

This Opinion is not a
Precedent of the TTAB

Mailed: November 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PEM Management, Inc.

Serial No. 86957812

Joseph M. Konieczny, Sr. of Ryder, Lu, Mazzeo & Konieczny LLC,
for PEM Management, Inc.

Jessica Hilliard, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Cataldo, Bergsman and Lynch,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

PEM Management, Inc. (“Applicant”) seeks registration on the Principal Register
of the mark PENN AUTO and design, shown below:¹



¹ Serial No. 86957812, filed on March 30, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based on Applicant’s claim of first use anywhere and first use in commerce on March 17, 2016, for all classes of goods and services.

Applicant submitted the following description of the mark:

The mark consists of the shaded word “PENN” arranged above an inverted triangle. The top horizontal bar of the inverted triangle is thicker than the rest of the triangle and inside the top horizontal bar of the triangle is the unshaded word “AUTO.”

Color is not claimed as a feature of the mark.

The description of goods and services is set forth below:

Metal fasteners for the automotive industry, namely, threaded fasteners, nuts, bolts, screws, inserts, rivets, sleeves, studs and pins, in Class 6;

Hardware components for the automotive industry, namely, fasteners for brake components and fluid handling components; bushings, compression limiters and dowel pins, all specially adapted for land vehicles, in Class 12; and

Product engineering services for others, namely, design engineering of hardware components and fasteners for the automotive industry, in Class 42.

Applicant disclaimed the exclusive right to use the term “Auto.” Also, in response to a requirement that Applicant disclaim the exclusive right to use the term “Penn,” Applicant claimed, in the alternative, that its use of the term “Penn” has acquired distinctiveness.

The Examining Attorney refused registration of Applicant’s mark for the services in Class 42 under Section 2(d) of the Trademark Act, 15 U.S.C § 1052(d), on the ground that Applicant’s mark so resembles the registered mark PENN UNITED (standard characters) for, inter alia, the services set forth below as to be likely to cause confusion:

Design and testing for new product development; Design and testing of new products for others; Designing of machines, apparatus, instruments or systems composed of such machines, apparatus and instruments; Product development; Product development for others; Product research & development; Product safety testing; Research and development for new products for others, in Class 42.²

The cited PENN UNITED mark was registered under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

The Examining Attorney also refused registration for the goods in Classes 6 and 12 pursuant to Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant failed to submit a specimen showing proper trademark use.

Finally, although the Examining Attorney accepted Applicant's claim of acquired distinctiveness for the term "Penn" made in the alternative, Applicant appeals the Examining Attorney's finding that the term "Penn" is primarily geographically descriptive.

When the refusals and requirement were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. The appeal has been briefed.

² Registration No. 3358508, registered December 25, 2007; renewed.

The Examining Attorney also cited three other registrations owned by Registrant incorporating the term "Penn United" for the same goods and services. For the sake of economy, we confine our analysis to the issue of likelihood of confusion between Applicant's mark and the mark in Registration. No. 3358508. Of all the cited marks, this one is the most similar to Applicant's mark. If the refusal cannot be affirmed on the basis of this registered mark, it could not be affirmed on the basis of the other cited marks. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

I. Likelihood of confusion

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. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the

marks and relatedness of the goods”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The number and nature of similar marks in use in connection with similar services.

Applicant argues that Registrant’s PENN UNITED mark is not entitled to a broad scope of protection because the term “Penn” followed by a descriptive term has been registered numerous times.³ Applicant states that the “Examining Attorney may take judicial notice of the fact that there are currently more than 260 live trademark registrations incorporating the mark PENN.”⁴ Applicant’s Office Action response includes a list of 15 third-party registrations containing the term “Penn.”⁵

The Board does not take judicial notice of third-party registrations and listing them does not make them of record.⁶ *See In re Peace Love World Live, LLC*,

³ January 3, 2017 Response to Office Action (TSDR 13-14). References to the TSDR database are to the downloadable .pdf format.

⁴ *Id.* at TSDR 13.

