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ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Industrial Vacuum Systems, Inc.

Serial No. 75/814,403

James A. Mitchell and Marcus P. Dolce of Price, Heneveld,
Cooper, DeWitt & Litton for Industrial Vacuum Systems, Inc.

Wendy B. Goodman, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Chapman and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Industrial Vacuum Systems, Inc. has appealed from the
final refusal of the Trademark Examining Attorney to
register CARPET WIZARD as a trademark for "carpet cleaning
equipment, namely, shampooer, spot remover and vacuum
cleaner" in Class 9.¹ Registration has been refused on two
grounds: 1) applicant has failed to disclaim exclusive

¹ Application Serial No. 75/814,403, filed October 4, 1999, and
asserting first use and first use in commerce on April 26, 1996.

rights to the word CARPET [Section 6(a)] and 2) applicant's mark so resembles the marks STEAMWIZARD² and DIRTWIZARD,³ both previously registered by the same individual for "vacuum cleaners for domestic use and for industrial use, and vacuum cleaner attachments, namely, brush attachments and squeegee attachments, sold together as a unit," that, when used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive [Section 2(d)].

The appeal has been fully briefed. Applicant did not request an oral hearing.

We turn first to a procedural point. With its appeal brief applicant has submitted a large number of what it asserts to be third-party registrations and applications for marks consisting of or containing the word WIZARD. The Examining Attorney has objected to the documents as being untimely, pointing to Trademark Rule 2.142(d) which provides that the record in the application should be complete prior to the filing of an appeal. Applicant argues that these registrations were of record because it had stated in its response dated May 18, 2001 that "there are about 30 registrations for the mark 'WIZARD' alone" and that "the word 'wizard' is being used either alone or in

² Registration No. 2,040,301, issued February 25, 1997.

³ Registration No. 2,040,428, issued February 25, 1997.

combination with other words in almost 700 applications or registered marks.”

We agree with the Examining Attorney that the third-party applications and registrations were not properly made of record. Registrations (or a pplikations) may be made of record by submitting copies of the registrations (or applications) taken from the records of the United States Patent and Trademark Office. See **In re Duofold**, 184 USPQ 638 (TTAB 1984). We acknowledge that the Board has stated that if an applicant provides a listing of registrations and the Examining Attorney does not object to them, the Examining Attorney will be deemed to waive any objection to their improper form. However, we do not equate the mere argument that there are a large number of third-party applications and registrations with a listing of such applications and registrations, and we do not deem the Examining Attorney’s decision not to address this argument as an acceptance of them into the record.

Further, we also note that applicant’s submissions with its appeal brief are not taken from the records of the United States Patent and Trademark Office, but from a private company’s records, and therefore are not evidence of the existence of the registrations and applications. More importantly, even if the submissions had been timely

submitted and were in proper form, they do not serve to show that the cited mark is weak. Third-party applications are only evidence that the applications have been filed. As for the registrations, they are for very different goods from those of the registrant and applicant. See, for example, the following goods in the registrations which were particularly set out by applicant in its brief: computer driven CD radio for use by highway authorities for travelers' advisories and safety information; coin operated gumball machines, toy gumball machines; computer programs for the engineering and operation of cellular wireless telecommunications systems; gamma counters for research and industrial use; automatic apparatus for sensing rain and controlling sprinkler operation; and laser-powered meters.

This brings us to the substantive issues on appeal. The Examining Attorney has required applicant to disclaim exclusive rights to the word "carpet" on the ground that this term is merely descriptive of applicant's goods. Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), provides that the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), prohibits the registration of a mark

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which is merely descriptive of the applicant's identified goods.

A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods with which it is used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought. **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986). See also, **In re Abcor Development Corp.**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Applicant contends that the word "carpet" is not merely descriptive of applicant's goods because its "goods are not carpet," reply brief, p. 1, and do not contain carpet. Applicant also asserts that the word "carpet" alone does not merely describe a purpose or use of applicant's goods, and that the word "carpet" alone requires imagination, thought or perception to reach a conclusion as to the nature of the goods.

We are not persuaded by these arguments. Applicant's goods, as is made clear by its identification, are carpet cleaning equipment. When the word "carpet" is viewed in connection with applicant's identified goods, it

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immediately conveys to purchasers a major characteristic of applicant's equipment, namely, that it is used to clean carpets. Accordingly, we affirm the requirement to disclaim the word "carpet."

Registration has also been refused on the basis that applicant's mark is likely to cause confusion with the marks STEAMWIZARD and DIRTWIZARD, both of which are registered for vacuum cleaners. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The goods identified in applicant's application and those in the cited registrations are all vacuum cleaners. Although applicant's equipment has a shampooing and spot removing capacity, the goods are essentially identical, and applicant does not argue to the contrary. These goods must be deemed to be sold in the same channels of trade, and to the same classes of consumers, which would include members of the general public.

We turn next to a consideration of the marks, keeping in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). We also keep in mind the well-established principle of trademark law that, although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We find that the word WIZARD is the dominant feature in all three marks. In applicant's mark, as we have previously stated, the word CARPET is descriptive of the carpet cleaning equipment, and is less likely to be viewed as a source identifier than is the word WIZARD. Similarly, in the cited marks, STEAM describes a feature of a vacuum cleaner (i.e., it may clean by steam), while DIRT indicates what the cleaner removes. Because of the descriptive or highly suggestive nature of these prefixes, consumers will look to the word WIZARD as having a greater origin-indicating significance.

We recognize that because of the differences in the initial elements of applicant's and the registrant's marks they have certain differences in appearance, pronunciation and connotation. However, each mark has strong similarities also. Each begins with a descriptive or highly suggestive word for the cleaning equipment, followed by the word WIZARD. Because of this, overall the marks are similar in appearance, pronunciation and connotation. Moreover, applicant's mark and the cited marks convey very similar commercial impressions. Consumers who are aware of the registrant's vacuum cleaners sold under the marks STEAMWIZARD and DIRTWIZARD are likely to believe, when they see the mark CARPET WIZARD used on a shampooer, spot remover and vacuum cleaner, that this is another product produced by the registrant, an extension of the registrant's STEAMWIZARD and DIRTWIZARD line of cleaners.

With respect to applicant's argument that the term WIZARD is commonly adopted as a mark, or as part of a mark, the only evidence of third-party registrations which is properly of record (see discussion supra) is two WIZARD marks registered by a single entity for air deodorizers, rug and room deodorizers, and one registration for WIZARD for various kinds of dust cloths and floor mops. The goods in these registrations are certainly not as similar to the

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registrant's goods as are applicant's; further, we cannot conclude on the basis of what are, in effect, only two registrations, that WIZARD is such a weak mark that consumers will look to the descriptive or highly suggestive elements in the marks to distinguish applicant's mark from the registrant's when the marks are used on virtually identical products.

Accordingly, we find that applicant's mark CARPET WIZARD, when used on carpet cleaning equipment, namely, shampooer, spot remover and vacuum cleaner, is likely to cause confusion with the marks STEAMWIZARD and DIRTWIZARD for vacuum cleaners.

Decision: The refusals of registration based on likelihood of confusion and the requirement for a disclaimer are affirmed. If applicant submits a disclaimer of CARPET within thirty days of this decision that portion of our decision affirming the requirement for a disclaimer will be set aside. See Trademark Rule 2.142(g).