
To: EH Europe (ipdocketing@stradley.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77374121 - ECOSAFE - 184736-5001
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Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 77/374121**MARK:** ECOSAFE**CORRESPONDENT ADDRESS:**Kevin R. Casey
Stradley, Ronon, Stevens & Young.

LLP

30 Valley Stream Parkway
Malvern PA 19355**APPLICANT:** EH Europe**CORRESPONDENT'S
REFERENCE/DOCKET NO:**
184736-5001**CORRESPONDENT E-MAIL ADDRESS:**
ipdocketing@stradley.com**GENERAL TRADEMARK INFORMATION:**<http://www.uspto.gov/main/trademarks.htm>**TTAB INFORMATION:**<http://www.uspto.gov/web/offices/dcom/ttab/index.html>**EXAMINING ATTORNEY'S APPEAL BRIEF**

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EH Europe G.m.b.H. (hereinafter referred to as "appellant") has appealed the Trademark Examining Attorney's refusal to register the proposed mark, ECOSAFE. Registration was refused on the Principal Register under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because appellant's mark, when used on or in connection with the identified goods, so resembled the mark in U.S. Registration No. 2744511, as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 et seq. The Trademark Examining Attorney respectfully requests that this refusal be affirmed.

FACTS

On January 17, 2008, the Appellant filed an application to register ECOSAFE for the now

amended identification of goods:

“Electrochemical cells and batteries, excluding electrical cables, for use in storage of electrical energy produced from renewable sources, namely, wind, wave, solar or geothermal energies and backup power for wind turbines, sold to manufacturers and distributors of equipment that produces energy from renewable sources and to consumers of such equipment” In International Class 9

In the first Office action, mailed March 26, 2008, the Trademark Examining Attorney refused registration on the Principal Register because the proposed mark so resembled the mark in U.S. Registration No. 2744511, as to be likely to cause confusion, to cause mistake, or to deceive. The cited, identical mark, ECOSAFE, is for the goods:

“Electrical cables” in International Class 9.

On September 26, 2008, the Appellant submitted a response to the Trademark Examining Attorney’s Office action asserting that while the marks were “concededly similar”, no such confusion was likely to occur because “there is no likelihood of confusion between the two (2) marks.” Appellant also stated that “the goods are clearly distinguishable” and that “the channels of trade through which these very different products travel are also quite different.”

On November 19, 2008, the Trademark Examining Attorney made the refusal to register final. Appellant filed a Request for Reconsideration on both February 25, 2009, and a subsequent Request for Reconsideration on March 23, 2009 but the Trademark Examining Attorney was not persuaded by the arguments and denied both Requests on April 23, 2009. On July 13, 2009, Appellant filed an appeal brief. The Trademark Examining Attorney has considered the Appellant’s arguments carefully but has found them unpersuasive.

ISSUE

The sole issue on appeal is whether applicant’s mark ECOSAFE (standard character format) for

use in connection with, as amended “Electrochemical cells and batteries, excluding electrical cables, for use in storage of electrical energy produced from renewable sources, namely, wind, wave, solar or geothermal energies and backup power for wind turbines, sold to manufacturers and distributors of equipment that produces energy from renewable sources and to consumers of such equipment” in International Class 9 is confusingly similar to U.S. Registration No. 2744511 for the identical mark, ECOSAFE (typed form drawing) for “Electrical cables” in class 9, thus creating a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act.

ARGUMENTS

THE PROPOSED MARK IS LIKELY TO CAUSE CONFUSION WITH U.S.

REGISTRATION NO. 2744511.

The Trademark Examining Attorney refused and maintained the refusal of registration on the Principal Register because the proposed mark was likely to cause confusion with Registration No. 2744511. Trademark Act Section 2(d), 15 U.S.C. §1052(d)

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 be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. Any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380

(Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Comparison of the Marks

When determining whether there is a likelihood of confusion under Section 2(d), it is well settled that the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (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, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In this case, the marks are not only highly similar in sound, appearance, and commercial impression, they are, in fact, identical. The Appellant concedes that the marks are identical, and further states that this is a "factor which cannot be ignored". Applicant's brief at page 9. However, the Appellant maintains that the commercial impressions of both marks is different, and also states that given the "weakness of the registrant's mark", the Examining Attorney has given this particular factor "overriding weight". Applicant's brief at page 9.

The Trademark Examining Attorney respectfully disagrees. Contrary to the Appellant's claim, the fact that both marks are identical in sound and appearance bolsters the argument that the marks share a highly similar, if not identical, commercial impression. The Appellant provides a brief explanation of the term "ecosafe" with regard to the term's suggestive implication of being "safe for the ecology", however, there is no distinction made in the Appellant's brief of why this particular definition, which is

shared by both marks, would constitute a difference in commercial impressions when viewed by consumers. Applicant's brief at page 9. It is well settled that consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Because the marks in this case are identical, there is no distinguishing factor that supports the Appellant's claim of both "ECOSAFE" marks having different commercial impressions.

With respect to the Appellant's argument that U.S. Registration No. 27444511 is "relatively weak and entitled only to a narrow scope of protection", The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). Furthermore, with respect to the Appellant's arguments pertaining to the possible dilution of the term "ECOSAFE", as well as the corresponding third party registrations the Appellant has submitted with regard to this argument, it is generally held that copies of third party registrations (or other exhibits) provided to demonstrate the weakness of a particular term are not probative because the other uses are not in the relevant field. Third-party registrations may be of value to the extent that they indicate that a particular word, feature or design has been adopted and registered by others *in a particular field*, indicating that word, feature or design has been adopted and registered by others *in a particular field*, and, thus, that registration of a mark consisting of that word or design or containing that feature, for goods or services *in the same or related field* should be given more restricted scope of protection. *Pizza Inn, Inc. v. Russo*, 221 USPQ 281 (TTAB 1983). This is not the case at hand. The goods/services indicated in the copies of third-party registrations offered by the applicant in support of its argument show use of the mark for different

and unrelated goods/services.

