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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hoffman Enclosures Inc.

Serial No. 78410108

Charles E. Steffey of Schwegman, Lundberg, Woessner & Kluth, PC
for Hoffman Enclosures Inc.

Rebecca Gan, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Seeherman, Hohein and Kuhlke, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Hoffman Enclosures Inc. has filed an application to register on the Principal Register in standard character form the mark "D-BOX" for "protective cabinets for housing electrical, electronic, telecommunication and computer components and equipment in the data communication field" in International Class 20.¹

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

¹ Ser. No. 78410108, filed on April 29, 2004, which is based on an allegation of a bona fide intention to use such mark in commerce.

mark "D-BOX," which is registered on the Principal Register in standard character form for "mounts for electronic instruments, namely, temperature transmitters, signal isolators, electropneumatic converters, signal conditioning equipment and signal transmitters for use in the industrial field" 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 held. 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 dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³ Here, inasmuch as applicant's mark and registrant's mark are identical in all respects,⁴ the focus of our inquiry is

² Reg. No. 2,131,919, issued on January 27, 1998, which sets forth a date of first use of the mark anywhere and in commerce of May 1, 1997; combined affidavit §§8 and 15.

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.

⁴ Applicant, in its initial brief, "concedes the similarity of the word marks," but "suggests that when properly viewed in context, they do

accordingly on the similarity or dissimilarity of the respective goods.

Applicant, in its initial brief, stresses among other things that the respective goods are dissimilar and therefore not related because its goods are classified in International Class 20 while registrant's goods are set forth in International Class 9. However, as the Examining Attorney correctly points out in her brief, the classification of goods is purely an administrative determination and has no bearing on the question of likelihood of confusion. Rather, it is the manner in which applicant and registrant have identified their goods which is controlling. See, e.g., *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); and *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

With respect thereto, as the Examining Attorney also properly notes, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed.

not make a similar commercial impression." Applicant fails, however, to offer any coherent explanation in such brief for its assertion. Similarly, in its reply brief, applicant "concedes that the D-BOX formative in Appellant's word mark is identical [to the mark] D-BOX in the cited registration," but urges that "[t]he marks, however, are not identical" because, applicant "suggests[,] ... when the words in Appellant's mark are considered in context with [the] goods with which those words are so used, no likelihood of confusion has been shown." Such a conclusory statement, without any underlying reasons, is simply not persuasive of a finding that the identical marks at issue herein differ in commercial impression.

Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where applicant's and registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Moreover, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Applicant contends, however, that not only are registrant's goods identified as "mounts" while applicant's goods are identified as "protective cabinets," but the former are specifically limited to those for "electronic instruments, namely, temperature transmitters, signal isolators, electropneumatic converters, signal conditioning equipment and signal transmitters for use in the industrial field" while its goods are restricted to those used "for housing electrical, electronic, telecommunication and computer components and equipment in the data communication field." In view thereof, applicant maintains that:

While the Examiner may characterize the products in the cited registration and the present application to be "enclosures," doing so ignores the substantial limitations incorporated into the goods descriptions of both marks and unfairly suggests that the products to which they are applied are the same. Though the [Final] Office Action indicates the basis for the assertion is language on the Registrant's and Applicant's websites that their products are "enclosures" any fair reading of those materials demonstrates that the products of Applicant are "for use in the data communications field" and those of Registrant are "for use in the industrial field."

Furthermore, Examiner has asserted that registrant's mounts for "signal conditioning equipment" would overlap with applicant's enclosures for "telecommunication ... components or equipment." Applicant denies that there is any "overlap" as asserted in the [Final Office Action]. If one considers the complete definition of goods in the cited registration it is noted that the "signal conditioning equipment" and other electronic instruments are all "for use in the industrial field." In Applicant's ... goods description, the electronic, telecommunications and computer components and equipment are "for use in the data

communications field." Applicant submits that the electronics and data communications fields do not "overlap."

Similarly, applicant asserts that while the Examining Attorney, in the final refusal, "stated that 'both applicant and registrant make protective enclosures for electronics,' applicant points out that in her denial of its request for reconsideration, the Examining Attorney "has unduly broadened the use of registrant's goods to be all inclusive in the "industrial field." Applicant contends, however, that as shown by the copy of the "Data Sheet" which it made of record from the file history of the cited registration, registrant's "D-BOX accommodates temperature, pressure, level and flow transmitters, meters, indicators, analyzers, integrators, and many other head-mount and hockey-puck instruments" and that "[n]owhere is registrant claiming the use of its D-BOX mark for data communication equipment." Applicant also "submits that the mounts in the cited registration for use in the industrial field move in substantially different trade channels than applicant's protective cabinets for the data communications field as evidenced by the website materials" which it made of record from both applicant's and registrant's websites.

