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Subject: U.S. TRADEMARK APPLICATION NO. 79124239 - VULCANIC - 06286-T0002A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79124239

MARK: VULCANIC



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: VULCANIC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

06286-T0002A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

INTERNATIONAL REGISTRATION NOS. 1067199 AND 1066675

The applicant has appealed the trademark examining attorney's refusal to register the marks "VULCANIC" and "VULCANIC (& DESIGN)" both for "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 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; 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 of 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, on the grounds that it is likely to cause confusion with the registered marks “VULCAN” (U.S. Registration No. 1609678) 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 and “VULCAN CAL-STAT” (U.S. Registration No. 1281328) for “Thermostats” in International Class 9.

#### **STATEMENT OF FACTS**

Applicant filed Requests for Extension of Protection based on International Registration Nos. 1067199 and 1066675 on November 8, 2012, to register the marks “VULCANIC” (a standard character mark) and “VULCANIC (& DESIGN)” for the following goods and services: “Scientific, measuring, signaling, checking (supervision) and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; indicators (electricity); regulating apparatus, electric; distribution boxes (electricity), distribution boards (electricity); batteries, electric, couplings, electric; branch boxes (electricity); cables, electric; electric

installations for the remote control of industrial operations; monitoring cabinets; resistances, electric; heat regulating apparatus; temperature indicators; temperature sensors; thermostats; mercury levels; boiler control instruments; fire alarms; measurement converters; data processing equipment and computers; computer software, recorded; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; screens and monitors” in International Class 9; “Heating, cooling, steam generating, refrigerating, drying, ventilating apparatus; apparatus and installations for heating air, fluids, solids, corrosive products, water and all other liquids; apparatus and installations for infrared heating; heating apparatus for solid, liquid or gaseous fuels; radiators (heating); heating apparatus, electric; radiators, electric; boilers; electrical boilers; feeding apparatus for heating boilers; stoves (heating apparatus); heat pumps; heaters for vehicles; hot air generators; heat accumulators; heat regenerators; heating elements; heating filaments, electric; fireplaces, domestic; solar collectors (heating); hot plates; heating plates; immersion heaters; heating cables; heating tapes; heating cartridges; hot air ovens; temperature control devices; heat regulators; heat exchangers, not parts of machines; apparatus and installations for cooling air, fluids, water and all other liquids; air conditioning apparatus and systems; fans and ventilation equipment (air conditioning); ventilation [air-conditioning] installations for vehicles; air conditioning apparatus and installations; cooling installations for liquids; ventilation hoods; air filtering installations; air purifying and freshening apparatus and machines; air dryers; fans (parts of air-conditioning installations); refrigerating apparatus and machines; refrigerating and cooling apparatus and installations; coolers for furnaces; steam accumulators; steam generating installations; humidifiers for central heating radiators; generators of infrared radiation for heating and drying; fuel economizers” in International Class 11; “Installation, maintenance and repair of electrical apparatus; installation, maintenance and repair of electrical heating and cooling apparatus and installations, especially for industry; information on the installation, maintenance and repair of electrical heating and cooling apparatus and installations for industry” in International Class 37; and

“Assessments, estimates and research in scientific and technological fields provided by engineers; industrial analysis and research services; surveying; technical project studies; material testing, all the aforesaid services provided in connection with electrical heating and cooling for industry” in International Class 42.

The first office action mailed on March 15, 2013, was a provisional full refusal containing a Section 2(d) refusal based on a likelihood of confusion with U.S. Registration No. 4001176 for the mark “VULCAN” for “Hand dryers, electrical hand dryers, warm air hand dryers” in International Class 11; U.S. Registration No. 1609678 for the mark “VULCAN” 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; U.S. Registration No. 666879 for the mark “VULCAN (& DESIGN)” for “ovens, ranges, and deep fat fryers” in International Class 11; U.S. Registration No. 666878 for the mark “VULCAN” for “cooking equipment-namely, ranges; broilers; combination broilergriddle-toasters; and ovens” in International Class 11; U.S. Registration No. 674532 for the mark “VULCAN” for “electric cooking ranges, deep fat fryers, food warmers, kettles, meat roasters, coffee urns, and mixers”; U.S. Registration No. 2193936 for the mark “VULCAN (& DESIGN)” for “gas, electric, and steam cooking equipment, namely ovens, ranges, broilers, and deep fat fryers” in International Class 11; U.S. Registration No. 2193935 for the mark “VULCAN” for “gas, electric, and steam cooking equipment; namely - ovens, ranges, broilers, and deep fat fryers” in International Class 11;

