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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Crosstex International, Inc.

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Serial No. 77888336

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Laura E. Smith, Esq. for Crosstex International, Inc.

Kapil K. Bhanot, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Seeherman, Grendel and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Crosstex International, Inc. ("applicant") filed a use-based application to register the mark ULTRA, in standard character form, for "surgical face masks," in Class 10.

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the mark ULTRA SOFT

and design, shown below, for "face masks for medical, dental and veterinary use," in Class 10.[1]

We first turn to an evidentiary matter. In the appeal brief, the examining attorney objected to applicant's submission of a table of registrations and applications of marks consisting, in whole or in part, of the word "Ultra" for goods in Class 10, attached as an exhibit to applicant's April 22, 2010 response. Applicant's table included the mark, goods, status, and "owner of record." Applicant referred to the marks listed in the table to rebut the examining attorney's contention that the word "Ultra" is the dominant element of the mark in the cited registration and to show that "Ultra" is a weak term when used in connection with goods in Class 10. In the May 10, 2010 Office action, the examining attorney noted applicant's table "as evidence of the weakness of the term ULTRA," but stated that the marks in the table were not persuasive because the goods in the application and the cited registration are identical. The examining attorney did not object to the table of registrations in the May 10,

[1] Registration No. 3257637, issued July 3, 2007.

2010 Office Action; the examining attorney did not raise the objection until the examining attorney's appeal brief.

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, complete printouts taken from any of the USPTO's automated systems (TESS, TARR, or TRAM)) must be submitted. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992).

"If an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have stipulated the registrations into the record." TBMP §1208.02 (3rd ed. 2011). *See also In re 1st USA Realty Professionals,* 84 USPQ2d 1581, 1583 (TTAB 2007) (Board considered applicant's own registration, provided for the first time on appeal, because it had been referred to during prosecution and the examining attorney addressed the issue without objection;

Board also allowed evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake); *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (objection to evidence waived where it was not interposed in response to applicant's reliance on listing of third-party registrations in response to initial Office action). Because the examining attorney addressed the merits of the evidence in applicant's table of registrations without objection in the May 10, 2010 Office action, we find that the examining attorney waived his/her right to object.

With respect to the pending applications listed in the table, a pending application is incompetent to prove anything other than the fact that it was filed. *Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 594 (TTAB 1980). Accordingly, we give no consideration to the applications listed in applicant's table.

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357,

177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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").

A. The similarity or dissimilarity and nature of the goods described in the application and registration, the likely-to-continue channels of trade and classes of consumers.

Applicant is seeking to register its mark for "surgical face masks" and registrant's mark is registered for "face masks for medical, dental and veterinary use." The goods at issue are legally identical for purposes of our likelihood of confusion analysis. Because the goods described in the application and the cited registration are legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods,

and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey,* 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Applicant contends that "registrant's general purpose face masks, suitable for veterinary as well as dental and medical use are not interchangeable with the applicant's surgical face masks and that, therefore, they do not serve the same purpose nor move in the same channels of trade." The problem with applicant's argument is that in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). The description of goods in the

registration are not restricted in any way and, therefore, we find that registrant's face masks for medical use encompass applicant's surgical face masks.

B. The strength of the cited registration.

A major part of our consideration of whether the marks are similar is the strength of the mark in the cited registration. With respect to the inherent strength of the registered mark, the word "Ultra" means "going beyond what is usual or ordinary; excessive; extreme."[2] The word "Soft" means, *inter alia,* "smooth and agreeable to the touch; not rough or coarse: *a soft fabric; soft skin.* … gentle or mild"[3] Thus, the term "Ultra Soft" means very smooth and agreeable to the touch, very comfortable or very gentle. This finding is supported by definitions of terms using the word "Ultra." For example, "ultraclean" means "extremely clean," "ultralight" means "extremely light," and "ultrapure" means "extremely pure."[4]

As indicated above, applicant submitted a table of 71 registrations of marks consisting, in whole or in part, of

[2] The Random House Dictionary of the English Language (Unabridged), p. 2050 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,* 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).
[3] *Id.* at 1813.
[4] *Id.* at 2050.

the word "Ultra" for goods in Class 10, including Registration No. 3667615 for the mark ULTRAMASK for respiratory face masks for medical purposes. Thus, on the record before us, there are three "Ultra" marks (*i.e.*, ULTRA, ULTRA SOFT and design and ULTRAMASK) and two "Ultra" registrations for "Ultra" marks (the cited registration and Registration No. 3667615) for medical face masks.

We also note from the materials submitted by applicant the following sets of registrations for "Ultra" marks for related medical products, owned, except where noted, by different entities:

1. Gloves for medical and/or dental use.

Mark	**Registration No.**	**Goods**
ULTRAGARD	3256375	Disposable latex, vinyl, and nitrile gloves for medical use
ULTRASENSE ULTRAFORM[5]	3283673 2725421	Disposable gloves for medical and dental use
ULTRA-SOFT	3489426	Gloves for medical use
ULTRA-FIT	1868143	Glove liners for use with latex gloves for use by persons with latex sensitivity
ULTRA-PLUS[6]	2052671	Latex examination gloves used in the dental-medical fields

[5] These registrations are both owned by Microflex Corporation.
[6] This registration is owned by applicant.