⁵ *Id.* at TSDR 14. Applicant states that copies of the third-party registrations were attached as Exhibit 15. Applicant did not attach any exhibits to its response. It is the responsibility of the party making submissions to the Board via the electronic database to ensure that the testimony or evidence has, in fact, been properly made of record. *See Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) (“the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board”), *aff’d per curiam* 565 F. App’x 900 (Fed. Cir. 2014); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer’s responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible and identified as to source and date.”).

⁶ The Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party’s registrations. Although the court took judicial notice of a third-party registration in that case, the Board does not take judicial notice of either third-party registrations or a party’s own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding. *See* 37 C.F.R. § 2.122(d) and 37C.F.R. § 2.122(e). *See also*

127 USPQ2d 1400, 1405 n.17 (TTAB 2018); *In re 1st Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold*, 184 USPQ 638, 640 (TTAB 1974). However, because the Examining Attorney did not object to the list of third-party registrations and, in fact, addressed the probative value of the third-party registrations, any objection to the list is waived and we consider Applicant's list of third-party registrations for what it shows on its face. *See In re Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (finding that the examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list); *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1583 (allowing consideration of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake).

The list of registrations is not probative because none of the listed PENN marks are for services even remotely related to Registrant's design, development, and testing of new products. *See In re i.am.symbolic, LLC*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified

MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEALBOARD RULES, 81 Fed. Reg. 69950, 69955 (October 7, 2016) (Board considered but rejected suggestion of taking judicial notice of USPTO records, explaining various reasons introduction of information contained in USPTO trademark file records is most appropriately borne by the party seeking to introduce the evidence).

in the registrations appear to be in fields which are far removed from the goods at issue). *See also Key Chem., Inc. v. Kelite Chem. Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word ‘KEY’. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here.”).

Subsequently, in its August 21, 2017 Response to an Office Action, Applicant asserted that “[t]here are currently 35 live U.S. trademark registrations (including Registrant’s marks) that include the word PENN and are registered for use in connection with goods/services in classes 6, 12 and 42, which are the classes for which Applicant seeks registration.”⁷ This time, Applicant submitted copies of the registrations.⁸ Nevertheless, we note that the Examining Attorney limited the Section 2(d) likelihood of confusion refusal to Applicant’s services in Class 42. After reviewing the registrations, we find that only Registration No. 1308610 for the mark PENN STATE for, inter alia, “performing research for others in the fields of ... industry, technology ...” is relevant.⁹

⁷ August 21, 2017 Response to Office Action (TSDR 4).

⁸ *Id.* at TSDR 18-184.

⁹ *Id.* at TSDR 138. The classification of goods and services by the USPTO is a purely administrative determination and has no bearing on the issue of likelihood of confusion.

While the Federal Circuit has held that “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established,” *see Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)), the record of third-party registrations is not persuasive because only one of the third-party registrations is for services related to Registrant’s product development services. Ultimately, the one relevant third-party registration submitted by Applicant does not rise to the level of persuasiveness as the voluminous evidence in *Juice Generation* and *Jack Wolfskin*.

Nevertheless, we still must assess the inherent strength of Registrant’s mark PENN UNITED issued under the provisions of Section 2(f) of the Trademark Act based on Registrant’s claim that its mark has acquired distinctiveness. In other words, by virtue of seeking registration under Section 2(f), Registrant has conceded that PENN UNITED is primarily geographically descriptive when used in connection with design, development, and testing of new products. However, Registrant claims under Section 2(f) that through use its mark has developed trademark significance. *See G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1637 (Fed. Cir. 1990) (acquired distinctiveness “arises when a symbol or device, not inherently distinctive at the time of its adoption, later acquires distinctiveness such that the symbol or device serves as a mark to indicate the source of the associated goods. (Internal citation omitted). A mark that has acquired secondary meaning may

serve as a trademark and be protected even if the mark was not distinctive at the time of its adoption.”); *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) (“Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless become distinctive of the applicant’s goods in commerce.”). Marks registered under the provisions of Section 2(f) are registered on the Principal Register and, therefore, provide the owner with a statutory presumption of trademark rights to preclude others from such use as would result in confusion. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (i.e., validity of the registered mark and of the registration of that mark, registrant’s ownership of the mark, and the registrant’s exclusive right to use the registered mark on or in connection with the goods or services specified in the registration).

