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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trumpf GmbH + Co. KG

Serial No. 79021358

Peter L. Costas of Pepe & Hazard LLP for Trumpf GmbH + Co. KG.

Daniel S. Brody, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hohein, Cataldo and Ritchie-De Larena,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Trumpf GmbH + Co. KG to register the mark TRUWELD in standard character form on the Principal Register for the following goods, as amended: "industrial machine tools for welding workpieces using a laser beam" in International Class 7 and "lasers, not for medical purposes, in particular for the welding and treatment of workpieces" in International Class 9.¹

¹ Application Serial No. 79021358 was filed on October 25, 2005, based upon applicant's request for extension of protection under

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with its goods, so resembles the mark TRU-WELD, previously registered on the Principal Register in typed or standard character form for "fastening devices including welding studs and shear connectors" in International Class 6,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Applicant argues that, based upon a comparison of its goods and those of registrant, "there is no overlap and no competition" between them (brief, p. 8). Applicant further argues that the "purchasers of the goods of the prior registrant and of those of Applicant are discerning and discriminating buyers who would recognize that the respective goods come from different sources" (brief, p. 9). Applicant argues that, as a result, purchasers of its

Section 66(a) of the Act. Services in International Classes 37, 40 and 42, originally recited in this application but not subject to the refusal to register at issue in this appeal, were divided into a "child" application that subsequently matured into Registration No. 3265403.

² Registration No. 0734796 issued on July 24, 1962. Section 8 and 15 affidavits accepted and acknowledged. Second renewal.

goods will not be confused by "the prior registrant's usage for fastening devices including welding studs and shear connectors" (brief, p. 5). In support of its position, applicant has made of record photographs of its goods; copies of informational literature concerning the goods of registrant; and information regarding registrant and its goods taken from Internet web sites.

The examining attorney argues that applicant's mark is nearly identical to the mark in the cited registration. The examining attorney further argues that applicant's goods are related to those of registrant and move in related trade channels. In support of the refusal to register, the examining attorney has made of record information concerning applicant's and registrant's types of goods taken from Internet web sites.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between

the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We first consider the similarity of the marks. In this case, applicant's mark, TRUWELD, is nearly identical to the cited mark, TRU-WELD, in appearance. The only difference between the marks is the presence of a hyphen between the terms "TRU" and "WELD" in registrant's mark. The mere presence of this hyphen between the syllables comprising registrant's mark creates a minimal difference in the appearance of the marks which are otherwise identical. Furthermore, the hyphen in registrant's mark does not create any difference between it and applicant's mark as to sound. It is well settled that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). However, there is no logical reason, and certainly no evidence, that consumers would vocalize the hyphen in registrant's mark. Thus, applicant's mark is identical in sound to that of registrant. In addition, both marks

connote the same meaning that the goods identified thereby will provide a "true weld." As a result of the foregoing, the marks convey nearly identical commercial impressions. Finally, we note that applicant "concedes that the marks are nearly identical" (brief, p. 8). Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

The Goods

We turn now to our consideration of the identified goods, noting that it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's goods are industrial machine tools and lasers used for welding workpieces. Applicant explains that its goods "are utilized in factories and may be used for processing large sheet metal workpieces"

(brief, p. 6). Registrant's goods are "fastening devices including welding studs and shear connectors." Applicant has made of record the following information from registrant's Internet web site:

Since 1959 TRU-WELD has been an industry leader of weld stud sales and manufacturing. TRU-WELD manufactures weld stud fasteners for a vast variety of applications. From the small everyday handheld tool or yard machinery to automobiles, aircrafts, bridges, ocean liners & steel structure buildings to military vehicles, weld studs are all around us in our everyday lives. (www.truweldstudwelding.com)

In addition, the examining attorney has submitted evidence from informational and commercial Internet web sites suggesting that both applicant's and registrant's types of goods may be used for the same applications. The following samples are illustrative (emphasis added):

Noble International Ltd. is North America's largest **laser welder**. We provide **laser-welded** flat blanks (LWFB) and **laser-welded** tubular products (LWT) to the North American automotive industry. We provide automakers with higher-technology, high-value products that offer numerous advantages over traditional methods of automotive body construction... (www.nobleintl.com/business.asp);

At present, the automotive sector contributes to over half of the total demand for **laser welding** equipment in Europe. In an industry requiring an extensive amount of metal joining for the average unit of output, **laser welding** offers ease of automation, high welding speeds and better quality of welds - all of which help in reducing the average cost of production...