U.S. Registration No. 1281328 for the mark “VULCAN” for “Thermostats” in International Class 9; U.S. Registration No. 2663624 for the mark “VULCAN” for “Computer software for use in audio and/or video production and recording, record production, and film production, for use in television, cable television,

radio and satellite broadcasting, for use in providing access to a global computer networks, wide-area compute networks and local-area computer networks, for use in computer software development, and in the fields of music, art, science, technology and telecommunications, medicine and health, finance and investment, education and entertainment; pre-recorded multimedia software recorded on CD-ROMs featuring music, art, [ science, technology and telecommunications, medicine and health, finance and investment, ] education and entertainment; [ computer games recorded on software, disks, CD-ROMS, cartridges and tapes; computer hardware; interactive multimedia computer programs in the fields of music, art, science, technology and telecommunications, medicine and health, finance and investment, education and entertainment; ] pre-recorded audio and video tapes, DVDs, compact discs and laser discs featuring music, entertainment, and news and information pertaining to the fields of music, art, science, technology and telecommunications, medicine and health, finance and investment, education and entertainment; [ electronic books featuring music, entertainment, and news and information pertaining to the field of music, art, science, technology and telecommunications, medicine and health, finance and investment, education and entertainment, recorded on multimedia software, namely, CD-ROMs, audio and video cassettes, compact discs and laser discs; and computer software which allows a user to create audio and audio visual displays and programs and sight and sound effects for presentation at public events; ] databases in the fields of music, art, science, technology and telecommunications, medicine and health, fiance and investment, education and entertainment, recorded on computer media” in International Class 9. Applicant was also notified of prior pending application serial no. 85693288 for the mark “VULCAN” for “Dryers for remediation and decontamination of soil, sludge, and sand by removing solid, liquid and vapor contaminants from soil, sludge, and sand.” Finally, applicant was required to amend the identification of goods and services for International Classes 9, 11, 37 and 42.

In applicant's response filed September 16, 2013, applicant amended the identification of goods and services for International Classes 9, 11, 37 and 42, and argued against the Section 2(d) refusal.

On October 18, 2013, the Section 2(d) refusal was withdrawn as to U.S. Registration Nos. 4001176, 666879, 666878, 2663624, 674532, 2193936 and 2913935, and made final as to U.S. Registration Nos. 1609678 and 1281328. The Section 2(d) refusal was limited to applicant's Class 9 and 11 goods. Prior-filed pending application no. 85693288 was also withdrawn as a potential bar to registration. In addition, applicant's amendments to the identifications for International Classes 37 and 42 were accepted, and the requirement to amend the identifications for International Classes 9 and 11 was made final.

On April 17, 2014, applicant filed an appeal with the Trademark Trial and Appeal Board. On October 14, 2014, applicant filed a Request for Reconsideration in which applicant amended the identification of goods for International Classes 9 and 11. The application was remanded to the examining attorney for reconsideration.

On December 10, 2014, applicant's Request for Reconsideration was accepted as to the amendments to International Classes 9 and 11, and denied as to the Section 2(d) refusal.

On March 10, 2015, applicant filed a Motion to Consolidate Ex-parte Appeals. On March 12, 2015, applicant filed its appeal brief. On March 16, 2015, applicant's Motion to Consolidate was granted and the file was forwarded to the examining attorney for statement.

## **ARGUMENT**

### **I. APPLICANT'S MARKS ARE LIKELY TO CAUSE CONFUSION WITH THE REGISTRANTS' MARKS**

Applicant's marks "VULCANIC" and "VULCANIC (& DESIGN)" create a likelihood of confusion when compared to the registered marks "VULCAN" and "VULCAN CAL-STAT" because the marks are similar in appearance, sound, connotation and commercial impression and the goods and channels of trade are related.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01.

In the present case, the following factors are the most relevant in determining likelihood of confusion: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

#### **A. Applicant's Marks are Confusingly Similar to the Registered Marks**

Applicant's marks "VULCANIC" and "VULCANIC (& DESIGN)" are similar to the registered marks "VULCAN" and "VULCAN CAL-STAT" in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion.

