

UNITED STATES PATENT AND TRADEMARK OFFICE

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SERIAL NO: 76/417366

FEB 27 2004

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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.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shark Abrasion Systems Pty Ltd :
 Trademark: SHARK :
 Serial No: 76-417366 :
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**BEFORE THE
 TRADEMARK TRIAL
 AND
 APPEAL BOARD
 ON APPEAL**

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed to the Trademark Trial and Appeal Board (hereinafter the "Board") the trademark examining attorney's final refusal to register the mark, SHARK, for "earthmoving equipment namely mechanical excavators and loaders; ground engaging tools for use with mechanical diggers and loader namely shrouds, lips, adaptors and teeth." The examining

attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark is likely to be confused with the mark in Registration No. 2083884, SHARK CHAIN for "chain comprised of digging bits for trenching machine."

ISSUE

The sole issue on appeal is whether or not the applicant's mark, SHARK, for "earthmoving equipment namely mechanical excavators and loaders; ground engaging tools for use with mechanical diggers and loader namely shrouds, lips, adaptors and teeth" is confusingly similar to the mark in Registration No. 2083884, SHARK CHAIN, for "chain comprised of digging bits for trenching machine," thus causing a likelihood of confusion between the respective marks.

ARGUMENTS

I. THE APPLICANT'S MARK IS LEGALLY IDENTICAL TO REGISTRANT'S MARK

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMEP § 1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

The applicant's mark is, SHARK, while the registrant's mark is SHARK CHAIN. The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986).

Here, SHARK is the dominant feature of both marks. It is the entirety of applicant's mark, and is the first and dominant term in registrant's mark. Moreover, the applicant has merely deleted the generic element, CHAIN, from the registered mark. Disclaimed matter, such as the word CHAIN in the registrant's mark, is typically less significant or less dominant. Despite this minor change, the commercial impression is the same.

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b). The applicant's mark in full is SHARK, while purchaser's general recollection of the registrant's mark will be of the word SHARK. Accordingly, the marks creates

the same commercial impression of a single source of ownership that a likelihood of confusion would result among purchasers.

II. THE MARKS ARE USED ON RELATED GOODS

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

The applicant's goods are identified in the application as "earthmoving equipment namely mechanical excavators and loaders; ground engaging tools for use with mechanical diggers and loader namely shrouds, lips, adaptors and teeth," while the registrant's goods are "chain comprised of digging bits for trenching machine." In the Office Action of May 8, 2003 that maintained the final refusal of registration, the examining attorney enclosed twenty-four third party registrations which indicated that applicant's goods and registrant's goods are frequently sold under the same mark. These registrations demonstrate that the goods are within the normal fields of expansion and can be traced to one source provider. Third-party registrations that cover a number of different goods or services have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The examining attorney has submitted numerous Nexis® articles (hereinafter known as “articles”) in the final Office Action of May 8, 2003 and December 4, 2003 showing the relatedness of the goods. First, “trenching machines” and “earthmoving equipment” such as excavators, diggers and loaders are generally machines manufactured, sold and used in the same channels of trade. In fact, some trenching machines may also refer to earthmoving equipment, excavators, diggers and loaders and vice versa. Secondly, the articles do indicate that chains are used on excavators, loaders and diggers. The broadness of registrant’s identification, namely “trenching machines” encompasses those goods in applicant’s identification, namely “excavators, diggers and loaders.” The examining attorney must determine whether there is a likelihood of confusion on the basis of the goods identified in the application and registration. 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, 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 Elbaum*, 211 USPQ 639 (TTAB 1981). TMEP §1207.01(a)(iii). Since there are no limitations in the identification by registrant with respect to the type of goods and channels of trade, then there is the presumption that registrant’s goods are “chains for excavators, diggers, loaders” and other earthmoving equipment. *See In re Elbaum, supra*. Furthermore, it is apparent from the articles that shrouds, lips, adaptors and teeth are common component parts of trenching machines. Accordingly, prospective purchasers of the applicant’s goods and registrant’s goods would mistakenly believe the goods come from a single source as to cause a likelihood of confusion.

The examining attorney submits that the applicant’s contention that purchaser of the applicant’s and the registrant’s goods are sophisticated is likewise unpersuasive. 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). Finally, it is well settled that the Board must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

CONCLUSION

The applicant's mark, SHARK, when used on "earthmoving equipment namely mechanical excavators and loaders; ground engaging tools for use with mechanical diggers and loader namely shrouds, lips, adaptors and teeth," is confusingly similar to registrant's mark, SHARK CHAIN, for "chain comprised of digging bits for trenching machine," because the goods are of a type that likely move in similar channels of trade and are made available to all prospective purchasers. Purchasers are likely to have a mistaken belief that, under such circumstances, that the goods emanate from a common source or are somehow associated with the same producer. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register the applicant's mark under Trademark Act Section 2(d).

Respectfully submitted,

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