

This Opinion is not a
Precedent of the TTAB

Mailed: September 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Littelfuse, Inc.
—

Serial No. 85964505
—

Michael E. Hall of Kacvinsky Daisak Bluni PLLC,
for Littelfuse, Inc.

James A. Rauen, Trademark Examining Attorney, Law Office 109,
Dan Vavonese, Managing Attorney.

—
Before Bucher, Kuhlke and Ritchie,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Littelfuse, Inc. (“Applicant”) seeks registration on the Principal Register of the mark ENGINEERED TO PERFORM. BUILT TO LAST. (in standard characters) for the following goods in International Class 9:

Prefabricated modular buildings and e-houses sold as a housing component of custom-designed, medium- and low-voltage electrical equipment for use in the mining industry, oil and gas industry, and other industrial applications for electrical distribution, protection, and control;

portable low-to-medium voltage electric power centers for power distribution, monitoring and controlling for use in

the mining industry, oil and gas industry, and other industrial applications;

skid mounted and aboveground and underground electric substations, namely, skid mounted aboveground and underground portable low-to-medium voltage electric power centers for monitoring and controlling mining operations consisting of medium voltage switch or breaker, low-to-medium voltage transformer, electronic motor control centers, namely, control consoles and programmable logic controllers, power take-off and automation panels for monitoring, diagnosing problems and controlling the distribution and flow of electrical power, featuring motor protection relays, ground fault relays, arc flash relays, feeder protection relays, custom key pads, variable frequency drives;

portable power cable couplers for use in underground and aboveground mining;

electronic controls for motors and custom-built switchgear for use in the mining industry, oil and gas industry, and other industrial applications;

electric generator controls and electrical equipment consisting of neutral grounding resistor and electric monitoring relays for use in the mining industry, oil and gas industry, and other industrial applications;

electric relays, namely, motor protection relays, ground fault relays, arc flash relays, feeder protection relays, pump protection relays, timers, flashers, power and voltage monitors, pump controllers, liquid level and load sensors, and current transformers, all for use in the mining industry, oil and gas industry, and other industrial applications.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground

¹ Application Serial No. 85964505 was filed on June 19, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The application also includes goods in International Class 7 that are not subject to this refusal and will proceed to publication regardless of the outcome of this appeal.

Applicant's mark, when used with the identified goods, so resembles the mark ENGINEERED TO ORDER. BUILT TO LAST. (in standard characters) registered on the Principal Register for the following goods in International Class 9:

Power cable terminations and joints, namely, pre-molded terminations and joints for use on dielectric cable systems;

cable splice boxes;

splicing kits primarily comprised of lead sleeve, Novoid compound, dry cotton tape, saturated flax twine, solder, stearine candle, varnished cambric tapes, paper pasters, tinned shielding braid, split tinned solder copper connectors, saturated webbing and compression connectors;

SF₆ electric circuit switches;

solid dielectric switches;

vacuum switches, namely, switches and switch gears used in transmission and distribution of electrical power; automatic transfer switches for use in connection with electrical distribution and transmission systems;

current limiting protectors;

single and three phase reclosers, namely, electric circuit closers to reclose interrupted high voltage electrical circuits;

and microprocessor-based power management systems comprised of power distribution switchgear with protective electric relays for controlling automatic switching operations in overhead and underground loop distribution circuits,²

as to be likely to cause confusion, mistake or deception.

² Registration No. 4433118, issued on November 12, 2013.

After the Trademark Examining Attorney made the refusal final and denied a request for consideration, Applicant appealed to this Board. We affirm the refusal to register.

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out 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 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Further, “[a]lthough confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user’s mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection.” *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1429 (TTAB 1993); *see also Majestic*, 65 USPQ2d at 1205 (“... mistaken belief that [a good] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”).

Similarity of the Marks

We consider the marks ENGINEERED TO POWER. BUILT TO LAST and ENGINEERED TO ORDER. BUILT TO LAST. and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm*

Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567.

The marks are nearly identical in appearance, sound, connotation and overall commercial impression. They are presented in the exact same structure, the only difference being that the second word in Applicant's mark is PERFORM rather than ORDER, which would be perceived simply as a variant of Registrant's mark, indicating that the goods you "order" will "perform."

Applicant does not address the marks other than to state in its reply brief that Applicant "simply does not believe it is necessary to get into an extended discussion regarding the marks because the unrelatedness of the goods is dispositive." Reply Br. p. 1, 7 TTABVue 2. We find the marks to be highly similar and this *du Pont* factor to weigh heavily in favor of a finding of likelihood of confusion.

