

This Opinion is not a  
Precedent of the TTAB

Mailed: September 3, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Caterpillar Inc.*

*v.*

*Big Cat Energy Corporation*

Opposition No. 91193704  
against Serial Nos. 77617945 and 77618417

Christopher P. Foley, Naresh Kilaru, Stephanie H. Bald and Michael R. Justus of  
Finnegan Henderson Farabow Garrett & Dunner, L.L.P., for Caterpillar Inc.

Cheryl L. Anderson and Craig R. Miles of CR Miles PC,  
for Big Cat Energy Corporation.

Before Bucher, Kuhlke and Masiello,  
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Big Cat Energy Corporation (“Applicant”) seeks registration  
on the Principal Register of the mark **BIG CAT** (*in standard  
character format*)<sup>1</sup> and the special form mark shown at right,  
both marks for goods, as amended, as follows:



<sup>1</sup> Application Serial No. 77617945 was filed on November 19, 2008, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On August 13, 2009, Applicant filed an Amendment to Allege Use (AAU) claiming first use anywhere and use in commerce since at least as early as February 28, 2006.

gas well equipment, namely, well bore fluid redistribution equipment comprised of a sealing body insertable into a well bore with ports allowing fluid to be pumped from one geological stratum to another, pumps, valves, and pipes in International Class 7.

Caterpillar Inc. (hereinafter “Opposer” or “Caterpillar”) has opposed these applications on the grounds of priority and likelihood of confusion under Section 2(d) of the Act, 15 U.S.C. § 1052(d), and likelihood of causing dilution by blurring under Section 43(c) of the Act, 15 U.S.C. § 1125(c).<sup>3</sup>

In addition to pleading common law rights in the mark CAT in connection with a wide range of goods and services in the oil and gas industry, including engines of oil and gas wells, both onshore and offshore; engines for use in connection with natural gas mining applications in coal bed methane (CBM), coal mine methane (CMM), and Coal Seam Natural Gas (CSNG) applications, including engines for powering, drilling and production, and well servicing; generators, pipelayers, track-type tractors, hydraulic excavators, motor graders, trucks and generator sets; and onsite support, repair and maintenance, Caterpillar has pleaded ownership of the following trademark registrations:

---

**CAT**

for “dump-wagons, wheel tractor-dump-wagon combinations, and structural parts for such products” in International Class 19;

---

---

<sup>2</sup> Application Serial No. 77618417 was filed on November 20, 2008, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On August 13, 2009, Applicant filed an Amendment to Allege Use (AAU) claiming first use anywhere and use in commerce since at least as early as February 28, 2006.

<sup>3</sup> See Opposer’s “First Amended Notice of Opposition of February 21, 2012 (16 TTABVue at 10-28 of 124), as approved by the Board on October 1, 2012 (21 TTABVue). This included Opposer’s addition of Registration No. 4045652 as a pleaded registration, and Opposer’s claim of rights in the CAT mark resulting from an acquisition.

	<p>“electric generators and diesel electric generator sets, and parts furnished with said products” in International Class 21;</p> <p>“diesel and other internal combustion engines adapted for employment as the source of power for self-propelled vehicles and as stationary or portable power units for industrial, marine and agricultural uses; scraping, carrying and dumping units adapted to be employed for scraping and collecting earth, rock, or like materials and transporting and dumping said materials; power and manually controlled graders, scarifiers, scrapers, and rippers adapted to be employed for the construction and maintenance of roads, for moving and removing of earth, rock, snow and like materials, for preventing soil erosion and for other industrial and agricultural uses; tractors for industrial and agricultural purposes; and parts and service tools furnished with said products” in International Class 23;<sup>4</sup></p>		
CAT	for “motor trucks, dump wagons, wheel tractor-dump wagon combinations, wheel tractors, and parts therefor” in International Class 19; <sup>5</sup>		
CAT	for “service, maintenance and repair of trucks, tractors, engines, earthmoving equipment and control units therefor, generators and agricultural equipment” in International Class 37; <sup>6</sup>		
CAT	for “lift trucks, and engines, attachments and parts therefor” in International Class 23; <sup>7</sup>		
CAT	for “maintenance and repair services in the field of internal combustion engines, vehicles and power equipment; namely trucks, tractors, engines, earthmoving equipment, material handling equipment, paving equipment, agricultural equipment, generators, and control units for the aforementioned” in International Class 37; <sup>8</sup>		
CAT	for “machinery for earth moving, earth conditioning and material handling, namely, loaders and engines therefor, and parts for vehicle and internal combustion engines” in International Class 7;	“vehicles for earth and material hauling and handling, namely, tractors and engines therefor” in International Class 12; <sup>9</sup>	
CAT	for “business management and consultation services, namely, product distribution operations management services; logistics consulting services, namely, providing contract logistics services and consulting in the areas of inventory management freight transportation management, warehouse and product distribution operations management” in International Class 35;	“warehousing services” in International Class 39;	“design of computerized information systems for managing logistics and

<sup>4</sup> Registration No. 0564272 issued on September 23, 1952; fourth renewal.

<sup>5</sup> Registration No. 0770639 issued on June 2, 1964; third renewal.

<sup>6</sup> Registration No. 0778638 issued on October 13, 1964; third renewal.

<sup>7</sup> Registration No. 0984444 issued on May 21, 1974; third renewal.

<sup>8</sup> Registration No. 1579437 issued on January 23, 1990; second renewal.

<sup>9</sup> Registration No. 2140606 issued on March 3, 1998; renewed.

	product distribution processes for others” in International Class 42; <sup>10</sup>
<b>CAT</b>	for “business management and consultation services, namely, product distribution operations management services; logistics consulting services, namely, providing contract logistics services and consulting in the areas of inventory management, freight transportation management, warehouse and product distribution operations management and designing and managing complete logistics solutions for others” in International Class 35; “warehousing services” in International Class 39; “design of computerized information systems for managing logistics and product distribution processes for others” in International Class 42; <sup>11</sup>
	for “hydraulic excavators; mini hydraulic excavators; wheeled excavators; front shovels; backhoe loaders; skid steer loaders; compact wheel loaders; wheel loaders; integrated tool carriers; telescopic handlers; track loaders; wheel tractor-scraper; track-type tractors; wheel dozers; motor graders; soil compactors; cold planers; road reclaimers; asphalt pavers; vibratory compactors; marine engines; industrial engines; diesel generator sets; gas generator sets; demolition machines and scrap material handlers for use therewith, namely, blades, buckets, crushers, grapples, hammers, hydraulic brooms, mobile shears, pallet forks; pulverizers, and rakes; log loaders; pipe layers; mining shovels; waste handling machines; and parts for all the above” in International Class 7; “off-highway trucks; articulated trucks; truck engines; agricultural tractors; and parts for all the above” in International Class 12; <sup>12</sup>
	for “attachments, namely, asphalt cutters, hydraulic brooms, vibratory compactors, cutting jaws, multi-processors, tillers, trenchers, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling” in International Class 7; <sup>13</sup>
	for “machinery for earth moving, earth conditioning and material handling, namely, backhoe loaders, track excavators, wheeled excavators, telescoping material handlers, track material handlers, wheeled material handlers, underground mining loaders” in International Class 7; <sup>14</sup>

<sup>10</sup> Registration No. 2364591 issued on July 4, 2000; renewed.

<sup>11</sup> Registration No. 2364592 issued on July 4, 2000; renewed.

<sup>12</sup> Registration No. 2421077 issued on January 16, 2001; renewed.

<sup>13</sup> Registration No. 3525811 issued on October 28, 2008; Section 8 affidavit accepted and Section 15 affidavit acknowledged. The mark consists of yellow trim around the perimeter of the mark, a yellow triangle at the bottom of the word “CAT,” a black background and a red edge at the right-hand side of the mark. The word “CAT” is white. The colors yellow, black, red and white are claimed as a feature of the mark.

<sup>14</sup> Registration No. 3525812 issued on October 28, 2008; Section 8 affidavit accepted and Section 15 affidavit acknowledged. The mark consists of a yellow triangle at the bottom of the word “CAT,” a black background and a red edge at the right-hand side of the mark. The word “CAT” is white. The colors yellow, black, red and white are claimed as a feature of the mark.



for “attachments, namely, augers, backhoes, hydraulic brooms, cold planers, compactors, vibratory compactors, crushers, grapples, hammers, pulverizers, pulverizing jaws, rakes, saws, shears, snow blowers, stump grinders, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling” in International Class 7;<sup>15</sup>



for, *inter alia*, “ ... pipes and tubes of metal; metal plugs, ... metal washers, metal seals, metal tie downs, metal pipe nipples, ... metal caps for tubing ends, metal closures for containers, metal pipe collars, metal clamps, metal couplings for use with hoses, ... metal storage tanks, metal drain plugs, ... metallic drain traps and drain caps; metal pipe extensions; metal debris deflectors; steel reinforcing grids for use in paving processes; clad steel plates; metal track hardware, namely, track links, track shoes and track pins; ... parts for land vehicles ... and earth moving machinery, namely, metal gaskets for machinery and land vehicles, metal pipe connectors, metal pipe fittings, metal cylinders for compressed gas or liquids sold empty, metal threaded fasteners, metal hose clamps, and metal hose fittings” in International Class 6;

“motors and engines not for land vehicles; ... electric pumps; excavators; bulldozers; ... earth moving machines, namely, scarifiers, motor graders; combustion engine fuel nozzles; water separators for use in engines; fuel ... current generators; ... drilling bits being parts of machines; drilling heads being parts of machines; drilling machines, power drills; ... fuel conversion apparatus for internal combustion engines; fuel economizers for motors and engines; ... electric pumps; ... turbo-compressors; ...” in Class 7;

“land vehicles; tractors and tractor engines; ... vehicle parts, namely, tracks; trucks; dump trucks; land vehicles incorporating loading, compacting, pipe laying, and grading apparatus; ...” in Class 12; and “Non-metal seals for use on pipe joints and flanges; ... non-metal gaskets for commercial and industrial applications; ... coupling and joints not of metal; rings of rubber or of plastic for use as pipe connection seals; sealing plugs made primarily of rubber; ...” in International Class 17.<sup>16</sup>

Opposer alleges that its “CAT brand image is uniquely associated with the term ‘big’” and that “Opposer is routinely associated with ‘big machines,’ ‘big projects,’ ‘big

<sup>15</sup> Registration No. 3541939 issued on December 2, 2008; Section 8 affidavit accepted and Section 15 affidavit acknowledged. The mark consists of yellow trim around the perimeter of the mark, a yellow triangle at the bottom of the word “CAT,” a black background and a red edge at the right-hand side of the mark. The word “CAT” is white. The colors yellow, black, red and white are claimed as a feature of the mark.

<sup>16</sup> Registration No. 4045652 issued on October 25, 2011. The mark consists of a rectangular shape with a diagonal edge, containing the word “CAT” with a triangle below the letter “A.” We have chosen not to list all the items in International Classes 1, 2, 4, 8, 9, 11, and 20 that seem more distantly related to

growth,’ ‘big challenges,’ ‘big power,’ and ‘big solutions’.” Finally, Opposer claims that it “is also often referred to as ‘BIG CAT’.”

