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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 75/334378

APPLICANT: SPECIALTY COATING SYSTEMS, INC.



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

CORRESPONDENT ADDRESS:

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MARK: OMEGA METER

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Specialty Coating Systems, Inc.,¹ has appealed the trademark examining attorney's final refusal on the Principal Register to register the trademark OMEGA METER AND DESIGN for *apparatus for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies*, in International Class 9, on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), with the United States Trademark

¹ The applicant is in the process of filing a correction or clarification to Assignment Frame/Reel No. 3240/0101. The correction or clarification is to explain the chain of title from the original applicant, Alpha Metals, Inc., to the current-listed applicant, Specialty Coating Systems, Inc.

Registration No. 2022762. The cited registration is OMEGA for a *variety of industrial and electronic parts and equipment, including ionic analyzer*, in International Class 9. See Attachment A for complete identification of goods. The examining attorney attaches a copy of the registration at the end of this brief. See Attachment B.

FACTS

On August 1, 1997, the applicant, Specialty Coating Systems, Inc., applied to register on the Principal Register the trademark OMEGA METER AND DESIGN for *apparatus for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies*, in International Class 9.

In an Office Action issued on May 4, 1998, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on the identified goods, so resembles the mark in United States Registration No. 2022762 for OMEGA for *a variety of industrial and electronic parts and equipment, including ionic analyzer*, in International Class 9, as to be likely to cause confusion, to cause mistake, or to deceive. On July 31, 1998, the applicant responded to the refusal by arguing that the applicant's mark does not cause a likelihood of confusion with the cited registered mark. After carefully reviewing the applicant's response but finding it unpersuasive, on November 20, 1998, the examining attorney issued a final refusal under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). On May 20, 1999, the applicant filed a Notice of Appeal and a Request for Reconsideration.

On September 29, 1999, the prosecution of this application was suspended pending the cancellation proceeding of the cited mark, Reg. No. 2022762 (Cancellation

Proceeding No. 92027575). On February 17, 2006, the Cancellation proceeding was dismissed. On March 4, 2006, the application was remanded to the examining attorney for determination of the applicant's request for reconsideration filed on May 20, 1999. The examining attorney denied the applicant's request for reconsideration. On June 12, 2006, the applicant filed its appeal brief.

The applicant's predecessor-in-interest, Kenco Alloy & Chemical Co., Inc., owned

Registration No. 1045835, which was for the same mark and same goods² as this present application. Reg. No. 1045835 was active from October 20, 1975 to April 6, 1998 and has expired

for failure to file a renewal.

ARGUMENT

The applicant's arguments in support that there is no likelihood of confusion are (1) an examining attorney had concluded previously that the parties' marks may coexist on the Principal Register, (2) the marks designate different goods and target different groups of purchasers, and (3) the parties' long coexistence without evidence of confusion demonstrates that there would be no likelihood of confusion.

(1) Decisions Involving Prior Registrations Are NOT Controlling

² The now-expired prior registration (Reg. No. 1045835) that was owned by the applicant's predecessor-in-interest, Kenco Alloy & Chemical Co. Inc., was OMEGA METER AND DESIGN for apparatuses for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies, in International Class 9.

The applicant argues that because the cited registration coexisted with a now-expired prior

registration owned by the applicant's predecessor-in-interest, this present application should also

be allowed to coexist with the cited registration. The now-expired prior registration Reg. No.

1045835 was active from October 20, 1975 to April 6, 1998. The cited registration, Reg. No.

2022762 has a filing date of January 21, 1994. There was contemporaneous registration of five

years.

Prior decisions and actions of other trademark examining attorneys in registering marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

It states in Trademark Manual of Examining Procedure § 1216.01:

Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (C.C.P.A. 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.*, 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000).

Each case must be decided on its own facts. The Office is not bound by the decisions of the examiners who examined the applications for the applicant's previously registered marks, based on different records. *See . . . In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (likelihood of confusion between applicant's EL GALLO for fresh tomatoes and peppers and the previously registered mark

ROOSTER for fresh citrus fruit, notwithstanding applicant's ownership of an expired registration of the same mark for the same goods)

Particularly, in *In re Perez*, 21 USPQ2d 1075 (TTAB 1991), the Trademark Trial and Appeal Board found likelihood of confusion between applicant's EL GALLO for fresh tomatoes and peppers and the previously registered mark ROOSTER for fresh citrus fruit, notwithstanding applicant's ownership of an expired registration of the same mark for the same goods.

