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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	116

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

APPELLANT'S REPLY BRIEF ON APPEAL

Sir:

This is a Reply Brief in 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 appellants 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. Appellant filed an Appeal Brief

CERTIFICATION UNDER 37 C.F.R. SECTION 1.10

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Date of Deposit 18 June 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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dated 22 March 2002 and the Examining Attorney filed an Appeal Brief dated 3 June 2002. This Appeal Brief is in reply to Examining Attorney's Appeal Brief.

The Rejection

The Examining Attorney has refused registration under Section 2(d), 15 U.S.C. Section 1052(d) of appellant's mark PORTFOLIO for use in connection with "printed merchandising aides used in connection with the display/advertising of architectural coatings, namely, color strips, color cards, color fan decks, formulation guides, and designer/architect kits, namely binders, color sheets, and color strips," in International Class 16. The Examining Attorney states that registration was refused based on a likelihood of confusion with the mark PORTFOLIO COLLECTION (Registration No. 2,290,382), for "interior and exterior paints, stains and varnishes," in International Class 2.2.

The Examining Attorney states that appellant's mark PORTFOLIO is highly similar in sound, appearance and overall commercial impression to the registered mark PORTFOLIO COLLECTION and the marks share the identical distinctive term PORTFOLIO. The Examining Attorney asserts that the term COLLECTION in the registered mark is merely descriptive and has been disclaimed. The Examining Attorney argues that the specimen of record in the present application shows that the term "collection" is commonly used as a descriptive or generic name for a group of related items and accordingly, the additional term COLLECTION in the registered mark is not sufficient to distinguish the marks to prevent confusion.

The Examining Attorney states that appellant's arguments that PORTFOLIO is merely descriptive and therefore entitled to only a limited scope of protection is unpersuasive. As applied to the registrant's goods, paints, stains and varnishes, the Examining Attorney contends that PORTFOLIO is in fact an arbitrary term, inasmuch as it does not have any readily discernible connection to the nature or characteristics of the goods. Moreover, the Examining Attorney maintains that there is no evidence of record that the term PORTFOLIO has been weakened or in any way diluted through widespread use on similar goods, and the registered mark is therefore presumed to be strong, and it is thus entitled to a

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relatively wide scope of protection. The Examining Attorney concludes that appellant's mark PORTFOLIO is identical to the dominant portion of the registered mark PORTFOLIO COLLECTION.

The Examining Attorney further states that appellant's goods are complementary, and are therefore closely related, to the registrant's goods because color strips and color cards such as appellant's are specifically designed and intended for use in selecting paints and stains such as those of the registrant. The Examining Attorney notes that appellant's goods are identified as "printed merchandising, aides used in connection with the display/advertising of architectural coatings, namely, color strips, color cards, color fan decks, formulation guides, and designer/architect kits, namely binders, color sheets, and color strips." The Examining Attorney concludes that the goods are thus used to select "architectural coatings" such as paints.

The Examining Attorney argues that the fact that appellant's mark PORTFOLIO is identical to the dominant portion of the registered mark PORTFOLIO COLLECTION, and differs only in the descriptive and disclaimed term COLLECTION, is more than sufficient to overcome the fact that appellant's goods and registrant's goods are not identical. The Examining Attorney states that when the marks of the respective parties are identical, or nearly so, as here, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. The Examining Attorney asserts that the identification of goods in the application and cited registration and the evidence of record establish that appellant's color strips, color cards, and other printed aides used in the selection of architectural coatings are complementary to the registrant's paints, stains and varnishes. The Examining Attorney concludes that appellant's goods are therefore closely related to the registrant's goods and accordingly, the test for whether there is a viable relationship between the goods is clearly met.

Response

The Examining Attorney argues that appellant's mark PORTFOLIO is likely to be confused with the mark PORTFOLIO COLLECTION in United

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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 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).

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.

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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, 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.

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Contrary to the Examining Attorney's position, appellant contends that the term "PORTFOLIO" is not arbitrary. By the Examining Attorney's own admission, the term "PORTFOLIO" means a "portable case for holding material, such as loose papers, photographs, or drawings... The materials collected in such a case, especially when representative of a person's work: a photographer's portfolio; an artist's portfolio of drawings." Appellant's mark PORTFOLIO is for use in connection with "printed merchandising aides used in connection with the display/advertising of architectural coatings, namely, color strips, color cards, color fan decks, formulation guides, and designer/architect kits, namely binders, color sheets, and color strips." This is the definition of a PORTFOLIO. 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.

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. Moreover, appellant's mark PORTFOLIO is classified in International Class 16 while the Registrant's PORTFOLIO COLLECTION is classified in International Class 2.2. 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.

Conclusion

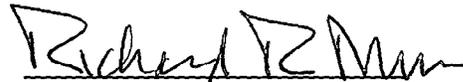
A review of the relevant *E.I. duPont* evidentiary factors demonstrates that there is no likelihood that use of the mark PORTFOLIO will cause confusion, deception or mistake on the part of consumers in the marketplace. When examined in their entirety, appellant's mark PORTFOLIO and registrant's mark 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

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the same purchasers under circumstances that could give rise to the mistaken belief 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' REPLY BRIEF ON APPEAL

Sir:

Enclosed herewith please find appellants' Reply Brief on Appeal pursuant to Section 2.142 in response to the Examining Attorney's Appeal Brief dated 3 June 2002 for filing in the above-identified trade mark application.

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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Richard R. Muccino

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(typed name of person mailing papers)

(signature of person mailing papers)