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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197243
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No.: 91197243

IOIP Holdings, LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Trademark Application Serial No. 77/648,190
	)	
Ontel Products Corporation,	)	
	)	
Applicant.	)	

OPPOSER'S MAIN BRIEF

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I. INTRODUCTION

Before the Board is an opposition filed by IOIP Holdings, LLC ("Opposer") to U.S. Trademark Application Serial No. 77/648,190 ("the '190 Application") for use of the mark OUT in connection with "all purpose cleaner; cleaning preparations" ("Applicant's Goods"). The '190 Application is owned by Ontel Products Corporation ("Applicant").

II. DESCRIPTION OF THE RECORD

A. Evidence Submitted by Opposer

Opposer's evidence includes the following:

- Opposer's Notice of Reliance on eight trademark registrations Pursuant to 37 C.F.R. §2.122(d)(2)
- Opposer's Notice of Reliance Pursuant to Rule 2.120(j) on Applicant's Response to Opposer's Requests for Admission to Applicant, Applicant's Response to Opposer's First Set of Interrogatories to Applicant and Applicant's Response to Opposer's First Set of Requests for the Production of Documents and Things to Applicant and various documents produced in response thereto
- Opposer's Notice of Reliance Pursuant to 37 C.F.R. §2.1202(e) on print outs from Opposer's web site, Applicant's web site and various third party web sites

B. Evidence Submitted by Applicant

Applicant did not take any testimony, submit a Notice of Reliance or otherwise submit any evidence during Applicant's testimony period in this proceeding.

C. Evidence Automatically of Record

The file history for the '190 Application.

III. STATEMENT OF FACTS

For more than 50 years, Opposer has, through licensees and/or predecessors in interest, sold a wide variety of cleaning preparations and related products under various trademarks that include the word "out." These are primarily household products used by consumers in laundry, bath, kitchen and water treatment applications to remove rust stains, iron stains and other stains, mineral deposits, hard water deposits and foreign matter from clothing, kitchen and bath fixtures, dishwashers, washing machines, water softeners and various surfaces. Opposer owns the following federal registrations for these marks (collectively, "Opposer's Marks"):

Reg. No.	Mark	Goods[1]	First Use Date	First Use in Commerce
693,672	IRON OUT	Chemical Compound for Use in Removing Foreign Matter from Water Softeners	12-17-1958	12-17-1958
1,505,474	RUST OUT	Chemical Compound for Use in Removing Foreign Matter from Water Softeners	0-0-1958	0-0-1958
1,537,090	IRON OUT	All Purpose Rust and Stain Remover for Use in Water Systems, Such as Toilets, Pipes, Pumps, and Water Conditioners	1-31-1964	1-31-1964
1,914,442	IRON OUT	All Purpose Rust and Iron Stain Remover for Whitening, Brightening and Removing Stains from Clothing; Removing Stains from Tubs, Sinks, Chrome, Ceramic Tile, Showers, and Like Items; Removing Stains from Dishes, Glassware, Plasticware, and Like Items; Removing Stains from Brick, Stone, Concrete and Other Exterior Surfaces; and Removing Stains from Dishwashers and Washing Machines	1-31-1964	1-31-1964
1,917,128	DRAIN OUT	Drain Openers and Sewer Cleaning Preparations	2-0-1995	2-0-1995

[1] The goods listed in the chart are collectively referred to herein as "Opposer's Goods."

1,976,124	RUST OUT	All-Purpose Rust and Stain Remover for Use in Toilet Bowls, Flush Tanks, Sinks and Bowls, Dishwashers and Washing Machines, and for White Clothing, Dishes and Glassware, Brick, Stone, or Concrete Exterior Surfaces, Tubs, Chrome, Ceramic Tile, Shower Stalls and the Like	2-19-1988	2-19-1988
1,986,001	YELLOW OUT	Cleaner for Removing Hard Water Stains, Rust Stains and Iron Stains from Clothing	8-31-1994	8-31-1994
2,366,983	LIME OUT	General Purpose Preparations for Preventing and Removing Mineral Deposits	1-1-2000	1-1-2000
2,685,393	WHIRL OUT	Mold, Mildew, Deposit, and Corrosion Inhibitor for Whirlpool Baths, Hot Tubs and Jetted Bathtubs	8-13-1999	8-13-1999

Applicant has not challenged these registrations in any way. Therefore, Opposer is entitled to all of the statutory presumptions accorded these registrations by the Trademark Act.

Applicant's '190 Application was filed on January 13, 2009 based on an alleged intention to use the mark. To date, Applicant has not filed an Amendment to Allege Use. The latest application filing date for any of Opposer's Marks is January 3, 2001. The latest first use day is January 1, 2000. Thus, Opposer is unquestionably the senior user and no issue as to priority is present.

