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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pentel of America, Ltd.

Serial No. 76/234,607

Bruce L. Adams of Adams & Wilks for Pentel of America, Ltd.

Jeffrey S. Molinoff, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Cissel and Holtzman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 3, 2001, applicant filed the above-identified application seeking registration of the mark SUN BURST on the Principal Register for "automatic pencils," in Class 16. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with these goods.

The original Examining Attorney refused registration under Section 2(d) the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark shown below,

SUNBURST

which is registered¹ for "stationery-namely, writing paper, tablets, and envelopes," in Class 16, that if applicant were to use the mark it seeks to register in connection with automatic pencils, confusion would be likely.

Applicant responded to the refusal to register by arguing that the goods identified in the cited registration are not so closely related to automatic pencils as to be likely to cause purchaser confusion. Applicant argued that the fact that the goods are in the same broad category and are available in the same retail outlets does not mean that purchasers are likely to be confused as to the source or sponsorship of them. Notwithstanding these contentions, applicant argued that the Examining Attorney had not met her burden of establishing that applicant's goods are

¹ Reg. No. 1, 004,791, issued to the Sangamon Co. on February 18, 1975; subsequently assigned to Champion International Corp.; affidavits under Sections 8 and 15 of the Act accepted and acknowledged; renewed.

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related to the goods listed in the cited registration, in that she had introduced no evidence that writing paper, tablets and envelopes are, in fact, sold in the same retail

outlets as automatic pencils. In any event, argued applicant, even if there were some overlap in the channels of trade in which these products move, that would be an insufficient basis for concluding based on the marks that they are produced by the same manufacturer.

The Examining Attorney was not persuaded by applicant's arguments, and in her second Office Action, she made the refusal to register final. Submitted with the final refusal were copies of a number of third-party registrations which list both pencils and stationery items such as paper and envelopes in their identification-of-goods clauses.

Also submitted with the final refusal to register were a number of excerpts from published articles, all retrieved from the Lexus-Nexis electronic database, wherein pencils and various items of stationery such as paper and envelopes are discussed together, indicating that they are used and/or purchased together. Typical examples include the following: "School supplies-pens, pencils, crayons... coloring books and writing paper-always are popular." Dayton Daily News, November 22, 2001; "Students also need pens, pencils, crayons, writing paper and other school supplies..." Fort Wayne News Sentinel, November 12, 2001; "The Welcome Kit offers \$75 worth of the most widely used

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office supplies for \$14,99: pencils, pens, folders, staples, envelopes, highlighters and correction fluid." The Orange County Register, September 29, 1997; "In the school supplies category, popular items include soft-side binders, specialty markers and crayons, pencils/pens, backpacks and stationery products." The Providence Journal-Bulletin, September 2, 1997; and "Dr. Grip is also available in a new 0.5 mm mechanical pencil for folks who like to pack a little lead. You'll find Dr. Grip where stationery and office supplies are sold, \$5.99." The Boston Globe, November 27, 1997. Additionally, the Examining Attorney provided copies of the results of an Internet search which show that pencils and stationery products such as paper and envelopes are available from the same commercial sources.

Applicant filed a Notice of Appeal, along with another response arguing against the refusal to register. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant's response. Finding that applicant had not presented any new facts or reasons compelling withdrawal of the refusal to register, the above-indicated Examining Attorney, newly assigned to this case, denied applicant's request and returned the

application to the Board for resumption of action on the appeal.

Applicant filed its appeal brief, the Examining Attorney filed his responsive brief and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the written record and arguments in light of the relevant legal precedents, we hold that the record supports the refusal to register.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. If the marks in question are identical, or nearly so, the relationship between the goods of the applicant and the goods of the registrant does not need to be as close in order to support a finding of likelihood of confusion as would be the case if significant differences between the marks existed. *Armcor, Inc. v. Armcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

In the case at hand, the marks are virtually the same. Although the registered mark presents the word SUNBURST in slightly stylized lettering, whereas the mark applicant seeks to register is a typed presentation of the term with a space in between SUN and BURST, these two marks look alike, they are pronounced alike and their connotations are the same. Each creates essentially the same commercial impression in connection with the products specified in the application and the cited registration.

Our attention therefore must be directed to the issue of whether the products set forth in the application are commercially related to those identified in the cited registration in such a way that the use of these very similar marks on both would likely lead to confusion. In this regard, we note that the goods do not need to be identical or even directly competitive in order to find confusion likely. They need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a single source. In re Martin's Famous Pastry Shoppe, Inc., 478 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The Examining Attorney has met his burden of establishing that automatic pencils are commercially related to writing paper, tablets and envelopes in such a way that the use of these very similar marks on all of them would be understood as an indication that they all emanate from a single source. The excerpted published articles show that these products all fall within the general category of office and school supplies which are complementary, i.e., they are used together by the same individuals in performing any number of tasks. Applicant does not appear to dispute this fact, or that they move through the same channels of trade to the same classes of purchasers.

The third-party use-based registrations listing both pencils and various stationery items, including paper and envelopes, although not evidence that the marks shown therein are in commercial use or that the public is familiar with them, nevertheless have probative value to the extent that they serve to suggest that listed goods are of types which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In Re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). The Internet website evidence submitted by the Examining

Attorney confirms that a number of businesses sell both pencils and these types of stationery items.

These facts lead to the conclusion that confusion is likely because the marks are almost identical and consumers have a basis upon which to conclude that the use of similar marks on them would be an indication that they emanate from the same source.

Applicant disagrees, however, contending "[t]hat paper manufacturers are not automatic pencil manufacturers is a fact of which official notice may readily be taken."

(brief p. 7) To the contrary, this assertion is not a fact of which the Board may take "official" or judicial notice.

Moreover, whether or not these goods are manufactured by the same companies is not determinative of whether confusion would be likely if applicant were to use the mark it seeks to register in connection with automatic pencils. Simply put, this record, in particular the Internet evidence and the third-party registrations listing both stationery items and pencils, establishes that these products may be purchased together from the same businesses under the same trademarks. Applicant has provided no factual basis upon which we could adopt its assertion that "[c]onsumers are fully aware that manufacturers of writing instruments, such as appellant Pentel, do not also

manufacture stationery, and that manufacturers of stationery, such as International Paper, do not manufacture automatic pencils."

We note that the Examining Attorney has provided no evidence upon which we could adopt the conclusion he argues in his brief, i.e., that applicant, primarily a manufacturer of writing instruments, itself owns a federal trademark registration wherein the goods are identified as writing paper. In view of the previously discussed evidence he did make of record, however, he did not need to prove that applicant in fact sells both pencils and writing paper.

We have no doubt that confusion would be likely if applicant were to use the mark it seeks to register on automatic pencils, but even if we did, any such doubt would necessarily be resolved in favor of the owner of the cited registration, and against applicant, who as the second comer, has a duty to select a mark which is not likely to cause confusion with a mark already in use in the marketplace for related goods. In re Hyper Shoppes, (Ohio), Inc., 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.