

From: Michos, John

Sent: 10/21/2009 11:49:09 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 76695792 - USCANTEEN - P-4098-7

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 76695792.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 76/695792

**MARK:** USCANTEEN



**CORRESPONDENT ADDRESS:**

MYRON AMER  
Myron Amer, P.C.  
350 NATIONAL BLVD STE 2B  
LONG BEACH, NY 11561-3327

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** USCANTEEN INC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

P-4098-7

**CORRESPONDENT E-MAIL ADDRESS:**

## EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trade mark USCANTEEN and design on the grounds that it is confusingly similar to the trademark USCANTEEN, U.S. Registration No. 3604558, within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

### FACTS

The applicant filed an application to register US CANTEEN and design for a "water bottle." The examining attorney refused registration under Section 2(d) of the Trademark Act because US CANTEEN and design was confusingly similar to USCANTEEN, U.S. Registration No. 3604558, for "plastic and metal water bottles sold empty." The examining attorney also required an amendment to the identification of goods.

The applicant argued against the refusal under Section 2(d). The applicant also amended the identification of goods to “non-leaching metal water bottles sold empty.”

The examining attorney accepted the amendment to the identification of goods. The examining attorney issued a final refusal under Section 2(d). Applicant filed a request for reconsideration of the refusal. The request for reconsideration was denied. The applicant is appealing that final determination.

## **ARGUMENT**

### **I. SECTION 2(d) OF THE TRADEMARK ACT BARS THE REGISTRATION OF CONFUSINGLY SIMILAR MARKS.**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. The goods and services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

**A. THE MARK OF THE REGISTRANT IS SIMILAR TO THE MARK OF APPLICANT.**

**1. THE DESIGN FEATURE IN APPLICANT'S MARK DOES NOT OVERCOME THE CONFUSING SIMILARITY BETWEEN THE MARKS.**

In U.S. Registration No. 3604558, the registrant is using USCANTEEN in typed or standard character format. Applicant is using the wording US CANTEEN in bold lettering on top of a square with the design of plastic water bottle with the universal prohibition symbol superimposed thereon.

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In this instance, the design feature in US canteen consisting of a plastic water bottle with the universal prohibition symbol does not serve to alter the commercial impression

created by the terms US CANTEEN. Rather, it serves merely to underscore and reinforce the commercial impression created by the terms “US CANTEEN” that the goods in question are some sort of a reusable container for water and not a disposable plastic bottle.

Furthermore, the mark of the registrant is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form will not generally avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). The mark of the registrant could be presented in a manner similar to applicant’s presentation. Applicant’s stylization, therefore, does not preclude a likelihood of confusion.

In this case, US CANTEEN, is the only literal element of applicant’s mark and USCANTEEN constitutes the entirety of registrant’s mark. In each instance, this shared wording is likely to be perceived by consumers as a source identifier. USCANTEEN and US CANTEEN and design, therefore, are highly similar and create confusingly similar commercial impressions.

**2. THE FACT THAT THE REGISTERED MARK USCANTEEN IS ON THE SUPPLEMENTAL REGISTER AND THAT APPLICANT HAS DISCLAIMED THE WORDING US CANTEEN DOES NOT OBVIATE THE LIKELIHOOD OF CONFUSION.**

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. This protection extends to marks registered on the Supplemental Register. *See, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Similarly, applicant’s disclaimer US CANTEEN has little significance in evaluating the confusing similarity between the marks. The marks must be considered in their entireties when determining whether there is likelihood of confusion. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001). Purchasers are not aware of disclaimers that reside only in the records of the Office.

**B. THE GOODS OF THE REGISTRANT ARE HIGHLY RELATED AND IDENTICAL, IN PART, TO THE GOODS OF APPLICANT.**

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and services identified in the application and registration, without limitations

or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); TMEP §1207.01(a)(iii). If the cited registration describes the goods and services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

In U. S. Registration No. 3604558, registrant is using its mark on “plastic and metal water bottles sold empty.” Applicant is using its mark on “non-leaching metal water bottles sold empty.” Both parties are using their USCANTEEN marks on water bottles. The goods are used for the same purpose, i.e., to carry drinking water, and will be sold in the same channels of trade.

The only limitation in applicant's and registrant's identification of goods is as to the type of water bottles; non-leaching metal and metal and plastic, respectively. The fact that applicant has “non-leaching metal water bottles” and registrant has “metal water bottles” does not obviate the closely related nature of the goods in question. As registrant's metal water bottles are described without limitation, it must be presumed that its metal water bottles are highly similar, if not identical, to the “non-leaching” metal water bottles of the applicant. Moreover, the evidence of record indicates that many metal and plastic water bottles have non-leaching properties. Accordingly, applicant's contention that because its

metal water bottles are described as non-leaching renders them distinct and unrelated to registrant's water bottles is not well taken. The goods of the registrant and the goods of applicant, therefore, are very closely related and appear to be identical in part.

Even if registrant's water bottles are not "non-leaching," it is reasonable to conclude that the

registrant might want to expand its water bottle product line to include non-leaching metal bottles.

Any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. *See In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand its business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4. The evidence of third party practice consists of website pages from manufacturers of both plastic and metal water bottles. Both types of bottles can possess non-leaching characteristics which counters applicant's assertion that its non-leaching properties serves to distinguish it from other water bottles. It appears that non-leaching water bottles are in demand in both metal and plastic variations. These listings confirm that it is likely that registrant's water bottles also possess this quality.



Even assuming, *arguendo*, that registrant's metal and plastic water bottles do not possess the quality of being "non-leaching" as applicant's metal water bottles do, the goods remain closely related. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). As the goods at issue are non-leaching metal water bottles and metal and plastic water bottles, the closely related nature of applicant's and registrant's goods has been demonstrated.

**1. EXAMINING ATTORNEY HAS SUBMITTED TIMELY EVIDENCE  
WHICH  
SHOULD BE CONSIDERED.**

Applicant's objection to the evidence attached to the Office action of August 10, 2009 denying the request for reconsideration is not well taken. It is well established that regardless of whether an applicant submits new evidence with a request for reconsideration, the examining attorney may introduce additional evidence directed to the issue(s) for which reconsideration is sought. TBMP §1207.04. *See In re Giger*, 78 USPQ2d 1405 (TTAB 2006). The evidence submitted serves to rebut the contention that applicant's water bottles are not closely related to the registrant's water bottles. Accordingly, this timely and probative evidence is properly of record.

## **2. SOPHISTICATED PURCHASERS CAN STILL EXPERIENCE SOURCE CONFUSION.**

Applicant has argued that there is no likelihood of confusion because the purchasers are likely to exercise more care because the purchasing decision relates to an important health decision. (Applicant's Brief at page 3). This is not persuasive. The potential customer base for the goods is the general public. When the relevant consumer includes the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). Even if the purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Consumers who encounter applicant's US CANTEEN and design mark on non-leaching metal water bottles are likely to conclude that they are a related product line to or originate from the same source as registrant's USCANTEEN metal and plastic water bottles.

## **CONCLUSION**

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because the mark of applicant is confusingly similar to the mark of the registrant should be affirmed.

Respectfully submitted,

/John E. Michos/  
Trademark Attorney  
Law Office 105  
571 272-9197

Thomas G. Howell  
Managing Attorney  
Law Office 105