IV. ARGUMENT

A. Applicant's Mark Creates a Likelihood of Confusion, Mistake, or Deception

The likelihood that potential consumers may be confused and mistakenly believe that there is an affiliation, connection, or association between the source of Applicant's OUT cleaning preparations and Opposer's Goods under Section 2(d) must be assessed based on an analysis of all of the probative evidence that is relevant to the factors set out in *In re E.I. du Pont de Nemours & Co.*, 177 USPQ. 563 (CCPA 1973). The ultimate issue, of course, is not whether

consumers will confuse the actual goods at issue, but, rather, whether there is a likelihood that an appreciable number of consumers will form a mistaken belief as to the source of the goods, such as believing that the owner of the senior mark somehow licensed or otherwise authorized the junior user's use of the mark in question. *See, In re Shell Oil Co.,* 26 USPQ.2d 1687, 1690 (Fed. Cir. 1993).

The Federal Circuit has explained that "[n]ot all of the DuPont factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case.'" *In re Majestic Distilling Co.,* 65 USPQ.2d 1201, 1204 (Fed. Cir. 2003) (*quoting In re Dixie Restaurants, Inc.,* 41 USPQ.2d 1531, 1533 (Fed. Cir. 1997)).

In the present case, every relevant *du Pont* factor on which evidence has been introduced weighs in favor of Opposer.

1. The Marks Are Similar In Their Entireties

The test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ. 106 (TTAB 1975).

A likelihood of confusion "is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the name, goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences." *Trademark Manual of Examining Procedure,* § 1207.01(b)(iii). *See also, In Re Toshiba Med. Sys. Corp.,* 91 USPQ.2d, 1266, 1271 (TTAB 2009) (VINTAGE TITAN for an MRI diagnostic

apparatus is likely to be confused with TITAN for a medical ultrasound device); *In Re SL&E Training Stable, Inc.*, 88 USPQ.2d 1216, 1219 (TTAB 2008) (SAM EDELMAN for use with wallets and bags is likely to be confused with EDELMAN used with the same goods); *In Re El Torito Restaurants, Inc.* 9 USPQ.2d 2002 (TTAB 1988) (MACHO COMBOS for use with food items as part of restaurant services is likely to cause confusion with MACHO also for food items as part of restaurant services); *In Re Equitable Bancorporation*, 229 USPQ. 709, 711 (TTAB 1986) (RESPONSE likely to be confused with RESPONSE CARD when both marks are used for banking services and the term "card" is disclaimed); *In Re Corning Glassworks*, 229 USPQ. 65, 66 (TTAB 1985) (CONFIRM used with solution used to yield predetermined dissolved gas values in a blood-gas analyzer is likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use, noting that "cells" would be perceived by relevant consumers as merely descriptive).

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to such a feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ. 749 (Fed. Cir. 1985). Furthermore,

> When assessing the likelihood of confusion between compound word marks, one must determine whether a portion of the word mark is dominant in terms of creating the commercial impression. . . . Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. . . . Accordingly, if two marks for related goods or services share identical or similar dominant features, and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely.

Trademark Manual of Examining Procedure, § 1207.01(b)(viii). *See also, In Re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (holding that "Delta" is the dominant portion of the mark THE DELTA CAFE in light of disclaimer of the generic term "cafe").

In the present case, Applicant's mark consists solely of the term "out." This term is also the dominant portion of Opposer's Marks. Opposer's registration for the LIME OUT mark includes a disclaimer of the term "lime." Opposer's Trademark Registration No. 1,976,124 for the RUST OUT mark includes a disclaimer of the term "rust." Applicant's registration for the WHIRL OUT mark includes a disclaimer of the term "whirl." "Out" is also the dominant portion of the remainder of Opposer's Marks, as the remaining matter is somewhat suggestive when used in connection with the goods identified. For example, Opposer's U. S. Trademark Registration No. 1,914,442 for the IRON OUT mark is an "all purpose rust and iron stain remover . . ."

Applicant also emphasizes the "out" portion of its marks in use. As shown in the documents referred to in Paragraph 11 of Opposer's Notice of Reliance, the term "out" typically appears in much larger font than the other terms in Opposer's Marks, such as "iron" or "lime."

Thus, Applicant's OUT mark is identical to the dominant portion of each of Opposer's Marks. When considered in their entireties, Applicant's OUT mark creates essentially the identical commercial impression as each of Opposer's Marks.

2. The Goods of the Parties Are Identical and/or Commercially Related

It is sufficient for a finding of likely confusion that the goods of the Applicant and the Opposer are related in some manner, such as that the conditions and activities surrounding the marketing of the goods are such that they may be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that the goods originate from (or are sponsored by) the same party. *See, e.g., In re International*

Telephone & Telegraph Corp., 197 USPQ. 910, 911 (TTAB 1978); *On-line Careline Inc. v. America Online Inc.*, 56 USPQ.2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ. 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ.2d 1812 (TTAB 2001); and *Chemical New York Corp. v. Conmar Form Systems Inc.*, 1 USPQ.2d 1139 (TTAB 1986).