The facts of *Perez* are very similar to the facts of this present application. The applicant in *Perez* owned a prior registration for the same mark and same goods as the application on appeal, but the prior registration had expired due to a failure to renew the registration. During the active period of this prior registration, there was a fifty-year period of contemporaneous registration and coexistence with the cited mark. However, the Board held that “[a]s to the years of contemporaneous registration, we are, of course, not bound by an Examining Attorney’s prior determination as to registrability.”³

Similarly, in this present application, the prior registration of the applicant’s predecessor-in-interest expired due to a failure to renew the registration. Further, the mark and goods of the prior registration are identical to this present application. While there was a contemporaneous registration of fifty years in *Perez*, there was contemporaneous registration of five years. The significant facts of *Perez* and this present application cannot be more similar than they are.

Therefore, as the Board is not bound the determination by an examining attorney, the Board should decide that the registration of this present application should not be

³ *Id.* at 1076.

decided on prior determinations but on its own facts and on its own merits, based on the relevant factors of *DuPont*.

(2) The Marks Designate Goods That Are Very Similar

The applicant argues in the alternative that there is no likelihood of confusion because the goods of the parties are sufficiently unrelated and are directed to different potential customers. Instead of in the alternative, the Board should decide only upon the relevant factors of *DuPont*, namely, the similarity of the marks and the close relationship between the applicant and registrant's goods.

The applicant does not appear to dispute the similarity of the marks. Both share the wording "OMEGA." The applicant has disclaimed the exclusive right to use "METER" in "OMEGA METER." The disputable factor is the close relationship of the goods.

The applicant argues that even if the marks of the parties are identical, there is no likelihood of confusion where the goods are sufficiently unrelated and are directed to different potential customers. This is correct statement of law. However, in this present application, the goods of the parties are more than sufficiently similar and are directed to related potential customers.

As demonstrated in the evidence of third-party registrations submitted previously, there is a close relationship between the applicant's goods - *apparatus for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies* - and registrant's goods - *ionic analyzer*. This evidence has probative value to the extent that they serve to suggest that the goods listed therein are of a kind that may

emanate from a single source. See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). For the Board's convenience, the examining attorney has attached the previously-submitted evidence. See Attachment C.

The applicant argues that the applicant's customers are sophisticated purchasers, namely, "quality and process engineers of electronics manufacturers." 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 *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Just as sophisticated as the applicant's customers may be, the registrant's customers may be just as sophisticated.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980). Because the registrant's goods are not limited to a specific normal channel of trade, the registrant's goods may also be marketed towards the same sophisticated, highly-trained and educated professional purchasers.

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii).

The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Although the applicant has argued that the applicant's customers are sophisticated purchasers, the applicant has not sufficiently demonstrated that the goods of the parties are neither closely related nor target different sophisticated purchasers.

(3) Absence of Actual Confusion Is Not Dispositive

The applicant argues there is no evidence of actual confusion within the thirty years of coexistence. However, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case).

Id. at 1026-1027.

In *In re Perez* (cited earlier), even with fifty years of contemporaneous use without actual confusion, the Board concluded that there is likelihood of confusion and stated:

[T]he absence of actual confusion is but one factor in our analysis which, in the case before us, is outweighed by the other factors bearing on likelihood of confusion. In any event, the issue before us is not one of actual confusion, but only the likelihood of confusion.

In re Perez, 21 U.S.P.Q.2d 1075, 1976 (TTAB 1991).

In this present application where the facts are very similar to *Perez*, the factor of actual confusion may be somewhat probative, but it is outweighed by the more significant factors, namely, the close similarity of the marks and the close relationship of the goods.

CONCLUSION

The marks are sufficiently similar. The good of the parties are closely related. Although the applicant has stated the applicant's customers are sophisticated purchasers, the applicant has not sufficiently demonstrated that the registrant's goods are dissimilar from, or unrelated to, the applicant's goods.

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), for the reason that there is a likelihood of confusion, should be affirmed.

Respectfully submitted,

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