

**THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB**

Mailed: March 12, 2007

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Caterpillar, Inc.
v.
Pave Tech, Inc.
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Cancellation No. 92041776
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Edward G. Weirzbicki, Mary E. Innis and Nerissa Coyle McGinn
of Loeb & Loeb LLP for Caterpillar, Inc.

Rebecca Jo Bishop and Michael J. O'Loughlin of Altera Law
Group LLC for Pave Tech, Inc.

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Before Hairston, Walsh and Taylor, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

A petition has been filed by Caterpillar Inc. to cancel
a registration issued to Pave Tech, Inc. for the mark
PAVERCAT, in typed or standard character format, for
"machines and machine parts used to aid in the installation
of segmental pavers."¹

As grounds for cancellation, petitioner alleges that it
is a long-established, multi-national company with business

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¹ Registration No. 2684138, issued February 4, 2003, claiming
first use and first use in commerce on February 23, 2000.

operations in many areas, including the development, manufacture, distribution, marketing and sale of construction and earthmoving equipment including but not limited to mini hydraulic excavators, road reclaimers, asphalt pavers, tractors, and power and manually controlled graders, scarifiers, scrapers, and rippers adapted to be employed for the construction and maintenance of roads; that since long prior to January 28, 2000, the date respondent filed its application for Registration No. 2684138, petitioner adopted and began to use the marks CAT, in typed or standard character form, and CATERPILLAR, in typed or standard character form, and the marks **CAT** and **CATERPILLAR** ("hereinafter collectively referred to as the Caterpillar marks")² in commerce with these goods and services.

Petitioner further alleges that since long prior to January 28, 2000, petitioner has enjoyed substantial sales of its products and services under its Caterpillar marks and has spent substantial sums in advertising and promoting the products and services sold under the Caterpillar marks in the United States; that since long prior to January 28, 2000, the Caterpillar marks became famous; that upon information and belief, neither respondent nor its

² Petitioner has pleaded ownership of eleven registrations for the marks CAT and CATERPILLAR (both with and without design elements) that cover various goods and services in the construction industry.

predecessor or related company made commercial use of the trademark PAVERCAT for the goods identified in Registration No. 2684138 prior to the date respondent filed its application for the registration; and that respondent's use of the trademark PAVERCAT for the identified goods is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of respondent's products.

In its answer, respondent has admitted the allegations contained in paragraphs 8 and 9 of the petition for cancellation, namely that "... neither Respondent nor any predecessor or related company of Respondent made commercial use of the trademark PAVERCAT for the goods identified in Registration No. 2,684,138 prior to January 28, 2000, the date Respondent filed its application for Registration No. 2,684,138" and "Respondent's use of the trademark PAVERCAT is without Petitioner's consent or permission." Respondent otherwise denied the salient allegations of the petition for cancellation. Respondent also has asserted what it characterizes as "AFFIRMATIVE DEFENSES," but are actually amplifications of its reasons why confusion is not likely.

THE RECORD

The record consists of the pleadings; the file of the registration sought to be cancelled; petitioner's testimony depositions, with exhibits, of Kurt D. Tisdale, petitioner's general construction industry division manager and J.

Michael Hurst, one of petitioner's trademark attorneys; and petitioner's notices of reliance on: status and title copies of petitioner's pleaded registrations; certain of respondent's interrogatory answers; and excerpts from the discovery depositions, with exhibits, of respondent's 30(b)(6) witnesses, namely, Stephen Jones, respondent's president, and Robert Cramer, respondent's field services manager.³ Respondent did not take any testimony or submit any other evidence in support of its position.

FINDINGS OF FACT

Petitioner, Caterpillar, Inc., is the world's leading manufacturer of construction equipment, including building construction and compact construction equipment.