Moreover, as the Federal Circuit stated in *Recot, Inc. v. M.C. Becton,* 214 F.3d 1332, 54 USPQ.2d 1895, 1898 (Fed. Cir. 2000), "even if the goods in question are different from and thus not related to one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." *See, also, Bose Corp. v. QSC Audio Products, Inc.*, 293 F.2d 1367, 63 USPQ.2d 1303, 1309-10 (Fed. Cir. 2002) ("Hence the products as described in the pertinent registration are not the same. But they are related as required by *du Pont*."); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ.2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.").

The evidence of the record demonstrates that Applicant's Goods are identical to certain of Opposer's Goods and closely related to others. Applicant's Goods are "all purpose cleaner; cleaning preparations." This description is broad enough to literally encompass those goods specified in Opposer's U.S. Trademark Registration No. 1,537,090 for the IRON OUT mark ("all purpose rust and stain remover . . ."), U.S. Trademark Registration No. 1,914,442 for the IRON OUT mark ("all purpose rust and iron stain remover for whitening, brightening and removing stains from clothing . . ."), U.S. Trademark Registration No. 1,976,124 for the RUST OUT mark ("all-purpose rust and stain remover . . .") and U.S. Trademark Registration No. 1,986,001 for

the YELLOW OUT mark ("cleaner for removing hard water stains, rust stains and iron stains from clothing").

Indeed, documents ONT0001 – ONT0005[2] produced by Applicant specifically state that Applicant's OUT product is an "instant stain remover" that can be used with clothing, carpets, upholstery, car seats, leather, metal "and more." Opposer's U.S. Trademark Registration No. 1,914,442 for the IRON OUT mark and U.S. Trademark Registration No. 1,986,001 for the YELLOW OUT mark both cover preparations for removing stains from clothing. Opposer's U.S. Trademark Registration No. 1,976,124 for the RUST OUT mark covers preparations for removing stains from metal, namely, chrome. Thus, Applicant's Goods are identical to some of Opposer's Goods.

Applicant's Goods are clearly related to the remainder of Opposer's Goods. All of Opposer's Goods clearly emanate from the same source as all ultimately emanate from Opposer. Thus, all of Opposer's Goods are related and are of the type of goods that consumers would believe emanate from a single source. Because Applicant's Goods fully encompass and are identical too certain of Opposer's Goods, they are necessarily related to the remainder of Opposer's Goods and are the types of goods which consumers would believe emanate from a single source. Thus, Opposer's Goods listed in each of Opposer's registrations are either identical to Applicant's Goods or commercially related to Applicant's Goods.

3. The Trade Channels of the Parties Are Identical

Applicant's pending application is unrestricted with regard to channels of trade. Consequently, it must be presumed that the '190 Application encompasses all goods of the type described, that the goods so covered move in all normal channels of trade, and that they are

[2] See ¶10 of Opposer's Notice of Reliance and accompanying documents.

available to all classes of purchasers. *See, e.g., In re Linkvest S.A.*, 24 USPQ.2d 1716 (TTAB 1992); *Otocom Systems Inc. v. Houston Computers Services Inc.*, 16 USPQ.2d 1783 (Fed. Cir. 1996); and *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ. 735, 736 (TTAB 1984) ("Since there is no limitation in Applicant's identification of goods, we must presume that they move in all normal channels of trade and are purchased by all potential customers."). As such, the parties' channels of trade certainly overlap.

Moreover, the actual channels of trade for the parties' goods also overlap. As shown by the evidence, the goods sold under each of Opposer's Marks are offered through the internet at the website of Summit Brands (Opposer's Notice of Reliance, Paragraph 11 and accompanying documents) and through retail outlets and the websites of retailers, such as Menards (Opposer's Notice of Reliance, Paragraph 12 and accompanying documents), Walmart (Opposer's Notice of Reliance, Paragraph 13 and accompanying documents), Ace Hardware (Opposer's Notice of Reliance, Paragraph 16 and accompanying documents), Lowe's (Opposer's Notice of Reliance, Paragraph 17 and accompanying documents), Kmart (Opposer's Notice of Reliance, Paragraph 19 and accompanying documents) and Sam's Club (Opposer's Notice of Reliance, Paragraph 20 and accompanying documents).

Applicant has admitted that its OUT cleaning preparations are sold to individual consumers through the internet and that it intends to continue to sell such products online and potentially through retail sales. (Applicant's Responses to Opposer's Interrogatory Nos. 4, 5, 9, and 22; Opposer's Notice of Reliance, Paragraph 8; Opposer's Notice of Reliance, Paragraph 23 and accompanying documents).

