

Applicant: Intecorr International, Inc. : BEFORE THE
Trademark: CORRMETER : TRADEMARK TRIAL
Serial No: 78/089697 : AND
Attorney: Raymond R. Ferrera, Esq. : APPEAL BOARD
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the mark CORRMETER based upon Section 2(d) of the Trademark Act.

FACTS

On 10/23/01, applicant, Intecorr International, Inc, a corporation, filed an application to register the mark "CORRMETER," for "electronic instrument designed to monitor real-time corrosion rates and pitting factors and transmit data to a central processing computer."

In Office Action No. 1, the examining attorney refused registration pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark when applied to the goods, so resembles the registrant's mark "CORROSOMETER," for "electrical instrument to measure in millionths of an inch the progress of corrosion on tested specimens."

The examining attorney suggested an amendment to the identification of goods, requested a substitute specimen and advised applicant of pending application Serial No.

78/047151. The examining attorney informed applicant that if pending Application Serial No. 78/047151 matured into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §1208.01.

In response to Office action No. 1, the applicant amended the identification of goods to read as follows: "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." The applicant advised the examining attorney that applicant has an ongoing, existing business relationship with the prior registrant, and has initiated discussions considered likely to lead to execution of a consent agreement between the parties which would likely bear on the registrability of the mark. Applicant requested a period up to six months to facilitate the negotiations. The applicant informed the examining attorney that applicant was attempting to obtain actual copies of the requested substitute specimens from its overseas manufacturer, and would submit the specimens together with a properly executed Declaration under 37 C.F.R. Section 2.20 when filing its report regarding the aforementioned proposed consent agreement and arguments substantively traversing the refusal under Trademark Act Section 2(d).

In Office Action No. 2, the examining attorney accepted the amendment to the identification of goods, withdrew the advisory concerning the prior pending application and made the specimen requirement and refusal under Trademark Act Section 2(d) final.

In response to Office Action No. 2, the applicant filed a Notice of appeal, submitted a substitute specimen and made arguments in support of registration.

In Office Action No. 3, the examining attorney, reviewed applicant's request for reconsideration, maintained the final refusal under Trademark Section 2(d), made evidence of record to support the conclusion that the respective goods are related, and maintained the final request for a substitute specimen, specifically a statement supporting use of the specimen, signed either in affidavit form or with a declaration under 37 C.F.R. §2.20; TMEP §904.09.

Registration has been finally refused pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark, when applied to the identified goods, so resembles the registrant's mark, as to be likely to cause confusion, or to cause mistake or deceive.

Applicant has appealed, contending that the marks create different commercial impressions and that the goods are not closely related. The applicant submitted the required statement supporting use of the specimen, with a signed declaration under 37 C.F.R. §2.20; TMEP §904.09.

The sole issue on appeal is whether the applicant's mark "CORRMETER" is confusingly similar to U.S. Registration No. 0665713 for CORROSOMETER, thus creating a likelihood of confusion.

ARGUMENTS

1. THE RESPECTIVE MARKS ARE SUBSTANTIALLY SIMILAR IN APPEARANCE, MEANING AND OVERALL COMMERCIAL IMPRESSION.

The examining attorneys finding that the marks create similar commercial impressions is based on the application of a few widely accepted principals. Firstly, similarity in appearance is one factor in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words. *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 E. 2d 1490, 1 USPQ2d 1813 (Fed. Cir 1987) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); In re Lamson Oil Co., 6 USPQ2d 1041 (TTAB 1986) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil). Secondly, the law is clear that similarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion between marks. The focus is on the recollection of the average purchaser who normally retains a general rather than specific, impression of trademarks. See: *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971) (AQUA-CARE (stylized) held likely to be confused with WATERCARE (stylized) both for water conditioning products.

In the present case, the applicant contends that the marks are dissimilar in sound, and appearance. The applicant argues that the marks are distinguishable, that the prior mark CORROSOMETER contains three additional letters when seen, and two additional syllables when either spoken or heard. The record, however, does not support this argument. Viewing the marks in their entireties, it seems clear that the similarities outweigh the dissimilarities. The registered mark CORROSOMETER incorporates every letter of applicant's mark CORROMETER. The composition of the mark is the same, i.e., the word METER is preceded by and conjoined with a designation that is suggestive of corrosion. The applicant has merely deleted three letters from the registered mark, causing a minor difference in the spelling and syllables. The slight sound difference caused by the deletion of the three letters from the registered mark is not differences that would overcome the essential similarity of CORRMETER and CORROSOMETER.

The applicant concedes that the respective marks comprises portions that are suggestive of a meter of some sort used in the corrosion industry. The applicant contends that the registered mark should be viewed narrowly, not broadly in a likelihood of confusion analysis because the prior mark is itself suggestive of its related goods. However, the fact that the respective marks CORRMETER AND CORROSOMETER are suggestive of a meter of some sort in the corrosion industry supports the conclusion that the marks convey the same meaning to a consumer. To this end, the respective marks have the same meaning or connotation, thus creating the same overall commercial impression.

The applicant notes that the applicant and owner of the cited registration have had a 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. The applicant and registrant continues to do business, and the registrant has never complained of or voiced any concern regarding applicant's commercial activities. It seems that applicant is equating the registrant's silence and lack of complaints concerning the applicant's commercial activities with a consent to register applicant's mark. Under *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973) weight may be given to detailed agreements whereby two owners of similar marks agree to use those marks in such a way to avoid consumer confusion. However, in this case, the applicant's statements that the registrant, who has some type of business relationship with applicant, has not complained about applicant's commercial activity is synonymous to a naked consent, which carry little weight. The fact is that the record shows no direct consent from the registrant for applicant to use or register the mark CORRMETER.

