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

Proceeding	76537228
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APPEAL BRIEF

This Appeal Brief is in support of Applicant's Notice of Appeal filed on December 28, 2004 from the Examining Attorney's June 28, 2004 action finally refusing to register Applicant's "GEMINI" composite mark.

THE MARK

The composite mark for which Applicant seeks registration on the Principal Register is the composite design/word mark "GEMINI" that appears as follows for use in connection with an active liquid phase biological air scrubbing system that removes airborne odorous compounds from wastewater treatment facilities:



REFUSAL TO REGISTER

The Examining Trademark Attorney has refused registration of Applicant's Mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark allegedly "so resembles the marks shown in U.S. Registration Nos. 1768011 and 1736101 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive." The Examining Attorney has based this rejection on Registration Nos. 1,736,101 (hereinafter, "the '101 mark") and 1,768,011 (hereinafter, "the '011 mark"), both of which are for the word mark "GEMINI."

ARGUMENT

I. The Standard To Support A Refusal To Register Under Section 2(d)

To support a refusal to register under § 2(d), the Patent and Trademark Office must show that Applicant's mark is likely to cause confusion among potential purchasers. A likelihood of confusion is synonymous with a probability of confusion. To sustain a § 2(d) rejection, it is not sufficient for the Official Action to show that confusion among potential purchasers is "possible." *American Steel Foundries v. Robertson*, 269 U.S. 372 (1926). The mere fact that a mark may call to mind a particular image or recollection is not the degree of confusion required to bar registration under § 2(d). *Viacom v. Komm*, 46 U.S.P.Q.2d 1233 (TTAB 1998).

To merit registration, it is only necessary that a reasonably prudent purchaser is *not likely* to be confused. Although the Examiner alleges that the Applicant "has a legal duty to select a mark which is totally dissimilar to trademarks already being used," there is no basis in law for such a requirement. In determining the likelihood of confusion among potential purchasers, the Office is to consider factors identified in *DuPont* as they may be applicable. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

II. Discussion Of The Refusal To Register

A. Similarity Of The Marks

DuPont states that the likelihood of confusion under § 2(d) is determined, in part, according to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. The commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920). As a general rule, trademarks are to be considered as a whole and not dissected. *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000). However, when one feature is more significant it is proper to give greater force to that dominant feature. *Kangol, Ltd. v. KangeROOS U.S.A., Inc.*,

974 F.2d 161 (Fed. Cir. 1992). For example, the design element of a composite mark may dominate or be a significant factor in distinguishing the marks if it is more conspicuous than the accompanying words. *In re Computer Communications, Inc.*, 484 F.2d 1392 (CCPA 1973); *In re Electrolyte Lab., Inc.*, 913 F.2d 930 (Fed. Cir. 1990), corrected 929 F.2d 645 (Fed. Cir. 1990).

In attempting to support the refusal to register, the Examining Attorney alleged that "[t]he applicant has fully appropriated the registered marks with the *mere* addition of a design element. The literal portions of both marks are identical in appearance, sound and meaning. The addition of the design element does not obviate the similarity between the marks." (emphasis added). The Examiner has ignored important differences between Applicant's composite mark and the word marks of the '101 and the '011 marks. First, the Examiner's allegation that the Applicant's mark is "identical" to the '101 and the '011 marks ignores that Applicant's mark is for a composite mark that includes both design and word elements, whereas the referenced marks are simply word marks. Given the addition of the design elements to Applicant's mark, there is simply no way that Applicant's mark can be identical to the word marks. This is a mischaracterization that ignores important differences between the marks.

Second, the Examiner has described the nature of the design element of Applicant's composite mark as a "mere addition." This, too, is a mischaracterization because the design element is the dominant portion of the composite mark. Not only is the design positioned above the word "**GEMINI**," but the percentage of the mark dedicated to the design portion is considerably greater than that dedicated to the word portion and as such, the eye is drawn to the more conspicuous design element before it is drawn to the word portion of the mark.

