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Subject: U.S. TRADEMARK APPLICATION NO. 79103504 - BLUE GENERATION -  
12/107 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 79103504

**MARK:** BLUE GENERATION



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** ITT CANNON GmbH

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

12/107

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTERNATIONAL REGISTRATION NO. 1093151**

The applicant, ITT CANNON GmbH, has appealed the trademark examining attorney's refusal to register the mark BLUE GENERATION on the ground that it is likely to cause confusion with U.S. Registration No. 3956849, within the meaning of Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1052(d), and the examining attorney's requirement to amend the identification of goods. It is respectfully requested that this refusal and requirement be affirmed.

**ISSUES**

The issues on appeal are 1) whether the applicant's proposed mark, BLUE GENERATION, when used in connection with "Electrical connectors namely housings,

electric and magnetic contacts, insulators, and cables for electrical signal transmission” so resembles registrant’s 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,” “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; 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,” “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,” and “Installation and repair of heating apparatus; installation and repair of electricity generation apparatus; installation and repair of refrigeration or air conditioning apparatus,” that is likely to cause confusion, or to cause mistake or to deceive and thus should be refused registration under Section 2(d) of the Trademark Act, and 2) whether the proposed amendment to the identification of goods exceeds the scope of original identification of goods pursuant to 37 C.F.R. §2.71(a).

### **STATEMENT OF FACTS**

On September 8, 2011, the applicant, ITT CANNON GmbH, filed an application under Trademark Act Section 66(a) to register the mark BLUE GENERATION for “Electric connectors and their parts” in International Class 9.

In an Office action dated January 6, 2012, the examining attorney refused registration under Trademark Act Section 2(d) on the ground that the applicant’s mark is confusingly similar to the registered mark BLUEGEN, U.S. Registration No. 3956849, 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” and “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; 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,” “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,” and “Installation and repair of heating apparatus; installation and repair of electricity generation apparatus; installation and repair of refrigeration or air conditioning apparatus.” In addition, the examining attorney required the applicant to amend the identification of goods.

In correspondence filed on May 15, 2012, the applicant responded to the first Office action and asserted therein that the applicant’s mark was not confusingly similar to the registered mark cited by the examining attorney. The applicant also proposed the following amendment to the identification of goods in Class 9: “Electrical connectors namely housings, electric and magnetic contacts, insulators, and cables for electrical signal transmission.”

In an Office action dated June 20, 2012, the examining attorney made final the refusal of registration under Trademark Act Section 2(d). Evidence in the form of registrations and excerpts from the examining attorney’s search on the Internet was attached to demonstrate the relatedness of the goods and services of the applicant and registrant. The applicant’s proposed amendment to the identification was deemed unacceptable and the requirement to amend the identification of goods was also made final.

The applicant filed a Notice of Appeal on October 11, 2012.

This appeal followed.

### **PRELIMINARY OBJECTIONS**

#### **OBJECTION TO THE INTRODUCTION OF NEW EVIDENCE**

Applicant has submitted new evidence with its appeal brief. Specifically, Exhibit A and Exhibits C through I, as well as referencing in its arguments in the Appeal Brief evidence that was never made of record, including searches on Google (p.7 of Appeal Brief), information on the cost of one of the registrant's machines (pp. 10 and 16), another reference to a Google search (p. 10), a dictionary definition for the term generator (p. 10), inferences as to whether or where the registrant's goods are sold and not sold (pp. 10 , 11, 16, and 17), a search conducted on Southern California Gas Company's website (p. 10), whether or not the registrant has legal counsel in the United States (p. 11), whether or not the registrant's goods have been certified by Underwriters Laboratores or any other recognized agency (p. 14), the searches and hits of trademark registrations and applications found on the PTO web site (p. 15). It is noted that Exhibit B is a copy of evidence included in the examining attorney's Office action mailed on January 5, 2012 and in the final refusal issued in the Office action dated June 20, 2012. Accordingly, the following objection does not apply to apply to Exhibit B.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney requests that the Board disregard this evidence. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1990-91 (TTAB 2011); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

The examining attorney objects to the introduction by the applicant of new evidence at the time of appeal. The applicant has attached evidence in the form of

Exhibit A and Exhibits C through I. In addition, in the body of the appeal, the applicant has discussed unsupported evidence that was not attached nor previously made of record and made arguments based on inferences unsupported by any evidence. This evidence was not properly made of record and placed in the file prior to the filing of the appeal by the applicant and is therefore untimely.