The applicant asserts that the prior registrant has never advised applicant of even a single instance of any actual or potential market confusions regarding the respective products. However, the law is clear, the test under Section 2(d) of the Trademark Act is the likelihood of confusion. Absence of actual confusion does not dictate a finding that no likelihood of confusion exists. *Hurst Performance, Inc., v. Torsten Hallman Racing, Inc.*, 207 USPQ 671 TTAB 1980).

Thus, in the case at hand, viewing the marks in their entireties, the similarities in appearance, sound and overall commercial impression outweigh the dissimilarities.

There is no evidence of record that would support a different conclusion

II. THE GOODS OF THE RESPECTIVE PARTIES ARE CLOSELY RELATED.

Turning to the goods, the applicant has questioned the examining attorney's timeliness in submission of arguments to support the conclusion that the goods are closely related. The applicant asserts that the recently issued Office action states that "the respective parties' goods are so closely related that pertinent consumers are likely to be confused as to their source or origin, and then presents entirely new arguments that applicant has never been allowed to consider or traverse." To the contrary, in the first Office action, the examining attorney advised applicant as follows: "The goods are alike. Both goods are electronic instruments to measure corrosion. It is likely that the goods would be sold and marketed to the same consumer. It is also likely that the goods would travel in the same channels of trade and be sold in the same type of venues. Therefore, it is likely that the consumer would be confused as to the source of the goods." When the examining attorney finally refused registration, the applicant had not made one argument in support of registration. Upon submission of a request for reconsideration, the applicant stated as follows: "The office has utterly failed to carry its burden of showing that the goods offered by the respective parties are closely related." In response to the request for reconsideration, the examining attorney submitted evidence to support the conclusion that the goods are closely related. The applicant's request for reconsideration after the final

refusal effectively reopened prosecution for the purpose of admitting the additional evidence similarly to an appeal being suspended and the case remanded for that purpose. Thus, the submission of additional evidence was neither improper nor untimely.

The applicant argues that the goods are not closely related as a matter of law, and that they would instead be clearly distinguishable to an ordinary practitioner in the corrosion arts. While it is clear that the respective goods are used to measure and/or monitor corrosion, the applicant seems to suggest that the goods would not be confused because the registrant's goods are mechanical in nature and relates solely to after-the-fact measurement of certain corrosive effects, and applicant's goods comprise an electrical device with numerous sensors coupled to an analytical processor, which provides users with real time acquisition and control data regarding a wide variety of electrochemical phenomena, including modality data, pitting factors, scaling factors and rates of corrosion as it occurs. The applicant argues that registrant's goods are incapable of performing the complex tasks handled by applicant's goods. It seems, however, that many purchasers familiar with registrant's mark COROSOMETER devices for measuring corrosion would assume, on being confronted with CORRMETER devices for measuring and/or monitoring corrosion, that the registrant has a new line of products or the products emanate from the same source.

For the purpose of determining the likelihood of confusion, of trademarks, The goods/services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions

surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i).

In the present case, both applicant and registrant offers electrical instruments used to either measure or monitor corrosion. The respective goods could be encountered by the same purchasers under circumstances that give rise to the mistaken belief that the goods come from a common source. The examining attorney has made of record the excerpted articles from the examining attorney's search in a computerized data base in which references to applicant's goods and registrant's goods make reference to monitoring corrosion. The examining attorney also refers to references wherein monitoring and measuring corrosion appeared in the same stories. See attachments from the following websites: <http://www.buysmartcet.com/corrmeter/>
http://www.buysmartcet.com/corrmeter/pdf/Implementation_Overview_v1.pdf
<http://www.corrpro.com/rcs/products/corrosometer.htm>
http://www.corrpro.com/rcs/products/corrosometer_instruments.htm
http://www.gebetz.com/ind_app_prod/pdfs/10_03EN.pdf
http://www.google.com/search?as_q=measuring&num=10&hl=en&ie=ISO-8859-1&btnG=Google+Search&as_epq=corrosion+monitoring+instruments&as_oq=&as_eq=&lr=&as_ft=i&as_filetype=&as_qdr=all&as_occt=any&as_dt=i&as_sitesearch=&safe=I

images http://www.chemtreatindia.com/corr_moni.html. The examining attorney has also made of record references to U.S. Registration Nos. 2685678 and 2492045 wherein the registrant's offer instruments for monitoring and measuring corrosion. See attachments to the office action mailed May 9, 2003.

The examining attorney notes applicant's contention that applicant's own marketing techniques help to reduce any possibility of confusion. However, in ex parte examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. Other factors may be considered only if relevant evidence is of record. *See In re National Novice Hockey League, Inc.* 222 USPQ 638, 640 (TTAB 1984).

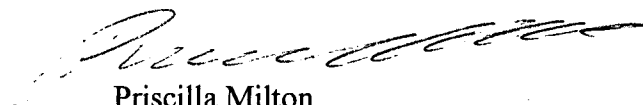
Thus, contrary to applicant's arguments, it seems clear that the goods are closely related. Because of the similarity of the marks and because the goods are closely related, confusion is likely.

CONCLUSION

Applicant's mark "CORRMETER" is confusingly similar to the registrant's mark "CORROSOMETER" The marks are substantially similar in sound, appearance and overall commercial impression. Further, the respective goods are closely related. Any doubt that could possibly exists in determining the likelihood of confusion must be

resolved in favor of the registrant. *Burrough Wellcome Co. v Warner-Lambert Co.*, 203

USPQ 191(TTAB 1979).



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