

<p>This Opinion is Not a Precedent of the TTAB</p>

Hearing: October 3, 2014

Mailed: September 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Diamond Power International, Inc.
v.
Clyde Bergemann, Inc.

Opposition No. 91201996
to Application Serial No. 85020585

Michael N. Spink, John T. Gabrielides and Steven L. Oberholtzer of Brinks Gilson
& Lione, for Plaintiff, Diamond Power International, Inc.

Michael J. Mehrman of Cantor Colburn PLLC, for Defendant, Clyde Bergemann,
Inc.

Before Rogers, Chief Administrative Trademark Judge, and Kuczma and
Hightower, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Clyde Bergemann, Inc., (“Applicant”), filed an intent-to-use application to
register the mark ASHCON with a standard character claim for:

Consulting services in the field of custom manufacturing
of industrial equipment for power plants, mainly bottom
ash dewatering systems in Class 40, and

Consulting services in the field of design and development
of industrial equipment for power plants, mainly bottom

ash dewatering systems, in Class 42.¹

Diamond Power International, Inc., (“Opposer”), opposes registration of Applicant’s mark on the grounds of likelihood of confusion and that the mark is merely descriptive of Applicant’s services under, respectively, Sections 2(d) and (e) of the Trademark Act, 15 U.S.C. §§ 1052(d) and (e).

Opposer pleads the following registrations:

- a. Registration No. 221,415: A-S-H (stylized) for “Apparatus for use in conjunction with boiler furnaces and the like-namely, hoppers, furnace bottoms, furnace walls, ash gates, sluiceways, quenchers, and bunkers” in Class 11, registered November 30, 1926, renewed, Opp. Ex. 2, (48 TTABVUE 16-19);
- b. Reg. No. 2,218,648: ALLEN-SHERMAN-HOFF for “Apparatus for use in conjunction with boiler furnaces and the like-namely, hoppers, furnace bottoms, furnace walls, ash gates, sluiceways, quenchers, and bunkers” in Class 11, registered January 19, 1999, Opp. Ex. 3, (48 TTABVUE 110-113);
- c. Reg. No. 2,444,743: ASHCORE for “Ceramic lined steel piping and fittings therefor for the transport of abrasive materials” in Class 6, registered April 17, 2001, Opp. Ex. 4, (48 TTABVUE 154-158);
- d. Reg. No. 774,841: ASHCOLITE (stylized) for “Special castings, namely cast pipe and fittings therefor” in Class 6, registered August 11, 1964, Opp. Ex. 5;²

¹ Application Serial No. 85020585 was filed on April 22, 2010, based on Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Registration No. 774,841 for ASHCOLITE was pleaded in the Notice of Opposition but apparently was not timely renewed and hence will expire in due course. Ex. 5 (48 TTABVUE 220-223). When a federal registration owned by a party has been properly made of record in an *inter partes* proceeding, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the Office. *See Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007) (judicial notice taken of current status of a registration owned by a party properly made of record, when status of registration changed between the time it was made of record and time case decided). Nonetheless, there is sufficient testimony regarding

- e. Reg. No. 2,394,639: ASHFLO for “Valves being parts of the transport piping of hydraulic conveying machines used in the conveyance of abrasive slurries” in Class 7, registered October 17, 2000, Opp. Ex. 6 (48 TTABVUE 279-281);
- f. Reg. No. 2,601,135: ASHANDLER for “Valves being parts of machines, namely, valves for regulating ash flow through conveying lines used in dry ash collecting systems” in Class 7, registered July 30, 2002, Opp. Ex. 7, (48 TTABVUE 330-332);
- g. Reg. No. 2,581,199: ASHVAC for “Valves being part of vacuum pneumatic material transport machines” in Class 007, registered June 18, 2002, Opp. Ex. 8, (48 TTABVUE 404-406);
- h. Reg. No. 3,065,460: PowerASH for “Clinker grinders; bottom ash grinders; grinders comprising grinding rolls, anvil elements, breaker bars, rollers, anvils, drive units, drive shafts, housing, access doors, debris deflectors, plates, packing chambers and mounting flanges all sold as a unit” in Class 7, registered March 7, 2006, Opp. Ex. 9, (48 TTABVUE 464-466); and

the continuous and current use of the ASHCOLITE mark for piping since the 1940’s. *See, e.g.*, Moskal “Confidential” Testimony Transcript pp. 56:6-59:12, 81:11-20, 108:3-5 (55* TTABVUE 59-62, 84, 111). Testimony is cited using the format: “Page:Line,” where “72:2-73:25” refers to Page 72, Line 2 through Page 73, Line 25.

Record citations are to the Trademark Trial and Appeal Board’s publicly available docket history system “TTABVUE.” Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Some of the testimony designated “confidential” we do not find to be sensitive information subject to the “confidential” designation and is cited in this opinion. *See* II. Evidence Designated “Confidential” *infra*. The symbol “*” when used in this decision indicates citation to Discovery or Testimony deposition transcripts that have been in pertinent part improperly designated “Confidential.” Inasmuch as the cited testimony from such transcripts, that is designated with the “*” symbol was not appropriately designated as confidential, the parties are directed to review and re-designate any transcripts we have treated as including improper designations of confidentiality, and to submit substitute transcripts with only appropriate redaction and designations; failure to do so will result in the release of the entire transcripts for public viewing in the TTABVUE file system. *See* section II *infra*.

- i. Reg. No. 3,169,328: CycloASH for “Industrial solid material particles, ash and dust collectors for use with vacuum conveying systems” in Class 7, registered November 7, 2006, Opp. Ex. 10 (48 TTABVUE 500-502).³

Opposer provides material handling systems predominantly to customers in the power utility business.⁴ It has used the marks identified above in commerce in connection with material handling conveyor systems for waste disposal and various parts and fittings therefor. Additionally, Opposer provides custom design, commission, maintenance and repair services for the handling conveyor systems, parts and fittings it sells.⁵ The record also shows Opposer owns common law rights in its A-S-H, ASHseal, DenseASH, www.a-s-h.com and “1.888.ash.parts” marks as used in connection with such goods and services.⁶ Lastly, Opposer uses “ASH” (capitalized and without hyphens) to refer to its ash-handling division, Allen-Sherman-Hoff, and its products.

³ Registration Nos. 221,415; 2,218,648; 2,394,639; 2,444,743; 2,581,199; and 2,601,135 have been renewed. Section 8 and 15 combined Declarations of Use have been accepted and acknowledged for Registration Nos. 3,065,460 and 3,169,328.

Reg. No. 2,218,648 for ALLEN-SHERMAN-HOFF, Reg. No. 2,394,639 for ASHFLO, Reg. No. 2,444,743 for ASHCORE, Reg. No. 2,581,199 for ASHVAC, and Reg. No. 2,601,135 for ASHANDLER, are “typed” marks which are the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure § 807.03(i) (July 2015). Reg. No. 3,065,460 for PowerASH and Reg. No. 3,169,328 for CycloASH are standard character marks.

⁴ Moskal “Confidential” Testimony Transcript pp. 11:18-20, 16:22-17:2, 17:16-20, 26:2-8, 27:7-22 (55* TTABVUE 14, 19-20, 29, 30); Opp. Ex. 1, (55* TTABVUE 263-265).

