

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

August 18, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Waste Management, Inc.

Serial No. 76433850

Bruce D. George of Woodcock Washburn LLP for Waste Management, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Quinn, Hohein and Kuhlke, Administrative Trademark Judges.
Opinion by Hohein, Administrative Trademark Judge:

Waste Management, Inc. has filed an application to register on the Principal Register the mark "WASTEMASTER/ALIVE" for "a commercial hauling control and monitoring system comprising computer hardware, computer software, electronic hardware and encoded smart cards that track, control, and maintain hauling activities to ensure hauler accountability, driver compliance, and the safety, weight, time and location of product loading, transfer and delivery" in International Class 9.¹

¹ Ser. No. 76433850, filed on July 24, 2002, based on an allegation of a date of first use of such mark anywhere and in commerce of August 2002 and subsequently amended, on August 20, 2004, to seek

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "WASTEMASTER," which is registered on the Principal Register for a "waste compactor fullness and usage monitoring and communications system comprised of electronic remote sensors for tracking usage, detecting waste fullness levels and providing notification of such conditions to user, hauler, servicer and seller, via facsimile, computer or pager" in International Class 9,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or

registration based on an allegation of a bona fide intention to use the mark in commerce.

² Reg. No. 2,455,686, issued on May 29, 2001, which sets forth a date of first use of such mark anywhere and in commerce of November 29, 2000.

dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³

Turning first to consideration of the respective goods, as well as to the related *du Pont* factor of the conditions under which and buyers to whom sales are made, applicant asserts in its initial brief that, "[i]n view of the difference in the relevant goods and the sophistication of their purchasers, it is extremely unlikely that confusion will occur." Applicant, in this regard, specifically points out among other things that (underlining in original):

The goods of applicant and registrant would not be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. Applicant's goods are limited to sophisticated consumers in the hauling trade, those hauling organizations large enough to coordinate and maintain numerous hauling vehicles operating between multiple transfer stations and/or pick-up/delivery locations. Applicant's goods monitor and control an entire (perhaps nationwide) hauling operation, an operation that coordinates employee and subcontract haulers, and involves perhaps hundreds or thousands of vehicles operating between the transfer stations and pickup and delivery locations. Applicant's computerized system tracks, controls and coordinates the operation of this hauling (e.g., trucking) organization, so that the last location of any vehicle, and the scheduled time and arrival location of that vehicle is always and instantaneously available, thereby ensuring subcontractor accountability, individual driver compliance, and the proper time, location and quantity of product transfer, pick-up and delivery.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

Applicant, in view thereof, further insists that the "ordinary purchaser" of its goods "is highly sophisticated, having a specialized and affirmative need (i.e., acquiring a means to monitor and control employees, subcontractors and a large pick-up and delivery network)." Such a purchaser, applicant urges, "undergoes a lengthy and deliberate consideration process, including extensive consultation with applicant both before and after the goods are procured." Applicant thus maintains that its "marketing practice ... is specifically focused to this sophisticated, costly and specialized need, thereby precluding confusion with registrant, the provider of a much more commonplace compactor or container fullness monitoring and communication system." Accordingly, applicant contends that "there is no impulse, off the shelf, or point and click purchasing of applicant's goods, and only a small, very identifiable group of potential customers exist across the country for applicant's goods."

By contrast, applicant argues that:

The ordinary purchaser of registrant's goods (i.e., owners of waste containers) may or may not be sophisticated. Their need (i.e., desiring timely and efficient pick-up of the generated waste) is much more commonplace and completely unrelated to the need of applicant's ordinary consumer, even in the rare event that the same large business entity might contemplate purchase of applicant's and registrant's goods. Purchase of registrant's goods would likely not involve interaction and/or deliberation with the registrant, and could be as simple as a point and click purchase

Applicant, citing *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), accordingly concludes that:

[E]ven in the rare instance where a single waste hauler might routinely purchase numerous products of registrant (i.e., numerous waste containers with fullness monitoring equipment included), and then might consider purchase of one product of applicant, ... the nature and purpose of the respective goods would dictate that the purchase be made by different persons in different departments, each having different responsibilities within that one corporation.

