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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77753025
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Crosstex International, Inc.
Trademark: SANITYZE (stylized)
Serial No.: 77/753025
Attorney: Laura E. Smith, Esq.

BEFORE THE
TRADEMARK TRIAL
AND
APPEAL BOARD
ON APPEAL

APPLICANT'S APPEAL BRIEF

The applicant appeals the Trademark Office's refusal to register the applicant's trademark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

DESCRIPTION OF THE RECORD

The evidence of record in this appeal consists of the applicant's application for registration of the mark in International Class 5; Office Action no.1 dated September 15, 2009; the applicant's Response to Office Action No. 1; Office Action no. 2 dated November 20, 2009; the applicant's response to the Final Action issued by the Examining Attorney dated January 25, 2010. The applicant's Request for Reconsideration and Amendment to the Supplemental Register dated February 26, 2010 and the Continuation of Final Refusal under Trademark Act Section 2(d) issued by the Examining Attorney on April 13, 2010. The applicant hereby incorporates by reference all arguments and exhibits previously made of record.

ISSUE

Whether the applicant's mark is likely to cause confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d) with the mark SANI-TYZE in registration number 3,199,936.

INTRODUCTION

The applicant seeks to register the mark SANITYZE in a stylized script. The mark appears as:

The image shows the word "Sanityze" written in a bold, black, stylized script font. The letters are thick and have a slightly irregular, hand-drawn appearance. The 'S' is particularly large and prominent, and the 'y' has a long, sweeping tail that extends downwards.

Registration number 3,199,936 is for the mark:

SANI-TYZE

The mark is registered as a typed drawing.

The applicant seeks to register its mark in connection with:

Antimicrobial waterless gel for use as a hand sanitizer, in class 5.

The mark cited in registration number 3,199,936 is for:

All purpose sanitizer and deodorizer for industrial and commercial use, in class 5.

ARGUMENT

THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE
APPLICANT'S MARK AND THE MARK IN REGISTRATION NO. 3,199,936

The marks of the respective parties are not confusingly similar

In her final action the Examining Attorney correctly references the factors set out in *In re E.I. du Pont de Nemours & Co.* for use in guidance in determining the likelihood of confusion between two marks, namely, that the marks must be compared for similarity as to 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).

In determining whether a likelihood of confusion exists between two marks, the marks must be compared *in their entirety* and not dissected into individual segments, *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 184 USPQ 36 (CCPA 1994); *Clairol Incorporated v. Roux Laboratories*, 58 CCPA 1170, 442 F.2d 980, 169 USPQ 589 (1971); *Magnovox Co. v. Multivox Corp. Of America*, 52 CCPA 1025, 341F.2d 139, 144 USPQ 501 (1965).

The basis of the Examining Attorney's refusal is her assertion that the marks are "phonetic equivalents and thus sound similar" and that "similarity in sound alone may be sufficient to support a likelihood of confusion".

It is the applicant's position that in reaching the conclusion that the marks are confusingly similar the Examining Attorney has failed to consider the marks in their entireties and has improperly based her refusal on the sole possibility that the marks of the respective parties may be pronounced in the same manner. Contrary to the Examining Attorney's assertion, there is no "correct" pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark, therefore, there is no way to know with certainty that the marks in are in fact phonetic equivalents and thus confusingly similar. TMEP Section 1207.01(b)(iv).

As the applicant's mark is comprised of a prefix similar to semi- or multi- it is the applicant's position that upon viewing the registrant's mark, consumers will recognize that the "i" is pronounced like a long "e" and that the entire mark is pronounced sãn-ee-tize; the emphasis or accent is on the long "e" at the center of the mark. The manner in which the registrant's mark appears indicates to consumers how the mark is pronounced.

