

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: February 12, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Buhler Technologies GmbH

Serial No. 79034792

Friedrich Kueffner of Law Office of Friedrich Kueffner for
Buhler Technologies GmbH.

Charisma Hampton, Trademark Examining Attorney, Law Office
112 (Angela Wilson, Managing Attorney).

Before Walsh, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Buhler Technologies GmbH
to register the following mark on the Principal Register:



¹ Application Serial No. 79034792 was filed on July 12, 2006, seeking an extension of protection under Section 66(a) of the Trademark Act based upon its International Registration No. 0914230, issued on July 12, 2006. Color is not claimed as a feature of the mark.

for the following goods:

Couplings and gearing for power transmission for machines that are not land crafts; filters, especially gas filters; partial air flow filters as parts of machines; oil draining pumps, all the above goods for use in connection with fluid-technical systems as well as systems for analysis of gases and liquids

in International Class 7;

Analyzing systems composed of scientific and laboratory instruments, essentially consisting of devices for extracting, conveying, recycling and analyzing of gases, gas mixtures and fluids from experiments from the environment, namely gas meters, gas chromatography apparatus, gas detectors for detecting the presence of gas, gas meters, residual gas analyzers, apparatus for testing gas and liquids and probes for gas detection; apparatus for indicating malfunctions in gas and liquid handling equipment, namely, level switchers, devices for temperature-monitoring, devices for filling level monitoring, humidity monitors incorporating transmitters for use in connection with fluid-technical systems as well as systems for analysis of gases and liquids

in International Class 9; and

Machines for purification, distribution and filtering of gases used in fluid technologies systems, namely, fibers filtering media for general industrial use and the purification of industrial fluids in water purification tanks; instruments for cooling, drying and ventilation, namely, pumps sold in combination for use in hot tubs, cooling recovery systems, comprising gas coolers, gas condensers other than parts of machines; mixture faucets for water pipes and replacement part thereof, heat exchangers not being parts of machines, air filters for air conditioning units for use in connection with fluid-technical systems as well as systems for analysis of gases and liquids

in International Class 11.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as sought to be protected in connection with its goods, so resembles the marks

BUHLER²

(in typed or standard characters) issued to Buhler-Miag, Inc. for the following goods and services:

roller mills; mechanical sieves and sifters; coal processing plants; cocoa processing plants; grain separators; mixing machines; extruding presses; pneumatic conveying equipment; chain conveying equipment; shipboard and port equipment for loading and unloading bulk materials; macaroni presses; ink and color processing machines; and machines for grinding and treating garbage and refuse and for waste disposal

in International Class 7;

filters and air cleaners for industrial use; drying and air-conditioning installations for industrial use

In International Class 11;

constructing and repairing plants for flour, corn and rye mills, breweries, oil mills, malting, for the manufacture of macaroni, chocolate, cocoa, paints, printing inks, mixed animal foods, chemical products, food products, rice milling, the treatment of rice and cereals, for silos (of the non-prefabricated type), for material handling, for the treatment of garbage and refuse and for waste disposal

² Registration No. 0857430 issued on September 24, 1968. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

In International Class 37;

BUHLER³

(in typed or standard characters) issued to Buhler AG for
"electrical control panels and consoles for process
control" in International Class 9;



issued to Buhler AG for the following goods and services:

machines, namely machines for cleaning,
controlling dust, grinding, sorting, mixing,
reducing size, processing, hulling,
degerminating, sifting, bolting, flaking, and
pulverizing, and for and bagging of all kinds of
raw materials, intermediate products and finished
products, for use in the flour-milling industry,
in the baked-goods industry, in the manufacture
of pasta, snacks, cous-cous, dry soup mixes,
infant food, starches, and other foods, in the
candy and chocolate industry, in the coffee
industry, in the rice industry, in the edible-oil
industry, in malting houses and breweries and in
the feed industry; mechanical and pneumatic
conveying systems comprising elevators, chain
conveyors, conveying pipes, airslide conveyors
for piece goods; ship unloading and loading
systems comprising cranes with pneumatic suction
conveying; filter systems comprising dust
collection filters for industrial use; systems

