

This Opinion is Not a  
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Weber Maschinenbau GmbH Breidenbach*

Serial No. 79281976

Joseph T. Nabor of Fitch, Even, Tabin & Flannery LLP,  
for Weber Maschinenbau GmbH Breidenbach.

Andrea D. Saunders, Trademark Examining Attorney, Law Office 117,  
Cynthia Tripi, Managing Attorney.

Before Lykos, Adlin, and Allard,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Pursuant to Section 66(a) of the Act, 15 U.S.C. § 1141f(a), Weber Maschinenbau GmbH Breidenbach (“Applicant”) filed a Request for Extension of Protection of an international registration for the mark WEBER WEPACK (in standard characters)<sup>1</sup>

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<sup>1</sup> The mark appears on the Request for Extension’s drawing page as “WEBER wePACK” but retains a claim as to standard characters and not special form. The presentation of the mark on the drawing page does not change the nature of the mark from a standard character mark to a special form mark. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (setting forth requirements for standard character mark). *See also In re Calphalon Corp.*, 122 USPQ2d 1153, 1158-61 (TTAB 2017) (applicant’s amendment of mark from SHARPIN to SharpIn did not transform mark from standard character to special form). Our references to Applicant’s

on the Principal Register for “Packaging machines for foodstuffs; robots for food packaging; conveyors for packaging food portions and food products; conveyor belts for food packaging machines; machines for separating and isolating packaged foodstuffs; machines for labeling and lettering food packaging; parts and fittings for the aforesaid goods” in International Class 7.<sup>2</sup>

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s applied-for mark so resembles the registered mark WEPACKIT (also in standard characters) for “packaging machines” in International Class 7 that it is likely to cause confusion or mistake or to deceive.<sup>3</sup>

Following issuance of the final refusal, Applicant timely filed a request for reconsideration with its notice of appeal which was denied. The case is now briefed.

For the reasons explained below, we affirm the refusal to register.

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mark in this opinion in all uppercase letters reflects the fact that a term, when registered as a mark in standard character format, is not limited to any particular presentation as to upper and lower case lettering. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) (“Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.”).

<sup>2</sup> Application Serial No. 79281976, filed October 9, 2019, based on International Registration No. 1522436 issued March 26, 2020 with a priority claim as of April 12, 2019.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. Citations to briefs refer to actual page number, if available, as well as TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

<sup>3</sup> Registration No. 5652483, registered on January 15, 2019. The mark is also registered for services in three other classes; however, the basis for the Examining Attorney’s refusal was limited to the goods in International Class 7.

## I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”); *see also In re Chatam Int’l*

*Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and others, are discussed below.

**A. The Goods and Established, Likely-to-Continue Channels of Trade and Classes of Consumers**

We commence by comparing the goods as they are identified in the involved application and cited registration, the second *DuPont* factor. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

As noted above, Registrant’s International Class 7 goods are identified simply as “packaging machines.” The application includes, among other goods, “[p]ackaging machines for foodstuffs.” With regard to this language, Applicant argues that,

[o]n the basis of the identification of goods of the parties, Wepackit Machinery’s “packaging machines” is a broad catch-all that can refer to any packaging machines that are wholly unrelated to the Applicant’s packaging machines for foodstuffs, as well as its robots for food packaging, machines for separating and isolating packaged foodstuffs, and machines for labeling and lettering food packaging. ...Here, Wepackit Machinery’s registration includes broad language in the identification as to packaging machines. However, upon examination, the language used in the cited registration is not so broad as to encompass all of the

products identified in the Applicant's description of goods or any reasonably related goods or services.<sup>4</sup>

Applicant's arguments miss the point. Insofar as Registrant's "packaging machines" are unrestricted as to type, we must assume that the identification encompasses all kinds of packaging machines, including Applicant's specialized packaging machines for foodstuffs. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). As such, the goods are legally identical in part. Moreover, it is well-established that likelihood of confusion must be found as to the entire class if there is likely confusion with respect to any good that comes within the identification in that class. *See Tuxedo Monopoly Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item that comes within the identification of goods or services in that class).

This brings us to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers. Because the goods are legally identical in part, we must presume that those particular goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers seeking packaging machinery for foodstuffs. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding

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<sup>4</sup> Applicant's Brief, p. 5; 7 TTABVUE 6.

channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Similarly, insofar as Registrant's identification does not contain limitations regarding intended users of its respective goods, we cannot narrow the class of the intended purchasers to exclude those seeking packaging machines for foodstuffs. *See, e.g., Detroit Athletic Co.*, 128 USPQ2d at 1052 ("the registration does not set forth any restrictions on use and therefore cannot be narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers") (citation omitted).

In view of the foregoing, the second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.

## **B. The Marks**

We now direct our attention to the first *DuPont* factor, an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019);

(citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728 , 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Where, as here, the goods are identical in part, less similarity between the marks is needed for us to find a likelihood of confusion. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

Applicant acknowledges that both marks contain the phrase “we pack” but argues that the similarities stop there. Applicant urges the Board to find that the marks

differ not only visually and aurally but also in meaning and commercial impression due to the addition to its mark of the initial term WEBER, an abbreviated version of Applicant's corporate name. In terms of appearance and sound, Applicant points out that its mark is comprised of two words with eleven letters in total, whereas the cited mark is limited to one term with eight letters. To support the argument that consumers will perceive this first term as a recognizable trade name, Applicant made of record two of its prior registrations for the mark WEBER.<sup>5</sup> Applicant also points to the display of WEBER WEPACK on its website with WEBER depicted in bold white letters outlined in blue in a stylized font.<sup>6</sup> With regard to connotation and commercial impression, Applicant takes the position that the "we" component of its mark creates a double entendre because it is a play on the pronoun "we" as well as the Weber trade name.

