

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 9, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IOIP Holdings, LLC

v.

Ontel Products Corporation

Opposition No. 91197243
to application Serial No. 77648190

Gerard T. Gallagher of Barnes & Thornburg LLP for IOIP
Holdings, LLC.

Jason M. Drangel of Epstein Drangel Bazerman & James LLP for
Ontel Products Corporation.

Before Kuhlke, Wellington, and Lykos,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Ontel Products Corporation, a New Jersey corporation,
seeks registration of OUT (in standard character form) for
"all-purpose cleaner; cleaning preparations" in
International Class 3.¹

¹ Serial No. 77648190, filed on January 13, 2009, alleging a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Opposer, IOIP Holdings LLC, has opposed registration of applicant's proposed mark based on its ownership of the following 6 registered marks (subject of 9 registrations):

1. IRON OUT

Registration No. 693672² for:
Chemical compound for use in removing foreign matter from water softeners in International Class 1;

Registration No. 1537090³ for:
All purpose rust and stain remover for use in water systems, such as toilets, pipes, pumps, and water conditioners in International Class 1;

Registration No. 1914442⁴ for:
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, plastic ware, and like items; removing stains from brick, stone, concrete and other exterior surfaces; and removing stains from dishwashers and washing machines in International Class 1;

2. RUST OUT

Registration No. 1505474⁵ for:
Chemical compound for use in removing foreign matter from water softeners in International Class 1;

Registration No. 1976124⁶ (RUST disclaimed) for:
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 in International Class 1;

3. DRAIN OUT

² Issued on March 1, 1960; renewed.

³ Issued on May 2, 1989; renewed.

⁴ Issued on August 29, 1995; renewed.

⁵ Issued on May 28, 1996; renewed.

⁶ Issued on September 27, 1988; renewed.

Registration No. 1917128⁷ for:
Drain openers and sewer cleaning preparations in
International Class 1;

4. YELLOW OUT

Registration No. 1986001⁸ for:
Cleaner for removing hard water stains, rust stains and
iron stains from clothing in International Class 1;

5. LIME OUT

Registration No. 2366983⁹ (LIME disclaimed) for:
General purpose preparations for preventing and
removing mineral deposits in International Class 1; and

6. WHIRL OUT

Registration No. 2685393¹⁰ for:
Mold, mildew, deposit, and corrosion inhibitor for
whirlpool baths, hot tubs and jetted bathtubs in
International Class 1.

Opposer alleges it has "ownership rights" in the above
marks that "predate and are superior to any rights of
applicant" and that applicant's proposed mark, if used on
the goods identified in the application, is confusingly
similar to opposer's registered marks, "both individually
and as a family of marks," and is likely to cause confusion
or mistake, within the meaning of Section 2(d) of the Act,
15 USC §1052(d).

Applicant filed an answer denying the salient
allegations or stating that it was "without knowledge or
information" to answer and therefore denies the allegation.

⁷ Issued on September 5, 1995; renewed.

⁸ Issued on July 9, 1996; renewed.

⁹ Issued on July 11, 2000; renewed.

Only opposer presented evidence at trial and filed a trial brief. While there is no indication that applicant actively defended its application, other than by filing an answer, we are cognizant of the burden that remains with opposer, namely, establishing its pleaded case (in this case, its standing and Section 2(d) ground of opposition) by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

The evidence of record in this case consists automatically of the file of applicant's involved application and the pleadings. In addition, opposer submitted a notice of reliance upon the following: status and title copies of its pleaded registrations; applicant's responses to opposer's interrogatories, requests for admissions and requests for the production of documents, including certain documents produced in connection therewith; and internet printouts from opposer's, applicant's and various third-party websites.

Because opposer's pleaded registrations are of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). *See also Cunningham*, 222 F.3d 943.

¹⁰ Issued on February 11, 2003; renewed.