³ Registration No. 1047573 issued on September 7, 1976. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

⁴ Registration No. 1952342 issued on January 30, 1996. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

for utilization or disposal of solid and liquid waste, namely composting and fermentation machines; machines for the chemical industry, namely paint manufacturing machines, plastic coating manufacturing machines, laundry and cleaning detergent manufacturing machines, toilet and household soap manufacturing machines, cosmetic product manufacturing machines, insulating material and filler manufacturing machines, metal die-casting machines and metal injection molding machines

in International Class 7;

controls, controllers and control systems comprising electronical control units, sensors and measuring devices and automation systems comprising computers, computer peripherals and computer programs as well as electrical control panels for operating and controlling industrial machinery; measuring instruments and controlling devices, namely temperature, humidity, pressure for acquisition and processing of measured values; weighing and metering devices, namely weighers, gravimetrical weighers, flowweighers, fluid-weighers for industrial machinery; laboratory equipment, namely roller stands, partical-and material-analysis equipment for testing grains and flour; and analysis equipment, namely measuring and optical apparatus, instruments and spectrometers in the near infrared; instruments for analyzing, data processors for measuring and evaluating data, software and hardware for analyzing organic substances; machines for metering and weighing all kinds of raw materials, intermediate products and finished products, for use in the flour-milling industry, in the baked-goods industry, in the manufacture of pasta, snacks, cous-cous, dry soup mixes, infant food, starches, and other foods in the candy and chocolate industry, in the coffee industry, in the rice industry, in the edible-oil industry, in malting houses and breweries and in the feed industry

in International Class 9;

drying, desiccating, heating and cooling installations for raw materials and semi-manufactured goods of all kinds; filtering systems and equipment, namely bag filters, dust collectors and dust separators

in International Class 11;

business consultation in financial questions; financing of third party projects for the construction of industrial equipment and machinery

in International Class 36;

construction planning, construction supervision, maintenance and repairing of industrial plants, control units and machinery for flour mills, plants and machinery for the baked-goods industry, for the dry-soup production, for the infant food production, for the cous-cous production, for the production of starch and other foodproducts, for the edible-oil industry, for the waste treatment and recycling industry, for the chemical industry (paints, varnishes, detergents and soaps), for feed mills, for the snack production, for the pasta production, for rice mills, for breweries and malting houses, for coffee processing, for candy and chocolate factories, for the ink production, for pneumatic conveying systems, for filter systems for industrial use, for plastic and rubber industries, for loading and unloading of ships and for silo equipment, for mechanical and pneumatic conveying systems, for injection-molding and die-casting systems

in International Class 37;

educational services, namely conducting seminars, conferences and classes in the field of managing and supervising of our plants in the flour milling industry, in the baked good industry, in the manufacture of pasta, snacks, cous-cous, dry soup mixes, infant food, starches, and other foods, in the candy and chocolate industry, in the coffee industry, in the rice industry, in the

edible-oil industry, in malting houses and
breweries and in the feed industry, publication
of books, brochures and periodicals

in International Class 41;

technical consultation engineering analysis;
engineering services; editing of books, brochures
and periodical; creating programs for data
processing for third parties; expert witness
services

in International Class 42;

and



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issued to Buhler Motor GmbH for the following goods:

Machine parts, namely electric motors, in
particular brushless direct current motors, small
direct current motors, direct current fractional
horse power motors, small direct current gear
motors, alternating current fractional horse
power motors, small alternating current gear
motors, linear motors, synchronous motors, small
synchronous gear motors, planetary gear motors,
stepper motors; machine parts, namely
electronically operated fans for machine engines,
in particular small direct current fans; machine
parts, namely small gears, electronically
operated curtain drawing devices for machine

