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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77753025

MARK: SANITYZE



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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>

APPLICANT: Crosstex International, Inc.

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark "SANITYZE" in pertinent part for "antimicrobial waterless gel for use as a hand cleanser"¹ on the ground that the mark is likely to be confused with the mark in U.S. Registration No. 3,199,936 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Initially, it is noted that while applicant's appeal brief refers to applicant's goods as "antimicrobial waterless gel for use as a hand sanitizer," the record indicates that applicant's goods are "antimicrobial waterless gel for use as a hand cleanser."

¹ The identification reflects changes made by the applicant in the correspondence dated November 30, 2010.

I. FACTS

Applicant, Crosstex International, Inc. applied to register the mark “SANITYZE” on the Principal Register for “antimicrobial waterless gel.”

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), based on the highly similar mark “SANITYZE” in pertinent part for “all purpose sanitizer for industrial and commercial use.” Additionally, the Examining Attorney issued a descriptive refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). The Examining Attorney also informed the applicant that its allegation of five years’ use was insufficient to show acquired distinctiveness since the mark was highly descriptive of the specified goods. Furthermore, the Examining Attorney asked the applicant to amend the identification of goods.

While accepting applicant’s amended identification of goods, the Examining Attorney issued a final Office action based on the likelihood of confusion refusal, the descriptive refusal and on the claim of acquired distinctiveness. Subsequently, the Examining Attorney accepted applicant’s amendment of the application to seek registration on the Supplemental Register but denied the Request for Reconsideration under Section 2(d) of the Trademark Act. This appeal now follows the Examining

Attorney's final refusal and denial of the Request for Reconsideration under Section 2(d) of the Trademark Act.

II. ARGUMENTS – LIKELIHOOD OF CONFUSION

APPLICANT'S MARK AND REGISTRANT'S MARK ARE HIGHLY SIMILAR AND THE GOODS ARE RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

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 in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks and similarity of trade channels of the services. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

Fundamentally, any doubt as to the issue of likelihood of confusion must be resolved in favor of the prior registrant. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

A. THE MARKS ARE CONFUSINGLY SIMILAR

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, 177 USPQ 563 (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); TMEP §1207.01(b).

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). 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 issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Thus, the primary focus in the analysis is on the recollection of the average purchaser who normally retains a general rather than a specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b).

With the above in mind, applicant seeks to register the mark “SANITYZE” in stylized form. The mark in the cited registration is “SANI-TYZE” in standard characters.

The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); TMEP §1207.01(b)(iv). Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). Moreover, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv).

Thus, a sufficient and clear resemblance exists between the applicant's mark and the mark contained in U.S. Registration No. 3,199,936 as to cause a likelihood of confusion.

Applicant argues that the Examining Attorney has failed to consider the marks in their entireties and has improperly based the refusal on the sole possibility that the marks could be pronounced in the same manner.

Indeed, when considering the similarity of the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are

similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); TMEP §1207.01(b). Contrary to applicant’s contention, the Examining Attorney has examined the similarity or dissimilarity of the marks in their entireties and finds that the marks are similar in sound, meaning and connotation. The marks project similar commercial impressions and are thus sufficiently similar as to cause a likelihood of confusion.

Applicant contends that since the applicant and the registrant sell the majority of their goods over the Internet, it is the appearance of the marks on the computer screen, and not the pronunciation of the marks that informs the relevant consumers as to the origin of the goods. Applicant argues that 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.

Nevertheless, marks may be pronounced by consumers whether orally or mentally. Therefore, the fact that the goods are sold over the Internet has little or no significance in this regard. Moreover, 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). Since neither the application nor the registration contains any limitations as to the channels of trade for the relevant goods, it is presumed that these

goods travel in all the normal channels of trade including those whereby the goods are purchased by verbal request.

Applicant argues that the marks do not create the same overall commercial impression, and that they differ significantly in appearance since the applicant's mark is one term in stylized script while the registrant's mark consists of two terms in typed form, separated by a hyphen.

However, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Clearly, the marks in this case create the same overall commercial impression.

Moreover, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991.) Therefore, since the registrant's mark is in standard characters, it could be displayed in the same stylized script as the applicant's mark.

Additionally, in evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

B. THE GOODS ARE RELATED

The goods or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *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, they need only be related in some manner, 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).

The crucial issue is not likelihood of confusion between particular goods or services, but likelihood of confusion as to the source of those goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein; TMEP § 1207.01.

The applicant's goods are identified in the application as "antimicrobial waterless gel for use as a hand cleanser." The registrant's goods are identified in pertinent part as "all purpose sanitizer for industrial and commercial use." The applicant's appeal brief characterizes the applicant's goods as "antimicrobial waterless gel for use as a hand sanitizer." Clearly, the registrant's goods could encompass the applicant's goods as identified in its appeal brief.

With the above in mind, the parties' goods could potentially be sold to the same class of customers and would be encountered under circumstances leading one to mistakenly believe that they originate from the same source.

Applicant asserts that the registrant's goods are "food contact surface sanitizers" while the applicant's goods are for use on hands. Applicant argues that its goods are primarily sold to medical facilities such as hospitals, clinics, doctors' offices and dental offices and that these goods are not likely to travel in the same channels of trade as the registrant's sanitizers which are sold through janitorial and facilities supplies companies. Applicant further argues that the parties' goods serve entirely different purposes.

