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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 ITT Cannon GmbH

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Serial Nos. 79103503 and 79103504

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Timothy T. Tyson for ITT Cannon GmbH.

Sharon A Meier, Trademark Examining Attorney, Law Office 112 (Angela Wilson,
Managing Attorney).

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Before Quinn, Wolfson and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark



and the standard character mark BLUE GENERATION based on requests for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1142(f), for goods currently identified as “Electrical connectors namely housings,

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electric and magnetic contacts, insulators, and cables for electrical signal transmission” in International Class 9.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s marks, when used on its identified goods, so resemble the registered standard character mark BLUEGEN for:

Electric power generators; mechanical control devices for heaters, namely, valves being parts of machines; mechanical control devices for air heaters and water heaters, namely, pump control valves, proportional flow valves as parts of machines, thermostatic control valves as parts of machines; pumps for heating installations, namely, pumps for machines (in International Class 7);

Electric circuit switches; testing and measuring instruments for use in testing the performance and efficiency of power plant equipment; power factor regulators to economize the delivery of electrical power; fuel cells and structural parts therefor; fuel cell stacks; galvanic electric cells; galvanic batteries; anodes; cathodes; electric batteries; battery chargers; photo voltaic cells; electric switches and circuit breakers; electricity inverters for use in electric power generation; electricity converters for use in electric power generation; electricity limiters for use in electric power generation; electric voltage transformers; voltage regulators for use in electric power generation; voltage surge protectors for use in electric power generation; electricity switch boxes; electricity control panels; electricity meters; electricity monitoring apparatus, namely, energy meters for tracking and monitoring energy usage; electric instruments, namely, power analyzers; control devices, namely, thermostats and timers for heating installations;

¹ Serial Nos. 79103503 and 79103504 respectively, both filed September 8, 2011. In its brief for Serial No. 79103503, applicant agreed to adopt the examining attorney’s proposed description of the mark, as follows: “The mark consists of the stylized letter B and the wording BLUE GENERATION. The wording is to the right of the letter B and the word BLUE is above the word GENERATION.” Br., p. 6. The description has been entered.

electrical remote control apparatus for heating and air conditioning systems; electric thermostats; computer software for controlling mains power electricity supply apparatus; measuring instrumentation and apparatus, namely, voltmeters, ammeters, ohmmeters, wattmeters, electric power supply analyzers; temperature indicators (in International Class 9);

Apparatus for heating, namely, boilers for heating installations, central heating radiators, heating installations, thermostatic valves as parts of heating installations; lighting apparatus, namely, lighting installations and electric lighting fixtures; steam generators; heat exchangers; heat regenerators; heat exchangers; hot water heaters; central heaters; gas operated apparatus for heating, namely, space heaters and water heaters; air conditioners; cooling appliances and installations, namely, air coolers, water coolers; gas regulators (in International Class 11); and

Installation and repair of heating apparatus; installation and repair of electricity generation apparatus; installation and repair of refrigeration or air conditioning apparatus (in International Class 37)²

as to be likely to cause confusion, mistake or deception. In addition, registration has been finally refused based on the requirement to amend the identification of goods in each application.

As the two appeals involve common issues of law and fact, and the evidentiary records and arguments are highly similar, the Board will decide the appeals in this single opinion.

Evidentiary Objection

As a preliminary matter, the examining attorney's objection to evidence presented for the first time attached to applicant's brief is sustained. Trademark

² Registration No. 3956849, issued on May 10, 2011.

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Rule 2.142(d) (record should be complete prior to filing of appeal). Accordingly, in making our decision, we have not considered Exhibit A or Exhibits C through I, or any arguments in applicant's brief related thereto.³

Identification of Goods

We turn first to the final refusal based on applicant's failure to comply with the Trademark Examining Attorney's requirement for an amended identification of goods.