*In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

**1. Applicant’s Marks Are Similar in Appearance and Sound to the Registered Marks**

In the present case, applicant’s mark “VULCANIC” is similar to the registered mark “VULCAN” in that “VULCANIC” is a VULCAN-formative term, varying in appearance from registrant’s mark only by the suffix “-IC”. The addition of the suffix “-IC” to the registered term “VULCAN” neither detracts from, nor obviates, the similarities in the appearance and sound of the marks.

Applicant’s mark “VULCANIC” is likewise similar to the dominant element, i.e., the term “VULCAN,” of the registered mark “VULCAN CAL-STAT”. Although the marks are compared in their entireties in the Section 2(d) analysis, one feature of a mark may be recognized as more significant or dominant in creating a commercial impression. Greater weight is generally given to that dominant feature in determining whether the marks are confusingly similar. See TMEP §1207.01(b); *In re Nat’l*

*Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

In the present case, the term “VULCAN” in registrant’s mark “VULCAN CAL-STAT” is considered dominant because it appears as the first term in the mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

With respect to applicant’s mark “VULCANIC (& DESIGN),” confusion is likely because the dominant element of applicant’s mark, i.e., the literal element “VULCANIC” is similar in appearance, sound, connotation and commercial impression to the registered mark “VULCAN” and to the dominant element, i.e., “VULCAN,” of the registered mark “VULCAN CAL-STAT” for all the reasons stated above. The term “VULCANIC” in applicant’s mark is considered dominant because the only remaining element in the mark, i.e., the design element, is accorded less weight in the likelihood of confusion analysis. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been

disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

## **2. Applicant's Marks Convey the Same Connotation and Commercial Impression as the Registered Marks**

The term "VULCANIC" in applicant's marks convey the same connotation and commercial impression as the term "VULCAN" in the registered marks. Specifically, the term "Vulcanic" is defined by *Webster's Revised Unabridged Dictionary* as "of or pertaining to Vulcan; made by Vulcan; Vulcanian."<sup>1</sup> Therefore, the marks are not only similar in appearance and sound, but they also convey the same connotation and overall commercial impression.

Applicant's argument that the term "VULCANIC" in its marks "has no recognized meaning" is unsubstantiated in light of the evidence of record. Specifically, the evidence shows that the term "VULCANIC" is derived from the term "VULCAN" and therefore has the same meaning as the registered term. As noted by applicant, "Vulcan" refers to the god of fire in Roman mythology.<sup>2</sup> Thus, the terms "VULCAN" and "VULCANIC" are often used to suggest heat and temperature. As used in connection with the parties' goods, both "VULCAN" and "VULCANIC" suggest products used in connection with heat and temperature. Since both the applicant and registrant's goods include products used for heating and for temperature regulations, consumers of the goods will likely ascribe this same meaning to both marks.

Although applicant argues that "VULCANIC" is intended to be a play on the term "volcanic," consumers familiar with the registrants' "VULCAN" marks are likely to believe that applicant's

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<sup>1</sup> See p.21 of the March 14, 2013 office action.

<sup>2</sup> See p. 6 of Applicant's Brief.

“VULCANIC” marks are associated with registrants marks and that the respective goods originate from the same source because the marks are not only similar in appearance and sound, but they also convey the same connotation.

**B. The Registered Marks Are Not Weak or Diluted in Relation to the Relevant Goods**

In the first office action, registration was refused under Section 2(d) of the Trademark Act based on multiple registrations because applicant’s original identification of goods and services as filed was so broad as to potentially include, or overlap with, the goods and/or services identified in each of the cited registrations.

In applicant’s response of September 16, 2013, applicant amended the identifications to narrow the description of goods and services. The Section 2(d) refusal was subsequently withdrawn as to those cited registrations for which the goods, services and/or channels of trade no longer presented a bar to registration. The Section 2(d) refusal was made final as the two cited registrations with goods similar to, or identical to, applicant’s amended description goods.

Applicant’s argument that the term “VULCAN” is a weak or diluted term in the relevant industry as evidenced by those (previously cited) third-party registrations is without merit because the goods listed in those registrations differ from applicant’s goods (as subsequently identified in applicant’s amended description of goods). The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d

1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Since the goods listed in the third-party registrations referenced by applicant are different from the goods in applicant's amended identification, the third-party registrations are not evidence that the term "VULCAN" is weak or diluted for the goods at issue in the present case. Specifically, U.S. Registration Nos. 4001176, 666879, 66878, 674532, 2193936, and 2193935 all feature goods in the nature of appliances, primarily household appliances for cooking such kettles, ovens, electric cooking ranges, and deep fat fryers. By contrast, applicant's goods are types of apparatus for regulating electricity and energy and heating and cooling installations. In fact, applicant's description of goods expressly excludes goods "for cooking" in its identification to make clear that the channels of trade for its goods differ from those of the third-party registrants, for example, *electric heating stoves, not for cooking*.

