Oral Hearing:
January 28, 1999

Paper No. 14
GDH/gdh

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Porcelain Metals Corporation

Serial No. 75/091,534

Amy B. Berge and Laura D. Robertson of Middleton & Reutlinger for Porcelain Metals Corporation.

Richard G. Cole, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Porcelain Metals Corporation to register the configuration shown below

as a trademark for "barbecue grills".[1] Such mark, which is sought to be registered on the basis of a claim of acquired distinctiveness pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is described in the application as follows:

> The mark consists of the three dimensional configuration of a portion of Applicant's barbecue grills consisting of an oval, egg-shaped kettle and an attached ash catcher.

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 so resembles both of the marks, reproduced side by side below,

which are registered, by the same registrant, for "barbeque

[1] Ser. No. 75/091,534, filed on April 19, 1996, which alleges dates of first use of March 31, 1989 and states that "[t]he broken lines ... indicate the location of the mark in relation to the remaining portion of one model of Applicant’s goods."

grills,"[2] as to be likely to cause confusion, mistake or deception. The marks, which in each instance were registered pursuant to a claim of acquired distinctiveness under Section 2(f) of the statute, are respectively described in the cited registrations as follows:[3]

> The trademark consists of a three-dimensional pictorial representation of the distinctive configuration of the kettle portion of applicant's barbecue grills. The kettle portion includes a bottom of generally semi-spherical shape having a top of generally semi-ellipsoid shape.
>
> The trademark consists of a three-dimensional pictorial representation of the distinctive configuration of the kettle and leg portions of applicant's barbecue grills. The kettle portion includes a bottom of generally semi-spherical shape having a top of generally semi-ellipsoid shape and supported by three downwardly and outwardly extending legs projecting from the bottom of the bottom portion.

Applicant has appealed. Briefs have been filed[4] and an oral hearing was held. We affirm the refusal to register.

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[2] Reg. Nos. 1,478,530 and 1,481,521, issued respectively on March 1, 1988 and March 22, 1988, and which set forth dates of first use of April 1955; combined affidavit §§8 and 15 accepted as to each registration.

[3] In view of the different spellings set forth in the registrations, and inasmuch as applicant's application uses the more commonly accepted spelling of "barbecue" rather than "barbeque," registrant's and applicant's goods will subsequently be referred to in this opinion as either "barbecue grills" or "charcoal grills".

[4] The Examining Attorney, citing Trademark Rule 2.142(d), has objected in his brief to consideration of the nine exhibits attached to applicant's initial brief, arguing, among other things, that "the insertion into the record of (partial) copies of design patents," as well as various "photographs and exhibits attached thereto," "should not be considered a part of the record since they were not placed therein until after the Appeal was filed". Although the first of such exhibits is simply a color copy of the brochure applicant originally submitted with its response to the initial Office action, and thus clearly is of record, the Examining Attorney plainly is correct that

Preliminarily, and since applicant's and registrant's goods are identical in legal contemplation, we concur with the view of both applicant and the Examining Attorney that, inasmuch as the respective marks are product configurations and hence, like pure design marks, cannot be pronounced, the issue of likelihood of confusion must be decided primarily on the basis of the overall visual similarity of the marks. Cf. In re ATV Network Ltd., 522 F.2d 925, 193 USPQ 331, 332 (CCPA 1977); In re Burndy Corp., 300 F.2d 938, 133 USPQ 196, 197 (CCPA 1962); and Daimler-Benz AG v. Chrysler Corp., 169 USPQ 686, 688 (TTAB 1971). Such an "eyeball analysis," as applicant terms it in its initial brief, is of course an inherently subjective test, see, e.g., Daimler-Benz AG v. Ford Motor Co., 143 USPQ 453, 456 (TTAB 1964), but it is still subject to the familiar rule that a side-by-side comparison of the marks is improper. See, e.g., Diamond Alkali

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the remaining eight exhibits are untimely under Trademark Rule 2.142(d), which provides that evidence submitted after an appeal has been filed will ordinarily not be considered by the Board. Applicant, in its reply brief, has offered no reason why it failed to furnish such exhibits prior to its filing of the appeal. Accordingly, while all but the first of the exhibits will not be considered further, we note in any event that even if such evidence had been timely submitted, it would make no difference in the outcome of this appeal inasmuch as resolution of the issue of likelihood of confusion must be based upon the marks and any descriptions thereof as set forth in the application and cited registrations. See, e.g., Cities Service Co. v. WMF of America, Inc., 199 USPQ 493, 494 (TTAB 1978) at n. 3 ["question of likelihood of confusion must be determined on the basis of applicant's mark sought to be registered rather than on the basis of the manner in which the mark is actually used"]; In re U.S. Plywood-Champion Papers Inc., 171 USPQ 762, 763 (TTAB 1971) ["Board's determination of the question of likelihood of confusion must be based on a consideration of the mark sought to be registered rather than on the basis of the manner in which the mark is used"; likewise, "the presumptions afforded a registration ... manifestly can extend only to the registered mark"]; and Martha White, Inc. v. American Bakeries Co., 157 USPQ 215, 217 (TTAB 1968) at n. 6 ["question of likelihood of confusion must be predicated on the basis of the mark applied for and not the mark as actually used"].