Trademark Rule 2.32(a)(6), 37 C.F.R. § 2.32(a)(6), requires that the application include "a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark." The Office has discretion to require a more particularized statement of the goods in the identification of goods, including in a case where the goods as identified could be classified in two different International Classes of goods. *See In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007). *See also* TMEP §1402.01 (2013). Moreover, the examining attorney will examine the identification of goods and/or recitation of services in a § 66(a) application according to the same standards of specificity used in examining applications under §§ 1 and 44 of the Trademark Act, 15 U.S.C. §§ 1051 and 1126. TMEP § 1402.01(c). In other words, the examining attorney must follow the procedures set forth in the TMEP, and identify an applicant's goods and/or services according to the USPTO ID Manual, whenever possible. *Id.*

³ The proper method to have new evidence examined after appeal is to request remand which, we note, is granted in only limited circumstances. *See* TBMP §1207.02 (2013). In any event, consideration of that evidence would not have altered our determination.

Applicant's goods originally were identified as "Electric connectors and their parts." In response to the examining attorney's requirement for a more definite identification of the term "parts," applicant amended the identification to "Electrical connectors namely housings, electric and magnetic contacts, insulators, and cables for electrical signal transmission." The examining attorney objects to the amendment because the term "insulators" is beyond the scope of the original identification of goods in that they are properly classified in International Class 17, and the type of "insulators" is not specified. We agree.

Under standard examination practice, the word "namely" is used to set out the common commercial names for items that fall within the general category of the term appearing before the word "namely." See, generally, TMEP § 1402.01(a). If, as applicant argues, applicant sells "insulators" as a component of the electrical connectors, applicant should have used the wording "composed of" or "comprising" rather than "namely." As currently written, the "insulators" appear to be stand-alone goods in a list of items used to modify "electrical connectors."

The ID Manual lists various types of "insulators," including "insulators for electrical cables" in International Class 17; none are listed in International Class 9. Section 66(a) applications, such as the instant applications, cannot be amended to include any goods outside the scope of the class assigned by the International Bureau (in this case International Class 9), as that would result in the lack of a basis for registration of those goods under U.S. law. TMEP § 1401.02(c).


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“Insulators” therefore are beyond the scope of the original identification, and the identification of goods is unacceptable.

Accordingly, we affirm the requirement for a more definite identification of goods.

Likelihood of Confusion


We turn now to the refusal based on a likelihood of confusion with the registered mark BLUEGEN. When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *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 Co., 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 or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We consider first the *du Pont* factor of the similarities and dissimilarities between applicant’s marks  and BLUE GENERATION, and registrant’s mark BLUEGEN. We must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005), *quoting In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The test, under the first *du Pont* factor, is not whether the marks can be distinguished

when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

Further, it is well-settled that marks may be confusingly similar in appearance where similar terms or phrases, or similar part of terms or phrases, appear in both applicant's and registrant's marks. *See, e.g., Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH).


There are obvious visual and phonetic similarities between applicant's marks and registrant's mark in that all three contain the identical word BLUE, followed by the term GEN or GENERATION, and GEN is a recognized abbreviation of the word GENERATION. In fact, the word GENERATION appears as the first of 16 results to the query "what does GEN stand for?" on acronymfinder.com.⁴ As registrant's goods include generators and other electrical power generation apparatus, consumers likely will understand that the GEN in registrant's mark refers to GENERATION.⁵


While applicant's mark  also includes a design element in the form of a stylized letter B, the design element merely draws attention to the first letter in

⁴ See January 5, 2012 Office action. The words "general", "generic (virus scanners)" and "generator" appear in second, third and fourth place, respectively.

⁵ We acknowledge that consumers also could understand that GEN in registrant's mark refers to "generator." However, as a "generator" is a type of electrical power generation apparatus, this distinction is not significant.

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the visually prominent word BLUE. When a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Thus, contrary to applicant's arguments, the wording BLUE GENERATION, which comprises the entirety of applicant's standard character mark, also is the dominant portion of applicant's mark .

We further find that the connotations of the marks are identical, and that they create the same commercial impression. Applicant's use of the full word GENERATION rather than its abbreviation GEN does not result in a different commercial impression between applicant's marks BLUE GENERATION and , and registrant's mark BLUEGEN. In this regard, even if some consumers could view BLUEGEN as similar to the word "bludgeon," as applicant argues, in light of the dictionary evidence regarding the term GEN, we find that consumers would more likely view registrant's mark as an abbreviated form of applicant's marks. Moreover, there is no evidence of record to suggest that consumers would view the letters b-l-u-e within applicant's mark as anything other than the color blue.