⁵ Registration No. 2714907 issued on May 13, 2003.

engines, speed governor for machines, engines and motors, dynamos, generators of electricity, and electric motors other than for land vehicles; blowing machines for the compression, exhaustion and transport of gasses; alternators; gears, other than for land vehicles; transmissions for machines; transmission other than for land vehicles; compressors for refrigerators; fans for motors and engines of machines; pumps for machines, industrial engines and motors for pumping liquids or air; industrial machine pumps for pumping liquids or air; electricity armatures, namely, rotors for electric motors; reduction gears other than for land vehicles; air suction machines; suction machines for industrial purposes; lubricating pumps; machine parts, namely reels; stands for machines; machine parts, namely starters; current generators; machine parts, namely vacuum pumps; machine parts, namely valves for regulating liquid or air flow; centrifugal pumps

in International Class 7;

Electric control mechanisms for machines, engines or motors; encoders, namely electronic devices for measurement of the rotation of revolving parts like shafts and the like used in the generation of electrical signals; self regulating fuel pumps; revolution counters; electromagnetic coils; electric anti-interference devices, namely interference suppressors or radio shielding units; automatic steering apparatus for vehicles, namely electro-hydraulic gear systems or parking assistance direct drives; electro-dynamic apparatus for the remote control of signals, namely hall sensors and photoelectric barriers; electric locks; electric coils; electricity transformers, electric closers; electricity armatures, namely rotors for electric motors

in International Class 9;

Electromotively operated fans, in particular small direct current fans; heat pumps; air conditioning fans; parts of air conditioning installations, namely fans; level controlling

valves in tanks and heat pumps; oil pumps for heating installations

in International Class 11.

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

Likelihood of Confusion

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 most likelihood of confusion analysis, two key, though not exclusive, 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).

However, in this case, we have a third key consideration, namely, letters of consent from the owners of the cited registrations to allow registration and use of applicant's involved mark. The agreements provide in their entirety as follows:

LETTER OF CONSENT

We, the undersigned

Buhler AG, Bahnhofstrasse, CH-9240 UZWIL/
Switzerland

are owners of the US-Trademark registrations
numbers: 857430, 1952342 and 1047573.⁶

We hereby consent to the registration and use of
the trademark "Buhler" US-Trademark Application
No. 79/034792 by Buhler Technologies GmbH, a
German corporation without limitation, of
Harkortstrasse 29, 40880 Ratingen, Germany, in
the USA.

Letter of Consent

We,

Buhler Motor GmbH
Anne-Frank-Str. 33-35
D-90459 Nurnberg
Germany

are owner of the US-Trademark "Buhler",
registration no. 2714907. We hereby consent to
the registration and use of the trademark
"Buhler" international registration no. 914230,
US application no. 79034792, filed by Buhler
Technologies GmbH, Hartkortstr. 29, 40831
Ratingen, Germany, in the USA except for the
registration and use of the just mentioned
trademark for the goods "motors (except motors
for landcrafts)" in class 07.⁷

⁶ Applicant asserts that Buhler-Miag, Inc., record owner of
Registration No. 0857430, is a wholly-owned subsidiary of Buhler
AG, record owner of Registration No. 1952342. The examining
attorney does not dispute this assertion.

⁷ Applicant subsequently deleted the goods identified as "motors"
from its identification of Class 7 goods.

In its brief on appeal, applicant concedes that "the marks of the cited Registrations and of the present application are essentially identical" (brief, p. 2). However, applicant argues that "the goods and/or services are sufficiently different for avoiding a confusion between the marks" (Id.) Applicant argues in addition that the goods in question are sold in different channels of trade, and that the goods "are relatively expensive items and the level of sophistication of the relevant purchasers must be considered high" (Id. at 4). Applicant further argues that its consent agreements with the owners of the cited registrations, even if found to be naked consents, possess "some weight as evidence in determining the likelihood of confusion issue" (Id. at 3). Finally, applicant argues that "the marks are primarily merely surnames and, therefore, are afforded a narrow degree of protection" (Id.).