Petitioner's CATERPILLAR and CAT marks have been used continuously on construction equipment since 1904 and 1948 respectively. Although initially known in large part for heavy road building and mining equipment, Caterpillar expanded its product line in the 1970's to include a line of smaller equipment known as the building construction compact equipment line. This equipment line includes various types of material handling machines such as skid steer loaders, multi terrain loaders, compact wheel loaders, compact

³ Petitioner also has submitted, under notice of reliance, a copy of the registration file for respondent's PAVERCAT mark. We note, however, that the record includes, without action by petitioner, the file of the registration. See Trademark Rule 2.122(b).

telehandlers, backhoe loaders, small wheel loaders hydraulic elevators, and small track type tractors. Some of petitioner's material handling machines are comparable in price to respondent's machines. (Tisdale dep., p. 7, 12, 24-25).⁴

Petitioner's equipment is sold through a worldwide network of independently-owned dealers, of which 57 are located in North America. Petitioner sells to its dealers, who in turn sell to end users and have their own rental fleet. Petitioner's business includes the CAT Rental Stores, 400 of which are located in North America. The CAT Rental Stores are owned by petitioner's dealers and serve the building construction, landscaping and contractor industries, where they rent on a short-term basis, e.g., daily, weekly and monthly, both petitioner's products and other products, including hand tools, generators and compact construction equipment. (Tisdale dep., p. 14-16).

The CAT trademark was first used in 1948 and is prominently displayed on each of petitioner's products. Several of petitioner's different business arms are branded with the CAT trademark, such as CAT Financial Services Corporation, CAT Logistics and the CAT Rental Store.

⁴ The pricing for petitioner's compact equipment line has been marked confidential.

(Tisdale dep., p. 28). Petitioner also uses the CAT mark in connection with its NASCAR program⁵. (Tisdale dep., p. 47).

Petitioner has extensively promoted its CAT mark through advertisement in trade publications, the distribution of product brochures and newsletters to its customers and potential customers, and on the Internet at www.cat.com. Petitioner's other advertising efforts include the appearance of the CAT mark on all of petitioner's authorized dealer's delivery trucks and through the licensing of its mark to a wide variety of merchandise providers for products such as clothing, boots, golf balls, and scale model replicas. Petitioner also promotes its CAT mark to the general public through its NASCAR program and two television shows, i.e., the Discovery Channel's series "American Chopper" for which the CAT Chopper motorcycle was built and HGTV's "Dream Home" Series which films the construction of a home. Petitioner particularly has promoted its compact equipment line in magazines, direct mail, brochures, radio, television, billboards, trade shows and open house promotions. (Tisdale dep., p. 93-95, Ex. 49). More generally, the CAT Rental Stores advertise in the Yellow Pages, trade magazines, radio, television, on

⁵ The program includes sponsorship of a Winston Cup Series NASCAR racing car, where the CAT design mark is prominently displayed on the hood of the sponsored race car. (Tisdale dep., p. 47).

vehicles and in petitioner's quarterly-published magazine. (Tisdale dep., p. 51-52; Ex. 9).

Although Petitioner's sales figures and advertising and promotional expenditures have been marked "confidential," they are substantial, with the sales figures for petitioner's compact equipment line steadily increasing since 1995. (Tisdale, ex. 67). The sales figures from 1995 through 1999 encompass petitioner's North American operation, while the sales figures from 2000 through 2004 are separated into North American and United States sales.⁶

CATERPILLAR [and CAT] has been named one of America's 80 strongest brands by America's Greatest Brands Inc.⁷ and the 68th most valuable brand in the world by *Business Week*. (Tisdale dep., p. 116-117; Tisdale Exs. 5 and 69).

Petitioner also has an aggressive trademark enforcement program related to its CATERPILLAR and CAT trademarks as well as CAT formative marks.⁸ (Hurst dep. and Exs. 73-75).

⁶ In this regard, we note the vast majority of the Cat Rental Stores are located in the United States.