Co. v. Dundee Cement Co., 343 F.2d 781, 145 USPQ 211, 213 (CCPA 1965). Instead, because consumers ordinarily will not be exposed to the respective marks in such a manner, it is the similarity of the general overall commercial impression engendered by the appearance of each of the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks or service marks. See, e.g., In re United Service Distributors, Inc., 229 USPQ 237, 239 (TTAB 1986); and In re Solar Energy Corp., 217 USPQ 743, 745 (TTAB 1983). Moreover, while product configuration marks, unlike most other design marks, are three dimensional rather than two dimensional, it is still the case that, for purposes of determining whether there is a likelihood of confusion, it is the perspective views shown by the reproductions of the marks in the application and cited registration(s) which must be considered. See, e.g., Daimler-Benz AG v. Ford Motor Co., supra at 455 [marks used as three-dimensional hood ornaments and/or insignias on automobiles].

Applicant argues that, in terms of appearance, its "mark has a shape unlike any other charcoal grill" in that "it consists of a football shaped kettle with a mug shaped ash catcher attached to its underside." Registrant’s marks, by contrast, "resemble an acorn," according to applicant. Thus, when encountered in the marketplace, applicant maintains that

because "these different shapes give consumers different overall visual impressions," there is no likelihood of confusion. In this regard, applicant additionally contends that the descriptions of the marks highlight the differences in the respective product configurations, noting that:

> Applicant has described its mark as an "oval, egg-shaped kettle and an attached ash catcher" while [registrant] Weber has described its grill as a kettle including "a bottom of generally semi-ellipsoid shape." When these descriptions are analyzed in connection with the grills themselves, it is obvious that the two marks create distinctly different commercial impressions. For example, Applicant's grill kettle has symmetrical halves. The top is as deep as the bottom, and each is a mirror image of the other. The Weber grill, on the other hand, has asymmetrical portions. The bottom of the Weber grill is much deeper than its top and its top looks like the capped top of an acorn sitting on its conical shaped bottom.
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> Although the Examiner tried to justify his conclusion of visual similarity by drawing attention to the semantical similarity of each mark's description, he failed to evaluate the overall appearance of the grills themselves. These marks are three dimensional products, and in the three dimensional world, these marks are different.

Applicant also insists that the Examining Attorney failed to give consideration to the fact that, as set forth in the declaration of its vice president of sales and marketing, John Waugh, the respective products have co-existed in the marketplace for nearly ten years without any reported incidents of actual confusion. Specifically, in addition to noting that applicant has continuously used "the applied-for design mark since 1989, Mr. Waugh declares, among other things, that since such time, applicant has spent "well over $100,000" in

advertising and promotion of the products bearing the mark; that "[h]undreds of thousands of Applicant's goods bearing the mark have been sold" "through a wide variety of stores, including discount department stores, specialty hardware stores and home improvement stores"; that such stores "enjoy high consumer traffic"; that, in consequence thereof, "literally millions of customers and potential customers have had the opportunity to see Applicant's mark on the goods and associate it as an indication of origin"; that sales growth has been "continuous and steady," with the product line having been expanded from one to four models; that applicant "is the only source in the industry for a charcoal grill with an oval kettle"; that applicant's competitors "use rectangular or circular shapes for grills"; and that "[f]rom discussions with dealers and retailers, Declarant is informed and believes that ... customers rely on the mark in selecting the goods of Applicant from among goods of Applicant's competitors." Thus, according to applicant, "t]here is no evidence that consumers faced with the competing products of Applicant and Weber have experienced any confusion."

Finally, applicant urges that because barbecue or charcoal grills are "large and relatively expensive" items, consumers will exercise discriminating care in their purchasing decisions. In particular, applicant contends that:

> Consumers of Applicant's and Weber's grills will inspect these items more closely than they would if they were smaller and less costly, and they will take note of differences between the two. In short, purchases of the grills in question here will be studied purchases. A finding of

> likelihood of confusion is simply not possible.

