furthermore, because the identification of goods in the cited registration contains no trade channel limitations, we must presume that the identified goods move in all normal trade channels for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). To the extent that the goods identified in the registration are legally identical to applicant's "commercial printing paper," we must presume that registrant's goods move in the same trade channels as those in which applicant markets its goods, and also that they are marketed to and purchased by the same classes of purchasers, including the class of "commercial printers" asserted by applicant to be the purchasers of applicant's goods.

We also find, on this record, that applicant's mark SPICERS NORTHWEST PAPER is confusingly similar to the registered mark NORTHWEST. Applicant's mark incorporates the registered mark in its entirety, and the additional elements which are present in applicant's mark, i.e., its house mark SPICERS and the generic term PAPER, do not suffice to distinguish the marks. We are not persuaded by applicant's argument that the Trademark Examining Attorney has improperly dissected applicant's mark by placing inordinate emphasis on the shared element NORTHWEST and insufficient emphasis on applicant's house mark SPICERS.

The evidence of record in this case simply does not support applicant's merely conclusory assertions and argument that NORTHWEST, as applied to paper products, is a "weak, geographic designation" which would be viewed as descriptive of the northwestern United States or of paper products originating from the northwestern United States. Applicant, during prosecution of its application, offered no evidence from dictionaries, gazetteers or other reference works to support its arguments regarding the geographic significance of the term NORTHWEST, nor has applicant submitted with its brief any such evidence of

which we might take judicial notice.³ There is no evidence in the record demonstrating any use by third parties of the term NORTHWEST in connection with paper products.

Additionally, we note that the cited mark NORTHWEST was registered on the Principal Register without resort to a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f).⁴ On this record, NORTHWEST might be deemed, at most, to be a suggestive term as applied to paper products, and we cannot agree with applicant's contention that the term should be assigned a subordinate or inconsequential role in our comparison of the commercial impressions created by the respective marks.

Nor are we persuaded by applicant's argument that the

³ Our own brief review of two readily-available reference sources reveals that Webster's Ninth New Collegiate Dictionary (1990), at 807, defines 'northwest' as follows:

northwest adv: to, toward, or in the northwest
northwest n: **1 a:** the general direction between north and west **b:** the point midway between the north and west compass points **2 cap :** regions or countries lying to the northwest of a specified or implied point of orientation
northwest adj **1:** coming from the northwest <a ~ wind> **2:** situated toward or at the northwest <the ~ corner>

and that Webster's New Geographical Dictionary (1984) at pp. 866-67, does not contain any entry specifically identifying or referring to the northwestern United States as 'Northwest'.

⁴ Of course, to the extent that applicant's arguments and assertions regarding the geographic significance of NORTHWEST are offered as an attack on the validity of the cited registration, we cannot entertain them in this *ex parte* proceeding. See TMEP §1207.01(c)(v) and cases cited therein.

inclusion in applicant's mark of the house mark SPICERS is sufficient to distinguish the respective marks in this case. The legal principles governing our analysis in cases involving house marks were discussed in *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985):

In cases involving the addition of a housemark to one of two otherwise confusingly similar marks, it has been held that such does not serve to avoid likelihood of confusion. Rather, such addition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid source confusion. See: *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979); *Key West Fragrance & Cosmetic Factory, Inc. v. The Mennen Co.*, 216 USPQ 168 (TTAB 1982) and cases cited therein. On the other hand, where there are some recognizable differences in the asserted conflicting product marks or the product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to the assertedly conflicting product mark has been determined sufficient to render the marks as a whole sufficiently distinguishable. See: *In re Cosvetic Laboratories, Inc.*, supra; *In re Hill-Behan Lumber Company*, 201 USPQ 246 (TTAB 1978); *In re Champion International Corporation*, 196 USPQ 48 (TTAB 1977) and cases cited therein.

Applying these principles to the marks involved in the present case, and in view of our finding, discussed above, that NORTHWEST has not been shown to be highly suggestive or merely descriptive or a play on commonly used or

registered terms, we find that the addition of applicant's house mark SPICERS does not distinguish applicant's mark from the registered mark, and that it may well aggravate the likelihood of confusion.

For the foregoing reasons, we conclude that applicant's mark and the cited registered mark are similar rather than dissimilar when viewed in their entireties, a fact which weighs in favor of a finding of likelihood of confusion in this case.

Applicant also asserts that during the four-and-one-half years in which it has been using its mark, it has not encountered any instances of actual confusion between its mark and the registered mark on the part of commercial printers. However, applicant has not submitted any evidence as to the extent of its use of its mark in terms of sales figures, advertising expenditures and geographic areas, nor do we have any such information regarding the extent of registrant's use of registrant's mark. In these circumstances, we cannot determine that there has been a meaningful opportunity for actual confusion to occur in the marketplace, and accordingly we cannot conclude that the absence of actual confusion is entitled to any significant weight in this case. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Applicant also argues that commercial printers, as experts in the field of printing paper, are sophisticated purchasers who are unlikely to be confused. As proof in support of this contention, applicant relies on the fact that applicant is unaware of any instances in which its commercial printer customers have been actually confused as a result of applicant's and registrant's concurrent use of their marks.⁵ However, even if commercial printers might be more sophisticated and knowledgeable in the field of printing paper than ordinary consumers would be, we are not persuaded that their sophistication and knowledge extends to the field of trademarks, or that they necessarily would be immune to source confusion when faced with the concurrent use, on identical goods, of the confusingly similar marks involved in this case. *See Refreshment Machinery Incorporated v. Reed Industries, Inc.*, 196 USPQ 840, 843 (TTAB 1977).

In short, we conclude from the evidence of record with respect to the relevant *du Pont* factors that a likelihood of confusion exists in this case. Purchasers familiar with

⁵ Applicant has cited no authority for the proposition that an absence of actual confusion is probative evidence of the sophistication of purchasers. Regardless, as discussed above, the absence of actual confusion is of little consequence in this case because it has not been shown that there has been any meaningful opportunity for actual confusion to have occurred in the marketplace.

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NORTHWEST paper, upon encountering paper sold under the mark SPICERS NORTHWEST PAPER, would be likely to assume that a source connection or other affiliation exists.

Decision: The refusal to register is affirmed.

R. L. Simms

B. A. Chapman

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board