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Paper No. 42
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Engineering Plastics, Inc.

v.

Extrutech Plastics, Inc.

Cancellation No. 28,489

Gerry A. Blodgett of Blodgett & Blodgett, P.C. for
Engineering Plastics, Inc.

Fred S. Lockwood of Cook, Alex, McFarron, Manzo, Cummings
& Mehler, Ltd. for Extrutech Plastics, Inc.

Before Seeherman, Quinn and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Respondent is the owner of the registered mark
depicted below



which is registered on the Principal Register for goods and services identified in the registration as "extruded plastic in the forms of bars, blocks, pellets, rods, sheets, tubes and other shapes as needed for use in manufacturing," in Class 7, and "custom manufacture of plastic extrusions, including designing and tooling according to customer specifications," in Class 40.¹

On January 20, 1999, petitioner petitioned to cancel respondent's registration, alleging as grounds therefor that petitioner is the prior user of the mark depicted below



¹ Registration No. 1,967,816, issued April 16, 1996. Section 8 affidavit filed and accepted. The registration issued from an application filed on August 25, 1994, in which, as to both classes, January 25, 1992 was alleged as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

Cancellation No. 28,489

"in connection with the manufacture of plastic products, and more specifically, with the custom manufacture of compression molding and insert molding products in International Class 40; and custom design of compression and insert molding products, in International Class 42" (Petition for Cancellation, ¶ 1), and that respondent's mark, as applied to the goods and services identified in respondent's registration, so resembles petitioner's mark as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respondent filed an answer by which it denied the salient allegations of the petition for cancellation.

The evidence of record consists of excerpts from printed publications made of record by petitioner under notice of reliance, i.e., excerpts from each annual edition of the Thomas Register for the years 1981 through 1999, inclusive, which show petitioner's use of its pleaded mark in connection with its listing in the "Company Profiles" directory section of the publication, and/or in connection with its advertisements appearing in the "Products and Services" section of the publication, and/or in connection with reproductions of its catalog in

the "Catalog File" section of the publication.² The record also includes respondent's notice of reliance on one of its interrogatories and petitioner's answer

² Respondent has moved to strike certain of petitioner's notice of reliance evidence, i.e., Exhibits V, W and portions of Exhibit X, which comprise excerpts from the 1997 (Exhibit V), 1998 (Exhibit W) and 1999 (Exhibit X) editions of the Thomas Register. Respondent contends that these excerpts do not comply with the rules for submitting printed publications under notice of reliance. Petitioner has contested the motion, and the Board, in its September 18, 2002 order, deferred decision on the motion until final hearing. After careful consideration of these materials and the parties' arguments, we rule as follows. Respondent's motion to strike is granted as to Exhibit V (1997 Thomas Register) and as to the first eleven pages of Exhibit W (1998 Thomas Register). These documents are not "printed publications" which may be submitted under notice of reliance, because they obviously are merely printer's proofs or reprints of advertisements, rather than excerpts from the actual printed publications. See, e.g., *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976). The remainder of respondent's motion to strike is denied, i.e., as to the rest of Exhibit W and as to Exhibit X. First, the obvious clerical error which resulted in certain pages from the 1999 Thomas Register being placed in Exhibit W (which deals with the 1998 Thomas Register) rather than in Exhibit X (which deals with the 1999 Thomas Register) does not warrant striking those pages; we deem those pages to be part of Exhibit X, not Exhibit W. Second, we decline to strike any of these pages simply because the year or edition of the Thomas Register in which it appeared is not apparent on the face of the particular page. Respondent cites no authority for such requirement. There is nothing which calls into question the truth of petitioner's assertions as to the particular Thomas Register edition in which each of these respective pages appeared; respondent has failed to support its motion to strike by showing that any of these pages in fact did not appear in the respective Thomas Register editions identified by petitioner. In summary, respondent's motion to strike certain of petitioner's Thomas Register evidence is granted in part and denied in part, as discussed above. We note as well that the Board, in its September 18, 2002 order, granted respondent's co-pending motion to strike the Morse affidavit submitted by petitioner under notice of reliance. We have given this affidavit no consideration.

thereto, in which petitioner admitted that it is not aware of any instances of actual confusion.

Petitioner and respondent both filed main trial briefs, and respondent filed a supplemental trial brief.³ No oral hearing was requested. We deny the petition to cancel.

Before we reach the merits of petitioner's claim, we must discuss certain arguments and issues raised by respondent in its trial brief and in its supplemental trial brief. In its trial brief, respondent contends for the first time that petitioner is not entitled to prevail in this case because it has abandoned its mark. Specifically, respondent argues that there is no evidence in the record of any use by petitioner of its mark in the three years preceding the close of petitioner's testimony period in March 2002, and that such non-use constitutes a

³ In accordance with the then-operative trial and briefing schedule, petitioner filed its trial brief on the case on August 20, 2002 and respondent filed its trial brief on September 16, 2002. Still pending when these briefs were filed were respondent's April 2002 contested motions to strike certain of petitioner's trial evidence. On September 18, 2002, and presumably before the parties' trial briefs had been associated with the file, the Board issued an order with respect to respondent's motions to strike. Citing its delay in deciding the motions to strike, the Board reset the time for filing final briefs on the case, with petitioner's brief to be due on November 15, 2002 and respondent's brief to be due on December 15, 2002. Petitioner did not file another brief, but respondent filed a "supplemental" trial brief on December 12, 2002.

prima facie case of abandonment under Trademark Act

Section 45, 15 U.S.C. §1127. We reject this argument.