Similarity of the Goods/Channels of Trade/Consumers

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the registration and application. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). See also *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods and/or services do not have to be identical or even competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs.*,

LLC, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). “[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). *See also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403–04, 186 USPQ 476, 480 (C.C.P.A. 1975); *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1270 (TTAB 2007). It is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347 (TTAB 2014). In addition, it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy*

Processing Industry SA, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), judgment set aside on other grounds, slip op. 91118482 (TTAB Jan. 22, 2014); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

Finally, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 26 USPQ2d at 1689 (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”); *In re Iolo Techs., LLC*, 95 USPQ2d at 1499; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

We turn then to analyze the goods. Each description separated by a semicolon stands on its own, *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163 (TTAB 2013) (“Under standard examination practice, a semicolon is used to separate distinct categories of goods or services.”), and we earlier set out the respective goods visually with each clause in a different paragraph. Therefore, two of Applicant’s goods are limited to the mining industry while the others are more broadly defined as applicable to the “mining industry, oil and gas industry, and other industrial applications.” Registrant’s goods are not limited by industry or more generally speaking by the end user, and therefore must be viewed as including the “mining industry, oil and gas industry, and other industrial applications.” Applicant argues that Registrant’s goods are for high voltage applications whereas Applicant’s goods are for medium and low voltage applications. February 28, 2014,

App. Response, TSDR p. 1.³ Only two of Applicant's goods are limited by voltage and only one of Registrant's goods is limited to high voltage. In view thereof, we must consider Applicant's and Registrant's other goods, as identified, for use in any voltage environment – high, medium or low voltage.

The Examining Attorney argues that Applicant's and Registrant's goods "are related in that they are all electrical goods used in the distribution and controlling of electrical power." Ex. Att. Br., 6 TTABVUE 11. More specifically, the Examining Attorney argues that Applicant's goods "are highly similar to the registrant's electrical products, and in particular the registrant's 'microprocessor-based power management systems comprised of power distribution *switchgear* with protective electric relays for controlling automatic switching operations in overhead and underground loop distribution circuits.'" Ex. Att. Br. 6 TTABVUE 11. The Examining Attorney points to Applicant's datasheet noting that it "indicates that the equipment delivers fully integrated electrical and automation systems." Ex. Att. Br., 6 TTABVUE 11. The data sheet describes the products as self-contained units, of which "the primary switchgear and control applications include low- and/or medium-voltage *switchgear* and motor control centre enclosures; relay panel enclosures." September 15, 2014 App. Response, TSDR p. 10.

Applicant argues the Office did not meet its burden in showing the relatedness of the goods because the Examining Attorney's "generalization is improper." Reply

³ If indeed Registrant's and Applicant's products are designed for highly-specialized uses and are targeted to separate classes of sophisticated consumers, this may well have been a case appropriate for the submission of a consent agreement.

Br. p. 2, 7 TTABVUE 3. Applicant relies on *In re W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007) wherein the Board explained that “to demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods.” *Id.* at 1215. However, in *W.W. Henry Co.* the identification of goods (PATCH & GO for cement based patch for wall and floor surfaces v. PATCH ‘N GO for chemical filler for polyolefin surfaces) inherently pointed to different end uses and end users. In addition, the record included evidence regarding the uses of these types of goods. By contrast, in the case before us, Registrant’s identification does not inherently contain any limitation as to field of use and encompasses the field of industrial use, including the mining industry.

Applicant’s and Registrant’s goods have the same function and purpose, *i.e.*, to facilitate the provision of electricity. Certain of Applicant’s goods are portable units designed for that purpose. For example, Applicant’s goods include:

portable low-to-medium voltage electric power centers for power distribution, monitoring and controlling for use in the mining industry, oil and gas industry, and other industrial applications;

skid mounted and aboveground and underground electric substations, namely, skid mounted aboveground and underground portable low-to-medium voltage electric power centers for monitoring and controlling mining operations consisting of medium voltage switch or breaker, low-to-medium voltage transformer, electronic motor control centers, namely, control consoles and programmable logic controllers, power take-off and automation panels for monitoring, diagnosing problems and controlling the distribution and flow of electrical power, featuring motor protection relays, ground fault relays, arc flash relays, feeder protection relays, custom key pads, variable frequency drives;

portable power cable couplers for use in underground and aboveground mining;

Registrant's goods are not limited and could thus include portable applications. For example, Registrant's "microprocessor-based power management systems comprised of power distribution switchgear with protective electric relay for controlling automatic switching operations in overhead and underground loop distribution circuits" encompass a power management system that is portable. In addition to the power systems, Applicant's and Registrant's identifications of goods include parts and accessories for power systems. The identification of parts and accessories for electrical power systems in the registration encompasses goods that could be used with Applicant's goods. For example, Applicant's "electronic controls for motors and custom-built switchgear for use in the mining industry, oil and gas industry, and other industrial applications" could be used to control Registrant's "vacuum switches, namely, switches and switch gear used in transmission and distribution of electrical power." We reiterate that we must make our determination based on the identifications and not on what may be the scope of actual use.