4. The Conditions under Which Sales Are Made Increase the Likelihood of Confusion

The goods sold by both parties are relatively inexpensive. They are the types of items which people tend to buy in small amounts and might buy on impulse while shopping online or walking through a Walmart. For example, Applicant's OUT product costs between $10.00 and $19.99 plus $6.99 shipping and handling for 2 to 3 tubes of product. Thus, Applicant's Goods cost between $8.50 and $13.49 per unit, including shipping and handling. (Applicant's Responses to Opposer's Interrogatory No. 3; Opposer's Notice of Reliance, Paragraph 8). Opposer's Goods are also inexpensive:

(a) IRON OUT products are $7.99 to $12.97 at Walmart (Opposer's Notice of Reliance, Paragraph 13 and accompanying documents)

(b) DRAIN OUT and IRON OUT products are $3.99 to $14.69 at Orscheln Farm & Home (Opposer's Notice of Reliance, Paragraph 14 and accompanying documents)

(c) DRAIN OUT, IRON OUT, LIME OUT and WHIRL OUT are $5.69 to $16.99 at Aubuchon Hardware (Opposer's Notice of Reliance, Paragraph 15 and accompanying documents)

It is well established that confusion is more likely when inexpensive goods are purchased by unsophisticated consumers. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed Cir. 2000) ("When the products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.").

5. Opposer's Marks Are Strong

The strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark, and the extent of advertising or

promotion of the goods with which the mark is used. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ. 390 (Fed. Cir. 1983). Opposer's Marks have been used for a minimum of 12 years and for as long as 54 years. Four of Opposer's Marks have been used for more than 47 years. One has been in use for nearly 25 years. The evidence shows that Opposer's Goods are sold under Opposer's Marks by some of the largest retailers in the country, such as Walmart, Lowes, Menards and Kmart, thereby exposing millions of consumers to Opposer's Marks on a daily basis. Thus, Opposer's Marks are strong and entitled to a broad scope of protection.

6. Opposer's Marks Constitute a Family of OUT Marks

A family of marks exists when a trademark owner uses a plurality of marks that include a common, distinguishing feature. *See American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ. 457, 461 (TTAB 1978) ("A 'family' concept is bottomed on recognition of the common feature as the distinguishing feature of each mark."). As discussed above, "out" is the dominant feature of each of Opposer's Marks. Opposer has also emphasized the term "out" on its product packaging. As shown in the documents referred to in paragraph 11 of Opposer's Notice of Reliance, Opposer's "out" products are advertised together as a family of brands. Thus, Opposer's Marks constitute a family of "out" marks.

It is also clear in light of the evidence that Applicant's mark would be perceived as member of Opposer's family of "out" marks. The goods are identical or commercially related, the channels of trade overlap and the products are inexpensive and would likely be purchased on impulse. Thus, Applicant' mark is likely to be confused with Opposer's family of "out" marks. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ.2d 1482, 1491 (TTAB 2007) ("In comparing opposer's marks with applicant's marks, then, the question is not whether each of

applicant's marks is similar to opposer's individual marks, but whether applicant's marks would be likely to be viewed as members of opposer's HOG family of marks.")

7. Other Du *Pont* Factors are not Pertinent

The Court's opinion in *du Pont* includes several factors in addition to those discussed above, but they are not pertinent to the record of this case, and do not warrant detailed discussion. For example, although there is no evidence of actual confusion, such evidence is not required. *Majestic Distilling,* 65 USPQ.2d at 1205 ("The lack of evidence of actual confusion carries little weight."). The test is not actual confusion, but likelihood of confusion. *See, Weiss Associates Inc. v. HRL Associates Inc.,* 902 F.2d 1546, 14 USPQ.2d 1840 (Fed. Cir. 1990).

8. Any Doubt Must Be Resolved in Opposer's Favor

Finally, it is well settled that any doubt as to whether there is a likelihood of confusion must be resolved in favor of the prior user. *See, In re Shell Oil,* 26 USPQ.2d 1687. While the record leaves no doubt, were the Board to be left with any such doubt, the Board must still find in favor of the Opposer.

V. CONCLUSION

Based on the evidence of record and the foregoing arguments, it is clear that Applicant's OUT mark is likely to be confused with each one of Opposer's Marks and with Opposer's family of OUT marks as a whole. Opposer respectfully requests that the Board sustain the present opposition and refuse registration of U.S. Trademark Application Serial No. 77/648,190.

Respectfully submitted,

IOIP HOLDINGS, LLC

Date: June 27, 2012

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Main Brief was served on Jason M. Drangel, Esq., Epstein Drangel LLP, 60 East 42nd Street, Suite 2410, New York, NY 10165, by first class mail, postage prepaid, on the 27th day of June, 2012.

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