The fact that it is registered on the Principal Register under Section 2(f) of the Trademark Act means that we presume it has acquired source-indicating significance and that is enough for it to preclude the registration of a similar mark for use in connection with related services.

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014). In comparing the marks, we are mindful that

“[t]he 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*, 101 USPQ2d at 1721. *See also San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

As noted above Applicant is seeking to register the mark PENN AUTO and design, shown below, and the mark in the cited registration is PENN UNITED (standard characters).



The marks are similar because they share the term “Penn” as the first word of their respective marks.

Moreover, Registrant’s mark PENN UNITED is registered as a standard character mark and, therefore, the rights associated with that mark reside in the wording, and not in any particular display. Registrant’s standard character mark PENN UNITED may be depicted in any manner, regardless of the font style, size, or color. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Because Registrant’s mark may be presented in any style, the term

PENN could be displayed in a larger size over the word UNITED in a manner resembling Applicant's mark as shown below:



Although we assess each mark in its entirety, the term “Penn” is the dominant part of Applicant’s mark PENN AUTO and design. The word “PENN” comes first in the mark and is a large and prominent element of Applicant’s mark that is most likely to catch consumers’ eyes.¹⁰ As is often the case with marks comprising both literal and design elements, the wording is considered the dominant feature because it is the literal portion most likely to make an impression upon purchasers, be remembered by them, and be used by them to request the services. *See Jack Wolfskin* 116 USPQ2d at 1134; *In re Viterra Inc.*, 101 USPQ2d at 1908 (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See Viterra*, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

¹⁰ Applicant’s argument that “when viewing Applicant’s composite mark, one’s eye is naturally drawn to the center, which is the word AUTO” strains credulity inasmuch as it is displayed inconspicuously in the horizontal leg of the triangle. Applicant’s Brief, p. 9 (8 TTABVUE 15).

Moreover, the design element in Applicant's mark is not so distinctive that it creates a commercial separate and apart from the words such that consumers will notice it or remember it. *See Herbko Int'l Inc. Kappa Books Inc.*, 64 USPQ2d at 1380 (words dominate the design feature where the design portion of applicant's mark does not convey any distinct or separate commercial impression apart from the word portion of the mark); *CBS, Inc. v. Morrow*, 218 USPQ at 200 ("minor design features do not necessarily obviate likelihood of confusion arising from consideration of the marks in their entireties."). We disagree with Applicant's assertion that the inverted triangle may be the focal point¹¹ and overshadows the literal portion of its mark PENN AUTO.¹²

Also, "Penn" is more significant than the term "Auto" in Applicant's mark because the term "Auto" is highly descriptive when used in connection with "design engineering of hardware components and fasteners for the automotive industry" and Applicant disclaimed the exclusive right to use it.¹³ It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion

¹¹ Applicant's Brief, p. 7 (8 TTABVUE 13).

¹² *Id.* a p. 8 (8 TTABVUE 14).

¹³ Applicant argues that PENN is not primarily geographically descriptive and, in the alternative, that it has acquired distinctiveness meaning that, according to Applicant, "Penn" is the more distinctive of the two terms in the mark PENN AUTO and design. Applicant's Brief, p. 11 (8 TTABVUE 17).

on the likelihood of confusion.”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

The significance of the term “Penn” in Applicant’s mark is reinforced by its location in the first part of the mark. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (noting that the dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *Presto Prod. Inc. v. Nice-Pak Prod., 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”). Likewise, “Penn” is the first part of the cited mark PENN UNITED making the marks similar in appearance.

Consumers encountering Applicant’s PENN AUTO and design for automotive design engineering services who are familiar with Registrant’s PENN UNITED “design and testing for new product development” may mistakenly believe that PENN

AUTO is the PENN UNITED line of automotive-related services because of the similarity of the marks.