⁵ Moskal “Confidential” Testimony Transcript pp. 21:21-23:8 (55* TTABVUE 24-26).

⁶ Moskal “Confidential” Testimony Transcript pp. 72:2-73:25; 74:14-75:25; 76:8-77:22 (55* TTABVUE 75-80); Opp. Ex. 13, 33, 34 (55* TTABVUE 298-299, 56* TTABVUE 5-14), and Opp. Brf., p. 10 (79 TTABVUE 11). Obviously, information concerning the existence and content of Opposer’s registrations is not confidential.

Opposer claims Applicant's mark is likely to cause confusion in view of Opposer's ASH Marks individually and/or collectively, and as to Applicant's affiliation, connection or association with Opposer, or as to the origin, sponsorship or approval of Applicant's services in view of Opposer's ASH Marks, individually and/or collectively. Opposer also challenges Applicant's ASHCON mark on the ground that it is merely descriptive of Applicant's services and should be refused registration.⁷

In its Answer, Applicant admits the publicly available records of the United States Patent and Trademark Office indicate registration of the referenced registrations set forth above, and denies the remaining salient allegations, alleging several affirmative defenses.⁸ While Applicant did not formally present affirmative defenses at trial, such "affirmative defenses" were incorporated into its defense of the case, including that "ASH" is a generic term incapable of serving as a trademark, "ASH" is a weak or merely descriptive term entitled to little or no weight, the element "ASH" in Opposer's ASH Marks has been commonly used by others in connection with similar goods and is not indicative of Opposer, and Opposer's Marks were not used or promoted together in a way that creates public recognition that the marks come from the same owner and Opposer did not establish a family of marks in which "ASH" is recognized as indicative of Opposer as the source of goods or services.

⁷ To the extent Opposer's references to its collective "ASH Marks" constitute an assertion that it owns a family of marks, we consider that argument *infra*. In this decision, we refer to Opposer's collective marks as the "ASH Marks" solely for convenience.

⁸ Answer to Notice of Opposition paragraph Nos. 1-3, (4 TTABVUE 2).

I. The Record

By rule, the record includes Applicant's application file and the pleadings.

Trademark Rule § 2.122 (b), 37 CFR § 2.122 (b). Additionally, the parties introduced the following testimony and evidence:

A. Opposer's Evidence

1. Opposer's First Notice of Reliance: Printed Publications, containing Ex. 1 (48 TTABVUE 2-3, 12-15);
2. Opposer's Second Notice of Reliance (48 TTABVUE 4-6):
 - a. Official Records, containing Exs. 2-13:
 - i. Exs. 2-10 collectively Opposer's Prosecution Files (48 TTABVUE 16-585);
 - ii. Ex. 11 Prosecution File for Applicant's DRYCON mark (48 TTABVUE 586-676);
 - iii. Ex. 12⁹ Applicant's Opposition to Opposer's Motion for Summary Judgment (48 TTABVUE 677-688);
 - iv. Ex. 13 consisting of:
 1. Exhibit-1 attached to Applicant's Opposition to Opposer's Motion for Summary Judgment including the Declaration of Ron Tempesta submitted with Applicant's Response to Opposer's Motion for Summary Judgment with Exhibits A-B (48 TTABVUE 689-705); and

⁹ Opposer's Exhibits 12 and 13 offered into evidence consist of Applicant's Opposition to Opposer's Motion for Summary Judgment and a page from the Discovery Deposition of Opposer's witness, Thomas E. Moskal, filed in connection therewith. Inasmuch as Applicant "concurs with the Description of the Record in [Opposer's] Trial Brief," Trial Brief of Applicant p. 2 (82 TTABVUE 7), it has stipulated to the admission of Exhibits 12 and 13 into evidence. We note that Exhibit 12 has no probative value with respect to evidence and arguments contained therein.

2. Exhibit-2 October 12, 2012 Deposition Transcript of Thomas E. Moskal (48 TTABVUE 706-708);
3. Opposer's Third Notice of Reliance:
 - a. Applicant's Responses to Opposer's Discovery Requests, containing Exs. 14-16 (Exs. 14-15 Applicant's Responses to Discovery Requests; Ex. 16 Stipulation) (48 TTABVUE 7-8, 709-718);
4. Opposer's Fourth Notice of Reliance: Discovery Depositions of Applicant's witnesses, containing Exs. 17-26 (47* TTABVUE 9-11 to 48 TTABVUE), specifically, the discovery depositions of:
 - a. Mr. Hans Schwade, President and CEO of Applicant's parent company, Ex. 17, hereafter, "Schwade CONFIDENTIAL Discovery Deposition" (47* TTABVUE 730-741),
 - b. Mr. Ronald Tempesta, President and CEO of Applicant, Ex. 20, hereinafter "Tempesta CONFIDENTIAL Discovery Deposition" (47* TTABVUE 748-760),
 - c. Mr. Ronald Grabowski, Vice President of Business Development for Applicant, Ex. 23, hereinafter "Grabowski CONFIDENTIAL Discovery Deposition" (47* TTABVUE 773-785), and
 - d. Mr. Gary Mooney, Project Manager of Ash Technology for Applicant, Ex. 25, hereinafter "Mooney CONFIDENTIAL Discovery Deposition" (47* TTABVUE 848-859);
5. Joint Notice of Reliance and Stipulation of Facts, filed under seal, containing the Declaration of Dr. Thomas Moskal, General Manager of Allen-Sherman-Hoff (hereinafter "Decl. Moskal"), and the Declaration of Mr. Ronald Grabowski, Vice President, Business Development of Clyde Bergemann Delta Ducon (hereinafter "Decl. Grabowski") (54 TTABVUE); and
6. Trial Testimony of Thomas Moskal, containing Moskal Exs. 1-49, (hereinafter "Moskal CONFIDENTIAL Testimony Transcript") (55*-56* TTABVUE and 57 TTABVUE 2-80).

B. Applicant's Evidence

1. Trial Testimony of Hans Schwade, containing Applicant Exs. 1-10 (hereinafter "Schwade Testimony Transcript") (60, 68-71 TTABVUE);
2. Trial Testimony of Gary Mooney, containing Applicant Exs. 11-15, (hereinafter "Mooney Testimony Transcript") (61-62, 72-74 TTABVUE);
3. Trial Testimony of Ronald Grabowski, containing Applicant Exs. 16-19, (hereinafter "Grabowski Testimony Transcript") (63-64 TTABVUE); and
4. Trial Testimony of Ronald Tempesta, containing Applicant Exs. 20-22, (hereinafter "Tempesta Testimony Transcript" or "Tempesta CONFIDENTIAL Testimony Transcript") (65-66*, 76-77 TTABVUE).

II. Evidence Designated "Confidential"

Portions of the deposition and testimony transcripts, and their exhibits, presented by the parties have been designated as "confidential." Inasmuch as submissions in Board proceedings are intended to be publicly available, the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write clear decisions when the facts in evidence may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision. While we observe such designations as a general rule, we decline to do so where they plainly do not apply and where to do so would hamper explanation of our analysis of the record in a case.

