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Paper No. 27
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Emhart Industries, Inc.
v.
Unimation, Inc.

Opposition No. 103,683
to application Serial No. 74/641,277
filed on **March 2, 1995**

Richard L. Kirkpatrick of Pillsbury Madison & Sutro LLP for
Emhart Industries, Inc.

James J. Hamill of Fitch, Even, Tabin & Flannery for Unimation,
Inc.

Before Cissel, **Walters and Holtzman**, Administrative Trademark
Judges.

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

An application has been filed by Unimation, Inc. to register
the mark ULTRASERT for a "plastic weldable fastener."¹

Registration has been opposed by Emhart Industries, Inc.
under Section 2(d) of the Trademark Act. As its ground for
opposition, opposer asserts priority and likelihood of confusion
under Section 2(d) of the Trademark Act, contending that

¹ Application Serial No. 74/641,277 filed March 2, 1995 alleging a bona fide intention to use the mark in commerce.

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applicant's mark when applied to applicant's goods so resembles opposer's previously used mark ULTRASERT for "metal inserts or fasteners used for affixing plastic components to one another" as to be likely to cause confusion. Opposer has alleged that no use was made of applicant's mark "prior to March 12, 1995" and that opposer used its mark prior to "applicant's first actual or constructive use of" the mark.

Applicant, in its answer, denies the salient allegations in the notice of opposition.

The record includes the pleadings; the file of the involved application; opposer's notice of reliance on evidence including applicant's discovery responses; and the testimony with exhibits of Gregory A. Wind, opposer's Director of Marketing and Development. Applicant did not take testimony or offer any other evidence. Only opposer filed a brief. An oral hearing was not requested.

Opposer claims, and the evidence shows, that its mark ULTRASERT is used on metallic threaded insert fasteners. Opposer's product catalogs, as identified and described by Mr. Wind, combined with evidence of product sales under the ULTRASERT mark, demonstrates that opposer and its predecessors have continuously used ULTRASERT to identify these products since at least as early as 1982. In any event, opposer has demonstrated use of its mark well prior to the March 2, 1995 filing date of applicant's application, which, in view of the absence of other

evidence, is the earliest date on which applicant is entitled to rely.

We turn then to a consideration of likelihood of confusion. 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, including the similarity of the marks and the similarity of the goods. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

The parties' ULTRASERT marks are identical. Where the marks are identical, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983). However, in this case, the evidence shows that the respective goods are directly competitive.

Opposer's goods are metallic threaded insert fasteners, that is, threaded seats for screws. These insert fasteners are designed to be installed into weak materials, primarily plastic, binding to the plastic through ultrasonic heating, and providing a strong, reliable thread in such materials, to enable the assembly and disassembly of plastic products and equipment. (Wind test. p.11). As described by Mr. Wind, these products would be used, for example, in the automotive field where they may be set

in side view mirrors, and in the computer industry to hold in circuitry and other hardware components in laptops and PC's. They could also be used in medical, garden and lawn equipment, electronics, telecommunications, including phone equipment, or in any application, whether in consumer or commercial products, that has a requirement for a threaded insert in plastic.

Mr. Wind testified that applicant's fasteners are essentially the same as those of opposer, differing only in their composition. Although opposer's fasteners are metallic brass and applicant's are made of plastic,² according to Mr. Wind, the respective products are functionally equivalent. As can be seen from applicant's product catalog, and as explained by Mr. Wind, applicant's products, like opposer's, are designed to be used with plastic components and assembly to provide a strong thread in plastic materials, molded into plastic with the same (ultrasonic) technology, and used for the same applications, and perhaps even in the very same products.

In view of the directly competitive nature of the parties' goods, the channels of trade and classes of purchasers for the

² Mr. Wind indicates that the advantages of plastic over metal are its slightly lower cost and its "recyclability" within an application. (Wind test. p.71). In fact, Mr. Wind states that opposer has explored the possibility of expanding its brass fastener line to include plastic alternatives.

respective goods are deemed to be the same.³ Furthermore, applicant's goods, as identified, are not restricted as to channels of trade or classes of purchasers. See Canadian Imperial Bank v. Wells Fargo, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Opposer has established that applicant's mark ULTRASERT for plastic weldable fasteners is likely to cause confusion with opposer's identical mark for competitive goods.⁴

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

³ Opposer markets its products to design engineers who specify it for a particular application. The products are sold primarily to "the injection molding facilities who have requests from original equipment manufacturers." (Wind test. p.39). We note that in response to opposer's interrogatories, applicant describes its classes of customers in part as "fabricators of products...and assemblers of products with specialize[d] fastening needs."

⁴ We note opposer's apparent request that the Board infer applicant's "intent to confuse" and "guilty heart" in adopting the mark based on applicant's "failure to defend its case with any testimony or other evidence" and its prior knowledge of opposer's mark. The evidence does not support such an inference. Opposer, as plaintiff in this proceeding, bears the burden of going forward with sufficient proof of its material allegations. Opposer has not met its burden respect to this allegation. Mere knowledge of the existence of a prior user's mark does not, by itself, constitute bad faith. See Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989). Establishing bad faith requires a showing that applicant intentionally sought to trade on opposer's good will or reputation. See Big Blue Products Inc. v. International Business Machines Corp., 19 USPQ2d 1072 (TTAB 1991).