

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 8, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dyson Technology Limited
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Serial No. 79188560
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Jennifer Lee Taylor of Morrison & Foerster LLP for Dyson Technology Limited.

Justin Berlin, Trademark Examining Attorney,¹ Law Office 125 (Mark Pilaro, Managing Attorney).

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Before Zervas, Kuczma, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Dyson Technology Limited (“Applicant”) filed an application² for extension of protection to the United States of its International Registration of the standard character mark CU-BEAM for the following goods:

Suspended lights in the nature of LED lighting fixtures designed to be suspended from a ceiling with uplighters and/or downlighters, the aforesaid optimized to reduce eye

¹ The application was reassigned to Examining Attorney Berlin for briefing.

² Application Serial No. 79188560 was filed on April 13, 2016 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1301595 dated April 13, 2016, with a priority filing date of October 13, 2015.

strain and increase comfort and productivity; parts and fittings for the aforesaid goods, in International Class 11.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods, so resembles the mark Q-BEAM SPOT/FLOOD as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered on the Principal Register in typed form for:

Lighting apparatus and instruments – namely, a hand-held combination spotlight and floodlight, in International Class 11.³

When the refusal was made final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney have filed briefs.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

³ Reg. No. 2600421 issued on July 30, 2002. Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed. Registrant disclaimed the exclusive right to use SPOT/FLOOD apart from the mark as shown. Registered as a typed mark which is the equivalent of a standard character mark. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 807.03(i) (Oct. 2017).

A. The goods; trade channels; customers.

We first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). All of the goods are lighting apparatus; however, Registrant's goods are limited to hand-held devices that combine the function of a spotlight and a floodlight, while Applicant's goods are suspended ceiling fixtures with features called "uplighters" and "downlighters" that are "optimized to reduce eye strain and increase comfort."

In order to demonstrate that the goods of Applicant and Registrant are related, the Examining Attorney has submitted evidence from the internet indicating that portable lighting devices are offered under the same marks as lighting fixtures for ceilings. Little of the evidence actually deals with hand-held spotlights or hand-held floodlights. The evidence shows that Larson Electronics offers a handheld spotlight that is "ideal for hunting, camping, marine and boating use as well as for first responders and emergency services,"⁴ as well as an "Explosion Proof LED Paint Spray Booth Light." Although this product is a ceiling fixture, it is designed "for areas where flammable chemical/petrochemical vapors exist . . . making it ideal for applications such as paint booths, oil rigs, offshore applications, petrochemical, manufacturing, chemical storage, water treatment centers, and food processing plants."⁵ It is quite

⁴ Office Action of September 21, 2017 at 20.

⁵ *Id.* at 27.

different in nature from Applicant's comfort-optimizing lighting fixture. West Marine offers a handheld spotlight that is listed under the categories of "Marine Electrical" and "Exterior Lighting,"⁶ and also offers "interior" lighting fixtures. However, these latter fixtures appear to be dome lights for installation on boats.⁷

The evidence showing that Honeywell and Eaton sell both flood lights and ceiling fixtures is not entirely on-point. The floodlights, although portable, are not hand-held devices, but "work lights" on steel stands.⁸ They are quite different from Registrant's goods in their nature, their purpose, and their likely purchasers.

The evidence shows that Phoenix offers LED ceiling fixtures as well as a "Portable Explosion-proof LED Floodlight," which is described as "rated for hazardous and wet locations [f]or use in chemical plants, drilling rigs, refineries and other hazardous locations."⁹ This latter item, while portable, is intended to be mounted. It is therefore somewhat different in nature from Registrant's goods. The Examining Attorney has also shown that Philips offers flashlights as well as ceiling fixtures.¹⁰ The flashlights, while hand-held, are not spotlights or floodlights and are not identified as such. Finally, the evidence shows the mark LUMAPRO applied both to a decorative ceiling fixture and "Temporary Job Site Lights, Clamp Base Style."¹¹ Again, this latter item

⁶ *Id.* at 10.

⁷ *Id.* at 9.