On the other hand, the Examining Attorney, citing *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984), notes in her brief that the goods at issue herein need not be identical or directly competitive in order for there to be a likelihood of confusion. She points out that, instead, the respective goods need only be related in some manner or that 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 common source. She insists that, in this case, "the goods of registrant and applicant could be encountered by the same purchasers under circumstances which would suggest that the goods come from the same provider because (1) the goods travel in the same channels of trade--that of waste management; (2) the goods may be encountered by the same users--waste haulers and waste management operators; and (3) the goods provide complementary or related information electronically about waste."

In particular, the Examining Attorney argues that:

Applicant's [commercial hauling control and monitoring system] product is used in connection with hauling waste. (See applicant's specimen/information of record). It provides information about drivers, loads and destinations. When a driver arrives at a [waste] transfer station or landfill, he presents a smart card for authorization. The smart card is swiped through the system located in the remote landfill or transfer station and driver/load compliance is instantly verified. It is clear, therefore, that both the hauling company and the landfill/transfer station or other waste management related operator come into contact with the mark and the goods.

Registrant's [waste compactor fullness and usage monitoring and communications system] product is used in connection with hauling waste as well. Registrant's product monitors waste compactor fullness and notifies users and haulers of the status [thereof]. It is equally clear that, in this circumstance as well, both the hauling company and the landfill/transfer station or other waste management related operators come into contact with the mark and the goods.

Both waste facility managers and waste haulers operate within a single channel of trade--that of waste management. The goods of registrant and applicant both travel within that trade channel. Therefore, both waste haulers and waste facility operators may easily come into contact with the products of both registrant and applicant and assume a common source.

For example, a waste facility manager may use waste compactors. Registrant's WASTEMASTER system would be responsible for notifying the manager that the waste compactor is full. Registrant's WASTEMASTER system would also notify the hauler to come and collect the waste from the compactor. Therefore, both the facility manager and the trash hauler would come into contact with the mark WASTEMASTER, identifying a system that provides information pertaining to waste.

The same waste facility manager may receive waste or have waste to be hauled. The hauler may use the system of applicant.

The waste facility manager would then use applicant's system to check the driver/load compliance. Again, both the facility manager and the trash hauler are exposed to [the mark] WASTEMASTER/ALIVE, also identifying a system that provides information pertaining to waste.

The above argument demonstrates that the goods travel in the same channel of trade, that the goods may be encountered by the same users and that the goods provide complementary or related information about waste. Therefore, the goods are highly related. A waste hauler and a waste facility manager coming into contact with such goods marketed under the names WASTEMASTER and WASTEMASTER/ALIVE are likely to assume a common source [for such goods].

Additionally, as to applicant's contention that its goods are limited to sales to sophisticated consumers in the waste hauling trade while registrant's goods are primarily purchased by owners of waste containers (and who may or may not be sophisticated consumers), the Examining Attorney urges that:

The evidence of record attached to the office action of July 28, 2003, demonstrates that the same party may provide waste compactors with monitoring systems (like the goods of registrant) as well as a variety of items for city, government and private haulers. This demonstrates that the same party may be the source of goods for both "owners of waste containers" and large private haulers. Accordingly, it would not be unreasonable for a consumer to assume that the goods of registrant, used by owners of waste containers, and the goods of applicant, used by private haulers, come from the same producer.

Furthermore, as to applicant's assertion that confusion is not likely in view of the sophistication of the customers for its goods, the Examining Attorney, citing *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988) and *In re Pellerin Milnor Corp.*, 221 USPQ 558

(TTAB 1983), maintains that "[t]he fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion.

Applicant, in its reply brief, contends that "[t]he Examining Attorney's conclusion and numbered statements are incorrect" in that:

First, the goods do not travel in the same distinct channels of trade. Second, while the goods may be encountered by the same users, they are not encountered by the same potential purchasers under circumstances suggesting that they originate from the same source. And third, the goods do not provide complementary or related information electronically about waste.