In addition, Section 2(d) priority is not an issue in this case as to the individual marks and goods covered by the pleaded registrations because said registrations are of record. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, to the extent that opposer has pleaded and relies upon a family of OUT marks, there is no evidence of record to establish the priority for this family of marks, i.e., we cannot make a finding that a family of marks was created prior to the earliest priority date that applicant may rely upon, in this case, the filing date of the application. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Because applicant has not established priority with respect to a family of marks, opposer's likelihood of confusion ground cannot be based on the purported family of OUT marks.¹¹

In view of the above, we now turn our attention to the likelihood of confusion analysis and limit our consideration to opposer's individually registered marks vis-à-vis the mark in the involved application.

¹¹ Indeed, on this record, we do not find that the registered marks have been promoted as a family or that the public perceives the marks as a family. "Simply using a series of similar marks does not of itself establish the existence of a family." *J & J Snack Foods Corp.*, 18 USPQ2d at 1891.

Our likelihood of confusion determination under Section 2(d) is based on 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). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first consider the *du Pont* factors regarding the similarity or dissimilarity of the goods, trade channels and classes of purchasers. In our evaluation of these factors, we are bound by the goods identified in the involved application and pleaded registrations. In the absence of any restrictions or limitations in the application and registration, we must assume the goods are sold through all the normal and usual trade channels for such goods to all the usual purchasers of such goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Here, applicant's goods ("all-purpose cleaner; cleaning preparations") are so broadly identified so as to encompass certain goods within each of opposer's pleaded registrations. That is, while opposer's goods may have a more specific cleaning purpose, as identified, they could fall within the scope of applicant's identified goods. For example, opposer's "chemical compound for use in removing foreign matter from water softeners" (Reg. No. 693672) can be classified a "cleaning preparation." Thus, the respective goods of the parties are legally identical.

Because there are no trade channel restrictions in the application and registration, we must presume that the parties' respective items, at least where we find them to be identical, would be found in the same channels of trade and be subject to purchase by the same consumers. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). This presumption is actually proven by the evidence submitted by opposer showing its own products, as well as cleaning preparation products of others, being offered for sale at retail stores such as Walmart, Menards, and hardware stores.

Accordingly, the aforementioned *du Pont* factors involving the similarity or dissimilarity of the goods, trade channels and classes of purchasers all favor finding a likelihood of confusion.

This brings us to the similarity or dissimilarity of the marks. Our focus is on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We keep in mind that when marks would appear on identical goods, as they do here, the degree of similarity of marks necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In comparing applicant's proposed mark, OUT, with opposer's previously registered marks, we find them to be very similar inasmuch as each of the opposer's marks is comprised of a single, highly suggestive or descriptive term followed by OUT.¹² We acknowledge that the common element of the parties' marks, OUT, will also likely be perceived as suggestive of cleaning preparations to the extent that it connotes the product's ability to take a stain or blemish "out," i.e., removing the stain or blemish. However, that same suggestive "out" meaning will be present in all of the marks, the only difference being that opposer's marks are more specific of the blemish or purpose of the cleaner. The record is also void of any evidence establishing that OUT is

commonly used by third-parties on or in connection with the same or similar goods such that registrant's marks should be considered "weak" or otherwise accorded a limited scope of protection. Furthermore, and with particular emphasis on opposer's marks LIME OUT and RUST OUT, we find that consumers will likely attribute less source-identifying significance to the disclaimed terms LIME and RUST, and thus focus on the common, non-disclaimed element, OUT.

Visually and phonetically, the marks are only distinguished by the initial various terms in opposer's marks. While these terms are not to be ignored in our comparison of the marks, the marks remain similar based on the common element, OUT. In view thereof, the parties' marks are similar in sound, appearance, connotation and overall commercial impression. Accordingly, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

In summary, we find that the marks are similar, the involved goods are identical in part, and the goods must be presumed to be marketed in the same channels of trade to the same classes of end consumers. Ultimately, upon weighing all of the relevant *du Pont* factors for which there is evidence or arguments, we find that applicant's use of the proposed mark OUT is likely to cause confusion with

¹² In two of the pleaded registrations (as indicated above), the initial terms, RUST and LIME, are disclaimed.

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opposer's registered marks, LIME OUT, RUST OUT, IRON OUT, YELLOW OUT, DRAIN OUT, and WHIRL OUT.

Decision: The opposition is sustained and registration to applicant is refused.