TMEP Section 1207.01(c) specifically addresses the issue of an applicant attempting to introduce new evidence at the time of appeal:

“The record in any application should be complete prior to appeal. 37 C.F.R. §2.142(d). Accordingly, if an examining attorney or applicant attempts to introduce new evidence at the time of the appeal, the new evidence will generally be excluded from the record. TBMP §1207.01; see *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont'l Records, Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002).”

TMEP Section 710.01(c)(in part). See also TBMP Section 1207.01.

The examining attorney respectfully requests that the Board exclude from the record all the new evidence introduced at the time of appeal. The examining attorney does not consider the newly introduced evidence to be part of the record and will not discuss the evidence, discuss the merits of the evidence, or otherwise treat it as being of record.

**REQUEST FOR REMAND TO EXAMINING ATTORNEY IF THE BOARD IS  
INCLINED TO CONSIDER THE IMPROPERLY INTRODUCED EVIDENCE**



Should the Board be inclined to consider any of the untimely new evidence objected to above, the examining attorney would respectfully request the remand of this case to the examining attorney. Upon remand, the examining attorney would review and consider the new evidence and address each on their merits.

## **ARGUMENT**

### **1. A LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARK**

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, BLUE GENERATION when used in connection with "Electrical connectors namely housings, electric and magnetic contacts, insulators, and cables for electrical signal transmission," so resembles the mark in U.S. Registration No. 3956849, 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" and "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; 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,” “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,” and “Installation and repair of heating apparatus; installation and repair of electricity generation apparatus; installation and repair of refrigeration or air conditioning apparatus,” as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.*

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark that it is likely, when applied to the services, to cause confusion, or to cause mistake or deceive. TMEP section 1207.01 *et seq.* The Court in *In re E. I. DuPont*

*de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the services. The overriding concern is to prevent buyer or consumer confusion as to the source of the services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga.1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

In the applicant's Appeal Brief, the applicant has sought to address each of the factors set out by the Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The applicant has placed special emphasis on evidence that was not previously made of record and has been objected to by the examining attorney as discussed above. The trademark examining attorney has considered applicant's other arguments that do not rely upon or involve the objected to evidence carefully and found them unpersuasive. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

### **The Marks Are Confusingly Similar**

The applicant's mark is BLUE GENERATION. The registrant's mark is BLUEGEN. The test of likelihood of confusion is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b). The examining attorney must consider the marks in their entireties in determining whether there is likelihood of confusion.

BLUE is the first and most dominant term in each of the marks. Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3956849. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration. Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

The next term in each of the marks begins with the same letters GEN. GEN is an abbreviation for the term GENERATION. Acronym Finder, [www.acronymfinder.com](http://www.acronymfinder.com) (visited December 31, 2011). See Office action dated January 5, 2012, p. 56. GENERATION is the first term listed in a search for what the acronym GEN stands for.

*Id.* Furthermore, consumers are likely to consider the meaning of the acronym or abbreviation relevant to the goods and/or services. Where the registrant's goods and services feature electrical goods and services featuring power generation and electricity power generation apparatus, it is likely to assume that those consumers will understand GEN to be an abbreviation for GENERATION especially when the other meanings are completely unrelated to the applicant's goods and services. As noted in the Office action dated June 20, 2012, it can be pointed out that the pseudo mark field for the registrant's mark BLUEGEN is BLUE GENERATION. No objection to this entry was made by either the registrant or anyone else. Applicant concedes that GEN is an abbreviation of the GENERATON. Applicant's response received May 15, 2012, p.4. Consumers will recognize it as such.

