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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Illinois Tool Works Inc.*

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Serial No. 86391742

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Bradley L. Cohn and Paul A. Borovay of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for Illinois Tool Works Inc.

Jason Malashevich, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Wellington, Masiello, and Lynch, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Illinois Tool Works Inc. (“Applicant”) filed an application for registration on the Principal Register of the mark SERTUN in standard characters for “Nonwoven cleaning towels, not being impregnated with sanitizing preparations, for use in commercial food-service establishments to sanitize surfaces,” in International Class 21.<sup>1</sup> The Trademark Examining Attorney refused registration under Section 2(d) of

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<sup>1</sup> Application Serial No. 86391742 was filed on September 11, 2014 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), on the basis of Applicant’s asserted use of the mark in commerce, stating April 1, 2014 as the date of first use and first use in commerce.

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 registered mark CERTAIN, in standard characters, as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for "Paper towels, bathroom tissue, paper napkins, facial tissue," in International Class 16.<sup>2</sup> When the refusal was made final, Applicant filed a request for reconsideration, which the Examining Attorney later denied, and a notice of appeal. Applicant then requested that the Application be remanded to the Examining Attorney for consideration of additional amendments and arguments. Upon remand, the Examining Attorney again maintained his refusal of registration, and this appeal proceeded. The case is fully briefed.

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).

(a) The goods; trade channels; customers.

We will 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. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In our analysis we compare Applicant's goods to Registrant's

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<sup>2</sup> Reg. No. 3462784, issued July 8, 2008. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

“paper towels,” because these are the goods that are most similar in nature to those of Applicant.

Applicant’s goods are “nonwoven cleaning towels.” Paper towels are typically a nonwoven product,<sup>3</sup> and the record shows that they are marketed as a “janitorial” product that can be used for cleaning.<sup>4</sup> Applicant’s goods are limited to towels that are “not ... impregnated with sanitizing preparations.” Paper towels, too, are typically sold not infused with sanitizing preparations; and even if they sometimes were, Registrant’s identification of goods is broad enough to encompass those that are not. Finally, Applicant’s goods are limited to those that are “for use in commercial food-service establishments to sanitize surfaces.” Registrant’s paper towels, as identified, are not limited to any particular field of use and could be used in such commercial establishments for sanitizing surfaces.

Giving “full sweep” to the goods as identified in the application and the cited registration, as we are required to do, we find that Applicant’s goods are identified with sufficient breadth to encompass Registrant’s paper towels, such that the goods must be treated as legally identical. *See Octocom v. Houston Computers*, 16 USPQ2d at 1787; *Paula Payne Prods. Co. v. Johnson Publ’g Co., Inc.*, 473 F.2d 901, 177

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<sup>3</sup> Paper is “a felted sheet of usu. vegetable but sometimes mineral or synthetic fibers laid down on a fine screen from a water suspension.” WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (1993) p. 1633. To “felt” means “to cause to adhere and mat together (as the fibers in paper).” *Id.* at 836. The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Applicant has not argued that the term “nonwoven” has any special meaning in the field of towels that would distinguish it from paper, and there is no evidence of record to so suggest.

<sup>4</sup> Office Action of February 16, 2016 at 11-12; 21.

USPQ 76, 77-78 (CCPA 1973); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (goods identified in an application or registration are presumed to encompass all goods of the nature and type identified).

Applicant seeks to distinguish the goods, arguing that “[Registrant’s] paper towels do not sanitize surfaces” and “a consumer would not use [Applicant’s] sanitizing towels for wiping up a simple spill, as the paper towels of the cited mark would do.”<sup>5</sup> However, there is nothing in the record to demonstrate the truth of these contentions; and there is nothing in Registrant’s identification of goods to limit the use of its product as Applicant suggests.

Because the goods of Applicant and Registrant are legally identical in relevant part, we presume that they travel through the same trade channels and are offered to the same classes of customers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). In any event, the Examining Attorney has presented some evidence to show that restaurant supply companies offer both non-woven towels and paper towels through their websites.<sup>6</sup> Thus, the record also reflects that these goods share the same trade channels and are offered to the same class of consumers.

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<sup>5</sup> Applicant’s brief at 7, 13 TTABVUE 11.

<sup>6</sup> Office Action of November 18, 2015 at 9; Office Action of February 16, 2016 at 7, 12.

For the reasons discussed, the *du Pont* factors of the similarity or dissimilarity of the goods, their trade channels, and the classes of customers to whom they are offered weigh in favor of 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 Imports, 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.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

With respect to sound, Registrant’s mark is a common English word having a conventional pronunciation. Applicant’s mark is not an actual English word, and such marks have no single correct pronunciation. *In re Viterra Inc.*, 101 USPQ2d at 1912. However, if SERTUN is pronounced according to ordinary English conventions of pronunciation, it would likely be pronounced the same as CERTAIN. The fact that the marks are likely to be pronounced identically or very similarly is a factor that invites confusion if the goods are recommended orally. *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (“Inasmuch as the goods may be ordered by phone or recommended by word of mouth,” the similarity in sound between ICE SHINE and  “is so

substantial that it outweighs any differences in appearance and meaning.”) Thus, although we recognize that the marks differ in appearance, a customer who has received an oral recommendation and who then encounters goods under the marks CERTAIN and SERTUN will not know which product was recommended.

The connotations of the two marks may also be viewed as similar. Customers could very well view SERTUN as a misspelling of CERTAIN and therefore ascribe to it the same meaning. In fact, Applicant promotes this perception of its mark, displaying on its package the slogan “Be *sure* you’re sanitizing”<sup>7</sup> and stating in its advertising that “Sertun™ Towels give your customers complete *assurance* that they are truly sanitizing ...”<sup>8</sup> Cf. Applicant’s characterization of “sure, positive, or assured” as synonyms of CERTAIN.<sup>9</sup> Because the mark will likely be perceived in this manner, the overall commercial impression of the mark is similar to that of Registrant’s mark.

We give full regard to the two marks’ difference in appearance. However, in all other regards they are highly similar, including the overall intended commercial impression. 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.

(c) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. In comparing the

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<sup>7</sup> Applicant’s specimen of use, submitted September 11, 2014 (emphasis added).

<sup>8</sup> Request for remand, 7 TTABVUE 10 (emphasis added).

<sup>9</sup> Applicant’s brief at 5, 13 TTABVUE 9.

marks, we are mindful that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). We also recall that “it is the affirmative duty of the newcomer to take reasonable precautions in the selection of a mark, so as to avoid needless public confusion and private injury by the invasion of the field previously occupied by another.” *Kalart Company, Inc. v. The Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139, 141 (CCPA 1958), *citing* *Waterman Co. v. Modern Pen Co.*, 235 U.S. 88, 94 (1914). In this case, Applicant’s mark, despite its peculiar spelling, resembles the cited registered mark in sound, meaning, and commercial impression. In a context of identical goods moving through the same market channels to the same customers, we find that Applicant’s mark so resembles the cited registered mark as to be likely to cause confusion or mistake or to deceive.

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