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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ferro Corporation

Serial No. 75/891,291

Kenneth A. Clark of Rankin, Hill, Porter & Clark for Ferro Corporation.

Doritt Carroll, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).¹

Before Cissel, Quinn and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Ferro Corporation has filed an application to register NIMEX as a trademark in Class 2 for goods identified as "color concentrates, namely, metal filled plastic color

¹ Examining attorney Andrea P. Hammond examined the application; Doritt Carroll briefed the appeal.

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concentrates for use in the manufacture of molded plastics."²

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, as used in connection with the identified goods, is likely to cause confusion or mistake or to deceive consumers, in view of the prior registration of the mark NYMAX for "polymeric compounds for further processing in extrusion or molding operations," in Class 1.³

When the refusal was made final, applicant appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case,

² Serial No. 75/891,291, filed January 7, 2000, asserting applicant's bona fide intention to use the mark in commerce.

³ Registration No. 2,324,355, issued February 29, 2000 to M.A. Hanna Company. The registration asserts March 8, 1999 as the date of both first use of the mark and first use of the mark in commerce.

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two key considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The examining attorney argues that NIMEX and NYMAX are highly similar because they each employ the same number of letters and set forth the same three consonants and differ only in their vowels; but even then, the consonants and vowels are set forth in the same pattern. The common pattern, the examining attorney contends, results in the two marks having a highly similar appearance. Moreover, the marks are asserted to sound virtually the same because the first vowel in each mark would be pronounced the same.

Applicant contends that the marks look and sound different. In regard to appearance, applicant has argued: "While they share the same consonants, the vowels are different, resulting in 40% of the letters of both marks being different. In a side by side comparison, the applicant's mark NIMEX is easily distinguishable from the registered mark NYMAX." (Response to Office action, p. 3) In regard to pronunciation, applicant acknowledges the phonetic similarity of the first syllable of each mark, but asserts that the phonetic dissimilarity of the respective

second syllables is sufficient basis upon which to find that there is no likelihood of confusion.

The examining attorney does not contend that the marks are similar in connotation. Applicant contends that they will be perceived as having dissimilar connotations. Specifically, applicant contends that "the second syllable of applicant's mark is MEX, which is phonetically suggestive of the term 'metallics' (ME-tal-X)" [brief p. 5], while the syllables of the mark in the cited registration -- NY and MAX -- assertedly refer to "Nylon" and "Maximum" [Response p. 3]. Applicant's assertions in regard to connotations of the marks are, largely, just that. While the assertion that MEX is suggestive of "metallics" is plausible when we note that applicant's goods are "metal filled plastic color concentrates," we see no connection between "Nylon" and registrant's identification of goods, and there is nothing in the record regarding the nature of registrant's goods.

We find the contention that the marks have dissimilar connotations debatable and with no support in the record. Even if we were to accept applicant's contention that the marks have dissimilar connotations, we still would find them similar because of their similarity in appearance and pronunciation. As the examining attorney has correctly

observed, the case law is clear that the test for similarity of marks is not a side by side comparison, and that there is no single, correct way to pronounce a mark. Prospective purchasers of the respective goods may not recall the different vowels used in the marks and may very well pronounce the marks very similarly. We agree with the examining attorney that the marks are very similar, with the similarity in appearance and pronunciation outweighing any purported difference in connotation.

Turning to the goods, the examining attorney argues two points. The first argument is that they are related because there is evidence of record which shows that these types of products tend to emanate from the same source. Applicant has not contested this point or otherwise addressed the evidence made of record by the examining attorney. We therefore take this argument as conceded. The second argument is that "the goods are complementary, i.e., they may be used together in the same manufacturing process." [Brief p. 4] This argument, too, essentially has been conceded. In its brief, applicant explains that its "goods are let down in small amounts into host molding resins to impart a metallic effect to the finished molded product" [Brief p. 6] and that "registrant's goods are host molding resins" [Brief p. 7].

Even if goods identified in an application and registration are not competitive, there may still be a likelihood of confusion, when similar marks are used in conjunction therewith, if such goods are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that would give rise to the mistaken belief that the goods emanate from or are in some way associated with the same source or sponsor. See In re Kangaroos U.S.A., 223 USPQ 1025, 1026-1027 (TTAB 1984), and cases cited therein. In the case at hand, we find the goods related for purposes of the likelihood of confusion analysis, in that they are complementary, would be marketed to the same prospective purchasers, and have been shown to be of a type that would emanate from the same source.

Applicant argues that the goods would be purchased only by sophisticated purchasers who would not mistake one product for the other. Even so, when marks very similar in appearance and pronunciation are used on or in connection with related goods, even sophisticated purchasers may be confused. See, e.g., Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). Moreover, given that the goods are complementary,

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even sophisticated consumers may view the marks as variations on a theme intended to differentiate related products having a common source or sponsorship.

Decision: The refusal of registration under Section2(d) of the Lanham Act is affirmed.