To adequately explain our analysis and the facts on which it is based, we must refer to some of the “confidential” testimony and exhibits, although we have not revealed anything that we find in any way confidential. Therefore, in this Opinion, we treat as confidential only the testimony and evidence that was appropriately designated as confidential and we will not be bound by all of the “unnecessary” confidential designations made by the parties. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402-1403 (TTAB 2010).

Accordingly, the parties are allowed until thirty (30) days after the issue date of this decision to file revised, redacted versions of the testimony and exhibits consistent with this Opinion, failing which the testimony and exhibits in their entirety will become part of the public record.

Additionally, in its Reply brief, Opposer objects to, and moves to strike, select portions of the testimony provided by Applicant’s witnesses, Messrs. Grabowski and Tempesta,¹⁰ and of Opposer’s *own* witness, Dr. Moskal, on the grounds of hearsay or speculation. We have carefully considered all of the testimony submitted. In doing so, we have kept in mind the various objections raised. With the exception of a portion of Mr. Grabowski’s testimony, our decision does not rely on the testimony which is subject to Opposer’s objections. As to the testimony of Mr. Grabowski

¹⁰ Opposer’s objection in footnote 5 on p. 21 of Opposer’s Reply Brief (84 TTABVUE) is somewhat confusing as it addresses Mr. Grabowski’s testimony while citing to the testimony transcript for Mr. Tempesta. Upon review of the testimony transcripts of Messrs. Grabowski and Tempesta, we have considered the objection with respect to the testimony given by Mr. Tempesta.

objected to at p. 18:4-5 of his testimony deposition (63 TTABVUE 20), we overrule the objection and accord whatever probative value such testimony merits.

III. Standing and Priority

Opposer bears the burden of proving both standing to oppose and at least one valid ground for refusal of registration. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Sanyo Watch Co., Inc. v. Sanyo Electric Co.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982). Because Opposer has properly made its pleaded Registrations for the ASH Marks of record, it has established standing to oppose registration of Applicant's ASHCON mark and its priority of use is not an issue as to the marks and goods covered by the Registrations. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Of course, priority remains an issue as to common law rights claimed by Opposer for unregistered marks or for uses of the registered marks with goods or services not included within the identifications of the registrations.

IV. Background

This case involves ash material handling systems. Such systems are utilized in the coal-fired power industry where boilers burn coal for energy production. The primary solid by-product of coal combustion is ash, which is disposed of using an ash conveying system. When boilers burn coal for energy production, ash falls to the bottom of the boiler where it is collected, treated and removed using an ash conveying system. The ash is conveyed hydraulically, pneumatically, and/or

mechanically, and many ash handling systems use a mechanical conveyor, either directly below the boiler, or at a remote location, for treating and disposing of the ash. Historically, power companies have used water ponds at the remote location to store the ash. However, in view of anticipated regulations to be issued by the Environmental Protection Agency due to recent pond spillages, dewatering bins or dewatering ash conveyors are more commonly being proposed and used to eliminate existing ash ponds.¹¹ As discussed further below, Opposer and Applicant are competitors who offer similar goods and provide corresponding services related to ash conveying systems. However, our focus is on Applicant's services identified in the two classes of the challenged application, as any goods which Applicant may sell, or other services it may provide, are not at issue in this case.

V. Descriptiveness

The first issue we consider is whether Applicant's ASHCON mark is merely descriptive. Section 2(e)(1) of the Lanham Act provides that a trademark may be refused registration if it consists of a mark that "when used on or in connection with the goods of the applicant is merely descriptive" of the goods. 15 U.S.C. § 1052(e)(1). A term is merely descriptive within the meaning of § 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods or services with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987).

¹¹ Mooney Testimony Transcript, pp. 9:20-10:7 (61 TTABVue 11-12).

Opposer contends ASHCON is a composite mark that is merely descriptive. Although we must consider the issue of descriptiveness by looking at the mark in its entirety, we begin by first examining the meaning of each component individually, then determining whether the mark as a whole is merely descriptive. *See DuoProSS Meditech Corp. v. Invivo Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1758 (Fed. Cir. 2012); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records noting “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application”).

Turning to “ASH” as the first “term” in the mark, we look to dictionary definitions to help in determining the commonly understood meaning. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1832-33 (Fed. Cir. 2007) (dictionary definitions are a source of evidence as to descriptiveness). Here, the “ASH” component of the mark is defined as “the solid residue left when combustible material is thoroughly burned or is oxidized by chemical means.”¹² In view of this definition, there can be no dispute that the term “ash” is descriptive of Applicant’s consulting services in the fields of “custom manufacturing of industrial equipment for bottom *ash* dewatering systems” and the “design and development of bottom *ash* dewatering systems.” (emphasis added).

¹² Opposer’s First Notice of Reliance: Printed Publications, Opp. Ex. 1, *Merriam-Webster’s Collegiate Dictionary* (10th ed. 2001) (48 TTABVue 2-3, 12-15).

Considering the second part of the mark, Opposer contends that “CON” is descriptive because it refers to “conveyor,” that Applicant’s decision to use “CON” in that manner is consistent with Applicant’s historical use of “CON” in other terms it uses to likewise refer to “conveyor,” and that third parties use “CON” to refer to “conveyor.” In other words, according to Opposer, Applicant has “simply combined two words that each describe a characteristic or feature of Applicant’s services and that together describe the purpose or function of Applicant’s services.”

Opposer relies on testimony from Applicant’s employees that “CON” refers to “conveyor,” and notes that Applicant’s promotional materials likewise reflect the descriptive nature of the composite ASHCON.¹³ Applicant’s employees’ testimony that “CON” was meant to mean conveyor,¹⁴ without more, does not mean that “CON” is descriptive. Rather, a term is merely descriptive within the meaning of § 2(e)(1) if it *immediately* conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods or services with which it is used. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 3 USPQ2d at 1009-10.

In support of its position, Opposer argues that the term “CON” is composed of the first three letters of the word “conveyor,” and Applicant’s employees responsible for including “CON” in the ASHCON mark considered the potential connotation of

¹³ Opp. Brf., p. 33 (79 TTABVUE 34).

¹⁴ Tempesta Deposition Transcript “Trade Secret Commercially Sensitive,” Opp. Ex. 20, pp. 29:5-23, 37:3-9, 59:23-60:13, 78:5-8 (47* TTABVUE 748, 752, 754, 755, 760); Schwade Deposition Transcript “Trade Secret Commercially Sensitive,” Opp. Ex. 17, pp. 18:24-19:13, 37:6-9 (47* TTABVUE 730, 736, 737); Grabowski Deposition Transcript “Trade Secret Commercially Sensitive” Opp. Ex. 23, pp. 38:24-39:6, 39:18-40:6 (47* TTABVUE 773, 781); Mooney Deposition Transcript “Trade Secret Commercially Sensitive,” Opp. Ex. 25, p. 14:9-13 (47* TTABVUE 848, 852).

“ash + conveyor” as a factor when adopting the mark.¹⁵ Even if the foregoing were so, it does not establish that “CON” means or is readily understood as a shortened replacement for the word “conveyor.” In fact, Applicant’s witnesses testified that “con” is not a thing or word that describes anything as it has no meaning of its own, they have never heard “con” used as an abbreviation for conveyor, and none of its customers calls Applicant to order a “con.”¹⁶

Applicant’s witnesses note further that the term “con” contains the same three letters as many other terms, several of which are related to the industry, for example, “concrete,” “conversion,” “control,” “concurrent” or “continuous.”¹⁷ There is no evidence showing that “con” is the recognized condensed form of any of these words, or a formative of the word conveyor, which is clearly a relevant term in this case. Nor is there evidence that “con” would be readily understood in the industry as referring to any such word. Thus, “con” does not possess a descriptive meaning with respect to Applicant’s services.

