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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intecorr International, Inc.

Serial No. 78089697

Raymond R. Ferrera for applicant.

Priscilla Milton, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hohein and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Intecorr International, Inc. has appealed from the
final refusal of the Trademark Examining Attorney to
register the mark CORRMETER for "electronic instruments,
namely, sensors, analyzers and processors useful with data
acquisition and control systems for monitoring and
processing data regarding various electrochemical

phenomena, namely, modality data, pitting factors, scaling factors, and corrosion rates."¹

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the mark CORROSOMETER for "electrical instrument to measure in millionths of an inch the progress of corrosion on tested specimens,"² as to be likely to cause confusion or mistake or deception.

Applicant and the Examining Attorney have filed briefs.³ An oral hearing was not requested.

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

¹ Application Serial No. 78089697, filed October 23, 2001, alleging first use anywhere on June 15, 2000, and first use in commerce on December 15, 2000.

² Registration No. 665713, issued August 12, 1958; second renewal.

³ Applicant, in its brief, contends that certain points raised by the Examining Attorney in her denial of applicant's request for reconsideration were improper because they were not raised earlier in the prosecution. Applicant suggests that the application should be remanded to the Examining Attorney "for further discussion based on the merits of said new arguments."

A remand is not warranted under these circumstances. The Examining Attorney, in responding to a request for reconsideration, is permitted to raise new arguments and introduce additional evidence to support the refusal to register. TBMP §1204. Thus, there is nothing improper in the Examining Attorney's actions.

1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Applicant points to a number of distinctions between the goods, including that the registrant's product is incapable of performing the complex tasks handled by

applicant's product. Although applicant's goods are specifically different from the goods identified in the cited registration, the question is whether purchasers are likely to confuse the source of the goods, not the goods themselves.

In this case, both applicant and the registrant sell instruments for checking the progress or rate of corrosion. These products appear to move in the same channels of trade and would be purchased by the same classes of purchasers. The record includes articles retrieved from the NEXIS database showing that the same articles make reference to instruments that measure corrosion and to instruments that monitor corrosion. The Examining Attorney also has made of record two registrations, one owned by the registrant (not cited as a Section 2(d) bar herein) and one owned by a third party, which show that instruments for measuring corrosion and instruments for monitoring corrosion are the types of goods which have been registered by individual entities under a single mark. Such registrations, which individually cover a number of different items and which are based on use in commerce, serve to suggest that the listed goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Accordingly, consumers could well

believe that applicant's identified electronic corrosion monitoring instruments and the registrant's electrical corrosion measuring instruments emanated from the same source if they were offered under similar marks.

With respect to the marks, applicant points out that the registrant's mark includes three additional letters and two additional syllables. As acknowledged by applicant, however, there is no correct pronunciation of a trademark. The similarities in sound, appearance and meaning between the marks CORROSOMETER and CORRMETER outweigh any differences. The marks are similarly constructed in that both begin with a term suggesting "corrosion" followed by the identical term "meter." Although the marks are suggestive, applicant's mark and the registrant's mark convey the same meaning, that is, a meter that checks on corrosion. We also note that the record is devoid of any evidence of third-party uses of similar marks in the trade.

We recognize that the technical nature of the goods dictates that purchasers are likely to be sophisticated and/or have educational advanced degrees, and that this factor weighs in applicant's favor. Nonetheless, given the similarities between the marks and the goods, even careful purchasers are likely to be confused. Purchasers will

assume that one mark is a variant of the other, with each identifying goods coming from a common source.

Applicant makes the point that a metal plate, having artwork and the name of applicant's company, is attached to each of its products. According to applicant, this "marketing technique" still further reduces the likelihood of confusion between the marks. Suffice it to say, however, that in deciding likelihood of confusion, we compare the marks as shown in the application and the cited registration.

In urging that the refusal be reversed, applicant asserts that it and registrant "have had an ongoing business relationship over the course of several years, and that the prior registrant is fully aware of the Applicant's ongoing use of the CORRMETER mark in commerce." Applicant goes on to state that "[t]o date, the prior registrant continues to do business with the Applicant, and has never complained of or voiced any concern regarding Applicant's commercial activities" and that the "prior registrant has also never advised Applicant of even a single instance of any actual or potential market confusion regarding the parties' respective products over a several year period." (brief, p. 3) During the prosecution of the application, applicant earlier indicated that it had "initiated

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discussions considered likely to lead to execution of a consent agreement between the parties which would likely bear on the registrability of the presently claimed mark." (response, July 22, 2002). An agreement, however, was never submitted for consideration.

Applicant's assertions, without any evidentiary support, are not persuasive of a different result. There is no consent agreement of record, and no presumption can be made that the registrant consents to applicant's use and registration of the mark or that the registrant admits that confusion among purchasers by applicant's concurrent use of the mark is unlikely. In re Majestic Distilling Company, Inc., supra at 1205-1206.

In sum, in view of the similarities between the marks and the goods sold there under, we find that confusion is likely to occur in the marketplace.

Decision: The refusal of registration is affirmed.

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