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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Meramec Group, Inc.**

Serial No. 75/095,780

Paul M. Denk, Esq. for **Meramec Group, Inc.**

Elizabeth A. Dunn, Trademark Examining Attorney, Law Office 109
(**Deborah S. Cohn**, Managing Attorney).

Before **Hohein**, **Walters** and **Chapman**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

An application has been filed by **Meramec Group, Inc.** to
register the mark "ULTRA-LITE" for "urethane structural shoe
components marketed to footwear manufacturers".¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75/095,780, filed on April 29, 1996, which alleges dates of
first use of February 1992.

applicant's mark, when applied to its goods, so resembles the mark "NITROGEN ULTRA-LITE," which is registered for "women's, men's and children's athletic shoes,"² 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 reverse the refusal to register.

Turning first to consideration of the respective goods, the Examining Attorney argues that athletic shoes and urethane structural shoe components marketed to footwear manufacturers are closely related goods because, as shown by copies of certain third-party registrations which she has made of record, several footwear manufacturers have in each instance registered the same mark for both shoes and components of shoes, such as leather, cushioning materials and linings, while a number of other footwear manufacturers own registrations for marks for various footwear components, including fabrics, straps, insoles and toe pieces and soles. The Examining Attorney contends, in view thereof, that:

None of the registrations in the record are limited to components used in the registrant's own footwear. The same footwear manufacturers who purchase the applicant's shoe components may purchase the shoe components of other shoe manufacturers. Thus, the footwear manufacturer who is familiar with the NITROGEN ULTRA-LITE footwear competitor and then encounters ULTRA-LITE footwear components is likely to believe the footwear and the components to emanate from a single source.

² Reg. No. 1,916,526, issued on September 5, 1995, which sets forth dates of first use of July 15, 1990.

The Examining Attorney also notes that the record contains evidence which "shows that shoe purchasers look for shoe components when purchasing shoes." Specifically, the Examining Attorney refers to excerpts from an article in the March 17, 1997 issue of the trade publication Footwear News, headlined "The right stuff: hot components can do wonders for shoe sales," which states, in relevant part, that:

Vibram, Thinsulate and Gore-Tex -- hot brands in the components arena -- are what educated shoppers are asking for these days when it comes to lifestyle as well as performance-driven products. These names have become so integral a part of the footwear market, say industry sources, that they can sometimes overshadow the brand name of a shoe or boot.

So powerful are these components that even unknown footwear brands can often bank on them

"If you're in the waterproof business, Gore-Tex is the buzz word," said Peter Hillier, general manager of Chippewa Boot
....

Not leaving anything to chance, Chippewa makes use of hangtags. "I put as many as I can on," boasted Hillier, about the number a particular item can carry. "I want the Encyclopedia Brittanica on my boot. Customers may not read it all, but otherwise it's a Kmart boot."

Since a portion of Lewiston, Maine,-based Dunham Bootmakers' line can feature anywhere from four to six name-brand components, the company has developed a hangtag of its own, which it uses in place of those supplied by component producers. The tag explains the benefits of each component and serves as an educational tool for both consumers and sales associates.

....

Quality is the driving force behind W. L. Gore's success with Gore-Tex, said Lisa Wyre, an associate with the company, which has a roster of licensed manufacturers that use its components in their products. To get its message out, the firm has gone straight to consumers through a corporate ad campaign with a slogan that reads, "If it doesn't say Gore-Tex, it's not."

Like Gore-Tex, Vibram doesn't throw its name around the industry. In fact, the sole company has a list of about 3,000 licensed shoe-repair centers that carry its products.

....

The Examining Attorney maintains, in view thereof, that "while the applicant's shoe components may be marketed directly to footwear manufacturers, those manufacturers may market the shoes to consumers using the trademarked ULTRA-LITE component." In consequence thereof, the Examining Attorney insists that "[s]hoe purchasers familiar with NITROGEN ULTRA-LITE shoes who then encounter shoes advertising ULTRA-LITE shoe components are likely to believe [that] the goods ... originate from the same source."