⁸ *Id.* at 6-8, 11-15.

⁹ Office Action of March 1, 2017 at 13-14.

¹⁰ *Id.* at 15-17.

¹¹ *Id.* at 10-11.

is not a hand-held device. Overall, the Examining Attorney's evidence does not persuade us that goods of the specific types identified in the application and the cited registration are commercially related.

With respect to trade channels, Applicant argues that it offers its goods to the trade and not to the general public, and points out that its website has no "point of sale option."¹² As the Examining Attorney points out, this argument is unavailing because Applicant's identification of goods lacks any limitation as to trade channels. We assume that Applicant's goods will be offered through all normal trade channels for such goods. *Octocom*, 16 USPQ2d at 1787. The Examining Attorney has, in fact, shown that Applicant's goods are offered by two online retailers, at <ylighting.com> and <lightology.com>¹³ and, therefore, might be purchased by the general public. This does not mean, however, that the goods of Applicant and Registrant travel through the same trade channels. There is no evidence indicating that YLighting and Lightology offer hand-held spotlights and floodlights.¹⁴ Considering that hand-held spotlight/floodlight combinations and suspended lighting fixtures designed for comfort have very different purposes, there is no reason to assume that they would

¹² Applicant's brief at 6, 9 TTABVUE 11.

¹³ Office Action of March 1, 2017 at 18-20.

¹⁴ The Examining Attorney is in error when he argues that "[a]bsent restrictions in an application and/or registration, the identified goods are 'presumed to travel in the same channels of trade to the same class of purchasers.'" Examining Attorney's brief, 11 TTABVUE 10, quoting *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). The logic of this presumption holds only in cases where the goods at issue are identical. In the case before us, the identified goods differ on their face; and even if they were commercially related goods, there would be no logical basis for making the presumption asserted by the Examining Attorney.

travel through the same trade channels or be purchased by the same customers in environments where they would consider the source of the goods as the same.

The evidence does not persuade us that the goods of Applicant and Registrant are related in such a way or are marketed under such circumstances that they could give rise to the mistaken belief that they emanate from the same source. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). We find that the *du Pont* factors relating to the similarity or dissimilarity of the goods, the likely trade channels, and the classes of customers to whom the goods are offered do not support a finding of likelihood of confusion.

B. The marks.

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “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.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721) (internal quotation marks omitted).

In appearance, the two marks are similar to the extent that they share the hyphenated term -BEAM. Otherwise, they are different in appearance.

With respect to sound, the Examining Attorney argues that CU-BEAM and Q-BEAM are phonetic equivalents. Although we note that in pronouncing Applicant’s

mark one might separately pronounce the names of the letters C and U (to sound like “see you beam”), Applicant does not argue that this is the pronunciation of its mark. Rather, Applicant argues that “Cu” is the symbol for the element copper and that, in the context of Applicant’s goods (which happen to include copper tubing, although this feature is not listed in the identification of goods), the mark could be pronounced “copper beam.”¹⁵ On this record, it appears unlikely that customers would pronounce Applicant’s mark as “copper beam.” The more likely pronunciation, as the Examining Attorney suggests, would be as the phonetic equivalent of Q-BEAM. *Cf. In re Viterra Inc.*, 101 USPQ2d at 1912 (“[T]here is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.”).

In terms of meaning or connotation, both marks contain the suggestion of light that is inherent in the word “beam.” However, there is no evidence to indicate what meaning Q-BEAM may have, and it is not clear whether customers would derive the meaning of “copper beam” from Applicant’s mark. Customers certainly could perceive Q- and CU- to have or suggest different meanings. We also note that the words SPOT/FLOOD in Registrant’s mark have a meaning that is not present in Applicant’s mark and, in the context of Applicant’s goods, would seem incongruous, since Applicant’s goods, as identified, are clearly not spotlights or flood lights.

In overall commercial impression, we find the marks to be similar only in part. The phonetic similarity of the marks and the visual similarity with respect to the component -BEAM are striking, but there are also notable differences in appearance

¹⁵ Applicant’s brief at 12-13, 9 TTABVUE 17-18.

and potential meaning. Under the circumstances, the *du Pont* factor of the similarity or dissimilarity of the marks has a mixed impact upon our analysis of likelihood of confusion.