Opposer also argues that Applicant’s use of “CON” in ASHCON is consistent with Applicant’s historical use of “CON” in other terms it uses to likewise refer to “conveyor” (*e.g.*, DRYCON, DELCON, DELTA/DUCON and DUCON), and with

¹⁵ Decl. of Ronald Tempesta, Opp. Ex. 13, ¶ Nos. 4, 6, 7, 16, (48 TTABVUE 692, 695); Schwade Deposition Transcript “Trade Secret Commercially Sensitive” Opp. Ex. 17, pp. 45:24-46:4 (47* TTABVUE 730, 740-741); Tempesta Discovery Deposition “Trade Secret Commercially Sensitive” Opp. Ex. 20, pp. 59:23-60:13, 78:1-8 (47* TTABVUE 748, 755, 760); Grabowski Discovery Deposition “Trade Secret Commercially Sensitive” Opp. Ex. 23 pp. 39:18-40:6 (47* TTABVUE 773, 781).

¹⁶ Tempesta Testimony Transcript p. 21:13-18 (76 TTABVUE 23); Grabowski Testimony Transcript pp. 27:23-28:5 (63 TTABVUE 29-30); Schwade Testimony Transcript p. 17:3-11 (60 TTABVUE 25); Mooney Testimony Transcript pp. 18:18-19:4 (61 TTABVUE 20-21).

¹⁷ See for example, Tempesta Testimony Transcript p. 24:19-23 (76 TTABVUE 26).

third parties' use of "CON" to refer to "conveyor" (e.g., POWERCON, BEV-CON, and SPIR-A-CON).¹⁸ Upon consideration, neither of these arguments supports Opposer's conclusion that the ASHCON mark is merely descriptive.

Applicant has registered the marks DRYCON for a dry ash conveyor,¹⁹ and DELTA/DUCON²⁰ and DUCON,²¹ for ash conveyors. At minimum, each of these registered marks possesses a statutory presumption of validity which is not challenged in this proceeding. Additionally, a number of other companies have also used "CON" as part of a mark in connection with conveying equipment or conveyors, including, POWERCON,²² BEV-CON²³ and SPIR-A-CON.²⁴ Rather than establishing that ASHCON is merely descriptive, these marks demonstrate that the ASHCON mark functions as a trademark. That ASHCON contains the letters "-con" which are the same letters forming the beginning of the descriptive words "convey" or "conveyor" is not enough for us to reach the conclusion that the ASHCON mark as a whole is merely descriptive. At minimum, Opposer must show that "-con" is commonly used or recognized as meaning "convey/conveyor" or that it describes an

¹⁸ Opp. Brf., pp. 21 and 33 (79 TTABVUE 22, 34).

¹⁹ U.S. Registration No. 4,258,274; Opp. Ex. 11 (48 TTABVUE 586-589); Ex. Applicant-1 (60 TTABVUE 2).

²⁰ U.S. Registration No. 2,630,430; Ex. Applicant-2 (60 TTABVUE 3).

²¹ U.S. Registration No. 2,777,192; Ex. Applicant-7 (60 TTABVUE 7).

²² Moskal Ex. 47 at DP 001472 (57 TTABVUE 74); also see Opp.'s Brf. p. 21 (79 TTABVUE 22).

²³ Moskal "Confidential" Testimony Transcript p. 119:13-20 (55* TTABVUE 122); Moskal Opp. Ex. 47 at DP 001459 (57 TTABVUE 61), also see Opp.'s Brf. p. 21 (79 TTABVUE 22).

²⁴ Moskal "Confidential" Testimony Transcript pp. 117:15-25 (55* TTABVUE 120); Moskal Ex. 47 at DP 001461-62 (57 TTABVUE 63-64), also see Opp. Brief p. 21 (79 TTABVUE 22).

ingredient, characteristic, function, feature, purpose or use of the goods or services. Short of such evidence, we find that “CON” is at most suggestive of convey/conveyor particularly where it is used as the second syllable of the ASHCON mark.

Neither do the cases cited by Opposer support the descriptiveness of the ASHCON mark. *In re Petroglyph Games Inc.*, 91 USPQ2d 1332 (TTAB 2009), involved the registrability of the term “Battlecam.” Because there was sufficient dictionary and other evidence on which to conclude that “battle” and “cam” would be viewed as descriptive terms when considered in conjunction with applicant’s goods, and because the combination of terms did not result in a composite that altered the meaning of either of the elements, refusal on the ground of descriptiveness was found to be appropriate. *Id.* at 1341. Similarly, in *In re Finisar Corp.*, 78 USPQ2d 1618, 1623 (TTAB 2006), the evidence showed that the terms “smart” and “SFP” were merely descriptive of applicant’s goods and, when combined to form the proposed SMARTSFP mark, did not present a unique or incongruous meaning. And, in *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1755 (TTAB 1991), the evidence established that the applied for mark “Multi-Vis” “immediately, and without conjecture or speculation, describe[d] the nature of applicant’s [‘multiple viscosity’ motor oil] goods.” The evidentiary showings made in those cases is very different from this case where there is little, if anything, that supports the meaning of “con” or more importantly, the meaning of Applicant’s ASHCON mark as a whole.

Applicant has not simply combined two words that each describe a characteristic or feature of Applicant’s services and together describe the purpose or function of

Applicant's services. While "ASH-" has a merely descriptive meaning for the use of the term in the industry, the "-CON" portion of Applicant's mark has no established meaning in the industry and there is no evidence that it is used in the industry as an abbreviated term for "conveyor."²⁵ Additionally, there is no evidence that customers in the industry would understand "CON" to be merely descriptive of a conveyor. Although customers might be able to figure out that the "CON" portion of the ASHCON mark was derived from the word "conveyor," the process of recognizing that derivation requires some thought, which is the essence of a suggestive mark. If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978); *see also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

Therefore, while the term "ash," as used in the ASHCON mark, is descriptive of Applicant's services regarding the custom manufacturing, design and development of bottom ash dewatering systems, there is no evidence that the ASHCON mark as a whole is descriptive of its services, and accordingly, this claim is dismissed.

²⁵ Schwade Testimony Transcript p. 17:1-11 (60 TTABVUE 25); Mooney Testimony Transcript pp. 18:13-19:10 (61 TTABVUE 20-21); Grabowski Testimony Transcript pp. 27:23-28:5 (63 TTABVUE 29-30); Tempesta "Confidential" Testimony Transcript p. 21:13-18 (66* TTABVUE 23).

VI. Likelihood of Confusion

Our determination under § 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We considered these and all other *du Pont* factors on which the parties have submitted evidence or argument.