It is well settled that the issue of likelihood of confusion must be determined both in light of the identifications of goods as set forth in the application and cited registration and, absent any limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods.³ Here, however, applicant has specifically limited the identification of its goods to urethane structural shoe

³ See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

components marketed to footwear manufacturers. By contrast, while registrant's identification of its goods contains no particular restriction as to their channels of trade, it is plain that women's, men's and children's athletic shoes would be sold to footwear resellers, such as retailers, for ultimate sale to the general public.

We thus agree with applicant that, on this record, the scenarios postulated by the Examining Attorney are not likely to result in confusion as to source or sponsorship. As applicant persuasively points out in its brief, the exclusive channels of trade for its urethane structural shoe components, and hence the only persons who will purchase its goods or otherwise encounter its mark, are manufacturers of footwear:

Applicant markets ... polyurethane midsoles and outsoles, under this trademark, by applying a hang tag to the cartons in which these shoe components are marketed and shipped to footwear manufacturers, in bulk. The trademark is not used upon the goods per se.

The affixation clause of the application, in fact, confirms that applicant's "ULTRA-LITE" mark "is used by applying it to hang-tags applied to the products upon their marketing." However, as applicant emphasizes in its reply, "there is no evidence in this case that the ... ULTRA-LITE mark is used upon the shoe components per se" and, "[h]ence, the examiner's assumption that customers of the retail shoes may also see footwear components of the applicant, bearing the trademark, is just not presented in this case," nor is there any indication that applicant so

licenses the use of its mark to the footwear manufacturers to which it exclusively sells its goods.

Thus, while applicant readily concedes that its products are "ultimately included into manufactured footwear," it also persuasively has established that the channels of trade for its goods are separate and distinct from those for registrant's goods, thereby making confusion as to origin or affiliation among resellers of footwear and/or their customers unlikely:

[The goods upon which] the mark of applicant is [used are] sold only to footwear manufacturers, and not on [sic] the retail marketplace. The goods are sold in bulk, and therefore, constitute an entirely different method of marketing, in a different channel of trade, from the mark of the cited registration. Obviously, the NITROGEN ULTRA-LITE mark as used upon [registrant's] athletic shoes, are ultimately sold upon the retail market, to women, men and children. Thus, an entirely different channel of trade is involved.

Furthermore, as applicant cogently notes, "footwear manufacturers are reasonably sophisticated purchasers, and are not likely to be confused through applicant's marketing of ULTRA-LITE branded shoe components, and obviously, the retail trade would not be confused, since applicant does not market its goods at that level."

It is remotely possible, of course, that a footwear manufacturer, knowing of registrant's "NITROGEN ULTRA-LITE" mark for athletic shoes, could perhaps wonder whether urethane structural shoe components marketed under the mark "ULTRA-LITE" emanate from or are otherwise associated with the same source. Such seems unlikely, however, since footwear manufacturers, by

the very nature of buying in bulk, would be careful and discriminating purchasers who would typically know the sources of supply for their shoe components and would not expend substantial sums to procure essential shoe components from a competitor based merely on an assumption of a common origin. As our principal reviewing court has cautioned in this regard:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967). Accordingly, given the differences in the channels of trade for the respective goods and the consequent differences in the purchasers encountering applicant's and registrant's products, confusion is not likely to occur. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993) ["PHOENIX" for leather sold in bulk held not likely to cause confusion with "PHOENIX" for all-purpose sports bags, luggage, attaché cases, portfolio briefcases, and handbags].⁴

⁴ For other cases in which confusion was held not likely to take place due to a lack of a significant commonality of trade channels and purchasers, see, e.g., *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) ["PURITAN" and design for "laundry and dry-cleaning services" held not likely to cause confusion with either "PURITAN" for "commercial dry cleaning machine filters" or "PURITAN" for "dry cleaning preparations" since the services and goods "are not so related that they would come to the attention of the same kinds of purchasers"]; and *In re Fesco Inc.*, 219 USPQ 437, 438-39 (TTAB 1983) ["FESCO" and design for "distributorship services in the field of farm equipment and machinery" found not likely to cause confusion with "FESCO" for, inter

This brings us to consideration of the respective marks, a factor which we find, in any event, compels a conclusion that there is no likelihood of confusion. Specifically, we note that even if applicant's goods, notwithstanding the explicit limitation in their identification that they are marketed only to footwear manufacturers, were considered to be closely related or sufficiently similar to the athletic shoes sold by registrant,⁵ it is still the case that, as argued by applicant, "there are distinct dissimilarities between the appearance, sound, connotation, and commercial impression of the mark of the cited registration, which includes the ... dominant word NITROGEN, when compared with the mark of the current application." In this regard, we observe that there is nothing in the record which indicates that the word "NITROGEN" has any descriptive or suggestive significance in relation to registrant's goods and that it is thus arbitrary or fanciful when used in connection with athletic shoes.