The Examining Attorney, while conceding at the oral hearing that he has no proof of the asserted fame of registrant's charcoal grills, argues in his brief that "[a] subjective, visual observation of the respective configurations clearly indicates to the average consumer that the goods would have a common source, especially when considering only those aspects which are claimed as ... feature[s] of each design, and which are shown in the drawings [of the marks] by solid lining only." Specifically, and citing a definition which he made of record from The Random House College Dictionary (rev. ed.), which defines the term "oval" as an adjective meaning "**1.** having the general form, shape, or outline of an egg; egg-shaped. **2.** ellipsoidal or elliptical," the Examining Attorney asserts that, as set forth in the final refusal (emphasis in original):

> While it is well-settled ... that the proper test of confusing similarity is never a "side-by-side" comparison, in this particular instance, even under those circumstances it is conceivable that confusion would result. When the ... drawings of the respective grill configurations are compared juxtaposed, the overall similarities between the kettle portions are strikingly similar. In this respect, applicant has emphasized that it's [sic] grill configuration is "oval" shaped, while the registrant's grill ..., as can be seen in the description of registrant's mark, ... refers to a "semi-spherical" bottom half shape and a "semi-ellipsoid top half shape. It is very interesting to note in this respect that the definition of "oval" refers to "ellipsoidal" as an equivalent term. .... In other words, it is apparent that the slight differences in the overall shape of the respective kettles is simply too subtle

> for the average prospective purchaser to remember in any given store setting (unless the parties[’] goods are displayed therein in a side-by-side setting. However, it is ... not unreasonable to assume that in such a setting[,] while the grills would appear to have <u>some</u> differences, it would be quite likely that said prospective purchasers would STILL assume that they emanate from the same source, and are merely a variation of the [registrant] manufacturer’s line of grills).

Although applicant, in its reply brief, asserts that "the consumer recognition afforded the Weber grill weighs heavily <u>against</u> a finding of confusing similarity" between registrant’s "acorn-shaped grill" and applicant’s "football-shaped grill," we are constrained to agree with the Examining Attorney that, when viewed in the perspectives presented by the application and the cited registrations, applicant’s barbecue grill configuration and registrant’s charcoal grill configurations are so substantially similar in their overall visual appearance that confusion is likely as to source or sponsorship. Moreover, while we concur with applicant that the semantic similarities in the descriptions of the prominent kettle portions of the respective designs are not dispositive, it nevertheless appears to us that the "oval, egg-shaped kettle" and mirror-image top of applicant’s barbecue grill configuration, when seen as a unit, look very much like registrant’s charcoal grill configurations when the "generally semi-spherical shape" of the bottom portion of the kettle and the "generally semi-ellipsoid shape" of the top portion thereof are likewise view together as a single unit. Taking into proper account the fallibility of the average consumer’s memory, and the fact that a side-by-side comparison of the respective designs may

not necessarily occur, we find that the overall commercial impression engendered by the barbecue grill designs at issue is substantially the same, especially when seen from the angles or viewpoints depicted in the application and cited registrations. We emphasize that this is the same perspective that prospective purchasers or users would view such products when standing in front of them.

As to applicant's contentions that there have been no incidents of actual confusion during a period of nearly ten years of contemporaneous use of the respective designs, suffice it to say that the Waugh declaration does not provide evidence that consumers faced with the competing products are able to readily distinguish between applicant's and registrant's charcoal grill configurations, or even that registrant's goods have in fact shared the same retail outlets over such time period. Moreover, while the purchase of a barbecue or charcoal grill of the kinds offered by applicant and registrant would not be the type of impulsive decision associated with relatively low cost, frequently replaced items, we disagree with applicant's assertion that the purchase of a grill for outdoor barbecuing or other cooking is such a painstaking and deliberate process that a great deal of care and discrimination would usually exercised by purchasers in making the decision to buy. The primary purchasers of applicant's and registrant's grills are members of the general public, who are simply looking for barbecue grills that they find pleasing and easy to use, and the features of such grills appear to be fairly standard and comparable. Thus, any discrimination

would relate principally to the price or cost of the goods rather than to their specific configuration.

Finally, we observe that even if consumers were to note the relatively inconsequential differences between the overall design of applicant's barbecue grills and the design of those offered by registrant, it would still be the case that, due to the substantial visual similarity between the configurations as they appear in the application and in the cited registrations, consumers familiar with registrant's goods would be likely, upon encountering applicant's goods, to regard applicant's goods as a new product or model line which emanates from or is sponsored by registrant.

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

R. F. Cissel

G. D. Hohein

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board