⁷ In the publication America's Greatest Brands An Insight Into 80 of America's Strongest Brands, Volume 1, ranking "Caterpillar" as one of America's strongest brands, America's Greatest Brand Inc. states, in part, that the CAT and CATERPILLAR brands [marks] are "equally established" and the CAT mark "takes a more dominant position in product promotion and identification." (Tisdale Ex. 5).

⁸ "Cat formative," as used by petitioner, is "any trademark that uses the term "CAT in any type of configuration found in the mark." (Hurst dep., p. 5).

What information we have regarding respondent and its goods was obtained through respondent's responses to petitioner's interrogatories and the discovery depositions, and accompanying exhibits, of its 30(b)(6) witnesses. Respondent, Pave Tech, "originally started as a 1986 corporation as a contractor involved in the installation of segmental paving ... [and] evolved from a construction company to ... a sales and marketing company for construction products." (Jones dep., p. 7-8).

"The PAVERCAT paver installation machine and the PAVERCAT name were first used by PAVE TECH, INC. at the World of Concrete 2000 trade show on February 23, 2000...." (Respondent's Response to Interrogatory No. 3). The only products offered by respondent under the PAVERCAT name are the motorized machine designed to aid in the installation of segmental pavers and accessories offered for use with it. (Respondent's Response to Interrogatory No. 14). The PAVERCAT product is described as a "[j]obsite material handler. Great for light grading, sand and paver transport and sand sweeping." (Ex. 7 to the Jones deposition, submitted as Ex. 72). The PAVERCAT product is further described as a "Universal Machine ... that can be fitted with a hydraulic paver clamp, a sand bucket, a sand broom, a rotary sand/cleaning brush and many other attachments for

the handling of concrete products." (Ex. 8 to the Jones dep., submitted as Tisdale ex. 72).

Respondent advertises and promotes its PAVERCAT product by displaying and demonstrating the product at trade shows. (Respondent's Response to Interrogatory No. 13).

Before beginning our discussion, we note that petitioner has pleaded ownership of eleven registrations in the petition for cancellation. Among the pleaded registrations is Registration No. 2421077⁹ for the mark CAT and design, as shown below,



for use on or in connection with a variety of compact construction equipment, including "skid steer loaders." In its brief on the case, petitioner focuses its arguments in favor of a finding of likelihood of confusion on its CAT and design mark and its compact construction equipment line, particularly the skid steer loaders. In analyzing likelihood of confusion, we accordingly limit our discussion to the PAVERCAT mark and recited goods vis-à-vis the Cat and design mark for "skid steer loaders," the skid steer loaders being most relevant to respondent's machines and machine parts to aid in the installation of segmental pavers.

⁹ Registered January 16, 2001, and claiming July 13, 1988 as the date of first use and October 20, 1988 as the date of first use in commerce, Section 8 and Section 15 affidavits, filed.

PRIORITY

Respondent's underlying application for the involved registration was filed on January 28, 2000. Respondent neither alleged nor proved a date of first use earlier than this date. Thus, the operative date of respondent's first use for purposes of this priority dispute is January 28, 2000. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c). See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1428-29, n. 13 (TTAB 1993); and *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). Regarding petitioner's use of its mark:

To establish priority, the petitioner must show proprietary rights in the mark that produce a likelihood of confusion. These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.

Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) [citation omitted].

Petitioner has made of record a status and title copy of its pleaded Registration No. 2421077. The filing date of the underlying application for that registration is November 12, 1999. Inasmuch as November 12, 1999 precedes any date of first use upon which respondent may rely, priority rests

Cancellation No. 92041776

with petitioner with respect to the CAT and design mark for skid steer loaders. *American Standard Inc. v. AQM Corporation*, 208 USPQ 840 (TTAB 1980). Notably, respondent does not dispute petitioner's priority.