By contrast, the term "ULTRA-LITE" in registrant's "NITROGEN ULTRA-LITE" mark appears, at a minimum, to be highly suggestive of athletic shoes which are exceedingly lightweight.

alia, "foundry processing equipment and machinery--namely, ... tanks" because "the record does not admit of a reasonable probability of an encounter of opposing marks by the same customers"].

⁵ For example, although it appears in light of applicant's comments that it does not presently do so, in the future applicant could allow the footwear manufacturers which purchase its goods to advertise, under license from applicant, that their shoes contain applicant's "ULTRA-LITE" urethane structural shoe components or it could decide to place its mark on the outsoles it sells in a manner in which the mark would be visible to purchasers of footwear which incorporates applicant's such components.

Likewise, as the hang-tag specimens filed with the application make clear, applicant's "ULTRA-LITE" mark is, at the very least, highly suggestive of a characteristic or feature of applicant's urethane structural shoe components, namely, that its products are exceptionally light in weight. The specimens state, in relevant part, that (emphasis in original):

ULTRA-LITE is a unique blend of polyurethane materials developed specifically for lightweight midsole and outsole applications. **ULTRA-LITE** products provide the ultimate in lightweight flexibility, shock absorption, cushioning, energy return and stability. . . . For the ultimate in lightweight stability and shock absorption, always demand products made of genuine **ULTRA-LITE**[.]

The Examining Attorney, citing various cases,⁶ contends that the marks at issue involve the simple rule that "[t]he mere [deletion or] addition of a term [from or] to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d)." A more complete and accurate statement of such principle, however, is set forth, for example, in *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), in which the Board pointed out that:

[T]here is a general rule that a subsequent user may not appropriate another's

⁶ See *Coca-Cola Bottling Co. of Memphis, Tennessee v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ["BENGAL LANCER" versus "BENGAL"]; *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ["THE LILLY" versus "LILLI ANN"]; *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ["MACHO COMBOS" versus "COMBOS"]; *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ["CAREER IMAGE" versus "CREST CAREER IMAGES"]; *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ["CONFIRM" versus "CONFIRMCELLS"]; *In re Riddle*, 225 USPQ 630 (TTAB 1985) ["RICHARD PETTY'S ACCU TUNE" versus "ACCUTUNE"]; and *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ["HEAD START COSVETIC" versus "HEAD START"].

entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it. See: *Bellbrook Dairies, Inc. v. Hawthorn Melody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958), and *In re South Bend Toy Manufacturing Co., Inc.*, 218 USPQ 479 (TTAB 1983). An exception to the rule may be found in those cases where the appropriated mark is highly suggestive or merely descriptive or has been frequently used by others in the field for the same or related goods or services. See: *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975) and *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 133 USPQ 242 (SDNY 1962), affirmed[,] 312 F.2d 125, 136 USPQ 236 (2nd Cir. 1963).

Applying the above to this case, and given the high degree of suggestiveness possessed by the term "ULTRA-LITE," applicant's "ULTRA-LITE" mark is readily distinguishable from registrant's "NITROGEN ULTRA-LITE" mark by the absence of the arbitrary or fanciful term "NITROGEN". Customers for registrant's athletic shoes would rely primarily on the arbitrary or fanciful term "NITROGEN" as the source indicative element of its "NITROGEN ULTRA-LITE" mark and would attribute to the designation "ULTRA-LITE" only its highly suggestive connotation. In view thereof, the contemporaneous use by applicant of its highly suggestive "ULTRA-LITE" mark in connection with urethane structural shoe components marketed to footwear manufacturers is not likely to cause confusion as to source or sponsorship.

Decision: The refusal under Section 2(d) is reversed.

G. D. Hohein

C. E. Walters

Ser. No. 75/095,780

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board