Even if the design of the Applicant's composite were not the dominant portion of the composite, the design elements of a mark cannot be ignored. *Spice Islands, Inc. v. Frank Tea &*

Spice Co., 505 F.2d 1293 (CCPA 1974). It is error to focus on the word portion of a composite mark to the substantial exclusion of all design elements. *In re Electrolyte Labs., Inc.*, 929 F.2d 645 (Fed. Cir. 1990). Conversely, while the '011 and the '101 registrations for "**GEMINI**" in typed form include all reasonable manners in which that word could be depicted, they do not include rights in the word "**GEMINI**" combined with other wording or designs. *Fossil, Inc. v. Fossil Group*, 49 U.S.P.Q. 2d 1451 (TTAB 1998). There is simply no basis in fact for any finding that the Applicant's composite mark is identical to the word marks in the '101 and the '011 registrations.

B. Similarity of the Goods

Even if the design of Applicant's composite mark were not the dominant portion of the mark, there are other factors showing that the Applicant's mark is not likely to cause confusion. *DuPont* also states that the evaluation of the likelihood of confusion should also include the similarity or dissimilarity of the nature of the goods that are described in the application or registration. The final Official Action alleges that the goods of the parties are sufficiently related to support a finding of likelihood of confusion.

Applicant seeks registration for the composite mark that includes the word "**GEMINI**" for use in connection with an active liquid phase biological air scrubbing system that removes airborne odorous compounds from wastewater treatment facilities, as specified in Applicant's description of the goods. Applicant's product does not use activated carbon, is not a water treatment unit, and is not comprised of filter underdrains or contactors, as is claimed in the description of the goods by the '011 mark. Even though the '011 mark claims use for "industrial, commercial and municipal" purposes, that broad recitation of the venue in which the '011 product could be used does not make the products similar. Many products having no relationship

to one another are used for "industrial, commercial, and municipal" purposes, but that does not make those products similar. Such is the case here, i.e., Applicant's product and the product sold under the '011 mark are entirely different products, making confusion unlikely, regardless of where the products are used.

Likewise, in contrast to the product sold under the '101 mark, Applicant's product is not an air pump or a sampling device, nor does it detect airborne odorous contaminants. Whereas the goods sold under the '101 mark are for *detection* of airborne odorous contaminants, Applicant's goods actually *remove* airborne odorous compounds from wastewater treatment facilities. Therefore, again, there is little likelihood of confusion because Applicant's product and the product sold under the '101 mark are different products.

C. Channels of Commerce

DuPont also requires that a determination of likelihood of confusion should account for similarities or dissimilarities between trade channels, when applicable. The Official Action speculates that the Registrants' goods and those of the Applicant are in the same channels of commerce. This is unsupported. Registrants' goods are different products with different purposes and different target markets from Applicant. Specifically, the Applicant's products are marketed to wastewater treatment facilities, while the '011 product is marketed to drinking water providers and the '101 product is marketed to the industrial toxic emissions market.

The Examiner alleges that the identification of goods in the '011 mark, namely the indication that its water treatment units are for "industrial, commercial and municipal waste," is broad enough to include wastewater treatment facilities. Such a conclusion assumes too much. But even assuming *arguendo* that "industrial, commercial and municipal waste" includes wastewater treatment facilities, it is a well-settled principle that the fact that both parties' goods

are purchased by the same institution does not alone establish similarity of trade channels or market overlap resulting in likelihood of confusion. This is because large institutions, such as those involved in industry, commerce, or municipalities, have diverse requirements and must purchase many different and unrelated products to meet those requirements. In effect, there may be different markets within the same institution because the products may be used in physically separate facilities to serve different needs. *Astra Pharm. Prod. v. Beckman Inst.*, 718 F.2d 1201, 1207 (1st Cir. 1983). Furthermore, the likelihood of confusion must be shown to exist in the customer or purchaser, not the institution. *Elec. Design & Sales v. Elec. Sys.*, 954 F.2d 713, 717 (Fed. Cir. 1992). It cannot be presumed that the products are selected by the same individuals, even if the products are used by the same institution, which Applicant argues that they are *not*. Applicant's products are for the treatment of *wastewater*, whereas the '011 product is for the treatment of *drinking water*. Therefore, even if these products are purchased by the same institution, *e.g.*, municipalities, the fact that they serve different needs (*i.e.*, *drinking water* treatment vs. *wastewater* treatment) shows that these products actually serve two different markets and are very likely selected by different purchasers.