LIKELIHOOD OF CONFUSION

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & 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 also must bear in mind that the fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the DuPont factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

Fame of Petitioner's Mark

As noted, we are required to consider evidence of the fame of petitioner's mark and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ 1303, 1309 (Fed. Cir. 2002);

Recot Inc. v. M.C. Becton, supra; Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's¹⁰ mark or marks, if it exists plays a "dominant role in the process of balancing the DuPont factors." Recot, 214 F.3d at 1327, 54 USPQ2d at 1897, and "[f]amous marks thus enjoy a wide latitude of legal protection. Id. This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. Id. Indeed, [a] strong mark ... cast a long shadow which competitors must avoid." Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." Id.

Bose Corp. v. QSC Audio Products Inc., supra, 63 USPQ2d at 1305.

In this case, we find that petitioner's CAT and design mark is indeed a famous mark in the field of compact construction equipment.¹¹ The record reflects that the CAT

¹⁰ Fame of a petitioner's mark likewise plays an important factor inasmuch as the analysis of the du Pont factors is the same in both opposition and cancellation proceedings.

¹¹ Petitioner also asserts that Pave Tech's President, Mr. Jones, admits that CAT is a world famous trademark. While there was some acknowledgment by Mr. Jones that CAT is a famous trademark, it is unclear whether Mr. Jones was referring solely to fame as it relates to petitioner's heavy construction equipment and, accordingly, we do not find a concession as to fame as it relates to petitioner's compact construction line. Specifically we note the following testimony of Mr. Jones during the 30(b)(6) discovery deposition:

Q. Would you agree, Mr. Jones, that "cat" is a famous trademark?

and design mark has been used since the late 70's in connection with petitioner's compact equipment line and that petitioner capitalized on the strength of its CAT and design mark for heavy equipment by co-marketing both lines of products. (Tisdale dep., p. 89-90 and the sampling of advertisements reproduced in Petitioner's Brief, p. 10-14). Further, the CAT and design trademark is featured prominently on all of petitioner's products, licensed merchandise and on the signage of the CAT Rental Stores, 400 of which are located in North America, 335 of which are in the United States.

Although certain portions of the record have been marked "confidential," so we are unable to disclose specific

Mr. O'LOUGHLIN: Answer only if you know the answer.

- A. Well, as a trademark, yes, it is quite worldwide famous, but it is also a very common term. So, in reference to heavy construction equipment, yes.
- Q. I just want to clarify to make sure I understand your last response. Is it correct that you would agree that "cat" is a famous trademark in the construction equipment industry?
- A. Yes.
- Q. In addition to the fact that "cat" is a famous mark in the construction industry, your last response indicated an addition to that. Could you also explain to me or, I guess, restate what the second part of your answer was?
- A. Well, the term cat is used by other companies known in the construction industry also such as Bobcat who we worked with in the past. So I guess if you are asking if the word cat in and of itself is a world famous trademark and do I recognize that, yes.

(Jones dep., p. 43-44). In any event, respondent did not dispute petitioner's claim that its CAT and design mark is famous.

sales figures and advertising and promotional expenditures, the record establishes that petitioner unquestionably has had significant volume of sales and has extensively promoted its CAT and design mark. Petitioner also has advertised its mark in virtually every medium. Indeed, petitioner's CAT mark has been recognized as one of the world's strongest brands. (Tisdale dep., p. 116-117; Tisdale Exs. 5 and 69).

Additionally, petitioner's aggressive trademark enforcement activities reinforce the strength of its CAT marks. See *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 11.91 (4th ed. 2005) ("... active program of prosecution of infringers ... enhances the distinctiveness and strength of a mark").

Based on this evidence, we find that petitioner's CAT and design mark is famous.

Similarity of the Marks

Considering now the marks, we must determine whether petitioner's CAT and design mark and respondent's PAVERCAT mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. As our principal reviewing court has indicated, while marks must be considered in their entireties, including any descriptive matter, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is

nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods and services is one commonly accepted rationale for giving less weight to a portion of a mark ... " Id. Furthermore, the test 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 and/or services 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).

