

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Vulcanic
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Serial Nos. 79124238 and 79124239
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Andy I. Corea of St. Ong Stewart Johnston & Reens,
for Vulcanic.

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Before Quinn, Bergsman and Hightower,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Vulcanic (“Applicant”) seeks registration on the Principal Register of the marks
VULCANIC (in standard characters)¹ and the mark shown below²

¹ Application Serial No. 79124239, filed January 24, 2013, based on International Registration No. 1067199 issued on January 4, 2011.

² Application Serial No. 79124238, filed January 24, 2013, based on International Registration No. 1066675 issued on January 4, 2011. The application includes the following statements: “The mark consists of the stylized wording ‘VULCAN’ in black and a stylized circular design in red representing a heating element, and with dark red shadowing. The colors(s) RED, DARK RED and BLACK is/are claimed as a feature of the mark.”



both for the following goods and services:

Scientific, measuring, signaling, checking and supervision, and teaching apparatus and instruments, namely, electricity conduits, electricity distribution consoles, electricity limiters, electricity routers for managing and optimizing energy loads within machines and within a building; electricity voltage regulators; LCD monitors for displaying electricity usage; electrical distribution boxes; electrical distribution circuit boards; electric batteries; electric couplings; electrical junction boxes; electric cables; electric installations for the remote control of industrial operations; electronic devices, namely, energy meters for tracking and monitoring energy usage; electric resistors; temperature controllers for industrial applications; temperature indicators; temperature probes for non-medical use; thermostats; mercury level gauges; boiler control instruments; fire alarms; measurement converters; data processing equipment and computers; computer software recorded on data media for controlling heating and cooling apparatus; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers; prerecorded video discs featuring information regarding heating and cooling systems; computer screens and monitors (in International Class 9);

Heating installations and cooling units for industrial purposes; steam generating installations; refrigerating machines and installations; drying apparatus for use in heating, ventilation, air conditioning, and refrigeration systems; climate control devices consisting of ventilation control devices; heating installations for heating air, fluids, solids, corrosive preparations, water and any other liquids; heating installations for infrared heating; heating apparatus for solid, liquid or gaseous fuels; heating radiators; electric heaters for commercial use; electric

radiators; heating boilers; electrical boilers; automatic waters feeders being parts for heating boilers; electric heating stoves, not for cooking; heat pumps; heaters for vehicles; electric hot air generators for use in heating; heat accumulators; heat regenerators, not being parts of machines; heating elements; electric heating filaments; fireplaces, domestic; solar collectors for heating; immersion heaters; electric heating cables; electrical heating tapes; heating element cartridges; temperature control devices, namely, thermoregulators and heat exchangers, not parts of machines; cooling installations for cooling air, fluids, water and any other liquids; air conditioning units; ventilation fans for air conditioning units; ventilation air-conditioning installations for vehicles; air conditioning apparatus and installations; cooling installations for liquids; ventilation hoods; air filtering installations; electric air purifiers and deodorizers; fans being parts of air-conditioning installations; refrigerating installations and machines; apparatus and installations for refrigeration and cooling; coolers for furnaces; steam accumulators; steam generating installations; humidifiers for central heating radiators; infrared generators for heating and drying; fuel economizers in the nature of energy recovering ventilators In International Class 11);

Installation, maintenance and repair of apparatus and installations relating to electric heating and cooling especially for industry; providing information in the field of industrial installation, maintenance and repair of electrical heating and cooling apparatus and installations for industry (in International Class 37); and

Scientific and technical research in the field of engineering; industrial research services in the field of heating and cooling; surveying; engineering services, namely, technical project planning in the field of heating and cooling; material testing, all the aforesaid services provided particularly in the fields of electric heating and cooling for industry (in International Class 42).

Under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), the holder of an international registration may file a request for extension of protection of that

registration to the United States, as Applicant has done here. An applicant who files such a request must declare its intention to use the mark in the United States, Section 66 of the Trademark Act, 15 U.S.C. § 1141f(a), and the resulting U.S. application is subject to examination and opposition, Section 68 of the Trademark Act, 15 U.S.C. § 1141h.