Furthermore, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See 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); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

The applicant cannot appropriate the mark of another by merely adding to it if the commercial impression remains the same. In this case, the dominant portions of the marks are identical, the use of identical wording BLUE and GEN is likely to be impressed on the minds of consumers, and the addition of the full term GENERATION in the applicant's mark in place of the abbreviation GEN in the registrant's mark does not change the commercial impression of the mark. The fact that Applicant's mark contains the word GENERATION is not significant. Both marks share the identical wording BLUE and GEN. The fact that the applicant has chosen to use the complete term GENERATION rather than the abbreviation GEN does not obviate the likelihood of confusion.

Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark . . . .”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011).

The applicant has argued that the term BLUEGEN is weak. Without addressing or considering the evidence already objected to, the examining attorney points out that weakness of a mark is determined by the presence of terms in a mark on the register. In this case, the federal register is devoid of any evidence of weakness of the mark. The only registration for Class 9 goods with the term BLUEGEN is the registration cited

against this application. Accordingly, with respect to the Principal Register, the term BLUEGEN is not weak. Even if the applicant had shown that the cited mark is “weak,” such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.* 193 USPQ 439 (TTAB 1976) and cases cited therein. However, the term BLUEGEN is “strong” in relation to electric products, apparatus and equipment.

### **The Goods and Services Are Highly Related**

It is well settled that, the goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); see *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin’s*



*Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant intends to use its mark in connection with “Electrical connectors namely housings, electric and magnetic contacts, insulators, and cables for electrical signal transmission.” As stated on the registration, the registrant mark is for use on “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” and “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; 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,” “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,” and “Installation and repair of heating apparatus; installation and repair of electricity generation apparatus; installation and repair of refrigeration or air conditioning apparatus.” The goods and services of the parties are highly related because they belong to the same general category of electric goods and services, appeal to the same consumers, and follow similar channels of trade.

In support of the relatedness of the parties’ goods and services, in the Office action dated January 5, 2012 and the final refusal dated June 20, 2012, the examining attorney attached printouts of registrations that indicated an identical source for the goods and services of both parties. In addition, the examining attorney attached excerpted articles from the examining attorney’s search on the Internet further demonstrating the relatedness of the goods and services. Specifically, the previously attached websites from Cole Hersee, Abra Key Dabra Electric, Delphi, Terra Power Systems, Finex Electronics that demonstrate that electrical connectors (the applicant’s goods) and electric and electricity generating devices including electric power generators, electric switches, circuit switches, fuel cells, volt meters, and batteries among other goods (the registrant’s

goods) commonly are sold together. See attachments to the Office action dated January 5, 2012 and to the Final Refusal mailed June 20, 2012. Among the evidence, the examining attorney also attached web pages and online catalogs from the Google search engine showing that applicant's and registrant's goods are the type of goods often sold together by the same company and encountered by the same classes of purchasers. See webpages of KOMPASS and SPSSW.COM that list various companies that offer the goods listed by both the applicant and registrant. Final Refusal, pp. 106 – 116. As a result, consumers who encounter these goods and services under very similar marks are likely to mistakenly believe that the goods and services come from a common origin or are somehow connected.

Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods and services are related to the applicant's identified goods or purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). The registrations noted above demonstrate that electrical connectors are often sold under the same or highly similar mark as other electrical goods such as those offered by the applicant. The Internet evidence attached to the January and June 2012 office actions further demonstrates relatedness of the goods and services. Accordingly, consumers are likely to believe that electrical connectors are within the normal field of expansion of the registrant's goods and services. Because the typical consumer of electric goods including power generators, power equipment, electrical equipment

including switches, batteries, and repair and installation of electricity generation apparatus services is accustomed to seeing the same mark used on wide range of related electrical goods and services to indicate the same source, the use of similar marks for related electrical products such as electrical connectors is likely to create consumer confusion as to source.

The applicant presents unsupported arguments that consumers of electrical products and services are sufficiently sophisticated and knowledgeable to appreciate the differences between the applicant's electrical connectors and registrant's real estate services. The examining attorney is not persuaded by this statement as the evidence previously attached demonstrates that sources of electrical goods and services routinely offer an array of goods and services including the goods and services of both parties under the same mark. Consumers are accustomed to seeing these goods and services provided under the same mark. Regardless, the fact that 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); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). TMEP §1207.01(d)(vii).