Likewise, prior cited U.S. Registration No. 2663624 for the mark "VULCAN" in connection with computer software for audio/video production, film production, and broadcasting in the entertainment and education fields was withdrawn as a bar to registration because the goods differ from applicant's goods which are computer software for "controlling heating and cooling apparatus." Applicant has not shown the term "VULCAN" or "VULCANIC" is weak or diluted for any of the goods in applicant's identification of goods.

Moreover, evidence of weakness or dilution consisting solely of third-party registrations, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB

2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

**C. Applicant's and the Registrants' Goods Are Related and Are Provided Within the Same Channels of Trade**

In the likelihood of confusion determination, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods would be encountered by the same consumers under circumstances such that offering the goods under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

In the present case, the goods at issue in the refusal are: "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 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; 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 of 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.

Applicant’s goods and the goods of the 1281328 registrant are identical with respect to “thermostats”. Accordingly, these goods are considered related for purposes of the likelihood of confusion analysis. Registrant’s “thermostats” are also related to applicant’s remaining Class 9 goods and Class 11 goods in that all are used for energy and temperature regulation and/or heating, cooling and ventilation and therefore travel in the same channels of trade. Likewise, the goods of the 1609678 registrant are related to applicant’s Class 9 and 11 goods because the registrant is providing types of “heating, cooling and air conditioning apparatus” and applicant’s goods are also types of heating, cooling and air conditioning apparatus, as well as devices and software for controlling heating and cooling apparatus.

Specifically, the attachments from applicant’s website <http://www.vulcanic.com/> show that applicant’s goods and those of the registrants overlap with respect to radiators, finned heating elements, thermostats, heating units such as air heaters, immersion heaters, cabinet heaters, and high-temperature air generators, and ventilations units such as AC units.<sup>3</sup>

The attachments from the 1281328 registrant’s website <http://vulcanelectric.com/> show that registrant provides goods in the field of “industrial heating equipment.”<sup>4</sup> Applicant’s goods are also provided in the field of industrial heating as noted by the following statements on applicant’s website:

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<sup>3</sup> See p. 44-50, 61 of the October 18, 2013 office action.

<sup>4</sup> See p. 51 of the October 18, 2013 office action.

“Vulcanic offers a range of products for industrial heating...” and “Electrical Heating and Cooling Solutions For The Industry.”<sup>5</sup>

The parties also serve customers in the same industries. For example, the 1281328 registrant serves the aerospace, packaging, power generation and alternative energies industries, among others.<sup>6</sup> Applicant likewise serves the aeronautic, packaging, power generation and alternative energies industries, among others.<sup>7</sup>

Likewise, the attachments from the 1609678 registrant’s website <http://www.mestek.com/> show that the ‘678 registrant is a manufacturer of HVAC technology including heating, cooling and air handling installations<sup>8</sup> that overlap with applicant’s goods which include air conditioning units, chillers, heaters and radiators.<sup>9</sup>

The attachments provided from the following third-party sources are additional evidence that goods similar to those of the applicant and registrants often originate from the same source or travel in the same channels of trade. For example, with respect to the parties’ Class 9 goods, the attachments from <http://www.omega.com/> show thermostats, electric heaters, temperature products, electrical cables and wires, meters including temperature meters and power meters, controllers, temperature and process multi-input indicators and wall mount indicators, all provided by a single source under the same trademark.<sup>10</sup> The attachments from <http://www.coppellac.com/> show thermostats, air conditioners, air handlers, humidifiers, temperature controls, solar energy products, air quality systems, heat pumps and furnaces, all sold in the same channels of trade.<sup>11</sup> The attachments from <http://yourhome.honeywell.com/home/> show thermostats, fans, heaters, air cleaners and air purifiers,

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<sup>5</sup> See p. 44 of the October 18, 2013 office action.

<sup>6</sup> See p. 52-53 of the October 18, 2013 office action.

<sup>7</sup> See p. 54 of the October 18, 2013 office action.

<sup>8</sup> See p. 62-65 of the October 18, 2013 office action.