Applicant filed an amended answer by which it denied the salient allegations of the first amended notice of opposition. Applicant also asserted fourteen “affirmative defenses,” which we construe as amplifications of its denials – providing Opposer early notice of how Applicant intended to defend this opposition. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). In response to the parties’ cross motions for summary judgment, the Board, on July 15, 2013, denied both parties’ motions.<sup>17</sup>

## **I. Preliminary Matters**

In an earlier interlocutory decision, it was determined that the expert reports prepared by Lonnie Fuller and Raymond Garland are in compliance with Fed. R. Civ. P. 26(a)(2) in that Opposer’s experts have set forth their opinions and the bases and reasons for them.<sup>18</sup> Nonetheless, Applicant’s contentions remain before us that Opposer’s expert designations and reports should be stricken because they consist solely of legal conclusions and that Opposer’s experts are not “trademark” experts.

According to their reports, Mr. Fuller and Mr. Garland – the top executives of enterprises that would actually be among the potential purchasers of both parties’ products – have a combined total of more than forty years of experience in the oil and gas industry. Based upon our experience with reliance on expert witnesses in

---

<sup>17</sup> As will be discussed in more detail later, the parties then agreed to Accelerated Case Resolution (ACR), providing for a simplified method for reaching this final decision.

<sup>18</sup> 13 TTABVue at 5 of 6, April 1, 2011.

trademark trials, Messrs. Fuller and Garland are prime examples of sophisticated consumers having knowledge to offer opinions on *du Pont* likelihood-of-confusion factors such as the relationship of the parties' goods and services as well as the overlap in trade channels and potential customers.

Federal Rule of Evidence 702 is part of the "liberal thrust" of the Federal Rules of Evidence and their "general approach to relaxing the traditional barriers to "opinion" testimony. See *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 593-94, 27 USPQ2d 1200 (1993). As finders of fact, we welcome the testimony from competent persons having experience in technical fields such as preparing and drilling oil and gas wells, optimizing mineral extraction from existing wells, and site reclamation of exhausted wells. Therefore, in this case, we will admit the testimony of these witnesses, although we will consider their qualifications in determining the weight we give their testimony.

In another contested matter, Applicant objected to the following argument from Opposer's brief:

The common usage of the "Big Cat" nickname is also supported by the deposition testimony of Mr. Oates, who testified that during his thirty years of selling Caterpillar equipment it was quite common to hear people refer to a piece of Caterpillar's massive machinery as a "Big Cat."<sup>19</sup>

As to the supporting testimony, it is Applicant's contention that the following testimony of Richard Oates is inadmissible hearsay:

Q. (By Counsel Justus): So you mentioned a couple seconds ago that people refer to Caterpillar as large machines with a nickname.

---

<sup>19</sup> Opposer's supplemental summary judgment brief of November 15, 2013, at 18, 51 TTABVue at 26 of 234.

A. (Richard Oates): Yes.

Q. What was that nickname?

A. Big CAT. ...<sup>20</sup>

A. And when people say, “Hey, I’m going to go get the big CAT,” you know, they’re thinking a Caterpillar product. And that’s what I know. ... And individual to, you know, different marketing meetings I’ve been to, in the past, with Caterpillar representatives, you know, they – they’ve referred to them just as, you know big CAT. ...

Years ago there was an operator in southwest Wyoming ... And he worked for Searle Brothers ... And as a salesman, I’d hear the term “big CAT.”

And ... specifically in the Peabody mines at NERM, we had the first field development 797 trucks, and they were referred to as the big CAT truck.<sup>21</sup>

We find that this testimony is admissible for what it shows on its face, but may not be relied upon for the truth of the matter asserted, i.e., that “Big Cat” is in common usage on natural gas well sites as a nickname for Opposer, as that is hearsay. On the other hand, a fact-finder could conclude that this testimony is probative to the extent that it is corroborated by newspaper articles and headlines pointing out the frequency with which Opposer, the entity – as well as its largest pieces of Caterpillar equipment – are both referred to as “Big CAT,” *infra*.

## **II. The Record; Accelerated Case Resolution**

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), Applicant’s application files.

The parties had filed cross motions for summary judgment,<sup>22</sup> which the Board denied, finding genuine disputes of material fact. The parties then agreed to

---

<sup>20</sup> Oates Trans. at 95, 28 TTABVue at 86 of 87.

<sup>21</sup> Oates Trans. at 93, 95 and 96, 28 TTABVue at 85-87 of 87.



Accelerated Case Resolution (ACR), providing for a simplified method for making evidence of record, and agreeing that the Board may resolve genuine disputes of material fact and issue a final ruling based on the parties' submissions.

The parties are commended for pursuing this cost-efficient alternative to trial. *See* Trademark Board Manual of Procedure ("TBMP") § 528.05(a)(2) ("Accelerated Case Resolution") and § 702.04(c) ("ACR Conversion – Summary Judgment Briefs").

The Board approved the following ACR agreement between the parties, 49 TTABVue at 4-5:

- 1) The parties shall forego trial and an oral hearing;
- 2) The parties shall submit supplemental summary judgment briefs, briefing both the claims of likelihood of confusion and dilution;
- 3) The parties shall rely on the evidence submitted in support of their previously submitted cross motions for summary judgment;
- 4) The evidence submitted by the parties in conjunction with the summary judgment pleadings<sup>23</sup> may be considered by the Board without the requirement of notices of reliance or the need for accompanying testimony;
- 5) The page limit for the parties' briefs shall be 40 pages for Opposer's main brief and Applicant's response brief, and 20 pages for Opposer's reply brief, if any;
- 6) The parties are not required to submit separate statements of material fact as part of their briefs; and
- 7) The parties agree that the Board may resolve genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions.

---

<sup>22</sup> We note that Opposer's premature filing of its first Motion for Summary Judgment on October 17, 2012, has been deemed premature, and therefore we have given it (23 TTABVue) and the supporting documents (24 and 25 TTABVue) no consideration. *See* 27 TTABVue, November 1, 2012. The reference to the parties' cross-motions identifies Opposer's Motion for Summary Judgment of January 4, 2013 (28 TTABVue at 2-27 of 87) and Applicant's combined response to Opposer's Motion for Summary Judgment and Cross-Motion for Summary Judgment of February 8, 2013 (32 TTABVue at 5-25 of 217).

<sup>23</sup> We construe the use of "pleadings" in this context to mean exhibits attached to the motions and memoranda.

Under the ACR model selected by the parties, both parties submitted supplemental summary judgment briefs.<sup>24</sup> According to the prior agreement between the parties, we render this final decision in accordance with the evidentiary burden at trial, that is, that Opposer bears the burden of proving its claims by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

In support of its motion for summary judgment, and in opposition to Applicant's cross-motion for summary judgment, Opposer submitted for the record the following:

- (1) a partial transcript of the testimony of Richard H. Oates, Jr., director of sales for Wyoming Machinery Company, taken on December 13, 2012;<sup>25</sup>
- (2) the declaration of Michael R. Justus, an attorney with the law firm of Finnegan Henderson *et al.*, dated January 3, 2013;<sup>26</sup>
- (3) Status and title copies of Opposer's registrations pleaded in its amended Notice of Opposition;<sup>27</sup>
- (4) Applicant's responses to Opposer's First Set of Requests for Admissions;<sup>28</sup>
- (5) Applicant's answers to Opposer's First Set of Interrogatories;<sup>29</sup>
- (6) Applicant's responses to Opposer's Third Set of Requests for Admissions;<sup>30</sup>

---

<sup>24</sup> See Opposer's supplemental summary judgment brief of November 15, 2013 (51 TTABVue); Applicant's supplemental summary judgment brief of January 14, 2014 (52 TTABVue); and Opposer's reply to Applicant's supplemental summary judgment brief of January 29, 2014 (54 TTABVue).

<sup>25</sup> Oates Transcript, 28 TTABVue at 64-87 of 87.

<sup>26</sup> 29 TTABVue at 2-13 of 137.

<sup>27</sup> Justus Decl.-Exhibit A, 29 TTABVue at 15-44 of 137.

<sup>28</sup> Justus Decl.-Exhibit B, 29 TTABVue at 45-61 of 137.

<sup>29</sup> Justus Decl.-Exhibit C, 29 TTABVue at 62-77 of 137.

<sup>30</sup> Justus Decl.-Exhibit D, 29 TTABVue at 78-111 of 137.

- (7) Copies of articles appearing in magazines and newspapers and transcripts of television shows;<sup>31</sup>
- (8) a copy of an article from *THE TRADEMARK REPORTER*;<sup>32</sup>
- (9) the declaration of Ed Stembridge, Caterpillar's Product Identity Manager, dated October 17, 2012,<sup>33</sup> with exhibits attached thereto;<sup>34</sup>
- (10) the second declaration of Michael R. Justus, dated March 15, 2013,<sup>35</sup> with exhibits attached thereto;<sup>36</sup> and
- (11) the second declaration of Ed Stembridge, dated March 14, 2013,<sup>37</sup> with exhibits attached thereto.<sup>38</sup>

In response to Opposer's motion for summary judgment and in support of its own cross-motion for summary judgment, Applicant submitted for the record the following:

- (1) additional pages of the testimony transcript of Richard H. Oates, Jr., director of sales for Wyoming Machinery Company;<sup>39</sup>
- (2) the declarations of Joseph R. Corbett, Mark Hettinger, Greg Greenough, and Robert Vergnani;<sup>40</sup>
- (3) the declaration of Tim G. Barritt, chief executive officer for Applicant, dated February 4, 2013,<sup>41</sup> with exhibits attached;<sup>42</sup>

---

<sup>31</sup> Justus Decl.-Exhibit E, 29 TTABVue at 112-30, 135-37 of 137.

<sup>32</sup> Justus Decl.-Exhibit F, 29 TTABVue at 131-34 of 137.

<sup>33</sup> 30 TTABVue at 2-8 of 277.

<sup>34</sup> Stembridge Decl.-Exhibits A-G, 30 TTABVue at 9-277 of 277.

<sup>35</sup> 39 TTABVue at 2-5 of 88.

<sup>36</sup> Justus-2 Decl.-Exhibits A-H, 39 TTABVue at 6-88 of 88.

<sup>37</sup> 40 TTABVue at 2-4 of 180.

<sup>38</sup> Stembridge-2 Decl.-Exhibits A-B, 40 TTABVue at 5-180 of 180.

<sup>39</sup> Applicant's Exhibit 2: 32 TTABVue at 30-69 of 217.

<sup>40</sup> Applicant's Exhibit 6, 32 TTABVue at 93-104 of 217.

<sup>41</sup> 32 TTABVue at 123-32 of 217.

- (4) the declaration of Cheryl L. Anderson, Applicant's attorney, dated February 7, 2013,<sup>43</sup> with exhibits attached;<sup>44</sup>
- (5) the declaration of Shih-Kuei Chen, a law student employed by Applicant's attorney, dated February 6, 2013,<sup>45</sup> with exhibits attached;<sup>46</sup>
- (6) the declaration of Judy D. Kosola, Applicant's Office Administrator, dated January 25, 2013,<sup>47</sup> with exhibits attached;<sup>48</sup>
- (7) the second declaration of Tim G. Barritt, dated April 3, 2013,<sup>49</sup> with exhibits attached;<sup>50</sup>
- (8) the second declaration of Cheryl L. Anderson, dated April 4, 2013,<sup>51</sup> with exhibits attached;<sup>52</sup>
- (9) the second declaration of Judy D. Kosola, dated March 29, 2013,<sup>53</sup> with attached exhibit;<sup>54</sup> and
- (10) the second declaration of Shih-Kuei Chen, dated March 29, 2013,<sup>55</sup> with attached exhibit.<sup>56</sup>

---

<sup>42</sup> Barritt Decl.-Exhibits A-M, 32 TTABVue at 133-217 of 217.

