

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vanair Manufacturing, Inc.

Serial No. 90293210

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for Vanair Manufacturing, Inc.

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Before Zervas, Cataldo, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Vanair Manufacturing, Inc. (“Applicant”) seeks registration on the Principal Register of the mark GENAIR in standard characters for “Air compressors; Generators, namely, integrated electric generators for land vehicles” in International

Class 7.¹ The Examining Attorney refused registration of the mark on two grounds: under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, based on the failure of Applicant's specimens to show use of the proposed mark on or in connection with the identified goods; and under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the previously registered mark GENAIRATOR in standard characters, for "diesel powered combination electricity generators and air compressors" in International Class 7.²

After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. The Examining Attorney denied reconsideration and maintained the refusal on both grounds. The appeal then proceeded, and Applicant and the Examining Attorney submitted briefs.³

For the reasons set forth below, we affirm the refusal to register on both grounds.

II. Specimen

Both the October 25, 2021 final Office Action and the May 19, 2022 Denial of Reconsideration clearly set out two grounds for refusal of registration, one of which was the unacceptability of the specimens. Although Applicant acknowledges in its summary of the prosecution history of the application that the Examining Attorney

¹ Application Serial No. 90293210 was filed November 2, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on alleged use of the mark in commerce.

² Registration No. 4355094 issued June 18, 2013, and has been maintained.

³ Applicant's single-spaced brief does not comply with the requirement that briefs be double-spaced. Trademark Rule 2.126(a)(1), 37 C.F.R. § 2.126(a)(1); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.01 (2022). However, the brief clearly would fall within the applicable page limits had it been double-spaced, and in this instance, we exercise our discretion to accept it. *See In re Univ. of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017).

“refused the substitute specimens” offered in Applicant’s Request for Reconsideration,⁴ Applicant’s Brief makes no further mention of the specimen-based refusal, and does not argue against it. As the Examining Attorney correctly points out, this failure to address the issue constitutes a waiver or forfeiture of the appeal on this ground. *In re Katch, LLC*, 2019 USPQ2d 233842, at *1-2 (TTAB 2019) (applicant who failed to address a ground for refusal in his briefing waived appeal of the refusal of registration on that ground); *see also* TBMP § 1203.02(g) (“If an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board.”). We therefore affirm the refusal to register.

The affirmance on this ground is a sufficient basis to affirm the refusal to register Applicant’s mark, but for completeness, we also address the likelihood of confusion ground below.

III. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers only those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *see also Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir.

⁴ 6 TTABVUE 6 (Applicant’s Brief).

2020) (“Not all *DuPont* factors are relevant in each case”). Two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (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.”).

A. Similarity of the Marks

We first compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

As an initial matter, we must reject Applicant’s assertion that the cited mark GENAIRATOR consists of “a non-distinctive term.”⁵ “As long as the registration relied upon . . . remains uncanceled, it is treated as valid and entitled to the statutory presumptions.” *In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). The registration issued on the Principal Register without a requirement of a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.” *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). On this record, we treat the cited mark as inherently distinctive, and, with no evidence that the mark has been diluted, we conclude that it is entitled to an ordinary scope of protection. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

Applicant’s mark GENAIR is identical to the first two syllables of the cited mark GENAIRATOR, such that the marks look and sound similar overall. This portion of the cited mark stands out because it comes first in the mark, and consumers are more likely to focus on it. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“the identity of the marks’ two initial words is particularly significant because consumers

⁵ 6 TTABVUE 8 (Applicant’s Brief).

typically notice those words first”). While Applicant downplays sharing this portion of the cited mark as a “common prefix,” we disagree, and find that GENAIR is more significant than a prefix. As we must, and as urged by Applicant, we compare the marks in their entireties. However, for rational reasons, we may give more or less weight to a particular feature of a mark, provided the ultimate conclusion regarding similarity of the marks rests on a consideration of the marks in their entireties. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