<sup>9</sup> See p. 45-46 and 49-50 of the October 18, 2013 office action.

<sup>10</sup> See p. 2-12 of the October 18, 2013 office action.

<sup>11</sup> See p. 13-18 of the October 18, 2013 office action.

humidifiers and ventilation systems, all provided in the same channels of trade.<sup>12</sup> The attachments from <http://www.robertshaw.com/> show thermostats, resistors, temperature probes, and temperature regulators provided by a single source or in the same channels of trade.<sup>13</sup> The attachments from <http://tekmarcontrols.com/> shows thermostats and boiler controls originating from the same source.<sup>14</sup>

Likewise, the evidence shows that goods similar to applicant's and registrant's Class 11 goods are also available in the same channels of trade. For example, <http://www.grainger.com/> shows air conditioning units, air diffusers, finned tubes, immersion heaters, and ventilation hoods provided in the same channels of trade.<sup>15</sup>

The evidence of record also shows that goods similar to both applicant's and registrant's Class 9 and Class 11 goods are sold in the same channels of trade as further evidence that the goods of the parties are related and likely to be encountered by the same group or class of purchasers. For example, the attachments from <http://www.chromalox.com/> show Class 9 goods, e.g., junction box, remote control units and thermostats, and Class 11 goods, e.g., air diffusers, finned tube heaters, heating element cartridges, infrared radiant heaters, and steam generating installations, sold in the same channels of trade.<sup>16</sup> The attachments from <http://www.emersonclimate.com/> show Class 9 goods, e.g., electric voltage regulator, power and energy meters, controllers for refrigeration/HVAC systems, thermostats, and power usage monitors, and Class 11 goods, e.g., drying apparatus for refrigeration, humidifiers, HVAC units and parts, sold in the same channels of trade.<sup>17</sup> The attachments from <http://www.johnsoncontrols.com/> show Class 9 goods, e.g., electric batteries, energy performance monitors and thermostats, and Class 11 goods, e.g., HVAC parts, diffusers, refrigerating machines and

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<sup>12</sup> See p. 19-43 of the October 18, 2013 office action.

<sup>13</sup> See p. 14-17 of the December 10, 2014 Request for Reconsideration Denied.

<sup>14</sup> See p.76-79 of the December 10, 2014 Request for Reconsideration Denied.

<sup>15</sup> See p. 42-57 of the December 10, 2014 Request for Reconsideration Denied.

<sup>16</sup> See p. 2-4 and p. 28-33 of the December 10, 2014 Request for Reconsideration Denied.

<sup>17</sup> See p. 5-9 and p. 34-41 of the December 10, 2014 Request for Reconsideration Denied.

installations, heat exchangers, climate control/ventilation control systems, provided in the same channels of trade.<sup>18</sup> The attachments from <http://www.tempco.com/> show Class 9 goods, e.g., thermostats, power limiters/regulators, junction boxes, and temperature indicators, and Class 11 goods, e.g., enclosed heaters, finned tubular heaters, heating elements, heating tape, and infrared heaters, originating from a single source under the same trademark.<sup>19</sup> The attachments from <http://www.westinghouse.com/> show Class 9 thermostats, and Class 11 air conditioners, heat pumps, air handlers and coils, furnaces, heating and cooling installations, originating from the same source under the same trademark.<sup>20</sup> The attachments from <http://www.lennox.com/> show Class 9 thermostats and Class 11 air conditioners, furnaces, heat pumps, solar products, boilers, air conditioning apparatus and installations.<sup>21</sup> The attachments from <http://www.catadyne.com/> show Class 9 industrial thermostats, and Class 11 heaters, boilers, industrial heating and cooling installations sold in the same channels of trade.<sup>22</sup> The attachments from <http://www.trane.com/> show Class 9 thermostats and Class 11 air conditioners, air handlers, furnaces, heat pumps, heating and cooling installations, originating from the same source.<sup>23</sup> The Board has established that evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related.<sup>24</sup>

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<sup>18</sup> See p.10-13 and p. 58-61 of the December 10, 2014 Request for Reconsideration Denied.

<sup>19</sup> See p. 62-75 of the December 10, 2014 Request for Reconsideration Denied.

<sup>20</sup> See p. 80-90 of the December 10, 2014 Request for Reconsideration Denied.

<sup>21</sup> See p. 91-100 of the December 10, 2014 Request for Reconsideration Denied.