The Trademark Examining Attorney refused registration in both applications *in Classes 9 and 11 only*. Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the bases of the previously registered marks VULCAN (in typed letters) for “heating, cooling and air conditioning apparatus, namely, heat transfer elements and enclosures therefor, heating and ventilating units and parts therefor; diffusers for forced air heating and cooling systems, and fluid and electric radiators, namely, finned tube heat transfer elements and enclosures” (in International Class 11);³ and VULCAN CAL-STAT (in typed letters) for “thermostats” (in International Class 9).⁴ The Examining Attorney maintains that Applicant’s mark, when applied to Applicant’s goods in Classes 9 and 11, so resembles the two previously registered marks for the identified goods as to be likely to cause confusion.⁵ The cited registrations are owned by different entities.

When the refusals were made final, Applicant appealed. The Board, on March 16, 2015, granted Applicant’s request to consolidate the two appeals. The appeals

³ Registration No. 1609678, issued August 14, 1990; renewed.

⁴ Registration No. 1281328, issued June 12, 1984; renewed.

⁵ With respect to Applicant’s mark in standard characters and Registrants’ marks in typed letters, it is noted that prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (2015).

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involve common issues of law and fact, and are based on the same evidentiary record. Pursuant to the consolidation, Applicant and the Examining Attorney filed single briefs covering both appeals. Accordingly, we will issue a single opinion in these consolidated appeals.

The Examining Attorney maintains that each of Applicant's marks is similar to each of the cited marks. Further, the Examining Attorney asserts that the goods are related, all being used in connection with heating and cooling equipment, or temperature regulation. In support of the refusals, the Examining Attorney introduced dictionary definitions of the words "volcanic" and "Vulcan," and portions of Applicant's and Registrant's websites, as well as third-party websites.

Applicant argues that the cited marks are weak or diluted in the industry, relying on the third-party registrations that the Examining Attorney originally raised as Section 2(d) bars, and then withdrew. Applicant also contends that purchasers are highly sophisticated.

In considering the refusals, we have decided to confine our decision to a consideration of the likelihood of confusion between Applicant's marks and the mark VULCAN shown in Registration No. 1609678. We do so on the basis that this registration for the mark and identified goods, when considered vis-à-vis the applied-for marks and identified goods, is most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Marks

With respect to the first *du Pont* factor, we must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark VULCANIC in standard characters is similar to the registered mark VULCAN in sound and appearance; Applicant's mark is a VULCAN-formative term, differing from the registered mark only by the suffix "-IC," and is likely to be perceived by purchasers as merely a close variation of the registered mark.

Insofar as meaning is concerned, the word "Vulcan" is defined as "the ancient Roman and Greek god of fire and metalworking." (*The American Heritage New Dictionary of Cultural Literacy* (2005)). Contrary to Applicant's argument that the term "Vulcanic" has no recognized meaning, the record reveals otherwise. The word "Vulcanic" is defined as "of or pertaining to Vulcan; made by Vulcan; Vulcanian; of or pertaining to volcanoes; specifically, relating to the geological theory of the Vulcanists, or Plutonists." (*Webster's Revised Unabridged Dictionary* (1998)). Based on the dictionary evidence, the words "Vulcan" and "Vulcanic" have similar meanings, and both, when considered in the context of heating apparatus, suggest the same idea, namely heat or high temperature. Accordingly, as used in connection with Applicant's and Registrant's goods, the marks convey similar meanings.

In view of the similarities in appearance, sound and meaning, we find that the marks VULCANIC in standard characters and VULCAN in typed letters engender overall commercial impressions that are similar.

Accordingly, we find that these marks, if used in connection with similar or related goods, would be likely to cause confusion among purchasers.

As to a comparison between Applicant's VULCANIC and design mark and the registered mark, although marks must be considered in their entireties, it is settled

that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). With respect to logo marks, where both words and a design comprise the mark as in the case of Applicant’s mark, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion. ... This makes sense given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.”); *see also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation’s Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Accordingly, Applicant’s logo mark is dominated by the term VULCANIC which, as discussed above, is similar to the entirety of the registered mark VULCAN.

