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THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Engelhard Corporation

Serial No. 75/615,079

Richard R. Muccino and Raymond F. Keller for applicant.

Andrew J. Benzmilller, Trademark Examining Attorney, Law
Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Quinn and Holtzman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Engelhard Corporation
to register the mark PORTFOLIO for "printed merchandising
aides used in connection with the display/advertising of
architectural coatings, namely, color strips, color cards,
color fan decks, formulation guides, and designer/architect
kits, namely binders, color sheets, and color strips."¹

¹ Application Serial No. 75/615,079, filed January 4, 1999,
asserting first use anywhere and first use in commerce on June
23, 1998.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Act on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark PORTFOLIO COLLECTION for "interior and exterior paints, stains, and varnishes"² 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.

Applicant, although acknowledging that both marks incorporate the word "PORTFOLIO," goes on to assert that the word is suggestive as applied to the goods and that, therefore, the cited mark is entitled to a narrow scope of protection. Applicant also contends that the goods do not travel in the same channels of trade.

The Examining Attorney maintains that the marks are similar, and that the goods are closely related and complementary. The Examining Attorney has submitted third-party registrations to show that single entities have registered the same mark for goods of the type identified in the involved application and registration.

² Registration No. 2,290,382, issued November 2, 1999. The word "Collection" is disclaimed apart from the mark.

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).

Turning first to the marks, the test is not whether the marks PORTFOLIO and PORTFOLIO COLLECTION can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks encountered in the marketplace. See: Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, "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 a consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "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..." Id. at 751.

We find that PORTFOLIO is the dominant feature in the commercial impression created by registrant's mark. It is the first word in registrant's mark, and it therefore is more likely to be perceived and recalled by purchasers. Further, PORTFOLIO is distinctive as applied to applicant's and registrant's goods.³ To the extent that the term PORTFOLIO has a meaning relative to the respective goods, the meaning is only somewhat suggestive and, in any event, the same suggestion is conveyed by both marks. Although we have not disregarded the descriptive and disclaimed word COLLECTION in registrant's mark, we find that it has relatively little source-indicating significance and that

³ Pursuant to the Examining Attorney's request, we take judicial notice of the dictionary definition of the term "portfolio": "the materials collected in a case, especially when representative of a person's work: *a photographer's portfolio; an artist's portfolio of drawings.*" The American Heritage Dictionary of the English Language (3rd ed. 1992).

it contributes relatively little to the mark's overall commercial impression.⁴

PORTFOLIO, the dominant feature of registrant's mark, is identical to applicant's mark PORTFOLIO in terms of appearance, sound, and connotation. In comparing the marks' overall commercial impressions, we find that any dissimilarity that may result from the presence in registrant's mark of the descriptive and disclaimed word COLLECTION is greatly outweighed by the basic similarity between the marks which results from the presence in both marks of the word PORTFOLIO.

With respect to the goods, they need not be identical or competitive in nature in order to support a finding of likelihood of confusion, it being sufficient for the purpose 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 circumstances that could give rise, because of the similarities between the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same source. See: Hilson Research

⁴ In this connection, we also note that applicant's informational literature shows use of the wording "color collection" immediately after its mark PORTFOLIO.

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Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); and Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

Applicant's goods are closely related and complementary to registrant's goods. Applicant's goods, as shown by the informational literature of record, essentially are paint chips in a wide range of colors and shades. These cards are used to select colors of "architectural coatings", which would include the goods listed in the cited registration, namely paints, stains and varnishes. Applicant's goods would travel in the same trade channels (e.g., paint stores and home improvement stores) and would be purchased and used by the same classes of customers (e.g., painters, interior decorators and ordinary consumers).

In reaching our decision, we have taken into account the third-party use-based registrations submitted by the Examining Attorney. The registrations show the same marks registered by the same entity for both types of goods listed in the involved application and registration. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods

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identified therein are of a kind that may emanate from a single source. See: Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

We conclude that consumers would be likely to mistakenly believe that registrant's interior and exterior paints, stains and varnishes sold under the mark PORTFOLIO COLLECTION and applicant's color strips, color cards, color fan decks, formulation guides and designer/architect kits sold under the mark PORTFOLIO originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.