It is the applicant's position that in finding that the marks are confusingly similar, the Examining Attorney has improperly focused on only one of the factors set out in *In re E.I. du Pont de Nemours & Co.* Similarity of the marks in either sight, sound, or meaning does not *automatically* result in a finding of likelihood of confusion even where the goods or services of the respective parties are identical or closely related, rather, similarity in one of those factors *may be sufficient* to support a finding of likelihood of

confusion when the record is considered as a whole [emphasis added], *In re Lamson Oil Co.* 6 U.S. P. Q. 2d 1041 n.4 (TTAB 1987). Only in appropriate cases may a finding of similarity as to sight, sound or meaning be sufficient to support a finding of likelihood of confusion, *In re White Swan Ltd.* 8 U.S.P.Q. 2d 1534, (TTAB 1988). It is the applicant's position that the Examining Attorney has failed to consider all of the relevant factors, and in particular, failed to consider the marks in their entireties when making a determination as to similarity of the marks.

Moreover, possible phonetic similarity is not likely to create confusion where the goods are not purchased through verbal request but by an act of "self service", *La Maur, Inc. v. Revlon, Inc.*, 245 F.Supp. 839, 146 U.S.P.Q. 645 (D. Minn 1965). The applicant and the registrant sell the majority of their goods over the internet either from their home page or through on-line distributors. It is the applicant's position that given the circumstances under which the registrant's and the applicant's goods are marketed and sold; it is the *appearance* of the mark on the computer screen that informs the relevant consumer as to the origin of the goods and not the possible pronunciation of the mark. Purchasers of the goods of the respective parties are not making a verbal request for the goods to a sales clerk. The way in which the goods are sold minimizes if not completely eliminates, any possible instances in which the applicant's mark may be confused with the registrant's mark.

The Examining Attorney states that despite the fact that the "registered mark is displayed with a hyphen, overall the marks have the same commercial impression". The applicant

finds this statement disingenuous. The basis of the refusal is the purported similarity in *sound* between the two marks. If the Examining Attorney is also going to assert that “overall the marks create the same *commercial impression*”, the applicant would like point out that the marks differ significantly in terms of appearance as “commercial impression” is generally understood to mean “sight, sound and meaning”, *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772* 396 F3d 1369, 73 U.S.P.Q. 2d 1689 (Fed. Cir.2005). The applicant’s mark is one term in stylized script form, while the registrant’s mark consists of two terms in typed form separated by a hyphen; thus the two marks differ in appearance and therefore cannot be said to create the same “overall commercial impression”.

It is the Applicant’s position that the Examining Attorney’s analysis is deeply flawed and that the marks of the respective parties, when used in connection with the identified goods, are not likely to cause confusion as to the source of the goods.

Consumers are not likely to believe that the goods of the respective parties emanate from the same source as the goods do not move in the same channels of trade

In determining whether there is a likelihood of confusion, all the circumstances surrounding the sale of the goods must be considered. These circumstances include the marketing channels, the identity of the prospective purchasers and the degree of similarity between the marks and the goods. *In re Du Pont de Nemours & Co.* 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973); *Industrial Nulceonic Corp.v. Hinde Engineering Co.* 475 F. 2d 1197, 177 USPQ 386 (C.C.P.A. 1973).

The applicant seeks to register its mark in connection with:

Antimicrobial waterless gel for use as a hand sanitizer, in class 5.

The mark cited in registration number 3,199,936 is for:

All purpose sanitizer and deodorizer for industrial and commercial use, in class 5.

The applicant's goods are primarily sold to medical facilities such as hospitals, clinics doctor's offices and dental offices. Previously made of record as Exhibit 1 were excerpts from on-line retailers where the applicant's product is available for purchase. These retailers provide dental supplies and goods related to sports medicine and other health related supplies. These retailers do not provide goods for industrial or janitorial use; the field of use identified by the registrant.