<sup>43</sup> 33 TTABVue at 2-10 of 306.

<sup>44</sup> Anderson Decl.-Exhibits A-O, 33 TTABVue at 11-306 of 306, and 34 and 35 TTABVUE.

<sup>45</sup> 36 TTABVue at 2-5 of 379.

<sup>46</sup> Chen Decl.-Exhibits A-F, 36 TTABVue at 6-379 of 379.

<sup>47</sup> 37 TTABVue at 2-5 of 99.

<sup>48</sup> Kosola Decl.-Exhibits A-B, 37 TTABVue at 6-99 of 99.

<sup>49</sup> 41 TTABVue at 26-31 of 174.

<sup>50</sup> Barritt Decl.-Exhibits N-X, 41 TTABVue at 32-126 of 174.

<sup>51</sup> 41 TTABVue at 127-29 of 174,

<sup>52</sup> Anderson Decl.-Exhibits P-R, 41 TTABVue at 130-53 of 174.

<sup>53</sup> 41 TTABVue at 155-56 of 174.

<sup>54</sup> Kosola Decl.-Exhibit C, 41 TTABVue at 157-63 of 174.

<sup>55</sup> 41 TTABVue at 165-166.

<sup>56</sup> Chen Decl.-Exhibit G, 41 TTABVue at 167-74 of 174.

### III. The Parties

Opposer, Caterpillar, Inc., is a manufacturer of construction equipment. Opposer's CAT marks have been used continuously on construction equipment since 1948. Opposer is known in large part for heavy road building and mining equipment. Caterpillar's equipment is sold through a worldwide network of independently-owned dealers, of which more than fifty are located in the United States.<sup>57</sup>

Applicant was first formed in 1997 as Big Cat Investment Corporation, using the designation "Big Cat" for financial investment services in the field of mining exploration. In 2001, its name was changed to Big Cat Mining Corporation, using the designation "Big Cat" in connection with the acquisition of mining exploration rights.<sup>58</sup> Then in 2006, upon acquiring new hydrogeological technology for use in the oil and gas and mining industries, Applicant changed its name to "Big Cat Energy Corporation."<sup>59</sup> Applicant started using both the applied-for marks in early 2006.<sup>60</sup>

Applicant's majority shareholders are the inventors of Applicant's proprietary hydrogeological technology.<sup>61</sup> Applicant initially offered its products and services on a field test basis to gas well owners and operators without charge. Later, Applicant began leasing the technology and offering it for sale, and has continued to do so thereafter.<sup>62</sup> Applicant claims to have offered and promoted its technology using

---

<sup>57</sup> Stembridge Decl., 30 TTABVue at 2-7 of 277.

<sup>58</sup> Barritt Decl. ¶¶ 2-5, Exhibits C, 32 TTABVue at 124, 145-47 of 217.

<sup>59</sup> *Id.* at ¶ 10, Exhibit G, 32 TTABVue at 126, 159-67 of 217.

<sup>60</sup> *Id.* at ¶ 9, Exhibit F, 32 TTABVue at 125-26, 155-58 of 217.

<sup>61</sup> *Id.* at ¶ 6, 32 TTABVue at 125 of 217.

<sup>62</sup> *Id.* at ¶¶ 9, 12-16, Exhibits F and I, 32 TTABVue at 125-27, 155-58, 171-87 of 217.

Applicant's marks in a variety of ways, including product labels and product marking, vehicle and building signage, direct mail, use of an active website at bigcatenergy.com, distribution of brochures and other marketing material, phone book listings, calls, meetings, site visits, demonstrations, exhibits, trade show participation, and attendance and participation at professional meetings and conferences.<sup>63</sup>

In order for a prospective customer to lease or purchase the technology, a geological evaluation of the proposed well site, the proposed well bore, and data from the well, along with water quality testing, must be done and all of this is performed by Applicant. A regulatory permit for the well must then be obtained; if a proposed site is deemed appropriate for installation and use of the technology, installation is done by Applicant or contractors trained and certified by Applicant.<sup>64</sup> Applicant deals directly with its customers, working primarily with those persons responsible for and most knowledgeable regarding well bore produced water management.<sup>65</sup> Applicant's customers may require that formalized procurement procedures be followed in leasing or purchasing Applicant's technology.<sup>66</sup>

#### **IV. Standing**

Caterpillar has made of record numerous valid and subsisting registrations for its CAT marks, and has established use of those marks in connection with a wide range

---

<sup>63</sup> *Id.* at ¶¶ 20-23, Exhibits D and M, 32 TTABVue at 128-29, 148-52, 195-217 of 217.

<sup>64</sup> *Id.* at ¶¶ 18-19, 24-25 and Exhibit K and L, 32 TTABVue at 127-29, 190-94 of 217.

<sup>65</sup> *Id.* at ¶ 23, 32 TTABVue at 129 of 217.

<sup>66</sup> *Id.* at ¶¶ 17-18, 25, Exhibit K, 32 TTABVue at 127-29, 190-91 of 217.

of products and services in the field of construction, including construction in the field of the oil and gas industry. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc., v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Hence, we find that Opposer has established its standing under Section 13(a) of the Trademark Act, 15 U.S.C. § 1063(a). In fact, at no point in this proceeding has Applicant contested Opposer's standing to bring this opposition.

## V. Priority

In view of Opposer's ownership of valid and subsisting registrations of its pleaded marks, priority is not in issue with respect to its **CAT** marks as to the goods identified and services recited in those pleaded and proven registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). There is before the Board no counterclaim challenging Opposer's registrations and we must accord them all the presumptions afforded by Section 7(b) of the Trademark Act.<sup>67</sup> Accordingly, Applicant is barred from arguing priority as to any of the goods or services encompassed within these thirteen registrations.<sup>68</sup>

On the other hand, priority remains an issue with regard to Opposer's pleaded common law uses that are not specifically recited in any of its registrations. Applicant contends that its rights should be deemed senior to Opposer's common law

---

<sup>67</sup> We further note that, in its briefs, Applicant never argued that Opposer's registrations should be cancelled or modified.

<sup>68</sup> In a ruling of October 1, 2012, it was determined that Opposer could amend its notice of opposition to expand Opposer's pleading to add to its twelve earlier-pleaded marks Registration No. 4045652 (which issued October 25, 2011) listing goods in eleven classes. 21 TTABVue at 6-8 of 10.

rights with respect to certain goods and services. To the extent that it is necessary for Opposer to rely upon its common law rights, we have chosen to consider these arguments in our discussion of the parties' goods and services, *infra*.<sup>69</sup>

Accordingly, we turn to the issue of likelihood of confusion under Section 2(d).

## VI. Likelihood of Confusion

### *Statement of the Law*

Our likelihood of confusion determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also*, *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“... mistaken belief that [a good or service] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001) (“The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner”).

---

<sup>69</sup> This extensive litigation contains substantial evidence and arguments as to the timing, significance and impact of the parties' relative priorities growing out of Opposer's expanding common law uses (especially since January 2006) and Applicant's claims of technical trademark use, use analogous to trademark use, tacking, etc. We have chosen to consider all of this evidence as a whole. *See West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). We have also concluded that the doctrine of a zone of natural expansion of trade (as applied to Applicant and to Opposer) requires specific analyses that do not appreciably add to our understanding of the relatedness of the goods and services in this case. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1598 (TTAB 2011).



The parties presented evidence and argument on the *du Pont* factors of the fame, strength and renown of the marks, the relationships of the goods and services and their respective channels of trade, the conditions under which and buyers to whom sales are made, the similarities and dissimilarities of the marks, the number and nature of similar marks in use on similar goods or services, as well as the nature and extent of any actual confusion.

**A. Goods and Services, and Channels of Trade**

**1. On the face of the registrations and applications**

We turn first to our consideration of the relationship between Opposer's and Applicant's goods and services, as well as their respective channels of trade. We must make our determinations under these factors based upon the goods and services as they are recited in the applications and registrations. *See Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1990). The respective goods and services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions surrounding their marketing are such that the goods will be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they originate from the same source. *See 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).

Opposer argues that its products (e.g., machinery and equipment used to prepare, dig, and reclaim gas-well sites) are closely related to those covered by Applicant's

applications for the **BIG CAT** Marks (e.g., specialized natural gas well equipment). For example, Opposer's registrations list trucks and heavy, earth-moving machines, such as track-type tractors, hydraulic excavators, and motor graders that are used to prepare oil and gas well sites, and then are used again in site reclamation; the registrations also list generators and gensets used as a power source at oil and gas wells; and its identified pipelayers are used in laying pipes for conveying oil, gas and water in the vicinity of the natural gas borehole.

Applicant itself has admitted that Caterpillar's **CAT**-branded products and services are used on the *same* job sites as Applicant's **BIG CAT** products, and that Caterpillar's **CAT** products such as Opposer's variety of earth-moving equipment are "not uncommonly used in well site preparation work (clearing a site, creating an access road, and the like)." Also, "Applicant admits that Applicant's **BIG CAT** and Big Cat Energy Corp.-branded products are used at coal bed methane or coal seam methane well sites where Opposer's **CAT**-branded products are operated."<sup>70</sup> However, Applicant argues that it does not offer goods or services related in any way to Opposer's heavy earth-moving and construction-type machinery and equipment, parts, accessories, and attachments therefor, industrial engines and generators, and services for these goods. Rather, Applicant's technology involves hydrogeological equipment, namely, subsurface water redistribution equipment.<sup>71</sup>

In this context, we review briefly the respective parties' involvement over the history of a gas well. Applicant acknowledges that Opposer's heavy equipment (or that of any number of other heavy equipment manufacturers) may sometimes be used by contractors

---

<sup>70</sup> Justus Decl. ¶¶ 6-10, Justus Exhibits C and D, 29 TTABVue at 8-9, 50-54, 69 of 137.

<sup>71</sup> Barritt Decl. ¶ 7, Barritt Exhibit D, 32 TTABVue 125, 148-52 of 217.

to prepare a new well site. From start to finish, the range of **CAT**-branded equipment on gas well sites may include Opposer's generator sets ("gensets") powered by large Caterpillar engines. After the well site has been prepared, a third party will drill the well bore, but may well depend upon Opposer's **CAT**-branded machinery and equipment. At some later point, Applicant's specialized proprietary subsurface water redistribution technology may be installed down into a well bore, where it remains until removed. Applicant provides ongoing services for its technology after installation.<sup>72</sup> During the life cycle of a well, Opposer's ongoing services may include maintenance and repair services on well site power equipment including internal combustion engines, generators and control units. During the active period when natural gas is being extracted from the well, testimony shows that Opposer's pipe layers and trenchers may be used in connection with the operations of the well. Years later, upon completion of mineral extraction from an exhausted well, the gas well extraction equipment, possibly including Applicant's well bore fluid redistribution equipment, is removed by the contractor to move on to another job. At that point, Opposer's equipment (or that of its competitors) may well be used to reclaim the well site. Accordingly, we readily find that the parties' respective goods will be used by an overlapping universe of customers, namely owners and operators of gas wells. As a corollary, we find that the respective goods and services will travel through overlapping channels of trade to these same classes of purchasers.

