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MARK: "EPIC"



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

CORRESPONDENT'S REFERENCE/DOCKET NO:

PRTUS"EPIC"

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Princeton Tectonics, Inc., appeals the examining attorney's final refusal to register the proposed mark, "EPIC" for "personal headlamps" in International Class 11, on the ground that the mark so resembles the mark in U.S. Registration No. 3107315 as to create a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

FACTS

On April 1, 2008, applicant applied for registration on the Principal Register of the mark "EPIC" for "personal headlamps" in International Class 11. The examining attorney refused registration on July 16, 2008 under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the mark was likely to be confused with the U.S. Registration No. 3107315 consisting of the mark "EPIC" for "electric lighting

fixtures” in International Class 11. The applicant traversed this refusal on January 21, 2009. This appeal follows the examining attorney’s final refusal issued February 18, 2009.

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 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. However, not all of the factors are necessarily relevant or of equal weight, and 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/or services, and similarity of trade channels of the goods and/or services. *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).

Regarding the issue of likelihood of confusion, 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). 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).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP

§1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

I. THE MARKS ARE IDENTICAL IN APPEARANCE AND COMMERCIAL IMPRESSION

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements 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).

In the present case, the marks are identical. Both marks are comprised of the word “EPIC” in standard characters. Therefore, applicant’s mark and registrant’s mark are similar in sound, appearance, and meaning. Applicant agrees that the marks are identical. *See Applicant’s Brief, Page 9.*

Applicant alleges that “EPIC” is a weak mark. *See Applicant’s Brief, Page 10.* The examining attorney respectfully disagrees. “EPIC” is not in any way descriptive or even suggestive in relation to applicant’s or registrant’s goods. In fact, the mark “EPIC” is an arbitrary mark that in no way suggests or describes a significant ingredient, quality, or characteristic of the goods or services. (e.g., APPLE for computers; OLD CROW for whiskey). *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee*

En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (VEUVE – meaning WIDOW in English – held to be “an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark”); *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way”); TMEP 1209.01(a).

Furthermore, if applicant intended to imply that “EPIC” is weak mark from a dilution standpoint, applicant failed to provide evidence to support such a claim. Weakness or dilution is generally determined in the context of the number and nature of similar marks in use in the marketplace on similar goods and/or services. *See Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

The applicant has provided no evidence whatsoever as to the use of the term “EPIC” in relation to the goods at issue or in the general marketplace. The examining attorney therefore concludes that the term “EPIC” in relation to the goods at hand is a mark of considerable strength and is highly and inherently distinctive. TMEP 1209.01.

II. APPLICANT’S GOODS ARE CLOSELY RELATED TO REGISTRANT’S GOODS

The applicant argues that personal headlamps and lighting fixtures are not in the same trade channels. *See Applicant's Brief, Pgs. 10-14.* The examining attorney respectfully disagrees. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); TMEP §1207.01; *see Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975).

The applicant spends a considerable amount of time and effort criticizing the examining attorney's third party registrations and internet webpages that were submitted as evidence. Applicant states that such evidence "falls short" in regard to a likelihood of confusion finding. *See Applicant's Brief, page 10.* However, the applicant has not

provided one scintilla of evidence to the contrary. Rather, the applicant makes unsubstantiated assertions as to where the applicant's goods are sold, (specifically sporting goods stores) and concludes by stating that, "one would not expect to find a personal headlamp in a store specializing in lighting fixtures." *Id.*

This is not the appropriate test, however. 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.3d 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). One does not need to find a personal headlamp in a store specializing in lighting fixtures or vice-versa.

The examining attorney has made of record, as attachments to both the July, 16, 2008 Office Action and the February 18, 2009 Final Office Action, copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve

to suggest that the goods and/or services listed therein, namely, headlamps and lighting fixtures, are of a kind that may emanate from a single source. *See Exhibit D, Final Office Action (February 18, 2009). In re Infinity Broad. Corp. of Dallas*, 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 applicant specifically questions the PANASONIC registration, stating that since this mark is known to be on a variety of diverse goods, there is little evidentiary value. *See Applicant's Brief, Page 11*. The applicant also assumes that the "head lamps" listed by the applicant refer to an automotive product, although such "head lamps" could in fact be personal-type head lamps. *Id.* Similarly, applicant assumes that the headlamps in the CLUSTERLITE registration are for automobiles. *Id.* However, there is no language in the registration that limits the headlamps to automobile headlamps; therefore, the headlamps listed in the registration include all types of headlamps, such as personal headlamps. 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); *see* TMEP §1207.01(a)(iii). If the cited registration describes the goods and/or services 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).

As mentioned previously, the applicant has failed to provide any evidence whatsoever as to the allegation as to how diverse the PANASONIC brand is or may be. This is certainly not a well-known fact for the Trademark Trial and Appeal Board to take judicial notice. TMEP 710.01(c); TBMP 1208.04. Furthermore, the listing of the other goods in the registration lead to the opposite conclusion. Note that there is not one other good listed in the registrant's identification that could even be considered automotive in nature. The majority of the products are for domestic and/or household use. Among the identification of goods are flashlights and electric lanterns as well as lighting fixtures. Furthermore, the flashlights and electric lanterns listed in the identification of goods are portable or "personal" devices much like the applicant's personal headlamps.