A. The Family of Marks Argument

Opposer's various ASH marks have been used and registered "for a variety of waste disposal and material handling equipment for power plants, including ash conveying systems and various parts and fittings therefor." Opposer has also provided consulting, design, development and manufacturing services relating to the handling systems it sells.²⁶ In view of the foregoing, Opposer asserts that it has a family of ASH Marks stemming from its uses of "ASH" in connection with a variety of different goods and services, contending it has done its best to "establish

²⁶ Moskal "Confidential" Testimony Transcript pp. 17:14-22:24 (55* TTABVUE 20-25); Opp. Brf., p. 11 (79 TTABVUE 12).

the collection of trademarks as a family that refer one to another and build upon the name recognition of the company Allen-Sherman-Hoff.”²⁷

Opposer essentially argues that it has a family of ASH marks because it uses ASH in connection with a variety of different marks. That Opposer has used and registered numerous marks incorporating the descriptive term “ASH” is not in itself sufficient to establish the existence of a family of marks. Opposer has not shown that it has used and promoted together a group of ASH marks. Nor has it shown that the ASH component of its various marks is used in a consistent manner, as a prefix, as a suffix, or in some other uniform way. There must be evidence establishing recognition among the purchasing public that the common “ASH” characteristic of the marks is indicative of a common origin of the goods and services. Although Opposer’s registrations for several of its ASH Marks are in the record along with some evidence establishing use of the marks, such evidence is insufficient to support a finding that “the pattern of usage of the common element is sufficient to be indicative of the origin of the family.”²⁸ *J & J Snack Foods v. McDonald’s*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991)); *see also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009).

²⁷ Moskal “Confidential” Testimony Transcript p. 74:1-7 (55* TTABVUE 77).

²⁸ In light of Opposer’s failure to prove it has advertised and used its ASH Marks as a family of marks, we need not reach the issue of whether the descriptive term “ASH” used as an initial prefix, *i.e.*, “ASH-”, and “-ASH” used as a suffix, are sufficiently distinctive to serve as the basis for a family of marks.

Thus, the record does not contain the necessary evidence to support the existence of a family of Opposer's ASH Marks.²⁹

Therefore, we look to Opposer's individual marks in considering Opposer's likelihood of confusion claim. We find Opposer's registered marks ASHCORE and ASHCOLITE to be the most relevant of Opposer's pleaded marks for our *du Pont* analysis. If we find a likelihood of confusion as to these two marks, we need not find it as to the others. On the other hand, if we do not reach that conclusion, we would not find it as to the other less-similar registered marks. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

B. Similarity of Goods/Services, Trade Channels and Customer Sophistication

1. Similarity of Goods/Services

We begin by considering the second *du Pont* factor, namely, the similarity of the goods and services. The services covered by Applicant's ASHCON application are the design, development and custom manufacture of industrial equipment for power plant bottom ash dewatering systems. Although Applicant's witnesses testified that its services pertain "generally to ash handling systems for coal-fired power plants

²⁹ In its defense, Applicant asserts ownership of a family of marks ending in "-CON," referring to its DUCON, DELTA/DUCON and DRYCON registered marks. App. Brf., p. 22 (82 TTABVUE 27). Aside from Applicant not providing sufficient evidence to establish its ownership of a family of "-CON" marks, a family of marks does not serve as a defense to a likelihood of confusion claim. Rather, it is a claim that a plaintiff, or counterclaim-plaintiff, may assert. *Cf. Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1051-52 (TTAB 1992); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ 1733, 1736-37 (TTAB 2001).

and, more specifically, to a remote submerged scraper conveyor,”³⁰ in this proceeding we must base our evaluation on the services more broadly recited in its application. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The parties have entered into a Stipulation that they “share common customers (existing) and prospective customers with regard to the goods and services to be sold by Applicant under the ASHCON mark, and the goods and services sold by Opposer under the marks referred to in ¶ 3 of the Notice of Opposition.”³¹ In view of this Stipulation, Opposer’s various ASH Marks are associated by the parties’ common consumers with a wide variety of Opposer’s goods and services, all of which are complementary.

Thus, the issue to be determined is whether the products and services marketed under Opposer’s marks, particularly its ASHCORE and ASHCOLITE marks, are so related to Applicant’s services as to be likely to cause confusion among customers and potential customers presented with Applicant’s ASHCON mark.

The evidence confirms that Opposer’s ASHCORE mark is used for “ceramic lined steel piping and fittings therefor for the transport of abrasive materials;”³² and its ASHCOLITE mark is used for “special castings, namely cast pipe and fittings

³⁰ Schwade Testimony Transcript p. 6:12-22 (60 TTABVUE 14) and Mooney Testimony Transcript pp. 7:7-9:16 (61 TTABVUE 9-11); App. Brf., p. 2 (82 TTABVUE 7).

³¹ Opp. Ex. 16, Stipulations, Stipulation No. 3, (48 TTABVUE 727-29). The marks referred to in ¶ 3 of the Notice of Opposition are the ASH Marks.

³² Registration No. 2,444,743 (48 TTABVUE 154-158).

therefor.”³³ As established by Opposer’s testimony and exhibits, the ASHCORE and ASHCOLITE marks are used on pipes and fittings for pneumatic and hydraulic ash handling systems used at power plants.

In promotional materials for Opposer’s ash handling systems and parts promoted under its ASH Marks, including ASHCORE and ASHCOLITE, Opposer has advertised its “leading name in the design, manufacture and service of ash-handling and boiler-cleaning systems” since prior to Applicant’s April 22, 2010 filing date,³⁴ as well as its custom design and engineering services.³⁵

Notably, Opposer’s annual revenue runs in the several tens of millions of dollars and sales of Opposer’s ASHCOLITE pipe and ASHCORE piping and fittings comprise as much as 14% of its annual revenue. While Opposer states “. . . the percentage that comes from the trademarked pieces is not particularly high,” it also explains “those are the tipping point kind of products that -- that drive a selection of Allen-Sherman-Hoff versus one of [its] competitors.”³⁶ Thus, Opposer places high

³³ Registration No. 774,841 (48 TTABVUE 221-223). *See* note 2; ASHCOLITE has been in use since the 1940’s. Moskal “Confidential” Testimony Transcript p. 56 (55* TTABVUE 59).

³⁴ *See* for example, Moskal Exs. 19 (© 2006) (55* TTABVUE 305-310) and 21 (© 2004) (55* TTABVUE 334-341).

³⁵ Opp. Ex. 16, Stipulations, Stipulation No. 3, (48 TTABVUE 727-29). *See* for example, Moskal “Confidential” Testimony Transcript pp. 74-76 (55* TTABVUE 77-79) and Ex. 34, DP000029-32, (56* TTABVUE 11-14) copies of trade ads showing use of “www.a-s-h.com,” “1.888.ASH.PARTS,” and “A-S-H sales representative;” Ex. 33, DP000101-102, (56* TTABVUE 5-6) “DenseASH™ system” brochure mentioning “Custom-designed, PLC-based control systems with optional interface to owned DCS system;” Moskal “Confidential” Testimony Transcript pp. 76-77, (55* TTABVUE 79-80) and Ex. 13, DP000107-108 (55* TTABVUE 298-99) “ASHvac™ Segregating Valve & ASHandler™ Valve” brochure mentioning “A-S-H™ Vacuum Conveying System,” “For engineered solutions to your specific ash handling needs . . .,” “www.a-s-h.com,” “Call: 1-888-ASH PARTS.”

