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

|                        |   |
|------------------------|---|
| Proceeding             | 76602221  |
| Applicant              | Carlisle Intangible Company   |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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In re Carlisle Intangible Company, )  
Serial No.: 76602221 )  
Mark: DURAPOWVER )  
Appeal Filed: February 29, 2008 )  

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APPLICANT'S APPEAL BRIEF

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## I. INTRODUCTION

Applicant is appealing from the Examining Attorney's refusal to register the mark DURAPOW<sup>ER</sup> of Application No. 76/602,221 for use with "power transmission belts" in Class 7 under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that there is a likelihood of confusion with the mark DURAPOW<sup>ER</sup> of Registration No. 3,006,364 for "power supply systems comprising generators and AC and DC bus and breaker panels" in Class 9. Applicant's power transmission belts are distinct from, and travel in different channels than, the cited power supplies of Registration No. 3,006,364. Moreover, the DURAPOW<sup>ER</sup> mark of Registration No. 3,006,364 was allowed over Applicant's prior registration for the DURAPOW<sup>ER</sup> mark for the identical goods that are the subject of the present application. Accordingly, the Examining Attorney's refusal should be reversed and the application passed to publication.

## II. FACTS

Applicant Carlisle Intangible Company is the owner by assignment of Registration No. 757,776 for the mark DURAPOW<sup>ER</sup> for use in connection with "power transmission belts" in Class 7. (See Exhibit 1 to the August 9, 2007 Response to Office Action.) Because of some communication problems during the transition from the original owner to Applicant, renewal papers for Registration No. 757,776 were not properly filed in 2003 and, as a result, that registration was cancelled on November 19, 2004.

On October 23, 2002, while Applicant's Registration No. 757,776 for the DURAPOW<sup>ER</sup> mark was in full force and effect, Tecumseh Products Company filed Application No. 78/177,767 for the mark DURAPOW<sup>ER</sup>. As shown by Exhibit 2 to Applicant's August 9, 2007

Response to Office Action, that application was approved and published for opposition on November 4, 2003, again while Applicant's Registration No. 757,776 was in full force and effect. That application registered on October 1, 2005 as Registration No. 3,006,364.

Because Registration No. 757,776 for the DURAPOWVER mark was going to be cancelled, Applicant filed a new application for the DURAPOWVER mark on July 14, 2004 (Application No. 76/602,221), for the identical goods that were the subject of Registration No. 757,776, namely, power transmission belts. After first suspending the present application on February 22, 2005, the Examining Attorney issued an Office Action on February 13, 2007 refusing registration of Applicant's mark over the DURAPOWVER mark of Registration No. 3,006,364 under Section 2(d), 15 U.S.C. § 1052(d), contending there was a likelihood of confusion between the two. In support of that assertion, the Examining Attorney included two third-party registrations (and referred back to three third-party registrations referenced in the February 22, 2005 suspension letter) that he stated included both applicant's goods and the registrant's goods.

Applicant responded on August 9, 2007, pointing out that the cited DURAPOWVER mark of Registration No. 3,006,364 was allowed over Applicant's prior registration for the DURAPOWVER mark that was for use of the mark in connection with the same goods as are the subject of the present application, which demonstrated the Trademark Office had already concluded there was no likelihood of confusion between the marks. Applicant also argued that the goods in the pending application are unrelated to the goods of the cited registration. To assist in an understanding of what was meant by the recited goods in Registration No. 3,006,364, namely, "power supply systems comprising generators and AC and DC bus and breaker panels" in Class 9, Applicant also submitted pages from the Internet website of the registrant showing

that the registrant's goods were what are known as uninterruptible power supplies. (See Exhibit 3 to the August 9, 2007 Response to Office Action.) Finally, Applicant pointed out that none of the third-party registrations cited by the Examining Attorney included the goods of both Applicant and registrant. In fact, none of the cited registrations included any goods in International Class 9.

On September 5, 2007, the Examining Attorney issued an Office Action making the refusal to register the DURAPOWER mark final. The Examining Attorney also included additional third-party registrations he stated showed use on the same or similar goods as those of Applicant and the registrant.<sup>1</sup> The Examining Attorney further asserted that the goods of Registration No. 3,006,364 were misclassified and, apparently misidentified. Although the goods in Registration No. 3,006,364 are identified as "power supply systems," which are classified in Class 9, the Examining Attorney stated:

It should also be noted that, contrary to applicant's position, electric generators, like applicant's goods are properly classified in International Class 7, and not in International Class 9.

(September 5, 2007 Office Action.)