2. Products and accessories for ultrasound procedures.

Mark	**Registration No.**	**Goods**
ULTRASHAPE	3390298	Ultrasonic therapeutic medical apparatus for medical, aesthetic and therapeutic purposes
ULTRA-COVER	3607822	Disposable medical products, including, *inter alia,* ultrasonic transducer covers
ULTRAMAX	2792486	Ultrasonic skin cleaning device
ULTRAFIT	3728718	Disposable protective cover for ultrasound probes
ULTRAGLIDE	2272095	Medical diagnostic ultrasound scanning gel

3. Needles.

Mark	**Registration No.**	**Goods**
ULTRA-FINE	2642357	Medical syringes and needles
ULTRACLEAN	2501133	Acupuncture needles
ULTRA GLIDE	2293488	Suture needles
ULTRASAFE	2624070	Needle guards and unit dose injection systems

4. Surgical blades

Mark	**Registration No.**	**Goods**
ULTRAFIT	2900456	Surgical blades and scalpels
ULTRA POINT	2086741	Surgical blades and blade tips
ULTRACUT	2707889	Shaver blades for endoscopic use

5. Sutures and related products

Mark	**Registration No.**	**Goods**
ULTRABRAID	3018683	Surgical suture
ULTRA GLIDE	2272095	Suture needles
ULTRAFIX	2162402	Suture anchors, suture anchor inserters, and suture threaders

Third-party registrations are not evidence that the marks are in use, much less that the extent of such third-party use has been so great that consumers have become accustomed to seeing various ULTRA marks in connection with medical products, specifically face masks and, therefore, have learned to distinguish between them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *AMF Inc. v. American Leisure Products, Inc.*, 474

F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nevertheless, the third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of goods and services, or that it has significance in a particular trade or industry.

The word "Ultra" is common to all of the listed registrations. The dictionary definition shows that it has a laudatory meaning that suggests the presence of some extraordinary characteristic. An inference that we can draw from the numerous third-party registrations consisting of the word "Ultra" in connection with medical products is that because of the suggestive or laudatory nature of the word "Ultra," a number of different registrants have believed that various "Ultra" marks can be used and registered side-by-side without causing confusion provided there are minimal differences between the marks and/or the goods. *See Plus Products v. Natural Organic, Inc.,* 204 USPQ 773, 779 (TTAB 1979); *Jerrold Electronics Corp. v. The Magnavox Company,* 199 USPQ 751, 757-758 (TTAB 1978) (third-party registrations reflect belief by registrants, who would be most concerned about avoiding confusion, that various "Star" marks can coexist provided that there is some difference between them); *In re Sien Equipment Co.,* 189 USPQ 586, 589 (TTAB 1975) (the suggestive meaning of

the word "Brute" explains the numerous third-party registrations incorporating that word with other wording or material no matter how little additional significance they may add to the word "Brute" *per se*). Therefore, unlike a situation involving an arbitrary or fanciful mark, the addition of other matter to a laudatory or suggestive word may be enough to distinguish it from another mark. *In re Hunke & Jocheim,* 188 USPQ 188, 189 (TTAB 1975).

> It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Sure-Fit Products Company v. Saltzson Drapery Company, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958). Under these circumstances, marks comprising or containing the word "Ultra" in the medical field should be accorded a narrow scope of protection.

C. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988).

In comparing the marks, we note that the marks are similar in that they have in common the word "Ultra." However, as discussed above, the word "Ultra" has a laudatory or suggestive meaning, and in the circumstances of this case, the inclusion in both marks of this laudatory element is not a sufficient basis for finding likelihood of confusion. Rather, the marks have different meanings and engender different commercial impressions. As indicated above, applicant's mark ULTRA means "going beyond what is usual or ordinary; excessive; extreme." When "Ultra" stands alone as a mark, it engenders the commercial impression of "the best." Registrant's mark ULTRA SOFT, on the other hand, means extremely comfortable or extremely

gentle and therefore engenders a different commercial impression from applicant's mark. These differences in meaning and commercial impression between applicant's mark ULTRA and registrant's mark ULTRA SOFT and design, given the weakness of the word "Ultra," are sufficient to distinguish the marks.

The examining attorney contends that "[a]pplicant's mark ULTRA is similar to the Registered Mark, ULTRASOFT, because both contain the dominant feature ULTRA."[7] We disagree with the premise that the word "Ultra" is the dominant element of the registered mark. Registrant's mark is a unitary term. The word "Ultra" modifies the word "Soft" to convey the meaning that registrant's face masks are very gentle or comfortable. The dictionary definitions using the word "Ultra" noted above (*e.g.*, ultraclean, ultralight, and ultrapure) corroborate this finding.

D. Balancing the *du Pont* factors.

Despite the fact the goods at issue are identical, because the word "Ultra" is a laudatory term, the fact that it is common to both applicant's and registrant's mark is not a sufficient basis to find confusion, particularly because the marks ULTRA and ULTRA SOFT and design have

[7] Examining Attorney's Appeal Brief, unnumbered page 3.

different meanings and engender different commercial impressions. Accordingly, we find that applicant's mark ULTRA for "surgical face masks" is not likely to cause confusion with the mark ULTRA SOFT and design for "face masks for medical, dental and veterinary use." In saying this, however, we wish to make clear we consider "Ultra" to be a suggestive or laudatory term for medical goods that is entitled to only a narrow scope of protection or exclusivity of use, such that if a registration issues to applicant it will also be entitled to a limited scope of protection.

Decision: The refusal to register is reversed.