In her brief on appeal, the examining attorney contends that the marks are confusingly similar and that applicant's goods as well as those of registrant are broadly identified and may encompass one another. The examining attorney further contends that there are no limitations as to the trade channels for either applicant's goods or registrants' goods and services. The examining

attorney contends in addition that there is no evidence that either applicant's or registrants' goods will be sold only to professionals. Finally, the examining attorney contends that the consent agreements proffered by applicant are naked consents that are insufficient to overcome the likelihood of confusion in this case.

Other than the letters of consent described above, neither applicant nor the examining attorney has made any evidence of record in support of their respective positions.⁸

Letters of Consent

We begin our consideration of applicant's letters of consent by observing that our primary reviewing Court has on numerous occasions demanded that this Board give "great weight" to consent agreements which are not merely naked consent agreements. See, for example, *Bongrain International v. Delice de France*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987). In this case, however, the owners of the three cited registrations have merely consented to the registration and use of applicant's

⁸ We note that with its June 2, 2008 notice of appeal, applicant indicated that it "is in the process of obtaining consent agreements from the owners of the cited registrations which are not merely naked consents but are drafted in accordance with the guidelines set out by the Examining Attorney..." However, no such additional consent agreements are of record.

involved mark. Further, because the subject application is based solely upon treaty rights and not use in commerce, there is neither evidence of use of the mark nor any real basis for the affected parties to determine that, based upon prior experience, confusion is unlikely to occur. See, for example, *In re Mastic, Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987). Nor do the letters of consent contain any additional information regarding the underlying facts which led the parties to conclude that confusion is not likely. See *Id.* As such, and as acknowledged by applicant in its notice of appeal, the letters of consent are "naked" consents that fail to establish either the factual basis for the parties' recognition of each other's right to use and register their respective marks, or their agreement to restrict their uses to the goods and/or services identified thereby to avoid confusion. See *Id.* Cf. *Bongrain, supra*, at 1482, USPQ2d at 1776.

Nonetheless, the letters of consent, while not conclusive on the issue of likelihood of confusion, are entitled to some probative value. Specifically, we may infer from the fact that consent was given by both registrants that the owners of the cited registrations do not believe confusion is likely. See *In re Donnay*

International Societe Anonyme, 31 USPQ2d 1953, 1956 (TTAB 1994).

The Marks

We now turn our attention to a comparison of the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test 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 entireties that confusion as to the source of the goods and services offered under the respective marks is likely to result.

In this case, and as noted above, applicant has conceded that its mark is "essentially identical" to the marks in the cited registrations. We agree that the word portion of applicant's mark, BUHLER, is identical to the marks in cited Registration Nos. 0857430 and 1047573 and identical to the word portion of the marks in cited Registration Nos. 1952342 and 2714907.

Further, we find that BUHLER is the dominant element of both applicant's mark and the cited marks, and

accordingly it is entitled to more weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In applicant's mark, as well as the marks in Registration Nos. 1952342 and 2714907, the relatively simple designs are visually less significant and contribute less to the overall commercial impressions thereof than the word BUHLER. This is because when a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For these reasons, we consider BUHLER to be the dominant feature of all the involved marks. The term BUHLER as it appears in applicant's mark as well as the mark in all four cited registrations, is identical in sound and connotation and highly similar in appearance.

Thus, we find that, when viewed as a whole, applicant's mark is highly similar to the marks in the cited registrations in appearance, sound, and connotation, and that the marks convey highly similar commercial impressions.

Strength of the Marks

Turning next to our consideration of the strength of the marks in the cited registrations, we note that applicant argues, with no evidentiary support, that BUHLER is a surname and thus entitled to a narrow scope of protection. We further note that neither the involved application nor any of the cited registrations contains a disclaimer of BUHLER or a claim of acquired distinctiveness under Section 2(f) of the Trademark Act as to that term. As such, we find applicant's unsupported argument that BUHLER is a surname to be unpersuasive.

