

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: 10/9/03
Paper No. 20
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CMB Industries, Inc.

Serial No. 75693024

Kenneth H. Oh of Baker & Hostetler LLP for CMB Industries,
Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Seeherman, Chapman and Rogers, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

CMB Industries, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register
WOLVERINE as a trademark for a "butterfly valve for use in
controlling the flow of water in water distribution
systems, in water filtration systems, and in sewage

Ser No. 75693024

treatment systems."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the registered mark WOLVERINE for "water softeners, water conditioners, water filters, water purification units and water odor removers for potable water used in domestic, commercial and industrial applications"² that, if used on or in connection with applicant's identified goods, it would be likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed. Applicant did not request an oral hearing.

We affirm the refusal of registration.

As a preliminary comment, we note that the Examining Attorney to whom this application was originally assigned conducted a search of the NEXIS database for stories in which the words "butterfly," "valve" and "water" appeared in close proximity. The search retrieved 77 stories, and the Examining Attorney submitted all 77, without regard to the fact that several were duplicates, and presumably without assessing their probative value, since many simply indicated that butterfly valves are used in connection with

¹ Application Serial No. 75693024, filed April 28, 1999, based on applicant's asserted bona fide intention to use the mark in commerce.

² Registration No. 2,321,745, issued February 22, 2000.

water treatment plants or are used to control the flow of water. Evidence to this effect is not necessary, since those facts are clear from applicant's own identification of goods. We reiterate our long-standing policy that Examining Attorneys need not submit, and in fact are discouraged from submitting, all articles retrieved by a NEXIS search. It is only necessary that a representative sample be submitted, along with a statement that the sample is representative. In re Vaughan Furniture Co. Inc., 24 USPQ2d 1068, n. 2 (TTAB 1992).

This brings us to the issue which is the subject the appeal, that of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in 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).

There is no dispute that the marks involved here are identical. As the Examining Attorney has pointed out, when the marks of the parties are identical, a lesser degree of relatedness of the goods is necessary to support a finding

of likelihood of confusion. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). See also, *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source). This is particularly true in the instant case, in which WOLVERINE is an arbitrary mark, and therefore the cited registration is entitled to a broad scope of protection. Thus, in this case, the fact that the marks are identical "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to the goods, it is well established that it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *In re Shell Oil Co.*,

supra, and In re International Telephone & Telegraph Corp.,
197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's butterfly valves for use in water distribution systems and in water filtration systems may be used in the same commercial and industrial installations in which the registrant's water filters and water purification units may be used. The related nature of the goods, and specifically the relatedness of applicant's butterfly valves used in water filtration systems and registrant's water filters and water purification units used in commercial and industrial applications, is obvious. These are used as part of a single system, although the individual items obviously perform different functions within the system. However, as noted above, it is not necessary that the goods be identical in order to support a finding of likelihood of confusion. Thus, applicant's point that applicant's goods and those identified in the cited registration are not "likely to be confused" is of no avail. The question is not whether a prospective purchaser or user of the goods might, for example, select a butterfly valve when intending to obtain a water filter or water purification unit, but whether confusion is likely as to the source of the goods.

The Examining Attorney has submitted a number of third-party registrations which show that entities have registered a single mark for, inter alia, water treatment and purification equipment, namely, water softener units, fleck control valves, filter housing, replacement cartridges;³ water purification or treatment systems comprising water purification filters and desalination plants, and accessories and components sold therewith, namely, pumps, valves, controls;⁴ water purification systems for residential, commercial and industrial use, namely water filtration systems comprising water softeners, filter housings, carbon post filters, check valves, ball valves, auto shut-off valves;⁵ cartridge water filtration systems for water purification comprising cartridge housings, filter elements, ball valves for industrial use.⁶

Applicant correctly points out that none of the valves identified in the third-party registration is specifically designated as a butterfly valve. However, the registrations do show that valves are an integral component

³ Registration No. 2,164,983.

⁴ Registration No. 1,720,082. Although this registration originally issued pursuant to the provisions of Section 44, subsequently a Section 8 affidavit and a renewal application were filed, thus showing that the mark has been used in commerce on the goods.

⁵ Registration No. 1,969,574.

⁶ Registration No. 1,976,212.

of industrial water filtration and purification systems that also include filters, and that both items can be sold by the same entity under the same mark. As a result, the consumers for the butterfly valves identified in applicant's identification and the filters and water purification units identified in the cited registration are likely to assume, upon seeing the identical and arbitrary mark WOLVERINE on both types of products, that they emanate from or are sponsored by the same source.

Applicant has tried to minimize the relatedness of the goods by asserting that "the issue of whether goods or services are related does not depend on whether a term can be found that describes both the goods or whether both can be classified under the same category." Reply brief, p. 1. However, we do not base our conclusion that the goods are related merely on the fact that "they are both used to control water." Rather, as indicated above, these goods are used as part of the same system, and similar goods are sold by single entities under a single mark.

We also recognize that the common purchasers of applicant's and the registrant's goods would be sophisticated and discriminating. However, given that valves and filters are sold as part of or for use in water purification systems, and given that the goods are sold

Ser No. 75693024

under the arbitrary and identical mark WOLVERINE, we find that even discriminating purchasers are likely to be confused.

Finally, to the extent that there is any doubt as to whether confusion is likely, such doubt must be resolved against the newcomer and in favor of the prior user or registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.