³⁶ Moskal CONFIDENTIAL Testimony Transcript pp. 93-94 (55 TTABVUE 96-97).

emphasis on trademarked product names and recognition because it facilitates the sale of its larger engineered systems³⁷; and we reiterate that the parties have stipulated to having common customers for their goods and services.

Applicant provides engineering services to figure out which products and what size of those products to include in its proposals.³⁸ Any slurry pipeline, including Opposer's ASHCOLITE pipes, could be connected to transport slurry that is pumped to Applicant's ASHCON remote submerged scraper conveyor.³⁹ Applicant's ASHCON design, development and custom manufacturing services for bottom ash dewatering systems could be rendered to place Applicant's ASHCON remote dewatering unit as the last part of an ash conveying system that includes Opposer's line of goods bearing the ASH Marks:

Q. If one were to be installed to retrofit an existing Allen-Sherman-Hoff material handling system, would maintenance personnel be presented with both ASHCON conveyor right next to an ASHCOLITE piping or ASHcore piping?

A. They would be -- they would be right in line with one another, adjacent to one another. And, in fact, you could even say that it would become an integral part of the system that goes from the pickup point to the ultimate discharge point, because it would be a continuous flow of material from one end to the other. And it would -- it would go through one component after another after another, and ultimately the last thing in line would be the

³⁷ Moskal CONFIDENTIAL Testimony Transcript p. 93 (55 TTABVUE 96).

³⁸ Mooney "Confidential" Discovery Deposition, Opp. Ex. 25, pp. 50:24-51:5 (47* TTABVUE 857).

³⁹ Mooney "Confidential" Discovery Deposition, Opp. Ex. 25, p. 51:6-13 (47* TTABVUE 857).

remote dewatering unit. And if it were by Clyde Bergemann, it would be the ASHCON.⁴⁰

Thus, there is little, if any, doubt that Applicant's design, development and custom manufacture of industrial equipment for bottom ash dewatering systems is directly related to Opposer's ASHCORE and ASHCOLITE piping and fittings, insofar as the involved goods and services are complementary.

Opposer's products and services are so closely related to Applicant's services that customers confronted with similar marks therefor would be apt to assume a common source or sponsorship. It is well recognized that a "relatedness" which bespeaks likelihood of confusion may occur not only where goods are involved but can exist between products on the one hand and services dealing with or related to those products on the other hand. *Safety-Kleen Corp. v. Dresser Industries, Inc.*, 186 USPQ 476, 480 (CCPA 1975) (cleaning equipment components and cleaning apparatus leasing services); *In re H. J. Seiler Co.*, 129 USPQ 347, 347 (CCPA 1961) (food products and restaurant catering services); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639-40 (TTAB 2007) (cosmetic products and retail women's clothing store); *MSI Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 655, 658 (TTAB 1983) (computer hardware manufacturing services and electronic ordering systems for gathering and transmitting source data comprising a recorder-transmitter and data receiver); *Corinthian Broadcasting Corp. v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (television picture transmitters and receivers, and television broadcasting services); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433,

⁴⁰ Moskal "Confidential" Testimony Transcript pp. 114:12-115:14 (55* TTABVUE 117-118).

435 (TTAB 1983) (refinishing of furniture, office equipment and machinery for others, and a variety of office furniture and accessory items and spray paints); *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983) (solar heating systems and solar energy engineering/consulting services).

Applicant's services are likely to be encountered by the same persons at the power plants who deal with Opposer's goods. The parties' stipulation that they have the same customers does not leave any doubt about this. Thus, Opposer's customers may reasonably assume, upon encountering Applicant's services under the ASHCON mark, that such services are related to Opposer's ASHCORE and ASHCOLITE products and associated services because of the similarity of the marks.⁴¹ It is sufficient for our determination of likelihood of confusion that we find some relationship between the involved goods or services and/or that circumstances surrounding their marketing would cause them to be encountered by the same persons who might, because of the similarity of the marks, mistakenly believe that they have a common origin or are somehow associated with the same producer. *See Mine Safety Appliances Co. v. Management Science America, Inc.*, 212 USPQ 105, 108 (TTAB 1981); *Monsanto Company v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978).

Thus, Opposer's products, taken together with the services provided in close connection therewith, and Applicant's services, are related enough in character that

⁴¹ Opp. Ex. 16, Stipulations, Stipulation No. 3, (48 TTABVUE 727-29).

customers confronted with similar marks therefor would be likely to assume a common source or sponsorship.

2. Similarity of Trade Channels and Class of Customers

Both parties view the relevant market for Opposer's goods and services, and Applicant's identified services, to be the electric power utility industry.⁴² More importantly, the parties stipulated that they "share common customers (existing) and prospective customers with regard to the goods and services to be sold by Applicant under the ASHCON mark, and the goods and services sold by Opposer under the marks referred to in ¶ 3 of the Notice of Opposition."⁴³ Therefore, the goods and services are provided in the same trade channels to the same customers. Indeed, the parties are direct competitors competing for the same customers.⁴⁴

In view of the foregoing, we find that Opposer's goods and services, and Applicant's services, travel in the same channels of trade and are sold to the same classes of customers, supporting a likelihood of confusion.

3. Sophistication of Customers

The fourth *du Pont* factor is the conditions under which and buyers to whom sales are made, *i.e.*, "impulse versus careful, sophisticated purchasing." *du Pont*, 177 USPQ at 567. Given the nature of the goods and services provided by Opposer and the services of Applicant, and the regulated nature of the industry in which they operate, we conclude the purchasers of the services and goods involved in this

⁴² Opp. Brf., p. 13 (79 TTABVUE 14); App. Brf., p. 19, 27 (82 TTABVUE 24, 32).

⁴³ Opp. Ex. 16, Stipulations, Stipulation No. 3, (48 TTABVUE 727-29).

⁴⁴ Moskal "Confidential" Testimony Transcript p. 99:4-7; p. 104:18-25 (55* TTABVUE 102, 107).

case likely are sophisticated. However, this fact alone does not necessarily serve to preclude confusion where the marks are similar and used on competitive goods and services. The law has long recognized that even careful purchasers who are sophisticated or knowledgeable in a particular field are not necessarily sophisticated or knowledgeable in the field of trademarks or immune from source confusion, especially in cases such as the instant one involving related services and goods. *See In re Research and Trading Corp.*, 230 USPQ 49, 50 (Fed. Cir. 1986); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988) (being knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks); *Wm. K. Stamets Co. v. Metal Products Co.*, 176 USPQ 92, 93 (TTAB 1972) (even technically trained purchasers who are extremely familiar with expensive machinery may be confused when similar marks are used with respect to the same goods).

In view of the foregoing, this *du Pont* factor is neutral.

C. Similarity of the Marks

As set forth above, the definition of “ash” is “the solid residue left when combustible material is thoroughly burned or is oxidized by chemical means.”⁴⁵ Thus, with respect to the goods and services involved in this case, “ash” refers to the

⁴⁵ Opposer’s First Notice of Reliance: Printed Publications, Ex. 1 (48 TTABVUE 2-3, 12-15).

combustion residue generated by the power plants.⁴⁶ Although the term “ash” would have the same connotation as used in the parties’ respective marks, this finding is not determinative of whether there is a likelihood of confusion between Opposer’s ASHCORE and ASHCOLITE marks that begin with “ASH” and Applicant’s ASHCON mark. The marks to be compared must be considered in their entirety.

