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Paper No. 20
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Siemens Power Transmission & Distribution, Inc.

Serial No. 75/363,102

Richard V. Westerhoff and Michael D. Lazzara of Ekert Seamans Cherin & Mellott, LLC for Siemens Power Transmission & Distribution, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Hanak and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant has appealed from the refusal of the Trademark Examining Attorney to register DVR for "active power conditioners for compensating for voltage sags and swells in electric power transmission and distribution systems,"¹ in International Class 9.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark DVR for "electric

¹ Application serial number 75/363,102 was filed on September 25, 1997.

voltage regulators,"² also in International Class 9, that, as used on applicant's identified goods, it is likely to cause confusion, to cause mistake or to deceive.

The appeal has been fully briefed, but an oral hearing was not requested. We affirm the refusal of registration.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & 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. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Obviously, applicant's and the registrant's marks are identical. Further, the registrant's mark is a strong one. Based upon this record, it appears that DVR is an arbitrary mark for the registrant's electric voltage regulators. Similarly, while the LEXIS/NEXIS® articles attached to the initial Office Action repeatedly show use of the designation " ... dynamic voltage restorer (DVR) ...," substantially all the "hits" appear to be references to applicant's product.

² Registration No. 1,759,107, issued on March 16, 1993; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

Furthermore, applicant argues strongly that it coined this initialism for its active power conditioner devices:

The trademark DVR was coined by Applicant to identify the source for its active power conditioner devices... Applicant respectfully submits that the DVR mark was not used by industry in the context of active power conditioner goods prior to its use by Applicant as a trademark for Applicant's product. The DVR mark was initially coined by Applicant... (applicant's response of December 28, 1998, p. 5).³

Inasmuch as the marks herein are identical in all respects, we turn to a consideration of whether the respective goods are sufficiently related. It is well settled, in this regard, that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96

³ We note that while the initial Office Action also refused this initialism as being merely descriptive under Section 2(e)(1) of the Act, the portion of applicant's response quoted above contains applicant's arguments against such a finding. Although the Trademark Examining Attorney never expressly withdrew this additional basis for refusal, it was not pursued again after applicant made its arguments against such a holding.

(TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

As noted above, applicant's goods are identified as active power conditioners for compensating for voltage sags and swells in electric power transmission and distribution systems while registrant's are identified as electric voltage regulators. In her final refusal, the Trademark Examining Attorney takes the position that "[t]he goods simply employ different methods to solve the same problem." (Office Action of February 16, 1999, p. 2). Applicant strongly disagrees with this characterization of the respective goods, arguing instead that these goods are not related in that they perform different functions in different ways on different equipment and are orders of magnitude different in size, power and cost. Specifically, applicant maintains that:

[Applicant's] active power conditioners function to address voltage sags and swells in the electric power transmission and distribution systems. They provide a source which injects power into the transmission or distribution line in the case of a sag, or withdraws power from the transmission or distribution line in the event of a swell, thereby providing or absorbing real power as needed to compensate for the disturbance in the electric power system. In addition, Applicant's goods sold under the mark provide compensation to improve the quality of the sinusoidal pattern of the voltage and shifts in phase of the voltage in addition to compensation for swells and sags in voltage magnitude.

On the other hand, the Registrant produces "standby generators ranging from 5 kilowatts to over 2,000 kilowatts" and a "digital voltage regulator" for "unprecedented precision and protection in the regulation of generators." Thus, Registrant's goods are devices that regulate the voltage that a standby generator produces. Such devices maintain a constant voltage output and are not designed to, nor are they capable of serving as a source or reservoir of energy. Most importantly, they are not designed and are not used to regulate the voltage on electric power transmission or distribution lines. Hence, the goods of Applicant and Registrant are not related in that they perform different functions, i.e., compensating for sags and swells on electric power transmission and distribution lines vs. regulating the output voltage of a generator, in that they operate in different ways, i.e., injecting or absorbing energy vs. maintaining a constant output voltage, and in that they operate on different equipment, i.e., electric power transmission and distribution lines vs. small standby generators. They are also orders of magnitude different in size, power and cost. Applicant's specimen filed with the application illustrates one of its devices which is housed in and fills a large trailer truck as opposed to the relatively small size of a voltage regulator on a small generator, which is Registrant's product. Obviously, such a much larger device costs much more.

The Examining Attorney, on the other hand, correctly notes that the issue of likelihood of confusion must be determined on the basis of the goods as they are identified in the application and the cited registration, citing Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Here, even if applicant's power conditioning devices may be used somewhat

differently from registrant's voltage regulators, given their similarities, the Trademark Examining Attorney contends that "it would be reasonable for a prospective customer to assume that both types of goods can come from the same source."

In support of this position, the Trademark Examining Attorney has submitted for the record a number of NEXIS® stories, such as the following paragraph, showing that these two devices for ensuring uninterrupted power are more alike than applicant argues:

Methods to safeguard against the vagaries of commercial AC power include dedicated lines, dual feeders, shielded isolation transformers, **line-voltage regulators, power-line conditioners**, motor generators, engine generators, power distribution centers, and UPSs. These power conditioning systems vary in cost and in the degree of protection they provide..
"Staying in Power: Uninterruptible power supply for computer equipment," Datamation, July 15, 1986. (emphasis supplied)

The Trademark Examining Attorney has also shown that a number of merchants and manufacturers listed in the Thomas Register offer among their listed electrical products goods identified as power conditioners as well as voltage regulators.

