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Paper No. 9

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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 Atico International USA Inc.  
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Serial No. 76/251,522  
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Peter T. Cobrin and Clyde A. Shuman of Gibbons, Del Deo,  
Dolan, Griffinger & Vecchione for Atico International USA  
Inc.

Won T. Oh, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney).  
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Before Quinn, Hohein and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Atico International USA Inc. has filed an  
application to register the mark ALCO on the Principal  
Register for a variety of goods in multiple classes.<sup>1</sup>

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<sup>1</sup> Serial No. 76/251,522, filed May 4, 2001, based on an allegation of a  
bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d),<sup>2</sup> on the ground that applicant's mark so resembles the mark ALCO, previously registered for "retail services in connection with variety and discount stores,"<sup>3</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.<sup>4</sup>

Additionally, the Examining Attorney has issued a final requirement for amendment to the identification of goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

*Identification of Goods*

In the first Office action, the Examining Attorney issued the requirement for an amendment to the

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<sup>2</sup> The refusal pertains to all goods in the application, including those identified in Class 20, which was added in applicant's reply brief to correctly classify goods previously listed in another class.

<sup>3</sup> The refusal to register under Section 2(d) also included as a citation the mark ALCO YES in a design format, previously registered for "discount department store services" [Registration No. 1,644,718 issued May 14, 1991, to Duckwall-Alco Stores, Inc., in International Class 42]. This registration has been cancelled. In his brief, the Examining Attorney withdrew this registration as a basis for refusal.

<sup>4</sup> Registration No. 865,520 issued February 25, 1969, to Duckwall-Alco Stores, Inc., in International Class 35. This registration was renewed for a period of twenty years from February 25, 1989.

identification of goods, setting forth the deficiencies and required amendments. Applicant responded by adopting all of the amendments suggested by the Examining Attorney.

In the final refusal, the Examining Attorney stated that the identification of goods remained indefinite because "memo boards" should be moved from International Class 21 to International Class 16.<sup>5</sup> In its main brief, applicant made this required change.

The Examining Attorney, in his brief, without acknowledging applicant's amendment, set forth further alleged deficiencies and required changes, not previously stated, to the identification of goods and classification. In its reply brief, applicant adopted, in its entirety, the identification of goods suggested in the Examining Attorney's brief, including paying the additional fee necessary for the additional class.

We are disturbed by the piecemeal manner in which the Examining Attorney has addressed the inadequacies in the identification of goods. At each stage of

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<sup>5</sup> Because proper classification of goods is a matter of USPTO administration, the Examining Attorney should have simply notified applicant that the improperly classified goods were being moved to the proper class. Both classes were already part of the application and no additional fees were necessary. See *Trademark Manual of Examining Procedure*, Sections 707.02 and 1401.03(b).

examination, applicant has tried to comply with the Examining Attorney's requirements for amendment to the identification of goods, only to be met with new requirements. Because applicant has submitted an amendment that adopts the exact identification of goods suggested by the Examining Attorney in his brief, we find that this amendment renders moot the refusal to register on the ground that the identification of goods is indefinite.<sup>6</sup>

Applicant's goods are, thus, identified as follows:

Scissors and utility knives, in International Class 8;

Pocket calculators and protractors, graduated rulers, in International Class 9;

Photograph albums, appointment pads, stationery boxes, crayons, desk caddies, desk organizers, drawing compasses, erasers, memo pads, pens, rubber stamps, score pads, paper staplers, telephone number and address books, art sets comprised of color pens, color pencils, crayons, oil pastels, watercolors pencils, palette, erasers, sharpeners, rulers, cutter, stapler, tacks, sponge, carrying case with handle, white water color, markers, brushes, scissors, glue and paper notepad, binders, book covers, chalk, clip boards, colored pencils, composition books, copy paper, correcting fluid for type, correcting tape for type, day planners, dry erase markers, envelopes, paper expandable files, filler paper, glue and glue sticks for

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<sup>6</sup> Should applicant ultimately prevail in this appeal, prior to publication for opposition, this application should be forwarded to the appropriate USPTO office for entry of the amended identification of goods.

stationery or household use, highlighter markers, hole punches, index cards, laser paper, markers, math sets consisting primarily of pencil sharpeners, eraser, six-inch ruler, protractor, triangles, pencil, compass, divider, and mechanical pencil, mechanical pencils, multipurpose paper, notebooks, paint brushes, painting sets, vinyl and metal paper clips, paper shredders, pencil cases, pencil grips, pencil pouches, pencil sharpeners, pencils, permanent markers, portfolio folders, push pins, rubber bands, drawing rulers, social stationery, staple removers, stencils, stick-on notes, stickers, adhesive tape for stationery for household use, writing pads, finger paints, in International Class 16;

Tote bags and backpacks, in International Class 18;

Locker accessories, namely, personal organizers, non-metal locks, picture frames, mirrors, in International Class 20;

Locker accessories, namely, lunch boxes, in International Class 21;

Artist aprons, in International Class 25; and

Children's play mats for use in connection with playing, exercise and sleeping, in International Class 28.

#### *Likelihood of Confusion*

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 considering the evidence of record on these factors, we

keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney contends that confusion is likely because the marks are identical and the goods and services are related to the extent that applicant's goods may be sold in registrant's retail variety and discount stores. In support of this contention, the Examining Attorney submitted copies of third-party registrations for marks identifying both retail store services and various goods including many of those identified in the application.

Applicant contends there is no likelihood of confusion, arguing that four third-party registrations, which have been subsequently expressly abandoned, for the mark ALCO for goods encompassed by applicant's identified goods, did not prevent the registration of the cited mark;<sup>7</sup> and that there is no evidence that any of the goods

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<sup>7</sup> Each case must be decided on its facts. Therefore, we can draw no conclusions from applicant's allegations regarding the state of the register or examination in another case.

sold at registrant's retail stores are identified by registrant's ALCO retail store mark. In support of this latter point, applicant submitted with its brief an excerpt allegedly from registrant's Internet web site [www.duckwall.com, May 31, 2002] to show that the goods advertised by registrant therein were identified by manufacturers' brand names.<sup>8</sup>

Considering, first, the marks, it is clear, and applicant does not dispute, that applicant's mark is identical to the mark in the cited registration. In this regard, the Board has stated, "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Considering the goods and services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the services recited in the registration, rather than what

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<sup>8</sup> The evidentiary record in an application must be complete prior to the filing of the notice of appeal. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). However, because the

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the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

While applicant has shown us evidence of registrant's advertisements of other manufacturers' branded products on its Internet web site, we are bound

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Examining Attorney did not object to this evidence and addressed it in his brief, we have considered this evidence in reaching our decision.

by the broad recitation of services in the cited registration. There is nothing in the language of this recitation that precludes registrant from using its service mark also on goods available through its retail services. Further, the question is not whether registrant can or does use its mark in such a manner; rather, the question is whether there is a sufficient relationship between applicant's goods and registrant's services that consumers exposed to applicant's mark on its goods would believe those goods emanate from registrant or a related source. In this regard, applicant does not seem to dispute that its products may be sold at retail variety and discount stores; and the Examining Attorney's evidence of third-party registrations with goods and services encompassing those in this case suggests that consumers are accustomed to seeing such goods and services emanate from the same source or related sources.

In view of the fact that applicant's mark and registrant's mark are identical, we find that the goods and services involved herein are sufficiently related that the contemporaneous use of ALCO by applicant and registrant on the goods and services involved in this

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case is likely to cause confusion as to the source or sponsorship of such goods and services.

*Decision:* The refusal under Section 2(d) of the Act is affirmed.