The electrical products and services of the parties are highly related. The evidence in the form of registrations and Internet excerpts previously attached show that applicant's and registrant's goods and services are the type of services often provided together by the same company and encountered by the same classes of consumers. As a result, consumers who encounter these goods and services under very similar marks are

likely to mistakenly believe that the services come from a common origin or are somehow connected.

The applicant admits “[b]oth Applicant’s and Registrant’s products are industrial electrical products and not household products” and “the methods of the channels of trade are identical.” Applicant’s brief, pp. 13-14. The applicant does not dispute the evidence made of record by the examining attorney to demonstrate the relatedness of the goods and services, including copies of registrations as well as excerpts from the examining attorney’s search on the Internet. The applicant’s arguments that “[i]t is impossible to buy the goods of Applicant from Registrant” and “it is impossible to buy the goods of Registrant from Applicant” is unpersuasive. Applicant’s Brief, p. 18. The question is not whether a consumer can in fact purchase related goods from a particular party, but whether consumers are accustomed to encountering the goods and/or services of both parties under the same or highly similar mark. The evidence demonstrates that not only is it possible, but that these goods and services are commonly offered under the same mark and provided by the same source.

### **Collateral Attack Prohibited**

Applicant argues that the owner of the cited registration has abandoned its trademark mark due to nonuse. However, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified goods. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv).

Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. *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). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Similarly, applicant's claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

## **2. APPLICANT'S PROPOSED AMENDMENT TO THE IDENTIFICATION OF GOODS EXCEEDS THE SCOPE OF THE ORIGINAL IDENTIFICATION**

A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2) and 1051(b)(2); 37 C.F.R. §2.32(a)(6). To "specify" means to name in an explicit manner. TMEP §1402.01. The identification should set

forth common names, using terminology that is generally understood. *Id.* For products or services that do not have common names, the applicant should use clear and succinct language to describe or explain the item. In addition, the identification of goods and/or services must be specific, definite, clear, accurate, and concise. *See In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987);

The USPTO has discretion to require the degree of particularity deemed necessary to clearly identify the goods and/or services covered by the mark. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007). The examining attorney, moreover, will examine the identification of goods and/or 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. That is, the examining attorney must follow the procedures set forth in the TMEP and identify the goods and/or services in accordance with the USPTO ID Manual, whenever possible. TMEP §1402(c).

In the present case, a portion of applicant's identification of goods in International Class 9 is not acceptable under the standards set forth in the TMEP and, more particularly, the USPTO ID Manual. In particular, the wording "insulators" is beyond the scope of the original identification.

The application in this case was submitted under Section 66(a) with a request for extension of protection for goods in Class 9 only. The identification submitted in the original application reads, "Electric connectors and their parts" in International Class 9. In the Office action dated January 5, 2012, the applicant was required to specify the type

of “parts” using common commercial terms for goods in Class 9 only. The advisory for Section 66(a) applications was provided notifying the applicant that the classification for goods cannot be changed. TMEP §§1401.03(d), 1904.02(b). The applicant proposed an amendment to the identification in its response dated May 15, 2012, deleting the term “parts” and providing specificity as to the types of connectors. The proposed amendment reads, “Electrical connectors namely housings, electric and magnetic contacts, insulators, and cables for electrical signal transmission.” Although the applicant chose to delete the wording related to “parts” and voluntarily amended the application to provide clarification and/or limitation to the type of connectors offered by the applicant, the requirements and advisories related to amendments to the identification of goods still applied. Accordingly, the examining attorney issued a final requirement on June 20, 2012, indicating that the wording “insulators” is beyond the scope of the identification because insulators are found in Class 17, not Class 9. Furthermore, this wording is unacceptable because the type of insulators is not specified. The scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

While an applicant may amend an identification of goods and/or services only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods



and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends the identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and/or services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

The proposed amendment is not acceptable because it adds goods that are not included in the original identification and cannot be added because they are properly classified in International Class 17, not International Class 9. Specifically, the goods “insulators” are not encompassed within the scope of the identification of record. Insulators are classified in International Class 17. Accordingly, they cannot be added to the identification to clarify the type of connectors provided by the applicant.