Applicant cites to the non-precedential decision *In re Formax, Inc.*, 77298497 and 77298502 (TTAB October 14, 2009) (POWERMAX for "industrial electric food processing machines, namely, machines for slicing food products for packing and packaging in commercial quantities, and parts therefor" v. POWERMAX for "electric food blenders") to support its position that the Examining Attorney did not present a fair analysis of the goods. However, in that case the applicant had submitted substantial evidence, including affidavits from its Business Development

Manager, to explain the nature of the goods. Based on this evidence, the Board found that the applicant's goods were very limited in nature and the broad identification of goods in the cited registration did not include industrial blenders used for packing commercial quantities. Here, we have no such evidence from Applicant.

Applicant also points to *In re Buhler Technologies GmbH*, Serial No. 79034792 (TTAB February 12, 2009) noting the importance of reading the identification in whole rather than piecemeal. We agree that it is the goods in their entirety in the identifications that must be considered, not individual words, and we have analyzed them in that manner. In the *Buhler* case in which the Board reversed the refusal under Section 2(d), the record included consent agreements between the applicant and the registrants, and the identifications of goods for applicant *and* registrants were limited by field of use, "filtering, analyzing, distributing and monitoring fluids and gases" v. "food and waste processing, air cleaning and conditioning, manufacturing, motors, engines and electrical devices used with such motors." *Id.*, 11 TTABVUE 17-18.

Applicant argues that the only possible overlap in purchasers would be sophisticated purchasers and points to other non-precedential Board cases where this factor contributed to reversals of the refusals.⁴

⁴ The Board is not bound by prior non-precedential decisions. We further note the records and facts in these cases are different from the case before us. In *In re Bunn-O-Matic Corporation*, Serial No. 77137482 (TTAB March 30, 2010) (TITAN for commercial coffee and tea brewers and servers v. TITAN for ranges, broilers cheesemelters, food and beverage chilling units, etc.). In this case, the Board found the goods served different purposes and

Applicant's and Registrant's types of goods are not impulse goods and would be purchased with a higher level of care and by knowledgeable purchasers. However, there is nothing specific in the record about the costs of these items or the purchasing process. *See, e.g., Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1413 (TTAB 2010) (products cost \$14,000 and \$47,000 respectively and testimony established that purchases of both products involve significant study and negotiation). This factor only slightly favors Applicant.

In conclusion, because the marks are highly similar, the goods are related, and the channels of trade are presumed to overlap in part, confusion is likely between Applicant's mark ENGINEERED TO POWER. BUILT TO LAST. and the mark ENGINEERED TO ORDER. BUILT TO LAST. in the cited registration.

the sophistication of the purchasers obviated likely confusion. Here, the goods serve the same purpose.

In *In re Boler Co.*, Serial No. 77059048 (TTAB February 17, 2008) (QUAANTUM for trailer suspension systems, incorporating wheel end systems v. QUANTUM for tires). In that case, the Board found the record did not support similarity of the goods in that most of the evidence did not address trailer suspension systems and the relationship was not inherent based on the identification of goods alone, this combined with the high degree of care exercised in making the purchase resulted in reversal of the refusal.

In *In re RAM Oil, Ltd, LLP*, Serial Nos. 77280977 and 77280981 (TTAB September 3, 2009) (RAM for fuel and service stations v. RAM ENERGY RESOURCES for oil and gas exploration and production) the Board found no likelihood of confusion based on the differences in trade channels and the sophisticated decision-making involved in the purchase of registrant's services. Here, because the registration is not limited by trade channels, it encompasses Applicant's "mining industry, oil and gas industry, and other industrial applications" trade channels.

In *In re Deceuninck North America LLC*, Serial No. 77465459 (TTAB May 27, 2009) (ENERGEX for windows and doors and parts therefor v. ENERGEX for exterior wall insulation system), the Board found that the goods as identified on their face did not appear to be commercially related and the evidence did not support a different finding as it did not include registrant's specific goods. In addition, the consumer overlap in the goods only included architects and builders who are sophisticated consumers. Here, we find the goods as identified are commercially related.

Decision: The refusal to register Applicant's mark ENGINEERED TO POWER. BUILT TO LAST. is affirmed. The application will proceed to publication for the International Class 7 goods.