Both parties’ marks are single-word marks that have “ash” as their first syllable. Like ASHCON, the ASHCORE mark is two syllables and shares the same first five letters with the ASHCON mark. ASHCOLITE also shares the same first five letters. All three of these marks begin with the common sound of ASH followed by a hard “C” sound. Thus, Opposer’s ASHCORE and ASHCOLITE marks, and Applicant’s ASHCON mark, are single terms comprising two (or three) syllables that begin with “ash,” followed by a hard “C” sound, making them similar in sound and appearance when compared in their entirety.

Applicant discredits the similarities between its ASHCON mark, and Opposer’s ASHCORE and ASHCOLITE marks, arguing the likelihood of confusion assessment must focus on each mark taken as a whole “*relying more* on the non-generic ‘dominant element’ that is combined with ASH in each instance.”⁴⁷ Applicant’s argument misses the point. The ultimate issue is whether the marks, as applied to the respective services and goods, so resemble each other that there is a likelihood of confusion as to source. Because of the similarity in overall visual and aural

⁴⁶ Opp. Ex. 14, Applicant’s Responses to Opposer’s First Set of Interrogatories, Response No. 16 (48 TTABVUE 710, 715); Moskal “Confidential” Testimony Transcript, p. 17:16-18, 23-25; p. 20:22-25 (55* TTABVUE 20, 23).

⁴⁷ App. Brf., p. 25 (82 TTABVUE 30).

impression of the ASHCON mark and the ASHCORE mark, as well as the ASHCOLITE mark, customers would likely assume the respective services and goods to be involved in ash conveying and produced by the same source.

D. The Variety of Goods/Services on Which Mark is Used

Despite the fact that Opposer has not shown that its ASH Marks collectively constitute a family of marks, it argues that its “longstanding use of its ASH Marks requires that due consideration be paid to the ‘ash’ component.”⁴⁸ Customers who may be familiar with various products and related services in Opposer’s established product line, as covered by its registrations and the common law uses shown in the record, when confronted with Applicant’s ASHCON mark for related services, would be likely to view the services marked therewith as services offered by Opposer.

One of the circumstances mentioned in the ninth *du Pont* factor is the variety of goods on which a prior mark is used. *See, e.g., In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001) (use on a wide variety of goods weighs in favor of likelihood of confusion). This factor assesses the variety of goods provided under the same mark. Applying a similar concept to the circumstances presented in this case involving not a single mark but at least two marks having a common form of construction to Applicant’s mark (*i.e.*, forming a single word mark), it is likely that customers, when encountering related services such as those marketed by Applicant under the ASHCON mark, would assume that a source, sponsorship or other connection to Opposer exists. *See In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774

⁴⁸ Opp. Brf., p. 30 (79 TTABVUE 31) and Reply Brief, p. 4 (84 TTABVUE 6).

(TTAB 2014). Thus, we find that the ninth *du Pont* factor weighs in favor of finding a likelihood of confusion in this case.

E. Number and Nature of Similar Marks in Use on Similar Goods/Services

In its attempt to distinguish its ASHCON mark from Opposer's ASHCORE and ASHCOLITE marks, Applicant contends that the extensive use of ASH-combination marks in the industry "conclusively establish[es] that confusion is unlikely."⁴⁹ According to Applicant, the weakness of Opposer's two marks limits them to a narrow scope of protection that does not encompass Applicant's mark. In support of its position regarding the alleged weakness of Opposer's two marks, Applicant points to several unregistered and registered "ASH-combination" marks made of record that are "in use in the relevant industry."⁵⁰ Applicant argues the third-party ASH-combination marks evidence widespread third-party use of the term "ash" for similar goods and services. According to Applicant, the "great many ASH-combination marks in use in the relevant industry" indicates no one party is entitled to exclusive use of "ash" and requires that Opposer's marks be narrowly construed such that confusion is unlikely.⁵¹

As to the third-party "ash" marks noted by Applicant, we focus our attention on those marks that begin with the term "Ash" which are most similar to the format of

⁴⁹ App. Brf., p. 28 (82 TTABVUE 33).

⁵⁰ App. Brf., pp. 19, 21-22, 28 (82 TTABVUE 24, 26-27, 33).

⁵¹ See App. Brf., p. 28 (82 TTABVUE 33).

Applicant's ASHCON mark, and of Opposer's ASHCORE and ASHCOLITE marks; and there are only two such marks.

Applicant argues that the term "AshTech" is "particularly relevant because it is used in connection with bottom ash handling systems that compete directly with the ASHCON solution."⁵² Although AshTech is the name of an ash handling company that sells ash handling products and services,⁵³ there is no evidence that it sells the "same solution or the same product" like the ASHCON or Opposer's remote submerged chain conveyor product,⁵⁴ or that AshTech's products are sold under the trademark "AshTech."⁵⁵

Next, Applicant points to ASHCOR which is used by a company named ASHCOR Technologies Ltd. in connection with the remarketing of fly ash obtained from power plants "and according to its website has been in use in the relevant industry for about 15 years."⁵⁶ However, there is no other support for the length of time the ASHCOR name has been used. Pages from a website are not evidence of the truth of the matters asserted therein.⁵⁷ Moreover, Applicant offered testimony that the ASHCOR "technology is for converting ash into a salable product, but in doing so, of

⁵² App. Brf., p. 21 (82 TTABVUE 26).

⁵³ Grabowski Testimony Transcript p. 7:20-25 (63 TTABVUE 9); Schwade Testimony Transcript p. 12:11-18 (60 TTABVUE 20).

⁵⁴ Moskal "Confidential" Testimony Transcript p. 194:3-16 (55* TTABVUE 197).

⁵⁵ App. Brf., pp. 7, 9, 21 (82 TTABVUE 12, 14, 26); App. Ex. 16 (63 TTABVUE 69); Moskal "Confidential" Testimony Transcript p. 136:10-16 (55* TTABVUE 139).

⁵⁶ App. Brf. p. 7 (82 TTABVUE 12); App. Ex. 17 (63 TTABVUE 68).

⁵⁷ Documents printed from the internet have little probative value. They are admissible only to show what has been printed, not the truth of what has been printed. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010).

course, they handle ash, move ash, convey ash sometimes.” Essentially, ASHCOR Technologies Ltd. is involved in “ash marketing.” It takes waste ash and tries to find beneficial uses for it, or disposes of it for the plant.⁵⁸ Thus, its business is only tangentially related to the parties’ goods and services.

Even if AshTech and ASHCOR are used as company names or trademarks, the testimony of the witnesses regarding the actual use of these names is vague. Moreover, it has not been shown that they are engaged in providing the same products or services as either Applicant’s ASHCON services, or Opposer’s products sold under its ASHCORE and ASHCOLITE marks, its remote submerged chain conveyor or its related services.

Turning to third-party registrations on which Applicant relies, there are only five of these, and three of the five registered marks do not share the same structure as the marks of Opposer and Applicant insofar as they are not compound words with ASH as the first part, but instead are multiple word marks.⁵⁹ Further, we note that third-party *registrations* are not evidence that the marks depicted therein are in actual use in the marketplace or that the relevant public is aware of them. *See Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *Smith Brothers Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ

⁵⁸ Grabowski Testimony Transcript pp. 11:5-21, 36:7-23, 38:1-10 (63 TTABVUE 13, 38, 40).