As to connotations and commercial impressions, we also find them similar. First, consumers would derive the same meaning and impression from the term GENAIR in Applicant’s mark and Registrant’s mark. In the cited mark, the combination of elements appears in the context of GENAIRATOR. According to the Random House Dictionary, the suffix “-ator” signifies “a combination of -ate and -or that forms nouns corresponding to verbs ending in -ate, denoting a human agent ... or nonhuman entity, especially a machine ... performing the function named by the verb.”⁶ Thus, in the context of the GENAIRATOR mark, the -ATOR portion conveys that a machine performs the functions. We are not persuaded by Applicant’s argument that consumers would mistake the cited mark for the word “generator,” so as to distinguish it from Applicant’s mark. Both Applicant’s mark and the cited mark contain GENAIR, and the additional -ATOR suffix in the cited mark does not

⁶ We take judicial notice of the Dictionary.com (sourced from the Random House Dictionary) entry for “-ator,” accessed at dictionary.com on January 6, 2023. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

substantially change the connotation or commercial impression. Rather, when considering the marks as a whole, they convey similar meanings and impressions.

We are not persuaded by the cases cited by Applicant, as the marks and goods and services in those cases differ, and we do not find them analogous to the issues in this case. *See In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1027 (TTAB 2017) (comparisons to other cases “are rarely helpful, because the critical facts of different cases almost always differ substantially”). Ultimately, “each case must be decided on its own facts and the differences are often subtle ones.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014).

We must consider the likelihood that marks will be considered to be similar “in light of the fallibility of memory.” *See id.* at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Given the resemblance in sound, appearance, connotation and commercial impression when the marks are considered in their entireties, we find that Applicant’s mark is similar to the cited mark, and the first *DuPont* factor weighs in favor of likely confusion.

B. Relatedness of the Goods

In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. *See Detroit Ath. Co.*, 128 USPQ2d at 1051; *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding

their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any good encompassed by the identification in this single-class application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*, 123 USPQ2d 1744 (Fed. Cir. 2017).

Applicant’s goods are “Air compressors; Generators, namely, integrated electric generators for land vehicles.” The air compressors are broadly identified and therefore encompass all types of air compressors. *See, e.g., 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 furniture.’”); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s goods encompass all such computer programs including those which are for data integration and transfer.”). Registrant’s goods are diesel-powered combination electricity generators and air compressors.

The goods can be considered legally identical in part because Applicant’s broadly identified air compressors could encompass air compressors sold as combination units with generators, as identified in the cited registration. *See, e.g., Lincoln Nat’l Corp.*

v. Anderson, 110 USPQ2d 1271, 1272 (TTAB 2014) (where the applicant’s broadly identified services encompassed opposer’s services the Board deemed them “in part legally identical”). The evidence discussed below indicates that air compressors often include or are part of combination units that include generators.

Additionally, we find Applicant’s and Registrant’s goods at issue here related because the record reflects that consumers are accustomed to encountering them coming from the same source. Applicant itself serves as an example of an entity providing the respective goods under the same mark. The Examining Attorney introduced screenshots from Applicant’s website that show it offers under the VANAIR mark a “single unit” that provides functionality including an air compressor and a generator, and is “Available in Diesel.”⁷ Applicant’s website also promotes that this combination unit “provides you with a complete mobile workstation on the back of your truck.”⁸ As another example, Applicant’s website offers its “Contractor-Gas Reciprocating Air Compressor with Generator,” and indicates that the systems are “[a]vailable with gasoline or diesel engines.”⁹ The screenshot below also shows Applicant’s VANAIR mark appearing on both standalone air compressors and diesel-powered combination electricity generators and air compressors:¹⁰

⁷ October 25, 2021 Office Action at TSDR 2 (vanair.com).

⁸ *Id.* at 3.

⁹ *Id.* at 5.

¹⁰ May 19, 2022 Denial of Reconsideration at TSDR 11 (vanair.com); *see also id.* at 12-16.



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Numerous screenshots from various third-party websites also show the promotion of goods like Applicant's and Registrant's under the same mark.