Respondent contends that "the marks PAVERCAT ... and CAT are not sufficiently similar, especially in light of Pave Tech's addition of the word PAVER at the beginning of its mark. The only similarity between the marks is the word "cat" which is insufficient given the placement

and emphasis of this word in Pave Tech's mark."

(Respondent's Brief, p. 4).

We disagree. In evaluating the similarity of the marks, as admitted by respondent, the term "paver" is generic for a segmental paver. (Jones dep., p. 16-17). We therefore find that the dominant and distinguishing portion of respondent's mark PAVERCAT is the term "CAT," due to the genericness of the word "paver." Thus, the dominant portion of respondent's mark is virtually identical to petitioner's mark.

The generic word "paver," while not present in petitioner's mark, would not be looked to as a source-identifying element. Nor do we find that the triangle design, located beneath the letter "A" in petitioner's mark, distinguishes the parties' marks in appearance. Additionally, because respondent's mark is registered in typed format, respondent's rights therein encompass the letters "PAVERCAT" and are not limited to the depiction thereof in any special form. See *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). As the Phillips Petroleum case makes clear, when a word mark is registered in typed form, the Board must consider all reasonable modes of display that could be represented. Accordingly, respondent's mark must be considered to include

the same stylized lettering and/or color scheme as that in which petitioner's mark appears.

Contrary to respondent's assertion, we also do not find the placement of the generic term "paver" at the beginning of respondent's mark a distinguishing feature. See *Caterpillar Tractor Company v. Gehl Company* 177 USPQ 343 (TTAB 1973) (the addition of the prefix "HYDRA," a descriptive term, to "CAT" found not sufficient to distinguish the mark as a whole from "CAT.>").

Accordingly, we find that in their entireties, the marks are not only substantially similar in appearance due to the shared phrase CAT but, in light thereof, they are substantially similar in connotation and convey a substantially similar commercial impression. Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

Similarity of the Goods/ Trade Channels/ Consumers

Turning now to a consideration of the goods, petitioner contends that both its skid steer loaders and respondent's paver installation machines are material handling machines which perform the same function. By contrast, respondent contends that such goods covered by the respective registrations are dissimilar. In particular, respondent asserts that the goods are dissimilar because "[n]ot one of Caterpillar's asserted trademark filings identify segmental

paving equipment." (Respondent's brief, p. 4). Respondent argues that the Board is constrained to evaluate the similarity of the goods on the basis of the descriptions set forth in the relevant trademark "filings" and that petitioner's activities are entirely irrelevant.

We concur that the issue of likelihood of confusion must be determined based on an analysis of the identification of goods or services set forth in defendant's involved registration vis-à-vis the goods or services recited in plaintiff's registration. See *Octocom Services Inc. v. Houston Computers Services Inc. v. Houston and Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). However, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. In *re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

Respondent's registration is for "machines or machine parts used to aid in the installation of segmental pavers." As observed earlier in this decision, respondent advertises its machine as a "Universal Machine ... that can be fitted with a hydraulic paver clamp, a sand bucket, a sand broom, a rotary sand/cleaning brush and many other attachments for the handling of concrete products." (Exhibit 8 to the Jones deposition, submitted and Ex. 72). The advertisement further touts: "[u]se the bucket to move your screening sand into position and level it"; ... "[m]oving your paving blocks to the laying face quickly"; ... "[u]se the brush to sweep your jointing sand." Id.

Mr. Tisdale, petitioner's general construction industry division manager, testified that these same tasks, namely, installation of segmental pavers, can be performed by petitioner's compact equipment, especially its skid steer loaders.¹² (Tisdale dep., p. 18-19, 20-23, 26-27, 35-36, 59-

¹² Mr. Tisdale specifically testified that:

- Q. And could you turn the page -- let's go to the exhibit -- let's go to the sixth page of Exhibit No. 72.
- A. On this page is a picture of the product called PAVERCAT. The title of the picture says PAVERCAT, capitol C-A-T, 2WD and 4WD, which refers to two-wheel drive and four-wheel drive offerings of this -- the industry term we use is material handler. It's a small four-wheel vehicle with a front tool or attachment that is handling a -- a pallet of bricks or pavers used in a driveway, patio or sidewalk project.
- Q. Which products in Caterpillar's compact equipment line could perform the same function that you see being performed on Page 6?