However, we note that at least two separate entities have obtained registration of marks that include the term BUHLER as their sole or most distinctive element. In addition, both of those entities have consented to the registration of the mark in the involved application, which also includes the term BUHLER as its most distinctive element. In the absence of any other evidence directed toward the relative strength of the marks in the cited

registrations, we find that by their actions the registrants have contributed to the weakening of their marks such that they are entitled only to a somewhat narrowed scope of protection that is less than that to which a stronger mark may be entitled.

The Goods

We next turn to the similarity or dissimilarity between applicant's goods and the goods and services in the cited registrations. We note at the outset that the examining attorney has presented neither arguments nor evidence that applicant's goods are similar or otherwise related to the services recited in Registration Nos. 0857430 and 1952342. Nor do we find that, as recited, there is an obvious relation between applicant's goods and the services in those registrations.

Turning then to registrants' goods, we note the examining attorney's assertion that because applicant's and registrants' goods are "identified broadly" (brief, p. 10) "it is presumed that they encompass all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers" (Id.). However, applicant's goods are all used in the fields of filtering, analyzing, distributing and monitoring fluids and gases. Registrants' good are used in the fields

of food and waste processing, air cleaning and conditioning, manufacturing, motors, engines and electrical devices used with such motors. As identified, both applicant's and registrants' goods are used for specific purposes that are not clearly related or encompassed by one another. Thus, we do not find that, for instance, applicant's "pumps sold in combination for use in hot tubs," which appear to be a component part of a finished product, are related to the "heat pumps" identified in Registration No. 2714907. Nor do we find that applicant's "air filters for air conditioning units" and "partial air flow filters as parts of machines," again component parts of finished products, are related to the "filters and air cleaners for industrial use" identified in Registration No. 0875430. Further, and as noted above, the examining attorney has not submitted any evidence to support her contention that the goods identified in the involved application and cited registrations are related.

In short, in the present case, there is no evidence to support the examining attorney's conclusory statement that registrants' goods and applicant's goods are related. Nor are applicant's goods, as identified, obviously related to registrants' goods such that we may find upon the face thereof that they are complementary, that a viable

relationship exists between them, or that such goods would move in the same or related channels of trade.

Based on this record and the mere conclusory statement of the examining attorney, we see the likelihood of confusion claim asserted by the examining attorney as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g 153 USPQ 412 (TTAB 1967). Further, we are not persuaded that applicant's goods are within the normal field of expansion for registrants' recited goods or services. Simply put, there is nothing in the record to support a finding that purchasers are likely to believe that registrants will expand their goods and/or services to encompass the goods recited in the application at issue. Cf. In re General Motors Corp., 196 USPQ 574 (TTAB 1977). Accordingly, based upon the record before us this *du Pont*

factor weights heavily against a finding of likelihood of confusion.

In reaching our decision on likelihood of confusion we have not relied upon applicant's arguments regarding sophistication of purchasers. Applicant asserts that due to the expense of its goods purchasers thereof are sophisticated and capable of discriminating between its goods and the goods and services of registrants. In that regard, we note that, as identified, most, if not all applicant's goods appear to be the type that would be used or purchased by sophisticated purchasers. However, there is no evidence of record that registrant's goods would be purchased only by highly sophisticated persons. Further, 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). Accordingly, we find this du Pont factor neutral in this case.

Summary

In view primarily of the dissimilarity between applicant's goods and the goods and services recited in the cited registrations, and giving some weight to the letters of consent to the use and registration of applicant's mark executed by the owners of all of the cited registrations,

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we find that the examining attorney has not met her burden of demonstrating that a likelihood of confusion exists between applicant's goods and registrant's goods and services.

Decision: The refusal of registration is reversed. Accordingly, the involved application will be forwarded for registration in due course.