Apart from the automotive industry, heavy and light industrial manufacturing industries also currently generate sizeable demand and, in combination, account for just under one-third of the total demand...

(www.automotive.com/features/90/auto-news/20885/index);

The General Motors Worldwide (GMW) standards contains more than 65 documents and provides information that dealers, repair shops, and suppliers will find useful when repairing GM vehicles or supplying products and service to GM locations. The Engineering Fasteners collection of GMW standards covers such topics as: mechanical properties and material requirements, weld nuts, hexagon nuts, speed nuts, tie straps, **weld studs**, hexalobular screw, prevailing torque, gaging, hexalobular bolts, hexagon screws and washer assemblies.

(<http://auto.his.com/collections/gmw/egm90.htm>);

Virtually all automotive manufacturers worldwide use fasteners and automatic feed or high-speed robotic **stud welding** systems. Nelson offers a broad range of stud fasteners and both digital and analog based **stud welding** equipment to OEMs around the globe...Some of the more common uses include: **Studs** used for vehicle accessory components...

(www.nelsonstud.com);

Arc Stud Welding Applications

Because a weld produced by the Arc stud welding process offers such benefits as high structural integrity, excellent productivity, leak resistance, corrosion resistance, minimized noise and vibration, and many other benefits, it has found extensive use in a wide range of applications, including:

Composite construction - **Shear connectors** can be welded through metal decking or directly to the beam or girder in commercial building or highway bridges. The **shear connector** transfers the horizontal shear from the slab to the beam allowing a reduction in steel,

Power Generators - Boiler tubes may be studded when new or restudded when generators are down for general repair. The **weld studs**, normally 3/8 x 3/4" long are used for heat exchange, secure refractory material, and for increasing tube life.

Ship building - Arc stud welding is used to secure wire bundles or hydraulic lines to the overhead or bulkhead. Also, used for the strongback application of lining up exterior steel plates.

(www.weldstud.com/ws.arc.apps);

Welding Machines

Welding machines and joining machines encompass those devices that are used for numerous joining processes. These processes include:

Arc welding (MIG, TIG, tick, submerged arc)

Resistance welding

Laser welding

Electron beam welding

Stud welding...

(www.RodOvens.com); and

Laser welding is a new technology which uses a laser beam to melt and join the work-piece. Although the feasibility of **laser welding** has been proven, cost has prevented its commercial application to date. The potential for efficient, high-quality welding may make **laser welding** an important technique for shipbuilding in the future.

Stud welding is a form of electric arc welding in which the **stud** itself is the electrode...**Stud welding** is a semi-automatic process commonly used in shipbuilding to facilitate installation of non-metallic materials, such as insulation, to steel surfaces...

(www.ilo.org/encylclopedia).

The foregoing evidence suggests that applicant's machine tools using a laser beam for welding and lasers for welding may be used in the same industries, e.g., the automotive, industrial manufacturing, and shipbuilding

industries, as registrant's weld studs. In other words, registrant's goods may be found as components of welded vehicles and equipment that are manufactured in part using applicant's goods. As a result, applicant's goods clearly are related to those of registrant, and this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

We are not persuaded by applicant's arguments that its goods travel in channels of trade that are separate and distinct from those in which registrant's goods may be encountered. It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ

76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") As identified, neither applicant's nor registrant's goods contain any limitations as to trade channels or intended consumers. Accordingly, both applicant's and registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including consumers of each other's goods. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Conditions of Sale

The final *du Pont* factor discussed by applicant is that of the conditions of sale. Applicant asserts that its goods would be purchased by careful and sophisticated users. However, there is no evidence that either applicant's or registrant's goods would be purchased only by highly sophisticated persons. Moreover, in view of the Internet evidence suggesting that both applicant's and registrant's goods are of a type which may be used in the manufacture of the same goods, prospective purchasers may mistakenly believe that these goods could emanate from the same source. In addition, even if some degree of care were exhibited in making the purchasing decision, the marks TRUWELD and TRU-WELD are so similar that even careful

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purchasers are likely to assume that the marks identify goods emanating from a single source. Finally, it is settled that even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988).

In summary, weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. Moreover, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.