Additionally, the examining attorney has made of record real-world evidence that illustrates that applicant's goods and registrant's goods emanate from a single source. *See Exhibit E, Final Office Action (February 18, 2009)*.

The applicant again contests this evidence stating that the various internet web pages are from diverse entities offering a wide variety of goods. *See Applicant's Brief, Page. 13*. Some of the internet evidence provided by the examining attorney features sites that offer a wide variety of goods. However, pay particular attention to where these goods are placed on these websites. The particular website THESTAR.COM lists personal headlamps, flashlights and other related products. *See Exhibit E, Final Office Action, pgs. 48-55*). The website specifically states that there is some relation between such goods. Note that the main page for personal lighting products (headlamps,

flashlights, etc.) states, “RELATED CATEGORIES; HOME LIGHTING, LIGHTING FIXTURES & CEILING FANS.” *See Exhibit E, Final Office Action, page 53.* This certainly leads to the conclusion at to the trade channels being similar.

Furthermore, the TOOTOOMART cite shows both personal lighting products as well as what the applicant would term lighting fixtures¹. *See Exhibit E, Final Office Action, pgs. 43-47.* Despite applicant’s objections to the third-party registrations and real world evidence, they nonetheless illustrate that the goods of the applicant and registrant can come from a single source. Most importantly, applicant has failed to provide any evidence that the goods are not related. Furthermore, if the marks of the respective parties are identical (as is the case here), 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); *Ancor, Inc. v. Ancor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

In addition, 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 their 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*

¹ The examining attorney disagrees as to the applicant’s interpretation of what a fixture is for our purposes here. Please see pages 9-10 of this brief.

Realty Prof'ls, 84 USPQ2d at 1584 n.4; *see* TMEP §1207.01(a)(v). As noted above, the examining attorney attached third-party registrations and real-world evidence to the final Office Action showing that headlamps and light fixtures commonly emanate from the same source. Given these facts, a purchaser would likely believe that such goods, regardless of whether such goods were displayed in a different section of a store or in a different store entirely, are indeed within registrant's logical zone of expansion. To put it another way, consumers who are familiar with registrant's mark, "EPIC," for "electric lighting fixtures" are likely to assume that applicant's mark, "EPIC," for "personal headlamps" simply represents new or special products offered from the registrant. *In re Compania Pesquera Vikingos de Colombia, S.A.*, 221 USPQ 556 (TTAB 1984).

The applicant also devotes a portion of their brief to contesting the applicant's interpretation of what a fixture is and how it applies to the case at hand. Even though the examining attorney need not show that a personal headlamp is a subset of lighting fixtures² as source confusion has already been shown, the examining attorney still believes her interpretation of a fixture to be accurate and will discuss this here.

The primary purpose of both applicant's and registrant's goods are to emit and to provide light. Furthermore, registrant's "fixtures" are broad enough to encompass applicant's goods. "Lighting fixtures" is defined as "a fixture providing artificial light." *Exhibit A, Final Office Action (February 18, 2009)*. "Fixture" is defined as an "object in

² The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

a fixed position: an object with a fixed position and function.” *Exhibit B, Final Office Action (February 18, 2009)*. Therefore, a fixture can include a personal headlamp, as such goods are placed in a fixed position on one’s head or helmet. A personal headlamp, which is found in applicant’s recitation of goods, is a “flashlight worn on [one’s] head” or a “lamp mounted on a miner’s or spelunker’s hard hat.” *Exhibit C, Final Office Action (February 18, 2009)*. Applicant contends that the examining attorney’s adopted definition of the word “overlooks the implication of the term ‘fixture.’” *Applicant’s Brief at 9*. However, applicant interprets the term “fixture” too narrowly. Applicant cites the definition of “fixture” as follows: “1. anything firmly in place 2. any of the fittings for furniture of a house, store, etc. attached to the building and, ordinarily, considered legally a part of it [bathroom *fixtures*] 3. any person or thing that has remained in a situation or place so long as to seem fixed there 4. [*Chiefly Brit.*] a well established, regularly occurring sports or social event.” *Id.* While this is one interpretation of the word “fixture,” applicant cannot ignore that the term has various meanings, such as those cited by the examining attorney above. It should also be noted that the first definition of “fixture” provided by the applicant is “anything firmly in place.” *Id.* As illustrated above, a personal headlamp is a flashlight or lamp that is attached *firmly in place* to one’s head or helmet. *Exhibit C, Final Office Action (February 18, 2009)*. While the applicant insists that this is an incorrect assertion, the definitional evidence proves otherwise and once again the applicant has failed to provide any evidence to bolster this claim. The similarity of goods and trade channels is quite readily apparent.

CONCLUSION

For the reasons set forth above, the examining attorney respectfully submits that applicant's proposed mark, "EPIC," is identical to registrant's mark, "EPIC," and that prospective purchasers encountering the marks in commerce are likely to mistakenly believe that the goods come from the same source. The evidence provided by the examining attorney is sound and the applicant has offered no evidence whatsoever for a different conclusion to be reached. Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register under Section 2(d) of the Trademark Act after all factors have been weighed.

Respectfully submitted,

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