

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUL 17, 00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Acme Royalty Company, L.P.

Serial No. 75/326,000

Charles S. Citropia of Sidley & Austin for Acme Royalty
Company, L.P.

Geoffrey D. Aurini, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Hanak and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 17, 1997, applicant filed an application to
register the mark shown below

Ser No. 75/326,000

on the Principal Register for "marble and ceramic tile; mortar for setting tile" in Class 19; and "wholesale distribution services of marble and ceramic tile and supplies for setting tile" in Class 42. The applicant claimed use of the mark in commerce in connection with the Class 19 goods since July of 1992, and use in connection with the services specified in Class 42 since 1984.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with the goods and services set forth in the application, so resembles the mark "AMERICAN," which is registered¹ for "ceramic tile" in Class 19, that confusion is likely.

Responsive to the first Office Action, applicant amended the recitation of services to read "wholesale distributorships featuring marble and ceramic tile and supplies for setting tile," in Class 35. Further, applicant disclaimed in the term "TILE SUPPLY," and entered a statement into the application that the lining shown in the drawing of the mark is a feature of the mark and is not intended to represent any particular color. Applicant also presented argument on the

¹ Reg. No. 874,547 issued to American Olean Tile Co., Inc. on August 12, 1969. Combined affidavit under Sections 8 and 15 of the Act accepted.

Ser No. 75/326,000

issue of likelihood of confusion, along with the affidavit of Richard J. Savitz, applicant's vice president, secretary and treasurer. Mr. Savitz stated in his affidavit that he is aware of no actual confusion between applicant's mark and the cited registered mark. Further, he claimed that applicant's mark had become distinctive of applicant's goods and services as a result of applicant's continuous and exclusive use of it for more than five years.

The Examining Attorney accepted applicant's claim of acquired distinctiveness, the disclaimer, the amendment to the recitation of services and the statement with respect to color lining, but maintained and made final the refusal of registration under Section 2(d) of the Act.

Applicant filed a timely notice of appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board, so we have resolved in this appeal based on the written record and arguments presented in the briefs.

After careful consideration of these materials in view of the statute and legal precedent on this issue, we affirm the refusal of registration.

Our primary reviewing court listed the factors to be considered in resolving the issue of likelihood of confusion under the Lanham Act in *In re E. I. DuPont de Nemours & Co.*,

Ser No. 75/326,000

476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key factors for our consideration are the similarities between the marks and similarities between the goods or services. We must first look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. If the marks are similar, then we must compare the goods or services to determine if they are commercially related or if the activities surrounding their marketing are such that confusion is likely if similar marks are used in connection with both. International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). If there has been any opportunity for actual confusion to have occurred, whether or not it has is a factor which should also be considered. Any doubt on the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant, who has a legal duty to select a mark which is dissimilar to trademarks already being used. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

The trademarks at issue in the case before us are similar. As noted above, the registered mark is a typed drawing of the word "AMERICAN," whereas in the mark applicant seeks to register features the same term, "American," combined with the descriptive words "Tile Supply" and a graphic design which is suggestive of ceramic tile. Although we have

compared these two marks in their entireties, it is well settled that one feature of a mark may nevertheless be recognized as having more significance in creating the commercial impression of the mark. Greater weight is to be given to such a dominant feature in determining whether confusion is likely. In re National Data Corp., 732 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Typically, when marks combine terms with other terms which are merely descriptive of the goods or services with which the marks are used and/or with design elements which depict or suggest the products or services, the remaining word elements which are neither suggestive nor descriptive are the dominant components of such marks. Such word elements are more likely to be impressed upon a purchaser's memory and are used in calling for the goods or services.

In the instant case, the word "American" is such an element, and that same word is the registered mark in its entirety. Clearly, if the goods and services specified in the application are commercially related to the goods identified in the cited registration, confusion is likely.

Turning, then, to the goods and services, we note that in order for confusion to be likely, the goods and/or services do not need to be identical or even directly competitive. All that is necessary is that they be related in some manner, or

Ser No. 75/326,000

that the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that would likely give rise to to the mistaken belief that the goods or services all come from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

If the goods and services of the respective parties are closely related, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be the case if the goods or services were disparate. ECI Division of E Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443 (TTAB 1980). In the case now before us, the goods are identical, namely, "ceramic tile." Applicant's use of its mark in connection with wholesale distributorships featuring ceramic tile is also likely to cause confusion. It has frequently been held that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving such goods, on the the other. In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). In the case at hand, confusion is clearly likely when these similar marks are used in connection with identical goods and wholesale distributorship services involving the same goods.

Applicant's argument that confusion is not likely because the goods and services at issue in this case are offered to sophisticated purchasers is not persuasive. To begin with, neither the application nor the registration restricts the channels of trade in which the ceramic tile of applicant or registrant is sold. In the absence of any such limitations, because the goods are the same, we must assume that the trade channels and customers are the same. That applicant also renders the specified tile distributorship services in Class 42 does not have the effect of limiting the channels of trade through which "ceramic tile" in Class 19 moves. Moreover, even if the terms in the registration and application, respectively, limited or restricted the trade channels for the goods of both parties in such a way that it was clear that only sophisticated purchasers were involved, applicant's argument would still not be persuasive. The fact that purchasers are sophisticated or knowledgeable in a particular field does not make them immune from source confusion when similar marks are used in connection with similar, or this case identical, products. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

Also unpersuasive is applicant's argument that third-party registrations of similar marks mandate registration of the mark in the instant application. To begin with, although

Ser No. 75/326,000

applicant presented arguments based on the assertion of several third-party registrations, copies of the registrations were never submitted. Even if the record did contain proper evidence of the existence of the registrations argued by applicant, it is well settled that such registrations are not entitled to much weight on the issue of likelihood of confusion. In *re* Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). They are not evidence that the marks therein are in use in commerce, much less that the public is familiar with the use of such marks. Moreover, the particular marks cited by applicant in its argument appear to create sufficiently different commercial impressions or are registered in connection with goods or services which are sufficiently different from those at issue in the instant case. As the Examining Attorney points out, applicant's mark is highly similar to the cited registered mark and the goods are in part identical.

Finally, we must note that although Mr. Savitz attests that he is aware of no incidents of actual confusion, actual confusion is not necessary in order to establish that confusion is likely. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Ser No. 75/326,000

In summary, confusion is likely because the goods listed in the application are in part identical to the goods specified in the cited registration, and the marks are similar in view of the fact that the dominant element in applicant's mark is the word "American," which is the registered mark in its entirety. Accordingly, the refusal to register under Section 2(d) the Act is affirmed.

R. F. Cissel

E. W. Hanak

B. A. Chapman
Administrative Trademark Judges
Trademark Trial & Appeal Board

Ser No. 75/326,000

Ser No. 75/326,000