PENN AUTO and design is similar to PENN UNITED in terms of appearance, sound, connotation and commercial impression.

C. The similarity or dissimilarity and nature of the services.

We must consider the services as they are described in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”). *See also Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”). We also do not read limitations into the identification of services. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”); *In re Thor Tech*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no

authority to read any restrictions or limitations into the registrant's description of goods.”).

Applicant is seeking to register PENN AUTO and design for the services listed below:

Product engineering services for others, namely, design engineering of hardware components and fasteners for the automotive industry.¹⁴

The description of services in the cited registration is listed below:

Design and testing for new product development; Design and testing of new products for others; Designing of machines, apparatus, instruments or systems composed of such machines, apparatus and instruments; Product development; Product development for others; Product research & development; Product safety testing; Research and development for new products for others.

Because Registrant's description of services is not restricted or limited in any way, Registrant's product design and development services may encompass product engineering for all types of goods, including hardware components and fasteners in the automotive field. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant's broadly worded identification of ‘furniture’ necessarily encompasses Registrant's narrowly identified ‘residential and commercial

¹⁴ “Engineering” is defined, inter alia, as “the art or science of making practical application of the knowledge of pure sciences, as physics or chemistry, as in the construction of engines, bridges, buildings, mines, ships, and chemical plants.” Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2018). *See also* Merriam-Webster.com (“the design and manufacture of complex products”). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

furniture.”). Moreover, the Examining Attorney submitted excerpts from third-party websites showing that product design engineering is equivalent to product design, development and research. For example,

- API Technologies Corp. (apitech.com)

When you retain our design engineering services, you benefit from the experience we have acquired in over 30 years of product design and manufacture. Whether you need an extension to your present engineering/technical team, or a complete design engineering production unit, API EMS is ready to meet your needs.

Want to find out how API EMS design engineering services can help you create marketing-leading products? Call us toll free at 1-800-295-8000 and ask for Sales.¹⁵

- Cascade Engineering (cascadeng.com)

Product development at Cascade Engineering is a disciplined process that’s integral to our daily operation. Powered by creativity and passion for problem solving, we design and develop large parts, complex designs, aesthetic finishes, structural performance, and sustainable materials. Not only do we work closely with our customers to engineer and manufacture their designs, we also design, manufacture, and market our own products.¹⁶

Cascade Engineering offers computer aided design, material development, process engineering and product testing services.

- ECA Enterprises Inc. (ecaenterprises.com)

ECA does more than just contract manufacturing services, we are a full service product development company with full design engineering services capable for taking a project from infancy to delivery using state of the art design engineering services. Using advanced 3D CAD tools, such

¹⁵ February 15, 2017 Office Action (TSDR 13).

¹⁶ *Id.* at TSDR 14,

as Pro Engineering software, our product design and manufacturing engineers help you model and test your designs. Once these models have been developed, we can create prototypes, build production tooling, and provide full documentation for your parts.

Our engineers have years of experience in mechanical and electrical design. We have helped our clients across multiple industries develop prototypes, select materials, streamline designs, troubleshoot problems, coordinate testing and manufacture their product.¹⁷


We find that the services are in part identical. Applicant, in its brief, did not challenge that the services are related.

D. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Because the services described in the application and the cited registration are in part identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Applicant, in its brief, did not challenge that the services are offered in the same channels of trade or to the same classes of consumers.

E. Conclusion

¹⁷ *Id.* at TSDR 15,

Because the marks are similar, the services are, in part, overlapping and legally identical and presumed to be offered in the same channels of trade to the same classes of consumers, we find that Applicant's mark  for "product engineering services for others, namely, design engineering of hardware components and fasteners for the automotive industry" is likely to cause confusion with the registered mark PENN UNITED for "design and testing for new product development; design and testing of new products for others; designing of machines, apparatus, instruments or systems composed of such machines, apparatus and instruments; product development; product development for others; product research & development; product safety testing; research and development for new products for others."

The refusal to register Applicant's mark for the services in Class 42 is affirmed.