61). More specifically, Mr. Tisdale testifies that: It is my belief that we are more versatile. ... For our skid steer loader, we offer over 40 different attachments and tools for the front of the machine to do these same applications [as the PAVERCAT machine] of grading, material handling, sweeping, etc...." Moreover, pictures in advertisements of both parties show petitioner's compact equipment, sold under its CAT and design mark, performing the same or similar tasks as respondent's PAVERCAT paver installation machine in the construction of driveways, patios, and sidewalks. (Tisdale exs. 28 and 55 and Jones exs. 10, 15 and 16 submitted as Tisdale ex. 72, and reproduced in Petitioner's brief, p. 43-44).

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- A. We have machines and work tools under the skid steer loader line, multi terrain loaders, compact wheel loaders, backhoe loaders, and telehandlers that all -- and as well as lift trucks -- that all offer material handling capabilities and can and are used in projects similar to this.
- Q. And they all can and are used for moving pavers and bricks and things of that nature. Is that correct?
- A. That is correct. We actually highlight in many of our own advertising and promotion pieces machines with a set of forks, a set of material handling tools, in the front that are handling pallets and groups of bricks, flagstone pavers, etc.

Tisdale Dep., p. 18-19.

- Q. Would individual consumers, homeowners, people of that type, also be potential customers of the CAT Rental Stores?
- A. We will take anybody who walks into the Cat Rental Store and solicit or gather their information on what their project needs are, show them what we have to offer. The targeted audience is the small contractor doing, like I mentioned, patio, driveway, landscaping, building type of projects.

Tisdale dep., P. 35-36.

We therefore find that respondent's machines and machine parts for aid in the installation of segmental pavers and petitioner's skid steer loaders, as identified in the respective identifications of goods, perform the same or very similar functions.

We also find that respondent's attempt to distinguish its goods from those of petitioner by stressing petitioner's admission that "*the PAVERCAT material handler cannot perform the same functions as a skid steer loader*" unpersuasive.

(Respondent's brief, p. 4 (emphasis in the original)). Simply because petitioner's skid steer loaders are more versatile, in that they are able to perform additional tasks, does not alter the fact that both respondent's machines to aid in the installation of segmental pavers and petitioner's skid steer loaders perform the same function, in that they are material handling machines that can be fitted with attachments or tools and used to, among other things, move pavers, move sand and sweep jointing sand used in paving projects.

Because respondent's machines for aiding in the installation of segmental pavers and petitioner's skid steer loaders perform the same or similar functions, they are overlapping or closely related compact construction equipment.

Further, in the absence of any limitations in either petitioner's registration or respondent's registration with respect to channels of trade, or classes of purchasers, we must assume that petitioner and respondent sell their respective goods in all of the usual trade channels for goods of this type and to all normal classes of customers therefor. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, supra*; and *Toys R Us v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). Accordingly, for the purposes of our likelihood of confusion analysis, at the very least, the parties' trade channels and customers overlap.

Respondent also argues that consumers of respondent's PAVERCAT segmental paver installation equipment and petitioner's compact construction equipment are sophisticated "given the high cost of these items." (Respondent's Brief, p. 6). While the items are admittedly expensive to purchase, the record demonstrates that petitioner's compact equipment, such as skid steer loaders, is often rented - for a fraction of the cost - by smaller construction contractors or even homeowners doing a "weekend" construction project who do not have a full time need for such a piece of equipment. (Tisdale dep., p. 24-25, 35-36, 69). As such, the relevant public also includes ordinary consumers with limited construction expertise. These less sophisticated consumers may therefore exercise

less care in selecting the above-mentioned construction equipment than would commercial purchasers, thereby making confusion more likely. See *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004) (noting that where both sophisticated and members of the general public are relevant consumers, the standard is equal to that of the least sophisticated consumer).