On the other hand, we agree with Applicant that simply because Opposer's **CAT**-branded products are used on the same job sites as Applicant's **BIG CAT** technology, and both will be sold and used in the same "field" or "industry" (i.e., to extract natural gas

---

<sup>72</sup> Barritt Decl. ¶ 24, 32 TTABVue 129 of 217.

from wells), this finding does not compel a finding that the parties' products and services are complementary, and hence "related" for purposes of our likelihood-of-confusion analysis. *Bose v. QSC Audio Prods*, 63 USPQ2d at 1310; *Cooper Indus., Inc. v. Repecoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983). Even in cases where marks are substantially identical, significant differences between the goods or services of the parties can preclude any likelihood of confusion. *See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1393 (Fed. Cir. 1992), *reh'g denied* 1992 U.S. App. LEXIS 1505 (Fed. Cir., Feb. 4, 1992), and *reh'g, en banc, denied* 1992 U.S. App. LEXIS 2473 (Fed. Cir., Feb. 20, 1992); *Conwood Corp. v. J.B. Williams Co.*, 475 F.2d 643, 177 USPQ 331, 332 (CCPA 1973); *Nat'l Assoc. of Blue Shield Plans v. Standard Mattress Co.*, 478 F.2d 1253, 178 USPQ 153 (CCPA 1973). In this case, the record shows no specific examples where Opposer's goods or services are actually shown to be used in close association or combination with Applicant's technology. The record contains no evidence that third parties who make heavy construction and generator equipment used in oil and gas wells also sell subsurface water redistribution systems.

Nonetheless, as discussed *infra*, we have concluded that Opposer's **CAT** marks are famous, in no small measure because, as the record shows, **CAT**-branded equipment is pervasive on natural gas well sites throughout the entire life-cycle of the well. Hence, based upon all of the evidence in the record, including the respective registrations and applications, there exists a relationship between Applicant's hydrogeological technology and Opposer's listed heavy machinery, engines and generator sets.<sup>73</sup>

---

<sup>73</sup> First Barritt Decl., ¶ 28, Applicant points out that its specialized technology bears no similarity to heavy equipment or machinery, engines or generators, nor is its purpose or function in any way similar. 32/130/217 See Dkt. No. 32, Barritt Decl., ¶ 29).

***2. Actual usage of Opposer's equipment in creating water holding/evaporation ponds***

In addition to the examples discussed above drawn from the life-cycle of a natural gas well, Opposer alleges that for decades it and its licensees have continuously used the **CAT** mark in connection with specific products in the oil and gas industry that are closely related to Applicant's products.<sup>74</sup> In fact, Opposer has pointed to one very specific usage of its **CAT**-branded heavy earth-moving and construction-type machinery and equipment to build culverts and reservoirs for coal bed methane water and to lay pipes for conveying such gas and water. We turn specifically to the declaration of Caterpillar's Product Identity Manager, Ed Stembridge:

3. As detailed below, Caterpillar has expanded its offerings over the years and it presently provides an overwhelming number of other products and services used in the oil and gas, mining, and pipeline industries. Indeed, CAT-branded engines have drilled the majority of the world's oil and gas wells – both onshore and offshore. (See website printouts and promotional materials attached as Exhibit A.)

4. Caterpillar has also sold or rendered the following CAT-branded products and services for decades: pumps and compressors for oil and gas well applications; generators and gensets to use as a power source at oil and gas wells; pipelayers to lay oil and gas pipes; track-type tractors, hydraulic excavators, motor graders, and trucks to prepare an oil and gas well site; GPS ("global positioning system") and laser based guidance systems for automated rock recognition to ensure accurate drill management; onsite support, repair and maintenance services; and drills and other equipment to drill the boreholes or oil and gas wells. Through its network of CAT dealers, Caterpillar provides well-servicing for maintaining well equipment in optimum condition. (See Exhibit A.)

---

<sup>74</sup> Opposer's supplemental summary judgment brief of November 15, 2013, at 12-13, 51 TTABVue at 20-21 of 234.

5. Caterpillar's products and services are commonly used at gas-well sites. For example, CAT-branded earth moving machines are used to prepare the well site for drilling; CAT-branded engines are used in drilling the well bore; CAT-branded generators provide power to pumps for withdrawing water and gas; CAT-branded heavy machinery is used to build culverts and reservoirs for coal bed methane water; CAT-branded compressors compress gas from the wells; CAT-branded pipelayers are used in laying pipes for conveying gas and water; and other CAT-branded products are used in site reclamation. CAT-branded products are used to dig ponds and/or lay pipes for receiving water from gas wells ... <sup>75</sup>

As seen above, according to Mr. Stembridge, **CAT**-branded products are used to dig ponds and lay pipes for receiving water from gas wells. Opposer argues that this "demonstrates a directly competing alternative to the device promoted under Applicant's **BIG CAT** Marks." Similarly, Richard Oates, Director of Sales at Wyoming Machinery Company, and one who has been involved with the sale of Caterpillar products for more than thirty years, testified about numerous **CAT**-branded products used in connection with oil and gas well sites and well bore drilling:

On any location there's various products of Caterpillar that are present before, during, and after the ... well is produced.

And the equipment that is present on a job site – and this may not be inclusive of everything that I've seen on a job site. But first you got to get into the job site. So they'll use a grader. And they may even use a scraper to, you know, level the road. They may use some kind of an excavator to put in culverts on the way in to the road. Then they may use a CAT dump truck articulator thereabouts; load it with gravel to gravel the road. ...

And depending on where they're drilling and what their permit requires, they may have to dig a mud pit or they

---

<sup>75</sup> Stembridge decl. ¶¶3-5, 30 TTABVue at 3-4 of 277.

may bring in some kind of a container to hold circulation material for when they're drilling. Then the drilling or work over rig may show up, and you may have – and it's customary nowadays that we have an integrated tool carrier on site which provides a loading tool, both for material with a bucket or it can be used as a forklift to load and unload pipe and the like.

The drilling rig itself, it may be CAT-powered. ... Today a lot of these rigs are electric. So we provide a 3512 generator package. And depending, again, on what the permits require, we may provide some kind of a Caterpillar selective catalyst reduction unit, SCR, which helps. ...

After the completion of the well ... we have pipelayers, CAT pipelayers, and we have CAT excavators digging the – the line in. The pipelayers lay the pipe in the hole. ...

... You know, that's what you're going to see on that site in general. You know, so the scrapers, motor graders, loaders, backhoes, IT machines, engines, generators to drive the pumps, and – you know, there's a lot of CAT product.

76

Opposer argues in this regard that inasmuch as **CAT**-branded heavy machinery is often used to build culverts, lay pipes and dig evaporation ponds for receiving coal bed methane water from gas wells, its claimed machines are used to construct a directly-competing alternative to the installation of Applicant's named goods, namely, its "well bore fluid redistribution equipment."<sup>77</sup> The testimony of Mr. Richard Oates corroborates the gist of Mr. Stembridge's declaration above, stating that gas well customers use **CAT**-branded products, including pipelayers, to convey gas and water from gas wells.

What – what Caterpillar does is we provide equipment to our customers that work on those sites, and I know that they use methods to transfer product and water through

---

<sup>76</sup> Oates Trans. at 77-79, 28 TTABVue at 77-79 of 87.

<sup>77</sup> Stembridge Decl. ¶ 5, 30 TTABVue at 3 of 277.

pipelines. And our guys dig the pipelines, and they install the pipe ...

78

While Applicant acknowledges that Opposer's **CAT**-branded products and services are likely used at some of the same coal bed methane natural gas well sites as are Applicant's **BIG CAT** products,<sup>79</sup> Applicant argues that functions for building culverts or digging onsite reservoirs for water is not a directly-competing alternative to the device it promotes under its **BIG CAT** marks. Certainly, Opposer does not claim to offer or sell any device that allows gas well operators to separate water and gas within the well bore so that only gas comes to the surface.<sup>80</sup>

However, we find convincing Opposer's argument that inasmuch as treating large volumes of water at coal bed methane / coal seam natural gas well sites is such a challenging problem, Opposer and Applicant are offering the operator alternative ways of dealing with this issue. For example, instead of paying a third-party for water treatment / reclamation, or rather than pumping produced water from the surface back down into an injection well, a well site operator also faces two alternative options: using Applicant's technology to reduce the volume of produced water, or using Opposer's equipment to build ponds for evaporation / disposal. In this sense, we find that Opposer's machines are likely to be used to construct an alternative to the installation of Applicant's named goods.

Applicant, even if not conceding that these alternatives are directly competitive, seems to acknowledge some connection between the two when arguing in its

---

<sup>78</sup> Oates Trans. at 84, 28 TTABVue at 84 of 87, and 32 TTABVue at 57 of 217.

<sup>79</sup> Justus Decl. at ¶¶ 8-9, 29 TTABVue at 10 of 137.

<sup>80</sup> 33 TTABVue at 105 of 306.



literature that operators who use its technology can avoid the cost and environmental impact of evaporation or holding ponds. While it is possible that a gas well owner or operator taking advantage of Applicant's involved technology might opt not to build a holding pond for surface water near the wellhead, Mr. Barritt argues that, it is logical to conclude, based upon his knowledge of the field, that such evaporation ponds might still be constructed for other uses, including as an integral part of the emergency management plan for the well site.<sup>81</sup> We are unpersuaded by this argument. While cognizant of quite different financial, environmental, regulatory and technical choices for dealing with produced water faced by the well operator at a specific gas well site, we find this specific application of Opposer's equipment (e.g., in creating water evaporation ponds) to be strong evidence that indeed Opposer's goods and services are related, for purposes of an analysis of likelihood of confusion, to Applicant's technology.

Finally, as to this factor, we also find compelling Opposer's arguments that Applicant's **BIG CAT** marks are not only likely to cause confusion with Caterpillar's famous **CAT** marks at the point-of-sale, but also in the post-sale context of dealing with produced water from the well sites. *See In re Artic Electronics Co., Ltd.*, 220 USPQ 836, 838 (TTAB 1983) (finding both point-of-sale confusion and post-sale confusion). Given the renown of the **CAT** marks generally, in the oil and gas industry specifically, and the ubiquitous presence of **CAT**-branded equipment at gas well sites, we agree that it is likely that during the life of the well, a range of persons, including miscellaneous contractors, well owners, and/or operators might well be confused

---

<sup>81</sup> Barritt Decl. ¶ 29, 32 TTABVue at 130 of 217.

regarding the source of Applicant's technology upon exposure to the **BIG CAT** marks on a well site inundated with Caterpillar's **CAT**-branded products and services.<sup>82</sup>

### 3. *Compressors*

We find many places in the record that large **CAT**-branded engines are used in a variety of applications in the drilling, production and transmission of oil and natural gas. Within **CAT**-branded gensets used in land-based as well as offshore drilling rigs, some gensets seem to have only **CAT**-branded components (i.e., **CAT**-engines paired with **CAT**-branded generator ends).

By contrast, where **CAT**-branded engines are used with gas compression installations, these **CAT**-branded engines are included with compressor packages marketed under third-party marks. At least prior to December 2012,<sup>83</sup> we find no evidence that Opposer offered or sold **CAT**-branded compressors.<sup>84</sup> Hence, we should note that we have given no consideration to Opposer's alleged use of its **CAT** marks on compressors.<sup>85</sup>

For all the reasons discussed above, this critical *du Pont* factor favors a finding of likelihood of confusion herein.

---

<sup>82</sup> Oates Trans. at 77-84, 28 TTABVue at 77-84 of 87.

<sup>83</sup> Caterpillar did announce the creation of a joint venture (Black Horse LLC) between Caterpillar and Ariel Corporation (maker of separable reciprocating gas compressors) to provide pressure-pumping solutions to oil and gas customers (40 TTABVue at 179 of 180). Although there is no corroboration about how the Joint Venture will market these products, Opposer alleges that these combined products will be branded and sold under the **CAT** mark and distributed through the **CAT** dealer network.