Applicant timely filed a Notice of Appeal on February 29, 2008.

### III. ISSUE ON APPEAL

The issue on appeal is:

(1) Whether Applicant's mark, DURAPOWER, when used in connection with "power transmission belts" in Class 7 is confusingly similar to the mark DURAPOWER of Registration

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<sup>1</sup> Although the new third-party registrations did include goods in both Class 7 and Class 9, none of them included "power supplies" which, as set out below, are a very specific piece of equipment.

No. 3,006,364 when used in connection with "power supply systems comprising generators and AC and DC bus and breaker panels" in Class 9.

#### IV. ARGUMENT

##### A. The Allowance of the DURAPOW ER Mark of Registration No. 3,006,364 Over Applicant's Prior Registration for the DURAPOW ER Mark Compels a Finding That There is No Likelihood of Confusion

Prior to Applicant's filing of the present application, an examining attorney confronted with the identical facts as in this case concluded that there was no likelihood of confusion between the mark DURAPOW ER as used with power transmission belts in Class 7 and DURAPOW ER as used with power supply systems comprising generators and AC and DC bus and breaker panels in Class 9. That action by this Office is compelling evidence that there is no likelihood of confusion between the two marks.

Applicant is the owner of U.S. Registration No. 757,776 for the DURAPOW ER mark for use with power transmission belts. Although that registration was cancelled on November 19, 2004, it was in full force and effect at the time that the application for the DURAPOW ER mark of U.S. Registration No. 3,006,364 was reviewed and approved by the Trademark Office and published for opposition on November 4, 2003. (See Exhibits 1 and 2 to the August 9, 2007 Response to Office Action.) It is clear, therefore, that the examining attorney of the application that matured as Registration No. 3,006,364 concluded there was no likelihood of confusion. That same conclusion must be reached in this case.

The Examining Attorney in this case erroneously gave no weight to this prior action of the Trademark Office and instead asserted that "prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not



binding upon the Office." (See September 5, 2007 Office Action.) That doctrine, however, has no application here. The prior actions of the Office that Applicant is relying on are not with respect to "different marks" as were at issue in the decisions cited by the Examining Attorney. See, e.g., *In re Consolidated Foods Corp.*, 200 USPQ 477, 481 (TTAB 1978) (noting that the "actions of Examiners in registering other marks or other parties for different goods are of little assistance."). Rather, the prior actions relied upon by Applicant are those of an examiner in registering the same marks of the same parties for the same goods that are at issue in the present case. Indeed, in a prior case, the Board found that it must consider "the fact that the cited registration was allowed over applicant's then-subsisting registration of the mark . . . ." *In re Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993) (concluding the mark PHOENIX when applied to leather sold in bulk did not so resemble the mark PHOENIX when applied to all-purpose sports bags, luggage, attache cases, portfolio briefcases, and handbags, as to be likely to cause confusion, or to cause mistake or to deceive).

Applicant submits that the fact that the DURAPOW ER mark of Registration No. 3,006,364 was allowed over Applicant's prior DURAPOW ER mark of Registration No. 757,776 for the identical goods as are the subject of the present application is not merely a fact that must be considered. Rather, it is a fact that compels that the refusal of the present application be withdrawn. To rule otherwise would be the height of an arbitrary and capricious decision. That is, there is no basis in law or fact that would permit an Examining Attorney to approve for registration a second mark over a first mark, and then for a subsequent Examining Attorney to refuse for registration of the first mark over the second mark.

B. The Goods With Which Applicant's Mark and the Cited Registration Are Used Are So Different as to Preclude Any Likelihood of Confusion

The goods of the present application – power transmission belts in International Class 7 – are unrelated to the goods that are the subject of Registration No. 3,006,364 – power supply systems comprising generators and AC and DC bus and breaker panels in International Class 9. The examining attorney failed to consider whether there was a likelihood of confusion when the DURAPOWVER mark is with the goods of Applicant's application and the goods of Registration No. 3,006,364. Instead, the Examining Attorney considered whether there was a likelihood of confusion if the DURAPOWVER mark was used with power generators. The failure of the Examining Attorney to consider the correct goods is of critical importance.

First, that the Examining Attorney was considering power generators rather than power supplies is clear from the Office Action making the refusal final. In that Office Action, the Examining Attorney, in response to Applicant's assertion that the goods of the present application and those in Registration No. 3,006,634 were in different classes, stated:

It should also be noted that, contrary to applicant's position, electric generators, like applicant's goods are properly classified in International Class 7, and not in International Class 9.

