

TRADEMARK
Eng 10-002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Appellant	Engelhard Corporation
Mark:	PORTFOLIO
Serial No.	75/615,079
Examining Attorney	Andrew J. Benzmilller
Trademark Law Office	113

Commissioner For Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513



03-22-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal to the Trademark Trial and Appeals Board from a final decision by the Examining Attorney dated 24 July 2001 in the above-identified trademark application who has refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the basis that appellant's mark, when used on or in connection with the identified goods, so resembles the mark in United States Registration No. 2,290,382, as to be likely to cause confusion, to cause mistake, or to deceive.

CERTIFICATION UNDER 37 C.F.R. SECTION 1.10

"Express Mail" mailing label number EU 072053250VS.

Date of Deposit 22 March 02.

I hereby certify that this Brief on Appeal Letter, and the documents referred to as enclosed, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 C.F.R. Section 1.10 on the date set out above and is addressed to the: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Richard R. Muccino

(typed name of person mailing papers)

(signature of person mailing papers)

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The Rejection

The Examining Attorney has refused registration under Section 2(d), 15 U.S.C. Section 1052(d), because the Examining Attorney states that appellant's mark (PORTFOLIO), when used on or in connection with the identified goods, so resembles the mark in United States Registration No. 2,290,382 (PORTFOLIO COLLECTION) as to be likely to cause confusion, to cause mistake, or to deceive consumers as to the source of the goods.

The Examining Attorney states that appellant's mark PORTFOLIO and the cited mark PORTFOLIO COLLECTION create confusingly similar overall impressions because they share the identical distinctive term PORTFOLIO. The Examining Attorney argues that the additional term COLLECTION in the cited mark is merely descriptive, and has been disclaimed, and plays a much smaller role in creating that mark's overall impression.

The Examining Attorney argues that the fact that the goods of the parties differ is not controlling in determining likelihood of confusion but rather that the issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. See *In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP section 1207.01.

In this case, the Examining Attorney contends that appellant's arguments regarding its goods and those of the registrant are unpersuasive. While the goods may not be not identical, the Examining Attorney argues that they are clearly complementary in that appellant's goods are used to select "architectural coatings," which the specimen of record shows would include the very goods identified in the cited registration, namely, paints, stains and varnishes. The Examining Attorney states that both types of goods are commonly sold under the same mark by the same parties. The Examining Attorney argues that the Trademark Trial and Appeal Board has stated that third party registrations have probative value in showing that goods or services are of a type that emanate from a single source. *In re Donnay Int'l S.A.*, 31 USPQ2d 1953 (TTAB 1994); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

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The Examining Attorney concludes that appellant's mark and the cited mark create confusingly similar overall commercial impressions. The Examining Attorney states that contemporaneous use of two such similar marks on closely related and complementary types of goods is likely to cause confusion as to the source of the goods. The Examining Attorney has made the refusal under Section 2(d) final.

Response

The Examining Attorney argues that appellant's mark PORTFOLIO is likely to be confused with the mark PORTFOLIO COLLECTION in United States Registration no. 2,290,382. The mark PORTFOLIO COLLECTION, issued to Orchard Supply Hardware Corporation, is registered for use in connection with "interior and exterior paints, stains, and varnishes in International Class 2". The Examining Attorney argues that appellant's mark PORTFOLIO and the registered mark PORTFOLIO COLLECTION are highly similar in overall appearance and commercial impression because both contain the identical term PORTFOLIO. The Examining Attorney contends that the goods are closely related because the appellant's goods are intended for use in selecting goods such as the registrant's paints, stains, and varnishes. The Examining Attorney concludes that overall, the similarities between the marks and the goods are so great that consumers seeing the mark PORTFOLIO COLLECTION on paints, stains and varnishes, and the mark PORTFOLIO on color strips and cards for use in selecting paints and other coatings, would mistakenly believe that the two types of goods come from the same or a related source. Appellant traverses the Examining Attorney's rejection.

In determining whether one mark is so similar to another so as to result in a likelihood of confusion, mistake or deception, the Examining Attorney must typically analyze the marks according to the factors set out in *In re E.I. duPont de Nemours & Co.*, 476 F.2d. 1357,1361, 177 U.S.P.Q. 563,567 (C.C.P.A. 1973), See: *In re Bed and Breakfast Registry*, 791 F.2d. 157, 159, 227 U.S.P.Q. 818 (Fed. Cir. 1986). *E.I. duPont* set out thirteen evidentiary factors which should be considered by the Examining Attorney in determining likelihood of confusion. *E.I. duPont* at 567. Each of the factors may from case to case play a

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dominant role. *Id.* Although it is law that the first step in making a determination as to the likelihood of confusion is a consideration of the marks themselves, that is, their "appearance, sound, connotation and commercial impression," it is also the law that the "question of confusion is related not to the nature of the mark but to its effect `when applied to the goods of the appellant.' The only relevant application is made in the marketplace." *E.I. duPont at 563* (emphasis in original).