II. Applicant's specimens for the goods in Class 6 and Class 12

The Examining Attorney refused registration for the goods in Classes 6 and 12 pursuant to Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant failed to submit a specimen showing proper trademark use. Applicant identified its specimen as "screenshots of applicant's online catalog displaying the PENN AUTO logo in connection with the recited goods and services." The relevant portion of Applicant's specimen is reproduced below:

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The Examining Attorney explained that the specimen appears to be mere advertising and does not function as a display used in association with the goods because it does not include a means for ordering the goods.¹⁸

¹⁸ June 25, 2016 Office Action (TSDR 4).

Applicant contends, without providing a verified statement in support by someone in the field, that the contact information and info@pemnet.com email address is sufficient ordering information because “the specialized, technical nature of the identified goods necessitates contact with sales representatives for guidance on pricing and specifications during purchasing decisions.”¹⁹ While not specifically stating that the contact information should be used for ordering, “the purpose of this contact information is obvious to commercial clients.”²⁰

In the next Office Action, the Examining Attorney explained that merely listing contact information of sales associates in advertising is not sufficient to make the advertising technical trademark use.²¹ The Examining Attorney quoted TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 904.03(h) reproduced below:

[T]he inclusion of a phone number, Internet address, and/or mailing address merely as part of corporate contact information on an advertisement describing the product is not in itself sufficient to meet the criteria for a display associated with the goods. **There must be an offer to accept orders or instructions on how to place an order.** See *In re MediaShare Corp.*, 43 USPQ2d 1304,1306 (TTAB 1997) (finding applicant’s fact sheet brochure, which included an address and phone number but omitted any information as to product price and how to order applicant’s software, was merely advertising material). (Emphasis added).

In response, Applicant submitted a “substitute” specimen, an excerpt from the pem.net website displaying the PENN AUTO and design trademark with the legend

¹⁹ January 3, 2017 Response to Office Action (TSDR 16).

²⁰ *Id.*

²¹ February 15, 2017 Office Action (TSDR 6).

“Fasteners & Precision Automotive Components.”²² The relevant portion of the pem.net website is reproduced below:²³



Applicant argues that “[i]t is common practice in the industry to have a single, separate ‘contact us’ page on the website for ‘sales’, ‘technical support’, etc. Customers browsing the original specimen can easily locate the contact information found in the supplemental specimen with a few clicks.”²⁴

The parties repeated the arguments in their briefs.

“[T]he company name, address and phone number that appears at the end of the web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone.”

In re Genitope Corp., 78 USPQ2d 1819, 1822 (TTAB 2006). *See also In re Quantum Foods Inc.*, 94 USPQ2d 1375, 1379 (TTAB 2010) (information normally associated

²² August 21, 2017 Response to Office Action (TSDR 200). The substitute specimen was not supported by an affidavit or declaration attesting to the fact that the specimen was in use at least as early as the filing date of the application. Trademark Rule 2.59(a), 37 C.F.R. § 2.59(a).

²³ *Id.* at TSDR 202.

²⁴ *Id.* at TSDR 7.

with ordering products via the Internet includes sales form, pricing information, offers to accept orders or special instructions for placing orders).

Our primary reviewing court has instructed that the Trademark Act “specifies no particular requirements to demonstrate source or origin; for displays, the mark must simply be ‘associated’ with the goods.” *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009), *citing In re Marriott*, 459 F.2d 525, 173 USPQ 799 (CCPA 1972). However, the court, in the context of reviewing a Board determination that a webpage specimen did not qualify as a display associated with goods, also stated that a relevant consideration was whether the webpage specimen had a “point of sale nature.” *Sones*, 93 USPQ2d at 1124, *citing Lands’ End Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992). The determination of whether a proffered catalog specimen is merely advertising or serves the function of a display associated with the goods is a question of fact. *In re Shipley Co.*, 230 USPQ2d 691, 694 (TTAB 1986). A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale. *Id.* at 694 (“A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location”). “Factually, we need to ask whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind.” *In re Anpath Group Inc.*, 95 USPQ2d 1377, 1381 (TTAB 2010).