Even though the dominant portion of Applicant’s logo mark is similar to the entirety of Registrant’s mark, we cannot overlook the prominent design portion of

Applicant's mark. The cited mark is VULCAN in typed letters. It differs visually from Applicant's mark in that it lacks the design feature and the slightly stylized lettering of Applicant's mark.⁶ In sum, the marks are visually similar to the extent that they both include the distinctive terms VULCANIC and VULCAN, but otherwise they are visually different.

In sound, the terms VULCANIC and VULCAN would be similarly pronounced in each mark.

With respect to the meanings of the marks, the terms VULCANIC and VULCAN, as discussed above, have similar connotations. If anything, the design feature of Applicant's mark, which Applicant describes as a red "heating element," reinforces the suggestion of heat or high temperature. Overall, we find the two marks to be substantially similar in meaning, especially when they are considered in the context of the identified heating-related goods of Applicant and Registrant.

While we appreciate the difference in appearance and slight difference in sound as between the two marks, we find that in overall commercial impression they are quite similar. As indicated earlier, we bear in mind that the "marks 'must be considered ... in light of the fallibility of memory ...,'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), and that the proper focus is on

⁶ It should be noted, however, that a mark in typed (or standard character) form may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); Trademark Rule 2.52(a); TMEP § 1207.01(c)(iii). Thus, it must be presumed that Registrant's mark may be displayed in the same font and style as the VULCANIC portion of Applicant's logo mark. *In re Viterra*, 101 USPQ2d at 1910 (a standard character mark may be used in all depictions regardless of the font style, size, or color, and not merely "reasonable manners" of depicting such mark).

the recollection of the average customer, who retains a general rather than specific impression of the marks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013). In this case, the similarities outweigh the differences.

Accordingly, when each of Applicant's marks is compared to the registered mark, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

The Goods

As to the second *du Pont* factor, when analyzing the similarity of the goods, "it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion." *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722, citing *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). Instead, likelihood of confusion can be found "if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Id.* The issue here, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162

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(Fed. Cir. 2014), quoting *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). Likelihood of confusion must be found if there is likely to be confusion with respect to *any* item in a class that comes within the identification of goods and/or services in the application and cited registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Registrant's goods are identified as follows: "heating, cooling and air conditioning apparatus, namely, heat transfer elements and enclosures therefor, heating and ventilating units and parts therefor; diffusers for forced air heating and cooling systems, and fluid and electric radiators, namely, finned tube heat transfer elements and enclosures." Applicant's identification in each application includes the following goods: "temperature controllers for industrial applications; temperature indicators; thermostats; boiler control instruments; computer software recorded on data media for controlling heating and cooling apparatus" in Class 9; and "heating installations and cooling units for industrial purposes; steam generating installations; refrigerating machines and installations; drying apparatus for use in heating, ventilation, air conditioning, and refrigeration systems; heating installations for heating air; heating radiators; heat pumps; electric hot air generators for use in heating; heating elements; electric heating filaments; heating element cartridges; cooling installations for cooling air; air conditioning units;

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ventilation fans for air conditioning units; air conditioning apparatus and installations; and apparatus for refrigeration and cooling” in Class 11.

The above goods are related insofar as all are directed to heating, ventilation and/or cooling, and temperature control and regulation; both Applicant and Registrant offer heating, ventilation and air conditioning (“HVAC”) goods. Indeed, there appears to be an overlap with respect to radiators and heating elements in Class 11. The similarity between the goods is buttressed by the respective websites of Applicant and Registrant. The websites indicate that both Applicant and Registrant offer their similar HVAC products to the same industries, including packaging, power generation and alternative energies.

This finding of similarity is further corroborated by the third-party websites introduced by the Examining Attorney. The several websites show that a variety of heating, ventilation and air conditioning apparatus often originate from the same source, and under the same mark; the various products include thermostats, heating and cooling apparatus and installations, air diffusers, temperature regulators, and the like. These websites include the following: <trane.com>; <lennox.com>; <Westinghouse.com>; <johnsoncontrols.com>; <tempco.com>; <chromalox.com>; and <emersonclimate.com>.

Applicant’s argument that its Class 9 goods primarily serve to control electrical energy loads in buildings is of no moment in our analysis, inasmuch as Registrant’s identification of goods does not include limitations, so we must assume that the goods covered by the cited registration also are used in buildings.