(September 5, 2007 Office Action.) Although the Examining Attorney is correct that power generators are classified in Class 7, "power supplies" as recited in Registration No. 3,006,364 are classified in Class 9. Indeed, with the exception of "high frequency motor spindles with high frequency electric converters and power supply units" that are classified in Class 7 and that are clearly not the goods recited in Registration No. 3,006,364, there are only five "power supplies" identified in the Trademark Acceptable Identification of Goods & Services Manual, which are as follows:

High-frequency switching power supplies  
Power supplies [electrical]  
Power supplies for lights, sirens and public address systems  
Power supply connectors and adaptors for use with portable electronic devices  
Voltage stabilizing power supply

As the Board will observe, each of these goods is classified in International Class 9.

The Board will also observe that the description of goods in Registration No. 3,006,634 – power supply systems comprising generators and AC and DC bus and breaker panels – is not the same as any of the previously accepted identifications and is somewhat unclear.

[W]hen the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description has a specific meaning to members of the trade.

In re Trackmobile Inc., 15 USPQ2d 1152, 1154 (TTAB 1990). Here, the Examining Attorney has arbitrarily concluded that the term "power supply" means "power generator." It does not. Applicant submitted extrinsic evidence from the Internet website of the registrant showing what it meant by a power supply. The products sold under the DURAPOWVER mark are "uninterruptible power systems." (See Exhibit 3 to the August 9, 2007 Response to Office Action.)<sup>2</sup> An uninterruptible power supply is used to assume the voltage load at a facility in the event incoming AC voltage to a facility is interrupted. (See Exhibit 1, Standard Handbook for Electrical Engineers at page 23-23 (1993).)<sup>3</sup> That is a very different product than an electric generator. Thus, a prospective consumer of Tecumseh Products Company is likely searching for

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<sup>2</sup> Applicant notes that, as originally filed, the description of goods in what issued as Registration No. 3,006,364 was "uninterruptible power supply systems."

<sup>3</sup> Although this reference was not provided to the Examining Attorney, "[t]he Board may take judicial notice of reference works, . . ." In re Spirits of New Merced LLC, 85 USPQ2d 1614, 1617 n.3 (TTAB 2007).

such an uninterruptible power supply. Applicant's goods, by contrast, are power transmission belts, which are totally unrelated to such uninterruptible power supplies.

The only evidence that the Examining Attorney submitted to show that the power transmission belts in Class 7 that are the subject of the present application and the power supply systems comprising generators and AC and DC bus and breaker panels in Class 9 of U.S. Registration No. 3,006,364 travel in the same channels of trade are some third-party registrations for marks that the Examining Attorney asserted included both applicant's goods and the registrant's goods. However, none of those registrations includes both power transmission belts in Class 7 and "power supplies" in Class 9. When confronted with similar facts, the Board has held that such registrations fail to support a finding of a likelihood of confusion.

[U]pon review, we find that none of the registrations appear to include goods of the type listed in applicant's application and the cited registration. In particular, none of the registrations cover preparations for the repair of polyolefin surfaces. Thus, the third-party registrations are insufficient to show that applicant's and registrant's goods are of a type that may emanate from a single source.

In re W.W. Henry Co., 82 USPQ2d 1213, 1215 (TTAB 2007). Moreover, even if the third-party registrations did include both Applicant's and registrant's goods (which they do not), that would be insufficient to show that consumers would expect goods bearing the DURAPOWER mark emanated from a single source.

In view of these differences in the goods, the two third-party registrations submitted by the Examining Attorney do not persuade us it is the norm for companies to sell both rackets and soccer balls and to adopt a single product mark for both, or that customers would be aware of such a practice, such that they would assume that the products emanate from the same source if they were sold under the same or similar marks. Third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them; their probative value is only that there serve to suggest that the listed goods and/or services are of a type that may emanate from a single source.

In re Donnay Int'l, Societe Anonyme, 31 USPQ2d 1953, 1955 (TTAB 1994) (addressing the mark THE GHOST for soccer balls and GHOST for tennis, squash and badminton rackets).

In short, "the record contains no convincing evidence that ultimate purchasers would be likely to encounter both marks." In re Albert Trostel & Sons Co., 29 USPQ2d at 1786 (reversing refusal to register PHOENIX for leather in Class 18 over prior registration for PHOENIX for luggage, handbags and other goods in Class 18). Accordingly, the refusal to register the DURAPOWVER mark for power transmission belts should be withdrawn.