<sup>84</sup> Oates Trans. at 74-75, 32 TTABVue at 48-49 of 217.

<sup>85</sup> Similarly, we note Opposer's argument that the "pipes" in its registration should be construed as being identical to the "pipes" identified in the involved applications. We are not persuaded. "Pipes" are not identified as discrete goods in the application, but only as components of Applicant's gas well equipment, which are, in nature, very different from simple "pipes" and pipe fittings.

## **B. Fame/Strength**

We turn then to the strength of Opposer's **CAT** marks in order to determine the scope of protection to be accorded to Opposer's pleaded marks. In the case at bar, Opposer's **CAT** marks are arbitrary as applied to Opposer's listed goods and services. Hence, **CAT** is an inherently distinctive mark, and as such, we find that it is a conceptually-strong mark.

Whenever fame exists it "plays a 'dominant' role in the process of balancing the *du Pont* factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Famous marks enjoy a wide latitude of legal protection since they are more likely to be remembered and associated with a single source in the public mind than is the case with weaker marks, and thus they are more attractive as targets for would-be copyists. For this reason, a famous mark "casts a long shadow which competitors must avoid." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Recot*, 54 USPQ2d at 1897, quoting *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); *Loreal S.A. v. Marcon*, 102 USPQ2d 1434, 1437 (TTAB 2012) ("[E]xtreme deference [is] accorded to a famous mark in terms of the wide latitude of legal protection it receives ... "). As a corollary, well-settled law teaches that as the fame or strength of a mark increases, the degree of similarity between the marks and goods and services necessary to support a conclusion of likelihood of confusion declines. *Bose v. QSC Audio Prods*, 293 F.3d 1367, 63 USPQ2d 1303, 1308-10 (Fed. Cir. 2002). Under our precedent, any doubts as to the registrability of an Applicant's mark must be resolved in favor of the prior

registrant of a famous mark. *See Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (“When balancing the interest in a famous, established mark against the interests of a newcomer, we are compelled to resolve doubts against the newcomer.”); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993) (“Doubt is resolved against the newcomer, ... for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so.”).

The commercial strength of a mark “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods or services traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”<sup>86</sup> *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). In addition, some context in which to place raw statistics may be necessary. *Id.* at 1309.

This extensive record demonstrates the renown of Opposer’s CAT marks:

- Opposer owns one registration for the mark **CAT** that issued in 1952 – claiming use since the 1940s.<sup>87</sup> The record shows that the **CAT** mark has been in use in commerce in the United States for more than 70 years.<sup>88</sup>
- In support of its assertion that its mark is famous, Opposer argues that tens of thousands of Caterpillar’s black-and-yellow vehicles prominently displaying the iconic **CAT** brand are ubiquitous throughout the United States. In fact, Caterpillar’s **CAT**-branded products and services reach a large number of consumers in myriad forms, from large machines to

---

<sup>86</sup> For purposes of likelihood of confusion, the Board generally accepts and considers evidence related to likelihood of confusion for the period up to the time of trial, and this includes evidence of the fame of a plaintiff’s mark. This is distinct from a claim of dilution under Section 43(c) of the Trademark Act where an element of the claim is the acquisition of fame prior to the defendant’s first use or application filing date.

<sup>87</sup> Justus Decl. at ¶ 3, Justus Exhibit A, 29 TTABVue at 3, 17 of 137.

<sup>88</sup> Stembridge Decl. ¶ 2, 30 TTABVue at 2 of 277.

electrical generators and related products, and from financial services to **CAT**-branded merchandise.<sup>89</sup>

- Caterpillar has a national network of fifty **CAT** dealers and over 53,000 employees in the United States.<sup>90</sup>
- Prior to any priority date that Applicant can claim, Caterpillar's total revenues had exceeded \$100 billion.<sup>91</sup> Looking at sales through the time of trial herein, Caterpillar has enjoyed revenues exceeding \$200 billion in the U.S. since 2000 alone.<sup>92</sup>
- The volume of past sales is significant inasmuch as the lifetime of **CAT**-branded large machines and related products is measured in decades.<sup>93</sup>
- Over the years, Caterpillar has invested hundreds of millions of dollars in advertising and promoting the **CAT** mark nationwide in virtually every medium (e.g., national and local television and radio programs, in books, on the Internet, in newspapers, national print publications, trade journals, and at large industry trade shows),<sup>94</sup> including staging the largest-ever exhibit at the MINExpo trade show in Las Vegas in 2012.<sup>95</sup> Caterpillar and its products and services have been featured in newspaper and magazine articles in the nation's most widely-circulated publications, such as *The New York Times*, *Chicago Tribune*, *Forbes*, and many more.<sup>96</sup>
- **CAT** has 30% market share in global construction machinery – several percentage points higher than its next largest competitor.<sup>97</sup>
- The **CAT** mark and name is prominently displayed at the top of each page of Caterpillar's website at [cat.com](http://cat.com), which is visited by millions of users each year.<sup>98</sup>
- Furthermore, the **CAT** mark appears on numerous third-party dealer websites in connection with Caterpillar's products and services.<sup>99</sup>

---

<sup>89</sup> *Id.* at ¶¶ 6, 7, 10, Exhibit B., 30 TTABVue at 4-5, 83-153 of 277.

<sup>90</sup> *Id.* at ¶¶ 8, 9, Exhibits B - D, 30 TTABVue at 5, 83-194 of 277.

<sup>91</sup> *Id.* at ¶ 12, Exhibits C – D, 30 TTABVue at 5, 154-94 of 277.

<sup>92</sup> *Id.* at ¶ 13 Exhibits C – D, 30 TTABVue at 5, 154-94 of 277.

<sup>93</sup> *Id.* at ¶ 11, 30 TTABVue at 5 of 277.

<sup>94</sup> *Id.* at ¶¶ 15, 20, 30 TTABVue at 5-6 of 277; Justus Decl. at ¶23, Justus Exhibit F, 29 TTABVue at 12-13, 115-137 of 137.

<sup>95</sup> Stembridge Decl. ¶ 16, Stembridge Exhibit E, 30 TTABVue at 5-6, 195-217 of 277.

<sup>96</sup> *Id.* at ¶ 20, 30 TTABVue at 6 of 277; Justus Decl. at ¶ 23, Justus Exhibit F, 29 TTABVue at 12-13, 115-137 of 137.

<sup>97</sup> 39 TTABVue at 87 of 88.

<sup>98</sup> Stembridge Decl. ¶ 17, 30 TTABVue at 6 of 277.

- Opposer uses the **CAT** mark in connection with its NASCAR program.<sup>100</sup>
- Opposer points out that in light of the substantial unsolicited national media attention and publicity Opposer’s consumers have referred to and identified the company Caterpillar as simply **CAT** for decades.<sup>101</sup>
- Caterpillar was included as No. 46 on the 2012 Fortune 500 list.<sup>102</sup> Caterpillar was listed as No. 20 overall on Fortune magazine’s 2013 list of the World’s Most Admired Companies, and #1 in the “Industrial and Farm Equipment” category.<sup>103</sup> Interbrand has consistently ranked the Caterpillar’s brand among the top 75 most valuable global brands, and it climbed to No. 61 in 2012.<sup>104</sup> And Opposer points out that even Applicant admitted that the **CAT** mark is well-known.<sup>105</sup>
- Caterpillar’s **CAT** brand has been featured in more than twenty feature films dating back to the 1920s.<sup>106</sup>
- Caterpillar has been vigilant in protecting the **CAT** mark against likelihood of confusion and dilution.<sup>107</sup> For example, Caterpillar has initiated hundreds of enforcement actions against third parties claiming confusingly similar **CAT**-formative marks, and has often prevailed in such actions, based in part on the renown of its **CAT** marks.<sup>108</sup>

---

<sup>99</sup> *Id.*

<sup>100</sup> Stembridge Decl. at ¶ 18, 30 TTABVue at 6 of 277. The program includes sponsorship of a Winston Cup Series NASCAR racing car, where the CAT design mark is prominently displayed on the hood of Jeff Burton’s No. 31 race car.

<sup>101</sup> *Id.* at ¶19, 30 TTABVue at 6 of 277.

<sup>102</sup> Justus Decl. ¶ 21, Justus Exhibit E, 29 TTABVue at 12, 112-14 of 137.

<sup>103</sup> Justus-2 Decl. ¶ 9, Exhibit H, 39 TTABVue at 4, 86-88 of 88.

<sup>104</sup> Stembridge Decl. at ¶ 22, 30 TTABVue at 7 of 277. Opposer notes that in the 2012 Interbrand rankings, Caterpillar’s brand is ranked ahead of the following brands, among others, which have been held famous by the TTAB or the federal courts: BURBURY, VISA, STARBUCKS, PORSCHE, and CARTIER.

<sup>105</sup> Justus Decl. ¶ 20, Justus Exhibit D, 29 TTABVue at 11, 100-09 of 137.

<sup>106</sup> Stembridge Decl. at ¶ 21, 30 TTABVue at 6-7 of 277.

<sup>107</sup> Justus Decl. ¶ 2, 29 TTABVue at 2 of 137.

<sup>108</sup> As recently as 2007, this Board found that Caterpillar’s “aggressive trademark enforcement activities reinforce the strength of its **CAT** marks.” *Caterpillar Inc. v. Pave Tech, Inc.*, Cancellation No. 92041776 (TTAB March, 12, 2007) (holding that the CAT mark is “famous” and “has been recognized as one of the world’s strongest brands”; cancelling defendant’s registration for **PAVERCAT** for paving machines and attachments); *see also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 11.91 (4<sup>th</sup> ed. 2010) (“... active program of prosecution of infringers ... enhances the distinctiveness and strength of a mark”); *Caterpillar Tractor Co. v. Gehl Co.*, 177 USPQ 343, 345 (TTAB 1973) (finding likelihood of confusion between “well-known” CAT mark and the mark HYDRACAT

In summary, Opposer argues that its **CAT** marks stand as the cornerstone of the Caterpillar brand portfolio, that **CAT** has achieved universal name recognition and is one of the most iconic brands in the world. In fact, various industry, media, and brand leaders have long recognized the **CAT** marks as among the most famous and valuable trademarks in the world. As seen above, Caterpillar owns prior rights in its **CAT** marks for various products in the oil and gas industry (machinery and equipment used to prepare, dig, trench, and reclaim gas-well sites). Given this showing, Applicant admits that Opposer's **CAT** marks are well-known for products used in the oil and gas industry.<sup>109</sup> As a result, Opposer argues that, as a matter of law, its claimed **CAT** marks are entitled to a broad scope of protection.

As discussed above, under our precedent, any doubts as to the registrability of Applicant's **BIG CAT** marks must be resolved in favor of Caterpillar as the prior registrant of a famous mark. We find that the **CAT** mark has reached an extraordinary level of fame, not only in the oil and gas industry, but also with respect to the general consuming public.<sup>110</sup>

Applicant has dedicated a substantial portion of this litigation to an attempt to weaken opposer's showing of commercial strength with evidence of third-party use of

---

for vehicles); *Caterpillar Tractor Co. v. Katrack Vehicle Co.*, 172 USPQ 409, 411 (TTAB 1972) (finding likelihood of confusion between "well-known" **CAT** mark and the mark **KATRAK** for vehicles); *Caterpillar Inc. v. Telescan Techs., LLC.*, 2002 WL 1301304, at \*4 (C.D. Ill. Feb. 13, 2002) (holding that the **CAT** mark is "among the most famous marks currently used in United States commerce") Opposer contends that **CAT** is a household name that is encountered by the general consuming public on a regular basis. *Id.* at \*3 (given its wide recognition, court held that the **CAT** mark is one of "the most famous marks in America").

