

7/20/01

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Paper No. 15  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re **United States Filter Corporation**

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Serial No. 75/664,412

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Peter C. Lando and Carole A. Boelitz of Wolf, Greenfield & Sacks for applicant.

David H. Stine, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

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Before Quinn, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by United States Filter Corporation to register the mark XCELL for "traveling bridge filter for industrial water and wastewater applications."<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that

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<sup>1</sup> Application Serial No. 75/664,412, filed March 19, 1999, based on an allegation of a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use that sets forth first use dates of May 5, 1997.

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applicant's mark, when applied to applicant's goods, so resembles the previously registered mark shown below



for "filter units for removing particulate matter and other contamination from fluids, filter vessels, cartridges, and dessicant dryers"<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the dominant portion of the cited mark is "EXCEL," and that the use of the "EDEN" house mark in the cited mark does not sufficiently distinguish the marks. The Examining Attorney contends that the goods in the cited registration are broadly worded and that, therefore, the goods must be considered to be legally identical. Also, the Examining Attorney points to the absence of any limitations in the identifications of goods in the application and registration, deeming that the goods travel in the same

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<sup>2</sup> Registration No. 1,380,276, issued January 28, 1986; combined Sections 8 and 15 affidavit filed.

channels of trade to the same purchasers. The Examining Attorney submitted a dictionary definition of the term "unit," and excerpts retrieved from the NEXIS database that, according to him, show that "traveling bridge filters" are "sold as units for removing particulate matter and other contamination from industrial water and wastewater." (Office action, March 31, 2000) The Examining Attorney is not persuaded by applicant's remarks relating to the sophistication of purchasers and the absence of actual confusion.

Applicant contends that the marks are dissimilar, arguing that its mark has a unique spelling and registrant's mark includes the term "EDEN." Applicant contends that the registered mark is dominated by "EDEN" because it is a house mark, and is the first word in the mark and is displayed on top of the term "EXCEL." Applicant argues that the cited mark is suggestive and, thus, entitled to a narrow scope of protection. In this connection, applicant submitted third-party registrations for what it asserts are similar marks for filtering systems. As to the goods, applicant states that its traveling bridge filters are large, built-to-specification filtering systems that may take up to a year to design, and two or three weeks to install. As such, applicant's goods

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are quite expensive, costing from \$50,000 to several millions of dollars.<sup>3</sup> Purchasers of applicant's goods are almost exclusively industrial plants and sanitary boards of municipalities. According to applicant, these purchasers are sophisticated since the filters require explicit specifications due to their custom manufacture. Applicant has submitted product booklets covering its filters. In urging that the refusal be reversed, applicant points to the lack of actual confusion since applicant began using its mark in May 1997.

Before turning to the merits of the likelihood of confusion refusal, we direct our attention to an evidentiary matter raised by applicant's submission of new evidence with its appeal brief. At the outset, we note that the submission of Exhibit B, consisting of applicant's product brochure, is not a problem because this material was properly made of record during the prosecution of the application.

Firstly, while applicant makes reference to a declaration of Dwight Smith (brief, p. 16), there is no such declaration accompanying the brief. Even if it were

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<sup>3</sup> This dollar figure appears in applicant's brief. In its request for reconsideration, applicant stated that the cost ranged from \$75,000 to \$125,000 per unit. Whichever figure is used, it can be said that applicant's goods are expensive.

in the file, the submission would be untimely.

Exhibit A consists of several third-party registrations retrieved from the Office's electronic search system (TESS). During the prosecution of the application, applicant introduced six third-party registrations. It has supplemented this submission with additional registrations that were not previously introduced. Also accompanying applicant's brief are invoices for applicant's goods to establish that they are expensive.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed. Evidence submitted after appeal may be considered, however, by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, *and* (2) discusses the new evidence or otherwise affirmatively treats it as being of record. *TBMP* §1207.03 [emphasis in original]. See, e.g., *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

In the present case, the Examining Attorney's brief is completely silent as to any of the third-party registrations and the invoices. Accordingly, we have not considered the invoices; and the six previously submitted

third-party registrations that were properly made of record are the only ones we have considered in reaching our decision.