The registrant, Spartan Chemical Company, is a manufacturer of chemical specialty maintenance products and industrial degreasers. Also previously made of record as Exhibit 1, was material downloaded from the registrant's web site as well as on-line retailers featuring the registrant's goods. The registrant's product is described as a "food contact surface sanitizer" and is designed for use on "hard surfaces in food related areas", as opposed to the applicant's goods which are specifically for use on an individual's hands. The Examining Attorney will note that the material on the on-line retailers reveals that the registrant's goods are sold through janitorial and facilities supply companies along with floor cleaners and drain and sewer maintenance products. It is the applicant's

position that this material clearly demonstrates that the goods of the respective parties serve entirely different purposes. The purchasers of the goods of the respective parties are not the same and are not likely to overlap as one would not use an industrial grade floor sanitizer interchangeably with a hand sanitizer. The products differ so widely that it is not likely that the purchasers of the goods would assume that they originate from the same source. The goods of the respective parties do not move in the same channels of trade, therefore, any possibility of confusion as to the source of the goods is highly remote.

It is the Examining Attorney's position that the goods of the respective parties are related and move in the same channels of trade. In support of her position, the Examining Attorney referenced excerpts from several internet websites that purportedly show that the "parties goods are of the type of goods that are likely to emanate from a single source and to travel in the same channels of trade". The first excerpt is from the applicant's home page where the product is referenced in connection with preventing the "spread of germs at home, work and school". There is no reference to an "industrial" or "commercial" use.

The second excerpt is from the Carfarma site which appears to be a distributor; the product PURELL is featured. PURELL is also a hand sanitizer. There is no reference to an "industrial" or "commercial" use for this product. There is no discussion at all of the types of consumers for the product.

The third excerpt, the Tradekey distributor, also features hand sanitizer. On the Tradekey site, the goods are described as being “for public place (*sic*) like Bank, Casino, hospital, school etc.” There is no reference to an “industrial” or “commercial” use. It is the applicant’s position that use of the product in a “bank” or a “casino” is not an “industrial” or “commercial” use as those terms are commonly understood.

The reference submitted by the Examining Attorney from Preparedness.com also does not contain any information as to the specific channels of trade for the hand sanitizer that is referenced on the site.

The Examining Attorney has also attached material from the THE BUYERSCOPE website. The print in the material submitted by the Examining Attorney is so small as to be indecipherable as is the material also submitted by the Examining Attorney from the Colgate-Palmolive website, the Dial website and the Freund website.

The Examining Attorney has also attached a page from Ecolab. The material shows that the company makes both surface disinfectants and hand washes. Both the hand washes and surface disinfectants appear under the healthcare division. There is no reference to any industrial or commercial use for either product.

The same may be said of the Gojo site which references skin care and hygiene solutions and specifically PURELL hand sanitizer, however, there does not appear to be any reference to sanitizers or deodorizers for industrial and commercial use.

It is the applicant's position that contrary to the Examining Attorney's assertion, the material does not demonstrate that the goods of the respective parties are likely to emanate from a single source and travel in the same channels of trade.

The Examining Attorney also attached material from the registrant's website that "shows that the registrant sells many types of cleaning products including hand cleaners and sanitizers and that these products are sold to different kinds of consumers including medical facilities." The applicant would like to point out that the material from the Spartan Medical Supply website that features hand sanitizers submitted by the Examining Attorney is not the registrant, Spartan Chemical Corp. but a different company all together located in Mattawan, Michigan and is therefore irrelevant.

The material from the registrant's Spartan Chemical's home page features a list of products including a reference to E-2 HAND WASH & SANITIZER. It is the applicant's position that this material does not support the Examining Attorney's assertion that the registrant sells hand cleanser and sanitizers to medical facilities but is simply a list of products. The Examining Attorney's position that "the registrant's goods include all types of sanitizers for industrial and commercial use, including hand sanitizers for use in medical facilities" is simply not supported by the evidence.

In support of her refusal to register the applicant's mark, the Examining Attorney has also attached copies of printouts from the USPTO X-Search database. The Examining Attorney asserts that the third party registrations show how one mark is used in connection with both the registrant's and the applicant's goods and that therefore, the goods of the respective parties are of a type that may emanate from a single source.