<sup>22</sup> See p. 101-119 of the December 10, 2014 Request for Reconsideration Denied.

<sup>23</sup> See p. 120-128 of the December 10, 2014 Request for Reconsideration Denied.

<sup>24</sup> See, e.g., In re G.B.I. Tile & Stone, Inc., 92 USPQ2d 1366, 1371 (TTAB 2009); In re Paper Doll Promotions, Inc., 84 USPQ2d 1660, 1668 (TTAB 2007). Material obtained from the Internet is generally accepted as competent evidence. See In re Davey Prods. Pty Ltd., 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); In re Rodale Inc., 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); In re White, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); In re Joint-Stock Co. "Baik", 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); In re Consol. Specialty Rests. Inc., 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); In re Gregory, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet

In light of foregoing, applicant's argument that "there is insufficient evidence to conclude that the goods of the respective parties are sufficiently related to cause confusion"<sup>25</sup> is without merit. Rather, the sum of the evidence presented clearly establishes the relatedness of the goods and of the channels of trade.

Applicant's argument that its Class 9 goods "primarily serve to control electrical energy loads in buildings" and as such are distinguishable from registrant's heating and cooling apparatus, is also without merit because the evidence from registrant's website <http://www.mestek.com/> shows that registrant's HVAC heating and cooling solutions are also designed for use in buildings.<sup>26</sup>

Moreover, the fact that applicant's identification does not limit the use of the goods to being "primarily [] to control electrical energy loads in buildings" is significant because the likelihood of confusion determination is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005.

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evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

<sup>25</sup> See p. 13 of Applicant's Appeal Brief.

<sup>26</sup> See p. 63 of the October 18, 2013 office action.

Finally, different goods in the electrical, electronic, and/or electromechanical fields have been found to be related where the evidence shows that the goods would be marketed through the same channels of trade and/or sold to the same classes of purchasers. *See, e.g., Alliance Mfg. Co. v. ABH Diversified Prods., Inc.*, 226 USPQ 348 (TTAB 1985) (finding cycling-type furnace controllers and various home products, including garage door openers and remote controls for operating lights and appliances, to be related, where both parties' goods were electrically powered/electronically operated, had similar energy conserving characteristics, and were sold for residential use); *In re Globe-Union Inc.*, 189 USPQ 158, 159 (TTAB 1975) (finding resistor-capacitor components and ceramic condensers to be related, where such goods "would be sold in the same trade channels to the same classes of purchasers such as original equipment manufacture[r]s for incorporation in the same piece of electronic equipment or apparatus"); *In re Dynaco, Inc.*, 189 USPQ 104, 105 (TTAB 1975) (finding two-channel stereophonic amplifiers, loudspeakers, and non-electronic devices for connecting amplifiers and speakers, on the one hand, and switching transistors, on the other, to be related because the goods would be "invariably sold to the same class of purchasers in such circumstances and conditions that if persons were to encounter them under the same or similar marks, they might well be induced to believe that they originate from a common source"); *Nat'l Steel Constr. Co. v. Matsushita Elec. Indus. Co.*, 158 USPQ 464 (TTAB 1968) (finding electric washing machines and electric water heaters to be related, where such goods were sold through the same channels of trade to the same class of purchaser, where the purchase of one of the party's goods could lead to the purchase of the other party's goods, and where the evidence of record indicated that a single manufacturer might produce both electric washing machines and electric water heaters); *see also Ultra Elec., Inc. v. Workman Elec. Prods., Inc.*, 192 USPQ 497 (TTAB 1976); *In re Int'l Components Corp.*, 191 USPQ 653 (TTAB 1976). The evidence in the present case shows that applicant's goods and the goods of the registrants are provided in the same channels of trade.

**D. The Marks Are So Similar and the Goods and Channels of Trade So Highly Related That Even Sophisticated Purchasers Are Likely to Be Confused**

Applicant's argument that confusion is not likely because the purchasers of the goods in question are highly sophisticated and less prone to confusion is without merit because 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. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Moreover, applicant's and registrants' marks in the present case are so similar and the goods and channels of trade so highly related and overlapping that even sophisticated purchasers are likely to be confused as to the source of the goods.

**CONCLUSION**

Applicant's mark is likely to cause confusion with the registrant's mark because the marks are confusingly similar in appearance, sound, connotation and commercial impression, the goods of the parties are related, and the channels of trade are the same. For the foregoing reasons, it is respectfully requested that the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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