

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BASF Drucksysteme GmbH

Serial No. 76/018,450

Herbert B. Keil for BASF Drucksysteme GmbH.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge.

BASF Drucksysteme GmbH (BASF or applicant) seeks to register in typed drawing form NEWSKING for "printing inks." The intent-to-use application was filed on April 5, 2000.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark, as applied to printing inks, is likely to cause confusion with two marks previously registered to the same entity. One mark is NEWS KING II depicted in typed drawing form for "printing presses." Registration No. 1,874,515. The second mark is NEWS KING

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and crown design depicted in the form shown below for "printing presses, paper handling apparatus for printing presses, and offset printing plates." Registration No. 782,050.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, applicant's mark NEWSKING is extremely similar to both of the registered marks. One of the registered marks is essentially applicant's mark

with the mere addition of II. The II has little source identifying significance. Rather, it merely suggests an advanced or second version of a NEWS KING or NEWSKING. Likewise, the second registered mark is essentially applicant's mark with the mere insertion of a crown design, which only reiterates the KING portion of the marks. Indeed, the marks NEWSKING and NEWS KING and crown design are absolutely identical in terms of pronunciation and meaning. Moreover, applicant itself has essentially conceded that its mark and the two registered marks are substantially identical when at the bottom of page 3 of its brief it refers to "purchasers of NEWS KING printing presses from [registrant] King Press."

Turning to a consideration of the goods as set forth in the application and the two registrations, we start with the proposition that as the similarities of the marks increase, the respective goods need not be as similar in order to support a finding of likelihood of confusion. For example, when applicant's mark and registrant's marks share a "substantial identity" as is the case here, then their use can lead to a likelihood of confusion "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993). However, in this case we

find that applicant's goods (printing inks) and at least certain of registrant's goods (printing presses and printing plates) are clearly related.

To elaborate, we note at the outset that the term "printing ink" is defined as "ink made especially for use in printing." The American Heritage Dictionary of the English Language (3rd ed. 1992). However, the most compelling evidence showing the clear relationship between printing inks and printing presses (as well as printing plates) are brochures submitted by applicant BASF demonstrating that BASF manufactures and sells complete printing systems, including printing inks and printing plates. One such brochure is entitled "BASF Printing Systems: Integrated Solutions for a colourful future." At page 4 of this brochure, there appears the following sentence: "BASF Printing Systems is in the unique position as a manufacturer of printing plates and inks to operate on the foundation of a complete process chain from raw material to finished product." As previously noted, cited Registration No. 782,050 encompasses not only printing presses, but also printing plates.

Given the fact that applicant's mark is extremely similar to if not substantially identical with the two registered marks, and the additional fact that printing

inks (applicant's goods) are clearly related to printing presses and printing plates (some of registrant's goods), we find that there exists a likelihood of confusion, and accordingly affirm the refusal to register.

One final comment is in order. Applicant argues that registrant's particular printing presses are expensive items which are purchased only by sophisticated consumers. The problem with applicant's argument is that the identification of goods in the two cited registrations does not restrict the printing presses or the printing plates to those presses or plates which are expensive and which are purchased only by sophisticated consumers. It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Put quite simply, cited Registration No. 1,874,515 lists simply "printing presses." This would include very simple printing presses that are relatively inexpensive and which are purchased by consumers who are not necessarily

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sophisticated. Likewise, cited Registration No. 782,052 lists simply printing presses and printing plates (amongst other goods). Accordingly, this cited registration would likewise encompass very simple printing presses and printing plates.

Decision: The refusal to register is affirmed.