

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: August 17, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Burnham Services, Inc., by merger and assignment from
Burnham Properties Corporation¹

Serial No. 74388732

Stanley B. Kita of Howson and Howson for applicant.

Jill C. Alt, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has filed, on May 5, 1993, an application to
register the mark shown below for services ultimately
amended to read "metal foundry services, namely preparing
molds and shaping metal in the molds to the order and
specification of others" in International Class 40. The

¹ The records of the Assignment Branch of the USPTO indicate that
a merger was recorded at Reel 2202, Frame 0443, and a subsequent
assignment was recorded at Reel 2646, Frame 0683.

application is based on applicant's claimed date of first use and first use in commerce of March 1993.



The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of Registration No. 2517601, issued December 11, 2001, for the mark shown below



for "semi finished steel products, namely, hot rolled coil steel, cold rolled coil steel, tube steel, pipe steel, plate steel, structural steel, galvanized and other treated coil steel, reenforcing bar steel and steel wire."

When the refusal to register was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

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. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Examining Attorney argues that the marks are highly similar in sound, appearance, connotation and commercial impression, both consisting of the letters "BF" and both in the same style using an inner "F" to define the two spaces of the surrounding "B"; that the reversal of the black and white portions of the marks and the use by registrant of a black background square are insignificant; that the purchasing public will perceive both marks as the letters "BF," even if the registrant referred to its mark as the letter "B"; that the goods and services are closely related even though applicant's services involve custom made forgings or castings, whereas registrant's goods are standard semi finished steel products; and that any doubt is resolved in favor of registrant.

The Examining Attorney submitted printouts of several third-party registrations to show that the goods and services of registrant and applicant frequently emanate from a common source under a single mark.

Applicant contends that the Examining Attorney erred in "mis-characterizing" the cited registrant's letter "B" mark as the letters "BF" and then treating the registrant's and applicant's marks as substantially similar; that the record shows that the Board referred to the cited registrant's mark as a "stylized B" in a July 6, 1994 order denying the summary judgment motions in consolidated Opposition Nos. 88,237 and 88,238;² that the Examining Attorney erred in either not considering or not giving proper weight to the information in the declaration of Billie T. Trout, submitted by applicant; that the purchasers of these goods and services are sophisticated; that there has been no actual confusion in ten years of use; and that these du Pont "factors should weigh more heavily in a determination of registrability." (Brief, p. 5.)

Applicant submitted the September 23, 2002 declaration of Billie T. Trout, an employee for many years of Burnham

² At that time the cited registrant's then-application was the subject of Opposition No. 88,238.

Foundry ("a division of Burnham Corporation which is a related company to Applicant"), until his retirement as vice president and general manager in 1995. Mr. Trout avers, *inter alia*, that foundries typically make castings to the specifications of their customers; that from the specifications patterns or molds are made in the shape of the article to be cast; that the molded or cast products are shipped to the customer for finishing by the customer; that these are often large volume productions and these runs "typically are not inexpensive to produce"; that the typical foundry customer seeks to have a part manufactured to meet technical requirements not available with rolled or drawn steel sheets, rods or plates; and that during his tenure at Burnham Foundry he was aware of the cited registrant and its standard steel products and he would have been aware of any actual confusion, but there were no instances of actual confusion involving these marks for these respective goods and services.

Turning first to a consideration of the marks, we find that there is a strong similarity between the involved marks. Because the involved marks are essentially stylized letter marks, the degree of stylization affects the overall visual impact of the involved marks. The Court of Appeals for the Federal Circuit addressed this type of situation in

In re Electrolyte Laboratories Inc., 913 F.2d 930, 16
USPQ2d 1239, 1240 (Fed. Cir. 1990) as follows:

There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. ...

...[T]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.

...[E]ven if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.

In this case, the visual impact of both marks is the letters "BF." That is, purchasers would perceive the marks as the letters "BF" (even if the cited registrant described its own mark as the letter "B"). Purchasers are not aware of either the manner in which an applicant describes its mark in submissions to the USPTO, or descriptions of marks appearing in decisions of this Board.

The background square appearing in the cited registrant's mark is a common geometric shape and is not

accorded trademark significance as it is a "carrier" of the letter mark. See *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); and *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804 (TTAB 1990).

The mark "BF" is unpronounceable except as the separate letters, and would be more difficult to remember, and thus, more susceptible of confusion or mistake. The slight differences in the style of lettering and the inverse black and white colors in the two marks may not be recalled by purchasers seeing the marks at separate times. The proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the purchasers, who normally retain a general rather than specific impression of the many trademarks encountered; that is, a purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrision, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

We find that the marks are similar in sound, appearance, connotation and overall commercial impression. See *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (confusion found

likely in contemporaneous use of TMM and TMS on computer software).