Furthermore, even sophisticated and careful purchasers of goods can be confused as to source under circumstances where similar marks are used on identical goods. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible.").

In view thereof, du Pont factors of the similarity of the goods, trade channels and purchasers favor petitioner.

Respondent's Intent

Petitioner argues that respondent adopted the PAVERCAT mark in bad faith because of respondent's prior knowledge of petitioner's use of the CAT and design mark for compact construction equipment. Petitioner also contends that the pattern established by respondent for its trademarks is to combine two descriptive terms - the first being PAVER - which is generic for segmental pavers - along with a second

term which would describe the individual product, such as PAVERSPLITTER, for a tool that breaks pavers and PAVERCART for a cart that moves pavers. Petitioner argues that contrary to the statements of respondent's president, the PAVERCAT mark is not "in keeping" with the other "trademarks" adopted by respondent and thus evidences respondent's attempt to profit from the fame of petitioner's CAT and design mark.

On the other hand, respondent argues that its "honest recognition that it had heard of the company known as 'Caterpillar' prior to adopting a trademark that happens to incorporate the letters 'c-a-t' hardly constitutes bad faith."

Although respondent admittedly knew of petitioner's mark prior to the adoption of its PAVERCAT mark¹³, mere knowledge thereof does not establish that respondent adopted its mark in bad faith. *Ava Enterprises, Inc. V. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). While questionable, we also do not find that respondent's deviation from its typical practice of identifying its products proves bad faith.

Even so, it is settled that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril. W.R.

¹³ Jones dep., p. 43-44.

Grace & Co. v. Herbert J. Meyer Industries, Inc. 190 USPQ
308 (TTAB 1976).

Actual Confusion

Respondent contends that "despite years of concurrent use, Caterpillar cannot point to one instance of actual confusion caused by Pave Tech's mark PAVERCAT."

(Respondent's Brief, P. 5). The record shows, however, that respondent's use and advertising of its mark in connection with the goods identified in the registration has not been substantial, and clearly not so extensive that there has been a meaningful opportunity for any actual confusion to have occurred. Notably, respondent's President, Mr. Jones, in his discovery deposition testified that: "... we currently are not promoting the sale of [the PAVERCAT product]" (Jones dep., p. 34); "the most we ever had at any one time was two" (Id. at 99); and "about two years ago ... we decided not to stock [the PAVERCAT product]." (Id. at 99) As indicated in the invoices submitted as Exhibit 22 to the Jones deposition, during the period between September 12, 2000 and May 2003, respondent sold only four PAVERCAT machines, along with attachments, to three different customers. Further, although respondent's advertising expenditures are marked "confidential" and therefore cannot be disclosed, they are minimal.

Cancellation No. 92041776

The absence, therefore, of actual confusion is not surprising and not legally significant. See *Time Warner Entertainment v. Jones*, 65 USPQ2d 1650, 1663; and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

Therefore, that du Pont factor is neutral.

Additional Argument

We are not persuaded by respondent's argument that the examining attorney's allowance of its application and subsequent registration of PAVERCAT should play a role in the likelihood of confusion analysis, as the Board is not bound by previous determinations made at the examination level. *Hilson Research Inc. v. Society For Human Resource Management*, supra; and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274, 1277 (TTAB 1995).

Conclusion

When all of the relevant du Pont factors are considered, especially the fame of petitioner's mark, we conclude that contemporaneous use by respondent of the mark PAVERCAT for machines and machine parts used to aid in the installation of segmental pavers is likely to cause confusion with petitioner's use of its CAT and design mark at the very least with respect to skid steer loaders.

Decision: The petition to cancel is granted and Registration No. 2684138 will be cancelled in due course.

Cancellation No. 92041776