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). 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); TMEP §1207.01(a)(iii). In this case, since there is no limitation as to the channels of trade for the parties' goods, it is presumed that the relevant goods move in all the normal channels of trade and are available to all potential customers. The registrant's goods, namely, "all-purpose sanitizers for commercial or industrial use" could be used in medical facilities, since such facilities could be considered commercial facilities. Furthermore, the registrant's goods could encompass sanitizers for use on hands.

Moreover, in the final Office action, the Examining Attorney attached Internet evidence which showed that companies that offer hand cleansers or sanitizers also offer surface sanitizers for use in commercial settings, including healthcare settings. As such, the parties' goods could travel in the same channels of trade and would be encountered under circumstances leading one to mistakenly believe that they originate from the same source. Furthermore, the evidence shows that both the applicant and the registrant sell hand cleansers or sanitizers and surface disinfectants or sanitizers. Additionally, contrary to applicant's contention, the evidence shows that both parties' products are used in healthcare settings.

The following are examples of these companies.

CROSSTEX INTERNATIONAL, INC. (applicant) offers hand sanitizers and cleansers and

surface disinfectants, including those used in healthcare settings

<http://www.crosstex.com/>

http://www.crosstex.com/cleanersproductguide.asp?mycat1=cat4&mycat2=cat4_1&mycat3=cat4_1

[See pages 16-19 of the final Office action]

SPARTAN COMMERCIAL COMPANY INC. (registrant) offers antiseptic hand

cleansers and surface sanitizers, including those used in healthcare settings.

<http://www.spartanchemical.com/web/webhome.nsf>

<http://www.google.com/products?hl=en&q=spartan+chemical+sanitizers&um=1&ie=UTF->

[F-](http://www.google.com/products?hl=en&q=spartan+chemical+sanitizers&um=1&ie=UTF-)

[8&ei=fptdTLLqKYH48Aa6tPm1DQ&sa=X&oi=product_result_group&ct=title&resnum=3&ved=0CIDIQrQQwAg](http://www.google.com/products?hl=en&q=spartan+chemical+sanitizers&um=1&ie=UTF-8&ei=fptdTLLqKYH48Aa6tPm1DQ&sa=X&oi=product_result_group&ct=title&resnum=3&ved=0CIDIQrQQwAg) [See pages 34-38 of the final Office action.]

PALMOLIVE COLGATE COMPANY markets both hand gel sanitizer and surface

cleansers or sanitizers including those used in healthcare facilities.

http://www.colpalcommercial.com/markets.aspx?mkt=3&menu_id=4 [See pages 55-56

of the final Office action.]

DIAL PROFESSIONAL SERIES offers hand sanitizers and antibacterial disinfectant

surface cleansers for commercial or industrial use.

<http://www.dialprofessional.com/> [See pages 57-59 of the final Office action.]

ECOLAB offers antibacterial hand washes and surface sanitizers or disinfectants for use in commercial and healthcare settings.

<http://www.ecolab.com/>

<http://www.ecolab.com/MarketsServed/CommercialFacilities.asp> [See pages 60-62 of the final Office action.]

FREUND CONTAINER & SUPPLY markets hand sanitizers and surface cleaners on the same webpage.

<http://www.freundcontainer.com/search.asp?ss=cleaner&bhcd2=1281206496> [See pages 63-64 of the final Office action]

Attached to the first Office action and the final Office action were copies of current U.S. registrations showing entities offering and using the same mark in connection with hand or skin cleansers or sanitizers and sanitizers or disinfectants for institutional or industrial use. Such third-party registrations have probative value to the extent that they serve to suggest that certain goods or services are of a type, which can emanate from a single source. *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988); TMEP §1207.01(d)(iii).

The following are examples of these registrations.

U.S. Registration No. 2,108,254 21ST CENTURY used in pertinent part for all purpose disinfecting preparations for janitorial use, namely, sanitizers, and antimicrobial hand cleaners. [See pages 10-12 of the first Office action.]

U.S. Registration No. 3,441,682 REMI-D used in pertinent part for hand and surface sanitizing and disinfecting preparations. [See pages 16-17 of the first Office action.]

U.S. Registration No. 3,494,093 GERM PRO used in pertinent part for antimicrobials for dermatological use, sanitizers for hospital use, sanitizers for use in institutional and industrial areas. [See pages 26-28 of the first Office action.]

U.S. Registration No. 2,572,042 SKINCARE'S BEST SOLUTION used in pertinent part for all-purpose disinfectant preparations for workplace hygiene, bacterial preparations for application to the skin, namely, skin sanitizers and medicated skin cleansers for use in medical areas. [See pages 4-6 of the final Office action.]

U.S. Registration No 3,263,270 CITROFRESH used in pertinent part for sanitizers, sanitizers for industrial and medical use and antibacterial hand wash. [See pages 13-15 of the final Office action.]

Applicant asserts that it has been using the mark in connection with the identified goods for over eight years and there that have not been any instances of confusion with the registrant's mark. However, the test under Trademark Act Section 2(d) is whether

there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

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. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Moreover, the Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Fundamentally, any doubt as to the issue of likelihood of confusion must be resolved in favor of the prior registrant. *S-ee In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Therefore, the Examining Attorney finds that the similarities between the marks and the goods of the parties are so great as to create a likelihood of confusion.

III. CONCLUSION

The marks are highly similar and the goods are related. Consumers encountering applicant's mark and the cited mark in the marketplace are likely to believe that the goods derive from a common source. Therefore, the refusal to register the applicant's mark pursuant to Section 2(d) of the Lanham Act should be affirmed.

Respectfully submitted,

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