Exhibit C, retrieved off the Internet, consists of excerpts from registrant's Web page. Applicant relies on this extrinsic evidence in an apparent attempt to limit the goods covered by the cited registration. The Examining Attorney specifically objected to the late introduction of this evidence. (brief, p. 4) In view of the untimely submission and the objection thereto, this evidence does not form part of the record on appeal and, accordingly, has not been considered in reaching our decision.

We now turn to the merits of the appeal. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. 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).

With respect to the marks XCELL and EDEN EXCEL (stylized), we find that the similarities in sound and

appearance outweigh the specific differences. The marks are similar in that XCELL is a phonetic equivalent of EXCEL. Although registrant's name EDEN appears in the registered mark, it appears in much smaller type as part of the letter "E" in the more prominently displayed "EXCEL" portion of the stylized mark. Given the subordinate manner in which registrant's name EDEN is displayed in the mark, the name is not likely to sufficiently distinguish the marks in the minds of purchasers.

In finding that the marks are similar, we have considered, of course, the suggestiveness of the term "excel" and its phonetic equivalents. In this connection, we take judicial notice of the dictionary definition of the term as "to surpass or outshine; be distinguishable by superiority." *Webster's Third New International Dictionary* (unabridged ed. 1993). While the marks are suggestive, however, they convey the same thought, namely, that the respective products are superior in quality.

In sum, when the marks are considered in their entirety, they engender similar overall commercial impressions.

Insofar as the goods are concerned, it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of

confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Further, the identifications of goods in the application and the cited registration control the comparison of the goods. See: Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)[ "[T]he question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be." ]; and In re Elbaum, 211 USPQ 639 (TTAB 1981).

When the goods are compared in light of the legal constraints cited above, we find that applicant's "traveling bridge filter for industrial water and wastewater applications" is related to registrant's broadly identified "filter units for removing particulate matter and other contamination from fluids, filter vessels,

cartridges, and dessicant dryers." As pointed out by the Examining Attorney, for purposes of the legal analysis of likelihood of confusion herein, it is presumed that registrant's registration encompasses all goods of the nature and type identified, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers. In re Elbaum, supra at 640. In this connection, the Examining Attorney relies upon a dictionary definition of "unit" showing that the term means "an entire apparatus or the equipment that performs a specific function." *The American Heritage Dictionary of the English Language* (3<sup>rd</sup> ed. 1992). Although their products may be specifically different, both applicant's and registrant's goods, as identified, are used to filter particulate matter and contamination from fluids.<sup>4</sup> Further, as identified, it is presumed that the goods travel in the same or similar trade channels and are bought by the same classes of purchasers.

We recognize that applicant's goods can be quite expensive and, therefore, may be the subject of deliberate

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<sup>4</sup> Applicant's product brochure indicates that the traveling bridge filter can be used for phosphorous removal, water reclamation and algae removal.

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purchasing decisions by sophisticated purchasers. Although this factor favors applicant, it is outweighed by the similarities between the marks and the goods. See: In re Decombe, 9 USPQ2d 1812 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983).

Another du Pont factor is the number and nature of similar marks in use on similar goods. In an attempt to narrow the scope of protection afforded the registered mark, applicant has introduced six third-party registrations of the marks EXCEL, XL, EXCEL, XL, XCEL and EXCELON for a variety of filter products. Although we have considered this evidence, as often stated, third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and the existence on the register of confusingly similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973), and Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967).

Applicant points to the absence of any actual confusion between the involved marks in the time since applicant began using its mark. As a du Pont factor, the

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absence of actual confusion weighs, of course, in applicant's favor. The probative weight is very limited here, however, by the fact that there are no specifics regarding the extent of use by applicant or registrant. Thus, there is no way to assess whether there has been a meaningful opportunity for confusion to occur in the marketplace. In any event, the test under Section 2(d) of the Trademark Act is the likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), aff'g, 12 USPQ2d 1819 (TTAB 1989); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re *Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re *Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.

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