⁵⁹ The five registered marks are ASK KLEEN, ASH*FLUX, ASH PUMP, ASHSCAN and ASHLOW. The evidence in this case differs from that in *Juice Generation, Inc. v. GS Enters. LLC*, which included a substantial number of third-party marks incorporating the phrase “peace and love” in connection with related services and products, the bulk of which were three-word phrases much like Juice Generation’s mark. *Juice Generation, Inc. v. GS Enters. LLC*, ___ F.3d ___, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the USPTO); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011).

Even considering the registered third-party marks that have “ASH” as their first syllable, they do not support allowing registration of Applicant’s mark. The ASH KLEEN and ASH*FLUX trademarks were registered for combustion additives which are different in nature than the physical parts and equipment, and related services, provided by Opposer and Applicant. Additionally, these marks were registered as two separate words, with “ash” being disclaimed. Moreover, Applicant testified through its witness Mr. Grabowski that it does not compete with Chemex Solutions, the owner of the ASH KLEEN mark, thinks the last time it saw the mark was “within a year or two, something like that” and does not even know if the mark was in use at the time of Applicant’s testimony.⁶⁰ As to ASH*FLUX, the registration for this mark was cancelled on December 13, 2003, due to failure to file the § 8 declaration.⁶¹ Similarly, the testimony regarding the ASH*FLUX mark was that it was in use “within five years.”⁶² This evidence is too vague for us to draw any conclusions regarding the usage of these marks.

⁶⁰ ASH KLEEN (Reg. No. 4,018,594), App. Ex. 12 (62 TTABVUE 9); App. Brief p. 6, ¶ 21 (82 TTABVUE 11); Grabowski Testimony Transcript pp. 17:14-18:11; 45:24-46:3 (63 TTABVUE 19-20, 47-48).

⁶¹ We take note of the status of Registration No. 1,756,309 for the mark ASH*FLUX as cancelled on December 13, 2003.

⁶² ASH*FLUX (Reg. No. 1,756,309), App. Ex. 12, (62 TTABVUE 14); App. Brief p. 7, ¶ 27 (82 TTABVUE 12); Grabowski Testimony Transcript pp. 20:12-21:7 (63 TTABVUE 22-23).

ASH PUMP is a mark that was used many years ago by Opposer. Opposer subsequently sold its pump division, transferring the ASH PUMP mark as part of the sale. Eventually, Weir Slurry Group, Inc. acquired that pump business and the ASH PUMP trademark which was only later registered. Weir Slurry Group is now supplying ASH PUMP products to original equipment manufacturers like Opposer. Although Applicant does not purchase ASH PUMP products, Applicant sees the ASH PUMP mark used in inquiries and quotation requests received from customers and architectural engineering firms.⁶³ Like the ASH KLEEN and ASH*FLUX marks, ASH PUMP employs “ASH” as the first word of a *two* word mark. Additionally, lacking the “CO_” syllable that follows ASH in both Applicant’s and Opposer’s marks, ASH PUMP differs significantly more from ASHCOR and ASHCOLITE in sight, sound, meaning, and overall commercial impression than does ASHCON.

The remaining marks, ASHSCAN and ASHLOW, are registered for products having different purposes than Opposer’s and Applicant’s goods and services. ASHSCAN is registered by Kanawha Scales & Systems, Inc. for equipment for in-line analyzing and measuring of ash content in coal. While Applicant has seen the ASHSCAN mark, there is no credible testimony supporting how the mark has

⁶³ ASH PUMP Reg. No. 2,683,128, App. Ex. 12 (62 TTABVUE 13); App. Br. p. 6, ¶ 26 (82 TTABVUE 11); Grabowski Testimony Transcript pp. 19:21-20:11; 50:19-24; 51:18-52:7 (63 TTABVUE 21-22, 52, 53-54); Mooney Testimony Transcript pp. 35:9-38:8. (61 TTABVUE 37-40).

actually been used. Moreover, Applicant could only testify that it last saw the mark going back in “that few year time frame.”⁶⁴

Finally, the ASHLOW mark was registered by Voest-Alpine Industrieanlagenbau GmbH, an Austrian company, for machines, apparatus and drives for the forming of metal billets and blooms. Aside from the fact that nothing in the record establishes that such goods compete with those goods and services offered by the parties, Applicant does not know whether the ASHLOW mark is even in use.⁶⁵

Based upon the scant information concerning use of the registered marks introduced by Applicant, the registrations provide little support for the registrability of Applicant’s mark. While the third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they “cannot justify the registration of another confusingly similar mark.” *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). *See also AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them”); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1659 n.20 (TTAB 2002) (“Third-party registrations are not evidence that the marks used therein are in use in commerce

⁶⁴ ASHSCAN Reg. No. 3,438,812; App. Ex. 12 (62 TTABVUE 10); App. Brf. p. 6 (82 TTABVUE 11); Grabowski Testimony Transcript pp. 18:12-19:5; 46:4-6 (63 TTABVUE 20-21, 48); Mooney Testimony Transcript p. 33:3-15 (61 TTABVUE 35).

⁶⁵ ASHLOW Reg. No. 2,742,460, App. Ex. 12 (62 TTABVUE 12); App. Brf. p. 6, ¶ 24 (82 TTABVUE 11); Grabowski Testimony Transcript pp. 19:17-20, 46:12-14 (63 TTABVUE 21, 48); Mooney Testimony Transcript pp. 34:12-35:8; 69:10-13 (61 TTABVUE 36-37; 71).

or that the public is familiar with them, for purposes of the sixth *du Pont* factor.”). Given the scant and vague testimony regarding the actual use of these registered marks and the differences in the goods, these third-party registrations shed little, if any, light on determining likelihood of confusion between the ASHCON mark and Opposer’s ASHCORE and ASHCOLITE marks.

In view of the foregoing, the third-party marks noted by Applicant are of little probative value as to the asserted weakness of Opposer’s ASH Marks. Accordingly, we find that the sixth *du Pont* factor relating to the number and nature of similar marks in use on similar goods to be neutral in this case.

F. Balancing the Factors

Considering all of the relevant factors for the reasons discussed, we conclude that when viewed in their entirety, there is a likelihood of confusion between Opposer’s ASHCORE and ASHCOLITE marks, and Applicant’s ASHCON mark. Opposer’s two marks are for products that are utilized in ash handling conveyor systems which is the same market for which Applicant’s ASHCON services are intended. Moreover, Opposer’s marks are used in connection with similar services provided by Opposer. Given the foregoing, there is a close association between Opposer’s ASHCORE and ASHCOLITE marks and Applicant’s ASHCON mark, so that when the respective marks are used for the respective goods and services, a likelihood of confusion among consumers exists.

Decision: In view of the foregoing, the Opposition is dismissed on the ground of descriptiveness under § 2(e) and sustained on the ground of likelihood of confusion under § 2(d).

The parties are allowed until thirty (30) days after the issue date of this decision to file revised, redacted versions of the testimony and exhibits consistent with this Opinion, failing which the testimony and exhibits in their entirety will become part of the public record.