However, where the marks at issue are identical, as is the case herein, the relationship between the respective goods need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. See, e.g., Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). The Examining

Attorney, in view thereof, maintains that confusion is likely from contemporaneous use by applicant and registrant of the identical mark "D-BOX" because "both Applicant and Registrant provide the same type of goods, namely, protective enclosures for electrical goods" and "these goods could be sold to the same class of consumers." In particular, the Examining Attorney insists that "a review of the attachments provided by Applicant's ... responses to Office Actions ... clearly evidences that Applicant, like Registrant, produce[s] mounts for electrical equipment" in that the excerpts from applicant's website refer to "its D-Box as a 'wall-mount Enclosure'" and "a 'field-mount Enclosure.'" Moreover, the Examining Attorney urges, inasmuch as "the field of use as identified in Registrant's identification [of its goods] is broadly defined as 'industrial[,]'" it is presumed that the registration encompasses all relevant industries, including data communications."

While, as previously indicated, the question of whether the goods at issue are related is governed by the identifications of the goods as respectively set forth in applicant's application and the cited registration, we have considered the information made of record by applicant inasmuch as, given the broad manner in which such goods are identified and our lack of familiarity with the term "mounts," it provides a better understanding of the nature and use of the goods at issue. See *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990). As such information confirms, the Examining Attorney is correct that both applicant's and registrant's goods are essentially protective enclosures for

mounting, *inter alia*, various items of electronic equipment, notwithstanding that applicant's goods are identified in its application as "protective cabinets for housing electrical, electronic, telecommunication and computer components and equipment in the data communication field" while registrant's goods are set forth in its registration as "mounts for electronic instruments, namely, temperature transmitters, signal isolators, electropneumatic converters, signal conditioning equipment and signal transmitters for use in the industrial field."

Specifically, the brochure excerpted from applicant's website describes its "D-Box™ Wall-Mount Enclosure" in relevant part as follows (emphasis added):

The ... D-Box™ Wall-Mount **Enclosure provides convenient mounting**, storage and protection for network equipment, patch panels, and connections. This versatile cabinet can meet many different network needs, including horizontal cable distribution, copper to fiber interface, cross connections, and consolidation point. The hinged door provides convenient access, and a combination of fixed and rotating rack angles accommodates varying equipment sizes. A full line of accessories facilitates enclosure and equipment installation.

In the same vein, the brochure retrieved from registrant's website describes its "D-BOX® Field-Mount **Enclosure** for Head-Mount & Hockey-Puck Instruments" as follows (emphasis added):

Handles a Wide Array of Instrumentation
The D-BOX® **accommodates** temperature, pressure, level and flow transmitters, meters, indicators, analyzers, integrators, and **many** other **head-mount** and hockey-puck **instruments**.

For Hazardous and General Locations

The *D-BOX* meets standards for enclosing indoor and outdoor electronic instruments
....

Safeguards Expensive Instruments
... the *D-BOX* is resistant to ultraviolet rays and chemicals. Its **high-impact materials protect instruments even when they must be installed in harsh field conditions.**

Replaces Costly Explosion-Proof Enclosures
At a fraction of the cost, the *D-BOX* provides **the right level of protection** in areas where explosion-proof certifications are not required.

Clear and Solid Covers
Instrument indicators such as process displays and alarm LEDs, can be clearly viewed without removing the *D-BOX* front cover. The solid cover is the answer for non-indicating instruments.

....

Custom Brackets for OEM Applications
Our team of engineers will work with you to design and provide any special installation hardware that may be required to integrate your instrument into the *D-BOX*.

While we further note, as contended by applicant in its response to the initial Office Action, that "[t]he products offered by Applicant and Registrant are directed toward what are distinctly different groups of purchasers" in that "[a]pplicant's goods are for use in the telecom industry for communications and network equipment, and Registrant's goods are for use [in] protecting sensors, meters and indicators for industrial [use], as distinguished from use for telecommunication or computer components or equipment," we see no reason why such uses are necessarily mutually exclusive, as applicant basically asserts. Instead, it would seem that many industrial uses in which mounts

are required for protection of electronic instruments, such as temperature transmitters, signal isolators, electropneumatic converters, signal conditioning equipment and signal transmitters, would also require the use of protective cabinets for housing electrical, electronic, telecommunication and computer components and equipment necessary to transmit the data generated by various electronic instruments. Consequently, protective enclosures for mounting various electronic instruments or items of data telecommunications equipment, if sold under the identical mark "D-BOX," would be regarded by purchasers thereof, such as industrial plant engineers, as closely related goods which emanate from the same commercial source. Confusion, therefore, would be likely to occur.

