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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elite Lighting

Serial No. 77799919

Thomas I. Rozsa of Rozsa Law Group LC for Elite Lighting.

Fong Hsu, Trademark Examining Attorney, Law Office 115
(John Lincoski, Managing Attorney).

Before Quinn, Grendel and Ritchie, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Elite Lighting (applicant) seeks registration on the
Principal Register of the **mark EQUINOX ARCHITECTURAL
PERFORMANCE LIGHTING** (in standard character form;
ARCHITECTURAL PERFORMANCE LIGHTING disclaimed), for Class

11 goods identified in the application as "recessed electrical lighting fixtures."¹

The Trademark Examining Attorney has issued a final refusal of registration of applicant's mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Specifically, the Trademark Examining Attorney has refused registration on the ground that applicant's mark, as applied to the goods identified in the application, so resembles the mark **EQUINOX**, previously-registered (in standard character form) on the Principal Register for Class 9 goods identified in the registration as "dimming controls for electric lighting fixtures utilized in commercial and industrial environments,"² as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant has appealed the final refusal. The appeal is fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we **AFFIRM** the refusal to register.

Our likelihood of confusion determination under Section 2(d) is a question of law, based on an analysis of

¹ The application was filed on August 7, 2009, and is based on applicant's asserted bona fide intention to use the mark in commerce. See Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Registration No. 1686165, issued on May 12, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). "While it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods." *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001).

Under the first *du Pont* factor, we determine the similarity or dissimilarity of applicant's mark (EQUINOX ARCHITECTURAL PERFORMANCE LIGHTING) and the cited registered mark (EQUINOX) when they are viewed in their entirety in terms of appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their overall commercial

impressions as to be likely to cause confusion when used on or in connection with the goods at issue. This necessarily requires us to take into account the fallibility of memory over time and the fact that the average purchaser retains a general rather than a specific impression of trademarks.

See In re Association of the United States Army, 85 USPQ2d 1264, 1269 (TTAB 2007); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be found to be more significant than another in terms of the mark's function and significance as a source-indicator, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark, and in comparing the marks at issue under the first *du Pont* factor. *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004). In this case, we find that the dominant feature in applicant's mark is the word EQUINOX, for the following reasons.

The disclaimed wording in the mark, ARCHITECTURAL PERFORMANCE LIGHTING, is highly descriptive (if not generic) as applied to applicant's goods, and it therefore contributes little, if anything, to the mark's function and

significance as an indication of source. For that reason, it is entitled to lesser weight in our comparison of applicant's mark and the cited registered mark under the first *du Pont* factor. See *In re Chatam International Inc.*, 71 USPQ2d 1944 at 1946; *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531 at 1533-34; *In re National Data Corp.* 753 F.2d 1056, 1048, 224 USPQ 749, 751 (Fed. Cir. 1985). By contrast, the word EQUINOX appears on this record to be an arbitrary term as applied to applicant's (and to the registrant's) goods. It therefore is the feature of the mark that purchasers are likely to perceive to be and recollect as being the indication of the source of the goods. For these reasons, we find that EQUINOX is the dominant feature of applicant's mark, and that it accordingly is entitled to greater weight in our comparison of the marks under the first *du Pont* factor.

Comparing the marks in their entireties in terms of appearance, sound, connotation and commercial impression, we find that applicant's mark is similar to and indeed identical to the registrant's mark but for applicant's addition to its mark of the descriptive if not generic wording ARCHITECTURAL PERFORMANCE LIGHTING. "While not ignoring the caveat that marks must be considered in their entireties when evaluating the chances of their being

confused in the marketplace, where a newcomer has appropriated the entire mark of a registrant, and has added to it a non-distinctive term, the marks are generally considered to be confusingly similar." *In re Denisi*, 225 USPQ 624 at 624 (TTAB 1985). We find that the similarity of the marks which results from the presence in both marks of the arbitrary word EQUINOX, as the dominant feature of applicant's mark and the whole of the registrant's mark, outweighs the dissimilarities between the marks which result from the presence in applicant's mark of the additional wording ARCHITECTURAL PERFORMANCE LIGHTING.

We therefore find, under the first *du Pont* factor, that the marks are similar. This finding supports a conclusion that a likelihood of confusion exists.

Under the second *du Pont* factor, we determine the similarity or dissimilarity of the goods identified in applicant's application ("recessed electrical lighting fixtures") and the goods identified in the registrant's registration ("dimming controls for electrical lighting fixtures utilized in commercial and industrial environments").

Applicant argues that its goods are different than the registrant's goods and that the respective goods would not be confused for each other. However, the issue is not

whether consumers would confuse the goods themselves. Rather, the goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods marketed under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. See *In re Wilson*, 57 USPQ2d 1863, 1866-67 (TTAB 2001). "Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services." *Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Here, we find that applicant's goods and the registrant's goods are related because they are complementary goods that would be used together. By definition, the "electric lighting fixtures" referred to in the cited registration would encompass and include applicant's "recessed electrical lighting fixtures." Thus, the registrant's goods would include dimming controls for recessed electrical lighting fixtures. Moreover, the Trademark Examining Attorney has submitted Internet evidence showing that "recessed lighting" is marketed as a category of "lighting fixtures" and that recessed lighting fixtures are sold together with dimming controls for

interior lighting systems. See the websites of Lamps Plus, Louie Lighting, and Pro Lighting, attached to the November 13, 2009 Office Action. Finally, with respect to the "commercial and industrial environments" in which the registrant's goods are used, there is no evidence which would suggest that recessed electrical lighting fixtures are not and would not be a type of electrical lighting fixtures used (with dimming controls) in those environments.

For these reasons, we find that applicant's goods and the registrant's goods are related goods, for purposes of the second *du Pont* factor. This finding supports a conclusion that confusion is likely.

Applicant argues, presumably under the sixth *du Pont* factor ("the number and nature of similar marks in use on similar goods") that the registrant's EQUINOX mark is a weak and diluted mark which is entitled to only a narrow scope of protection. However, the evidence applicant has submitted fails to support this argument. First, the evidence submitted by applicant for the first time with its reply brief on appeal (mere TESS listings of purported third-party registrations) is untimely and shall be given no consideration. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d).)

The previously-submitted mere listings from TESS of purported third-party registrations are not sufficient to make those registrations of record. See *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996). In any event, the listings are of essentially no probative value because they do not identify the goods covered by the listed registrations. See *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1380 (TTAB 2006).

As to the actual TESS printouts of third-party registrations applicant has submitted, they are not evidence that the registered marks are in use or that the public is familiar with them, and they thus are of no probative value under the sixth *du Pont* factor. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). Moreover, the third-party registrations are of little probative value under the sixth *du Pont* factor in any event because, although they cover goods in Classes 9 and 11, the actual

goods identified in the registrations are far afield of the goods at issue in this case.³

In summary, we have considered all of the evidence of record as it pertains to the relevant *du Pont* factors. For all of the reasons discussed above, we find that the marks are similar and that the goods are similar and related. We conclude on that basis that a likelihood of confusion exists. We are not persuaded by applicant's arguments to the contrary.

Decision: The refusal to register is affirmed.

³ To the extent that applicant is arguing that these third-party registrations show that the word EQUINOX in itself is descriptive or generic and thus entitled to a limited scope of protection, that argument is wholly unpersuasive. As discussed above in connection with the first *du Pont* factor, we find that the word EQUINOX in fact is arbitrary as applied to the goods at issue in this case and that it thus is entitled to a broad scope of protection.