The Examiner also alleges that the use of activated carbon, as in the '011 mark, is a "closely related competing technology" and that "the relevant goods could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source." The Examiner further alleges that the Applicant uses the activated carbon technology, citing the Applicant's website as support. A review of Applicant's website, however, clearly shows that Applicant sells three different systems for odor control and that the "**GEMINI**" is a biological air scrubbing system. Even a cursory review of the Applicant's website reveals that any mention of "activated carbon" occurs in relation to separate

products of Applicant sold under separate marks, *e.g.*, "Phoenix," "High Flow," and "Titan," but not with respect to "**GEMINI**." This is because "**GEMINI**" applies only to odor control products using wholly biological materials: hence the website's reference to "**GEMINI**" as a "Bio-scrubber." The fact that the Applicant sells *other* products for removal of airborne odorous compounds from wastewater treatment facilities that use activated carbon technology is irrelevant to the Examiner's allegation that the products sold under the Applicant's "**GEMINI**" mark and those sold under the '011 mark serve the same channels of trade. The activated carbon sold by Applicant under the "**GEMINI**" mark is used for a different purpose than the activated carbon product claimed in the recitation of use of the '011 mark. Specifically, the Applicant uses activated carbon *in another product not marketed under the "GEMINI"* mark for the treatment of wastewater by wastewater treatment facilities, and the '011 mark uses it for the treatment of drinking water by drinking water providers. Given these two different uses of activated carbon in two different industries, confusion is highly unlikely.

The Examiner also alleges that the '101 registration broadly identifies the goods and that "[t]herefore the registrant's goods are broad enough to cover air pump accessories, namely, sorbent tube samples for the *detection* of airborne [sic] contaminants in wastewater treatment facilities." (emphasis added). However, there is no allegation that the registered goods are broad enough to cover a system that *removes* airborne contaminants in wastewater treatment facilities, as Applicant's product does. Detection and removal, respectfully, are quite different. If the Examiner's reasoning is taken as sound, then by analogy smoke detectors and air purifiers that remove smoke from smoke-damaged environments must be in the same market and respectfully, they are not. Further, even if the '101 Registered goods are sold to wastewater treatment facilities, as discussed above, the mere fact that both parties' goods are purchased by the same

institution is not enough to establish similarity of trade channels or market overlap resulting in likelihood of confusion. Thus, the fact that these two products serve different purposes, detection vs. removal, shows that the products actually serve two different markets, even if they coexist within the same broad institution, wastewater treatment facilities.

Moreover, it should be noted that all of these products are ones for which the purchaser pays a considerable price.¹ As such, the purchaser generally invests considerable time into researching the products that are being considered.² The purchaser is an informed, sophisticated buyer who knows the source of the products and who uses a high degree of care in making purchases. Given this, there is little chance for confusion of the source. *See Perini Corp. v. Perini Constr.*, 915 F.2d 121, 127 (4th Cir. 1990).

D. Actual Confusion

Also important is the fact that during the time that Applicant has been using the composite “**GEMINI**” mark, no incidents of actual confusion with Registrants’ or any other marks have been reported. This supports Applicant’s argument that there is no likelihood of confusion between Applicant’s composite “**GEMINI**” mark and the word marks in “**GEMINI**” held by Registrants. *See e.g., Al-Site Corp. v. VSI Int’l*, 174 F.3d 1308, 1331 (Fed. Cir. 1999).

IV. Conclusion

Even in cases where there may be an identity of goods and channels of trade, dissimilarity of the marks can result in a holding that there is no likelihood of confusion.

¹ Applicant's products range in price from \$39,000 to \$731,000, depending upon the model.

² Typically, one of Applicant's representatives meets with the purchaser, during which time Applicant's representative presents technical information regarding the GEMINI product, including PowerPoint presentations, technical literature, reference lists, and expert commentary. The customer is also provided with product specifications and drawings, and on occasion, pilot trials may be instituted to demonstrate the

Keebler Co. v. Murray Bakery Prods., 9 USPA 2d 1736 (Fed. Cir. 1989). Here, the marks, goods, and channels of trade are all dissimilar. Further, there are no reported incidents of actual confusion between the marks. For the reasons stated herein, the Applicant's composite mark "**GEMINI**," when considered in light of the '101 and the '011 registrations, creates no likelihood of confusion among potential purchasers. Accordingly, Applicant is entitled to registration of the composite mark "**GEMINI**" on the Principal Register and such registration is hereby respectfully requested.

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viability of the product. The customer must then secure a price from Applicant for the system in order to bid on a project.