<sup>109</sup> Justus Decl. ¶ 20, Justus Exhibit D, 29 TTABVue at 11, 100-09 of 137.

<sup>110</sup> See Opposer's Brief at 24-31, 51 TTABVue at 32-39 of 234.

a variety of CAT marks. We are unpersuaded by this contention, and find in those cases where third-party competitors have moved at all close to Opposer's famous marks, Caterpillar has demonstrated a rigorous enforcement effort.

Finally, as seen above, Applicant itself has admitted that the **CAT** mark is well known for construction equipment generally, and specifically for construction equipment in the oil and gas industry. Not surprisingly, in light of the **CAT** brand's fame, Applicant admitted that it was well aware of the **CAT** marks prior to filing its applications for the **BIG CAT** marks.<sup>111</sup>

Accordingly, we find on this record that Opposer's **CAT** marks are extremely well known and are therefore entitled to a broad scope of protection. *Recot*, 54 USPQ2d at 1897.

### C. Similarities of the marks

Opposer argues that the similarity between the parties' respective marks as to sound, appearance, and overall commercial impression is irrefutable inasmuch as the mere addition of the highly descriptive term "big" in Applicant's mark fails to distinguish the parties' marks. *See In re Rexel*, 223 USPQ 830, 832 (TTAB 1984) (**LITTLE GOLIATH** for a stapler and staples held to be confusingly similar to **GOLIATH** for pencils). We agree with Opposer's contention that potential consumers of Applicant's technology will consider its **BIG CAT** marks as merely a variation of Opposer's famous **CAT** marks. *See, e.g., In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946-48 (Fed. Cir. 2004); *In re El Torito Restaurants Inc.*, 9 USPQ2d

---

<sup>111</sup> Justus Decl. ¶ 20, Justus Exhibits B and D, 29 TTABVue at 11, 48, 100-09 of 137.



2002, 2004 (TTAB 1988); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985). We also find that Opposer's CAT marks and Applicant's **BIG CAT** marks contain an identical dominant element, i.e., the distinctive "Cat" term. *See Giant Food, Inc. v. Nation's FoodService, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739-40 (Fed. Cir. 1989) (holding that it is proper to give less weight to weaker portion of marks).

As to the difference in appearance with Applicant's addition of a feline design to its "BIG CAT & design" mark, we find that this does not avoid a likelihood of confusion. The wording in this composite mark, and especially the word "Cat," is the dominant portion of the mark, which will make the greatest impression on consumers. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) ("The words dominate the design feature."); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586-87 (TTAB 2007) ("If a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services."). Moreover, the addition of the words "Energy Corp." to Applicant's design mark is not sufficient to avoid a likelihood of confusion. It is well-settled that adding generic matter to another's mark will not avoid a likelihood of confusion. *See Motion Picture Association of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1561 (TTAB 2007) (**RATED R SPORTSWEAR** for clothing confusingly similar to **RATED R** mark for film ratings).

Applicant argues that the parties' trade dress (i.e., especially different color combinations) is different such that confusion is unlikely. Trade dress usage,

however, is largely irrelevant to this opposition proceeding, as we do not rely for our ultimate decision on rights Opposer holds only in common law marks. Instead, we focus on the similarity of the marks as depicted in the parties' applications and registrations. *See Octocom Sys., Inc.*, 16 USPQ2d at 1787-88 ("The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein.").<sup>112</sup>

As to pronunciation, we agree with Opposer that the aural differences between these marks are minor inasmuch as Applicant's "Big Cat" marks contain the entire literal portion of Opposer's **CAT** marks, differing only by the addition of the laudatory term "big." *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (TTAB 2000).

As to connotation, Applicant argues that both of its **BIG CAT** marks are sufficiently distinct to avoid a likelihood of confusion with Caterpillar's **CAT** marks. Applicant's primary argument regarding the dissimilarity of the parties' marks is that the "Big Cat" wording in its **BIG CAT** marks is a "unitary term" having "a specific and well recognized meaning" connoting "large animals of the feline species who have the ability to roar and typically reside in the wild ... ." In this context, Applicant argues that the word "big" is not merely a laudatory way of referring to a "cat."

On this point, we agree with Opposer. "Big" is a separate word with a readily understood, descriptive meaning. By contrast, examples of coexisting marks raised by

---

<sup>112</sup> As to the marks themselves, Applicant's special form drawing for its "BIG CAT & design" composite mark identifies no colors, and only three of Opposer's thirteen claimed marks identify the colors yellow, black, red and white as features of the marks.

Applicant, such as **BEARCAT**, **BOBCAT**, **POLECAT**, and **WILDCAT**, are arguably unitary terms<sup>113</sup> creating readily understood visual impressions quite different from the imagery prompted by the word “Cat” alone. With Applicant’s **BIG CAT** marks, much like the reported decision of the coined term, **HYDRACAT** (where the “Hydra” prefix was viewed as a shortened form of “hydraulic,” which in turn describes a feature of the respondent’s product),<sup>114</sup> the addition of such a descriptive term to “CAT” is not sufficient to distinguish the parties’ marks.

Moreover, the possibility consumers might think of “Big Cat” as referencing “large animals of the feline species” would not necessarily avoid a likelihood of confusion given the facts before the Board, such as the fame of Opposer’s **CAT** marks, the overlapping trade channels and customers, and the relatedness of the goods and services. *See TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1317-18 (Fed. Cir. 1997) (finding likelihood of confusion between **GRAND AM** and **GRAND SLAM** despite different connotations because there was no evidence that the relevant purchasers were familiar with applicant’s proffered meaning).

Finally, the record reveals evidence of a competing definition of the term “Big Cat,” namely, as a laudatory attribution used by the consuming public and the media to refer to the size, popularity, and widespread recognition of Caterpillar and/or its

---

<sup>113</sup> *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (“A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements.”).

<sup>114</sup> *Caterpillar Tractor Co.*, 177 USPQ at 345.

products.<sup>115</sup> This evidence suggests that over the years, much of the thrust of Opposer’s commercial imagery has been transformed from that of a “caterpillar” to that of a “feline.” Specifically, the sustained and consistent nickname usage (i.e., the term “Big Cat”) belies Applicant’s position on the dissimilarities of the respective connotations under this *du Pont* factor, and greatly increases the likelihood of confusion.<sup>116</sup>

In support of this position, what follows is a representative sampling of the hundreds of examples where the “big Cat” nickname was used by well-recognized newspapers and national magazines. For example, consumers and the media refer to a piece of Caterpillar’s large machinery as a “Big Cat,” while Opposer itself is regarded as a bellwether with respect to the economy<sup>117</sup> such that it is commonly referred to as “Big Cat” by the media and others in the financial world.<sup>118</sup>

HEADLINE: Train Wrecks: Then and now

At the wreck, the **Big Cats** are unloaded and rather than gingerly picking over the rubble of crunched train cars for transport, the whole train wreck is simply pushed into the ditch ... .<sup>119</sup>

HEADLINE: A lift – and a letdown / Caterpillar profit jumps 49%, but outlook takes hit

Photo caption: At a trade show last month, Dmitry Golitsyn, of Moscow, checked out a **big Cat** earth mover.<sup>120</sup>

---

<sup>115</sup> Stembridge Decl. ¶ 24, 30 TTABVue at 7 of 277.

<sup>116</sup> *Norac Co., Inc. v. Occidental Petroleum Corp.*, 197 USPQ 306, 315 (TTAB 1977); *Volkswagen A.G. v. ThermoChem Corp.*, 185 USPQ 560 (TTAB 1975); *Coca Cola Co. v. Busch*, 52 USPQ 377 (D.C. E.Pa. 1942).

<sup>117</sup> Caterpillar is included in the prestigious “Dow 30” list of companies, which comprise the Dow Jones Industrial Average. (Justus Decl. ¶ 22.)

<sup>118</sup> Stembridge Decl. ¶ 24, 30 TTABVue at 7 of 277, Stembridge-2 Decl. ¶ 2, 40 TTABVue at 2 of 180.

<sup>119</sup> *Sentinel-Standard* (Ionia, Michigan) at A-1, January 27, 2013, 40 TTABVue at 7 of 180.

<sup>120</sup> *Chicago Tribune*, at C-1, October 23, 2012, 40 TTABVue at 9 of 180.

HEADLINE: Is Cat Ready to Run? Don't Jump the Gun  
Is the **big Cat** back? ... 121

HEADLINE: The **Big Cat** Plows Ahead on Better US Growth Prospects  
... Caterpillar is the world's largest maker of construction equipment and farm machinery... 122

HEADLINE: Students get to work with **big Cat** technology  
... Oak Creek High School and the Caterpillar Inc. have formed a partnership  
... 123

HEADLINE: Did **Big Cat** Just Purr?  
... Is Caterpillar losing its mojo? ... 124

HEADLINE: 'Cat' roars in with high hopes  
... There's every reason to believe that Caterpillar will be an economic boon to our area. Let the **big Cat** roar. 125

HEADLINE: *Et tu* Caterpillar? Then fall America!  
... The larger question for the American people and Washington policymakers is this: Why won't the **Big Cat** just build its new factory in Illinois and export its miniexcavators to China? ... 126

HEADLINE: A small contender with a big backer; Cat Auction Services of Shakopee, a seller of used construction equipment, finds ways to keep the **big Cats**, and customers, purring.  
... The David in this saga is a Shakopee construction equipment auction company, Cat Auction Services, which peddled consignments worth about \$48 million in 2009, its first year in business. 127

HEADLINE: Looking for a moving experience? Dig This  
... The engine roars, and the **big Cat** starts to lift. ... 128

---

<sup>121</sup> *Investor's Business Daily*, National Ed., at B04, February 16, 2012, 40 TTABVue at 11 of 180.

<sup>122</sup> *Midnight Trader*, February 3, 2012, 40 TTABVue at 13 of 180.

<sup>123</sup> *Milwaukee Journal Sentinel* (Wisconsin), at 3, September 8, 2011, 40 TTABVue at 14 of 180.

<sup>124</sup> Benzinga.com, July 22, 2011, 40 TTABVue at 16 of 180.

<sup>125</sup> *Winston-Salem Journal* (North Carolina), at 20, November 13, 2010, 40 TTABVue at 38 of 180.

<sup>126</sup> *Chicago Tribune*, at C-13, October 12, 2010, 40 TTABVue at 39 of 180.

<sup>127</sup> *Star Tribune* (Minneapolis, MN), at 1-D, June 3, 2010, 40 TTABVue at 42 of 180.

<sup>128</sup> *The Denver Post*, at B05, August 3, 2008, 40 TTABVue at 44 of 180.