C. Strength of Registrant’s mark; similar marks in use.

The Examining Attorney argues, with reason, that the element Q-BEAM, in Registrant’s mark, “is more significant in creating a commercial impression in the mind of the consumer,”¹⁶ because the other wording of the mark is merely descriptive of Registrant’s goods. Applicant responds that “a shared use of the term ‘BEAM’ for light fixtures is of limited value in discussing a likelihood of confusion, because the word ‘beam’ is commonly used in relation to lighting, as it refers to ‘a ray or shaft of light.’”¹⁷ Applicant has submitted Internet evidence of the following third-party uses of marks that include the term BEAM:¹⁸

Mark	Product or Service
BEAM	Lighting design firm.
BEAM4LED	Compact, linear lighting system.
MR BEAMS	Bright wireless LED lights that install anywhere in minutes.
BEAM-LED	Suspended direct LED luminaire for interior spaces.
CASPER BEAM LIGHTART COLLECTION	Solid state LED system.

¹⁶ Examining Attorney’s brief, 11 TTABVUE 7.

¹⁷ Applicant’s brief at 14, 9 TTABVUE 19, quoting the MERRIAM WEBSTER online dictionary, Applicant’s response of February 7, 2017 at 35.

¹⁸ Applicant’s response of February 7, 2017 at 41-52.

G-BEAM	Suspended lighting fixtures.
AUXBEAM	LED light bars for vehicles.
STARBEAM LIGHTING SOLUTIONS	Lighting solutions, including energy audits and design solutions.
BEAM 5450	Interior and exterior LED sconce.
SL BEAM 300fx	High performance moving head luminaire.

Applicant has also made of record copies of registrations of the following marks in the field of lighting:¹⁹

Reg. No.	Mark	Goods
4063194	X-BEAM	Laser light projectors.
4220557	G-BEAM	Lighting fixtures.
4997744	ACEBEAM	Bicycle lights, diving lights, electric lamps, flashlights, headlights for vehicles.
4909270	TRUBEAM	Motorcycle headlamps.
4421612	BIG BEAM	Emergency warning lights, exit signs, electric lanterns.
2990898	I BEAM	Flashlights.
3280339	I-BEAM	Fluorescent high bay lighting fixtures for industrial, warehouse, and large retail spaces.
1938339	PROBEAM	Electric lighting fixtures for roadway tunnels.
1336510	V-BEAM	Incandescent lamps.

¹⁹ *Id.* at 54-62. In our table we paraphrase or abbreviate the identifications of goods in the registrations.

Evidence of the registration and use of a term by others may indicate that the term is weak as an indicator of source, either because it has a well-recognized descriptive or suggestive meaning or because its commercial strength has been diluted by third-party use. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). In this case, the dictionary evidence and the evidence of third-party use clearly show that BEAM has a meaning in the lighting industry that is invoked frequently in the marketplace. Moreover, the evidence shows quite a few trademarks in the form of the word BEAM with a single-letter prefix (G-BEAM, X-BEAM, I-BEAM, V-BEAM), suggesting that marks in this form are distinguishable from one another. Overall, the evidence of the meaning of BEAM and of similar marks in use on similar goods indicates that the scope of protection to be afforded Registrant's mark should be somewhat limited.

D. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Applicant's mark is similar to Registrant's mark primarily because it is the phonetic equivalent of the dominant portion of the cited mark. In appearance – and to some extent in sound – the similarity of the marks depends on the term -BEAM, which has been shown to be somewhat weak as a source indicator. Otherwise, there are noticeable differences in the appearance, sound, and commercial impression of the marks. The evidence does not persuade us that the goods of Applicant and Registrant are related or that they

Serial No. 79188560

would likely be offered through related channels of trade. Under the circumstances, we find that the marks are sufficiently different that confusion as to source is unlikely.

Decision: The refusal under Section 2(d) is reversed.