As noted above, Applicant, through counsel, asserts that this is the customary and usual way for companies to provide point-of-sale information to customers. However,

the specimens do not contain any information normally associated with ordering products via catalog or the Internet. There are no sales forms, no pricing information, no offers to accept orders, and no special instructions for placing orders anywhere on the specimen. There are no instructions regarding what information the caller needs to have available to help Applicant process an order.

Another problem with counsel's explanation is that there is no support for his statements in the record. We have only counsel's statements as to how Applicant sells its products. The facts in this appeal are similar to *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002 (TTAB 2002) where applicant's counsel explained how applicant and its competitors conducted business without providing any foundational information regarding counsel's investigation of, or understanding of, applicant's business, that would put him in a position to make statements regarding the marketing of the products at issue, which in these cases are essential to our analysis of the registrability of the mark. *Id.* at 2006, citing *In re DeBaun*, 687 F.2d 459, 214 USPQ 933, 934 n.4 (CCPA 1982) ("we need not evaluate the weight to be given to the attorney's declaration with respect to statements more appropriately made by appellant"); *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (where appellant argued that the magazines at issue deal with unrelated subject matter, the court held that "[s]tatements in a brief cannot take the place of evidence."); *In re Scarbrough*, 500 F.2d 560 182 USPQ 298, 302 (CCPA 1974) (where patent claims were rejected for the insufficiency of disclosure under Section 112, the response of appellant was argument in lieu of evidence leading the court to

hold that “argument of counsel cannot take the place of evidence lacking in the record.”); *In re Nat’l Distiller & Chem. Corp.*, 297 F.2d 941, 132 USPQ 271, 274 (CCPA 1962) (“statements made over the signature of counsel are not evidence of the facts averred”); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983) (applicant argued without corroborating evidence that its brochure would be recognized as an offer of services leading the Board to hold that “[u]nfortunately we have no evidence of record to this effect and assertions in briefs are normally not recognized as evidence”); *Spin Physics, Inc. v. Matsushita Electric Industrial Co., Ltd.*, 168 USPQ 605, 607 (TTAB 1970) (“The arguments and opinions of counsel for applicant are wholly insufficient to overcome the facts established by the Sugaya report.”). *Compare In re Valenite Inc.*, 84 USPQ2d 1346, 1348 (TTAB 2007) (appellant submitted the declaration of its director of marketing who testified that appellant’s customers regularly order its products by contacting the customer service department by telephone).

If applicant wished to show that orders for its industrial chain cannot readily be ordered by reference to particular goods and pricing information, and are regularly ordered by telephone following customer review of technical information in its specimens and consultation with employees of applicant, so that applicant’s specimens are viewed as point of sale displays, applicant was obligated to introduce such evidence to rebut the *prima facie* case made by the Trademark Examining Attorney. In cases such as this, where it is asserted that the nature of the goods and the consumers therefor require more involved means for ordering products, it is critical that the examining attorney be provided with detailed information about the means for ordering goods, and that such information be corroborated by sufficient evidentiary support, for example, a declaration from the applicant about its process for taking

and filling orders, as in the *Valenite* case. At best, applicant's catalog pages provides applicant's telephone number and domain name as information about applicant; the telephone number and domain name do not constitute a means to order applicant's chains by telephone or the Internet.

U.S. Tsubaki, 109 USPQ2d at 2006-07.

The specimens simply do not contain adequate information for making a decision to purchase the goods and placing an order and, therefore, we find that Applicant's specimens are advertisements that do not show the mark PENN AUTO and design used in commerce as a trademark for the goods described in Classes 6 and 12. The mere listing of telephone numbers and emails do not turn what is otherwise ordinary advertisements into a point-of-sale display or a "display used in association with the goods" and, thus, into a valid specimens showing technical trademark use.

We find that applicant has not submitted evidence showing proper use of its mark in commerce for the goods listed in Classes 6 and 12 and, therefore, we affirm the refusal of registration for those Classes.