- HEADLINE: Owens Does the Heavy Lifting  
... **Big Cat** needed to dig itself out of deep trouble in the early 1980s. ... 129
- HEADLINE: Machinery Stocks Power Ahead On Int'l Building, Mining Boom  
... **Big Cat's** shares are up nearly 35% so far this year. ... 130
- HEADLINE: Limestone landslide traps man in tractor  
... The **big Cat** dug at the mountain next to the trapped vehicle and built a smaller hill of limestone with the material it removed. 131
- HEADLINE: Residents Emerge, Start Digging;  
... Raton emergency workers on Monday sent a D-6 Caterpillar bulldozer rumbling up a rural mesa to rescue nine elk hunters holed up in a cabin. As of late afternoon, the **big cat** was chugging its way back to town - followed by the hunters in their vehicles. ... 132
- HEADLINE: Creek group perseveres despite theft  
... Richmond firefighters responded to the site to put out what was left of a Caterpillar 320 excavator, a piece of heavy equipment valued at about \$65,000, said subcontractor Brett Schreiner. The **Big Cat** was burned so completely it had to be disassembled to be moved. 133
- HEADLINE: Caterpillar Crashes after Big Warning on Housing Slump; **Big Cat** Shares Dive 14.5%; Heavy equipment giant misses Q3 views, slashes 2006, 2007 forecasts 134
- HEADLINE: Thompson celebrates new home  
... Having the ability to service the **big Cats**, as well as sell them, was a major reason for the move. 135
- HEADLINE: **Big 'Cat'** Family Business Is Sold  
... Beckwith Machinery, known primarily as a **Caterpillar** equipment dealer, employed about 750 when the sale closed last week. 136

---

<sup>129</sup> *Investor's Business Daily*, at A04, February 5, 2008, 40 TTABVue at 46 of 180.

<sup>130</sup> *Investor's Business Daily*, at A01, June 21, 2007, 40 TTABVue at 58 of 180.

<sup>131</sup> *Green Bay Press-Gazette* (Wisconsin), at 3-A, March 4, 2007, 40 TTABVue at 60 of 180.

<sup>132</sup> *Albuquerque Journal* (New Mexico), at A-1, January 2, 2007, 40 TTABVue at 62 of 180.

<sup>133</sup> *The San Francisco Chronicle* (California), at B1, November 7, 2006, 40 TTABVue at 65 of 180.

<sup>134</sup> *Investor's Business Daily*, at A01, October 23, 2006, 40 TTABVue at 67 of 180.

<sup>135</sup> *The Leaf-Chronicle* (Clarksville, Tennessee), at 9B, October 20, 2006, 40 TTABVue at 69 of 180.

<sup>136</sup> *Pittsburgh Post-Gazette* (Pennsylvania), at F-1, October 12, 2005, 40 TTABVue at 77 of 180.

HEADLINE: **Big Cat**

... Until now, no one had ever rebuilt the 994, the biggest loader in Caterpillar's mining-equipment line ... 137

**Big Cat** jumps on analyst report. Caterpillar gained 1.5% to 102.20 after Lehman Bros. said a meeting with the firm's management increased the brokerage's confidence that margins will improve in the second half of '05 and in '06. The heavy equipment maker's orders should remain strong and price increases appear to be sticking, said Lehman. ... 138

HEADLINE: IBD'S Top 10

Caterpillar Up On Dividend, Split

#8 - The heavy equipment maker rose 2% to 96.58 after it hiked its quarterly dividend by 22% to 25 cents a share, payable Aug. 19, and said it'll split 2-for-1 on July 13. Earlier, Prudential upgraded Caterpillar, saying it should easily beat profit forecasts due to strong volume. **Big Cat** was one of the best Dow components on Wed. ... 139

HEADLINE: Collector cars get spin at GPC

The **big cat**: Mark Pawuk returns to a favorite track ... and this weekend will be racing under some new colors. In a sport dominated by aftermarket automotive sponsorship, Pawuk brings new blood in the form of Ohio Cat, the state-wide Caterpillar company. 140

HEADLINE: Techs Can Repair Really **Big Cats**

... Next month, 12 students will graduate from Mesa Community College's new Caterpillar Technician Training program ... 141

HEADLINE: Equipment drivers to show skills in rodeo

A Heavy Equipment Rodeo on Saturday will feature **big Cats** but no bronses or bulls. Those are Cats as in the big yellow Caterpillar vehicles common at construction sites. ... 142

HEADLINE: Rahco's equipment is making the grade

... "We wanted to do a product that looks, smells and tastes Cat," Col says. And, if all goes well, roars like the **big cats**, too. 143

---

<sup>137</sup> *Charleston Gazette* (West Virginia), at 1C, July 6, 2005, 40 TTABVue at 78 of 180.

<sup>138</sup> *Investor's Business Daily*, at A02, June 22, 2005, 40 TTABVue at 83 of 180.

<sup>139</sup> *Investor's Business Daily*, at A01, June 9, 2005, 40 TTABVue at 85 of 180.

<sup>140</sup> *Plain Dealer* (Cleveland), at D6, May 20, 2005, 40 TTABVue at 86 of 180.

<sup>141</sup> *The Arizona Republic* (Phoenix), at 1, April 19, 2005, 40 TTABVue at 90 of 180.

<sup>142</sup> *Tucson Citizen*, at 8A, September 30, 2004, 40 TTABVue at 92 of 180.

<sup>143</sup> *Spokesman Review* (Spokane, WA), at A-6, April 6, 2004, 40 TTABVue at 93 of 180.

HEADLINE: Colorful characters

... [Baltimore Colts kicker Jim O'Brien]: "I learned how to operate a **big Cat** (Caterpillar construction equipment) and how to build framing and flooring and electrical and plumbing. ..."

144

HEADLINE: Monster Machines Are Waging War Against Lake Erie Shoreline Surges

... At the bottom, the **Big Cat** waited - Mike Huffman Jr.'s Caterpillar 330L. The **Big Cat** had the task of carefully and precisely positioning the rocks along the 315-foot long shoreline erosion-control area. ...

145

HEADLINE: Cat Building Leaves Tracks

Watch out in the elevator lobbies in the new Caterpillar Financial Services Corp. building on West End Avenue.

There are Cat tracks in the floors.

And screens on the overhead lighting that resemble the scoops on the **big Cats**.

There's even an old Cat in the lobby.

146

HEADLINE: **Big Cat** learns to think small

147

HEADLINE: Bulldozer 'Toast' After Line Rupture

... [O]ne of the tracks of the **big Cat** slid off a level area and into a trenched area, where it fractured a 4-inch gas line. The Cat's driver escaped without injury, but the gas ignited. ...

148

HEADLINE: Saving Sears: Former Workers Collect Pieces of Plant

... Betty White works fast because the big Caterpillar tractor that's scooping up huge loads of concrete chunks ... "I'm making a rock garden," White says over the din of the **big Cat**. "I used to work out here. It's all gone. I'm kind of sad about it. I have some good memories out here."

149

HEADLINE: The Sound of Oil

The camp lay a few miles offshore, a collection of orange trailers parked in parallel lines, home to 83 workers and 33 vehicles. **Big Cat** tractors were rumbling nearby, bulldozing a new road system. Far out in the blinding glare of ice, dots that were seismic rigs inched along the horizon.

150

---

<sup>144</sup> *St. Petersburg Times* (Florida), at 1C, January 25, 2004, 40 TTABVue at 98 of 180.

<sup>145</sup> *Plain Dealer* (Cleveland, Ohio), at 1B, November 1, 2000, 40 TTABVue at 110 of 180.

<sup>146</sup> *The Tennessean*, at 2E, April 3, 2000, 40 TTABVue at 112 of 180.

<sup>147</sup> *The Times Union* (Albany, NY), at C1, July 18, 1999, 40 TTABVue at 117 of 180.

<sup>148</sup> *Albuquerque Journal* (New Mexico), at D2, June 30, 1999, 40 TTABVue at 119 of 180.

<sup>149</sup> *News & Record* (Greensboro, NC), at B1, June 12, 1998, 40 TTABVue at 126 of 180.

<sup>150</sup> *Anchorage Daily News* (Alaska), at 4F, May 17, 1998, 40 TTABVue at 131 of 180.



HEADLINE: New Plant's Output Is Coveted '**Big Cat**' Hopes High for Sarpy-Made Combine

It's as wide as a downtown street, big as a bungalow and heavier than some Army tanks. Friday, the Lexion combine harvester was on display in downtown Omaha, as Caterpillar Claas America announced plans to mass produce the machine in Sarpy County. Secretary of State Scott Moore, who was on hand for the announcement, called it simply the "**Big Cat**."

151

HEADLINE: Small Machines for The **Big Cat**

152

HEADLINE: How to Move a Whole Lot of Earth

... The man who keeps the **big Cats** running despite heat, grit and dust is Mike Monnot, equipment superintendent for Atkinson-Washington-Zachry, the water district's contractor tapped for building the dam at the west end of the valley. ...

153

HEADLINE: Thieves lift 25-ton tractor; Theft is Hurst's 2<sup>nd</sup> large equipment heist  
HURST - Case 97-5908.

The Stolen **Big Cat**.

It was slow, it was yellow, and it weighed 25 tons.

But someone still took it - a Caterpillar track loader - early yesterday from a highway construction site on Northeast Loop 820.

Think Andy Sipowicz has big cases on NYPD Blue? He's got nothing on detectives in Hurst.

154

HEADLINE: Caterpillar Touts 600-HP Engine

... The 600-hp engine won't be in full production until January 1998, but it already has been dubbed "The **Big Cat** 600" by drivers and others aware of its development. ...

155

HEADLINE: "Cat" may give developers new life in W. Broward

... But developers have awesome plans for West Broward's nowhere - another 100,000 homes. Providing, of course, this **big Cat** can dig them out of a public relations chasm [associated with blasting].

156

---

<sup>151</sup> *Omaha World Herald* (Nebraska), at 1, May 2, 1998, 40 TTABVue at 137 of 180.

<sup>152</sup> *Engineering News-Record*, Vol. 239, No. 19, at 19, November 10, 1997, 40 TTABVue at 140 of 180.

<sup>153</sup> *Orange County Register* (California), at A08, August 17, 1997, 40 TTABVue at 143 of 180.

<sup>154</sup> *Fort Worth Star-Telegram* (Texas), at Metro-1, August 6, 1997, 40 TTABVue at 146 of 180.

<sup>155</sup> *Automotive News*, at 18, March 24, 1997, 40 TTABVue at 148 of 180.

<sup>156</sup> *The Miami Herald*, at 7C, December 8, 1996, 40 TTABVue at 150 of 180.

Applicant argues that this showing is *de minimis*, and urges us to consider instead an Internet search of “big cat” where allegedly Caterpillar did not show up among the first 200 search results. However, we do find Opposer’s showing above to be compelling. Stretching over a period of more than twenty years, the record shows actual examples of the use by quoted persons, reporters and headline writers of the term “Big Cat” as an unmistakable reference to Opposer and its large equipment. This evidence further supports the conclusion that confusion is likely when Applicant uses its **BIG CAT** marks on its named goods.

Accordingly, given the previous discussion, we find that this *du Pont* factor weighs in favor of a finding of a likelihood of confusion.