After a complete review of the entire record, we conclude that there are differences in the functional characteristics of these respective goods. For example, applicant's sophisticated power conditioners have a capacity for compensation (e.g., injecting power to the load side in the

case of a sag in electricity coming from the grid), whereas the typical voltage regulator has no reservoir of energy. From registrant's web pages made part of the record by applicant, it is clear that many of registrant's motors and generators are targeted to small- and medium-sized businesses, while applicant's specimens of record show a product housed on a tractor trailer and marketed to electric power utilities and large manufacturers.

In spite of these differences, however, we agree with the Trademark Examining Attorney that they are related goods. Both serve as devices placed between a power source (e.g., an electric power substation, the utility's electricity power grid or a local, standby generator) and the load (e.g., large factories, computer intensive industrial sites or hospitals). Both are designed to take an electrical power input and improve the quality of the electrical signal at its output end.

A "voltage regulator" is a device that "holds an output voltage constant during variations in the output load or input voltage."⁴ Under this definition, an active power conditioner would be a specialized subset of this broadly defined category

⁴ *The Illustrated Dictionary of Electronics*, Seventh edition (1997) McGraw-Hill, p. 720.

of goods.⁵ While applicant's current identification of goods is indeed listed as "active power conditioners for compensating for voltage sags and swells in electric power transmission and distribution systems," we note that the application as originally filed identified the goods as "solid state voltage regulators." Upon receiving the initial Office action, which cited registrant's mark as applied to voltage regulators, applicant amended its identification of goods. To the extent that applicant submitted this amendment, and the Trademark Examining Attorney subsequently approved this change, under the strictures of Trademark Rule 2.71(a)⁶, we have to assume that both applicant and the Trademark Examining Attorney made the determination that the amended terminology of "active power conditioners" was a clarification or limitation on the term "voltage regulators," rather than a device falling entirely outside the scope of that initial identification of goods.

⁵ Even if we view applicant's complex product as consisting of a number of different components, one part of which has the basic function of the traditional voltage regulator in ensuring a constant output of voltage, the goods of applicant and registrant both provide a similar function and could be competitive solutions for dealing with the "vagaries" of electrical inputs by improving the quality of the electrical signal at its output end.

⁶ §2.71 Amendments to correct informalities.
The applicant may amend the application during the course of examination, when required by the Office or for other reasons.

As to alleged differences in size and cost of these respective goods, the specimens of record indeed show a large, trailer-mounted compensation system designed to protect larger loads. However, there is nothing in the identification of goods that would restrict the use of applicant's power quality technology from a more compact sized platform. This might be due to advances in technology, or because applicant has found a market for a device that could likewise protect smaller electrical loads from voltage disturbances. Accordingly, if one compares the largest of registrant's generators (e.g., 2000 to 4000 kW) and their attendant voltage regulators to a more compact DVR device from applicant intended for smaller industrial customers, those differences in "size, power and cost" need no longer be measured in "orders of magnitude" (applicant's appeal brief, p. 6).

In its reply brief, applicant cites to *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990),⁷ arguing that in the current case, it has shown by a submission of registrant's web page that " ... a recitation of goods in a registration can have a

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- (a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

⁷ In *Trackmobile*, a Section 2(d) refusal had been issued based on a registration in which the goods were identified as "light railway motor tractors." The applicant, in attempting to overcome the Section 2(d) refusal by demonstrating that its goods were unrelated to the goods identified in the cited registration, offered extrinsic

meaning in the trade that does not include Applicant's goods." (reply brief, p. 2).

However, the Board considered the applicant's extrinsic evidence regarding the registrant's goods in Trackmobile because the Board was uncertain as to what the goods identified in the registration entailed. That is, the Board did not consider the extrinsic evidence in order to determine the exact nature of the registrant's particular "light railway motor tractors," but rather to determine generally what type of vehicles "light railway motor tractors" comprised.

In the present case, by contrast, no extrinsic evidence is necessary in order to educate the Board as to what "electric voltage regulators" are; the term has been defined with a dictionary entry, and while it may be broad, it is neither vague nor uncertain. Accordingly, applicant's reliance on Trackmobile is misplaced, and applicant's proffered extrinsic evidence regarding the nature and scope of the goods actually sold by the registrant is not probative of a different result herein.

As to the channels of trade, while some of the case studies cited in the LEXIS/NEXIS® materials do reflect the purchase of applicant's devices by utility companies, the

evidence as to the nature of the registrant's goods, evidence which the Board considered.

affidavit of James R. Legro makes it clear that these "power-conditioning" devices are also marketed to "large users" of electrical power including manufacturers having sensitive electrical loads. While in ¶ 17 of his affidavit, James R. Legro opines that registrant's goods "... are sold primarily to consumers of electrical generation equipment...", there is nothing in the record to suggest that this group of consumers does not overlap with applicant's potential customers, e.g., manufacturers having sensitive devices and production processes such as in the chemical industry, glass production, semiconductor production, paper industry, automobile factories, etc.

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, we acknowledge that applicant's goods are targeted to careful, sophisticated purchasers. However, with identical marks used on closely related goods, the fact that applicant's goods would be used by sophisticated purchasers, and not members of the general public, does not avoid a likelihood of confusion. That is, under the circumstances of this case, even among knowledgeable purchasers working for technically sophisticated customers, confusion as to the origin of the respective goods, or mistakenly attributing a common association thereto, is likely.

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods, there is nothing in the record to suggest that there are any third parties using this designation on power quality products or services, on voltage regulators or even any remotely related electrical power goods or services.

Finally, any doubt on the question of likelihood of confusion must be resolved against applicant as the newcomer has the opportunity of avoiding confusion and is obligated to do so. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Decision: The refusal to register is affirmed.