III. Requirement for Applicant to disclaim the exclusive right to use the term "Penn"

The Examining Attorney required Applicant to disclaim the exclusive right to use the term "Penn" on the ground that it is primarily geographically descriptive when used on or in connection with Applicant's goods and services.²⁵ Sections 2(e)(2) and 6 of the Trademark Act, 15 U.S.C. §§ 1052(e)(2) and 1056. Under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), an applicant may be required to disclaim an

²⁵ Examining Attorney's Brief (10 TTABVUE 23-24).

unregistrable component of a mark otherwise registrable. Failure to provide the required disclaimer constitutes a ground for refusing registration. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005). In this case, the Examining Attorney takes the position that PENN is the abbreviation of “Pennsylvania” which is a geographically descriptive term and, therefore, must be disclaimed.

To establish a prima facie case for refusal to register a mark, or for a disclaimer of a portion of a mark, as primarily geographically descriptive, the examining attorney must show that:

- (1) the primary significance of the mark is a generally known geographic location; and
- (2) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.

In re Societe Generale des Eaux Minerals de Vittel S.A., 824 F.3d 957, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014). The second inquiry, regarding goods/services-place association, can be presumed when the goods or services do in fact emanate from the place named in the mark. *Hollywood Lawyers Online*, 110 USPQ2d at 1853; *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (“[W]here there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term is neither obscure nor remote, a public association of the goods or services with the place may ordinarily be presumed from

the fact that the applicant's goods or services come from the geographical place named in the mark.”).

A geographic nickname (e.g., “Big Apple” or “Motown”), or an abbreviation or other variant of the name of a geographic location, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. *See In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007) (holding that “Yosemite” is a well-recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in general and conveys a readily recognizable geographic significance); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services, where the evidence showed that “Carolina” is used to indicate either the state of North Carolina or the state of South Carolina).

The Examining Attorney submitted the evidence listed below to prove that “Penn” is the abbreviation for “Pennsylvania”:

- AcronymFinder.com identifies “Penn,” inter alia, as Pennsylvania (including “Pennsylvania Avenue Building (US government);²⁶
- Merriam-Webster.com defines “Penn,” inter alia, as Pennsylvania.²⁷ It also identifies “Penn” as a surname identifying William Penn, the founder of Pennsylvania;

²⁶ June 25, 2016 Office Action (TSDR 23).

²⁷ February 15, 2017 Office Action (TSDR 20).

- ENGLISH OXFORD LIVING DICTIONARIES
(oxforddictionaries.com/definition/us/) defines “Penn.” as “Pennsylvania”;²⁸
- THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2016) (ahdictionary.com) defines “Penn.” as “Pennsylvania”;²⁹ and
- MACMILLAN DICTIONARY (macmillandictionary.com/dictionary/American) defines “Penn.” as “Pennsylvania.”³⁰

See also the RANDOM HOUSE UNABRIDGED DICTIONARY, abbreviations for Pennsylvania include “PA (for use with zip code), PA., Penn., Penna.”³¹

According to THE COLUMBIAN GAZETTEER OF THE WORLD, Pennsylvania is a state in the Middle Atlantic region of the United States. It is one of the original 13 colonies. It has an estimated population of over 12,000,000 that includes the cities of Pittsburgh and Philadelphia.³²

Applicant counters by submitting the “Penn” entry from Abbreviations.com defining “Penn” as “Penn National Gaming, Inc.” and “Professional Educational

²⁸ *Id.* at TSDR 21.

²⁹ *Id.* at TSDR 22.

³⁰ *Id.* at TSDR 23.

³¹ Dictionary.com based on the Random House Unabridged Dictionary (2018).

³² “Pennsylvania,” COLUMBIA GAZETTEER OF THE WORLD ONLINE (columbiagazetteer.org) (2018). *See also* Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2018); “Pennsylvania,” ENCYCLOPAEDIA BRITANNICA (2018) (britannica.com). The Board may take judicial notice of information in a gazetteer which is a standard reference work, as well as from an encyclopedia. *See B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *In re Consolidated Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004); *In re Broyhill Furn. Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTB 2001); *Sprague Elec. Co. v. Elec. Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980).

