

Mailed: 6/30/03

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pentel of America, Ltd.

Serial No. 76/234,608

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 Cissel, Hanak and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 3, 2001, applicant, an Illinois corporation,
filed the above-identified application to register the mark
CARNIVAL 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 products.

The original Examining Attorney refused registration
under Section 2(d) of the Lanham Act, 15 U.S.C. Section

1052(d), on the ground that a the same mark is registered¹ for "printing paper" by Champion International Corporation, and that if applicant were to use this mark in connection with automatic pencils, confusion would be likely. In support of the conclusion that the goods specified in the application are commercially related to those identified in the cited registration, she made of record a number of third-party registrations wherein is the identifications of goods include both "printing paper" and "pencils."

Applicant responded to the refusal to register with argument that confusion would not be likely if it were to use the mark it seeks to register in connection with automatic pencils.

The Examining Attorney was not persuaded by applicant's arguments. With the second Office Action, she made the refusal to register final. She submitted additional materials in support of her conclusion that the goods with which applicant intends to use its mark and those identified in the cited registration are commercially related. The first group of materials consists of excerpts from published articles, retrieved from the Nexis automated

¹ Reg. No. 736,040 issued on Aug. 14, 1962; affidavits under Sections 8 and 15 accepted and acknowledged, respectively; renewed.

database, wherein the terms "printed paper" and "pencil[s]" are used together. Some of these excerpts show uses of the terms which establish that both printing paper and pencils may be categorized as office supplies or school supplies. The second group of materials includes printouts from Internet web pages wherein both paper and pencils are offered for sale by the same office supply businesses. The Examining Attorney argued that this evidence demonstrates that goods similar to applicant's goods and registrant's goods travel in the same channels of trade and are likely to be encountered by the same potential customers.

Applicant concurrently filed a Notice of Appeal and a response to the final refusal. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration. The application was reassigned to the above-identified Examining Attorney, who reconsidered the refusal to register, but found that applicant had presented no new facts or reasoning that justified withdrawing the refusal. He issued a brief Office Action to that effect and returned the application to the Board, which resumed action on the appeal.

Applicant and the Examining Attorney filed briefs², and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion would be likely if applicant were to use the mark CARNIVAL in connection with automatic pencils in view of the registration of the same mark for printing paper. After carefully considering the application file, the arguments made by applicant and the Examining Attorney and the relevant legal precedents, we conclude that confusion within the meaning of Section 2(d) the Lanham Act would be likely, and therefore that the refusal to register is well taken.

The predecessor to our primary reviewing court set forth the factors to be considered in determining whether confusion is likely in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these

² The Examining Attorney submitted with his brief a copy of a definition of "printing paper" from The Dictionary of Paper, published under the auspices and direction of the American Paper Institute, Inc. in 1980. The term is defined as "any paper suitable for printing, such as book paper (general definition), bristols, newsprint, writing paper, etc." Ordinarily, additional evidence may not be submitted with an appeal brief, but the Board may take judicial notice of dictionary definitions, so this definition has been considered. (The additional third-party registrations the Examining Attorney also submitted with his brief are discussed later in this opinion.)

factors are the similarity of the marks and the relatedness of the goods. Another factor relevant to the instant case is the similarity of the channels of trade through which the goods move.

In determining whether the marks are similar, we must compare the marks in sound, pronunciation, meaning and commercial impression. Similarity in any one of these elements is sufficient find a likelihood of confusion. In *re Mack*, 197 USPQ 755 (TTAB 1977). In the instant case, the marks are identical in every respect. The commercial impression applicant's mark would create in connection with automatic pencils is the same as that engendered by the registered mark in connection with printing paper.

When the marks at issue are identical, the relationship between the goods of the respective parties does not need to be as close to support a finding of likelihood of confusion as would be a case when differences exist between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). We need not apply this rule in the case at hand, however, because the record before us amply demonstrates that the paper and pencils identified in the registration and application, respectively, are complementary products which move through the same channels

of trade and may be purchased and used together by the same individuals.

The use-based third-party registrations listing both pencils and printing paper made of record by the Examining Attorney, 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 the goods listed therein are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ 2d 1783 (TTAB 1993); and in Re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988). The excerpts from published articles and the results of the Examining Attorney's Internet search submitted with the second Office Action establish that pencils and paper for printing may be purchased from the same retail suppliers of office and school supplies. Paper and pencils obviously may be used together.

Applicant disputes the probative value of the evidence which establishes the relationship between the goods specified in the cited registration and the goods with which it intends to use the mark it seeks to register. Applicant contends that "[u]pon closer examination, it can be readily seen that the third-party registrations

introduced by the Examiner do not establish a nexus between printing paper and automatic pencils." (Brief p. 8)

Applicant concedes that the registrations establish that various entities sell both paper and pencils, but argues that the registrations do not establish that "consumers associate pencils and paper as being produced by the same party." Applicant divides the third-party registrations into several categories, each of which is argued to be distinguishable from the instant case. The categories of marks identified by applicant are marks used on children's products or arts and craft supplies; marks used on premium items; marks used on items sold by office supply distributors under their own marks; and marks used by overseas manufacturers of large numbers of unrelated goods. These characterizations of the marks registered by third parties, however, are simply speculation on the part of applicant. What the record shows is that each of these third-party marks have been registered for both "printing paper" and "pencils," a term which must be interpreted to encompass pencils of all kinds, including automatic pencils. Under the rule set forth in the Trostel and Mucky Duck cases, supra, this evidence supports the conclusion that the listed goods are of types which may come from the same source. When this evidence is viewed in connection

with the materials discussed above, which establish that these products move in the same channels of trade, it is clear that the use of identical marks on these goods would be understood by purchasers as an indication that one source is responsible for both of them.

Applicant argues that "paper manufacturers are not automatic pencil manufactures" and that this is a fact of which the Board may take "official notice." This argument is not persuasive for several reasons. To begin with, the commercial relationship between paper manufacturers and the makers of automatic pencils is not something of which we may take judicial notice. See Fed. R. Evid. 201 and TBMP Section 712. If applicant had wanted to establish facts concerning the relationship between these types of businesses, it should have introduced evidence on the subject. In any event, however, whether confusion would be likely in this case would not be determined based on whether the same manufacturer produces both of the products at issue. The issue is not whether the goods come from the same factory or whether the goods would be confused with each other, but rather whether confusion as to source is likely when the same mark is used on both types of products. In re Rexel Inc., 223 USPQ 830 (TTAB 1984). Applicant has made of record no evidence that rebuts the

showing made by the Examining Attorney that these goods may emanate from a common source and that they move in the same trade channels.

The Examining Attorney, in his brief, notes that applicant, a manufacturer of pens and pencils, owns a registration for a mark used with writing paper, and that a related company owns a registration for a mark used with writing paper and paper pads. He submitted copies of these registrations as further evidence that customers would have a basis upon which to expect both printing paper and automatic pencils to be produced by the same manufacturer. This argument fails, however, because the registrations submitted in support of it were not timely made of record. Trademark Rule 2.142(d) states that the record should be complete when the Notice of Appeal is filed, but that the Board, upon request, may allow submission of additional evidence under certain circumstances. The Examining Attorney in the case at hand did not request permission to supplement the record, so the late-filed registrations have not been considered.

As noted above, however, the evidence timely made of record prior to the appeal is sufficient to meet the Examining Attorney's burden of showing that if applicant were to use the mark CARNIVAL in connection with automatic

Ser No. 76/234,608

pencils, confusion would be likely in view of the cited registration for the same mark for printing paper.

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