Insofar as the goods and services are concerned, confusion in trade can occur from the use of similar (or the same) marks for products, on the one hand, and for services involving those products, on the other hand. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Safety-Klean Corporation v. Dresser Industries, Inc.*, 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983).

It is not necessary that the goods and services be identical or even competitive 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 in situations that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods and services originate from or are in some way associated with the same source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings

regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, the registered mark is for "semi finished steel products, namely, hot rolled coil steel, cold rolled coil steel, tube steel, pipe steel, plate steel, structural steel, galvanized and other treated coil steel, reenforcing bar steel and steel wire," while applicant offers the service of "metal foundry services, namely preparing molds and shaping metal in the molds to the order and specification of others." The Examining Attorney has submitted printouts of numerous third-party registrations, several of which are based on use in commerce,³ indicating the same entities offer both of these goods and services under the same mark. See, for example, Registration No. 1717471 for "steel and stainless steel castings" and "custom manufacture of metal castings";

³ We have disregarded all third-party registrations offered by the Examining Attorney which were not based on use in commerce.

Ser. No. 74388732

Registration No. 2556397 for "manufactured bar steel products, namely, ..." and "custom manufacturing of bar steel products"; Registration No. 2492463 for "steel in sheet, namely, rolled steel plate and rolled steel strip, ... coiled steel plate and strip, and discrete plate, ..." and "... manufacturing custom rolled steel to customer order, ..."; Registration No. 2590394 for "cast steel products, namely bars, tube and pipe" and "manufacture of steel bars, tube and pipe to the order and specification of others"; Registration No. 1523818 for "metal castings" and "metal casting and foundry services"; and Registration No. 2706681 for "metal castings, rolled bar steel in round, square and flat shapes, ..." and "melting and casting of metals."

When considering the third-party registrations submitted by the Examining Attorney, we are aware that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such goods and services are of a type which emanates from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Purchasers aware of registrant's semi finished steel products, who then encounter applicant's metal foundry services, offered under these similar marks, are likely to believe that applicant's services emanate from or are sponsored by or affiliated with registrant.

When the goods and services are compared in light of the legal principles cited above, we find that applicant's metal foundry services and registrant's semi finished steel products are related.

Applicant contends that the trade channels are "sufficiently different" that the Examining Attorney should have found no likelihood of confusion. However, applicant does not explain what those specific different trade channels are for the registrant's "standard grade steel goods" and applicant's foundry services to produce custom-made metal products. (Applicant's response filed October 10, 2002, p. 2.) Entities that purchase steel products may well purchase both standard and custom made steel products in different situations.

We find that the respective goods and services, as identified, could be sold through the same or overlapping channels of trade, to the same or overlapping classes of purchasers.

Applicant argues that the purchasers of the involved goods and services are sophisticated purchasers who interact with the foundry to obtain special-order goods and they will distinguish between applicant's and registrant's marks. Assuming the sophistication of the purchasers of these goods and services, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also, Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Decombe, 9 USPQ2d 1812 (TTAB 1988); and 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"]. That is, even relatively sophisticated purchasers of these goods and services are likely to believe that the goods and services emanate from the same source, if offered under the involved substantially similar marks. See Weiss Associates Inc. v. HRL Associates Inc., supra; and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

With regard to applicant's argument that there has been no actual confusion involving these marks for the respective goods and services over the last ten years, that argument is not actually supported by the evidence, specifically Mr. Trout's declaration. Mr. Trout avers that during his tenure (ending in 1995 when he retired) at a division of a related company to applicant, he was not aware of any instances of actual confusion. Thus, this declaration covers the time period only up to the year 1995, with no information from applicant (or any related company or division) regarding whether or not there have been any instances of actual confusion from 1995 to the present. Moreover, there is no evidence of applicant's and the cited registrant's geographic areas of sales, or the amount of the sales of the goods and services under the respective marks; and there is no information from registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, supra; and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). This factor is entitled to little weight. *Majestic Distilling Co.*, supra, 65 USPQ2d at 1205 ("With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated

statements of no known instances of actual confusion are of little evidentiary value.").

Based on the similarities of the marks; the relatedness of the goods and services; the same or overlapping trade channels; and the same or overlapping purchasers; we find that the relevant purchasers would likely be confused as to the source of applicant's services vis-a-vis registrant's goods, offered under their respective marks.

Decision: The refusal to register under Section 2(d) is affirmed.