Specifically, applicant asserts among other things that the respective goods do not provide complementary or related information electronically about waste. Instead, applicant maintains that registrant's goods only "provide information regarding waste compactor fullness," while applicant's commercial hauling control and monitoring system relates to any material and not just waste matter. Applicant thus insists that because, in its system, "material weight is the only monitored characteristic relating to the material ..., applicant's and registrant's goods do not monitor and manage complementary or related information about waste." According to applicant:

Applicant's system provides information about drivers, loads and destinations. When a driver arrives at a transfer station or landfill, he presents a smart card for authorization. The smart card is swiped through the system located in the remoter landfill or transfer station and driver/load compliance is instantly verified. Other than

material weight, and trailer compliance in accordance with motor vehicle guidelines, the material transferred in the trailer is just not consequential to the information monitored and managed in applicant's system. Further, in applicant's system, the trailer being hauled is not a waste compactor having possibly associated with it registrant's fullness monitoring system.

Although applicant acknowledges, as asserted by the Examining Attorney, that both a trash or other waste hauling company and a landfill/transfer station or other waste management related operator may come into contact with the goods at issue and the respective marks, applicant emphasizes that (underlining in original):

The test is whether the goods of applicant and the goods of registrant are related or marketed in such a way that they would be encountered by the same consumers in situations that would create the incorrect assumption that they originate from the same source. In the instant matter, the answer is no. Waste management related operators are simply not the consumers of applicant's goods, nor are the drivers of the hauling companies that are likely to come into contact with the mark through the carrying of applicant's smart cards

Applicant's goods would involve a single purchase for a hauling company that could be nationwide, or even international. The representative purchaser from the hauling company is responsible for high level logistical operations, and hauling network coordination, safety and efficiency. The website provider (see the examining attorney's evidence of record attached to the office action of July 28, 2003) of "waste compactors with monitoring systems (like the goods of registrant) as well as a variety of items for city, government and private haulers" (Examining Attorney's Appeal Brief at ... 7), will not be providing applicant's goods by online ordering.

In view thereof, applicant insists that "the channels of trade and class of purchaser of applicant's goods and registrant's goods are and will remain significantly unrelated and distinct, due to the specific and unrelated nature of the respective goods and the sophistication of the respective purchaser." Applicant thus reiterates its contention that confusion is not likely due to the differences in the respective goods and their principal purchasers.

We find, however, that the goods at issue are related. As the Examining Attorney has pointed out and applicant has acknowledged, customers for applicant's and registrant's goods include waste or trash haulers. We note, in this regard, that applicant's advertising brochure, which it originally submitted as a specimen of use, states among other things that while applicant "is the largest trash hauling company in North America," it is also the case that, "[i]n the Eastern area, independent contractors make up 94 percent of the drivers who haul Waste Management trash." Such waste or trash haulers obviously constitute the principal purchasers of applicant's "WASTEMASTER/ALIVE" product, which as indicated in its advertising brochure, "provides up to the minute information about our drivers, our loads...and the destinations of those loads," "guarantees that Waste Management complies with state and federal regulations" and "lets Waste Management's Transportation Department track all third party haulers and their drivers utilizing a Smart Card technology." Moreover, as the website excerpts made of record by the Examining Attorney disclose, waste

or trash haulers would also be customers for waste compactors, as of course would be waste management related operators, and therefore such customers would concomitantly be purchasers of registrant's "WASTEMASTER" "waste compactor fullness and usage monitoring and communications system ... for tracking usage, detecting waste fullness levels and providing notification of such conditions to [a] user, hauler, servicer and seller, via facsimile, computer or pager." Furthermore, like applicant's product, registrant's product electronically monitors and provides notification as to the status or condition of the waste collection and disposal equipment or activity being tracked. Applicant's and registrant's goods thus would not only share the same purchasers, namely, those persons at trash or waste hauling companies who are responsible for buying equipment used in connection with refuse collection and disposal, but such goods are similar in function in that they electronically monitor and report on trash or waste loads which require transport from a collection site or transfer station to a landfill or other refuse disposal facility. Plainly, conditions are such that if applicant's and registrant's goods were to be marketed under the same or similar marks, confusion as to their source or sponsorship would be likely to occur.