Comparison of the Goods

With respect to the issue of likelihood of confusion, it is well settled that all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). Additionally, in comparing the goods and/or services, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi). Furthermore, if the marks of the respective parties are identical, the relationship between the goods and/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. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

The Appellant has applied to register the mark "ECOSAFE" for the now-amended goods of:

"Electrochemical cells and batteries, excluding electrical cables, for use in storage of electrical energy produced from renewable sources, namely, wind, wave, solar or geothermal energies and backup power for wind turbines, sold to manufacturers and distributors of equipment that produces energy from renewable sources and to consumers of such equipment" in International Class 9

The registered mark, also "ECOSAFE", is for:

"Electrical cables" in International Class 9

The respective identifications are similar because both entail goods that are highly related, and as such, would likely emanate from a single or similar source.

The Appellant argues that several differences exist between the goods. In its appeal brief, the Appellant argues that its identification of goods “expressly excludes the registrant’s goods” and also that “entirely unrelated to the electrical cables with which the cited mark is used. The goods are specifically different and noncompetitive”. Applicant’s brief at page 9-10.

In the both the Final Office action of November 19, 2008 and in the denial of Appellant’s Request for Reconsideration of April 23, 2009, the Trademark Examining Attorney provided as evidence that the respective goods are related copies of printouts from the USPTO X-Search database.

In its appeal brief, the Appellant maintains that the Trademark Examining Attorney has not proven that the registrant’s goods and its goods are related and attacks the validity of these third party registrations. However, it is clear from the third party registrations provided by the Trademark Examining Attorney that a number of companies do produce both batteries and electrical cables, and that these goods, which are the focus of this particular case, are indeed highly related. Furthermore, these third party registration printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely Electrochemical cells and batteries and electrical cables, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). The Appellant concedes that both sets of goods are generally classified as “electrical components”, and although the Appellant attempts to argue that the “industrial” nature of both its batteries and the electrical cables sold by the registrant is a distinguishing factor, no such limiting language can be found in either set of identifications. Applicant’s brief at page 11-12.

The applicant argues that “As amended, the applicant’s identification of goods expressly excludes the registrant’s goods. The applicant respectfully submits that, especially in the context of the parties’ respective goods, this fact is most important to the likelihood of confusion analysis. Applicant’s brief at page 10.

The Trademark Examining Attorney disagrees that the exclusionary language has any impact on the Section 2(d) analysis because he has never argued that the goods in this particular case are identical (or that the applicant's goods legally encompass the goods of the registrant), only that the goods are commercially related for purposes of a Section 2(d) analysis. Clearly batteries are not electrical cables, so that the exclusion is already implicit. For example, "shirts" would be understood to be just that: "shirts." To add exclusionary language to create an identification of "shirts, excluding pants" effectively creates nothing new. Exclusionary language, such as that offered by the Appellant, does not obviate nor undermine a finding of relatedness with respect to goods where it already clear that the goods are not identical or overlapping and where the basis for the commercial relationship is other than that of where the goods are identical.

Other Factors

In its response of September 26, 2008, Appellant argues that its goods are distinguishable because the channels of trade differ to the extent that the Appellant's goods "would be sold to manufacturers and distributors of equipment generating electricity from wind, wave, solar or geothermal energies and to the consumers buying such equipment". The Appellant continues this argument by contrasting this potential pool of consumers with what they believe to be the Registrant's potential consumer base. However, the Registrant's identification of goods contains no limitations whatsoever with respect to the channels of trade the goods may move in. In the Appellant's Request for Reconsideration of March 23, 2009, the Appellant amended the identification of goods by adding the language "sold to manufacturers and distributors of equipment that produces energy from renewable sources and to consumers of such equipment" in an attempt to narrow the scope of the channels of trade. However, the additional wording added by the Appellant does not in any way restrict the channels of trade because it simply reiterates the normal channels of trade one would expect such goods to travel in. In addition, the Appellant does not address the lack of limitations found in the registrant's identification of goods. The Appellant repeats this argument in its appeal brief of July 13, 2009, however, it is well settled that a determination of whether there is a likelihood of confusion is made

solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); TMEP §1207.01(a)(iii). Furthermore, despite the Appellant's arguments pertaining to the difference in the channels of trade, there is no evidence to rebut the argument that because the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services 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, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). Lastly, any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand its business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from or are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; see TMEP §1207.01(a)(v).

The Appellant also maintains that the "Trademark Examining Attorney discounted the sophistication of the purchasers who buy the applicant's and registrant's respective goods". Applicant's brief at page 21. However, 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. TMEP §1207.01(d)(vii); see *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Additionally, because no limitations exist within the identification of goods, it is presumed that the goods are available to all potential customers.

CONCLUSION

As stated above, the question is not whether consumers will confuse the marks, but rather whether the marks will confuse consumers into believing that the goods they identify emanate from the same source. The Trademark Examining Attorney argues that the respective marks will cause source confusion.

For the foregoing reasons, it is requested that the refusal to register be affirmed on the ground that the proposed mark ECOSAFE when used on or in connection with the identified goods, so resembles the marks in U.S. Registration No. 2744511, as to be likely to cause confusion, to cause mistake, or to deceive.

Respectfully submitted,

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