Applicant's arguments with regard to the actual depiction of its mark are misplaced. In an ex parte appeal, our analysis is based on the marks as depicted in the application and cited registration without regard to how the marks appear in actual use. *See also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on

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<sup>5</sup> October 19, 2020 Response to Office Action, Exhibit A (Registration Nos. 3011409 and 5547763), pp. 10-20. Applicant also made of record its application Serial No. 79276427 for the mark WEBER GUARDIAN. *Id.* at Exhibit B.

<sup>6</sup> *Id.* at Exhibit C, p. 27.



any labels that may have additional wording or information.”). Thus, our comparison involves a determination of whether Applicant’s mark as it appears on the drawing page is similar in appearance, sound, connotation and commercial impression to the cited mark as it appears on the cited registration’s drawing page, and nothing more.

Furthermore, we disagree with Applicant’s assessment that the marks can be distinguished visually and phonetically on the basis that the applied-for mark consists of two terms whereas the cited mark consists of a single term. WEPACK as it appears in Applicant’s mark and WEPACKIT in Registrant’s mark are each compound word mark components, i.e. a mark or component comprised of two or more distinct words (or words and syllables) that are represented as one word (e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, and PULSAIR). *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1213.05(a) (July 2021). While there is no correct pronunciation of a mark, consumers are likely to pronounce these components as “we pack” and “we pack it.” Contrary to Applicant’s contention, consumers do not focus on minutia but rather overall impressions. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 315-16 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting — they are governed by general impressions made by appearance or sound, or both.”).

With regard to determining the dominant element in each mark, we acknowledge our case law that consumers are generally more inclined to focus on the first word in a trademark. *See, e.g., Palm Bay*, 73 USPQ2d at 1692 (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . .

remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”). This principle, however, is merely a guide. “[T]he presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.” *In re Mighty Leaf Tea*, 601 F.3d, 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Consumers familiar with the registered mark WEPACKIT are likely to perceive Applicant’s mark WEBER WEPACK as a variant mark denoting a product line extension. *See, e.g., Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant’s mark is a variation of opposer’s mark that opposer has adopted for use on a different product.”); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d at 1271 (VANTAGE TITAN “more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices”). This is because the marks share a similar meaning and commercial impression. The phrase “we pack” conveys anthropomorphic attributes to both Applicant’s and Registrant’s packaging machinery. Thus, the addition of the preposition “it” to the cited mark does not create a significantly different overall connotation and impression than Applicant’s mark. Consumers are unlikely to perceive the WEBER component of Applicant’s mark as a play on the trade name WEBER since “we” combined with the suffix “-ber” is nonsensical and has no known meaning. *See* TMEP § 1213.05(c) (“A ‘double entendre’ is a word or expression capable of more than one interpretation. For trademark purposes, a ‘double entendre’ is an expression that has a double connotation or

significance as applied to the goods or services.”).

In sum, we acknowledge the fundamental rule that the marks must be considered in their entirety and not dissected. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 273-74 (CCPA 1974). It is likely that consumers, when encountering Registrant’s mark, will focus on the dominant literal portion, namely the phrase WEPACK, just as they would focus on the WEPACK portion in Applicant’s mark. The emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)). Thus, when comparing the marks overall, they are similar in sound, meaning, connotation and overall commercial impression. The similarity of the marks also weighs in favor of finding a likelihood of confusion.

### **C. Conditions of Sale**

We turn now to the conditions under which the goods are likely to be purchased, *e.g.*, whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

The record shows that a packaging machine for foodstuffs is a highly specialized, expensive piece of industrial equipment not offered for sale to the general public. For example, the Berkel 350-STD Food Packaging Machine offered by KitchenRestock retails for \$7709.25.<sup>7</sup> An excerpt from Bush Machinery’s website explains that “the types of food packaging machines are as varied as the products you will see in grocery stores. ... Piston filling machines are great for filling thick products with particulates – hot or cold – into bottles, jars, or pouches.<sup>8</sup> WeighPack touts its provision of a “wide variety of bulk and food processing machines... providing our customers a wide selection of products based on available foot print, package style, budget and production requirements.<sup>9</sup> Thus, packaging machines for foodstuffs are sold in a niche industry to industrial buyers with expertise in the field. Accordingly, this factor weighs against finding a likelihood of confusion.

## **II. Balancing the *DuPont* Factors - Conclusion**

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. The fourth *DuPont* factor does not favor a likelihood of confusion because the goods are relatively expensive and the relevant consumers have specialized knowledge and expertise, and will make careful purchasing decisions. Nonetheless, the first, second and third factors each weigh in favor of finding a likelihood of confusion. While there are instances where a single *DuPont*

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<sup>7</sup> October 19, 2020 Response to Office Action, p. 44.

<sup>8</sup> September 7, 2021 Denial of Request for Reconsideration, p. 2.

<sup>9</sup> *Id.* at 5.

factor is dispositive, we find that the fourth *DuPont* factor does not play such a role here, given the strong similarity between the marks when compared as a whole as applied to in-part legally identical goods in presumptively overlapping trade channels. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Balancing these factors, we find that the first three *DuPont* factors outweigh the fourth *DuPont* factor, i.e., any care in purchasing decisions. Accordingly, we find that confusion is likely between Applicant's applied-for mark and the mark in the cited registration.

**Decision:** The Section 2(d) refusal is affirmed.