

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Symbol Technologies, Inc.*

Serial No. 74/697,985

David B. Kirschstein of Kirschstein, Ottinger, Israel &
Schiffmiller, P.C. for *Symbol Technologies, Inc.*

Virginia T. Isaacson, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before *Simms*, Holtzman and McLeod, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Symbol Technologies, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register the mark
shown below for "pens" in Class 16.¹

¹ Application Serial No. 74/697,985, filed June 14, 1995, based upon
allegations of use since February 1995. The application includes the
statement that the lining in the drawing is a feature of the mark and
is not intended to indicate color.

symbol

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the basis of Registration No. 1,886,003 for the mark SYMBOL for the following goods:²

Paper, cardboard and paper and cardboard articles; namely, bond paper, illustration paper, lining paper, paper pads, printing paper, reproduction paper, paper illustration boards, paper board, writing papers, greeting cards, envelopes, card boxes, corrugated record storage boxes, paper boxes, business cards, book covers, check book covers, calendars, hanging folders, file folders, stationery folders, blank and partially printed price tickets, printed blank and partially printed paper and cardboard labels, posters, printed and graphic art reproductions, paper file jackets, catalogs in the field of paper products and art reproductions, cardboard floor displays for merchandising products.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.³

A brief procedural review is necessary at this point. The application was initially filed in six classes, 14, 16, 18, 21, 25 and 28.⁴ In the first Office action, the Examining Attorney

² Issued March 28, 1995 under Section 44 of the Trademark Act.

³ The application was assigned to a different Examining Attorney for the appeal brief.

⁴ The goods in those classes are identified as follows: Watches (Class 14); Pens (Class 16); Portfolios, sports bags and umbrellas (Class 18); Mugs (Class 21); Golf shirts, jackets, sweaters, T-shirts, sweatshirts and hats (Class 25); and Golf balls (Class 28).

Ser No. 74/697,985

refused registration under Section 2(d) of the Trademark Act in Class 16 on the basis of Registration No. 1,886,003 and in Class 25 in view of Registration No. 1,687,170. In addition, the Examining Attorney required substitute specimens for the goods identified in Class 14 and advised as to the existence of a prior pending application (Serial No. 74/638,593) pertaining solely to that class. Applicant subsequently filed amendments to delete the goods identified in Class 14 and to divide Classes 18, 21, and 28 out of the application.⁵ In her appeal brief, the Examining Attorney noted the cancellation of Registration No. 1,687,170 under Section 8 of the Trademark Act (on November 16, 1998) and withdrew the refusal to register as to Class 25.

Thus, this appeal goes forward on the issue of likelihood of confusion between Registration No. 1,886,003 and the goods identified in Class 16 of the application. We affirm the refusal to register for the reasons set forth below.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods or

⁵ The divided "child" application issued into Registration No. 2,142,922 on March 10, 1998 in Classes 18, 21 and 28.

Ser No. 74/697,985

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976) and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Turning first to the marks, we find that applicant's mark, SYMBOL and design, and registrant's mark, SYMBOL, are identical in sound and meaning and create very similar commercial impressions. The word portions of the marks are identical. In fact, applicant's mark incorporates registrant's mark in its entirety.

Applicant essentially argues that the marks must be considered as a whole, that the word and design portions are integrated features of applicant's mark and therefore are not separable components of the mark. Applicant is correct that marks must be compared in their entireties in determining likelihood of confusion. However, as our primary reviewing court has stated, there is nothing improper in giving more or less weight to certain features of the marks as being more dominant or otherwise significant, and therefore to give those features greater weight. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods, and the words, rather than the design feature or the stylized lettering, will therefore have a greater

Ser No. 74/697,985

impression on them. See *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999) citing *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

In this case, the dominant portion of applicant's mark is the word "SYMBOL." That same word is registrant's entire mark. The design element of applicant's mark results only in a modest visual difference in the marks which, contrary to applicant's contention, is hardly sufficient to differentiate one mark from another and does not change the commercial impressions both marks create.

Turning to a consideration of the goods, the Examining Attorney argues that pens and "paper products such as those sold by the registrant" are "marketed together in the same channels of trade and are often sold by the same source." The Examining Attorney has made of record five third-party registrations as evidence of the asserted relatedness of the goods and to support her position that one source has registered the same mark for pens and "a variety of paper goods." Applicant, on the other hand, maintains that the goods are not "the same," and that the differences in the marks together with the differences in the goods overcomes any likelihood that the respective goods would be confused.

We begin by noting that it is not necessary that the goods of the applicant and registrant be similar or even competitive to

Ser No. 74/697,985

support a holding of likelihood of confusion; it is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's pens and registrant's writing papers, for example, may not be "the same" or directly competitive products. They are, nonetheless, related. The complementary nature of pens and writing papers is obvious. It is also a matter of common knowledge that they are both basic stationery or office supply products which would typically be sold to the same classes of purchasers in the same types of stores or outlets, including stationery stores and office supply stores. Such complementary use and "interests" have long been recognized as relevant

considerations in determining a likelihood of confusion.⁶ See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Moreover, at least one Board decision has held that the use of similar marks in connection with these very products is likely to cause confusion. See *Anciennes Manufactures Canson et Montgolfier, Societe Anonyme v. Anson Incorporated*, 170 USPQ 238 (TTAB 1971).

Finally, there is no evidence or argument that the purchasers of the respective goods are sophisticated or that the products are purchased after thoughtful attention. Indeed, the products, pens on the one hand and writing papers on the other are generally inexpensive stationery items which may be purchased on impulse without a great deal of care. It is well settled that purchasers of such items are held to a lesser standard of

⁶ In determining that the respective products are related, however, we did not find the five third-party registrations to be particularly persuasive. In fact, only one of the registrations tends to support a claim that pens and a number of the specific paper products identified in the cited registration are related. One other registration does not even include any of the specific products identified in the cited registration. Of the remaining three registrations, we note that two are owned by the same entity and they are all issued to what appear to be baseball organizations. This becomes significant when we note that while these registrations cover both pens and some sort of paper products (such as posters and calendars, items identified in the cited registration) the paper products consist primarily of baseball-related merchandise such as trading cards, score books, souvenir programs and team photos. In other words, the registrations appear to cover a line of collateral merchandise which is used to promote the underlying sports team. As such, the registrations do not reflect the general consumer marketplace for the goods identified therein as they do in the involved application and cited registration but rather a limited consuming public, that is, fans of the particular sports team.

Ser No. 74/697,985

purchasing care and are more likely to be confused as to the source of the goods. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984).

We conclude, in view of the foregoing, that purchasers familiar with registrant's writing papers sold under its mark SYMBOL are likely to believe, upon encountering applicant's mark SYMBOL, and design, for pens, that the products originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.

R. L. Simms

T. E. Holtzman

L. K. McLeod
Administrative Trademark
Judges, Trademark Trial
and Appeal Board