

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/498199

**APPLICANT:** Itoya of America, Ltd.

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

**MARK:** XENON

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 31730-187996

**CORRESPONDENT EMAIL ADDRESS:**

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 has appealed the trademark examining attorney's refusal to register the trademark XENON for writing pens on the ground that it so resembles U.S. Registration No. 2,340,074 – XENON for paper and cardboard – as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d), 15 U.S.C. §1052(d).

**FACTS**

On March 14, 2003, the applicant filed for registration of the typewritten mark XENON for writing pens based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). On September 16, 2003, the trademark examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* The reference mark is U.S. Registration No. 2,340,074 – XENON for paper and cardboard. The action also included a registration caveat regarding a prior pending application and a request for the applicant to indicate the significance of the proposed mark. In its response to the refusal filed December, 9, 2003, the applicant argued that there was no likelihood of confusion, that the proposed mark had no significance in relation to the specified goods, and that the prior pending

application had abandoned. The registration caveat was withdrawn. The significance requirement was inadvertently made final and the likelihood of confusion refusal was maintained and made final. The applicant then filed a request for reconsideration. With respect to the significance of the mark requirement, the final requirement was withdrawn. However, the final 2(d) refusal was maintained.

The applicant now appeals.

### ISSUE ON APPEAL

The issue for consideration in the instant appeal is whether the applicant's proposed mark, XENON, when used in connection with writing pens, so resembles the mark shown in U.S. Registration No. 2340074, for paper and cardboard, as to be likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act.

### ARGUMENT

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 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 relatedness of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are

compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.* All circumstances surrounding the sale of the goods are considered when considering the likelihood of confusion. *Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973). These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning is sufficient to find a likelihood of confusion. In comparing the goods, it is necessary to show that they are related in some manner. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755, 757 (TTAB 1977); TMEP §§1207.01 *et seq.*

There is no legitimate issue regarding the nature of the marks because they are identical – namely, the term XENON, in typewritten form. Hence, pivotal in this case is whether the relatedness of the goods nexus is satisfied.

#### Relatedness of the Goods Standard is Satisfied

In comparing the relatedness of the goods, the standard does not require that the goods 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. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *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). Here, that standard has been met.

## The Plain/Ordinary Meaning of the Goods Determine their Scope

When comparing the goods, the determination of whether there is a likelihood of confusion is made solely on the basis of the goods identified in the application and registration. However, such comparison is made without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). Where the cited registration describes the goods broadly and there are no limitations as to their nature, type, and 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).

Here, in comparing the goods identified – namely, writing pens, paper and cardboard - the relatedness of the goods nexus is satisfied because the goods are marketed and sold to similar customers, through similar channels of trade and are of the type that emanate from the same source. However, in its interpretation of the registered goods, the applicant improperly restricts the registered goods by narrowly interpreting of the wording “paper and cardboard” to only those goods that are a combination of both paper and cardboard.

Relying upon the Trademark Acceptable Identification of Goods and Services Manual (hereinafter, the “ ID Manual”), the applicant argues that the registered mark is not related to the proposed mark because the goods in the registration, are limited to only those goods specifically described as “paper and cardboard.” However, this narrow interpretation is an improper restriction. The ID MANUAL provides descriptions that are mere suggestions as to wording that is sufficiently definite. It provides suggestions of precise wording that may be accepted and wording that by analogy and example, suggests the kinds of identifications that will be acceptable for products and services not covered by the existing listings. TMEP § 1402.04. The ID Manual does not define the particular nature of specific goods but is merely a listing of common terms that may be relied upon, based upon the ordinary meaning of the wording and is not intended as an exhaustive listing. TMEP §1402.01 and TMEP §1402.04. Moreover, punctuation does not determine acceptability as certain characters are not permitted TMEP 1402.01(a) and TMEP 1402.12. Hence, when construing the scope of the registered goods in this case, based upon their ordinary meaning, the registered goods includes paper, cardboard, and goods that may

be commercially described as paper and cardboard, which are closely related to the applicant's goods. This interpretation is consistent with the plain meaning of the wording provided in the ID Manual and the registration.