As the Examining Attorney is not doubt aware, third party registrations are given little evidentiary weight in determining a likelihood confusion as the existence of the registrations is not evidence of what happens in the market place or that customers are familiar with the marks as they are used in connection with the goods. *AMF Inc. v. American Leisure Products, Inc.* 474 F.2d 1403, 177 U.S.P.Q. 268 (C.C.P.A. 1973).

Moreover, third party applications and registrations which are filed under the provisions of Section 44 of the Trademark Act based on foreign registrations have very little evidentiary value as to actual use of the mark in connection with the goods or services identified in the registration. *In re Mucky Duck Co, Inc.* 6 USPQ 2d 1467 (TTAB 1988).

The registrations submitted by the Examining Attorney do not show one mark used with both the registrant's and the applicant's goods. All of the goods for registration number 2862964 for the mark DEB are for use on the skin; there is no reference to simply "sanitizers"; the registrant's goods. The second registration for the mark SKINCARE'S BEST SOLUTION is owned by the same entity and uses nearly the identical description of goods.

The identification of goods for the second set of registrations for the marks ESSENTIAL INDUSTRIES and ESSENTIAL INDUSTRIES and design, contains a reference to both sanitizers and hand cleanser, however, the registrations merely show that one entity *may* use the same mark on goods that are similar to those of the applicant and the registrant and is not conclusive as to what actually occurs in the relevant marketplace, *In re Donnay International, S.A.* 31 USPQ2d 1953 (TTAB 1994).

The last third party registration referenced by the Examining Attorney was filed under Trademark Act Section 44 (d) and registered under Section 44 (e) and as such has minimal evidentiary value in establishing whether the goods at issue would emanate from the same source. *In re Mucky Duck Co, Inc.* 6 USPQ 2d 1467 (TTAB 1988).

It is the Applicant's position that the Examining Attorney's evidence does not establish that the goods of the respective parties are of the type that are likely to emanate from a single source or likely to be perceived as emanating from a single source or to move in the same channels of trade.

In support of her refusal to register the Applicant's mark the Examining Attorney states that the issue is not whether there is a likelihood of confusion between the goods of the respective parties; but whether there is a likelihood of 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); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476,

480 (C.C.P.A. 1975); TMEP §1207.01. The cases cited by the Examining Attorney are inapposite to the facts at hand. In *In re Shell*, the Court of Appeals affirmed the refusal to register the mark RIGHT-A-WAY and arrow design for “service station oil and lubrication change services” based on a likelihood of confusion with the mark RIGHT-A-WAY and arrow design for “distributorship services in the field of automotive parts”. The Court found that the potential consumer of the applicant’s oil change and lubrication services is the broad class of automobile owners. Moreover, the applicant conceded that the substantially all of the registrant’s costumers are prospective consumers of the applicant’s services. *In re Shell Oil Co.*, 26 USPQ2d at 1689 (Fed. Cir. 1993).

It is the Applicant’s position that the material previously submitted by the applicant demonstrates that sanitizers for personal use on one’s body and the registrant’s goods, namely, sanitizers for use in an industrial or commercial setting, more specifically for use on hard surfaces such as shelves and countertops, serve distinctly different purposes and move in different channels of trade. The purchasers of the applicant’s and the registrant’s goods are not all members of one class of consumer and the registrant’s consumers are not prospective consumers of the applicant’s goods. Unlike the goods *In re Shell Oil*, the applicant has clearly demonstrated that there is no overlap between the registrant’s and the applicant’s goods.

The Applicant has been using the mark in connection with the identified goods for over eight years and there have been no instances of confusion with the mark cited by the Examining Attorney.

It is the Applicant's position that there is no likelihood of confusion between the Applicant's mark and the mark cited by the Examining Attorney. The Applicant respectfully requests that the Board reverse the refusal to register the Applicant's mark.

Respectfully submitted,


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Dated: June 18, 2010