Notetaking Network, not “Pennsylvania.”³³ However, determining whether a term is primarily geographically descriptive is not done in the abstract, but in connection with the goods and services for which registration is sought. Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2) provides that no mark shall be refused registration on account of its nature if it consists of a mark which “when used on or in connection with the goods of the applicant is primarily geographically descriptive of them.” *See also In re Nantucket, Inc.*, 677 F.2d. 95, 213 USPQ 889, 892 (CCPA 1982) (Section 2(e)(2) of the Trademark Act requires that the mark be evaluated when applied to the goods of the applicant). Nevertheless, the term “Penn” is also a surname identifying the prominent Sir William Penn, an English admiral, and his son, William, the founder of Pennsylvania.³⁴

Applicant argues that the Examining Attorney used the wrong term when searching for the meaning of “Penn” “because the search term was ‘penn.’ [with a period] not ‘penn,’” [without a period] and that changes the results.³⁵ However, the Examining Attorney used “penn” (without a period) as her search term and retrieved results which identified “Penn.” (with a period) as the abbreviation for “Pennsylvania.” The results showing that “Penn.” (with a period) is the abbreviation for “Pennsylvania” are probative to suggest that “Penn” (without a period) may more likely be the alternative meaning as a surname.

³³ August 21, 2017 Response to Office Action (TSDR 186).

³⁴ Dictionary.com based on the Random House Unabridged Dictionary (2018). *See also* Merriam-Webster.com; William Penn, Sean Penn, Arthur Penn and Irving Penn, ENCYLOPAEDIA BRITANNICA.

³⁵ Applicant’s Brief, pp. 12-13 (8 TTABVUE 18-19).

As noted above, in its August 21, 2017 Response to an Office Action, Applicant submitted “35 live U.S. trademark registrations (including Registrant’s marks) that include the word PENN and are registered for use in connection with goods/services in classes 6, 12 and 42, which are the classes for which Applicant seeks registration.”³⁶ “A real evidentiary value of third party *registrations* per se is to show the sense in which ... a mark is used in ordinary parlance.” *Juice Generation*, 115 USPQ2d at 1675 (quoting MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2015) (emphasis added). “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.*; see *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).

We summarize the information in the registrations submitted by Applicant as follows:

- Excluding the cited registrations, the exclusive right to use “Penn” was disclaimed in two registrations;³⁷

³⁶ August 21, 2017 Response to Office Action (TSDR 4).

³⁷ August 21, 2017 Response to Office Action (TSDR 18 and 63).

- Registrants claimed acquired distinctiveness in seven registrations presumably because the term “Penn” has geographic significance;³⁸
- Applicant is the owner of Registration No. 0928124 for the mark PENN ENGINEERING (typed drawing) for “self-clinching fasteners, self-locating weld fasteners, and self-clinching drill bushings,” in Class 6, registered on the Principal Register without a disclaimer of the term “Penn” or a claim of acquired distinctiveness under Section 2(f) of the Trademark Act;³⁹
- Penn is a surname in two registrations;⁴⁰ and
- The remaining 19 registrations were registered on the Principal Register without a disclaimer or claim of acquired distinctiveness.

The Examining Attorney has failed to show that the significance of the term “Penn” is primarily geographic inasmuch as “Penn” also has surname significance. No other indicia in the mark point to or emphasize one possible meaning over the other.

Decision: The refusal to register Applicant’s mark for the services in Class 42 under Section 2(d) of the Trademark Act is affirmed.

The refusal to register Applicant’s mark for the goods in Classes 6 and 12 for failure of Applicant to submit acceptable specimens of use is affirmed.

³⁸ *Id.* at TSDR 26, 36, 59, 116, 133, 170 and 175.

³⁹ Registered February 1, 1972; third renewal. *Id.* at TSDR 140.

⁴⁰ *Id.* at TSDR 34 and 120

The requirement for Applicant to disclaim the exclusive right to use the term
“Penn” is reversed.