In ascertaining the scope of the goods specified, other acceptable identifications provide guidance. Both paper and cardboard, without any additional specification, are each acceptable terms used to identify goods as described in the ID Manual. The examining attorney request that the board take judicial notice of the ID Manual and the pertinent parts attached hereto. The record evidence shows that various types of paper and cardboard all fall within the scope of "paper and cardboard" as specified in the registration and ID Manual. Please see the previously provided dictionary definition of the term "paper" as provided in the Final Office Action dated February 10, 2004.

At its broadest, "paper" describes those sheet-type materials used chiefly for writing, printing, drawing and wrap.[1] "Cardboard" describes a thick, stiff paper that is made of pressed paper pulp or pasted sheets of paper. The examining attorney requests that the Board take judicial notice of the attached dictionary definitions for the word "cardboard." Because no limiting wording – such as writing paper, wrapping paper, art paper, and corrugated cardboard, packing cardboard, or cardboard boxes – is included in the registration, the applicant's limitation is an improper restriction of the goods. Hence, in considering the goods, both paper and cardboard each fall within the category of goods described in the registration and to which the proposed goods are compared.

#### Applicant's and Registrant's Goods are Related Goods

When the proposed and registered goods are compared, the relatedness of the goods nexus is satisfied. The record third-party registrations and trade channel evidence show that the applicant's writing pens are related to the registrant's paper and cardboard.

The third-party registrations show that the applicant and registrant's goods are the type of goods that emanate from a single source. As shown by Registration Nos. 2670300, 2616033, 2530003, 2750335, 2333560, 1440584, 1447416, 2492654, 2547610, 2613352, 2272505, 2223455, 1813651, 1263574, 0631799 and 2588594, stationery and writing paper are the type

of goods that emanate from a common source. Registration No. 2736644 shows the relatedness between writing instruments and paper by specifying computer paper, flip paper charts and pens. Other third-party registrations show that writing pens similar to the applicant's, are related to similar paper and cardboard goods that fall within the scope of office product goods identified as paper and cardboard. These third-party registrations are probative in showing the relatedness of the goods. 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).

In addition, the record also includes trade channel evidence that shows that the goods are marketed and sold in the same channels of trade and to the same and/or similar consumers. The record includes website information from various office supply retailers. The evidence shows that the "paper and cardboard" refers to various type of paper products that is consistent with those goods that are either paper, cardboard or combinations of paper and cardboard. Moreover, printing stock paper, writing paper and other forms of art papers are included within the category of products identified as "paper and cardboard." Hence, the evidence shows that within the relevant industry, the wording is not used to generically identify some other good that is limited to only those goods comprised of a combination of paper and cardboard as suggested by the applicant.

The evidence shows the wording "paper and cardboard," identifies paper and various types of paper-stock, cardboard and paper sold with cardboard. In addition, the record evidence shows that the conditions surrounding the marketing is 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. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *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)

Although the evidence does not specifically show actual brands in commerce with the applicant's and registrant's goods

under the same mark, the combined third-party registrations and website evidence support the refusal. The third-party registrations and trade channel evidence show that the goods are the type of goods that emanate from a common source and are marketed and sold through common trade channels.

In establishing the relatedness of the goods, it is noted that the goods 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. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *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).

Moreover, where the marks of the respective parties are identical, as here, the relationship between the goods 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. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a). As such, because the marks are identical and the goods can be found in the same channels of trade, marketed to the same or similar customers, and are the type that emanate from a common source, the marks will confuse people into believing that the goods they identify come from the same source.

### CONCLUSION

The evidence of record shows that the marks convey the same commercial impression because they are identical. Moreover, the goods are closely related in that they that emanate from a single source and are sold in the same channels of trade and to the same or similar consumers. In addition, 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).

For the reasons stated above, the examining attorney respectfully requests that the Board affirm the refusal to register the proposed mark under Section 2(d) of the Trademark Act.

Respectfully submitted,

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