We find that the goods are related and, as shown by the website evidence, travel in similar trade channels (e.g., online retailers of HVAC equipment, HVAC installation companies, and the like). The goods are ultimately sold to the same classes of purchasers, that is, HVAC installers, as well as the ultimate customers seeking HVAC systems.

The factors of similarity between the goods, trade channels and classes of purchasers weigh in favor of a finding of a likelihood of confusion.

Third-Party Registrations of Similar Marks

The sixth *du Pont* factor focuses on the number and nature of similar marks in use on similar goods. In connection with this factor, Applicant relies upon the seven third-party registrations originally cited by the Examining Attorney as bars under Section 2(d), but subsequently withdrawn as refusals: Reg. No. 4001176 for VULCAN for “hand dryers”; Reg. Nos. 2193935, 2193936, 666878, 666879 and 674532 (all owned by the same entity) for cooking equipment; and Reg. No. 2663624 for VULCAN for computer software for use in film production, television and radio, and for use in computer software development in the fields of music, art, science, technology, telecommunications, medicine, health, finance, investment, education and entertainment.

Extensive evidence of third-party use and registrations may be probative in showing that a term is weak and that customers have been educated to distinguish between different marks on the basis of small distinctions. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*,

___F.3d___, ___USPQ2d___, No. 14-1789 (Fed. Cir. Aug. 19, 2015); *Juice Generation, Inc. v. GS Enters. LLC*, ___F.3d___, 115 USPQ2d 1671 (Fed. Cir. 2015). Because the goods listed in the third-party registrations referenced by Applicant are different from the goods involved in these appeals, the third-party registrations are not evidence that the term “VULCAN” is weak or diluted for the HVAC goods at issue in the present case. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue). *See also Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word ‘KEY’. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here.”); *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) (“Registrations for goods unrelated to the clothing field are irrelevant to our discussion.”); *Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329, 336 (TTAB 1979) (“we need not comment on the third-party registrations placed in the record by applicant save to note that they pertain to completely unrelated goods and are therefore irrelevant.”).

Specifically, Registration Nos. 4001176 is for hand dryers. Registration Nos. 666878, 666879, 674532, 2193935, and 2193936 all feature goods in the nature of cooking appliances, such as kettles, ovens, electric cooking ranges, and deep fat

fryers. By contrast, Applicant's and Registrant's goods are HVAC products. In fact, Applicant's identification of goods expressly excludes heating stoves "for cooking," making it clear that the channels of trade for its goods differ from those of this third-party registrant. Likewise, the specific computer software for use in film production and the like identified in the previously cited Registration No. 2663624 differs from Applicant' and Registrant's HVAC products.

Accordingly, the evidence of strength of the cited mark, consisting of only seven third-party registrations (five of which are owned by a single entity), is readily distinguishable in this case from the evidence in the recent *Jack Wolfskin and Juice Generation* cases.

In sum, Applicant has not shown the term "VULCAN" or "VULCANIC" is weak or diluted for any of the goods in the cited registration. Rather, the mark VULCAN is distinctive in the HVAC industry. This factor favors a finding of likelihood of confusion.

Sophistication of Purchasers

Contrary to Applicant's contention regarding the sophistication of purchasers, there is nothing in the respective identifications of goods that warrants a finding, based solely on the identifications, that consumers of either Applicant's or Registrants' goods would make a careful purchasing decision. That is to say, the nature of the goods, in and of themselves, does not necessarily dictate that purchasers are sophisticated. Moreover, there is no evidence in support of Applicant's claim. However, even assuming that Applicant's and/or Registrant's

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goods may involve a careful purchase, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving very similar marks and similar goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers...are not infallible.”). *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarity between the marks and the similarity between the goods sold thereunder would outweigh any presumed sophisticated purchasing decision. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff’d*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

In view thereof, we find this factor to be neutral.

Decision: In view of the above, we find that the marks and goods of Applicant and the mark and goods shown in Registration No. 1609678 are sufficiently similar that purchasers are likely to be confused.

The refusal to register under Section 2(d) on the basis of Registration No. 1609678 in each application is affirmed.