Appellant's goods and registrant's goods do not travel in the same channels of trade and the conditions surrounding their marketing are such, that they are not encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. Specifically, appellant's mark PORTFOLIO is for use with printed merchandising aides used in connection with the display/advertising of architectural coatings while registrant's mark PORTFOLIO COLLECTION is for use on paints, stains and varnishes. Accordingly, purchasers are not likely to believe that goods sold under the respective marks come from the same source and therefore, a likelihood of confusion between the marks does not exist.

Although both appellant's mark and the registered mark incorporate, in some fashion, the word "PORTFOLIO", it is well settled that a mark should not be dissected but rather must be considered as a whole in determining likelihood of confusion. *MaCon v Avon*, 4 U.S.P.Q. 1474, 1476 (TTAB 1987) citing *Mint Corp v. Master Manufacturing Co.*, 667 F. 2d 1005, 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981); *In Re Bed & Breakfast Registry*, 229 U.S.P.Q. 2d 818 (the common elements of the marks, even if descriptive cannot be ignored). Consideration of the marks as a whole includes consideration of the word "PORTFOLIO", which suggests to the consumer in the marketplace that the mark is used in connection with loose papers, pictures, or pamphlets. Although these words are descriptive of the goods offered "arguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between only what remains is an erroneous approach." *Spice Islands, Inc. v. The Frank Tea and Spice Co.*, 505 F.2d 1293, 184 U.S.P.Q. 35, 37 (C.C.P.A. 1974). Clearly these descriptive words are important here because they give meaning to the marks in question.

If, however, the Examining Attorney were to focus on "PORTFOLIO", the portion of the mark shared by both appellant and registrant,

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consideration should also be given to the scope of protection to which the mark is entitled. When coined or arbitrary marks are involved, similarity between marks in meaning or significance may be sufficient to deny registration. On the other hand, prior use and registration of a descriptive or highly suggestive term cannot preclude the subsequent registration of a similarly suggestive, but otherwise distinguishable term or trademark for like or similar goods. *Penn Dairies, Inc. v. Pennsylvania Agriculture Marketing Cooperative*, 200 U.S.P.Q. 462 at 466 (TTAB 1978).

As noted by the C.C.P.A. in *Sure-Fit Products Co. v. Saltzson Drapery Company*, 117 U.S.P.Q. 295 (C.C.P.A. 1958):

"It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights."

In this case, the term "PORTFOLIO", used as part of appellant's mark PORTFOLIO and as the registered mark PORTFOLIO, is highly suggestive of the goods offered by the parties and is therefore entitled to a narrow scope of protection. Accordingly, the Examining Attorney's refusal to register appellant's mark on the basis that the mark would cause a likelihood of confusion as to source should be withdrawn.

Conclusion

A review of the relevant *E.I. duPont* evidentiary factors demonstrates that there is no likelihood that use of the mark PORTFOLIO will cause confusion, deception or mistake on the part of consumers in the marketplace. When examined in their entirety, appellant's mark PORTFOLIO and registrant's mark PORTFOLIO COLLECTION are seen not to travel in the same channels of trade and the conditions surrounding their marketing are such, that they are not encountered by the same purchasers under circumstances that could give rise to the mistaken belief

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that the goods come from a common source. Accordingly, there would be no likelihood of confusion. In view of the foregoing response, appellant requests withdrawal of the Examining Attorney's refusal to register appellant's mark and publication of the mark pending in this application.

Appellant requests the Examining Attorney to telephone the undersigned attorney should the Examining Attorney have any questions or comments which might be most expeditiously handled by a telephone conference.

ENGELHARD CORPORATION



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TRANSMITTAL LETTER FOR APPELLANTS' BRIEF ON APPEAL

Sir:

Enclosed herewith please find appellants' Brief on Appeal pursuant to Section 2.142 for filing in the above-identified trade mark application. Appellants do not request an oral hearing.

Appellant's attorney authorizes the Examiner to charge Deposit Account no. 13-4822 if there are any additional charges in connection with this response. A duplicate copy of this Transmittal Letter is enclosed.

ENGELHARD CORPORATION

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