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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Itoya of America, Ltd.

Serial No. 76498199

Mark B. Harrison of Venable LLP for Itoya of America, Ltd.

Ingrid C. Eulin, Trademark Examining Attorney, Law Office 111
(Craig D. Taylor, Managing Attorney).

Before Hanak, Walsh and Zervas, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Itoya of America, Ltd. (applicant) seeks to register in
standard character form XENON for "writing pens." The
application was filed on July 1, 2003 with a claimed first
use date of October 1, 2002.

Citing Section 2(d) of the Trademark Act, the Examining
Attorney has refused registration on the basis that
applicant's mark, as applied to writing pens, is likely to
cause confusion with the identical mark XENON previously

registered in standard character form for "paper and cardboard." Registration No. 2,340,074.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first applicant's mark and the mark of cited Registration No. 2,340,074, they are absolutely identical. Both consist of a highly arbitrary term XENON depicted in standard character form. Thus, the first Dupont "factor weighs heavily against applicant" because applicant's mark is identical to the mark of the cited registration. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's goods (writing pens) and the goods of the cited registration (paper

and cardboard), we note that because the marks are identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or even intrinsically related." In re Shell Oil Co., 922 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in this case we find that applicant's writing pens have been proven to be extremely closely related to at least one of registrant's goods, namely, paper.

In this regard, the Examining Attorney has made of record over fifteen third-party registrations which cover both writing pens (or simply pens) and paper. To be clear, some of these third-party registrations mention a particular type of paper (usually stationery) as opposed to paper per se. However, we note that the term "stationery" is defined as "writing materials; specifically paper and envelopes." Webster's New World Dictionary (1996). While it is true that such third-party registrations do not prove that the marks registered are in actual use, they nevertheless "have some probative value to the extent that they may serve to suggest that such goods or services are of the type which may emanate from a single source." In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), aff'd as not citable precedent 88-1444 (Fed. Cir. November 14, 1988).

Moreover, the Examining Attorney has also made of record evidence showing that many stores sell both pens and paper, a point conceded by applicant at page 5 of its brief and again at page 4 of its reply brief.

Given the fact that writing pens and paper are clearly related goods, we find that the contemporaneous use of the identical mark XENON on both writing pens and paper would cause consumers to believe that the pens and paper emanate from the same source. This is particularly true given the fact that, as previously noted, XENON is an entirely arbitrary term with absolutely no meaning, a point conceded by applicant at page 1 of its response dated December 9, 2003.

In attempting to argue that there is no likelihood of confusion, applicant asks this Board to read registrant's description of goods, not as it reads, but rather as simply "paper cardboard." In other words, applicant is asking this Board to consider registrant's goods "as a single item." Applicant's brief page 3, original emphasis.

This Board will not accept applicant's highly dubious logic. The description of goods in the cited registration clearly reads "paper and cardboard." (emphasis added). It does not read "paper cardboard."

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Decision: The refusal to register is affirmed.