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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/782799

MARK: PCI

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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: Punching Concepts, Inc. d/b/a Pro
Cal, I ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

76602.76602.

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant: Punching Concepts, Inc. d/b/a Pro Cal, Inc. : BEFORE THE
Trademark: PCI : TRADEMARK TRIAL
Serial No: 78782799 : AND
Attorney: R. Scott Keller : APPEAL BOARD
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STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark PCI on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark in Registration No. 2537607.

FACTS

Applicant filed this application on December 30, 2005, applying to register on the Principal Register the mark PCI for "component parts for material handling machines, namely pulleys, deflection wheels, shafts, axles, track rollers, cam followers, wheel hubs, shaft and hub locking devices, clutches, brakes, torque limiters and take up frames."¹ In the first Office action dated July 6, 2006, registration was refused under Section 2(d) on the ground that the mark, when used in connection with the identified goods, so resembles the mark in Registration No. 2537607 as to be likely to cause confusion, to cause mistake, or to deceive. Applicant was also required to specify whether PCI had any

¹ This wording reflects the identification of goods as amended

significance in the material handling system trade or industry or as applied to the goods described in the application.

On January 2, 2007, applicant indicated the letters PCI had no significance in its trade or industry and traversed the Section 2(d) refusal.

On February 15, 2007, the statement regarding the significance of the mark was accepted and the refusal to register under Section 2(d) was made final and this appeal ensued.

OBJECTION

Applicant has attempted to introduce new evidence in its Appeal Brief. Specifically, internet evidence, consisting of a web page from Wikipedia, has not previously entered been introduced as evidence and the examining attorney objects to its introduction into the record at this time. The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d). Accordingly, if applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. TBMP §§1207 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999); TMEP § 710.01(c).

ISSUE

The issue on appeal is whether the mark, when used in connection with the identified goods, so resembles the mark in Registration No. 2537607 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

BECAUSE THE MARKS CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION AND WILL BE APPLIED TO CLOSELY RELATED GOODS, CONSUMER CONFUSION AS TO SOURCE IS LIKELY

(A) SIMILARITY OF THE MARKS: THE MARKS CREATE A HIGHLY SIMILAR COMMERCIAL IMPRESSION

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

When determining whether there is a likelihood of confusion under Section 2(d), the question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate 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 question is whether the marks create the same overall impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (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 (TTAB 1979); TMEP §1207.01(b).

Applicant applied to register the mark PCI. The registered mark is PCI PROCESS CONCEPTION INGENIERIE (and design). [Exhibit A].

(1) DOMINANT FEATURE OF THE MARKS

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). The design portion of registrant's mark is a circle containing four bands and an arc to the right of the circle. The design is merely a combination of common geometric elements and would serve a far less dominant source indicating function than the wording.

Furthermore, within the literal element of registrant's mark the letters PCI are featured as the dominant portion of the mark. The letters are much larger than the wording PROCESS CONCEPTION INGENIERIE. Thus, while the mark contains the wording PROCESS CONCEPTION INGENIERIE, consumers are likely to refer to registrant's goods as emanating from "PCI" because that is the visually dominant portion of the mark. The dominant portion of registrant's mark, the acronym PCI, is identical to applicant's entire mark, PCI.

(2) SIMILARITY IN APPEARANCE

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689

(TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987); TMEP §§1207.01(b)(ii) and (b)(iii).

Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and applicant would be free to adopt any style of lettering, including lettering identical to that used by registrant.

Therefore, applicant's presentation of its mark in standard character form means that applicant's mark could be used in the same manner of display as registrant's special form mark. *See In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); TMEP §1207.01(c)(iii).

The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

Applicant argues that its mark is the acronym for its trade name ProCal, Inc.; however, the applied-for mark does not contain this additional wording. There is no indication

from the application that a consumer would draw the conclusion supposed by the applicant. Instead, the marks must be compared as they appear in the drawings.

Applicant has applied for the letters PCI in standard characters. Were applicant's mark to proceed to registration, applicant would be entitled to use in the mark in any font or form without any additional wording or design elements. Consumers who encounter applicant's mark in the marketplace would not necessarily know what the acronym as used by applicant stands for. They would, however, encounter closely related goods bearing registrant's mark and applicant's highly similar marks and are likely to believe that the goods marketed under these marks emanate from a single source.

The commercial impression created by applicant's mark, PCI is highly similar to the commercial impression created by registrant's mark PCI PROCESS CONCEPTION INGENIERIE.

(B) SIMILARITY OF THE GOODS: APPLICANT'S IDENTIFIED GOODS ARE CLOSELY RELATED TO, AND CAN BE EXPECTED TO EMANATE FROM THE SAME SOURCE AS, REGISTRANT'S GOODS

Likelihood of confusion is determined on the basis of the goods identified in the application and registration. If the application or registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“With reference to the channels of trade, applicant's argument that its goods are sold

only in its own retail stores is not persuasive ... There is no restriction [in its identification of goods] as to the channels of trade in which the goods are sold”); TMEP §1207.01(a)(iii).

Applicant’s identified goods are “component parts for material handling machines, namely pulleys, deflection wheels, shafts, axles, track rollers, cam followers, wheel hubs, shaft and hub locking devices, clutches, brakes, torque limiters and take up frames.”

Registrant’s identified goods are “machines, namely, industrial robots and machines tools.”

(1) THE RESPECTIVE GOODS MOVE IN THE SAME CHANNELS OF TRADE

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, 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 come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i). A consumer who sees a highly similar marks on finished products and their component parts is likely to believe that they emanate from the same source.

Material handling systems are frequently composed of industrial robots in part. (See internet evidence attached to the Office action dated July 6, 2006 and incorporated

herein.) Because registrant's identification of goods does not contain any restrictions to the field or area of use, its goods encompass industrial robots used in material handling systems. Applicant's goods are component parts of materials handling machines and are therefore, closely related. It is likely that a consumer who encounters a component part of a material handling machine bearing a highly similar mark to the mark on the finished product would believe that the goods emanate from a single source.

(2) PURCHASERS WOULD BELIEVE THAT APPLICANT'S GOODS IN ARE WITHIN REGISTRANT'S ZONE OF EXPANSION

Any goods in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods are related to the applicant's identified goods for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the goods are within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

Third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant in this case have probative value to the extent that they serve to suggest that the goods listed therein, namely, machine tools, robots, and material handling systems are of a kind that may emanate from a single source. (See fourteen third party registrations attached to the Office action dated July 6, 2006 and incorporated herein.) *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). Because consumers

are accustomed to seeing these types of goods emanate from a single source under a common mark, consumers are likely to believe that the emanate from a single source when the goods are marketed under highly similar marks.

(C) SOPHISTICATED CONSUMERS

Applicant has argued that the consumers of its products are sophisticated (Applicant's brief at 3), but has not properly submitted any evidence in support of this contention. Furthermore, even if applicant had shown that the purchasers are sophisticated, 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii).

CONCLUSION

Applicant's mark PCI is likely to be confused with registrant's mark PCI PROCESS CONCEPTION INGENIERIE where applicant's mark creates a highly similar commercial impression and the marks are used on goods that are closely related. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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EXHIBIT A



PROCESS CONCEPTION INGÉNIERIE