Applicant nonetheless further argues among other things that the "website materials ... show that both Registrant's and Applicant's products are for careful sophisticated purchasers who are purchasing products with careful study of the website materials."⁵ Applicant insists that "purchasers for such

⁵ Applicant additionally asserts that "the website materials for Registrant and Applicant also bear the corporate trademarks of Registrant and Applicant which ... allow the purchasers to confirm that they are selecting the proper product for their specific application rather than basing the buying decision solely upon the presence of the D-BOX mark." However, because the issue of likelihood of confusion must be decided on the basis of the mark which applicant seeks to register and the mark shown in the cited registration, the fact that applicant and registrant use their respective "D-BOX" marks in conjunction with other marks simply is legally irrelevant and immaterial to a determination of the issue of likelihood of confusion. See, e.g., Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); Burton-Dixie Corp. v. Restonic Corp., 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); Hat Corp. of America v. John B. Stetson Co., 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and ITT Canteen Corp. v. Haven Homes Inc., 174 USPQ 539, 540 (TTAB 1972).

enclosures are highly sophisticated and are less likely to be confused as to the source or origin of these goods than average retail consumers would be likely to be." However, as the Examining Attorney properly notes, "the 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." See, e.g., *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); *In re Decombe*, 9 USPQ 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Applicant also maintains, due to the copies of three other registrations of the mark "D-BOX" which it made of record, that such mark is a weak mark which is entitled to only a narrow

Furthermore, as to the *du Pont* factor of the nature and extent of any actual confusion, applicant asserts that the "Office Actions cites [sic] no evidence of any actual confusion and Applicant is aware of none" and that, as to the converse thereof, namely the *du Pont* factor of the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, it merely claims that "[a]ny concurrent use ... has not led to any confusion known to Applicant." It is not known, however, whether registrant has likewise experienced any instances of actual confusion. Moreover, for an asserted lack of any incidents of actual confusion to be a meaningful factor, the record must demonstrate that there has been appreciable and continuous use by applicant of its mark in the same market(s) as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Specifically, there must be evidence showing that there has been an opportunity for instances of actual confusion to occur and here the record is devoid of any such proof. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Lastly, while applicant also briefly mentions several other *du Pont* factors, it is pointed out that such factors are irrelevant to the issue of likelihood of confusion in this case because there is simply no evidence of record which pertains thereto.

scope of protection, arguing in particular that:

Applicant submits that there are four registered marks D-BOX found in our search at the USPTO Trademark Electronic Search System. Registrations of the D-BOX mark in International Class 009 have subsequently been granted to two additional Registrants (2,677,372 [for electrical modules and sensors for use in the tuning and for improved performance of diesel truck engines for sale to individual consumers through retail outlets] and 2,711,302 [for speakers and motion simulation systems comprised of a controller, a channel processor or receiver, a CD-ROM or DVD drive, motor driven actuators and a remote control]). A prior registration 2,033,376 for D-BOX in International Class 009 for an adjustable camera mounting platform was in place prior to the granting of the [cited] registration

The Examining Attorney, in response, properly points out that:

[W]ith respect to Applicant's citation of third-party registrations containing the "D-BOX" literal matter, [the] Examining Attorney notes that third-party registrations by themselves ... are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); *National Aeronautics and Space Admin. v. Record Chem. Co.*, 185 USPQ 563 (TTAB 1975); TMEP §1207.01(d)(iii). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Although we also note that third-party registrations may indicate that a term has been adopted by multiple entities because it has a particular significance, the goods as set forth

in the other registrations for the mark "D-BOX" are different from the goods in the cited registration and applicant's application, and none on their face is as closely related to the cited registrant's goods as are the goods listed in applicant's application. Applicant has thus not only failed to demonstrate the asserted weakness of such mark, but on this record the mark appears to be a strong one. While the word "BOX" in the mark "D-BOX" is obviously, at a minimum, highly descriptive of any kind of protective enclosures, including mounts and cabinets, the letter "D" therein appears to be arbitrary, rather than suggestive, as used in connection with the goods at issue herein. The combination of the letter "D" with the word "BOX" to form the mark "D-BOX" therefore results in a mark which is entitled to more than just a narrow scope of protection.

Nonetheless, as a final consideration, we note that to the extent that applicant's contentions with respect to specific differences in the respective goods, their purchasers and the channels of trade therefor may serve to raise any doubt as to our conclusion with respect to the issue of likelihood of confusion, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004); In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

Accordingly, we conclude that customers and prospective purchasers who are familiar or otherwise acquainted with

registrant's "D-BOX" mark for its "mounts for electronic instruments, namely, temperature transmitters, signal isolators, electropneumatic converters, signal conditioning equipment and signal transmitters for use in the industrial field," would be likely to believe, upon encountering applicant's identical "D-BOX" mark for its "protective cabinets for housing electrical, electronic, telecommunication and computer components and equipment in the data communication field," that such commercially related protective enclosures for mounting, *inter alia*, various items of electronic equipment emanate from, or are otherwise sponsored by or affiliated with, the same source.

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