Turning, therefore, to consideration of the marks at issue, applicant contends in its initial brief that its "WASTEMASTER/ALIVE" mark is not likely to cause confusion with registrant's "WASTEMASTER" mark because:

When viewed in their entirety, the marks differ in appearance, sound, and commercial

impression. The meaning or connotation of a mark must be determined in relationship to the goods or services. The "ALIVE" portion of applicant's mark influences the commercial impression, as applicant's goods (a commercial hauling control and monitoring system) are directed to ensuring safety in the hauling industry, and on the roadways of America. An investment in safety, through purchase and employment of applicant's goods, is the message conveyed to and recollected by the ordinary purchaser through the "ALIVE" portion of applicant's mark. Therefore, the commercial impression conveyed by applicant's mark is significantly different and distinct than that conveyed by registrant, whose mark WASTEMASTER is highly suggestive of a controller for a waste compactor.

The Examining Attorney, however, asserts in her brief the general principal that the "mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion." She argues, in view there, that in the present case:

Registrant is using WASTEMASTER. Applicant intends to use WASTEMASTER/ALIVE. Applicant has simply added ALIVE to WASTEMASTER, a registered mark. The addition of this term is not sufficient to overcome the similarities of the marks. Therefore, the marks of the registrant and applicant are highly similar and they create highly similar commercial impressions.

Applicant, in its reply brief, takes issue with what it characterizes as "the examining attorney's conclusory statement." In particular, applicant maintains that "the examining attorney's conclusion focuses on only a portion of applicant's mark, and not on the appearance and connotation of the mark in its entirety." Applicant, notwithstanding the statement in its application that "the term (i.e., acronym) 'ALIVE' means 'All Licensed Insured Vehicles & Employees,'" reiterates its assertion that its mark conveys a commercial impression of "ensuring safety in the

hauling industry, and on the roadways of America," urging that "the dominant portion of applicant's and registrant's mark[s] is not the same due to the fact that "the addition of applicant's dominant portion, ALIVE ..., causes the marks, when viewed in their entireties, to convey significantly different commercial impressions" (underlining in original).

We concur with the Examining Attorney, however, that overall, the similarities in the marks at issue outweigh their differences. Here, while the word "ALIVE" forms a significant portion of applicant's "WASTEMASTER/ALIVE" mark, it is neither the first nor most prominent part thereof, which is instead the term "WASTEMASTER." Customers for applicant's product would thus tend to focus their attention on, and would undoubtedly remember, the term "WASTEMASTER," which in sound, appearance and connotation is identical to and constitutes the entirety of registrant's mark. Even assuming, as urged by applicant, that the terminology "ALIVE" in its "WASTEMASTER/ALIVE" mark denotes or conveys an image of safety when used in connection with applicant's product, it is still the case that the overall commercial impression engendered by such mark is that it is a "WASTEMASTER" commercial hauling control and monitoring system which is "ALIVE." We therefore conclude that, when considered in their entireties, applicant's "WASTEMASTER/ALIVE" mark is so substantially similar in sound, appearance, connotation and commercial impression to registrant's "WASTEMASTER" mark that the use thereof in connection with the related goods at issue herein is likely to cause confusion as to source or sponsorship thereof.

In this regard, even knowledgeable and sophisticated purchasers are likely to regard applicant's "WASTEMASTER/ALIVE" computerized and smart card based commercial hauling control and monitoring system as another product in a line of specialized waste management equipment from the same source or provider as that which markets registrant's "WASTEMASTER" waste compactor fullness and usage monitoring and communications system. Thus, while we agree with applicant that customers for its product and that of registrant would generally be sophisticated in that they would be knowledgeable and discriminating as to their equipment needs and safety requirements, it nevertheless is well settled that the fact that buyers may exercise care and deliberation in their choice of goods "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *In re Decombe*, supra at 1814-15; and *In re Pellerin Milnor Corp.*, supra at 560.

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