Finally, there is no evidence of record to support applicant's contention that the term BLUEGEN is weak, and the examining attorney argues, with supporting evidence, to the contrary.

In view of the foregoing, we find that, when applicant's marks and registrant's mark are compared in their entireties, they are sufficiently similar in

appearance, sound, connotation and commercial impression that, if used in connection with related goods, confusion would be likely to occur. As such, this *du Pont* factor favors a finding of likelihood of confusion.

We turn next to the *du Pont* factor of the relatedness of the goods.⁶ We base our evaluation on the goods as they are identified in the registration and applications. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Contrary to applicant's assertions, the record supports a finding that many of registrant's goods are related to applicant's goods and often emanate from the same source. The examining attorney submitted copies of more than 20 use-based, third-party registrations that include the types of goods identified in the applications and cited registration. These registrations suggest, in general, that electrical connectors are related to many of the items listed in the registration, such as power generators, power equipment, electrical equipment including switches and batteries,

⁶ Although the registration includes services, we need only find a likelihood of confusion vis-à-vis any of the goods in any of the classes in the registration. *See, e.g., See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

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voltmeters, and electricity generating apparatus.⁷ *See In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001). Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. *See, e.g., In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

The examining attorney also submitted web pages from third-party websites showing that the same companies offer the types of registrant's goods and applicant's goods under the same marks. In particular, web pages from the websites of Cole Hersee, Abra Key Dabra Electric, Delphi, Terra Power Systems and Finex Electronics demonstrate that applicant's goods (electrical connectors) and various of registrant's goods (electric and electricity generating apparatus such as electric power generators, electric switches, circuit switches, fuel cells, voltmeters and batteries) commonly are sold together. The evidence also includes web pages and online catalogs from the Google search engine showing that applicant's goods and registrant's goods are of the types that the same companies often sell and the same classes of purchasers often encounter. Specifically, the IQS Industrial Quick Search Manufacturer Directory, KOMPASS and SPSSW.COM web pages list various companies that offer goods of the types identified by both applicant and registrant. Consequently, consumers who encounter these goods under very similar

⁷ See, e.g., Registration Nos. 2545934, 2798898, 3342672, 3603060 and 3564678.

marks are likely to believe, mistakenly, that the goods come from the same source or are otherwise connected.

Based upon the evidence made of record by the examining attorney and the nature of the goods themselves, we find that the goods of applicant and registrant are closely related. As a result, this *du Pont* factor also favors a finding of likelihood of confusion.


Applicant argues, without evidentiary support, that the trade channels are different because the goods of applicant and registrant are not ordered off the shelf, and must be ordered directly from applicant or registrant. However, because the goods are so closely related and there are no limitations in the identifications of the applications and cited registration, such as that the goods are “made to order,” we must presume that they are offered in the same channels of trade to the same classes of customers. *Hewlett-Packard Co.*, 62 USPQ2d 1001. Further, the web pages and online catalogs from the Google search engine mentioned above establish that the goods, as identified, travel in the same trade channels.

Applicant also contends, without support, that applicant’s and registrant’s goods are very expensive, are not subject to impulse buying, and the purchasers are sophisticated. As discussed above, the evidence demonstrates that the same sources of electrical products often offer a variety of goods, including goods of the types identified in the applications and registration, under the same mark, and that consumers are accustomed to seeing those types of goods sold under the same mark. In any event, the fact that purchasers are sophisticated or knowledgeable in a

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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).

Finally, we agree with the examining attorney that applicant's arguments regarding registrant's purported abandonment of its mark constitute an impermissible collateral attack on the registration. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Similarly, applicant's arguments regarding its priority are appropriate for a cancellation proceeding, should applicant choose to initiate one. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Neither argument is appropriate in this *ex parte* proceeding.

In conclusion, we find that because the goods are related, the channels of trade and classes of consumers are the same, and the marks are similar, confusion is likely between applicant's marks  and BLUE GENERATION, and registrant's mark BLUEGEN.

Decision: The refusal to register based on a likelihood of confusion under Section 2(d) of the Trademark Act is affirmed in each application. In addition, the refusal to register based on the requirement for an acceptable identification of goods in each application is affirmed.