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TJQ

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hughes Supply IP, Inc.<sup>1</sup>

Serial No. 75/907,894

Terry M. Sanks and Robert L. Wolter of Beusse, Brownlee, Bowdoin & Wolter for applicant.

Matthew Swyers, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Hughes Supply IP, Inc. to register the mark OH-SO-SOFT for "water softening units; and accessory parts therefor, namely filters."<sup>2</sup>

<sup>1</sup> The application originally was filed by Hughes Supply Management Services, Inc. An assignment to the above-identified applicant was recorded in the records of the Assignment Branch of the Office on March 11, 2002 at reel 2472, frame 0338.

<sup>2</sup> Application Serial No. 75/907,894, filed February 2, 2000, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth dates of first use anywhere and first use in commerce as February 2000.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark O-SO PURE ("PURE" disclaimed) for "water conditioning units"<sup>3</sup> 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 contends that the marks are different in sound, appearance and meaning. While applicant concedes that the beginnings of the marks are phonetically equivalent, applicant points to the dissimilarities between the ends of the marks. As to the goods, although applicant "does not contest that there is some common level of generality between the goods since both goods are identified for use with units that treat water in some fashion" (brief, p. 8), applicant goes on to argue that there are differences between applicant's and registrant's goods. Further, according to applicant, its goods are sold to sophisticated purchasers. In support of its position, applicant submitted dictionary definitions of the words

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<sup>3</sup> Registration No. 1,996,751, issued August 27, 1996; combined Sections 8 and 15 affidavit filed.

"soft" and "pure," and the declaration of one of applicant's managers relating to the absence of any known instances of actual confusion.

The Examining Attorney maintains that "both the applicant and the registrant's marks utilize the phonetically equivalent, dominant, arbitrary prefixes OH-SO and O-SO in conjunction with the descriptive or suggestive terms SOFT and PURE" (brief, p. 5). The Examining Attorney also asserts that the goods are related, and that the goods must be compared as they are specifically identified in the identifications of goods. In support of the refusal, the Examining Attorney introduced a dictionary definition of "soft water," and third-party registrations which show that parties have registered a single mark for both types of goods involved herein.

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).

With respect to the goods, it should be noted that it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

We find that applicant's water softening units and registrant's water conditioning units are, at a minimum, closely related. Both are used to treat water, albeit, perhaps, in somewhat different manners. Further, registrant's goods are broadly identified, and the terminology "water conditioning units" is arguably broad enough to cover goods of the type sold by applicant.

In connection with comparing the goods, we have taken note that the Examining Attorney has introduced into the record third-party registrations which show that parties have registered a single mark for both water conditioning units and water softening units. Third-party registrations which individually cover both types of goods and which are

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based on use in commerce serve to suggest that the listed goods are of a type which may emanate from a single source. See: In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that the channels of trade for its goods and registrant's goods are different, and specifically that applicant's goods are sold to sophisticated purchasers (e.g., water well drillers and plumbing contractors). According to applicant, its goods range in price from thirty dollars for a filter to several thousand dollars for a complete system.

It is not clear to us that a filter which costs thirty dollars would be purchased with a great deal of care. More importantly, the question of likelihood of confusion must be determined on the basis of the identification of goods set forth in the subject application and the cited registration. In re Elbaum, 211 USPQ 639 (TTAB 1981). The identifications of goods do not include any limitations, and therefore we must deem the goods to move through all normal channels of trade, and to all relevant purchasers. These channels would include such places as do-it-yourself hardware stores, and consumers would include the public at large. Thus, we are not persuaded by applicant's assertion that its customers are sophisticated.

We next turn to compare the marks OH-SO-SOFT and O-SO PURE. The marks are similarly constructed, beginning with the phonetically equivalent, arbitrary OH-SO and O-SO portions, followed by the descriptive terms SOFT and PURE. The marks, when considered in their entireties, are similar in sound and appearance. Although there are specific differences between SOFT and PURE, when these words are used in the context of water conditioning/softening units, they have a similar connotation, and the overall commercial impressions of the marks are the same. Thus, it is reasonable to assume that consumers familiar with the mark O-SO PURE will view the mark OH-SO-SOFT as a variant thereof, and believe that registrant has expanded its brand to a closely related product. In finding that the marks are similar, we have kept in mind the fallibility of human memory over time and the fact that consumers usually retain a general rather than a specific impression of trademarks encountered in the marketplace.

Finally, we have considered the declaration of Richard Davis, one of applicant's area managers. Mr. Davis states that since February 2000, applicant has sold about 1,500 units throughout the Midwest and eastern United States, and that he is not aware of any instances of actual confusion between the involved marks.

Although the absence of actual confusion over a long period of time is a factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by applicant of its mark in the same markets as those served by registrant under its mark. See: *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See: *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed Cir. 2000).

In the present case, we do not find Mr. Davis' declaration to be persuasive that confusion is not likely. It is possible that confusion has not occurred because of applicant's fairly limited sales over a relatively short period of time. Moreover, we have not had an opportunity to hear from registrant in this ex parte proceeding as to what its experience has been regarding actual confusion.

We conclude that purchasers familiar with registrant's water conditioning units sold under registrant's mark O-SO PURE would be likely to believe, upon encountering applicant's mark OH-SO-SOFT for water softening units and filters therefor, that the goods originated with or are somehow associated with or sponsored by the same entity.

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Decision: The refusal to register is affirmed.