Applicant argues that the proposed amendment should be permitted because applicant is not selling insulators separately and that the insulators listed in the application are components of the connectors, not individual goods. Applicant’s Appeal Brief, p. 18. In other words, applicant argues that the “insulators” constitutes components of the “electric connectors” within the scope of the identification of goods. Applicant does not dispute that “insulators are classified in Class 17 when they are sold by themselves.” Applicant’s Appeal Brief, p. 18.

This argument is unpersuasive in light of the common understanding and practice related to the use of the wording “namely.” Contrary to the applicant’s arguments, the use of the wording “namely” does not suggest major components, but rather serves to permit the applicant the opportunity to clarify the type of goods listed before the term “namely” and then list the specific goods identified by their common commercial or generic names after the term “namely.” Had the applicant intended to list the major components of the electrical connectors, the applicant could have used wording such as “comprised of” or “comprising.” Furthermore, the applicant did not specify insulated cables but has listed insulators separately.

Applicant argues that “almost all electrical connectors are sold with insulators surrounding their cables.” In this context, it is unclear whether the applicant is referring to insulation material commonly used to bind and protect cables commonly referred to as “insulation” or whether the applicant is referring to stand alone insulators such as electrical ceramic insulators for use on railways or electrical insulators for use on electric utility poles or power transmission towers. Various types of insulation and insulators are found in Class 17, not in International Class 9. If the applicant is in fact referring to the insulation found on the cables then the entry of “insulators” is misleading as it is not a component of the electrical connectors but rather a component of the cables. A suggestion to properly amend the identification would be for the applicant to delete “insulators” from the listing and simply further clarify the type of cables, e.g., “Electrical connectors comprised of housings, electric and magnetic contacts, and \_\_\_\_\_ cables [applicant can specify the type of insulated cables, e.g., mineral insulated cables, asbestos fabric insulated cables] for electrical signal transmission.”

As currently listed, the “insulators” appear to be stand alone goods in a listing of items used to modify “electrical connectors.” As such, the insulators are beyond the scope of the original identification because the applicant cannot amend the identification in a Section 66(a) application to include goods that are properly listed in Class 17.

Please note, as discussed above, the examining attorney will not consider the evidence attached in Exhibit I or the arguments related to insulators in Class 21 as this evidence has been objected to as untimely. Specifically, the examining attorney will not discuss the applicant’s reliance on a U.S. Acceptable Identification of Goods and Services Manual (ID Manual) printed in 1989, particularly when entries for insulators have been listed in International Class 17 in the Identification Manual as far back as 1991. For the applicant’s reference, please note that periodically the USPTO revises the *U.S. Acceptable Identification of Goods and Services Manual (ID Manual)* based on changes to the international classification system and the USPTO’s policies regarding acceptable identifications of goods and services. *See* TMEP §1402.14. Identifications are examined in accordance with the Trademark Rules of Practice and the USPTO’s policies and procedures in effect on the date an application is filed. *See* 37 C.F.R. §2.85(e)(1); TMEP §1402.14. However, an applicant may voluntarily choose to follow policies and procedures adopted after the application was filed. *See* 37 C.F.R. §2.85(e)(2); TMEP §1401.12.

For guidance on writing identifications of goods and/or services, applicant was provided with information on the USPTO’s online ID Manual at <http://tess2.uspto.gov/netathtml/tidm.html>, which is continually updated in accordance with prevailing rules and policies. *See* TMEP §1402.04. Please note that the link to the

current Manual of Acceptable Identifications of Goods and Services has been included in every Office action forwarded to the applicant.

### **CONCLUSION**

The applicant has a legal duty to select a mark that is totally dissimilar to trademarks and/or service marks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). In light of that duty, and for the foregoing reasons, the examining attorney respectfully requests that the Board resolve the likelihood of confusion in favor of the registrant and affirm the refusal to register the mark on the basis of Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1052(d).

Applicant's proposed amendment to the identification of goods constitutes a broadening of the scope of the identification of record in that it includes goods that are not encompassed. For the foregoing reasons, it also is respectfully submitted that the requirement under 37 C.F.R. §2.71(a) to amend the identification of goods in a manner that does not exceed the scope of the original identification be affirmed.

Respectfully submitted,

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