**D. Number and nature of similar marks in use on other goods and services**

Attempting to counter opposer’s evidence of commercial strength, applicant has submitted evidence to show third-party use of marks in support of its argument that opposer’s mark is weak. Applicant has argued that various third-party names and marks containing the word “CAT” diminish the strength and scope of protection to which Caterpillar’s **CAT** mark is entitled. Specifically, Applicant has submitted various third-party registrations and website printouts.<sup>157</sup>

However, any relevant third-party goods and services in the case at bar would have to relate to heavy construction equipment or the oil and gas industry. Accordingly, we find that much of Applicant’s evidence is irrelevant as it relates to completely unrelated goods and services (e.g., radon detection device, armored

---

<sup>157</sup> 36 TTABVue and 37 TTABVue.

vehicles, supply chain management system, surveillance system, forestry and logging equipment, highway and utility markers, vegetation harvesting systems, etc.), or involves marks (e.g., **BOBCAT**, **POLECAT**, **WILDCAT**, etc.) that convey commercial impressions quite different from those of Opposer's **CAT** marks.<sup>158</sup>

Furthermore, Opposer points to a series of past cases wherein Caterpillar's rigorous enforcement efforts have been recognized by this Board. The instant record likewise shows not only that Opposer's federal trademark registrations remain valid and subsisting, but that Opposer's trademark enforcement actions also are still underway. Given these efforts, and the limited usage by third parties with respect to heavy equipment or uses in the oil and gas fields, Applicant has failed to demonstrate that third-party marks in more distant fields should provide cover for Applicant's adoption of its **BIG CAT** marks for gas-well equipment – a field in which Caterpillar is a prominent participant and in which the **CAT** marks are famous.

---

<sup>158</sup> For instance, in 36 TTABVue, Applicant has submitted website printouts relating to an **AIRCAT** radon testing device (at 9–12 of 379), an **AQUA CAT** scuba diving company (p. 16-17 of 379), a **BIG CAT** rifle gun (at 36-37 of 379), a **BEAR CAT** vacuum cleaner (at 180-81 of 379), a **FACTORY CAT** industrial floor scrubber (at 184-85 of 379), **KIT KAT** chocolate bars (at 199-200 of 379), and **POWERCAT** portable fans and blowers (at 219 of 379). Similarly, in 37 TTABVue, Applicant has submitted website printouts relating to a climate assessment tool called **CAT** developed by the EPA (at 10-12 of 99), a wildlife photographer's collection of cat photographs entitled "Big Cats (and small cats...)" (at 36-38 of 99), a fishing company called "Big Cat Guide Service" (at 39 of 99), an event called the "10th Annual Big Cat Poker Run" (at 40-41 of 99), a website for "Big Cat Records" (at 42-45 of 99), a "Mad Cat Bike Shop" (at 81-82 of 99), a "Tom Cat Bakery" (at 85 of 99), and a medical website explaining the meaning of CAT scans (at 83-84 of 99).

See also *Caterpillar v. Gehl*, 177 USPQ at 345 ("These third-party registrations and uses are, however, insufficient to establish that '**CAT**', *per se*, is in any way lacking in trademark significance or distinctiveness as applied to earthmoving and material handling equipment because twenty-one of the twenty-six registrations pertain to goods distinctly different from those here involved and the remaining registrations and third-party uses cover such marks as '**BEARCAT**', '**BOBCAT**', '**POLECAT**', and '**WILDCAT**', which, as unitary terms, have well-known and recognized meanings which are sufficiently different from and do not conjure up the same image as '**CAT**', *per se*.")

Indeed, Applicant dedicates a substantial portion of its brief and declarations to its position that alleged third-party use and/or registration of **CAT**-formative marks somehow precludes or materially weakens Caterpillar's claims in this opposition proceeding by diminishing the strength of the **CAT** mark to such an extent that no likelihood of confusion exists. Such alleged third-party marks are only relevant, however, if the evidence of record establishes that "the marks have been used to such an extent that customers have become accustomed to seeing the marks and hence have learned to distinguish them based on minor differences in the marks." *Pro Quest Information & Learning Co. v. Jacques R. Island*, 83 USPQ2d 1351, 1357 (TTAB 2007); see *Palm Bay Imps., Inc.*, 73 USPQ2d at 1693-94 ("The probative value of third-party trademarks depends entirely upon their usage."). Here, Applicant's evidence fails to establish that any of the alleged third-party uses have been so widespread as to have had any impact on consumers of Applicant's technology. 7-*Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1729 (TTAB 2007).

Even assuming for the sake of argument that some of these third-party marks are relevant, the existence of such marks does not justify the registration of another confusingly similar mark. *Id.* ("If the particular marks involved in a proceeding are in conflict, the fact that others may have used and/or registered marks comprising a feature common to the marks in issue is of no particular significance. That is, third-party registration or use cannot justify the registration of what possibly may be another confusingly similar mark."); *In re Helene Curtis Indus., Inc.*, 305 F.2d 492, 134 USPQ 501 (CCPA 1962); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967).

## E. Actual Confusion

Applicant argues that a lack of actual confusion evidence is sufficient to avoid a likelihood of confusion. However, given the inherent difficulty of obtaining reliable actual-confusion evidence, it is well-established that actual confusion is not required for a finding of likelihood of confusion. *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); *Giant Food*, 218 USPQ at 395-96 (holding that “it is unnecessary to show actual confusion in establishing likelihood of confusion”); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012) (recognizing that “evidence of actual confusion is difficult to obtain”).<sup>159</sup> The difficulty of obtaining actual confusion evidence is compounded by the fact that the overlap in the parties’ products involves an extremely niche market (i.e., coal bed methane well operators and companies providing services to those operators), the fact that Applicant operates only in a limited geographic area in Wyoming, and because Applicant has had comparatively minimal sales and promotional activity. Under these circumstances, it would hardly

---

<sup>159</sup> Also, recognizing that “it is very difficult, and often impossible, to obtain reliable evidence of actual confusion,” courts and the Board do not require such evidence for various reasons. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:12 (4<sup>th</sup> ed. 2010). First, “[i]n an impersonal marketplace,” confusion may not be discoverable because consumers “ordinarily do not disclose their state of mind.” *Restatement (Third) of Unfair Competition* § 23 cmt.d, (1995). Second, consumers may have been confused without realizing it. See *Int’l Kennel Club of Chicago v. Mighty Star, Inc.*, 846 F.2d 1079, 6 USPQ2d 1977, 1987 n.6 (7<sup>th</sup> Cir. 1988). Third, those who later learn “of their deception will often not bother to report the fact.” 3 *McCarthy* at § 23:12. Fourth, the “vast majority” of confused persons do not contact either party. *Kinark Corp., et al. v. Camelot, Inc.*, 216 USPQ 111, 126 (D.N.J. 1982).

be surprising if no evidence of actual confusion had come to light.<sup>160</sup> *See Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989).

Nonetheless, Caterpillar uncovered an instance of asserted actual confusion in this case. Lonnie Fuller, the President of Fuller Construction, located in Moorcraft, Wyoming, testified as follows:

I am familiar with Big Cat Energy, as Fuller Construction works with the same customers as Big Cat Energy in the Powder River Basin. I understand that Big Cat Energy is developing a device that provides an alternative for depositing coal bed methane water in a reservoir. When I first learned of the name BIG CAT in connection with this company, I associated this use with Caterpillar and Caterpillar equipment because of Caterpillar's use of the CAT brand.

161

We do note that Applicant questions Mr. Fuller's credibility, describes his statement as conclusory in nature without any factual support, and criticizes Fuller's (and other similar) testimony on this point as irrelevant, inasmuch as the claims simply represent instances of "calling to mind," which are not probative on the question of likelihood of confusion.

The predecessor to our primary reviewing court has held that even a single instance of actual confusion is entitled to weight. *See Libbey-Owens-Ford Glass Co. v.*

---

<sup>160</sup> Applicant submitted four declarations from individuals who purportedly work in the oil and gas industry, containing virtually identical boilerplate denials of confusion between the **BIG CAT** Marks and Caterpillar's **CAT** mark. (See Applicant's Corbett Decl., Hettinger Decl., Greenough Decl., and Vergnani Decl.) As argued by Opposer, however, duplicative, self-serving declarations like these are entitled to little or no weight. *See Hexcel Corp. v. Ineos Polymers, Inc., F/K/A BP MRP-RNB Amoco Polymers, Inc.*, 681 F.3d 1055, 1063-64 (9<sup>th</sup> Cir. 2012) (faulting "virtually identical boiler-plate general denials" contained in eight declarations).

<sup>161</sup> Lonnie Fuller Rpt. ¶ 6, 33 TTABVue at 141-42 of 306.

*Thermoproof Glass Co.*, 390 F.2d 770, 156 USPQ 510, 511 (CCPA 1968) (where the Board had dismissed a single instance of actual confusion, the Court of Customs and Patent Appeals reversed, *inter alia*, on the ground it was entitled to consideration); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975) (holding that even a single instance of actual confusion is at least “illustrative of a situation showing how and why confusion is likely”).

Opposer argues that this instance of asserted actual confusion is entitled to even greater weight herein because Mr. Fuller is a professional with over thirty years of experience in the oil and gas industry, as opposed to a layperson who arguably might be more easily confused. *See Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 73 USPQ2d 2002, 2009-10 (8<sup>th</sup> Cir. 2005) (holding that when even professional buyers are confused, it serves as strong evidence of likelihood of confusion); *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623, 638-39 (7<sup>th</sup> Cir. 1976); *Morningside Group Ltd. v. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 51 USPQ2d 1183, 1189 (2d Cir. 1999).

Inasmuch as we cannot be sure whether Mr. Fuller was truly initially confused (as Opposer argues) or whether he was merely associating the two marks (as argued by Applicant), we find this to be a neutral *du Pont* factor in our determination of likelihood of confusion herein.

#### **F. Sophistication of Purchasers**

We acknowledge that Opposer’s products and service are generally quite expensive. Moreover, we also find relevant the complex nature of Applicant’s

proprietary technology, site specific issues such as complex geological assessments, state and federal regulatory approval processes, etc. Hence, Applicant will necessarily be involved in detailed interactions with its customers. Of course, even sophisticated purchasers can be confused by very similar marks. *See Weiss Associates, Inc.* 14 USPQ2d at 1841-42. Furthermore, the alleged expertise of owners and operators of gas wells is neither controlling nor persuasive when one considers an array of contractors in the post-sale context. *See Octocom Systems Inc.*, 16 USPQ2d at 1787. On balance, this *du Pont* factor weighs slightly against a finding of a likelihood of confusion.

#### **G. Other factors**

Finally, Applicant argues that inasmuch as its technology is the subject of multiple patents, it could not be made, offered, or sold by Opposer. We agree that valid utility patents provide Applicant the right to exclude others from offering this technology. However, patent rights are wholly distinct from trademark rights and the fact that Applicant has patent protection for its technology is irrelevant to our decision on trademark registrability under Section 2(d) of the Lanham Act. *See San Juan Products, Inc. v. San Juan Pools, Inc.*, 849 F.2d 468, 7 USPQ2d 1230, 1235 (10<sup>th</sup> Cir. 1988). Accordingly, this factor is neutral.

#### **H. Determination**

Caterpillar has proven as a matter of law its prior rights for products that are related to the technology listed in Applicant's involved applications. We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as



well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically mentioned or discussed in this opinion.

In spite of the cost of the involved goods and services, and the sophistication of the respective purchasers, in balancing the relevant factors we conclude that inasmuch as Opposer's **CAT** marks are famous (in fact, Applicant has admitted that Caterpillar's **CAT** marks are well-known for products used in the oil and gas industry), and hence, as a matter of law, the **CAT** marks are entitled to a broad scope of protection, given that the similarities of the marks in their entireties outweigh the dissimilarities, the goods and services are related, travel in the same channels of trade and are purchased by the same consumers, there is a likelihood of confusion herein that dictates judgment in Caterpillar's favor.

## **VII. Dilution**

In view of our determination as to the claim of likelihood of confusion, we do not reach the claims of dilution by blurring. *See Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1572 (TTAB 2007).

## **VIII. Decision**

*Decision:* Based upon our finding of likelihood of confusion, the opposition is hereby sustained under Section 2(d) of the Lanham Act, and registration of these two marks by Applicant is denied.