Respondent's abandonment allegation "is, in effect, in the stance of a defense to" petitioner's assertion of Section 2(d) priority. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665-66 (Fed. Cir. 1994). Such defense was neither pleaded by respondent nor tried by the parties, and respondent may not raise the defense for the first time in its trial brief.⁴ Absent proper assertion by respondent of an abandonment defense, petitioner may establish its priority under Section 2(d) simply by proving that it is

⁴ Even if respondent had properly raised the abandonment defense, we would find that respondent has failed to carry its burden of proving such abandonment. The record includes evidence of petitioner's use of its mark in the 1999 edition of the Thomas Register. Respondent argues that we should deem such 1999 use to have occurred on January 1, 1999 (and thus more than three years prior to the close of petitioner's testimony period on March 19, 2002), because the actual date of publication of the 1999 edition of the Thomas Register is not apparent from the record. Respondent cites no legal authority for this proposition, and we see no factual basis for it either. On its face, the Thomas Register appears to be an annually-published reference work. Even if we assume that the 1999 edition was published on January 1, 1999 (and there is no basis in the record for such an assumption), there is no reason to assume that it was not in circulation and available for consultation by potential purchasers of petitioner's goods after March 19, 1999 and throughout 1999. Accordingly, even if the applicable three-year period for determining *prima facie* abandonment is deemed to have ended at the close of petitioner's testimony period on March 22, 2002 (rather than, say, on January 20, 1999 when the petition to cancel was filed), the record does not support a

the prior user; it need not also prove that its use subsequent to respondent's first use has been continuous. See *id.* As discussed *infra*, we find that petitioner's evidence suffices to establish that petitioner is the prior user.

Second, we find that petitioner's Thomas Register evidence shows use of petitioner's mark in connection with the custom manufacturing and custom design services pleaded in the petition for cancellation. Respondent's argument to the contrary, raised for the first time in its supplemental trial brief, is not persuasive.

Turning now to the merits of petitioner's claim, we find that petitioner has standing to bring this cancellation proceeding. Petitioner has shown that it has a commercial interest in its pleaded mark, and its likelihood of confusion claim (although ultimately unproven; see *infra*) is not wholly without merit. This showing suffices to establish petitioner's standing. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).⁵

finding of non-use for three consecutive years, and respondent's abandonment defense fails.

⁵ Petitioner alleged in the petition to cancel that it has filed an application to register its pleaded mark and that respondent's registration has been cited as a bar under Section 2(d), but petitioner failed to present evidence supporting that

We next find that petitioner has established its Section 2(d) priority. The evidence of record shows that petitioner was using its pleaded mark in advertisements for its pleaded services in the 1981 through 1993 editions of the Thomas Register. These uses of petitioner's mark predate the earliest date upon which respondent can rely for priority purposes in this case, i.e., the August 25, 1994 filing date of the application which matured into respondent's involved registration,⁶ and they therefore suffice to establish petitioner's priority.

We find, however, that petitioner has failed to carry its burden of proving likelihood of confusion. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *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

allegation at trial. Petitioner attached a copy of the final Office action to its trial brief, but such evidence is improperly submitted and untimely.

⁶ Respondent submitted no evidence as to its date of first use of its mark, so its application filing date is the earliest date upon which it can rely for priority purposes. See Trademark Rule 2.122(b)(2), 37 C.F.R. §2.122(b)(2); *Philip Morris Inc. v. He-Man Products, Inc.*, 157 USPQ 200 (TTAB 1968).

keep in mind that "[t]he fundamental inquiry mandated by §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).

We turn first to the issues of the similarity or dissimilarity of the respective goods and/or services, and of the similarity or dissimilarity in trade channels and classes of purchasers. Both parties deal in plastics products and related services, but we cannot conclude, on this sparse record, that purchasers are likely to assume that a source relationship exists between such products and services which are based on an extrusion process (like respondent's) and those based on compression and insert molding processes (like petitioner's). Nor can we conclude, on this record, that petitioner's and respondent's respective goods and/or services are marketed in the same trade channels or to the same classes of purchasers. Petitioner, which bears the burden of proof on these issues, has presented no argument with respect thereto, nor has petitioner pointed to any evidence in the record which establishes, or even pertains to, the existence of any relationship or

similarity between the parties' respective goods and services, purchasers and trade channels.⁷

In short, we cannot conclude on this sparse record that the parties' respective goods and/or services, purchasers and trade channels are sufficiently related or similar that confusion is likely to result from the parties' use of their respective marks.

Moreover, to the extent that both parties are providing custom-made products and custom manufacturing and design services, we reasonably assume that the purchasers of the respective goods and services are likely to exercise a certain amount of care in purchasing the goods and services, a factor which further militate against a finding of likelihood of confusion.

As for the marks, we find that they are similar in terms of appearance and sound to the extent that both marks include the letters EPI. However, each of the marks is fairly highly stylized, and the differences in stylization help to distinguish the marks visually. Considering the marks in their entirety, we find that they are not sufficiently similar to support a finding of

⁷ Indeed, petitioner makes no argument at all with respect to the *du Pont* likelihood of confusion factors; it simply contends that if the Trademark Examining Attorney's rejection of petitioner's application under Section 2(d) is correct (see

likelihood of confusion, at least not without a stronger showing as to the existence of a relationship between the goods and services on or in connection with which the marks are used.

Finally, the evidence of record includes petitioner's admission that it is not aware of any instances of actual confusion. That fact weighs in respondent's favor (albeit only slightly, given the absence of evidence showing that there has been a meaningful opportunity for actual confusion to have occurred; see *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992)).

Having considered the evidence in this record as it pertains to the relevant *du Pont* evidentiary factors, we find that petitioner has failed to prove that a likelihood of confusion exists, and that petitioner therefore is not entitled to prevail on its pleaded Section 2(d) ground for cancellation.

Decision: The petition to cancel is denied.

supra at footnote 5), petitioner should prevail in this case because it has priority.