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**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 9
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Randy Wolf

Serial No. 75/749,328

Joseph G. Mitchell for Randy Wolf.

Hyun (Kenneth) Oh, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Chapman, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Randy Wolf seeks to register TITAN CONVERTING EQUIPMENT for "machines, comprised of slitter-rewinders, to convert, slit, and rewind flexible packaging or coated papers to aid in the processing of products or packages; said machines are not used to convert, slit or rewind cardboard boxes or food," in International Class 7.¹ Applicant has disclaimed the words CONVERTING EQUIPMENT apart from the mark as shown.

¹ Application Serial Number 75/749,328, was filed on July 12, 1999. The application is based upon applicant's claim of dates of first use of December 1, 1983. As an aside, we note that the trademark register is not enhanced by such nonsensical clauses as "...said machines are not used to convert, slit or rewind ... food." This restriction was evidently included to overcome an earlier citation, since withdrawn, for the mark TITAN as applied to "food moulding machines." Even the portion of applicant's amended

The Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to his goods, so resembles the registered mark, TITAN, for "machines for making cardboard boxes, particularly machines for cutting, impressing, punching, notching, embossing and erasing paper and cardboard," also in International Class 7, as to be likely to cause confusion, to cause mistake or to deceive.²

Applicant appealed, and briefs have been filed. Applicant did not request an oral hearing. We affirm the refusal to register.

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

identification of goods that explicitly eliminates the fabrication of "cardboard boxes" does not obviate the Office's likelihood of confusion refusal herein, and seems quite unnecessary for an understanding of applicant's machinery, especially in light of the earlier designation of slitter-rewinder machines used on "flexible packaging or coated papers."

² Registration No. 916,248, issued July 13, 1971; Section 8 affidavit accepted and section 15 affidavit acknowledged; renewed. The claimed date of first use is April 23, 1959.

the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a consideration of the respective marks, applicant argues that the overall commercial impression of its TITAN CONVERTING EQUIPMENT mark differs from that of registrant's TITAN mark. Such marks, while concededly sharing the term TITAN not only are visually and phonetically distinct, according to applicant, but also are different in meaning. In consequence thereof, applicant insists that customers encountering the marks would be left with different commercial impressions.

While applicant is correct that the respective marks must be compared in their entireties, we agree with the Trademark Examining Attorney that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that the ultimate conclusion rests on consideration of the marks in their entireties. In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

Here, as the Trademark Examining Attorney points out, the designation TITAN is the dominant and source-indicative

portion of both applicant's and registrant's marks, because the disclaimed term CONVERTING EQUIPMENT in applicant's mark is generic which makes it less significant in forming the overall commercial impression of applicant's mark. Inasmuch as the dominant portions of both marks are identical in appearance, sound and meaning, we agree with the Trademark Examining Attorney that, overall, the applicant's and registrant's marks project essentially the same commercial impression when used in connection with their respective goods. Clearly, if such substantially similar marks were to be used in conjunction with the same or closely related goods, confusion as to source or sponsorship would be likely to occur.

Considering, therefore, the extent to which the respective goods are related, as the Trademark Examining Attorney correctly observes, we look to the goods as identified in the registration and in the application, and these goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient, instead, 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 under 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 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

It is applicant's position, however, that these respective goods are not likely to be encountered by the same purchasers under circumstances that would give rise to this mistaken belief:

... Applicant's mark is associated with machines that operate on flexible packaging or coated papers. The cited registered mark operates on cardboard boxes. The machines, then, are not highly related, so there is no cause of confusion of the source.

(Applicant's appeal brief, p. 7).

However, as the Trademark Examining Attorney argues, it appears as if both types of machinery are designed to be used in the packaging industry - where raw materials (e.g., paperboard, large sheets of coated papers, plastics, etc.) are turned into a finished product (e.g., resealable bags, folding cartons, gum wrappers, envelopes, etc.). In fact, applicant has not denied the conclusion of the Trademark Examining Attorney that the category of "package-related converting machinery" includes applicant's slitting and rewinding machinery as well as registrant's machines for making cardboard boxes. While the goods may well be specifically designed to perform different functions, and in some cases,

deal with differing materials,³ both fit within the same category, that of converting equipment.

As to the du Pont factor dealing with channels of trade, we conclude that both types of machinery would be marketed to the converting industry that turns large rolls or sheets of paper and cardboard stock into finished package products. Accordingly, it appears reasonable that the same vendors would manufacture both types of machinery, and that some of the larger enterprises in the packaging and converting industry would be cutting, embossing, printing and otherwise converting both flexible and more rigid packaging materials. Hence, we conclude that the channels of trade are most similar.

As to the du Pont factor focusing on the conditions under which, and buyers to whom, sales are made, we acknowledge that registrant's and applicant's goods are both targeted to careful, sophisticated purchasers. However, with nearly identical marks used on closely related goods, the fact that registrant's and applicant's goods would be encountered by sophisticated purchasers, and not members of the general public, does not negate a likelihood of confusion. That is,

³ Judging by the goods identified in its registration, a special niche for registrant's machinery in the converting and packaging industry involves more rigid, corrugated containers, while the special niche for applicant's machinery in the primary converting and packaging industry involves flexible packaging, including finished package products converted from rolls of more flexible materials like plastic, film or paper.

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, despite applicant's submission of a copy of a single page of the Greater Atlanta Business Telephone Book (demonstrating multiple businesses in that metropolitan area trading under the name "Titan"), there is nothing in the record to suggest that there are any third parties using this designation in the primary converting and packaging industry.

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, 1440 (TTAB 1993).

Decision: The refusal to register is affirmed.