

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

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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 *Optische Werke G. Rodenstock*

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Serial No. 76/093,266

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*Alan E. Schiavelli* of Antonelli, Terry, Stout & Kraus, LLP  
for *Optische Werke G. Rodenstock*.

*Brett M. Tolpin*, Trademark Examining Attorney, Law Office  
107 (*Thomas Lamone*, Managing Attorney).

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Before *Simms*, *Hanak* and *Hairston*, Administrative Trademark  
Judges.

Opinion by *Hairston*, Administrative Trademark Judge:

*Optische Werke G. Rodenstock* has appealed from the  
final refusal of the Trademark Examining Attorney to  
register the mark SOLITAIRE for "scratch resistant and  
anti-reflective coatings for eyeglasses sold to labs and

opticians."<sup>1</sup> Registration has been finally refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with the identified goods, so resembles the mark SOLITAIRELENS, which is registered for "contact lenses,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant and the Examining Attorney have filed appeal briefs.<sup>3</sup> No oral hearing was requested. We affirm the refusal.<sup>4</sup>

It is the Examining Attorney's position that the marks are highly similar and that the goods are closely related. The Examining Attorney argues that SOLITAIRE is the dominant part of registrant's mark because LENS is a generic term for registrant's goods; and that applicant's mark simply incorporates the dominant feature of registrant's mark and adds nothing to it. Further, the

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<sup>1</sup> Application Serial No. 76/093,266, filed July 21, 2000. The application was filed pursuant to Section 44(e) of the Trademark Act, based upon German Registration No. 205886 issued March 3, 1994, and with an allegation of a bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,776,341 issued June 15, 1993; affidavits under Section 8 and 15 accepted and acknowledged, respectively.

<sup>3</sup> The current Examining Attorney was not the original Examining Attorney in this case.

<sup>4</sup> We note that applicant previously sought to register the mark SOLITAIRELENS for "coatings for spectacle lens." (Application Serial No. 74/506,610). Registration of this application was refused in view of the same cited registration. The Board, in an opinion issued September 23, 1997, affirmed the refusal to register. The prior decision is not citable as precedent.

Examining Attorney maintains that applicant's and registrant's goods are related and would travel in the same channels of trade to the same purchasers, namely labs and opticians. In support of the refusal, the Examining Attorney submitted copies of third-party registrations which show that wholesale distributors of optical products and optical labs market both coatings for eyeglasses and contact lenses.

Applicant, in urging reversal of the refusal to register, argues that when the marks are considered in their entirety, they create different commercial impressions; that the goods are very different in nature; and that its goods will be sold to sophisticated purchasers, namely labs and opticians.

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. 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, 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).

Considering, first, the marks, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, SOLITAIRE is the dominant portion of registrant's mark because the term LENS is at least highly descriptive, if not generic, for contact lenses. The fact that SOLITAIRE and LENS are merged into a single term does not detract from the dominance of the word SOLITAIRE in registrant's mark. Applicant's mark is identical to the dominant portion of registrant's mark and the addition of LENS to registrant's mark does not distinguish the parties' marks. In finding that the marks are highly similar, we have considered that the record is devoid of any evidence of third-party uses and/or registrations of SOLITAIRE marks for goods similar to the types of goods involved in this appeal.

Turning next to the goods, the issue to be determined here is not whether the goods are likely to be confused but rather whether there is a likelihood that the relevant purchasers will be misled into the belief that they emanate from the same source. Thus, goods need not be identical or even competitive in nature in order to support a finding of

likelihood of confusion. It is enough that they 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. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein. In the present case, we find that applicant's coatings for eyeglasses are closely related to registrant's contact lenses. Both contact lenses and coatings for eyeglasses are optical products. Although applicant has restricted the purchasers of its coatings for eyeglasses to labs and opticians, the cited registration has no limitation as to purchasers. Thus, we must presume that registrant's goods are sold to all the normal purchasers for such goods, including labs and opticians. See Canadian Imperial Bank v. Wells Fargo, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In short, the parties' goods may be marketed to some of the same classes of purchasers.

We recognize that opticians and purchasing personnel for labs may be sophisticated. However, "even careful purchasers are not immune from source confusion." In re

Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"]. Here, purchasers may believe that there is a SOLITAIRE line of optical products of which SOLITAIRELENS contact lens is one product.

Finally, to the extent that there may be any doubt on the issue of likelihood of confusion, we must resolve such doubt in favor of the registrant and prior user. See In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

**Decision:** The refusal to register is affirmed.