#### V. CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register DURAPOWVER for "power transmission belts" in Class 7 under Trademark Act Section 2(d), 15 U.S.C. § 1052(d)

Respectfully submitted,

Date: April 28, 2008

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Attorneys for Applicant,  
Carlisle Intangible Company

# EXHIBIT 1

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# STANDARD HANDBOOK FOR ELECTRICAL ENGINEERS

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*Director Emeritus, Institute of Electrical and Electronics Engineers; formerly Vice President—Research, Philco Corporation; President of the Institute of Radio Engineers; Editor of the Proceedings of the IRE; Fellow of the IEEE; Fellow of the IEE (London); Eminent Member, Eta Kappa Nu; Member of the National Academy of Engineering*

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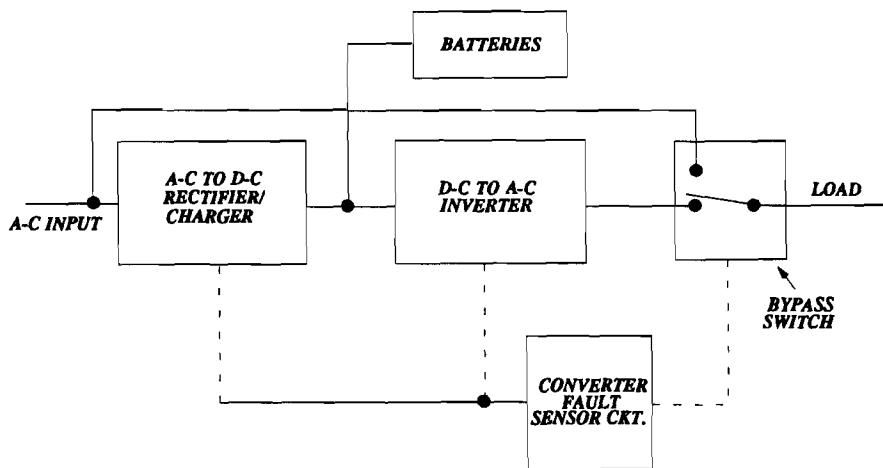


FIG. 23-18 Standard UPS schematic.

torque characteristics of a squirrel cage motor. This high starting torque enables a high-inertia rotor to be used, increasing ride-through due to the rotational momentum (flywheel effect) of the rotor.

This scheme maintains voltage and frequency for durations of at least 15 s at full rated load. It is useful for ride-through during momentary outages due to instantaneous utility breaker operations and during the starting of a standby generator for emergency power. Figure 23-17 shows a cutaway of a 35-kVA Roebel motor-generator rotor construction.

**UPS and Standby Power Supplies.** Uninterruptable power sources (UPS) typically consist of a rectifier, a large bank of dc storage batteries, and a dc-to-ac inverter. The rectifier keeps the batteries charged *and* powers the load through the dc-to-ac inverter. If the incoming ac voltage is interrupted, the batteries assume the load through the inverter until normal ac voltage returns.

Under normal conditions, the UPS load operates from the dc-to-ac inverter with the ac-to-dc rectifier keeping the batteries charged *and* supplying the inverter. If there is an internal failure of the UPS, the bypass switch automatically switches to unconditioned power. The bypass

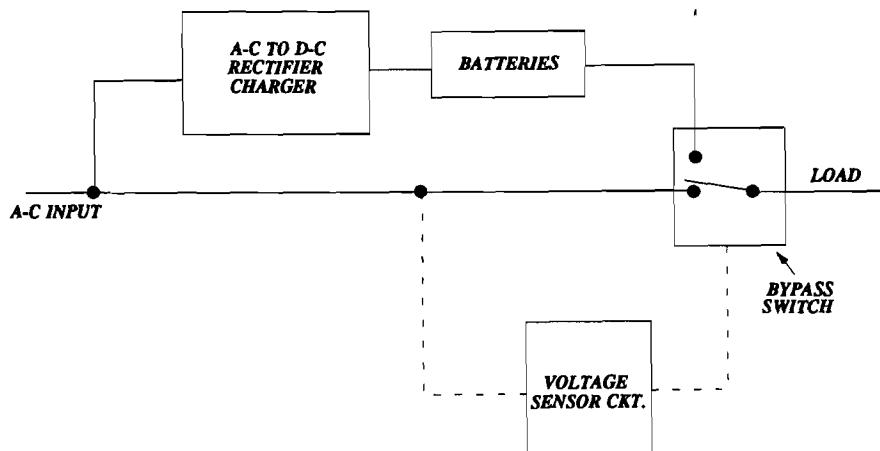


FIG. 23-19 Simplified schematic of a typical battery-powered standby power supply.