The Mi-T-M website has a webpage devoted to "Air Compressor Generators," describing "[t]he Mi-T-M air compressor/generator combination unit," including models that are "diesel powered." The website also promotes its industrial air compressors.¹¹

The website of VMAC Air Innovated offers under the VMAC mark a "Multifunction-Compressor-Generator Power System" with accessories that include a diesel fuel tank and a diesel fuel pump kit. Also under the VMAC mark, the site offers air compressors appropriate for mounting in trucks and VMAC Underhood Air Compressors for trucks and vans. The site promotes another system under the CAT mark that is powered by a diesel engine and includes an air compressor and generator.¹²

The Industrial Gold website promotes its "Compressor & Generator Combos" that are "driven by diesel motors." The site also features air compressors that "fit into tight spaces in service vans [and] enclosed trucks."¹³

The John Deere website promotes under the JOHN DEERE mark its "Compresserators™" that have a "built-in generator system alongside the single or two-stage air compressor," and come in a diesel-based version. The machine is pictured for use with a JOHN DEERE tractor. The website also features JOHN DEERE air compressors.¹⁴

The Eaton Compressor website shows a variety of air compressors as well as a combination compressor/generator, powered by a gas engine.¹⁵

¹¹ October 25, 2021 Office Action at TSDR 6 (mitm.com).

¹² October 25, 2021 Office Action at TSDR 11-19 (vmacair.com).

¹³ October 25, 2021 Office Action at TSDR 20-25 (industrialgold.com).

¹⁴ May 19, 2022 Denial of Reconsideration at TSDR 2-3 (deere.com).

¹⁵ May 19, 2022 Denial of Reconsideration at TSDR 4-5 (eatoncompressor.com).

The Boss Air/Power website promotes under the BOSS mark a generator that is mounted in a vehicle, an air compressor that is diesel-powered and vehicle-mounted, and multiple combination compressor/generator units.¹⁶

This evidence supports the relatedness of the goods in the application and cited registration by showing that consumers are accustomed to encountering them offered by a single source under the same mark. *See Detroit Ath. Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

While Applicant argues that specific actual features of its identified “air compressors” differentiate them from the units identified in the cited registration,¹⁷ we cannot consider marketplace limitations not included in the identification. Instead, we must rely on the goods as identified. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). The respective identified goods must only be related, in the sense that consumers might expect them to come from

¹⁶ May 19, 2022 Denial of Reconsideration at TSDR 6-10 (bossair.com).

¹⁷ Applicant’s Brief refers to “attached Exhibit A,” but no attachment was included with the Brief. The Examining Attorney noted the omission, and lodged an objection to consideration of any new evidence. We obviously have not considered what was not provided, and regardless, any evidence submitted with Applicant’s brief that was not introduced during prosecution is untimely and would not be considered.

the same source. *Coach Servs.*, 101 USPQ2d at 1722. The record clearly supports such a consumer expectation in this case.

Given the partial overlap and otherwise related nature of the respective goods, the second *DuPont* factor weighs in favor of likely confusion.

C. The Trade Channels and Classes of Consumers

Turning to the trade channels and classes of consumers, because the identifications in the application and cited registration have no restrictions on channels of trade, we must presume that the goods travel in all the normal channels of trade for their respective goods. *See Hewlett-Packard Co.*, 62 USPQ2d at 1005. The legally identical goods are presumed to move in the same channels of trade to the same classes of consumers. *Viterra*, 101 USPQ2d at 1908 (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); *see also Inter IKEA Sys. B.V. v. Akea*, 110 USPQ2d 1734, 1743 (TTAB 2014); *L. & J.G. Stickley, Inc. v. Cosser*, 81 USPQ2d 1956, 1971 (TTAB 2007) (“Because the goods of both parties are at least overlapping, we must presume that the purchasers and channels of trade would at least overlap.”). The third-party website evidence discussed above further shows that goods such as Applicant’s and Registrant’s move in some of the same channels of trade to some of the same classes of consumers.

The evidence of records shows that the trade channels and consumers overlap. Thus, the third *DuPont* factor weighs in favor of likely confusion.

D. Conclusion as to Likelihood of Confusion: Balancing the Factors

The similarity of the marks, and in part-legal identity and otherwise relatedness of the goods, which travel in overlapping trade channels to some of the same consumers, render confusion likely.

Decision: The refusal to register based on the lack of an acceptable specimen is affirmed, and the refusal based on likelihood of confusion is affirmed.